

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

PACO RABANNE PARFUMS)

Opposer,)

v.)

YOSHIKI HAYASHI)

Applicant.)

Opposition No. _____

Serial No. : 78/031192

Filing Date : October 18, 2000

Mark : VIOLET UK

Class : 003

Published : February 19, 2002

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

08-18-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

NOTICE OF OPPOSITION

PACO RABANNE PARFUMS ("Opposer"), a French corporation with its principal place of business at 6, Boulevard du Parc, 92523 Neuilly sur Seine, France believes that it will be damaged by the registration of the above-identified application and hereby opposes the grant of the registration.

As grounds for this opposition, it is alleged that:

1. Opposer is the owner of U.S. Registration No. 2,387,390 for ULTRAVIOLET (the "ULTRAVIOLET Mark") on the Principal Register of the United States Patent and Trademark Office for "perfumes; toilet waters; body, face, and skin

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soaps; cosmetics, namely, personal deodorants, bath and shower gels and oils for cosmetic purposes, bath and shower salts, not for medical purposes” in International Class 003. The registration date is September 19, 2000. A copy of this registration is attached as Exhibit 1.

2. Since approximately February 1, 2000, and prior to October 18, 2000, Applicant’s filing date, Opposer has been using the ULTRAVIOLET Mark in commerce in the United States.

3. Through a substantial amount of time and effort in advertising and promotion by the Opposer, the ULTRAVIOLET Mark has become a strong trademark, widely recognized by the consuming public so as to create enormous goodwill in the ULTRAVIOLET Mark inuring to the benefit of Opposer.

4. YOSHIKI HAYASHI (“Applicant”) filed an intent-to-use application for registration of the trademark VIOLET UK (“Applicant’s Mark”) on the Principal Register of the United States Patent and Trademark Office on October 18, 2000, for “perfume, cosmetics, namely, eye pencils, eye cream, eye makeup, eye makeup remover, eye shadow, eyebrow pencils, face powder, facial scrubs, foundation makeup, face cream, non-medicated lip balm, lip gloss, lipstick, facial lotions, body lotion, facial makeup, mascara, skin moisturizer, night cream, cosmetic pencils, nail polish, face powder, bath powder, hair shampoo, shower gel, skin clarifiers, skin cleansing lotion, skin emollients, skin soap, sun block preparations, sun screen preparations, suntanning preparations, wrinkle removing skin care preparations” in International Class 003.

5. Applicant’s application was assigned Serial No. 78/031,192 and published for opposition in the Official Gazette on February 19, 2002. Since that time,

Opposer has obtained numerous extensions of it's time to oppose the registration of Applicant's Mark due to ongoing negotiations between the parties. The most recent deadline for filing an opposition or obtaining a request for an extension expires on August 18, 2003. At this time, negotiations between the parties are ongoing, although the parties have not reached an agreement.

6. Applicant's Mark is visually and phonetically similar to Opposer's Mark. In addition, the goods cited by Applicant in its application are virtually identical to those of Opposer. In view of the similarity of the respective marks and the identity of the goods of the respective parties, Applicant's mark so resembles Opposer's mark as to be likely to cause confusion, or to cause mistake, or to deceive within §2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Opposer will therefore be damaged by the registration of Applicant's mark.

7. In view of the above allegations, Applicant is not entitled to federal registration of its mark in that Applicant is not entitled to exclusive use—or, indeed, any use—of said mark in commerce in connection with the goods specified.

11. This Notice of Opposition is being submitted in duplicate along with the requisite \$300.00 fee.

WHEREFORE, Opposer respectfully requests that application Serial No. 78/031192 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Dated: August 18, 2003

Respectfully Submitted,



Lynda M. Braun
Lisa M. Kurcias

WEIL, GOTSHAL & MANGES LLP
767 Fifth Avenue
New York, NY 10153
Tel: (212) 310-8000

Attorneys for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the Notice of Opposition was mailed, first-class postage prepaid to the following on August 18, 2003:

Anthony M. Keats
Keats McFarland & Wilson LLP
9720 Wilshire Blvd. Penthouse Suite
Beverly Hills, California 90212

August 18, 2003

Dated

Lisa M. Kurcias

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08-18-2003

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513
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We enclose the following for filing at the Trademark Office on behalf of **Paco Rabanne Parfums**:

1. Two (2) copies of a Notice of Opposition against Serial No. 78/031192;
2. Certificate of Express Mail Label No. EL861158812US;
3. Authorization to charge the filing fee of \$300.00 for an opposition against an application in one (1) class to **Deposit Account 23-0800 (Attorney Docket No. 68625.0027)**.

Please charge any additional costs to Deposit Account 23-0800.

Respectfully submitted,
WEIL, GOTSHAL & MANGES LLP

Date: August 18, 2003

By:

Phyllis Eremitaggio
Phyllis Eremitaggio
Trademark Specialist

Int. Cl.: 3

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

Reg. No. 2,387,390

United States Patent and Trademark Office

Registered Sep. 19, 2000

**TRADEMARK
PRINCIPAL REGISTER**

ULTRAVIOLET

PACO RABANNE PARFUMS (FRANCE CORPORATION)
6, BOULEVARD DU PARC
NEUILLY-SUR-SEINE
HAUTS DE SEINE, FRANCE

FOR: PERFUMES; TOILET WATERS; BODY,
FACE, AND SKIN SOAPS; COSMETICS, NAMELY,
PERSONAL DEODORANTS, BATH AND SHOWER
GELS AND OILS FOR COSMETIC PURPOSES, BATH
AND SHOWER SALTS, NOT FOR MEDICAL PUR-

POSES, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND
52).

PRIORITY CLAIMED UNDER SEC. 44(D) ON
FRANCE APPLICATION NO. 99.775856, FILED
2-17-1999, REG. NO. 99/800030, DATED 2-17-1999,
EXPIRES 2-17-2009.

SER. NO. 75-695,759, FILED 4-28-1999.

TARAH HARDY, EXAMINING ATTORNEY

CERTIFICATE OF "EXPRESS MAILING"

MARK: VIOLET UK

APPLICANT: Yoshiki Hayashi

TYPE OF PAPER: Two (2) copies of a Notice of Opposition

"Express Mail" mailing label number EL861158812US

I hereby certify that this correspondence is addressed to the Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, and is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on August 18, 2003.

August 18, 2003

(Date of Signature)

Phyllis Eremitaggio

(Print Name of person mailing the paper or fee)

Phyllis Eremitaggio

(Signature of person mailing the paper or fee)