

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

In the Matter of Application Serial Number 76/487,792
Published in the Official Gazette on October 21, 2003

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V SECRET CATALOGUE, INC., :
VICTORIA'S SECRET STORES, INC. :
INTIMATE BEAUTY CORPORATION :
D/B/A VICTORIA'S SECRET BEAUTY, and : Opposition No.
VICTORIA'S SECRET DIRECT, LLC, :
:
Opposers, :
:
v. :
:
WOMEN'S SECRETS, S.A., :
:
Applicant. :
:
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NOTICE OF OPPOSITION

V SECRET CATALOGUE, INC., a Delaware corporation, having its principal office and place of business at 1105 North Market Street, Wilmington, Delaware 19801, VICTORIA'S SECRET STORES, INC., a Delaware corporation, having its principal office and place of business at Four Limited Parkway, Reynoldsburg, Ohio 43068, INTIMATE BEAUTY CORPORATION D/B/A VICTORIA'S SECRET BEAUTY, a Delaware corporation, having its principal office and place of business at 888 Seventh Avenue, New York, New York 10106, and VICTORIA'S SECRET DIRECT, LLC, a Delaware limited liability company, having its principal office and place of business at 3425 Morse Crossing, Columbus, Ohio 43219 (herein referred to collectively as "Victoria's Secret" or "opposers"), believe they will be damaged by registration of the designation

WOMEN'S SECRET NO SECRET in Application Serial No. 76/487,792, filed February 4, 2003, published at page TM 174 of the Official Gazette of October 21, 2003 (Vol. 1275, No. 3), for the goods set forth therein, in International Classes 3 (U.S. Classes 1, 4, 6, 50, 51 and 52).

As grounds of opposition, opposers aver that:

1. WOMEN'S SECRETS, S.A. (herein "applicant"), a foreign corporation, having its principal office and place of business at Avda. del Llano Castellano 51, 28034 Madrid, Spain, is not now and never was entitled to register as a trademark the designation WOMEN'S SECRET NO SECRET for which it seeks registration in its Application Serial No. 76/487,792, filed on February 4, 2003, published at page TM 174 of the Official Gazette of October 21, 2003 (Vol. 1275, No. 3), for the goods set forth therein, namely, facial lotions; cleansing milks for cleaning the skin; eye makeup remover in gel form; pre-moistened cosmetic tissues for removing makeup; nourishing skin creams; moisturizing anti-age skin creams; ampoules containing moisturizers; skin moisturizing lotions; non-medicated lip protecting preparations; preparations for body care, namely, non-medicated skin gels for cosmetic and cleaning purposes, personal deodorants and skin moisturizing milk; cosmetic preparations for slimming purposes, namely, non-medicated skin creams and skin lotions to treat stretch marks; non-medicated skin creams and skin lotions to firm the skin; hand creams; preparations for sun tanning, namely, sun block and sun creams; fragrances for personal use, namely, eau de toilette, perfume, cologne, scented

body spray, cosmetics in International Class 3 (U.S. Classes 1, 4, 6, 50, 51 and 52).

2. Applicant is not entitled to use or register as a trademark the designation WOMEN'S SECRET NO SECRET for which it seeks registration in its Application Serial No. 76/487,792, either on February 4, 2003, the date of filing of said application, or on October 21, 2003, the date of publication thereof in the Official Gazette.

3. Opposer, V Secret Catalogue, Inc. is the owner and opposers, Victoria's Secret Stores, Inc., Intimate Beauty Corporation d/b/a Victoria's Secret Beauty, and Victoria's Secret Direct, LLC, are the exclusive users of the trademark and service mark VICTORIA'S SECRET (the "VICTORIA'S SECRET Mark"), which is registered in the United States Patent and Trademark Office under Registration Nos. 1,146,199 and 1,908,042. Copies of said registrations are annexed hereto and incorporated herein by reference as opposers' Exhibits A and B. Said registrations are outstanding, validly subsisting and uncancelled.

4. Since long prior to applicant's selection and adoption of the designation WOMEN'S SECRET NO SECRET, opposers have been continuously and now are engaged in the manufacture, advertising, offering for sale and sale of a wide range of goods and services, including, but not limited to women's and men's clothing, accessories, and personal care products, as well as retail clothing store and mail order services in interstate commerce throughout the United States.

5. Since long prior to applicant's selection and adoption of the designation WOMEN'S SECRET NO SECRET, opposers have been continuously and now are advertising, offering for sale and selling in interstate commerce throughout the United States the aforesaid goods and services under the VICTORIA'S SECRET Mark.

6. Upon the introduction of the aforesaid goods and services of opposers so marked upon the market and continuously thereafter, opposers became and are now widely known and recognized by the VICTORIA'S SECRET Mark, which mark is closely and universally associated with opposers as a means by which opposers and their said goods and services have become known to the public and their source or origin identified.

7. As a result of opposers' extensive advertising and promotion of their goods and services under the VICTORIA'S SECRET Mark, the large volume of sales of goods bearing the VICTORIA'S SECRET Mark, and the extensive media coverage that opposers and their goods and services have received, the VICTORIA'S SECRET Mark has become and now is a famous trademark in the United States, as well as internationally.

8. Applicant's adoption and intent to use the designation WOMEN'S SECRET NO SECRET is without license or permission of opposers.

Count I - Likelihood of Confusion

9. Opposers repeat and reaver the averments set forth in paragraphs 1 through 8 inclusive of this notice of opposition as if more fully set forth herein again.

10. Applicant's goods are closely related to opposers' goods and services, will be sold to the same class of purchasers, and will be available for sale through the same or similar channels of trade.

11. The designation applicant seeks to register, namely, WOMEN'S SECRET NO SECRET, so resembles opposers' VICTORIA'S SECRET Mark, as to be likely, when applied to the goods of applicant, to cause confusion or mistake or to deceive persons by creating the erroneous impression that applicant's goods originate with or come from the same source as opposers' goods and/or services, or are endorsed by, or are sponsored by, or are connected in some way with opposers, and the registration thereof would be injurious to opposers.

Count II - Dilution

12. Opposers repeat and reaver the averments set forth in paragraphs 1 through 8 inclusive of this notice of opposition as if more fully set forth herein again.

13. Applicant's proposed use and registration of the designation WOMEN'S SECRET is likely to, and will dilute, blur and erode the distinctiveness of opposers' famous VICTORIA'S SECRET Mark, and/or damage the goodwill associated with the VICTORIA'S SECRET Mark.

WHEREFORE, opposers pray that Application Serial No. 76/487,792 be rejected and that registration of the designation WOMEN'S SECRET NO SECRET as a trademark to applicant be refused and denied, and/or that opposers have such other and further relief as the Board may deem just and proper.

Dated: New York, New York
November 20, 2003

COLUCCI & UMANS

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

(Typed or printed name of person mailing paper or fee)

By Frank J. Colucci
Frank J. Colucci
Attorneys for Opposers
Manhattan Tower
101 East 52nd Street
New York, New York 10022
(212) 935-5700

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,146,199

Registered Jan. 20, 1981

TRADEMARK
Principal Register

VICTORIA'S SECRET

Victoria's Secret (partnership)
1560 Waller St.
San Francisco, Calif. 94117

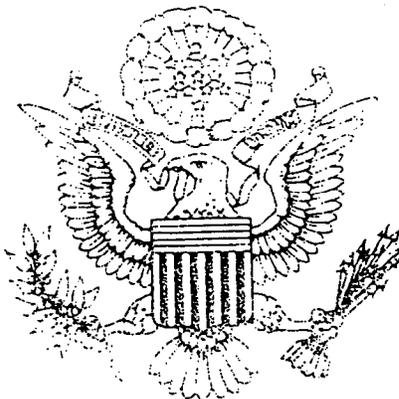
For: WOMEN'S LINGERIE, in CLASS 25 (U.S.
Cl. 39).

First use Jun. 12, 1977; in commerce Jun. 12, 1977.

Ser. No. 159,253, filed Feb. 21, 1978.

J. H. WEBB, Primary Examiner

The United States of America



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CERTIFICATE OF REGISTRATION

This is to certify that the records of the Patent and Trademark Office show that an application was filed in said Office for registration of the Mark shown herein, a copy of said Mark and pertinent data from the Application being annexed hereto and made a part hereof,

And there having been due compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks,

Upon examination, it appeared that the applicant was entitled to have said Mark registered under the Trademark Act of 1946, as amended, and the said Mark has been duly registered this day in the Patent and Trademark Office on the

PRINCIPAL REGISTER

to the registrant named herein.

This registration shall remain in force for TEN years unless sooner terminated as provided by law.



In Testimony whereof I have hereunto set my hand and caused the seal of the Patent and Trademark Office to be affixed this first day of August 1995.

Bence Lehman

Commissioner of Patents and Trademarks

NOTICE

This Registration will be canceled by the Commissioner of Patents and Trademarks at the end of six years following the date of registration, unless within one year next preceding the expiration of such six years, the registrant files in the Patent and Trademark Office an affidavit showing that said mark is in use in Commerce or showing that its nonuse is due to special circumstances which excuse such nonuse and is not due to any intention to abandon the mark. A fee of \$100.00 for each class must accompany the affidavit.

Int. Cls.: 3, 4, 9, 16, 20, 21, 22, 24, 25, 28 and 42

Prior U.S. Cls.: 1, 2, 4, 5, 6, 13, 15, 22, 23, 29, 30,
32, 33, 36, 37, 38, 39, 40, 42, 50, 51, 52, 100 and 101

United States Patent and Trademark Office

Reg. No. 1,908,042

Registered Aug. 1, 1995

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

VICTORIA'S SECRET

V. SECRET CATALOGUE, INC. (DELAWARE
CORPORATION)
1105 NORTH MARKET STREET
WILMINGTON, DE 19801

FOR: TOILET SOAPS, WASHING COM-
POUNDS FOR USE WITH LINGERIE AND
FINE WASHABLES, HAIR SHAMPOOS,
SCENTED DRAWER SACHETS; PERSONAL
FRAGRANCES, NAMELY COLOGNE, PER-
FUME, TOILET WATER, AND ESSENTIAL
OILS FOR PERSONAL USE; BATH POWDER,
NON-MEDICATED FOOT POWDER, AND
BODY POWDER; AND PERSONAL CARE
PREPARATIONS, NAMELY BATH, HAND
AND BODY LOTIONS, IN CLASS 3 (U.S. CLS. 1,
4, 6, 50, 51 AND 52).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: CANDLES, IN CLASS 4 (U.S. CL. 15).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: PRERECORDED COMPACT DISCS
AND AUDIO TAPES, BOTH FEATURING
MUSIC, IN CLASS 9 (U.S. CL. 36).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: MAIL ORDER CATALOGS FEATUR-
ING CLOTHING, LINGERIE, AND TOILE-
TRIES; BRIDAL GUEST BOOKS; CALENDARS,
AND ADDRESS BOOKS, IN CLASS 16 (U.S.
CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: PICTURE FRAMES, HAND MIRRORS
AND PILLOWS, IN CLASS 20 (U.S. CLS. 32
AND 50).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: PERFUME ATOMIZERS SOLD EMPTY;
PERFUME BOTTLES SOLD EMPTY; NON-
METAL DECORATIVE BOXES; HAIR COMBS
AND HAIR BRUSHES; DECORATIVE TRAYS
NOT OF PRECIOUS METAL; AND FLASKS
SOLD EMPTY, IN CLASS 21 (U.S. CLS. 2, 13, 23,
29, 30, 33, 40 AND 50).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: MESH LINGERIE BAGS FOR WASH-
ING LINGERIE AND CLOTH BAGS FOR LIN-
GERIE STORAGE, IN CLASS 22 (U.S. CL. 2).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: WASH CLOTHS, TOWELS AND BED-
DING, NAMELY COMFORTERS, PILLOW
CASES, SHEETS, SHAMS, DUVETS, AND
DUST RUFFLES, IN CLASS 24 (U.S. CL. 42).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: WOMEN'S AND MEN'S OUTERWEAR,
UNDERWEAR AND NIGHTWEAR, NAMELY
LINGERIE, ROBES, CAFTANS, KIMONOS,
BOXER SHORTS, PAJAMAS, SHIRTS, PANTS,
JEANS, DRESSES, SKIRTS, SWEATERS, JUMP-
SUITS, BODYSUITS, SWEATSHIRTS, JACKETS,
T-SHIRTS, SCARVES, LEOTARDS, TIGHTS,
SWIMSUITS, BEACH SHIRTS, HOSIERY, FOOT-
WEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: TOY STUFFED ANIMALS, IN CLASS 28
(U.S. CL. 22).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

FOR: RETAIL STORE AND MAIL ORDER
CATALOG SERVICES FOR LINGERIE CARE
PREPARATIONS, PERSONAL CARE PREP-
ARATIONS, PERFUMES, CANDLES, PICTURE
FRAMES, MIRRORS, COSMETIC AND PER-
FUME APPLICATORS, TOWELS, BEDDING,

WOMEN'S AND MEN'S LINGERIE, UNDER-
GARMENTS AND CLOTHING AND TOYS, IN
CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 6-12-1977; IN COMMERCE
6-12-1977.

OWNER OF U.S. REG. NOS. 1,146,199, 1,533,217
AND OTHERS.

SER. NO. 74-507,663, FILED 3-31-1994.

CATHERINE KAISER KREBS, EXAMINING
ATTORNEY

TTAB

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WOMEN'S SECRETS, S.A., :

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Applicant. :

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

Sir:

Enclosed is an original and a copy of Opposers' Notice of Opposition to Women's Secrets, S.A.'s Application Serial No. 76/487,792 to register the designation WOMEN'S SECRET NO SECRET in International Class 3 (U.S. Classes 1, 4, 6, 50, 51, and 52).

A credit card authorization form in the amount of \$1,800.00 to cover the fee for filing this Notice of Opposition is enclosed herewith.

If for any reason the Patent and Trademark Office filing fee should exceed \$1,800.00, please charge any additional sums due to our firm's Deposit Account No. 20-0050.



Kindly acknowledge receipt by having your mail room
date stamp the enclosed postcard and deposit it with the United
States Postal Service

Dated: New York, New York
November 20, 2003

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Service "Express Mail Post Office to
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date indicated above and is addressed to the
Assistant Commissioner for Trademarks,
2900 Crystal Drive, Arlington, VA 22202-3513

By Frank J. Colucci
Frank J. Colucci
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New York, New York 10022
(212) 935-5700

(Typed or printed name of person mailing
paper or fee)