

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

VENUS SWIMWEAR, INC.)	
a Florida corporation,)	Opposition No.
)	
Opposer)	Application Ser. No. 75/857446
)	
Essence of Venus, Inc., a Texas)	Published: October 1, 2002
Corporation)	
)	
Applicant)	
)	

Express Mail No. EV 105813035 US

OPPOSER'S NOTICE OF OPPOSITION

In the matter of the Application of Essence of Venus, Inc., 11125 South Country Squire, Houston, Texas, (hereinafter "Applicant"), for registration of the mark "ESSENCE OF VENUS" depicted in Application Serial No. 75/857446, published in the *Official Gazette* on October 1, 2002. Venus Swimwear, Inc., a corporation organized and existing under the laws of the State of Florida, having a business address of 11711 Marco Beach Drive, Jacksonville, Florida, (hereinafter "Opposer"), believes that it will be damaged by registration of the mark depicted in Application Serial No. 75/857446, and hereby opposes that application under the provisions of 15 U.S.C. § 1063.

As grounds for the opposition to this application, it is alleged that:

1. The opposed Application Serial No. 75/857446 was filed November 24, 1999.
2. Application Serial No. 76/857446 was published for opposition on October 1, 2002.
3. Opposer has been granted extensions to file an opposition against the referenced application up to and including January 29, 2003.

{WP119636;1}

4. At least as early as 1983, prior to Applicant's filing of its Intent-To-Use application, Opposer adopted and used the trademark "VENUS" in connection with the manufacture and sale of swimwear and clothing products.

5. At least as early as 1988, prior to Applicant's filing of its Intent-To-Use application, Opposer adopted and used the trademark "VENUS" in connection with entertainment services in the nature of preliminary and final beauty pageants.

6. At least as early as 1993, Opposer has also used the mark "VENUS" in interstate commerce in connection with the manufacture and sale of lingerie.

7. Opposer has used its mark continuously and extensively in interstate commerce in connection with the above described goods and services since prior to the filing date of Application Serial No. 75/857446.

8. The mark is and has been displayed on Opposer's products and in promotional and advertising media related to its products and services. As a consequence, the mark "VENUS" is widely recognized as an indicator of source for Opposer's products and services.

9. Opposer is the owner of the following trademark applications and registrations:

United States Trademark Application Serial No. 76/292795 - "VENUS" - retail store, catalog and Internet services in the field of clothing.

United States Trademark Registration No. 1,971,354 - "VENUS" - outer wear clothing, namely swimsuits, tee-shirts, shirts, shorts, wrap skirts, rompers, dresses, coverups, pants, headbands, and caps.

United States Trademark Registration No. 2,268,534 - "VENUS" - entertainment services in the nature of preliminary and final beauty pageants.

United States Trademark Registration No. 1,672,665 - "VE" (stylized) - clothing; namely, swimsuits, tee-shirts, shirts, shorts, wrap skirts, rompers, dresses, cover-ups and pants.

United States Trademark Registration No. 1,989,787 - "VENUS ATTITUDES" (stylized) - mail order catalog services featuring women's outer clothing

United States Trademark Registration No. 2,549,941 - "VENUS EDGE" - clothing and footwear, namely swimwear, pants, shorts, skirts dresses, shirts, tops, tee shirts, scarfs and body wraps, shoes, sandal, wristbands and headbands.

United States Trademark Registration No. 2,614,787 - "THE VENUS EDGE" - catalog mail order and online wholesale and retail distributorship services featuring clothing, jewelry, eyewear and cosmetics, namely swimwear, pants, shorts, skirts, dresses, shirts, tops, tee shirts, scarfs and body wraps, shoes, sandals, wristbands and headbands; earrings, necklaces and bracelets, swimwear cleaning solution, sunglasses, hair mascara and glitter kit, beaded mirror kit having a beaded bag with mirror and hair clips therein.

United States Trademark Registration No. 2,130,707 (By Assignment)- VENUS GIRL TRAP - men, women, and children's apparel, namely, hats, caps, visors, hoods, berets, head bands, sweat bands, ear muffs, gloves, mittens, wrist bands, suspenders, belts, socks, stockings, pantyhose, bodysuits, leotards, leggings, sweat socks, thermal socks, shoes, sneakers, galoshes, waders, boots, sandals, slippers, kerchiefs, scarves, mufflers, bandannas, neckerchiefs, vests, pajamas, robes, kimonos, caftans, smocks, aprons, boxer shorts, briefs, underpants, corsets, corselets; girdles, brassieres, bustiers, chemises, teddies, camisoles, slips, negligees, peniors, shirts, blouses, knit tops, dresses, skirts, jumpsuits, pant suits, rompers, swimming trunks, wet suits, thermal underwear, undershirts, tunics, tank tops, cotton woven shirts, knit shirts, polo shirts, T-shirts, sweat shirts, crew neck sweaters, V-neck sweaters, turtleneck sweaters, cardigans, suits, jogging suits, shorts, sweat shorts, jeans, pants, slacks, trousers, sweat pants, ski suits, ski pants, ski bibs, capes, shawls, blazers, waistcoats, rain coats, overcoats, top coats, sport coats, parkas, boleros, jackets, flannel jackets, wool jackets, polyester woven shirts, rayon woven shirts, wool woven shirts, leather coats, elastic waist coats, fixed waist shorts, denim shorts, and denim jackets.

10. Opposer also uses the mark "VENUS" in connection with the sale of lotions.

11. There is a relationship between the goods set forth in Application Serial No. 75/857446 and the goods and services in connection with which Opposer has used and is using its mark and name "VENUS." In addition, on information and belief, Applicant's goods will be offered to the same class of consumers who purchase the goods in connection with which Opposer uses its mark and name "VENUS" and will be offered through the same channels of trade.

12. The applied-for mark "ESSENCE OF VENUS" is substantially similar to the Opposer's mark "VENUS" and is likely to cause confusion, mistake, and deception as to an

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affiliation, connection or association between Opposer and Applicant, or as to the origin, sponsorship or approval of Applicant's goods and other commercial activities, all to Opposer's damage. Potential customers are likely to believe that Applicant's goods originate from, or are sponsored or approved by, Opposer, when that is not the case.

13. Applicant is not connected in any way to Opposer and Opposer has not given consent to Applicant's use of the mark "VENUS".

14. If Applicant is granted the registration herein opposed, it would thereby obtain a prima facie exclusive right to use of its mark, which would be a further source of damage to Opposer.

WHEREFORE, Opposer believes that it will be damaged by registration of said mark, and prays that this Opposition be sustained, that Application Serial No. 75/857446 be rejected, and that the mark applied for therein be refused registration.

The filing fee for this opposition in the amount of \$300.00 is enclosed.

Respectfully submitted

AKERMAN SENTERFITT

Date: 1/29/03

By: *Diane Churchill*

Diane Churchill
222 Lakeview Avenue, 4th Floor
West Palm Beach, FL 33401
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ATTORNEYS FOR OPPOSER

Apr-08-03 05:15pm From-Akerman Senterfitt
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88-1256/670

T-268 P.007/008 F-386

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1/29/2003

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MEMO 133237

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Director Of The United States Patent And Trademark Office	
Attorney Number	churchill
C-M NUMBER	21725/133237
CLIENT NAME	venus swimwear
DOCKET NUMBER	
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1/29/2003

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300.00

OPERATING ACCOUNT 133237

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Serial No.: 75/857446 Docket No.: 2150-5
Client: VENUS SWIMWEAR, INC.

Assistant Commissioner
for Trademarks

Sir:
Please acknowledge receipt of the paper(s) noted hereon by stamping the date received and returning this card to the undersigned.

- ITU/TM Application
- Sheets of Drawing
- Specimens
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- Amendment/Response
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- Request for Extension Time
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OPPOSER'S NOTICE OF OPPOSITION

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January 29, 2003

EXPRESS MAIL LABEL NO. EV 105813035 US

Box TTAB
Commissioner for Trademarks
2900 Crystal Drive
Arlington VA 22202-3513

**Re: Venus Swimwear, Inc. v. Essence of Venus, Inc.
Notice of Opposition/Application Serial No. 75/857446
ESSENCE OF VENUS
Our Reference: 7150-5; Our File No. 21725/133237**

Dear Sir:

Please find enclosed for filing in the United States Patent and Trademark Office the following materials:

- Opposer's Notice of Opposition (in triplicate)
- Check in the amount of \$300 for filing fee
- One Postcard

If there is any deficiency in fees, please charge the cost to our Deposit Account No. 50-0951. This Transmittal Letter is submitted in duplicate.

Respectfully submitted,

Date: 1/29/03

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Diane Churchill
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7150-5
(WP120006;1)

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FAX COVER SHEET

From: Diane K. Churchill, Esq.

Date: April 8, 2003

PLEASE DELIVER ⁸ PAGE(S) (including cover sheet) TO:

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Comments/Special Instructions

Venus Swimwear, Inc. v. Essence of Venus, Inc. - Pursuant to our telephone conversation attached is a copy of the transmittal letter, Notice of Opposition, check in the amount of \$300; returned post card and express mail label. The returned postcard states that the Notice was filed on January 29, 2003. Please advise as to the status of this matter.

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