

ESTTA Tracking number: **ESTTA349637**

Filing date: **05/26/2010**

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	Hookedge Limited
Granted to Date of previous extension	05/26/2010
Address	c/o Browne Jacobson LLP 77 Gracechurch Street London, EC3V OAS UNITED KINGDOM

Attorney information	Karl M. Zielaznicki, Esq. Troutman Sanders LLP c/o TM DKT CLK 600 Peachtree St., NE, STE 5200 Atlanta, GA 30308-2216 UNITED STATES trademarks@troutmansanders.com, christina.russo@troutmansanders.com, karl.zielaznicki@troutmansanders.com Phone: 212-704-6125
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Applicant Information

Application No	79063114	Publication date	01/26/2010
Opposition Filing Date	05/26/2010	Opposition Period Ends	05/26/2010
International Registration No.	0987556	International Registration Date	11/19/2008
Applicant	Patrick Cox (Holdings) Limited Gresham House, 32 Portland Place Marylebone, London, W1B 1NA UNITED KINGDOM		

Goods/Services Affected by Opposition

<p>Class 018. All goods and services in the class are opposed, namely: Handbags; suitcases; backpacks; key cases; purses; wallets; traveling trunks; vanity cases sold empty; umbrellas; linings of leather for boots and shoes, namely, unworked and semiworked leather; leather and imitation leather and goods made from these materials, namely, briefcases, handbags, suitcases, backpacks, key cases, purses, wallets, traveling trunks and vanity cases sold empty; excluding any articles for the practice of sport</p>
<p>Class 025. All goods and services in the class are opposed, namely: Footwear; boots; shoes; slippers; sandals; belts; caps; gloves; mittens; scarves; stoles and wraps; coats; shirts; sweaters; cardigans; pants; trousers; jeans; suits; jackets; underpants; socks; hosiery; swimwear; dresses and skirts; excluding any articles for the practice of sport</p>

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1903615	Application Date	06/14/1993
Registration Date	07/04/1995	Foreign Priority Date	NONE
Word Mark	PATRICK COX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1986/09/00 First Use In Commerce: 1986/09/00 shoes and belts		

U.S. Registration No.	2899213	Application Date	10/28/2003
Registration Date	11/02/2004	Foreign Priority Date	NONE
Word Mark	PC'S PATRICK COX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 Shoes, boots, slippers and sandals		

Attachments	76558599#TMSN.gif (1 page)(bytes) PC1411741_1.pdf (5 pages)(27092 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	/kmz/
Name	Karl M. Zielaznicki, Esq.
Date	05/26/2010

As grounds for opposition, it is alleged:

1. Since at least as early as September 1986, Hookedge Limited (“Opposer”) and its predecessors in interest have been providers of shoes, boots, slippers, sandals and belts throughout the United States and overseas under the mark PATRICK COX (“Opposer’s Goods”).

2. Through its use of the mark PATRICK COX, Opposer has developed goodwill and consumer recognition so that customers have come to associate the mark PATRICK COX with Opposer’s Goods.

3. Opposer is the legal and beneficial owner of the following US Trademark Registrations containing or consisting of the name PATRICK COX:

<i>MARK</i>	<i>REGISTRATION NO.</i>	<i>REGISTRATION DATE</i>
PATRICK COX	1903615	July 4, 1995
PC PATRICK COX logo	2899213	November 2, 2004

Opposer intends to rely on the above registrations (hereinafter, “Opposer’s Marks”) in this proceeding and, accordingly, will order status and title copies of these registrations from the US Trademark Office for later submission to the Board together with a Notice of Reliance pursuant to TMBP § 2.122(d).

4. Opposer’s registrations set forth in Paragraph 3 herein are valid and subsisting, uncancelled and unrevoked and are *prima facie* evidence of Opposer’s exclusive right to use the marks claimed therein in commerce on or in connection with the goods claimed in each of the registrations listed.

5. Opposer’s US Trademark Registration No. 1903615 is incontestable.

6. On November 19, 2008, Patrick Cox (Holdings) Limited (“Applicant”) filed Trademark Application Serial No. 79063114 seeking registration of the mark PATRICK COX plus fleur de lys logo filed in the United States Patent and Trademark Office claiming priority under Section 66(a) from International Registration Number 0987556 (the “Priority Registration”).

7. At the time of publication, Application Serial No. 79063114 for the mark PATRICK COX plus fleur de lys logo covered handbags; suitcases; backpacks; key cases; purses; wallets; traveling trunks; vanity cases sold empty; umbrellas; linings of leather for boots and shoes, namely, unworked and semiworked leather; leather and imitation leather and goods made from these materials, namely, briefcases, handbags, suitcases, backpacks, key cases, purses, wallets, traveling trunks and vanity cases sold empty; excluding any articles for the practice of sport, in Class 18; and footwear; boots; shoes; slippers; sandals; belts; caps; gloves; mittens; scarves; stoles and wraps; coats; shirts; sweaters; cardigans; pants; trousers; jeans; suits; jackets; underpants; socks; hosiery; swimwear; dresses and skirts; excluding any articles for the practice of sport, in Class 25 (“Applicant’s Goods”).

8. There is no question as to priority since Opposer’s first use date precedes the filing date of Application Serial No. 79063114 and also the filing date of the Priority Registration.

9. Opposer’s Goods are likely to be offered to the same consumers of Opposer’s Goods sold under Opposer’s Marks containing or consisting of the name PATRICK COX and therefore, Applicant’s use and registration of the mark PATRICK COX plus fleur de lys logo as claimed in Application Serial No. 79063114 is likely to cause confusion, or mistake or deception of customers, irreparably damaging Opposer.

10. Applicant’s use and registration of the mark PATRICK COX plus fleur de lys logo as claimed in Application Serial No. 79063114 is likely to deceive and/or mislead

prospective customers into believing that Opposer is the source of Applicant's Goods and/or that Applicant's Goods are sponsored, licensed, approved or endorsed by Opposer, irreparably damaging Opposer.

11. Applicant's use and registration of the mark PATRICK COX plus fleur de lys logo as set forth in Application Serial No. 79063114 is calculated or likely to cause irreparable loss, injury and damage to Opposer's reputation and would permit Applicant to trade on Opposer's valuable rights and goodwill in Opposer's Marks containing or consisting of the name PATRICK COX in violation of Section 2 of the of the Trademark Act of 1946, as amended. (15 U.S.C. § 1052).

12. Applicant's mark as set forth in Application Serial No. 79063114 is a misappropriation of Opposer's prior rights in Opposer's Marks containing or consisting of the name PATRICK COX and any use and registration of the same by Applicant will disparage and falsely suggest a connection with Opposer in violation of Section 2(a) of the Trademark Act of 1946, as amended, (15 U.S.C. § 1052(a)) resulting in irreparable harm and injury to Opposer.

13. Applicant's use and registration of the mark PATRICK COX plus fleur de lys logo as claimed in Application Serial No. 79063114 is likely to cause confusion with Opposer's rights in Opposer's Marks containing or consisting of the name PATRICK COX in violation of Section 2(d) of the Trademark Act of 1946, as amended. (15 U.S.C. § 1052(d)).

14. At the time of filing Application Serial No. 79063114, Applicant was aware of Opposer's clearly established superior legal rights in and ownership of Opposer's Marks containing or consisting of the name PATRICK COX. By failing to disclose this material fact to the US Trademark Office, Applicant intended to procure a registration to which it was not entitled.

15. At the time of filing Application Serial No. 79063114, Applicant was aware that it had no rights in or to the mark PATRICK COX plus fleur de lys logo and such claim was knowingly false. By failing to disclose this material fact to the US Trademark Office, Applicant intended to procure a registration to which it was not entitled.

16. At the time of filing Application Serial No. 79063114, Applicant therefore knowingly made false, material representations of fact with the intent to deceive the US Trademark Office into issuing Applicant a registration to which it was not entitled.

17. During the prosecution of Application Serial No. 79063114, such application was rejected by the Examining Attorney in an Office Action dated February 20, 2009 based upon a Section 2 (d) likelihood of confusion with Opposer's Marks.

18. During the prosecution of Application Serial No. 79063114, Applicant filed a Response to an Office Action dated August 24, 2009 claiming ownership of Opposer's Marks and knowingly submitted a copy of an invalid assignment from Opposer to Applicant dated May 14, 2008 (the "Assignment") to support such claim.

19. During the prosecution of Application Serial No. 79063114, the Examining Attorney issued an Office Action dated September 21, 2009 requesting entry of either a statement by Applicant into the record as to the claim to ownership of Opposer's Marks or recordation of the Assignment at the US Trademark Office Assignment Branch and also a consent from Mr. Patrick Cox.

20. During the prosecution of Application Serial No. 79063114, Applicant filed a Response to an Office Action dated November 19, 2009 amending said application to include a false claim to ownership of Opposer's Marks and asserted reliance on Mr. Cox's prior consent entered in the file histories for Opposer's Marks.

21. During the prosecution of Application Serial No. 79063114, the Examining Attorney issued an Office Action dated December 23, 2009 relying on Applicant's knowingly made false, material misrepresentations of fact which withdrew the Section 2(d) rejection based upon Opposer's Marks (which Applicant now claimed to own) and amended the application to include Mr. Cox's prior consent as contained in the file histories for Opposer's Marks

22. In an Order entered on April 19, 2010 (the "Order"), the UK High Court of Justice, Chancery Division, Intellectual Property declared (at paragraph 3) that the Assignment from Opposer to Applicant of Opposer's Marks (and other non-US registrations) filed in support of Application Serial No. 79063114 was invalid and that Opposer had been at all times the legal and beneficial owner of Opposer's Marks. A copy of the Order is annexed as Exhibit A hereto and incorporated herein by reference.

23. During the prosecution of Application Serial No. 79063114, Applicant therefore knowingly made false, material representations of fact with the intent to deceive the US Trademark Office into issuing Applicant a registration to which it was not entitled.

24. Applicant's use and registration of the mark PATRICK COX plus fleur de lys logo as claimed in Application Serial No. 79063114 therefore consists of or comprises the name, of a living individual without written consent in violation of Section 2(c) of the Trademark Act of 1946, as amended. (15 U.S.C. § 1052(c)).

WHEREFORE, Opposer prays that this Opposition be sustained and that Application Serial No. 79063114 for the mark PATRICK COX plus fleur de lys logo in Classes 18 and 25 be refused registration.