

ESTTA Tracking number: **ESTTA280126**

Filing date: **04/24/2009**

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	Maidenform, Inc.
Granted to Date of previous extension	04/29/2009
Address	485 U.S. Highway 1 South Iselin, NJ 08830 UNITED STATES

Attorney information	Laura Popp-Rosenberg Fross Zelnick Lehrman & Zissu 866 United Nations Plaza,6th Floor, New York, NY 10017 UNITED STATES lpopp-rosenberg@fzlz.com,lapolzon@fzlz.com Phone:(212) 813-5900
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Applicant Information

Application No	77385962	Publication date	12/30/2008
Opposition Filing Date	04/24/2009	Opposition Period Ends	04/29/2009
Applicant	Metal Mulisha, LLC P.O. Box 656 Temecula, CA 92593 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: clothing, namely, shirts, blouses, tank tops, jackets, pants, shorts, belts, underwear, swim wear, sweat suits, sweaters, suits, hats, gloves, socks and foot wear

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	547558	Application Date	06/27/1950
Registration Date	09/04/1951	Foreign Priority Date	NONE
Word Mark	MAIDENFORM		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U039 (International Class 025). First use: First Use: 1923/12/01 First Use In Commerce: 1924/01/01 BRASSIERES, BANDEAUX, CORSETS, CORSELETTES, PANTIES, PANTIE-GIRDLES, GIRDLES, AND GARTER BELTS

U.S. Registration No.	719353	Application Date	09/14/1960
Registration Date	08/01/1961	Foreign Priority Date	NONE
Word Mark	MAIDENFORM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1950/06/27 First Use In Commerce: 1950/06/27 Foundation Garments, Particularly Brassieres, Girdles, Combination Brassieres and Girdles, Pantie-Girdles [, and Garter Belts; and Beach Wear-Namely, Swim Suits]		

Attachments	Notice of Opposition (F0448408).PDF (12 pages)(223571 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Laura Popp-Rosenberg/
Name	Laura Popp-Rosenberg
Date	04/24/2009

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

In the matter of Application Serial No. 77/385,962

MAIDENFORM, INC.,	X	
	:	
Opposer,	:	Opposition No. _____
	:	
- against -	:	
	:	
METAL MULISHA, LLC,	:	
	:	
Applicant.	:	
	X	

NOTICE OF OPPOSITION

Opposer, Maidenform, Inc. (“Opposer”), a New York corporation with its principal place of business at 485 U.S. Highway 1 South, Iselin, New Jersey 08830, believes that it would be damaged by the issuance of a registration for the trademark MAIDEN applied for in intent-to-use Application Serial No. 77/385,962 (the “Application”) for “clothing, namely, shirts, blouses, tank tops, jackets, pants, shorts, belts, underwear, swim wear, sweat suits, sweaters, suits, hats, gloves, socks and foot wear” in International Class 25, and therefore opposes the same. As grounds for this opposition, Opposer, by its counsel, Fross Zelnick Lehrman & Zissu, P.C., states as follows:

FACTS

A. Opposer and Opposer’s Mark

1. Opposer is a global intimate apparel company with a portfolio of established and well-known brands, top-selling products and an iconic heritage. Opposer designs, sources and markets an extensive range of intimate apparel products, including bras, panties and shapewear, as well as swimwear and intimate apparel accessories. During the company’s 86-year history,

Opposer has built a strong reputation for innovation, creativity and quality. Maidenform products are currently distributed in the United States and in approximately 60 foreign countries and territories.

2. Among Opposer's several well-known brands is MAIDENFORM. Opposer and/or its predecessors have used the MAIDENFORM mark continuously since at least as early as 1923.

3. Opposer has extensively used and promoted its MAIDENFORM mark. Through Opposer's extensive promotion and use of the MAIDENFORM mark, and the success of Opposer's offerings under the mark, the MAIDENFORM mark has come to represent enormous goodwill of Opposer.

4. Dating to long before any date upon which Applicant can rely, Opposer's MAIDENFORM mark has become uniquely identified with Opposer and has come to identify the products of Opposer exclusively.

5. Opposer owns the following federal trademark registrations, among others, for the MAIDENFORM mark: Registration No. 547,558 and Registration No. 719,353. True and correct copies of printouts from the U.S. Patent and Trademark Office online Trademark Applications and Registrations Retrieval ("TARR") database showing the status of the foregoing registrations are attached hereto as Exhibit 1. These registrations are valid, subsisting and in full force and effect, and constitute evidence of the validity of the marks and of Opposer's exclusive right to use them on the goods identified in the registrations. In addition, these registrations are incontestable pursuant to 15 U.S.C. § 1065, and thus constitute conclusive evidence of Opposer's exclusive rights in the MAIDENFORM mark for the goods recited in those registrations.

B. Applicant and Its Application

6. Upon information and belief, Applicant is a California limited liability company with a business address of P.O. Box 656, Temecula, California 92593.

7. Upon information and belief, on January 31, 2008, Applicant filed the Application to register the mark MAIDEN (“Applicant’s Mark”) based on an alleged bona fide intent to use the mark in commerce for, *inter alia*, “clothing, namely, shirts, blouses, tank tops, jackets, pants, shorts, belts, underwear, swim wear, sweat suits, sweaters, suits, hats, gloves, socks and foot wear” in International Class 25.

COUNT I: Priority and Likelihood of Confusion

8. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 7 as if fully set forth herein.

9. The January 31, 2008 filing date of Applicant’s intent-to-use Application, which is its constructive date of first use, is many decades after Opposer’s first use of and acquisition of rights in the MAIDENFORM mark. As such, Opposer’s rights in the MAIDENFORM mark are prior and superior to any rights Applicant may claim in Applicant’s Mark.

10. Applicant’s Mark is confusingly similar to Opposer’s MAIDENFORM mark.

11. The goods identified in the Application are identical or closely related to the goods offered by Opposer under the MAIDENFORM mark.

12. Use by Applicant of Applicant’s Mark for the goods identified in the Application is likely to create the erroneous impression that Applicant’s goods originate with, are sponsored or approved by, or are otherwise connected with Opposer or with Opposer’s MAIDENFORM mark or the goods provided by Opposer under that mark. Any use of Applicant’s Mark by

Applicant is therefore likely to cause confusion, cause mistake or to deceive the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

13. As a result of the foregoing, registration to Applicant of Applicant's Mark would be inconsistent with Opposer's prior exclusive rights in the MAIDENFORM mark and would threaten to destroy Opposer's investment and goodwill in that mark. Opposer therefore will be injured by the registration of Applicant's Mark.

COUNT II: Dilution

14. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 13 as if fully set forth herein.

15. The MAIDENFORM mark is distinctive and famous, has been used in commerce and widely advertised throughout the United States, and is instantly recognized by consumers as a symbol of Opposer and its goods.

16. Opposer's MAIDENFORM mark became famous long before any priority date upon which Applicant can rely.

17. Applicant's Mark is virtually identical to Opposer's famous MAIDENFORM mark.

18. Registration of Applicant's Mark is likely to dilute the distinctive quality of Opposer's MAIDENFORM mark by lessening the capacity of that mark to identify and distinguish Opposer's goods exclusively, thereby harming Opposer in violation of Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).

19. As a result of the foregoing, registration to Applicant of Applicant's Mark would be inconsistent with Opposer's prior exclusive rights in the MAIDENFORM mark and would

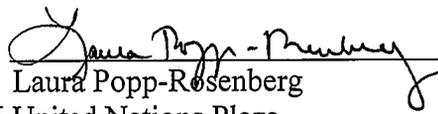
threaten to destroy Opposer's investment and goodwill in that mark. Opposer therefore will be injured by the registration of Applicant's Mark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that registration to Applicant's Mark in all respects be denied.

Dated: New York, New York
April 24, 2009

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
Laura Popp-Rosenberg
866 United Nations Plaza
New York, New York 10017
Telephone: (212) 813-5900
Email: lpopp-rosenberg@frosszelnick.com

Attorneys for Opposer Maidenform, Inc.

EXHIBIT 1

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2009-04-24 09:14:03 ET

Serial Number: 71599833 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 547558

Mark (words only): MAIDENFORM

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2001-09-22

Filing Date: 1950-06-27

Transformed into a National Application: No

Registration Date: 1951-09-04

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2008-10-15

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. MAIDENFORM, INC.

Address:

MAIDENFORM, INC.
200 MADISON AVE
NEW YORK, NY 10016
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

U.S. Class: 039 (International Class 025)

Class Status: Active

BRASSIERES, BANDEAUX, CORSETS, CORSELETTES, PANTIES, PANTIE-GIRDLES, GIRDLES, AND GARTER BELTS

Basis: 1(a)

First Use Date: 1923-12-01

First Use in Commerce Date: 1924-01-01

ADDITIONAL INFORMATION

Section 2(f)**Prior Registration Number(s):**[192834](#)[351873](#)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

[2008-10-15 - Case File In TICRS](#)[2007-06-20 - Assignment Of Ownership Not Updated Automatically](#)[2005-08-15 - Review Of Correspondence Complete](#)[2004-06-04 - PAPER RECEIVED](#)[2004-05-13 - PAPER RECEIVED](#)[2001-09-22 - Third renewal 10 year](#)[2001-09-22 - Section 8 \(10-year\) accepted/ Section 9 granted](#)[2001-06-22 - Combined Section 8 \(10-year\)/Section 9 filed](#)[1992-08-11 - Second renewal 10 year](#)[1992-06-09 - Response received for Post Registration action](#)[1992-04-24 - Section 7 amendment issued](#)[1992-02-07 - Section 7 amendment filed](#)[1991-09-04 - Post Registration action mailed - Section 9](#)[1991-08-08 - Response received for Post Registration action](#)[1991-06-24 - Response received for Post Registration action](#)[1991-05-30 - Post Registration action mailed - Section 9](#)[1991-04-22 - Section 9 filed/check record for Section 8](#)[1971-09-04 - First renewal](#)

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

JODI L PERLMAN
MAIDENFORM INC
200 MADISON AVE
NEW YORK NY 10016-3903

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2009-04-24 09:15:18 ET

Serial Number: 72104466 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 719353

Mark (words only): MAIDENFORM

Standard Character claim: No

Current Status: [This registration has been renewed.](#)

Date of Status: 2001-08-04

Filing Date: 1960-09-14

Transformed into a National Application: No

Registration Date: 1961-08-01

Register: [Principal](#)

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2008-10-27

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Maidenform, Inc.

Address:

Maidenform, Inc.
200 MADISON AVE.
New York, NY 10016
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

U.S. Class: 039 (International Class 025)

Class Status: Active

Foundation Garments, Particularly Brassieres, Girdles, Combination Brassieres and Girdles, Pantie-Girdles

Basis: 1(a)

First Use Date: 1950-06-27

First Use in Commerce Date: 1950-06-27

Used Anywhere in Another Form: [AT LEAST AS EARLY AS JUNE 24, 1924 IN A MODIFIED FORM.](#)

Used in Commerce in Another Form: [AT LEAST AS EARLY AS JUNE 24, 1924 IN A MODIFIED FORM.](#)

ADDITIONAL INFORMATION

Prior Registration Number(s):

192834

541637

547558

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

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2006-09-09 - Review Of Correspondence Complete

2004-06-04 - PAPER RECEIVED

2004-05-13 - PAPER RECEIVED

2001-08-04 - Second renewal 10 year

2001-08-04 - Section 8 (10-year) accepted/ Section 9 granted

2001-05-15 - Combined Section 8 (10-year)/Section 9 filed

1984-10-25 - Section 8 (6-year) accepted & Section 15 acknowledged

1981-08-01 - First renewal

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

JODI L PERLMAN

Correspondent

JODI L PERLMAN

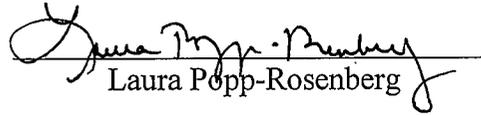
MAIDENFORM, INC.

200 MADISON AVENUE

NEW YORK, NY 10016

CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of April 2009, I caused a true and correct copy of the foregoing NOTICE OF OPPOSITION to be sent by First Class Mail, postage pre-paid, in an envelope addressed to the correspondent of record for the opposed application, Mark C. Schollaert, Esq., TrademarkSmart, 4747 Panorama Drive, San Diego, CA 92116.


Laura Popp-Rosenberg