

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 76/634,595
Filed March 29, 2005
For the Mark FF
Published in the *Official Gazette* on June 27, 2006

Fendi Adele S.r.l.,

Opposer,

Opposition No.

-v-

Action Concepts Fast Forward Ltd.,

Applicant.

BOX TTAB FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

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NOTICE OF OPPOSITION

Opposer Fendi Adele S.r.l. ("Fendi"), a limited liability corporation duly organized and existing under the laws of Italy, and having its principal address at via Flaminia 968, Rome I-00189, Italy, believes that it will be damaged by and hereby opposes the registration of the mark FF, Application Serial No. 76/634,595, filed on March 29, 2005 in connection with "clothing, namely, suits, dresses, gowns, jackets, blazers, vests, sweaters, cardigans, blouses, shirts, tank tops, T-shirts, skirts, pants, shorts, jeans, belts, caps, hats, headwear, sweatshirts, sweatpants, coats, rainwear, shawls, gloves, sashes, scarves, socks, leggings, sleepwear, footwear, sandals, swimwear, and undergarments" in International Class ("IC") 25, "skateboard hardware parts sold as an integral component part of skateboards, namely, bearings, mounting hardware, bolts, screws, nuts, washers and bushings" in IC 28, and "retail store services featuring men's, women's

and junior's clothing and footwear, jewelry, sunglasses, skateboards and inline skates" in IC 35 in the name of Action Concepts Fast Forward Ltd. ("Fast Forward" or "Applicant"), and published in the Official Gazette on June 27, 2006. On July 24, 2006, the Trademark Trial Appeal Board granted Opposer's request for an extension of time to oppose and extended the period of time to oppose until October 25, 2006.

As grounds for this Opposition, Fendi relies upon the rights developed by it and related companies (hereinafter referred to as "Opposer"). Opposer alleges on knowledge as to itself and otherwise upon information and belief, as follows:

1. Opposer owns the following seven United States registrations for marks containing the lettering "FF" in connection with a wide variety of goods (hereinafter "Opposer's Registrations" or "Opposer's Marks"):



Mark: FF
 Goods/Servs.: (IC 001) Leather and imitations of leather
 (IC 018) Luggage, trunks and traveling bags; umbrellas
 and parasols
 Reg. No.: 1,214,472
 Reg. Date: October 26, 1982
 Owner: Fendi Adele S.r.l.



Mark: FF
 Goods/Servs.: (IC 003) Perfumes, toilet water, face soap, bath soap,
 skin cleansing and moisturizing creams and lotions, hair
 creams and lotions, lipstick, eye shadow, mascara,
 rouge, face powder, talcum powder
 (IC 025) Fur coats, fur stoles, fur pieces, rainwear, cloth
 coats, jackets, skirts, trousers, dresses, hosiery, shirts,
 blouses, headwear, scarves, foulards, gloves, ties,
 neckwear, socks, stockings, belts, swimwear, lingerie,
 shoes, boots and slippers
 Reg. No.: 1,267,539
 Reg. Date: February 11, 1984
 Owner: Fendi Adele S.r.l.



Mark: FF
 Goods/Servs.: (IC 014) Watches and parts thereof
 Reg. No.: 1,583,578
 Reg. Date: February 20, 1990
 Owner: Fendi Adele S.r.l.



Mark: FF FENDI
 Goods/Servs.: (IC 018) attaché-cases, tote bags, briefcases, key cases, credit card cases, garment bag for travel, handbags, shoulder bags, luggage, passport cases, briefcase type portfolios, suitcases and umbrellas
 Reg. No.: 1,439,955
 Reg. Date: May 19, 1987
 Owner: Fendi Adele S.r.l.



Mark: FF FENDI
 Goods/Servs.: (IC 014) Watches not made wholly or in part of precious metals; costume jewelry, namely, earrings, cufflinks, and ornamental pins, bracelets, necklaces
 (IC 016) Diaries, fountain pens, pencils, pens
 (IC 034) Cigar and cigarette cases, lighters
 Reg. No.: 1,433,773
 Reg. Date: May 24, 1987
 Owner: Fendi Adele S.r.l.



Mark: FF FENDI
 Goods/Servs.: (IC 009) Spectacles, spectacle frames and spectacle cases
 Reg. No.: 1,476,586
 Reg. Date: February 16, 1988
 Owner: Fendi Adele S.r.l.



Mark: FF FENDI
 Goods/Servs.: (IC 003) Body lotions, skin moisturizer
 Reg. No.: 1,845,311
 Reg. Date: July 19, 1994
 Owner: Fendi Adele S.r.l.

2. Opposers' Registrations are valid and subsisting, unrevoked and uncancelled, and are *prima facie* evidence of the validity of Opposer's exclusive right to use the mark FF in commerce in connection with spectacles, bags, jewelry, watches, clothing, and other goods,

without condition or limitation, constitute constructive notice of Opposer's ownership of the mark FF for the goods set forth in the registrations, including, *inter alia*, spectacles, bags, jewelry, watches, and clothing, as provided for by §§ 7(b) and 22 of the Lanham Act, 15 U.S.C.A. §§ 1057(b) and 1072 (2006), and are incontestable under § 15 of the Lanham Act, 15 U.S.C.A. 1065.

3. Opposer has expended substantial amounts of time and effort in advertising and promoting its goods under Opposer's Marks. As a result of such advertising and promotional activities, Opposer's Marks have become well known and favorably received, the relevant public has come to associate and identify the mark FF with Opposer, and Opposer derives substantial goodwill from such identification by consumers.

4. On March 29, 2005, Applicant filed an intent-to-use trademark application for the mark FF (Ser. No. 76/634,595), which covers "clothing, namely, suits, dresses, gowns, jackets, blazers, vests, sweaters, cardigans, blouses, shirts, tank tops, T-shirts, skirts, pants, shorts, jeans, belts, caps, hats, headwear, sweatshirts, sweatpants, coats, rainwear, shawls, gloves, sashes, scarves, socks, leggings, sleepwear, footwear, sandals, swimwear, and undergarments" in IC 25, "skateboard hardware parts sold as an integral component part of skateboards, namely, bearings, mounting hardware, bolts, screws, nuts, washers and bushings" in IC 28, and "retail store services featuring men's, women's and junior's clothing and footwear, jewelry, sunglasses, skateboards and inline skates" in IC 35 (the "Applied-for Mark").

Count: Likelihood of Confusion

5. Opposer hereby incorporates by reference the allegations in Paragraphs 1 through 4 hereof as if fully set forth herein.

6. The Applied-for Mark, as set forth in the application opposed herein, is substantially similar in commercial impression to Opposer's Marks. The Applied-for Mark and Opposer's Marks are similar in sight, sound, and meaning. The Applied-for Mark and Opposer's Marks all consist of or contain the lettering "FF." In the Applied-for Mark and Opposer's Marks, the first letter "f" is upright and the second letter "f" is upside down and next to the first letter "f". The lettering "FF" and the orientation of the lettering are identical in the Applied-for Mark and Opposer's Marks.

7. The Applied-for Mark and Opposer's Marks cover related goods. The Applied-for Mark covers clothing, skateboard parts, and retail services selling clothing, footwear, jewelry, sunglasses, skateboards, and inline skates. Opposer's Marks cover clothing, footwear, jewelry, spectacles, and related goods.

8. Accordingly, the Applied-for Mark is likely to cause confusion or mistake or to deceive the public into believing that Applicant's goods are somehow affiliated or associated with, connected to or sponsored by Opposer, in violation of Section 2(d) of the Lanham Act.

9. Due to the high degree of inherent distinctiveness, the duration and extent of use, the duration and extent of advertising and publicity, the geographical extent of the trading area, and the degree of recognition, Opposer's Marks are "famous" pursuant to Section 43(c) of the Lanham Act.

10. Because Opposer's Marks are famous and because Opposer currently uses Opposer's Marks in connection with a variety of goods and services, there is a greater likelihood that the public will believe that the same or similar mark found on a wide range of goods or services are affiliated or associated with, connected to or sponsored by Opposer. Accordingly, confusion is more likely between Opposer's Marks and the Applied-for Mark.

11. If Applicant is permitted to register or use the mark herein opposed, confusion would be likely as to the sponsorship of the goods, resulting in damage and injury to Opposer by reason of the similarity between the Applied-for Mark and Opposer's Marks. Persons familiar with Opposer's Marks will be likely to purchase Applicant's goods, believing them to be affiliated or associated with, connected to or sponsored by Opposer. Likewise, persons exposed to the Applied-for Mark who subsequently become acquainted with Opposer's Marks are likely to conclude that the goods and services offered by Opposer under its marks are in some manner affiliated or associated with, connected to or sponsored by Applicant. Any such confusion as to sponsorship inevitably would result in damage and injury to Opposer.

12. Opposer will be damaged by registration of the mark shown in the application opposed herein because such registration will support and assist Applicant in the confusing and misleading use of the Applied-for Mark, and will give color of rights to Applicant in violation of Opposer's prior and superior statutory and common-law rights in Opposer's Marks.

Count II: Likelihood of Dilution

13. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 12 hereof as if fully set forth herein.

14. The registration and use of the Applied-for Mark will likely dilute the distinctive quality of Opposer's Marks.

15. Opposer will be damaged by registration of the mark shown in the application opposed herein because such registration will support and assist Applicant in the diluting use of Applicant's mark, and will give color or rights to Applicant in violation of Opposer's prior and superior statutory and common law rights in Opposer's Marks.

WHEREFORE, Opposer requests that this Opposition be sustained and that the application for registration of the mark FF be denied in all respects.

Dated: New York, New York
October 25, 2006

Respectfully submitted,

HUGHES HUBBARD & REED LLP

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451

on October 25, 2006

HUGHES HUBBARD & REED LLP

Dated: 10/25/06 By: Cecelia Rabona

Name: