

ESTTA Tracking number: **ESTTA349138**

Filing date: **05/24/2010**

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	Banana Republic (Apparel) LLC
Granted to Date of previous extension	05/26/2010
Address	2 Folsom Street San Francisco, CA 94105 UNITED STATES
Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza 6th Floor New York, NY 10017 UNITED STATES jweinberger@frosszelnick.com, gwoo@frosszelnick.com Phone:(212) 813-5900

**Applicant Information**

Application No	77538225	Publication date	01/26/2010
Opposition Filing Date	05/24/2010	Opposition Period Ends	05/26/2010
Applicant	Arnold P. Nerenberg 7238 South Painter Avenue Whittier, CA 90602 UNITED STATES		

**Goods/Services Affected by Opposition**

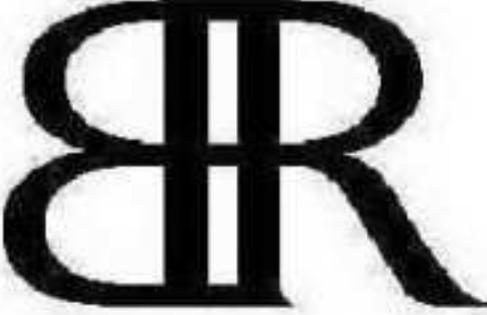
Class 014. All goods and services in the class are opposed, namely: Jewelry, namely, tie tacks, necklaces, tiepins, pins, bracelets
Class 025. All goods and services in the class are opposed, namely: Clothing, namely, t-shirts, hats, shorts, jackets, pants and shorts

**Grounds for Opposition**

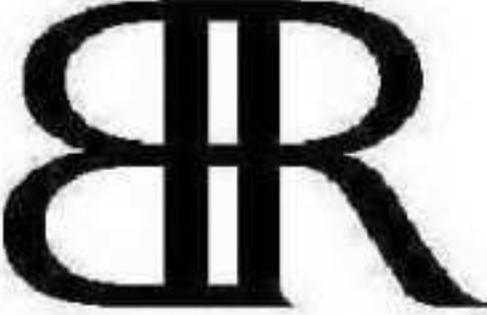
Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3248232	Application Date	11/18/2004
Registration Date	05/29/2007	Foreign Priority Date	NONE

Word Mark	BR
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2005/08/18 First Use In Commerce: 2005/08/18 Clothing, namely, t-shirts, shirts, blouses, sweaters, vests, pants, jeans, shorts, dresses, skirts, jackets, blazers, suits, coats, sleepwear, swimwear, loungewear, jogging suits, sweatshirts, socks, underwear, lingerie, athletic pants, tops, belts, scarves, ties, gloves; footwear; headwear

U.S. Registration No.	3776293	Application Date	11/18/2004
Registration Date	04/13/2010	Foreign Priority Date	NONE

Word Mark	BR
Design Mark	
Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 2008/08/06 First Use In Commerce: 2008/08/06 Jewelry, namely, rings, bracelets, necklaces, earrings and cuff-links

U.S. Application No.	77718976	Application Date	04/21/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BR		

Design Mark	
Description of Mark	The mark consists of The mark consists of stylized letters "BR".
Goods/Services	Class 025. First use: First Use: 2005/08/18 First Use In Commerce: 2005/08/18 Bottoms; Footwear; Headwear; Outer jackets; Tops

Attachments	78519571#TMSN.jpeg ( 1 page )( bytes ) 78519533#TMSN.jpeg ( 1 page )( bytes ) 77718976#TMSN.jpeg ( 1 page )( bytes ) Respectfully Real Notice of Opposition (F0629453).PDF ( 18 pages )(146567 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	/s/ James D. Weinberger
Name	James D. Weinberger
Date	05/24/2010

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

In the Matter of Application Serial No. 77/538,225  
Published in the *Official Gazette* on January 26, 2010

BANANA REPUBLIC (APPAREL), LLC,

Opposer,

-against-

ARNOLD P. NERENBERG,

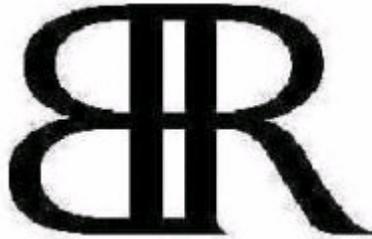
Applicant.

**NOTICE OF OPPOSITION**

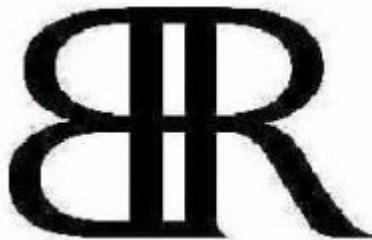
Opposer Banana Republic (Apparel), LLC, a California corporation with a place of business at 2 Folsom Street, 13th Floor, San Francisco, California 94105 (“Opposer”), believes that it will be damaged by the issuance of a registration for the trademark RR RESPECTFULLY REAL (and design) applied for in Application Serial No. 77/538,225, filed on August 4, 2008, for “Jewelry, namely, tie tacks, necklaces, tiepins, pins, bracelets” in International Class 14; and “Clothing, namely, t-shirts, hats, shorts, jackets, pants and shorts” in International Class 25 by Arnold P. Nerenberg (“Applicant”), and therefore opposes the same. As grounds for the opposition, Opposer alleges as follows:

1. Opposer is a leading in-store and online retailer of, among other things, clothing, accessories, personal care products and household goods.
2. Opposer is the owner of all right, title, and interest in and to the mark BR (and design) in connection with retail clothing goods and services based on first use since 1988.

3. Opposer owns numerous U.S. trademark registrations for the BR mark in connection with such goods and services, including but not limited to U.S. Reg. No. 3,248,232 for the following mark:



for “Clothing, namely, t-shirts, shirts, blouses, sweaters, vests, pants, jeans, shorts, dresses, skirts, jackets, blazers, suits, coats, sleepwear, swimwear, loungewear, jogging suits, sweatshirts, socks, underwear, lingerie, athletic pants, tops, belts, scarves, ties, gloves; footwear; headwear” in International Class 25, registered on May 29, 2007 based on first use on August 18, 2005; and U.S. Reg. No. 3,776,293 for the following mark:



for “Jewelry, namely, rings, bracelets, necklaces, earrings and cuff-links” in International Class 14, filed under section 1(b) of the Lanham Act, 15 U.S.C. § 1052(b) on November 18, 2004, and registered on April 13, 2010 based on first use on August 6, 2008. These registrations are valid, subsisting and in full effect and serve as prima facie evidence of the validity of the marks and of Opposer’s exclusive right to use Opposer’s Marks in connection with the goods and services identified therein, pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(a). Attached

hereto as Exhibit A is a printout from the TARR electronic database records of the U.S. Patent and Trademark Office showing the current status and title of the registrations relied upon herein.

4. Opposer is also the owner of a pending application, Application Serial No. 77/718,976 for the following mark:



for “Bottoms; Footwear; Headwear; Outer jackets; Tops” in International Class 25 based on first use on August 18, 2005. Attached hereto as Exhibit B is a printout from the TARR electronic database records of the U.S. Patent and Trademark Office showing the current status and title of the aforementioned pending application. (Opposer’s BR marks and the registration relied upon here are collectively referred to herein as “Opposer’s Mark”.)

5. Upon information and belief, Applicant is an individual located at 7238 South Painter Avenue, Whittier, California 90602.

6. On August 4, 2008, Applicant filed Application Serial No. 77/538,225 to register the following mark:



for “Jewelry, namely, tie tacks, necklaces, tiepins, pins, bracelets” in International Class 14; and “Clothing, namely, t-shirts, hats, shorts, jackets, pants and shorts” in International Class 25 based

on a bona fide intent to use under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b) (“Applicant’s Mark”).

7. Upon information and belief, Applicant has not commenced use of Applicant’s Mark on any goods or services in International Class 14 or International Class 25 in the United States.

8. Upon information and belief, prior to any date on which Applicant can rely, Applicant was on actual notice of Opposer’s prior rights in and to Opposer’s Mark.

9. The filing date of Applicant’s application, August 4, 2008, which is the earliest date upon which Applicant can rely, is years after the use, registration and acquisition of rights in Opposer’s Mark by Opposer or its predecessors in interest. As such, Opposer’s rights in its Opposer’s Mark are prior and superior to any rights Applicant may claim in Applicant’s Mark. The registration of Applicant’s Mark is inconsistent with Opposer’s prior rights and statutory grant of exclusivity of use.

10. Applicant’s Mark is confusingly similar to the prior used and registered Opposer’s Mark. The marks of the parties present nearly identical general commercial impressions and are very similar in appearance. Moreover, Applicant seeks to use its Mark in connection with jewelry in International Class 14 and clothing in International Class 25, goods that are identical or closely related to those on which Opposer has long used Opposer’s Mark.

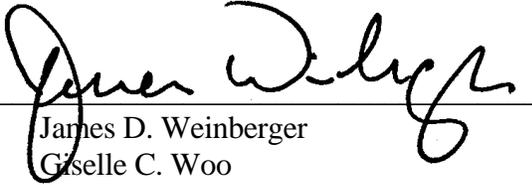
11. Applicant’s use and registration of Applicant’s Mark in connection with the goods identified in its application is likely to cause confusion, cause mistake or deceive consumers into the false belief that Applicant’s goods offered under Applicant’s Mark come from or are otherwise authorized, sponsored by, or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

12. By reason of the foregoing, Opposer is likely to be harmed by registration of Application Ser. No. 77/538,225 for Applicant's Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 77/538,225 be denied.

Dated: May 24, 2010  
New York, New York

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:   
James D. Weinberger  
Giselle C. Woo

866 United Nations Plaza  
New York, New York 10017  
(212) 813-5900

*Attorneys for Opposer*

# **EXHIBIT A**

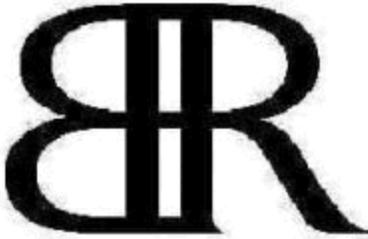
Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2010-05-24 07:22:54 ET

Serial Number: 78519571 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3248232

Mark



(words only): [BR](#)

Standard Character claim: [No](#)

Current Status: [Registered](#)

Date of Status: [2007-05-29](#)

Filing Date: [2004-11-18](#)

Transformed into a National Application: [No](#)

Registration Date: [2007-05-29](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 104](#)

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](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2007-04-26](#)

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

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1. [Banana Republic \(Apparel\), LLC](#)

Address:

[Banana Republic \(Apparel\), LLC](#)

2 Folsom Street  
San Francisco, CA 94105  
United States

**Legal Entity Type:** Limited Liability Company  
**State or Country Where Organized:** California  
**Phone Number:** 415-427-5575  
**Fax Number:** 415-427-2166

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### GOODS AND/OR SERVICES

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**International Class:** 025

**Class Status:** Active

Clothing, namely, t-shirts, shirts, blouses, sweaters, vests, pants, jeans, shorts, dresses, skirts, jackets, blazers, suits, coats, sleepwear, swimwear, loungewear, jogging suits, sweatshirts, socks, underwear, lingerie, athletic pants, tops, belts, scarves, ties, gloves; footwear; headwear

**Basis:** 1(a)

**First Use Date:** 2005-08-18

**First Use in Commerce Date:** 2005-08-18

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### ADDITIONAL INFORMATION

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(NOT AVAILABLE)

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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

2007-05-29 - Registered-Principal Register

2007-04-09 - Law Office Registration Review Completed

2007-04-09 - Assigned To LIE

2007-03-17 - Allowed Principal Register - SOU Accepted

2006-12-13 - Statement Of Use Processing Complete

2006-10-27 - Use Amendment Filed

2006-10-27 - TEAS Statement Of Use Received

2006-03-30 - Extension 1 Granted

2006-03-30 - Extension 1 Filed

2006-03-30 - TEAS Extension Received

2005-11-29 - Noa Mailed - SOU Required From Applicant

2005-09-06 - Published For Opposition

2005-08-17 - Notice Of Publication

2005-04-29 - Law Office Publication Review Completed

2005-04-22 - Assigned To LIE

2005-04-16 - Approved For Pub - Principal Register

2005-04-16 - Assigned To Examiner

2004-11-29 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Julie Gruber

**Correspondent**

JULIE GRUBER

GPS SERVICES, INC.

2 FOLSOM ST

SAN FRANCISCO, CA 94105-1205

Phone Number: 415-427-5575

Fax Number: 415-427-2166

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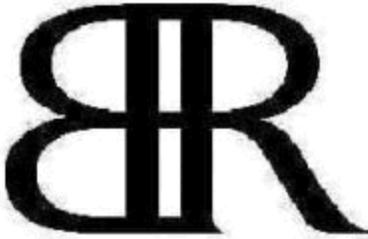
Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2010-05-24 07:23:42 ET

Serial Number: 78519533 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3776293

Mark



(words only): [BR](#)

Standard Character claim: [No](#)

Current Status: [Registered](#)

Date of Status: [2010-04-13](#)

Filing Date: [2004-11-18](#)

Transformed into a National Application: [No](#)

Registration Date: [2010-04-13](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 115](#)

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](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2010-03-10](#)

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

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1. [Banana Republic \(Apparel\), LLC](#)

Address:

[Banana Republic \(Apparel\), LLC](#)

2 Folsom Street  
San Francisco, CA 94105  
United States

**Legal Entity Type:** Limited Liability Company  
**State or Country Where Organized:** California  
**Phone Number:** 415-427-5575  
**Fax Number:** 415-427-2166

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### GOODS AND/OR SERVICES

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**International Class:** 014  
**Class Status:** Active  
Jewelry, namely, rings, bracelets, necklaces, earrings and cuff-links  
**Basis:** 1(a)  
**First Use Date:** 2008-08-06  
**First Use in Commerce Date:** 2008-08-06

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### ADDITIONAL INFORMATION

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**Color(s) Claimed:** Color is not claimed as a feature of the mark.

**Prior Registration Number(s):**  
2740345

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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

2010-04-13 - Registered-Principal Register  
2010-03-10 - Law Office Registration Review Completed  
2010-03-09 - Assigned To LIE  
2010-02-18 - Allowed Principal Register - SOU Accepted  
2010-02-01 - Statement Of Use Processing Complete  
2009-12-22 - Use Amendment Filed  
2010-02-01 - Case Assigned To Intent To Use Paralegal

2009-12-22 - TEAS Statement Of Use Received  
2009-07-06 - Extension 5 Granted  
2009-07-01 - Extension 5 Filed  
2009-07-01 - TEAS Extension Received  
2009-01-12 - Extension 4 Granted  
2008-12-23 - Extension 4 Filed  
2009-01-12 - Case Assigned To Intent To Use Paralegal  
2008-12-23 - TEAS Extension Received  
2008-05-08 - Extension 3 Granted  
2008-04-30 - Extension 3 Filed  
2008-04-30 - TEAS Extension Received  
2008-01-15 - Extension 2 Granted  
2007-12-19 - Extension 2 Filed  
2007-12-19 - TEAS Extension Received  
2007-08-31 - Extension 1 Granted  
2007-06-13 - Extension 1 Filed  
2007-06-13 - TEAS Extension Received  
2007-02-19 - Exparte Appeal Terminated  
2007-01-02 - Noa Mailed - SOU Required From Applicant  
2006-10-10 - Published For Opposition  
2006-09-20 - Notice Of Publication  
2006-08-23 - Law Office Publication Review Completed  
2006-08-18 - Assigned To LIE  
2006-08-13 - Approved For Pub - Principal Register  
2006-08-08 - Jurisdiction Restored To Examining Attorney  
2006-06-06 - Ex Parte Appeal-Instituted

2006-06-05 - Exparte Appeal Received At TTAB

2005-12-09 - Final Refusal E-Mailed

2005-12-09 - Final Refusal Written

2005-10-25 - Amendment From Applicant Entered

2005-10-14 - Correspondence Received In Law Office

2005-10-14 - Paper Received

2005-04-16 - Non-Final Action E-Mailed

2005-04-16 - Non-Final Action Written

2005-04-16 - Assigned To Examiner

2004-11-29 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Frank Goldberg

**Correspondent**

Frank Goldberg  
Banana Republic (Apparel), LLC  
2 FOLSOM ST  
SAN FRANCISCO CA 94105-1205  
Phone Number: 415-427-5575  
Fax Number: 415-427-2166

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# **EXHIBIT B**

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

This page was generated by the TARR system on 2010-05-24 07:24:18 ET

Serial Number: 77718976 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: (NOT AVAILABLE)

Mark



(words only): [BR](#)

Standard Character claim: [No](#)

Current Status: [Report Completed Suspension Check - Case Still Suspended](#)

Date of Status: [2009-12-22](#)

Filing Date: [2009-04-21](#)

Filed as TEAS Plus Application: [Yes](#)

Currently TEAS Plus Application: [Yes](#)

Transformed into a National Application: [No](#)

Registration Date: (DATE NOT AVAILABLE)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 115](#)

Attorney Assigned:  
[LOWRY LEIGH A](#)

Current Location: [M60 -TMO Law Office 115](#)

Date In Location: [2009-12-22](#)

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

---

1. [Banana Republic \(Apparel\) LLC](#)

**Address:**

Banana Republic (Apparel) LLC  
2 Folsom Street  
San Francisco, CA 94105  
United States

**Legal Entity Type:** Limited Liability Company**State or Country Where Organized:** California**Phone Number:** 415-427-5575**Fax Number:** 415-427-2166

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**GOODS AND/OR SERVICES**

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**International Class:** 025**Class Status:** Active

Bottoms; Footwear; Headwear; Outer jackets; Tops

**Basis:** 1(a)**First Use Date:** 2005-08-18**First Use in Commerce Date:** 2005-08-18

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**ADDITIONAL INFORMATION**

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**Color(s) Claimed:** Color is not claimed as a feature of the mark.**Description of Mark:** The mark consists of The mark consists of stylized letters "BR".**Prior Registration Number(s):**

3096787

3124964

3248232

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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

2009-12-22 - Report Completed Suspension Check Case Still Suspended

2009-12-22 - Assigned To LIE

2009-06-22 - Notification Of Letter Of Suspension E-Mailed

2009-06-22 - Letter Of Suspension E-Mailed

2009-06-22 - Suspension Letter Written

2009-06-12 - Assigned To Examiner

2009-04-25 - Notice Of Pseudo Mark Mailed

2009-04-24 - New Application Office Supplied Data Entered In Tram

2009-04-24 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Frank Goldberg

**Correspondent**

FRANK GOLDBERG

GPS SERVICES, INC.

2 FOLSOM ST

SAN FRANCISCO, CA 94105-1205

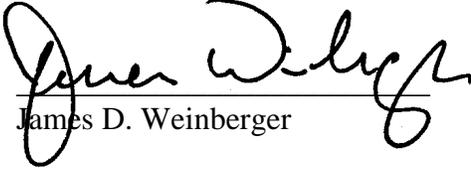
Phone Number: 415-427-5575

Fax Number: 415-427-2166

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was sent by first class mail postage pre-paid to the Correspondent of Record, Arlen L. Olsen, at Schmeiser, Olsen & Watts, 22 Century Hill Drive, Suite 302, Latham, New York 12110-2137 this 24th day of May, 2010.

  
James D. Weinberger