

Exh.

TTAB

BOX TTAB FEE
TRADEMARK

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

In re the matter of Application Serial No. 76/175086

For the Mark : CALISTA

Filed: December 4, 2000

Published in the Official Gazette of July 2, 2002



08-05-2002

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

KALLISTA, INC.

Opposer,

v.

FETIM B.V.,

Applicant.

§
§
§
§
§
§
§
§
§
§

Opposition No. _____

TRADEMARK TRIAL AND
APPEAL BOARD
02 AUG - 9 AM 8:44

NOTICE OF OPPOSITION

In the matter of an application to register a trademark under the Trademark Act of 1946, Serial No. 76/175086, filed December 4, 2000, in the name of Fetim B.V. published for opposition in the Official Gazette of July 2, 2002.

The grounds for opposition are as follows:

1. Opposer, Kallista, Inc. ("Opposer"), is a California corporation, with offices at 444 Highland Drive, Kohler, Wisconsin 53044.

2. Applicant, Fetim B.V. ("Applicant"), is a Netherlands limited liability company having its primary place of business located at 1000 Kopraweg 1 1000 at Amsterdam, Netherlands. Applicant applied for the mark CALISTA ("Applicant's Mark"), under an application assigned Serial No. 76/175086 and filed December 4, 2000.

08/08/2002 SWILSON1 00000066 76175086

01 FC:377

300.00

This application as published covers the following goods: "parquet wood flooring; non-metal floor tiles, wood tile floors" (Applicant's Goods"). This application was published for opposition in the Official Gazette of July 2, 2002, and this Notice of Opposition is timely filed within 30 days thereafter.

3. Commencing long prior to Applicant's first use, Opposer has been and is now engaged in, the distribution, sale, marketing and promotion in the United States, and in interstate commerce, of Opposer's products under the mark KALLISTA ("Opposer's Mark").

4. Opposer is the owner by assignment of, and will rely herein upon, among others, U.S. Trademark Registration No. 1,361,693, KALLISTA, for "bathroom fixtures, namely, bath basins and bowls, hand showers, and whirlpool water jets; bar basins and bowls". This registration issued on September 24, 1985, with first use in December 1980. This registration is active and constitutes "incontestable" evidence of Opposer's exclusive right to use Opposer's Mark under Section 15 of the Trademark Act, as amended. Attached as Exhibit 1 is an uncertified copy of this registration.

5. Since its initial use of the mark KALLISTA, Opposer's products under Opposer's Mark has expanded to include decorative non-metal tiles, wooden furniture, dressers, vanities, etageres, mirrors, drawer pulls, dressing tables, tables, wastebaskets, shower doors, valves, lavatories, table lamps, bathtubs, whirlpools, bathtubs, lavatories, handshower items, towel bars, sconces, cabinets, clothes and towel hooks, faucets, toilets and bidets, flush levers, sinks, bar basins and bowls, cutting boards, clocks, and a variety of kitchen and bath decorative products ("Opposer's products").

6. Opposer sold its decorative tile in interstate commerce under Opposer's Mark long prior to December 2000, and at least as early as 1997, and continues to do so. Attached as Exhibit 2 is an excerpt from a Kallista brochure copyrighted 1997 depicting Kallista tile.

7. Since Opposer's initial use of Opposer's KALLISTA Mark, Opposer has extensively used, advertised, promoted, offered and sold Opposer's products under the mark, with the inevitable result that Opposer's customers and the public in general have come to know and recognize Opposer's Mark and associate same with Opposer and its products. Opposer thus has built up a valuable reputation and extensive goodwill in connection with the sale of products under its mark.

8. Opposer maintains at www.kallista.com an extensive and popular website highlighting its products and their decorative design. Attached as Exhibit 3 is a printout from this site.

9. Applicant's Mark is a colorable imitation of, and so resembles Opposer's Mark, as to be likely to cause confusion or to cause mistake or to deceive consumers and/or customers, resulting in damage and detriment to Opposer and its reputation.

10. Applicant's mark CALISTA is phonetically at least virtually identical to KALLISTA.

11. Parquet wood flooring, non-metal floor tiles, and/or wood tile floors, are sold in outlets that also sell kitchen and bath products.

12. Parquet wood flooring, non-metal floor tiles, and/or wood floors, are often used in the kitchen, and in the bathroom, and are often promoted as elements of interior design.

13. Opposer's products, on the one hand, and parquet wood flooring, non-metal floor tiles, and wood floors, on the other hand, are so related that Opposer's customers and the consuming public in general are likely to be confused, mistaken or deceived as to the origin, affiliation and sponsorship of Applicant's goods intended to be sold under Applicant's Mark, and misled into believing that such goods are sold by, emanate from, or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer and its reputation.

14. Opposer alleges that Applicant was previously aware of Opposer's Mark, and Opposer's business thereunder, before the subject application was signed and filed on December 4, 2000.

15. Opposer alleges that Applicant's mark had not previously been used within the United States, or in commerce with the U.S., in connection with Applicant's goods prior to December 4, 2000.

16. Opposer alleges that it will be damaged by the issuance of a registration to Applicant's Mark in that the mark is substantially similar to, and a colorable imitation of, Opposer's Mark and, is used in connection with Opposer's products that are related thereto. As a result, such mark when used is likely to cause confusion or to cause mistake or to deceive consumers, under the provisions of 15 U.S.C. §1052(d), Section 2(d)

of the Lanham Trademark Act as amended, resulting in damage and detriment to Opposer and its reputation.

17. Prior to Applicant's adoption of Applicant's Mark, Opposer's Mark was established as a famous mark.

18. Applicant's Mark so closely resembles the Opposer's famous Mark that when Applicant's Mark is used by Applicant it would likely be so associated with Opposer and Opposer's Mark that the distinctive quality of the Opposer's Mark will be diluted, within the meaning of 15 U.S.C. §1125(c), Section 43(c) of the Lanham Trademark Act, as amended.

WHEREFORE, the Opposer, Kallista, Inc. believes and avers that it will be damaged by registration of the above asserted mark of the Applicant, Fetim B.V., and respectfully requests that the Applicant's Mark be rejected and refused, that no registration issue thereon, and that this Opposition be sustained by issuance of judgment in favor of Opposer.

The filing fee of \$300.00 per class of the opposed application is enclosed herewith; should this filing fee become detached or the amount be insufficient, please charge Deposit Account No. 12-0400.

Respectfully submitted,

KALLISTA, INC.

By: 

JOHN E. MCKIE

LINDSEY E. WELU

Ladas & Parry

224 South Michigan Avenue, Suite 1200

224 S. Michigan Avenue

Chicago, Illinois 60604

312-427-1300

Attorneys for Opposer.

LAW OFFICES

LADAS & PARRY

JOHN E. MCKIE

Telephone: (312) 427-1300 ext. 213
Email: johnm@ladas.net

224 SOUTH MICHIGAN AVENUE

CHICAGO, ILLINOIS 60604

TELEPHONE: (312) 427-1300
TELEFAX: (312) 427-6663
(312) 427-6668

www.ladas.com

26 WEST 61 STREET
NEW YORK, NY 10023

5670 WILSHIRE BLVD.
LOS ANGELES, CA 90036

52-54 HIGH HOLBORN
LONDON WC1V 6RR, ENGLAND

DACHAUERSTRASSE 37
80335 MUNICH, GERMANY

August 1, 2002

Box TTAB Fee
Assistant Commissioner
for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513



08-05-2002

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

RE: Notice of Opposition
Kallista, Inc. v. Fetim B.V.
published U.S. Trademark Application
S.N. 76-175086
Opposed Mark: CALISTA

02 AUG - 9 AM 8:44
TRADEMARK TRIAL AND
APPEAL BOARD

Dear Sir:

Enclosed for filing please find the following:

1. Notice of Opposition, including Exhibits 1-3, in duplicate;
2. Check in the amount of \$300.00 made payable to the Commissioner of Patents and Trademarks in payment of the applicable filing fee;
3. Certificate of Mailing; and;
4. Return receipt postcard.

Please process this Notice of Opposition and affix your date stamp to the enclosed return-receipt postcard to evidence your receipt of the same. The Commissioner is authorized to charge any additional fees associated with this case or credit any overpayment to Deposit Account 12-0400.

Very truly yours,
JOHN E. MCKIE
LINDSEY E. WELLS

Enclosures: as recited above

JEM/LEW/bmr

CERTIFICATE OF MAILING (37 CFR 1.8)

Date of Deposit: August 1, 2002

Opposer: Kallista, Inc.

Opposed Mark: CALISTA

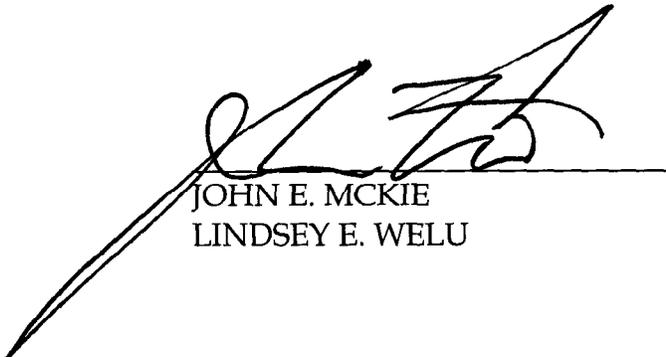
Opposed Serial No.: 76-175086

Documents: Notice of Opposition, with Exhibits 1-3, in duplicate, and as recited in cover letter

I hereby certify that these documents and fees are being deposited with the United States Postal Service as first class mail, postage prepaid, addressed as follows on the date stated below, pursuant to 37 CFR 1.10:

Box TTAB Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

On this 1st day of August, 2002.



JOHN E. MCKIE
LINDSEY E. WELU