

ESTTA Tracking number: **ESTTA28575**

Filing date: **03/18/2005**

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

Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

Opposers Information

Name	HARRY WINSTON, INC.
Granted to Date of previous extension	04/16/2005
Address	718 Fifth Avenue New York, NY 10019 UNITED STATES

Name	Harry Winston Ultimate Timepiece S.A.
Granted to Date of previous extension	04/16/2005
Address	43 Rue Du Rhone 1204 Geneva, 1204 SWITZERLAND

Correspondence information	Joseph R. Dreitler Jones Day P. O. Box 165017 Columbus, OH 43216-5017 UNITED STATES jrdreitler@jonesday.com Phone:614-281-3902
-----------------------------------	---

Applicant Information

Application No	76588602	Publication date	02/15/2005
Opposition Filing Date	03/18/2005	Opposition Period Ends	04/16/2005
Applicant	CHARLES WINSTON ENTERPRISES, LLC 2200 Pullman Lane Redondo Beach, CA 90278 UNITED STATES		

Goods/Services Affected by Opposition

Class 014.
All goods and services in the class are opposed, namely: men's and women's jewelry

Attachments	Notice of Opposition - Charles Winston.pdf (6 pages)
Signature	/joseph r dreitler/
Name	Joseph R. Dreitler
Date	03/18/2005

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

IN THE MATTER OF: TRADEMARK APPLICATION NO. 76/588,602 - CELEBRITY
STYLE BY CHARLES WINSTON

DATE OF PUBLICATION: FEBRUARY 15, 2005

HARRY WINSTON, INC.

and

**HARRY WINSTON ULTIMATE
TIMEPIECE S.A.**

Opposers,

v.

CHARLES WINSTON ENTERPRISES, LLC.

Applicant.

Notice of Opposition _____

NOTICE OF OPPOSITION

Harry Winston, Inc., a New York corporation of 718 Fifth Avenue, New York, N.Y. 10019, and its related and controlled entity, Harry Winston Ultimate Timepiece S.A., a Swiss corporation of 43 Rue Du Rhone, 1204 Geneva, Switzerland (both collectively referred to hereafter as "Opposer"), believes that it is and will be damaged by registration of application Serial No. 76/588,602 - CELEBRITY STYLE BY CHARLES WINSTON, for "men's and women's jewelry," in Class 14, filed by Charles Winston Enterprises, LLC, and hereby opposes the same under the provisions of *Section 13 of the Trademark Act of July 5, 1946, 15 U.S.C. § 1063*. As grounds therefor, it is alleged that:

1. Opposer has since long prior to April 26, 2004, the filing date of Charles Winston Enterprises, LLC's (hereinafter referred to as "Applicant") intent to use trademark application of CELEBRITY STYLE BY CHARLES WINSTON, for "men's and women's jewelry", been engaged in the business of producing, selling and operating retail stores featuring gemstones,

precious and semi-precious, and all types and manner of jewelry under the trademarks WINSTON, HARRY WINSTON and JEWELER TO THE STARS.

2. The Opposer has, since at least as early as 1932 for the mark WINSTON, been engaged in producing and selling jewelry and operating retail jewelry stores in interstate commerce identified and distinguished by its WINSTON and HARRY WINSTON marks, by applying the marks to the goods, by labels on containers and packaging, by displaying representations of the marks in advertising and on retail store signs and in other ways customary to the trade. For many years Opposer has also been referred to as JEWELER TO THE STARS because of the numerous celebrities who have purchased Harry Winston jewelry.

3. Opposer is the owner of the trademarks WINSTON, HARRY WINSTON, JEWELER TO THE STARS and the United States Trademark Registrations thereof, and the goodwill symbolized by the trademarks and the registrations thereof for a variety of goods and services, including the following:

- a. WINSTON - Registration No. 848,629, Registered May 7, 1968, jewelry and polished diamonds;
- b. WINSTON - Registration No. 1,457,927, Registered September 22, 1987, perfume, eau de toilette and cologne;
- c. HARRY WINSTON - Registration No. 1,457,928, Registered September 22, 1987, perfume, eau de toilette and cologne;
- d. HW HARRY WINSTON - Registration No. 1,747,040, Registered January 19, 1993, jewellery,[sic] namely, crowns, necklaces, sets of jewels, brooches, bracelets, rings, earrings, cufflinks; horological and chronometric instruments; namely, write-watches, pocket watches, table watches, clocks, alarm-clocks, watch bracelets, bracelet fasteners, watch cases; jewelcases in precious metals, precious and semi-precious stones;
- e. HW HARRY WINSTON - Registration No. 2,112,912, Registered November 11, 1997, handwriting instruments, namely, pens, fountain pens, ballpoint pens, writing pens;
- f. HW - Registration No. 2,390,073, registered September 26, 2000, handwriting instruments, pens, fountain-pens, ballpoint pens, writing pens;
- g. HW HARRY WINSTON THE OCEAN COLLECTION - Registration No. 2,461,192, Registered June 19, 2001, precious metals and their alloys sold in bulk; goods of precious metal or coated therewith, namely, crowns, necklaces,

sets of jewels, brooches, bracelets, rings, earrings, cufflinks; jewel cases in precious metals; precious and semi-precious stones; jewelry, precious gemstones; chronometric instruments, namely, watches and clocks, watch bracelets, bracelet fasteners, watch cases; chronometers;

- h. HW HARRY WINSTON THE ULTIMATE PERFUME - Registration No. 2,538,811, registered February 19, 2002, perfumes and cosmetics; and
- i. HW HARRY WINSTON THE ULTIMATE COLLECTION - Registration No. 2,593,490, registered July 16, 2002, precious metals and their alloys sold in bulk; goods of precious metal or coated therewith, namely, crowns, necklaces, sets of jewels, brooches, bracelets, rings, earrings, cufflinks; jewel cases in precious metals; precious and semi-precious stones; jewelry, precious gemstones; chronometric instruments, namely watches and clocks, watch bracelets, bracelet fasteners, watch cases; chronometers; and
- j. JEWELER TO THE STARS - Registration No. 2,200,587, registered October 27, 1998, retail store services in the field of diamonds and jewelry.

A photocopy of registration numbers 848,629; 1,457,927; 1,457,928; 1,747,040; 2,200, 587; 2,112,912; 2,390,073; 2,461,192; 2,538.811 and 2,593,490 are attached as Exhibits 1(a-j). As soon as certified copies of the Exhibits are received from the U.S. Patent and Trademark Office, they will be submitted with an Amended Notice of Opposition.

4. The certificates of registration identified in paragraph 3 are valid and subsisting and record title is in Opposer; the certificates of registration are prima facie evidence of the validity of the registrations, the Registrant's ownership of the mark, and of the Registrant's exclusive right to use the mark in commerce in connection with the goods and services specified in the certificates of registration under the provisions of 15 U.S.C. § 1057(b) and constructive notice of the Registrant's claim of ownership under 15 U.S.C. § 1072. Registration Nos. 848,629; 1,457,928, 1,747,040, 2,112,912 and 2,200,587 are incontestable, which provides conclusive evidence of their validity under 15 U.S.C. § 1115(b).

5. On November 21, 2003, Applicant filed application Serial Number 76/561,222 - CHARLES WINSTON COLLECTIONS - for "men's and women's jewelry", which application was rightfully refused by the Examiner under Section 2(d) on the basis of Opposer's Registration No. 848,629 for WINSTON for related goods; and Applicant herein proceeded to abandon Serial Number 76/561,222, but has come back for a second bite of the apple attempting to register a Winston mark for jewelry.

6. The Applicant's CELEBRITY STYLE BY CHARLES WINSTON, "men's and women's jewelry" are identical products to Opposer's WINSTON, HARRY WINSTON and JEWELER TO THE STARS jewelry products.

7. Upon information and belief, the goods for which Applicant seeks to register the designation CELEBRITY STYLE BY CHARLES WINSTON will be sold and distributed through the channels of trade and sold in the same points of sale retail establishments to the same classes of the purchasing public as are the goods sold by Opposer under its Winston, Harry Winston and Jeweler To The Stars trademarks.

8. Upon information and belief, the Applicant's jewelry products will be advertised, marketed and promoted through the same marketing channels and advertising media for jewelry as are the goods sold by Opposer under its Winston and Harry Winston trademarks.

9. The designation CELEBRITY STYLE BY CHARLES WINSTON which the Applicant seeks to register is very similar to the Opposer's famous Winston and Harry Winston trademarks, as the dominant portion of the term is the name Charles Winston and the mark also includes a reference ("Celebrity Style") reminiscent of Opposer's mark and heritage, Jeweler To The Stars.

10. The Opposer since long prior to the adoption of CELEBRITY STYLE BY CHARLES WINSTON by the Applicant, has spent, and continues to spend, large sums of money in the promotion and advertisement of its goods and services identified and distinguished by its Winston, Harry Winston and Jeweler To The Stars trademarks, and by reason of such promotion and advertising and the high quality of its products and services carrying the Opposer's trademarks, Opposer now enjoys a valuable good will and an enviable and world famous reputation with respect to its trademarks and its goods and services.

11. The distinctive trademarks Winston and Harry Winston have attained widespread public recognition and acquired great value as an identification of the source of goods and services in or by Opposer for seventy (70) years; Harry Winston and Winston have become synonymous with very creative, high end and exclusive jewelry, as has the mark Jeweler To The Stars, and the said marks all distinguish Opposer's goods and services from the goods and services of others.

12. The designation CELEBRITY STYLE BY CHARLES WINSTON which Applicant seeks to register consists of Opposer's entire "Winston" mark. The addition of the first name "Charles" to Opposer's WINSTON mark and the merely descriptive words "celebrity style" does not differentiate Applicant's mark from Opposer's and reduce the likelihood of confusion; rather it increases the likelihood of confusion among consumers who know Harry Winston as the Jeweler To The Stars, and will believe that Celebrity Style Charles Winston is a new line of celebrity or "star" jewelry being produced and sold by Harry Winston. This is especially so when Charles Winston is trading off of the fame of the Harry Winston marks, the fact that Harry Winston is Jeweler To The Stars, and Charles Winston has promoted the fact that he is the nephew of Harry Winston; however he is now competing against Harry Winston on the basis of both his surname and his "celebrity style" products that are meant to evoke the "star" image of Harry Winston jewelry products and trade off of the Winston goodwill for jewelry.

13. For several years, Applicant and Charles Winston, whose consent is of record, have advertised, marketed and promoted both its products and Charles Winston by falsely suggesting a connection with Opposer, in contravention of Section 2(a) of the Lanham Act.

14. The use, promotion and registration of CELEBRITY STYLE BY CHARLES WINSTON by the Applicant will cause the purchasing public to assume, erroneously, and to be confused, misled and/or deceived, that the Applicant's "Celebrity Style" goods are new, lower priced lines of Winston or Harry Winston jewelry for the mass market, and are made by or originate with, are endorsed, licensed or sponsored by Opposer who is the Jeweler To The Stars, all to the Opposer's irreparable damage.

15. Applicant's attempt to register CELEBRITY STYLE BY CHARLES WINSTON for jewelry is a bald attempt to trade off of his family surname and Opposer's reputations as the Jeweler To The Stars in order to confuse, mislead or deceive potential consumers into thinking that Applicant is affiliated with Opposer and its business of designing and making jewelry, and/or that Applicant has been approved or endorsed by Opposer in the field of jewelry, neither of which is true.

16. For the reasons set forth in paragraph 1 through 15, Opposer believes, and believing asserts, that the goodwill in its Winston and Harry Winston trademarks will be damaged under Sections 2(a) and 2(d), and that the Applicant should be denied the registration

of the term CELEBRITY STYLE BY CHARLES WINSTON for all goods for which it has made application.

17. By reason of the foregoing, Applicant's application of CELEBRITY STYLE BY CHARLES WINSTON for jewelry products falsely suggests a connection with Opposer, and is likely to cause confusion with Opposer's marks for the same goods and is thus not registrable under Section 13 of the Trademark Act of 1946 (15 U.S.C. § 1063).

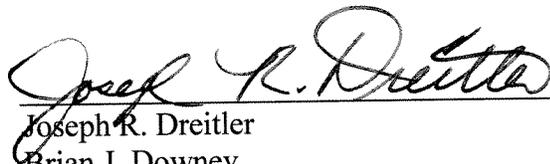
WHEREFORE, Opposer prays that this Opposition be sustained and that application Serial No. 76/588602 - CELEBRITY STYLE BY CHARLES WINSTON - be refused registration.

The fee of \$300.00 as provided by *Sections 13 and 31 of the Trademark Act of 1946* is paid by changing Opposer's attorneys' deposit account.

Please recognize Joseph R. Dreitler, Brian J. Downey and Mary R. True, all members of the Bar of the State of Ohio, as its attorneys to prosecute this Notice of Opposition and to transact all business in the Patent and Trademark Office in connection herewith. Please address all communications to: Joseph R. Dreitler, Esq., c/o Jones Day, P.O. Box 165017, Columbus, Ohio 43216-5017.

Dated: March 18, 2005

Respectfully submitted,



Joseph R. Dreitler

Brian J. Downey

Mary R. True

JONES DAY

P.O. Box 165017

Columbus, OH 43216-5017

Telephone: (614) 281-3902

Facsimile: (614) 461-4198

Attorneys for Opposers

Harry Winston, Inc. and Harry Winston

Ultimate Timepiece S.A.