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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/150,155

Published in the Official Gazette of September 4, 2001

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GABRIELLE STUDIO, INC.,

Opposer,

Opposition No.

-against-

NOTICE OF OPPOSITION

BCNY INTERNATIONAL INC.,

Applicant.

----- X

Gabrielle Studio, Inc. ("Opposer"), a New York corporation, having an address at 87 Mayfield Avenue, Edison, New Jersey, 08837, believes that it will be damaged by registration of the mark shown in Serial Number 76/150,155, filed October 19, 2000, seeking registration on the Principal Register in International Class 25 and hereby opposes the same.

As grounds of opposition, it is alleged that:

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202 on

March 26, 2002
(Date of Deposit)

Esther M. Weiner
(Typed or printed name of
person mailing paper or fee)

Esther M. Weiner
(Signature)

1. For many years, Opposer has been and is now engaged in the business of producing, selling and distributing wearing apparel and various fashion accessories, including sunglasses, jewelry, bags and other personal accessories of the highest quality.

2. Beginning at least as early as August 1988 and continuing to the present in connection with wearing apparel, and beginning at least as early as December 1990 and continuing to the present in connection with footwear, Opposer has through authorized licensees used in interstate commerce the trademark DKNY in International Class 25.

3. All use of the trademark DKNY by Opposer's authorized licensees as hereinabove alleged inures to the benefit of Opposer.

4. Opposer is the owner of the following federal registrations, among others, for the trademark DKNY:

(a) A Principal Register registration of the mark DKNY , Registration No. 1,554,808 for "women's apparel; namely, dresses, skirts, sweater, jackets, pants, trench coats, and body suits" in International Class 25, registered September 5, 1989.

(b) A Principal Register registration of the mark DKNY, Registration No. 1,586,886 for "hats, caps, neckties, ascots, scarves, gloves, belts, and shoes" in International Class 25, registered March 13, 1990.

(c) A Principal Register registration of the mark DKNY, Registration No. 1,649,910 for "t-shirts" in International Class 25, registered June 4, 1991.

(d) A Principal Register registration of the mark DKNY, Registration No. 1,848,632 for "panty hose, tights, and socks" in International Class 25, registered August 9, 1994.

(e) A Principal Register registration of the mark DKNY, Registration No. 1,949,229 for "footwear" in International Class 25, registered January 16, 1996.

(f) A Principal Register registration of the mark DKNY, Registration No. 2,470,110 for "clothing for men, women and children, namely, coats, raincoats, anoraks, parkas, blazers, jackets, cardigans, boleros, sport coats, wind resistant jackets, suits, tuxedos, vests, dresses, evening gowns, jumpers, skirts, pants, slacks, trousers, jeans, dungarees, jumpsuits, overalls, coveralls, flight suits, gym suits, jogging suits, sweat pants, thermal underwear, shorts, skorts, rompers, culottes, shortalls, shirts, sweaters, jerseys, blouses, tunics, sweatshirts, t-shirts, halter tops, tank tops, bodysuits, unitards, camisoles, chemises, undershirts, slips, foundation garments, bodyshapers, brassieres, bustiers, garter belts, briefs, boxer shorts, bloomers, underpants, panties, lingerie, loungewear, nightgowns, night shirts, negligees, robes, pajamas, hosiery, pantyhose, tights, knee highs, leg warmers, leggings, socks, head wear, hats, caps, hoods, head bands, neckties, bow ties, ascots, pocket squares, scarves, shawls, neckerchiefs, gloves, mittens, belts, sashes, cummerbunds, shoes, footwear, boots, athletic shoes, athletic footwear, galoshes, swimwear, bathing suits, bathing trunks, beachwear, beach coverups, sarongs, ski wear, ski suits, ski pants, ski gloves, thermal socks, infant wear, bibs, booties, baby bunting, playsuits" in International Class 25, registered July 17, 2001.

5. The registrations noted above in paragraph 4 are all valid, subsisting, and in full force and effect. Registration Nos. 1,554,808; 1,586,886; 1,649,910; and 1,848,632 are all incontestable.

6. On or about October 19, 2000, BCNY International Inc. ("Applicant") filed an application in the United States Patent and Trademark Office, Serial No. 76/150,155, to register BCNY as a trademark for "footwear" in International Class 25.

7. In its aforementioned application for the trademark BCNY, Applicant claimed a date of first use and first use in commerce of April 1992.

8. Since long prior to April 1992 and continuing to the present, Opposer has through authorized licensees continuously and extensively advertised and otherwise promoted the sale of wearing apparel, footwear and other Class 25 products bearing its DKNY trademark and has made significant sales of such products in interstate commerce.

9. As a result of the sales, advertising and promotion of goods as hereinabove alleged under its DKNY trademark, Opposer has built a valuable goodwill in its DKNY trademark, which has come to signify quality products originating with Opposer.

10. Also, as a result of the sales, advertising and promotion of goods as hereinabove alleged under its DKNY trademark, Opposer's trademark DKNY has become famous and distinctive, and was so prior to April 1992, the dates of first use and first use in commerce claimed by Applicant in Application No. 76/150,155.

11. Upon information and belief, Applicant has made no use in commerce of the BCNY trademark for the goods specified in Application Serial No. 76/150,155 as of the present time.

12. The goods for which Applicant seeks to register the trademark BCNY are identical to those in connection with which Opposer has used Opposer's DKNY trademark.

13. Upon information and belief, the goods for which Applicant seeks to register the trademark BCNY will be sold to the same classes of purchasers as the goods originating from Opposer under Opposer's DKNY trademark, and may be advertised and promoted through similar media of communication.

14. Applicant's trademark BCNY so resembles Opposer's DKNY trademark as to be likely, when applied to the goods of Applicant, to cause confusion, or to cause mistake, or to deceive. As a result of Applicant's registration and use of the trademark BCNY in connection with the goods specified in Application No. 76/150,155, the public is likely to be confused and deceived into the mistaken belief that these goods, sold and/or advertised by Applicant, have their origin with Opposer, or that such goods are approved, endorsed or sponsored by Opposer or are associated in some way with Opposer.

15. Opposer's common law and statutory rights in Opposer's DKNY trademark precede October 19, 2000, the filing date of Application No. 76/150,155, as well as April 1992, the dates of first use and first use in commerce claimed by Applicant in Application No. 76/150,155. Accordingly, Opposer's common law and statutory rights in its DKNY trademark afford Opposer a priority over Application No. 76/150,155 and Applicant's claimed dates of first use and first use in commerce of the trademark BCNY.

16. Opposer would be injured by the granting to Applicant of a certificate of registration for Applicant's BCNY trademark because that mark is so similar to Opposer's DKNY trademark that, when applied to the goods of Applicant, it would be likely to cause confusion, or to cause mistake or to deceive, and would falsely suggest a connection with Opposer.

17. Opposer further would be injured by the granting of such registration because it would inevitably tend to damage Opposer's valuable goodwill in Opposer's DKNY trademark, and interfere with Opposer's sale of its goods under that mark.

18. Registration of Applicant's BCNY mark in connection with the applied-for goods in International Class 25 would dilute the distinctive quality of the DKNY mark, thus further damaging Opposer.

WHEREFORE, Opposer, by its attorneys, respectfully prays that its opposition be sustained and that the application for registration be denied.

Dated: New York, New York
March 26, 2002

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys For Opposer

By: *Susan R. Schick*

Jeffrey H. Epstein

Susan R. Schick

1133 Avenue of the Americas
New York, NY 10036-6799
(212) 790-9200