

ESTTA Tracking number: **ESTTA365156**

Filing date: **08/26/2010**

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	Mario Tricoci Hair Salons & Day Spas, Inc.
Granted to Date of previous extension	08/28/2010
Address	3822 E. University Dr., #5 Phoenix, AZ 85034 UNITED STATES

Attorney information	Thomas Pasternak Step toe & Johnson LLP 115 S. La Salle St., Ste. 3100 Chicago, IL 60603 UNITED STATES tpasternak@step toe.com, tholt@step toe.com
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### Applicant Information

Application No	77933627	Publication date	06/29/2010
Opposition Filing Date	08/26/2010	Opposition Period Ends	08/28/2010
Applicant	Franco Tricoci Enterprises 1026 W. Devon Ave. Elk Grove, IL 60007 UNITED STATES		

### Goods/Services Affected by Opposition

Class 044. All goods and services in the class are opposed, namely: Beauty salon services; Health spa services, namely, cosmetic body care services
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### 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.	2882038	Application Date	05/12/2000
Registration Date	09/07/2004	Foreign Priority Date	NONE
Word Mark	MARIO TRICOCI		

Design Mark	<b>MARIO TRICOCI</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 Hair care styling preparations, namely, hair gel, hair mousse and hair lotion; coloring products, namely, hair dyes</p> <p>Class 042. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 Personal care services in the nature of hair styling, cutting, conditioning and coloring; skin care salons, massage therapies, nail manicuring services, foot treatments, namely, pedicures, and body, hand and foot treatments, namely, body, hand and foot waxing; health spa services including aromatherapy, body wraps, skin peels, including facial peels, and milk therapy in the nature of milk baths</p>		

U.S. Registration No.	2882037	Application Date	05/12/2000
Registration Date	09/07/2004	Foreign Priority Date	NONE

Word Mark	MARIO TRICOCI TOO		
Design Mark	<b>MARIO TRICOCI TOO</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 Hair care styling preparations, namely, hair gel, hair mousse and hair lotion; coloring products, namely, hair dyes</p> <p>Class 042. First use: First Use: 1995/00/00 First Use In Commerce: 1995/00/00 Personal care services in the nature of hair styling, cutting, conditioning and coloring; skin care salons, massage therapies, nail manicuring services, foot treatments, namely, pedicures, and body, hand and foot treatments, namely, body, hand and foot waxing; health spa services including aromatherapy, body wraps, skin peels, including facial peels, and milk therapy in the nature of milk baths</p>		

U.S. Registration No.	2911345	Application Date	05/12/2000
Registration Date	12/14/2004	Foreign Priority Date	NONE
Word Mark	MARIO TRICOCI HAIR SALONS AND DAY SPAS		

Design Mark	MARIO TRICOCI HAIR SALONS AND DAY SPAS
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 hair care styling preparations, namely, hair gel, hair mousse and hair lotion; coloring products, namely, hair dyes

U.S. Registration No.	2911575	Application Date	05/12/2000
Registration Date	12/14/2004	Foreign Priority Date	NONE
Word Mark	MARIO TRICOCI HAIR SALONS AND DAY SPAS		
Design Mark	MARIO TRICOCI HAIR SALONS AND DAY SPAS		
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 personal care services in the nature of hair styling, cutting, conditioning and coloring; skin care salons, massage therapies, nail manicuring services, foot treatments, namely, pedicures, and body, hand and foot treatments, namely, body, hand and foot waxing; health spa services including aromatherapy, body wraps, skin peels, including facial peels, and milk therapy in the nature of milk baths		

U.S. Registration No.	2919223	Application Date	05/12/2000
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00 HAIR CARE STYLING PREPARATIONS, NAMELY, HAIR GEL, HAIR MOUSSE		

	<p>AND HAIR LOTIONS; COLORING PRODUCTS, NAMELY, HAIR DYES  Class 042. First use: First Use: 1987/00/00 First Use In Commerce: 1987/00/00  PERSONAL CARE SERVICES IN THE NATURE OF HAIR STYLING,  CUTTING, CONDITIONING AND COLORING; SKIN CARE SALONS,  MASSAGE THERAPIES, NAIL MANICURING SERVICES, FOOT  TREATMENTS, NAMELY, PEDICURES, AND BODY, HAND FOOT  TREATMENTS, NAMELY, BODY, HAND AND FOOT WAXING; HEALTH SPA  SERVICES INCLUDING AROMATHERAPY, BODY WRAPS, SKIN PEELS,  INCLUDING FACIAL PEELS, AND MILK THERAPY IN THE NATURE OF MILK  BATHS</p>
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Attachments	<p>76047453#TMSN.gif ( 1 page )( bytes )  76047452#TMSN.gif ( 1 page )( bytes )  76047644#TMSN.gif ( 1 page )( bytes )  76976645#TMSN.gif ( 1 page )( bytes )  76047451#TMSN.gif ( 1 page )( bytes )  Tricoci Opposition FINAL.pdf ( 5 pages )(14974 bytes )</p>
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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	/Thomas G. Pasternak/
Name	Thomas G. Pasternak
Date	08/26/2010

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

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MARIO TRICOCI HAIR SALONS AND DAY SPAS, INC.,	)	
	)	
Opposer,	)	Opposition No.: _____
	)	
v.	)	Serial No. 77/933,627
	)	Filed: February 11, 2010
	)	
FRANCO TRICOCI ENTERPRISES, LLC,	)	<b>NOTICE OF OPPOSITION</b>
	)	
Applicant.	)	

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In the matter of Application Serial No. 77/933,627, filed on February 11, 2010 by Franco Tricoci Enterprises, LLC, an Illinois limited liability company with offices at 1026 West Devon Avenue, Elk Grove Village, Illinois 60007, (“Franco Tricoci”), seeking registration of the trademark FT (stylized) in International Class 044, which application was published for opposition in the *Official Gazette* on June 29, 2010, Mario Tricoci Hair Salons & Spas, Inc., a Delaware corporation having a principal place of business at 3822 East University Drive, #5, Phoenix, AZ 85034, (“Mario Tricoci”), believes it will be damaged by registration of the mark and therefore opposes on the following grounds:

1. Mr. Mario Tricoci, who is still affiliated with and a minority owner of Mario Tricoci, is an internationally renowned hair stylist and innovator in the salon world. Mr. Tricoci has devoted over 30 years to building the MARIO TRICOCI brand into a name synonymous with outstanding quality, style and service. Over ten years ago, Mario Tricoci recognized the value of the MARIO TRICOCI brand and acquired the business and the trademarks protecting the brand.

2. Mario Tricoci now owns a family of federally registered MARIO TRICOCI marks, including the mark MT (Stylized), all of which are listed below:

<b>Mark</b>	<b>Registration No.</b>	<b>Registration Date</b>	<b>Goods</b>
MARIO TRICOCI	2,882,038	September 7, 2004	Hair and skin care preparations and services
MARIO TRICOCI TOO	2,882,037	September 7, 2004	Hair and skin care preparations and services
MARIO TRICOCI HAIR SALONS AND DAY SPAS	2,911,345	December 14, 2004	Hair and skin care preparations and services
MARIO TRICOCI HAIR SALONS AND DAY SPAS	2,911,575	December 14, 2004	Hair and skin care preparations and services
MT (stylized)	2,919,223	January 18, 2005	Hair and skin care preparations and services

(collectively the “MARIO TRICOCI Marks”).

3. Pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b), Mario Tricoci’s federal registration certificates are prima facie evidence of the validity of these marks as well as Mario Tricoci’s ownership and exclusive right to use these marks in connection with the identified goods and services. In fact, Mario Tricoci’s exclusive right to use the marks for the goods and services recited in Registration Nos. 2,882,037 and 2,882,038 has achieved incontestable status under 15 U.S.C. § 1065.

4. Mario Tricoci has expended millions of dollars to advertise and enhance the quality of its services and products symbolized by the MARIO TRICOCI Marks. As a result of the efforts of Mario Tricoci and its predecessor(s) in interest over more than three decades, the

MARIO TRICOCI Marks have become, through widespread and favorable public acceptance and recognition, an asset of incalculable value as a symbol of Mario Tricoci, its quality services and products and its goodwill. Indeed, Mario Tricoci is acclaimed as the leading salon and spa in the Chicago area and as one of the leading salons in the country.

5. Long after Mario Tricoci's adoption and use of the MARIO TRICOCI Marks and after the MARIO TRICOCI Marks had become well known, Franco Tricoci set up new hair salons and spas under the confusingly similar mark FRANCO TRICOCI and filed Application Serial No. 77/933,627 to register the FT (stylized) mark for "beauty salon services; health spa services, namely cosmetic body care services" in International Class 044. Franco Tricoci's conduct in promoting these new salons under their FRANCO TRICOCI and FT (stylized) marks reveals his intentions to exploit and take advantage of the tremendous goodwill associated with the MARIO TRICOCI Marks.

6. Franco Tricoci had constructive knowledge of the MARIO TRICOCI Marks before filing Application Serial No. 77/933,627. Upon information and belief, Franco Tricoci had actual knowledge of the MARIO TRICOCI Marks before filing Application Serial No. 77/933,627.

7. Franco Tricoci's FT (stylized) mark is confusingly similar in sight, sound, and commercial impression to the MARIO TRICOCI Marks.

8. The services identified in Franco Tricoci's FT (stylized) application are highly related to those goods and services offered by Mario Tricoci under the MARIO TRICOCI Marks.

9. Franco Tricoci's FT (stylized) mark so closely resembles MARIO TRICOCI Marks that, if used in connection with the applied-for services, it would be likely to cause confusion, mistake or deception of the relevant trade and public.

10. By reason of the foregoing, Mario Tricoci believes that it will be damaged by Franco Tricoci's registration of the FT (stylized) mark.

WHEREFORE, Mario Tricoci believes that it will be damaged by the registration of Franco Tricoci's FT (stylized) mark and prays that this Opposition be sustained and that Application Serial No. 77/933,627 be refused.

Dated: August 26, 2010

Respectfully submitted,

By: /s/ Thomas G. Pasternak

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*Attorneys for Mario Tricoci Hair Salons and  
Day Spas, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that on August 26, 2010, I served a true and correct copy of the foregoing  
NOTICE OF OPPOSITION on counsel for Applicant by U.S. Mail at the following address:

Mitchell J. Edlund  
Meckler Bulger Tilson Marick & Pearson LLP  
123 North Wacker Drive  
Suite 1800  
Chicago, IL 60606

/s/ Thomas G. Pasternak  
One of the Attorneys for Opposer  
Mario Tricoci Hair Salons & Day Spas, Inc.