

ESTTA Tracking number: **ESTTA331931**

Filing date: **02/12/2010**

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	Sephora
Granted to Date of previous extension	02/14/2010
Address	65 avenue Edouard Vaillant Boulogne, 92100 FRANCE

Attorney information	Kathleen E. McCarthy King & Spalding LLP 1185 Avenue of the Americas New York, NY 10036 UNITED STATES nytrademarks@kslaw.com, kmccarthy@kslaw.com Phone: 212-556-2345
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Applicant Information

Application No	77547912	Publication date	08/18/2009
Opposition Filing Date	02/12/2010	Opposition Period Ends	02/14/2010
Applicant	Howard, D.M. 225 McKinley Ave. Stratford, CT 06615 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2008/06/01 First Use In Commerce: 2008/06/01 All goods and services in the class are opposed, namely: providing on-line magazines in the field of fashion
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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.	2431967	Application Date	11/21/1997
Registration Date	02/27/2001	Foreign Priority Date	NONE
Word Mark	SEPHORA		

Design Mark	<h1>SEPHORA</h1>
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Description of Mark	NONE
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Goods/Services	<p>Class 003. First use: First Use: 1973/00/00 First Use In Commerce: 1998/07/16 [perfumes; perfumery products, namely, colognes; toilet waters;] essential oils for personal use, namely, bath oils, body oils, and massage oils; soaps, and cosmetics, namely, bath gels, [bath powders,] non-medicated bath salts, beauty masks, body creams, [body powders,] cosmetic pencils, cotton for cosmetic purposes, hand creams, night creams, skin cleansing creams, skin creams, vanishing creams, eye creams, skin lotions, facial lotions, body lotions, skin moisturizers, [night creams,] shower gels, skin clarifiers, [skin soaps,] suntanning preparations, [toilet soaps;] make-up products, namely, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliner, face powder, lipstick, make-up mascara, nail polish, nail polish remover, rouge; [hair lotions;] hair shampoos</p> <p>Class 035. First use: First Use: 1973/00/00 First Use In Commerce: 1998/07/16 [organizing and conducting trade show exhibitions in the field of perfumery and beauty care products;] retail store services in the field of perfumery, cosmetic products, beauty products, make-up products, hair lotions, preparations and shampoos</p> <p>Class 038. First use: First Use: 1996/12/21 First Use In Commerce: 1999/10/15 [transmission of data for others via a global computer network]</p> <p>Class 042. First use: First Use: 1973/00/00 First Use In Commerce: 1998/07/16 consulting services in the field of perfumery and beauty products; [beauty salons, hairdressing salons, tanning salons]</p>
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U.S. Registration No.	2431968	Application Date	11/21/1997
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Registration Date	02/27/2001	Foreign Priority Date	NONE
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Word Mark	SEPHORA
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Design Mark	 <p style="text-align: center;">SEPHORA</p>
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Description of	NONE
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Mark	
Goods/Services	<p>Class 003. First use: First Use: 1997/01/13 First Use In Commerce: 1998/07/16 [Perfumes; perfumery products, namely, colognes; toilet waters; essential oils for personal use, namely, bath oils, body oils, and massage oils; soaps, and cosmetics, namely, bath gels, bath powders, non-medicated bath salts, beauty masks,] body creams, [body powders, cosmetic pencils, cotton for cosmetic purposes,] hand creams, [night creams, skin cleansing creams, skin creams, vanishing creams, eye creams,] skin lotions, facial lotions, body lotions, skin moisturizers, [night creams,] shower gels, [skin clarifiers, skin soaps,] suntanning preparations, [toilet soaps; make-up products, namely, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliner, face powder, lipstick, make-up mascara, nail polish, nail polish remover, rouge; hair lotions;] hair shampoos</p> <p>Class 035. First use: First Use: 1997/01/13 First Use In Commerce: 1998/07/16 [organizing and conducting trade show exhibitions in the field of perfumery and beauty care products;] retail store services in the field of perfumery, cosmetic products, beauty products, make-up products, hair lotions, preparations and shampoos</p> <p>Class 038. First use: First Use: 1996/12/21 First Use In Commerce: 1999/10/15 [transmission of data for others via a global computer network]</p> <p>Class 042. First use: First Use: 1997/01/13 First Use In Commerce: 1998/07/16 [consulting services in the field of perfumery and beauty products; beauty salons, hairdressing salons, tanning salons]</p>

U.S. Registration No.	2770691	Application Date	02/20/2001
Registration Date	10/07/2003	Foreign Priority Date	NONE

Word Mark	SEPHORA
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 018. First use: Leather and imitations of leather goods, namely, handbags, make up bags sold empty, vanity cases sold empty, [beach bags,] travel bags, [shoulder bags, coin purses; umbrellas; parasols]</p> <p>Class 025. First use: Clothing, namely, [bandanas, bandeaux, bathing caps, belts, blazers, blouses, bras, boxer shorts, cardigans, coats, rain coats, dresses, gloves, dressing gowns, hats, jackets, jeans, negligees, night gowns, pants, polo shirts, pullovers, scarves, shawls, shirts, shorts, skirts,] socks, [suits, sweat shirts, sweaters, tee-shirts, ties, tights, trousers,] turbans, [underpants,] headwear, [footwear]</p>
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U.S. Registration No.	3738088	Application Date	03/10/2009
Registration Date	01/12/2010	Foreign Priority Date	NONE
Word Mark	NATURALLY SEPHORA INGREDIENTS OPTIONS RESULTS		
Design Mark			
Description of Mark	The mark consists of the stylized wording "NATURALLY SEPHORA INGREDIENTS OPTIONS RESULTS" in green on a white border around the design of a green and white flame over a solid green circle design, all surrounded by a green outer circle.		
Goods/Services	<p>Class 003. First use: First Use: 2009/02/15 First Use In Commerce: 2009/03/18 Cosmetics; hair shampoo; hair conditioners; hair styling preparations; hair care preparations; skin soap and cleansers; bath and shower gels; eye, facial and skin moisturizers, lotions and creams; essential oils for personal use; sunscreen; facial masks; body and facial scrubs; lip balm; body oils; bath salts; make-up remover; body deodorants</p> <p>Class 035. First use: First Use: 2009/02/15 First Use In Commerce: 2009/02/15 Retail store services in the field of cosmetics, beauty, skin and hair care products; providing consumer information in the field of cosmetics, beauty, skin and hair care products</p>		

U.S. Registration No.	3744176	Application Date	06/08/2009
Registration Date	02/02/2010	Foreign Priority Date	NONE
Word Mark	SEPHORA PURE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2009/03/10 First Use In Commerce: 2009/03/10 Cosmetics		

Attachments	75394577#TMSN.gif (1 page)(bytes) 75394578#TMSN.gif (1 page)(bytes) 76212530#TMSN.gif (1 page)(bytes) 77687114#TMSN.jpeg (1 page)(bytes) 77754119#TMSN.jpeg (1 page)(bytes) Zephora Opposition.pdf (10 pages)(29052 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	/Kathleen E. McCarthy/
Name	Kathleen E. McCarthy
Date	02/12/2010

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

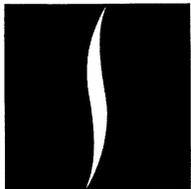
SEPHORA,)	
)	
Opposer,)	OPPOSITION NUMBER
)	
v.)	
)	
D.M. Howard,)	_____
)	
Applicant.)	

OPPOSITION

SEPHORA (“Opposer”) is a societe anonyme organized under the laws of France, whose business address is 65 avenue Edouard Vaillant, Boulogne, Billancourt, France 92100 (formerly located at 79-83 Rue Baudin, Levallois Perret, France 92300). Opposer believes it would be damaged by registration of the mark ZEPHORAH (“Applicant’s Alleged Mark”) for “providing on-line magazines in the field of fashion” (“Applicant’s Services”) in International Class 41, which mark is the subject of application Serial No. 77/547,912 (the “Application”), filed August 15, 2008, by D.M. HOWARD (“Applicant”) and published for opposition in the Official Gazette of August 18, 2009, and, by and through its undersigned attorneys, hereby opposes the same.

The grounds for this Opposition are as follows:

1. Opposer, including its predecessors-in-interest and its related and affiliated companies (hereinafter collectively referred to as “Opposer”), is now and has for many years been engaged in, inter alia, the perfume, skin care, cosmetics and beauty supplies and accessories business and in the operation of retail stores and an internet e-commerce website and in the provision of a beauty magazine, all using the mark SEPHORA.
2. Opposer is the owner of all right, title, and interest in and to the SEPHORA mark in the U.S., including a number of U.S. trademark registrations as indicated in the following table.

Trademark	Status	Ser./Reg. No.	Goods/Services
SEPHORA	Registered Feb. 27, 2001 Section 8 & 15 Sept. 12, 2007	SN:75-394577 RN:2,431,967	<p>(Int'l Class: 3) Essential oils for personal use, namely, bath oils, body oils, and massage oils; soaps, and cosmetics, namely, bath gels, non-medicated bath salts, beauty masks, body creams, cosmetic pencils, cotton for cosmetic purposes, hand creams, night creams, skin cleansing creams, skin creams, vanishing creams, eye creams, skin lotions, facial lotions, body lotions, skin moisturizers, shower gels, skin clarifiers, suntanning preparations, make-up products, namely, eye makeup, eye makeup remover, eye pencils, eye shadow, eyebrow pencils, eyeliner, face powder, lipstick, make-up mascara, nail polish, nail polish remover, rouge; hair shampoos</p> <p>(Int'l Class: 35) Retail store services in the field of perfumery, cosmetic products, beauty products, make-up products, hair lotions, preparations and shampoos</p> <p>(Int'l Class: 42) Consulting services in the field of perfumery and beauty products</p>
 SEPHORA	Registered Feb. 27, 2001 Section 8 & 15 Sept. 26, 2007	SN:75-394578 RN:2,431,968	<p>(Int'l Class: 3) body creams, hand creams, skin lotions, facial lotions, body lotions, skin moisturizers, shower gels, suntanning preparations, hair shampoos</p> <p>(Int'l Class: 35) Retail store services in the field of perfumery, cosmetic products, beauty products, make-up products, hair lotions, preparations and shampoos</p>
SEPHORA	Registered Oct. 7, 2003 Section 8 & 15 Oct. 21, 2009	SN:76-212530 RN:2,770,691	<p>(Int'l Class: 18) Leather and imitations of leather goods, namely, handbags, make up bags sold empty, vanity cases sold empty, travel bags</p> <p>(Int'l Class: 25) Clothing, namely, socks, turbans, headwear</p>

Trademark	Status	Ser./Reg. No.	Goods/Services
	Registered Jan. 12, 2010	SN:77-687114 RN:3,738,088	<p>(Int'l Class: 3) Cosmetics; hair shampoo; hair conditioners; hair styling preparations; hair care preparations; skin soap and cleansers; bath and shower gels; eye, facial and skin moisturizers, lotions and creams; essential oils for personal use; sunscreen; facial masks; body and facial scrubs; lip balm; body oils; bath salts; make-up remover; body deodorants</p> <p>(Int'l Class: 35) Retail store services in the field of cosmetics, beauty, skin and hair care products; providing consumer information in the field of cosmetics, beauty, skin and hair care products</p>
SEPHORA PURE	Registered Feb. 2, 2010	S.N.: 77/754119 R.N.: 3,744,176	(Int'l Class: 3) Cosmetics

3. Said registrations are valid and enforceable. In addition, Registration Nos. 2,431, 97, 2,431,968 and 2,770,691 are incontestable under Section 15 of the Lanham Act.

4. Opposer uses its SEPHORA mark in connection with a wide variety of goods and services. Opposer operates a large number of SEPHORA retail stores throughout the U.S. and throughout the world selling perfume, cosmetics and beauty products and offering makeup, skincare and fragrance consultations. In addition, Opposer operates an active internet e-commerce website at www.sephora.com through which consumers can purchase said goods, provide

their own reviews regarding products they have purchased, obtain information and recommendations, obtain beauty advice, and watch videos regarding beauty products and tips. The sephora.com website also includes a number of other features that attract interest and customers such as a blog and the SEPHORA beauty magazine.

5. Opposer's SEPHORA mark is inherently distinctive.

6. Opposer has promoted its SEPHORA mark extensively in its advertising and promotional materials.

7. By virtue of Opposer's distribution, sale, promotion, and advertising of products and services under its SEPHORA mark, said mark has become identified with high quality products and services originating with Opposer.

8. By virtue of Opposer's distribution, sale, promotion, and advertising of products and services under its SEPHORA mark, Opposer's SEPHORA mark has become famous and became famous prior to the filing date of Applicant's Application.

9. As a result of the long, widespread, and extensive use by Opposer of the SEPHORA mark, the SEPHORA mark has tremendous good will and is of great value to Opposer.

10. As a result of Opposer's extensive use of the SEPHORA mark, the SEPHORA mark has become well-known to consumers generally, enjoys widespread recognition, and is a famous and strong mark entitled to the broadest scope of protection.

11. Upon information and belief, no party other than Opposer owns or is using any federally-registered mark that is the same as or is substantially similar to Opposer's SEPHORA mark.

12. By the Application, Applicant seeks to register ZEPHORAH as a mark for providing on-line magazines in the field of fashion. The application is based on a claim of use of the mark in commerce as of June 1, 2008.

13. By virtue of its prior use and registrations, Opposer has rights in the mark SEPHORA prior and superior to any rights of Applicant in the mark covered by the Application.

14. Upon information and belief, “magazines in the field of fashion” often include extensive information regarding beauty products and cosmetics of the type typically sold at Opposer’s SEPHORA stores and promoted in Opposer’s SEPHORA beauty magazines.

15. Upon information and belief, Applicant’s Services are similar to Opposer’s services.

16. Opposer’s SEPHORA products and services and Applicant’s Services are capable of sale and promotion, and are likely to be sold and promoted, to the same class of purchasers.

17. Opposer’s SEPHORA products and services and Applicant’s Services are capable of sale and promotion, and are likely to be sold and promoted, in the same channels of trade, including over the Internet.

18. Opposer’s SEPHORA mark and Applicant’s Alleged Mark are confusingly similar.

19. Opposer’s SEPHORA mark and Applicant’s Alleged Mark are phonetically identical.

20. Upon information and belief, Applicant's Alleged Mark, in connection with Applicant's Services, so resembles the SEPHORA mark as to be likely to cause confusion, or to cause mistake, or to deceive with respect to the source or origin of Applicant's Services, with respect to Opposer's sponsorship thereof or connection or affiliation therewith, and/or in other ways under Section 2(d).

21. Opposer would be damaged by registration of Applicant's Alleged Mark because such registration would constitute prima facie evidence of Applicant's exclusive right to use Applicant's Alleged Mark for and in connection with Applicant's Services, which would be inconsistent with and detrimental to Opposer's prior, established and superior rights in the SEPHORA mark.

22. Opposer's SEPHORA mark is a famous mark within the meaning of Section 43(c) of the Lanham Trademark Act, and Applicant's Alleged Mark for Applicant's Services is likely to cause dilution of the distinctive quality of Opposer's SEPHORA mark under Section 43(c).

23. By reason of the foregoing facts, Opposer believes it will be irreparably damaged by the registration of Applicant's mark.

PRAYER FOR RELIEF

WHEREFORE, Opposer respectfully prays that the subject application be refused, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

KING & SPALDING LLP

/Kathleen E. McCarthy/

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New York, NY 10036

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Attorneys for Opposer

SEPHORA

CERTIFICATE OF SERVICE

This is to certify, in accordance with Rule 2.101(b) of the Trademark Rules of Practice, that I have this day served the foregoing Opposition on the Applicant, by causing a true and correct copy thereof to be deposited in the United States Mail, postage prepaid, addressed to the correspondent of record for the Applicant as indicated in the USPTO TARR database as follows:

D.M. Howard
225 McKinley Ave.
Stratford CT 06615

This 12th day of February, 2010.

/Kathleen E. McCarthy/