

ESTTA Tracking number: **ESTTA87207**

Filing date: **06/27/2006**

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 party opposes registration of the indicated application.

Opposer Information

Name	Burberry Limited		
Entity	Corporation	Citizenship	United Kingdom
Address	18-22 Haymarket London, SW1Y 4DQ UNITED KINGDOM		

Attorney information	Roberta L. Horton Arnold & Porter LLP 555 Twelfth Street, N.W. IP Docketing Washington, DC 20004 UNITED STATES trademarkdocketing@aporter.com, Roberta_Horton@aporter.com Phone:202-942-5161
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Applicant Information

Application No	78582053	Publication date	06/27/2006
Opposition Filing Date	06/27/2006	Opposition Period Ends	07/27/2006
Applicant	Freeze 24/7 International LLC 555 Madison Avenue, 11th Floor New York, NY 10022 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Cosmetic lip treatments namely lipsticks, lip balms, lip gloss and lip cream

Attachments	BRRBERRY Notice of Opposition.pdf (7 pages)(416606 bytes)
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Signature	/Roberta L. Horton/
Name	Roberta L. Horton
Date	06/27/2006

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

In Re Application Serial No. 78-582053

Mark: BRR.BERRY [Block letters]

Filed: March 7, 2005

Published in the Official Gazette: June 27, 2006

Burberry Limited,)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	
Freeze 24/7 International LLC,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Burberry Limited (“Opposer”) believes that it will be damaged by the registration of the mark BRR.BERRY [in block letters], which is the subject of Application Serial No. 78-582053, and hereby opposes registration of the same under the provisions of Section 13 of the Trademark Act of July 5, 1946, as amended, 15 U.S.C. § 1063 and Trademark Rule 2.101, 37 C.F.R. § 2.101.

As grounds for opposition, Opposer alleges that:

I. THE PARTIES

1. Opposer Burberry Limited is a corporation duly organized and existing under the laws of the United Kingdom with an office and principal place of business at 18-22 Haymarket, London, SW1Y 4DQ, United Kingdom.

2. On information and belief, Applicant Freeze 24/7 International LLC is a New York limited liability company with an office at 555 Madison Avenue, 11th Floor, New York, New York 10022.

II. OPPOSER'S MARKS

3. The founder of the Burberry business, Mr. Thomas Burberry, opened an outfitters shop in Hampshire, United Kingdom in 1856.

4. Opposer's marks have a long and esteemed history in the United States, as well as in Britain. The BURBERRY® trademark has been used in connection with clothing in U.S. commerce by Opposer and its predecessors in interest for more than a century, since 1903.

5. In addition, Opposer sells a variety of BURBERRY brand fragrances and toiletries in U.S. commerce, including fragrances marketed under the names BURBERRY®; BURBERRY BRIT®; BURBERRY TOUCH®; BURBERRY LONDON; and WEEK END BURBERRY LONDON®. These fragrances are sold at Burberry stores and/or department stores such as Nordstrom and Sephora.

6. Opposer owns several federal registrations and pending applications for marks consisting of or incorporating BURBERRY in International Class 3, encompassing articles such as cologne, shampoos, soaps and shower gels and potpourri. These

registrations and applications (collectively, the “BURBERRY Marks”) are listed in the attached Exhibit A. As this exhibit shows, Opposer has rights in the BURBERRY Marks in this field, based on priority claims, dating back to March 13, 1997 (for WEEK END BURBERRY LONDON, stylized), March 15, 2000 (for BURBERRY) and May 10, 2000 (for BURBERRY TOUCH).

III. APPLICANT’S MARK

7. On information and belief, on March 7, 2005, Applicant filed an application to register the mark BRR.BERRY that is the subject of Serial No. 78-582053 for “cosmetic lip treatments, namely lipsticks, lip balms, lip gloss and lip cream.” Applicant made this filing based upon its intent to use the mark in commerce.

8. Applicant’s mark was published for opposition on June 27, 2006.

IV. LIKELIHOOD OF CONFUSION

9. There is no issue as to priority. Opposer has priority in its BURBERRY Marks in International Class 3 dating back as early as March 13, 1997 (for WEEKEND BURBERRY LONDON, stylized, as noted in Paragraph 6). Opposer also has priority over Applicant with respect to Opposer’s other BURBERRY Marks.

10. Applicant’s BRR.BERRY mark is confusingly similar to Burberry’s BURBERRY Marks for the following reasons, among others:

a) The Marks Are Virtually Identical. The parties’ marks are identical in sound and closely similar in sight and appearance. BRR.BERRY is an obvious play on the well-known BURBERRY Marks.

b) Similarity of the Products. The parties' goods are also closely related. Opposer sells, among other things, fragrances, soaps, shampoos and other

toiletries under the BURBERRY Marks; Applicant intends to sell cosmetics for lips under the BRR.BERRY mark. These products are all in International Class 3. Moreover, the parties' products are clearly complementary. Many other manufacturers sell, in tandem, fragrances, other toiletries, and makeup. These include companies such as Estee Lauder Inc. and Chanel, Inc. *See* <http://www.esteelauder.com> and <http://uma.chanel.com/home.php>. Just as female consumers expect these types of manufacturers to offer an array of cosmetic products, so, too, they might be confused into thinking that a lip treatment named "BRR.BERRY" -- which is phonetically identical to the well-known BURBERRY mark and name -- emanates from, or is sponsored by, Opposer.

c) Similarity of Trade Channels. The parties do not include any restrictions on trade channels in their applications and registrations. Therefore, on information and belief, Applicant intends to market its cosmetics through channels of trade identical or similar to those that Opposer uses for products sold under the BURBERRY Marks. Moreover, Applicant's website indicates that it markets products at some of the same high-end retail stores in which Opposer's products are sold, such as Nordstrom. *See* <http://www.freeze247.com/atetail>. cfm.

d) Nature of Purchasers. Upon information and belief, Applicant also intends to market its lip cosmetics under the BRR.BERRY mark to the same types of consumers that comprise the purchasing public for Opposer's products offered under Burberry's BURBERRY Marks, namely, primarily female consumers.

V. DILUTION

11. The BURBERRY Marks are famous and distinctive within the meaning of 15 U.S.C. § 1125(c). These Marks have been famous and distinctive since long before Applicant filed its intent to use application on March 7, 2005.

12. Applicant's use of the mark BRR.BERRY actually dilutes the distinctiveness of Burberry's BURBERRY Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) by eroding public identification of the BURBERRY Marks with Opposer.

* * *

For the reasons set forth above, Opposer believes that it will be damaged by the registration of Applicant's mark BRR.BERRY. Applicant should thus be denied registration of this proposed mark, and this Opposition to Application Serial No. 78-582053 should be sustained.

BURBERRY LIMITED

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Attorneys for Opposer

Dated: June 27, 2006

Exhibit A

Trademark	Class 3 Goods	File Date/ Ser. No.	Priority Claim/ Date	Reg. Date/ Reg. No.
BURBERRY TENDER TOUCH	perfumes, eau de cologne, toilet water, essential oils for personal use, cosmetics, preparations for the teeth and for the hair, namely, toothpastes, shampoos, conditioners, hair sprays, and hair gels; soaps for the body, shower gels, bath gels and bath foams; antiperspirants and deodorants; shaving preparations; potpourri	03/25/2004 76-583202 (Allowed)		
BURBERRY LONDON	non-medicated toilet preparations, namely perfumes, eau de cologne and toilet water, essential oils for personal use; cosmetics, preparations for the teeth and for the hair, namely toothpastes, shampoos, conditioners, hair sprays, hair gels, soaps for the body, shower gels and bath gels and bath foams; anti-perspirants and deodorants, shaving preparations, potpourri	12/11/2003 76-564751 (Allowed)		
BURBERRY BRIT	non-medicated toilet preparations, namely, perfumes, eau de cologne, and toilet water, essential oils for personal use, cosmetic preparations for the teeth and for the hair, namely, toothpastes, shampoos, conditioners, hair sprays, hair gels, soaps for the body, shower gels and bath gels and bath foams; antiperspirants and deodorants; shaving preparations and potpourri	11/11/2003 79-000114	YES 10/31/2003	12/13/2005 3029220
BURBERRY TOUCH	non-medicated toilet preparations, namely perfumes, eau de cologne, and toilet water, essential oils for personal use, cosmetic preparations for the teeth and for the hair, namely, toothpastes, shampoos, conditioners, hair sprays, hair gels, soaps for the body, shower gels and bath gels and bath forms; antiperspirants and deodorants; shaving preparations and pot pourri	10/25/2000 76-153502	YES 05/10/2000	10/15/2002 2634190
BURBERRY	non-medicated toilet preparations, namely, perfumes, eau de cologne, and toilet water, essential oils for personal use, cosmetic preparations for the teeth and for the hair, namely, toothpastes, shampoos, conditioners, hair sprays, hair gels, soaps for the body, shower gels and bath gels and bath foams; antiperspirants and deodorants; shaving preparations and pot pourri	04/26/2000 76-035456	YES 03/15/2000	10/08/2002 2629931
<i>Week end</i> Burberry <small>LONDON</small>	non-medicated preparations, namely, perfumed body cream and perfumed body milk, perfumes, eau de perfume, body lotion, eau de cologne, toilet waters, after-shave lotion, cologne, bath and shower gels	09/11/1997 75-355145	YES 03/13/1997	02/08/2000 2315279

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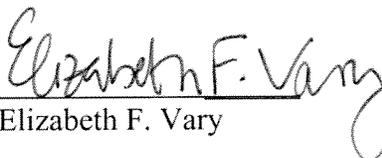
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I hereby certify that the foregoing Notice of Opposition is being filed electronically, on June 27, 2006, with the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board.


Elizabeth F. Vary