

ESTTA Tracking number: **ESTTA95748**

Filing date: **08/22/2006**

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	Dooney & Bourke, Inc.
Granted to Date of previous extension	08/23/2006
Address	One Regent Street Norwalk, CT 06855 UNITED STATES
Correspondence information	Robert Laplaca, Esq. Levett Rockwood P.C. 33 Riverside Avenue Westport, CT 06880 UNITED STATES rlaplaca@levettrockwood.com Phone:203-222-3110

Applicant Information

Application No	78626336	Publication date	04/25/2006
Opposition Filing Date	08/22/2006	Opposition Period Ends	08/23/2006
Applicant	Carina International, Inc. 4848 West Lawrence Chicago, IL 60630 UNITED STATES		

Goods/Services Affected by Opposition

Class 018. All goods and services in the class are opposed, namely: Handbags, leather keychains
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Attachments	00124936.pdf (12 pages)(307534 bytes)
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Signature	/Robert Laplaca/
Name	Robert Laplaca, Esq.
Date	08/22/2006

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

In The Matter of Trademark Application:

Serial No.: 78/626,336
Applicant: Carina International, Inc.
Mark: DP
Filing Date: 5/10/2005
Publication Date: 4/25/06

Dooney & Bourke, Inc., :
Opposer :
 :
v. :
 :
Carina International, Inc., :
Applicant :

NOTICE OF OPPOSITION

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Opposer, Dooney & Bourke, Inc. (“D&B”), a corporation organized and existing under the laws of the State of Connecticut, located and doing business at One Regent Street, East Norwalk, Connecticut 06855, believes it will be damaged by registration of the design mark **DP** shown in Serial No. 78/626,336 filed by Applicant Carina International, Inc. (“Carina”), and hereby opposes the same.

Applicant seeks registration for its mark on the Principal Register in connection with the following goods: “handbags, leather keychains,” all in International Class 18. The opposed

design mark was published for opposition on April 24, 2006. Opposer has properly obtained Extensions of Time to Oppose.

As grounds of opposition, it is alleged as follows:

1. D&B was founded in 1975 and since at least as early as 1981 has continuously used the name DOONEY & BOURKE and/or various versions of its initials “DB” as marks in interstate commerce for its products, including but not limited to handbags, leather key cases and leather key fobs – *i.e.*, the identical goods claimed by Carina in its Application in this matter.

2. D&B is the owner of the design mark **DB (plus design)** shown in U.S. Reg. No. 2,771,012 (copy attached as Exhibit A hereto), which mark comprises a design of the interlocking letters DB in a typeface and layout strikingly similar to the design mark **DP** shown in Carina’s Application in this matter (copy attached as Exhibit B hereto). The goods covered by D&B’s **DB (plus design)** registration include exactly the same goods listed in Carina’s Application – *i.e.*, handbags, leather keychains – as well as a wide array of leather goods, including, without limitation, wallets, purses, handbags, shoulder bags, tote bags, backpacks, luggage, coin purses, mobile phone holders, personal organizers, key fobs, and key cases. Other “DB” registrations by D&B for similar goods include, without limitation, U.S. Regs. Nos. 1,411,046, 1,718,142, and 2,540,048.

3. D&B has been using the design mark **DB (plus design)** with the interlocking letter design and repeating pattern shown in Reg. No. 2,771,012 since at least as early as January of 2001, which was long before the May 10, 2005, filing date of Carina’s Application in this matter and substantially prior to any use of the proposed design mark **DP**. D&B's use of its other DB marks also predates Carina’s Application.

4. D&B's interlocking **DB (plus design)** mark is highly distinctive and also has become well-known to the public and associated with D&B as the result of extensive advertising and sales, all as documented in March of 2003 in the prosecution history file for Reg. No. 2,771,012, and as further supplemented by additional sales (over 4,000,000 additional units) and advertising since that time. The interlocking **DB (plus design)** mark is used on D&B's famous "Signature" collection as well as other products. Indeed, the repeating pattern of interlocking **DB** logos has become synonymous with D&B.

5. The **DP** mark shown in Carina's application obviously imitates D&B's **DB (plus design)** mark shown in Reg. No. 2,771,012 and is clearly likely to cause confusion when applied to the identical goods sold by D&B. The letter pairs comprising the two design marks are highly similar. The typefaces are almost identical. The unusual and distinctive interlocking position of the letters in D&B's mark has been copied by Carina. The positioning of the P, bisected by the first D, renders the combination of the letters confusingly similar with D&B's **DB (plus design)** mark. The goods are identical. The "DP" letters have nothing to do with Carina's name. Carina's selection of these letters and its logo in a pattern duplicating D&B's **DB (plus design)** logo demonstrates that Carina is attempting to copy D&B's famous mark. For all these reasons, confusion is likely. The confusion is further exacerbated by the deployment and repeated use of the **DP** logo on Carina's products in a repeating, criss-cross pattern with alternating upside-down and rightside-up versions that slavishly duplicates the form of use of the **DB (plus design)** mark on D&B's products, as shown in the prosecution history file for Reg. No. 2,771,012 (sample illustration of D&B products attached as Exhibit G to D&B's Response to PTO Office Action, dated March 18, 2003, and attached hereto as Exhibit C).

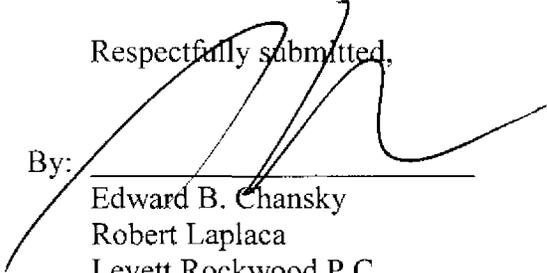
6. D&B has previously successfully opposed other applications for similar imitations of its famous **DB** mark, such as the “BB” logo shown in App. No. 78/223,492.

Wherefore, Dooney & Bourke, Inc. believes that it will be damaged by the registration of the **DP** mark shown in Carina’s Application, and prays that such registration not be allowed.

The filing fee of \$300.00 for this Notice of Opposition is enclosed.

Date: August 22, 2006

Respectfully submitted,

By: 

Edward B. Chansky
Robert Laplaca
Levett Rockwood P.C.
33 Riverside Avenue
Westport, Connecticut 06880
203-222-0885

COUNSEL FOR OPPOSER

EXHIBIT A

Int. Cls.: 9, 16 and 18

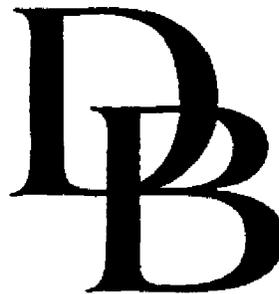
Prior U.S. Cls.: 1, 2, 3, 5, 21, 22, 23, 26, 29, 36, 37, 38,
41 and 50

Reg. No. 2,771,012

United States Patent and Trademark Office

Registered Oct. 7, 2003

TRADEMARK
PRINCIPAL REGISTER



DOONEY & BOURKE, INC. (CONNECTICUT
CORPORATION)
ONE REGENT STREET
P.O. BOX 841
NORWALK, CT 06856

FOR: EYEGLASS CASES, CAMERA CASES, BI-
NOCULAR CASES, MOBILE PHONE HOLSTERS,
COMPACT DISC CASES, IN CLASS 9 (U.S. CLS. 21,
23, 26, 36 AND 38).

FIRST USE 1-10-2001; IN COMMERCE 1-10-2001.

FOR: PERSONAL ORGANIZERS, CHECKBOOK
WALLETS, CHECKBOOK COVERS, CHECKBOOK
HOLDERS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37,
38 AND 50).

FIRST USE 1-10-2001; IN COMMERCE 1-10-2001.

FOR: WALLETS, PURSES, COIN PURSES, CLUT-
CHES, HANDBAGS, SHOULDER BAGS, SHOULDER
STRAPS, TOTE BAGS, BACKPACKS, LUGGAGE,
SUITCASES, TRUNKS, EMPTY COSMETICS CASES,
LEATHER KEY CASES, LEATHER KEY FOBS,
FANNY PACKS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22
AND 41).

FIRST USE 1-10-2001; IN COMMERCE 1-10-2001.

OWNER OF U.S. REG. NOS. 1,410,517 AND
1,718,142.

SEC. 2(F).

SER. NO. 76-406,189, FILED 5-9-2002.

ROBERT C. CLARK JR., EXAMINING ATTORNEY

EXHIBIT B



TRADEMARKSCAN@--U.S. Federal

Serial Number: 78626336

Status: PENDING
INTENT TO USE

USPTO Status: (630) NEW APPLICATION - RECORD INITIALIZED NOT ASSIGNED TO EXAMINER
USPTO Status Date: May 19, 2005

Filed: May 10, 2005

International Class(es):
18 (Leather Goods)

Goods/Services:
(INT. CL. 18) HANDBAGS, LEATHER KEYCHAINS

Applicant:
CARINA INTERNATIONAL, INC.
ILLINOIS CORPORATION
4848 WEST LAWRENCE
CHICAGO, ILLINOIS 60630

Filing Attorney: PATRICK G. BURNS
Reference Number: 0356.73022

Filing Correspondent:
PATRICK G. BURNS
GREER, BURNS & CRAIN, LTD.
300 S WACKER DR STE 2500
CHICAGO, IL 60606-6771

Design Phrase: THE MARK CONSISTS OF A PATTERN OF "DP"'S.

Design Codes:
300104 D
300116 P
300502 LETTERS (NOT NUMERALS) AS PART OF SMALL INITIAL STRINGS

History:
MAY 17, 2005 NEW APPLICATION ENTERED IN TRAM

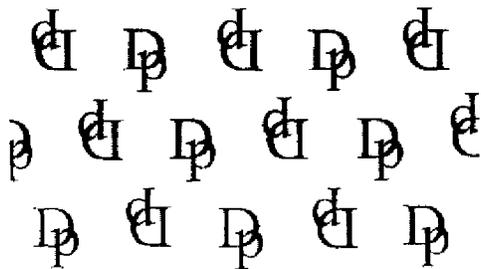


EXHIBIT C

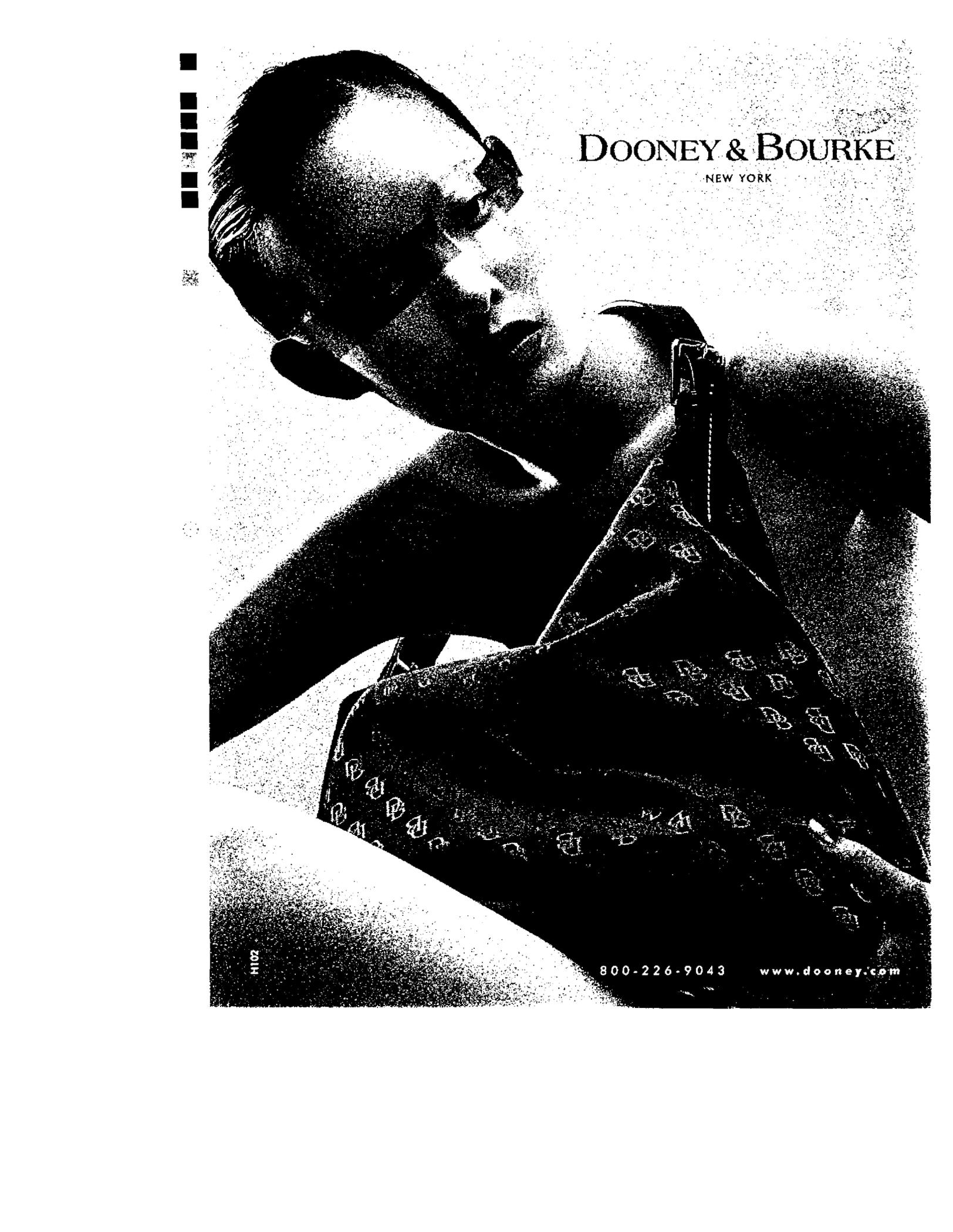
photo: Jason Fennley



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