

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

**In the Matter of Application Serial No. 76/154,474
Published in the Official Gazette on 10 August 2004**

Labeltex Mills, Incorporated,)
)
) **Opposer,**)
)
) **vs**)
)
) **Labeltex S.r.l.,**)
)
) **Applicant.**)

Opposition No.: _____

09/01/2004 TMCCANTS 00000081 76154474

01 FC:6402

900.00 OP

NOTICE OF OPPOSITION

Box TTAB Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514


08-30-2004

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

Opposer, Labeltex Mills, Incorporated (“Opposer”), is a corporation formed under the laws of the State of California, having its principal office in Los Angeles, California. Applicant, Labeltex S.r.l. (“Applicant”), is an Italian limited liability company, having its principal office in Soliera, Modena, Italy. Applicant is seeking to register the mark LABELTEX AND DESIGN for PAPER TAGS FOR CLOTHING AND SHOES; PRINTED PAPER LABELS; PRINTED CARDS FOR SHOP WINDOW DISPLAYS; PAPER TAPES FOR CLOTHING, in International Class 016; CLOTH LABELS FOR CLOTHING AND

FOOTWEAR, in International Class 024; CREATION, DEVELOPMENT AND DESIGN OF CUSTOMIZED GRAPHICS FOR LABELS AND TAGS, in International Class 042 (“Applicant’s Mark”) on the Principal Register. Applicant’s Application Serial Number 76/154,474 was published for opposition on 10 August 2004. Opposer believes it will be damaged by the registration of Applicant’s Mark and hereby opposes the grant of Application Serial Number 76/154,474 upon the following grounds:

COUNT ONE

1. Opposer manufactures and sells and custom designs labels, tags, buttons, rivets, accessories, patches, packaging and related products for the garment industry.

2. From a long time prior to July 2000, the earliest date of first use alleged by Applicant, Opposer has continuously and widely used the mark LABELTEX in commerce for a broad spectrum of goods and services as described in Paragraph 1 and has enjoyed great success in doing so. Opposer has been actively expanding its use of the LABELTEX mark.

3. Opposer is the owner of Application Serial Number 76/321,870, filed 9 October 2001, to register the mark LABELTEX for PAPER TAGS; PAPER POCKET FLASHERS AND STICKERS; AND DECORATIVE PAPER BAGS FOR PACKAGING MERCHANDISE AND GIFTS, in International Class 016; TEXTILE PRODUCTS FOR THE CLOTHING MANUFACTURING TRADE, NAMELY, WOVEN LABELS FOR CLOTHING AND WOVEN TRIMS FOR CLOTHING, in International Class 24; EMBROIDERED CLOTH PATCHES FOR CLOTHING; CLOTH RIBBONS AND FABRIC APPLIQUÉS FOR CLOTHING; AND FASTENERS AND ORNAMENTAL ACCESSORIES FOR CLOTHING, NAMELY, BUTTONS, RIVETS, BUCKLES, CLASPS AND RINGS OF NON-PRECIOUS METAL, in International Class 026; DESIGNING FOR OTHERS, NAMELY, PAPER TAGS,

PAPER POCKET FLASHERS AND STICKERS, AND DECORATIVE PAPER BAGS FOR PACKAGING MERCHANDISE AND GIFTS; TEXTILE PRODUCTS FOR THE CLOTHING MANUFACTURING TRADE, NAMELY, WOVEN LABELS FOR CLOTHING, WOVEN TRIMS FOR CLOTHING, AND WOVEN CLOTH RIBBONS FOR CLOTHING; EMBROIDERED CLOTH PATCHES AND APPLIQUÉS FOR CLOTHING; AND FASTENERS AND ORNAMENTAL ACCESSORIES FOR CLOTHING, NAMELY, BUTTONS, RIVETS, BUCKLES, CLASPS AND RINGS OF NON-PRECIOUS METAL, in International Class 42 ("Opposer's Mark"). Action on Opposer's Application has been suspended pending the disposition of Applicant's pending Application.

4. Opposer's trademark LABELTEX is distinctive.

5. Opposer has expended great effort and large sums of money in advertising and promoting the LABELTEX mark. As a result of such expenditures and Opposer's aforementioned widespread use of the mark in connection with Opposer's goods and services, LABELTEX has acquired extensive goodwill, has developed a heightened degree of distinctiveness and has become well known and widely recognized as identifying goods and services of excellent quality which have their origin with or have been authorized or approved by Opposer.

6. Applicant's mark LABELTEX AND DESIGN is confusingly similar to Opposer's LABELTEX trademark in sound, appearance and commercial impression.

7. Applicant's goods are closely related to the goods and services sold and provided in connection with Opposer's LABELTEX trademark and/or represent a natural zone of expansion for Opposer. Such goods and services would travel and/or be promoted through the same channels of trade for sale to, and use by, the same class of purchasers.

8. Applicant's Mark LABELTEX AND DESIGN so resembles Opposer's Mark LABELTEX as to be likely, when used in connection with Applicant's aforementioned goods and services, to cause confusion, or to cause mistake or to deceive as to the source or origin of Applicant's goods and services in that the public, the trade and others are likely to believe that Applicant's goods and services are those of Opposer or are otherwise provided, endorsed, sponsored, approved or licensed by, or are affiliated or in some other way legitimately connected with Opposer, all in contravention of Section 2(d) of the Lanham Act, 37 C.F.R. 2.83 and TMEP section 1208.01.

9. Applicant's adoption and use of the mark LABELTEX AND DESIGN are without Opposer's authorization, consent or approval.

COUNT TWO

10. Opposer repeats the allegations set forth in Paragraphs 1 through 9 and incorporates the same herein by reference.

11. Opposer is informed and believes and upon such information and belief alleges that Applicant has not used LABELTEX AND DESIGN in interstate commerce or in commerce that can be regulated by Congress.

COUNT THREE

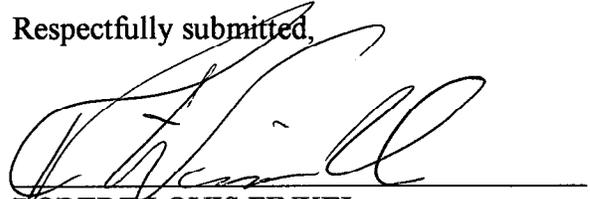
12. Opposer repeats the allegations set forth in Paragraphs 1 through 9 and incorporates the same herein by reference.

13. Opposer is informed and believes and upon such information and belief alleges that any use of LABELTEX AND DESIGN by Applicant in interstate commerce or in commerce that can be regulated by Congress was subsequent to Opposer's aforesaid first use of LABELTEX in commerce.

WHEREFORE, Opposer earnestly requests that this opposition be sustained and Applicant's application to register the mark LABELTEX AND DESIGN be denied in all respects.

Dated: 08/25/04

Respectfully submitted,



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Attorney for Opposer

DECLARATION OF MAILING

I hereby declare that on the date set forth below, this Notice of Opposition is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

**BOX TTAB FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513**

Dated: 08/25/04



**ROBERT LOUIS FINKEL,
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25 August 2004

TTAB FEE
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Labeltex Mills, Incorporated, Opposer, vs. Labeltex S.r.l., Applicant

SUBMISSION OF OPPOSITION

Madam:

Enclosed are the Notice of Opposition of Labeltex Mills, Incorporated, the undersigned's check No. 14541 in the amount of \$900.00 to cover the Opposition fee, and a postage prepaid return receipt card. Kindly stamp and return the enclosed card acknowledging receipt of the enclosed papers, institute the opposition, and set and notify the parties as to the Answer Date and the discovery and testimony periods.

Please contact the undersigned immediately, preferably by telephone or e-mail, if you require anything further from Opposer or if you encounter any impediment to the prompt filing of the Opposition and processing of this request.

Respectfully submitted,



Robert Louis Finkel
Reg.No. 19,601

Attorney for Opposer



08-30-2004