

TTAB

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



04-17-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #61

In re trademark application serial no.: 76295565
Filed: August 6, 2001
For the mark: ADELANTE HISPANIC
MARKETING A DIVISION OF GEORGES
DIRECT
Published in the Official Gazette on March 19, 2002

02 MAR 26 11 14 AM '02

DGWB, Inc.,

Opposer,

v.

Georges Direct, Inc.,

Applicant.

Opposition Number: _____

NOTICE OF OPPOSITION

Asst. Commissioner for Trademarks
Box TTAB / FEE
2900 Crystal Drive
Arlington, VA 22202-3513

DGWB, Inc. ("Opposer"), a California corporation, whose business address is 217 N. Main Street, Suite 200, Santa Ana, CA 92701, believes that it will be damaged by the registration of the mark ADELANTE HISPANIC MARKETING A DIVISION OF GEORGES DIRECT (Serial Number 76295565) as applied for by Georges Direct, Inc. ("Applicant"), which application was published for opposition in the Official Gazette on March 19, 2002 (page TM 565). DGWB, Inc. hereby opposes, the registration of said mark in International Class 35 for use with all goods and services as stated on the application of Georges Direct, Inc.

Opposer, through its attorneys, brings forth this Opposition to Applicant's confusingly similar mark under 15 U.S.C. §1063.

As grounds for opposition, it is alleged that:

1. Opposer is a California corporation whose address is 217 N. Main Street, Suite 200, Santa Ana, CA 92701.

2. Opposer provides professional business services including, but not limited to, advertising, marketing, and business consulting services directed towards the Hispanic community. Opposer uses the similar mark ADELANTE as a trademark and hence, a source of origin for the services it offers and provides. Opposer has been using its mark ADELANTE in interstate commerce as early as August 1999.

3. Opposer is the owner of the trademark application pending before the United States Patent and Trademark Office (serial no. pending) as filed on April 15, 2002 for registration of the mark ADELANTE for use with an advertising agency and marketing services to the hispanic community in International Class 35. Opposer's application is based upon actual use of the mark ADELANTE as early as August 1999, which precedes Applicant's reported first use of its confusingly similar mark, August 2001.

4. Opposer has expended substantial sums of time, money, and effort in advertising, promoting, developing, and popularizing its mark ADELANTE as a trademark such that members of the trade, and public have come to associate the usage of the mark ADELANTE as services originating with Opposer only.

5. The pending ADELANTE HISPANIC MARKETING A DIVISION OF GEORGES DIRECT mark, as applied for by Applicant, is likely to be confused with Opposer's mark ADELANTE, which Opposer has been using prior to Applicant's alleged first use. Opposer's first use of the mark ADELANTE dates as early as August 1999, while Applicant's first use of its confusingly similar mark is reported as August 2001. Hence, Applicant is not entitled to adopt, use or seek registration of its mark based upon

well established trademark principles set forth in the Lanham Act which states that priority of similar or confusing marks goes to the first user of the mark.

6. Applicant's mark ADELANTE HISPANIC MARKETING A DIVISION OF GEORGES DIRECT, encompasses Opposer's mark ADELANTE. The word "adelante" appears identical in spelling, connotation, pronunciation, and commercial impression such that use of the respective marks will create a likelihood of confusion among members of the trade and public.

7. The services identified in Applicant's application are closely related to the services provided by Opposer so far as both listed "advertising," and "marketing services." Thus, the channels of trade are likely to be identical.

8. The services described in Applicant's application are of the same nature as those services offered by Opposer, such that the trade and purchasing public would reasonably anticipate that such services would originate from the same source. This is in direct conflict with basic trademark principles as Opposer's mark would no longer be recognized as the sole and exclusive origin of the services, especially considering Opposer's prior use of the mark ADELANTE.

9. Opposer has received several acknowledgements and awards for the use of its prior mark ADELANTE, and is likely to be damaged by the registration of Applicant's confusingly similar mark.

10. Since Applicant's and Opposer's services are similar, and are offered and provided in similar channels of trade, to the same types of customers, and since Applicant's mark incorporates the identical spelling, pronunciation, and connotation of Opposer's mark ADELANTE, any problems or lack of quality of service on behalf of Applicant will reflect adversely on Opposer and its established goodwill and reputation, unless this opposition is sustained.

11. Applicant's use of the mark incorporating Opposer's mark ADELANTE will dilute or impair Opposer's rights, and will eventually result in a loss of distinctiveness and exclusivity of Opposer's mark. Thus, this opposition must be sustained.

12. Opposer clearly has superior rights over Applicant's pertaining to the use of the mark ADELANTE as Opposer has used its mark in commerce continuously and prior to the date claimed by Applicant. Thus, Opposer claims that confusion, and mistake by members of the trade and public will occur as between Opposer's and Applicant's marks and as to the origin of similar services, with resulting damage to Opposer.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that the registration of Applicant's mark ADELANTE HISPANIC MARKETING A DIVISION OF GEORGES DIRECT (serial number 76295565) be refused.

Dated: April 17, 2002

Respectfully Submitted,

Rutan & Tucker, LLP



S. Daniel Harbottle

Attorneys for Opposer DGWB, Inc.

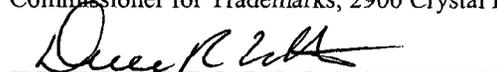
Please direct all correspondence, and documents in connection with the Opposition proceedings to the following:

S. Daniel Harbottle
Rutan & Tucker, LLP
611 Anton Blvd, Suite 1400
Costa Mesa, CA 92626
(714) 662-4646

Certificate of Mailing:

Date of Deposit: April 17, 2002

I hereby certify that this document is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service (Express Mail Label Number EL722861955US), under 37 CFR 1.10 on the date indicated above and is addressed to: Box TTAB / FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513


Dennis R. Nakata, Legal Assistant