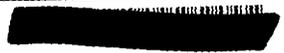


TAB

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U.S. PATENT & TRADEMARK OFFICE

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

In re Serial No. 75/939,472



-----X
:
JO MALONE LIMITED :
:
Opposer, :
:
-Against- :
:
MM LICENSING GROUP, LLC :
:
Applicant. :
:
-----X

09-06-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #66

Opposition No. _____

NOTICE OF OPPOSITION

Jo Malone Limited, ("Opposer"), an English/Welsh corporation, with its principal office at The Old Imperial Laundry, Warriner Gardens, London SW11 4XW, England, believes that it would be damaged by the registration of the mark MALONESPORT shown in U.S. Trademark Application Serial No. 75/939,472 ("Applicant's Mark") to MM Licensing Group LLC ("Applicant") and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer is the internationally known fragrance, bath and body, skin care, and lifestyle products company, Jo Malone Limited.
2. Opposer manufactures and markets high quality fragrance, skin care, bath and body, hair care, candles, potpourri, linen sprays, room sprays and lifestyle products for sale throughout the

09/10/2002 ZCARRITH 00000012 051315 75939472

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United States, and abroad under the famous mark JO MALONE and has done so for more than four years.

3. Opposer has established a significant customer base for its products through retail sales at prestige department stores and through direct sales in its own stores; through mail order gift service and over the Internet.
4. Opposer is the owner of various registrations for the mark JO MALONE. These include the following Registrations*:

TRADEMARK NAME	REGISTRATION NO.	REGISTRATION DATE	DATE OF FIRST USE
JO MALONE	2,020,243	December 3, 1996+	February 1, 1995
JO MALONE	2,215,533	December 29, 1998	March 31, 1998

* See attached certificate of registration
+ Incontestable marks

5. First introduced in March, 1998, Jo Malone's fragrance, skin care and lifestyle products and services bearing the JO MALONE mark have achieved a reputation for excellence and sales success. U.S. sales at retail for the last two years have exceeded U.S. \$ 9 million for products sold under the JO MALONE mark.
6. Opposer has invested significant sums of money in the promotion of its JO MALONE products and services in the United States. In the last two years alone, Opposer has spent in excess of \$2.5 million for advertising and promotional expenses in the United States. Opposer engages in cooperative advertising of its JO MALONE products in major newspapers with prestigious department stores such as Saks Fifth Ave and Neiman Marcus. Opposer also

advertises and promotes its products through in-store promotions at such department stores and in its own retail store where sample products are distributed at no charge to customers.

Opposer also develops thousands of cards advertising JO MALONE products which are mailed by Opposer and prestigious department stores to their customers across the country.

7. Opposer's products have been the subject of widespread media coverage, including magazine and newspaper articles commenting on the innovative nature and high quality of JO MALONE products. Opposer has received favorable publicity about its JO MALONE fragrance/beauty products in magazines, such as Town & Country, W and O The Oprah Magazine.
8. As a result of Opposer's extensive sales, advertising and promotion of JO MALONE fragrance, bath and body, skincare, haircare and lifestyle products, as well as the favorable media attention such products have received, Opposer has developed a valuable reputation and enormous goodwill in its JO MALONE mark and has achieved a loyal following among consumers. Consumers have come to associate the JO MALONE mark with high quality products.
9. Opposer's mark JO MALONE is the name of its founder.
10. On or about March 9, 2000, Applicant filed an intent to use application herein opposed in the United States Patent and Trademark Office, Serial No. 75/930,472 on the Principal Register of the trademark MALONESPORT. The goods of the application are "make-up and cosmetics; skin care preparations; hair care preparations; perfumery for personal use, including, perfumes, eau de parfum, parfum de toilette, concentrated eau de toilette, eau de toilette, eau de cologne, splash cologne; personal care soaps, including, toilet soaps, bath soaps and shaving soaps; products for body and beauty care, including pre shave lotion, after shave

lotion, after shave lotion, shaving cream and foam, after shave cream and emulsion, moisture lotion, emulsion and cream, deodorant and anti perspirant cream, talc sticks and lotions, also in the form of atomizers and roll-on devices, spray talc, body cream and lotion, hand cream, hand balm, massage cream, gel and oil” in class 3.

11. Upon information and belief, Applicant has not used the mark MALONESPORT in connection with the goods covered by its application.
12. Opposer’s trademark rights for its JO MALONE mark have priority over Applicant’s application herein opposed to register MALONESPORT, inasmuch as Opposer commenced its use in March 1998, approximately two years prior to the filing date of Applicant’s intent to use MALONESPORT application.
13. Opposer believes that consumers confronted with the Applicant’s mark MALONESPORT will inevitably be confused and deceived into the mistaken belief that Applicant’s products have their origin with the Opposer, or are associated with the Opposer in some way.
14. Applicant’s mark MALONESPORT reproduces the same name MALONE which is a key element of Opposer’s mark and covers virtually identical products in class 3 to those covered by Opposer’s JO MALONE registrations. As a result consumers are likely to believe that the MALONESPORT products originate from the same source as JO MALONE products. The minor distinction between JO MALONE and MALONESPORT is insufficient to avoid confusion and mistake among the consuming public. There are no other marks consisting of MALONE registered in International Class 3 except for Opposer’s registrations.
15. It is common in the beauty industry for competitors to offer products under the SPORT name, such as POLO SPORT. If Applicant’s MALONESPORT mark is used and allowed to be registered, consumers are likely to form the mistaken belief that Opposer has also entered this

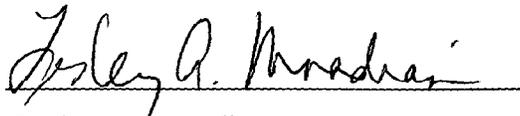
field with a new line of fragrance and beauty products, some of which are now geared to men, called MALONESPORT. This is an area of natural expansion for Opposer.

16. The registration of Applicant's mark would grant Applicant rights to which it is not entitled and would be inconsistent with the prior and established rights of Opposer in its JO MALONE mark.

17. The registration of Applicant's mark is likely to dilute the distinctiveness, by blurring the considerable source-identifying power, of Opposer's JO MALONE mark.

18. By reason of the foregoing, Opposer will be seriously damaged by the registration of Applicant's mark to Applicant.

WHEREFORE, Opposer respectfully requests that the Notice of Opposition be sustained and the registration of Applicant's mark to Applicant be refused.



Dated: September 3, 2002
New York, N.Y.

Lesley A. Moradian
Lido L. Puccini
Jo Malone Limited
C/o Estee Lauder Companies
Legal Department- 42nd Floor
767 Fifth Avenue
New York, New York 10153
Tel: (212) 572-6798
Counsel for Opposer

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Date 9/3/02, Signature Donna Calven

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

Reg. No. 2,020,243

Registered Dec. 3, 1996

United States Patent and Trademark Office

**TRADEMARK
PRINCIPAL REGISTER**

JO MALONE

JO MALONE LIMITED (UNITED KINGDOM
COMPANY)
THE OLD IMPERIAL LAUNDRY
WARRINER GARDENS
LONDON SW11 4XW, UNITED KINGDOM

FOR COSMETICS, NAMELY, CREAMS, EYE
MAKE-UP BLUSHER, FOUNDATION, EYE-
BROW PENCILS, LIPSTICK, LIP GLOSS,
MAKE-UP AND MAKE-UP REMOVING PREP-
ARATIONS, OILS FOR COSMETIC PURPOSES;
NON-MEDICATED TOILET PREPARATIONS
AND PREPARATIONS FOR THE CLEANING
OF THE HAIR, SKIN AND BODY, NAMELY,
TOILET WATER, TOILETRIES, TALCUM
POWDER, SOAP, SKIN CARE CREAMS, SHAM-
POOS, CONDITIONERS FOR THE HAIR,
CLEANING AND CLEANSING OILS, CLEANS-
ING MILK, BEAUTY MASKS, DEODORANTS
AND ANTIPERSPIRANTS FOR PERSONAL

USE, ROOM AND LINEN FRAGRANCE
SPRAYS; SKIN CARE GELS, BALMS, MILKS,
SCRUMS, LOTIONS, POWDERS, SCRUBS AND
SHAVING CREAMS AND SHAVING GELS; ES-
SENTIAL OILS FOR PERSONAL USE AND
FOR USE AS INGREDIENTS IN THE MANU-
FACTURE OF COSMETIC PREPARATIONS, IN
CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

PRIORITY CLAIMED UNDER SEC. 44(D) ON
UNITED KINGDOM APPLICATION NO.
2009577, FILED 2-1-1995, REG. NO. 2009577,
DATED 2-1-1995, EXPIRES 2-1-2005.

"JO MALONE" IDENTIFIES A LIVING INDIV-
VIDUAL WHO CONSENT IS OF RECORD.

SER. NO. 74-654,598, FILED 3-31-1995.

DOMINICK J. SALEMI, EXAMINING ATTOR-
NEY

Int. Cls.: 4 and 5

Prior U.S. Cls.: 1, 6, 15, 18, 44, 46, 51, and 52

Reg. No. 2,215,533

United States Patent and Trademark Office

Registered Dec. 29, 1998

**TRADEMARK
PRINCIPAL REGISTER**

JO MALONE

**JO MALONE LIMITED (UNITED KINGDOM
COMPANY)
THE OLD IMPERIAL LAUNDRY
WARRINER GARDENS
LONDON SW11 4XW, ENGLAND**

**FOR: CANDLES, SCENTED CANDLES, IN
CLASS 4 (U.S. CLS. 1, 6 AND 15).**

**FIRST USE 3-0-1998; IN COMMERCE
3-0-1998.**

**FOR: ALL-PURPOSE DISINFECTANTS; AIR
FRESHENING PREPARATIONS AND ROOM**

**DEODORANTS AND DEODORIZERS, IN
CLASS 5 (U.S. CLS. 6, 18, 44, 46, 51 AND 52).**

**FIRST USE 3-0-1998; IN COMMERCE
3-0-1998.**

**"JO MALONE" IDENTIFIES A LIVING INDI-
VIDUAL WHOSE CONSENT IS OF RECORD.**

SN 75-977,897, FILED 6-28-1996.

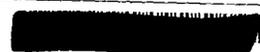
**ALEXANDER L. POWERS, EXAMINING AT-
TORNEY**

The Estée Lauder Companies Inc.
767 Fifth Avenue
New York • NY • 10153
212 • 572 • 4200

September 3, 2002

ESTÉE
LAUDER
COMPANIES

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513



09-06-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

NOTICE OF OPPOSITION

We enclose for filing in the Trademark Trial and Appeal Board at the United States Patent and Trademark Office:

1. A Notice of Opposition concerning Serial No.75/939,472 for the mark MALONESPORT.

The Commissioner is hereby authorized to charge the Statutory filing fee to our Deposit Account No. 05-1315 in the name of Estee Lauder Companies. For that purpose, we enclose herewith a duplicate copy of this letter.

Please feel free to contact me at (212) 572-6798 with any questions you may have in connection with this filing.

Respectfully submitted,

BY

A handwritten signature in cursive script that reads "Lesley A. Moradian".

Lesley A. Moradian
Trademark Counsel

Enc.