

ESTTA Tracking number: **ESTTA367180**

Filing date: **09/08/2010**

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	Swank, Inc.
Granted to Date of previous extension	09/08/2010
Address	90 Park Avenue New York, NY 10016 UNITED STATES

Attorney information	Paul Fields Leason Ellis 81 Main Street, Suite 503 White Plains, NY 10601 UNITED STATES tmdocket@leasonellis.com, fields@leasonellis.com
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**Applicant Information**

Application No	77774354	Publication date	05/11/2010
Opposition Filing Date	09/08/2010	Opposition Period Ends	09/08/2010
Applicant	Taylor, Robert S. 1451 East 55th St. #317N Chicago, IL 60615 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, shirts and shorts; apparel for men, women and children, namely, dresses, jeans and tops; shoes
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**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
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.	3448767	Application Date	10/12/2007
Registration Date	06/17/2008	Foreign Priority Date	NONE

Word Mark	SWANK
Design Mark	<h1>SWANK</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1984/02/15 First Use In Commerce: 1984/02/15 Retail store services in the field of jewelry, belts, wallets, umbrellas and briefcases

U.S. Registration No.	3425568	Application Date	05/01/2007
Registration Date	05/13/2008	Foreign Priority Date	NONE

Word Mark	SWANK
Design Mark	<h1>SWANK</h1>
Description of Mark	NONE
Goods/Services	<p>Class 003. First use: First Use: 1975/00/00 First Use In Commerce: 1975/00/00 Shoe cleaner sets consisting primarily of shoe polish, shoe polish applicators, and shoe brushes</p> <p>Class 014. First use: First Use: 1927/07/01 First Use In Commerce: 1927/07/01 Items of men's jewelry, namely, collar pins; jewelry cases not made of precious metal; collar holders formed wholly or in part of precious metal; jewelry for personal wear, not including watches, namely, cuff links, dress sets consisting of cufflinks and matching studs, tie holders, key rings made in whole of, in part of, or plated with precious metal</p> <p>Class 016. First use: First Use: 1927/07/01 First Use In Commerce: 1927/07/01 Money clips</p> <p>Class 018. First use: First Use: 1935/05/21 First Use In Commerce: 1935/05/21 Wallets, billfolds, key cases, fitted traveling cases, tie cases, luggage accessories, namely luggage tags</p> <p>Class 020. First use: First Use: 1935/05/21 First Use In Commerce: 1935/05/21</p>

	Tie racks Class 021. First use: First Use: 1935/05/21 First Use In Commerce: 1935/05/21 Military-style hair brush sets, clothes brush sets, brush and shoe brush sets Class 025. First use: First Use: 1934/03/04 First Use In Commerce: 1934/03/04 Belts in the nature of garment supporters and for outer wear; suspenders Class 026. First use: First Use: 1927/07/01 First Use In Commerce: 1927/07/01 Belt buckles
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U.S. Registration No.	1131853	Application Date	08/28/1978
Registration Date	03/11/1980	Foreign Priority Date	NONE
Word Mark	SWANK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1978/08/10 First Use In Commerce: 1978/08/10 NECKWEAR		

Attachments	77303155#TMSN.jpeg ( 1 page )( bytes ) 77169842#TMSN.jpeg ( 1 page )( bytes ) NOTICE OF OPPOSITION (00075518).PDF ( 4 pages )(234782 bytes ) AFFIDAVIT OF SERVICE (00075520).PDF ( 1 page )(121623 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	/Paul Fields/
Name	Paul Fields
Date	09/08/2010

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

SWANK, INC.,	)	
	)	
Opposer,	)	
	)	Opposition No.
v.	)	Application Ser. No. 77/774,354
	)	Published in the Official Gazette on
ROBERT S. TAYLOR d/b/a	)	11 May 2010
SEAN SWANK COUTURE CO.,	)	Filing Date: July 5, 2009
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**

Swank, Inc. (“Opposer”), a Delaware corporation located at 90 Park Avenue, New York, New York 10016, believes it will be damaged by the registration of the designation SEAN SWANK, as shown in Application Serial No. 77/774,354 (the “ ‘354 App.”) for use in connection with “clothing, namely, shirts and shorts; apparel for men, women and children, namely dresses, jeans and tops; shoes”, filed by Robert S. Taylor (“Applicant”) and hereby opposes the same. An extension of time to oppose the ‘354 App. has been granted until 8 September 2010 on behalf of Opposer.

The grounds for opposition are:

1. Continuously since at least as early as 1984, Opposer has operated retail stores in the United States and has provided retail store services under the SWANK name. The stores sell various items including jewelry, belts, wallets, umbrellas, hats, gloves, scarves, raincoats and ponchos. The name and mark SWANK appears on the façade of and is used within the stores.

2. Since long prior to the filing date of the ‘354 App., Opposer has used SWANK in the United States in connection with the promotion and sale of a wide variety of goods including but not

limited to, jewelry, cuff links, dress sets, tie holders, collar pins, and key rings; neckwear; wallets, luggage accessories, military brush sets, clothes brush sets, belts, suspenders, belt buckles, and mechanical pens and pencils (the “Swank Marks”).

3. Opposer has spent large sums of money and expended tremendous effort in promoting products and rendering services under its SWANK Marks, which marks have become extremely well known and famous and are associated exclusively with Opposer and its products and services. The goodwill of the business connected with the use of, and symbolized by, the SWANK Marks is an asset of incalculable value.

4. Opposer is the sole owner, inter alia, of the following United States trademark registrations and of all the business and goodwill connected with said marks issued on the dates and under the number set out beside them. The following SWANK Marks are now in full force and effect and have not been canceled.

<b>TRADEMARK</b>	<b>REGISTRATION DATE</b>	<b>REGISTRATION NUMBER</b>	<b>GOODS/SERVICES</b>
SWANK	June 17, 2008	3448767	Retail store services in the field of jewelry, belts, wallets, umbrellas and briefcases
SWANK	May 13, 2008	3425568	Shoe cleaner sets consisting primarily of shoe polish, shoe polish applicators, and shoe brushes in Class 3;  Items of men’s jewelry, namely, collar pins; jewelry cases not made of precious metal; collar holders formed wholly or in part of precious metal; jewelry for personal wear, not including watches, namely, cuff links, dress sets consisting of cufflinks and matching studs, tie holders, key rings made in whole of, in part of, or plated with precious metal in Class 14;  Money clips in Class 16;

			<p>Wallets, billfolds, key cases, fitted traveling cases, tie cases, luggage accessories, namely luggage tags in Class 18;</p> <p>Tie racks in Class 19;</p> <p>Military-style hair brush sets, clothes brush sets, brush and shoe brush sets in Class 21;</p> <p>Belts in the nature of garment supporters and for outer wear; suspenders in Class 25;</p> <p>Belt buckles in Class 26.</p>
SWANK	March 11, 1980	1131853	Neckwear

5. On 5 July 2009, long after Opposer’s first use of its SWANK Marks, Applicant filed Application Serial No. 77/774,354 to register SEAN SWANK in respect of “clothing, namely, shirts and shorts, apparel for men, women and children, namely dresses, jeans and tops; shoes.” The ‘354 App. is based on intent to use and an Amendment to Allege Use has not yet been filed.

6. The filing date of the ‘354 App. is subsequent to Opposer’s first use of its SWANK marks.

7. Upon information and belief, Applicant’s SEAN SWANK mark so resembles Opposer’s SWANK Marks such that consumers are likely to conjure an association between Applicant’s Mark and Opposer’s SWANK marks and are likely to be confused, mistaken and deceived into believing that the goods of Applicant are provided, sponsored, licensed or approved by Opposer, that Applicant’s and Opposer’s goods emanate from the same source and/or that Applicant is in some other fashion connected or associated with Opposer, all to Opposer’s injury.

8. Upon information and belief, registration of Applicant’s SEAN SWANK mark will diminish and dilute the famous and distinctive quality of Opposer’s famous SWANK Marks because one viewing Applicant’s Mark will associate the trademark SWANK with Opposer less strongly or exclusively, or

conclude that the SEAN SWANK products of Opposer are now associated with a new product or service, resulting in damage to Opposer.

9. Registration of the '354 App. by Applicant is barred by the provisions of 15 U.S.C. §1052(d), for the reason that it consists of or comprises a mark which so resembles Opposer's SWANK Marks as to be likely, when applied to the goods of Applicant, to cause confusion, mistake or to deceive.

10. Registration of the '354 App. by Applicant is barred by the provisions of 15 U.S.C. §1052(f), because when used, would cause dilution under §43(c) , thereby damaging Opposer as a result of dilution by blurring and would lessen the capacity of Opposer's Marks to identify goods having their source in Opposer.

11. For these reasons, Opposer would be damaged by the registration of the '354 App.

WHEREFORE, Opposer respectfully requests that the '354 App. be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Pursuant to 37 C.F.R. §2.101 Opposer has served a copy of the Notice of Opposition on the Applicant identified on the USPTO's TARR database by first class mail on September 8, 2010. A copy of the Certificate of Service is attached.

The required fee of \$300.00 is enclosed.

Respectfully submitted,

LEASON ELLIS LLP

By:     /Paul Fields/    

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Attorneys for Opposer  
Swank, Inc.

Dated: White Plains, New York  
September 8, 2010

**CERTIFICATE OF SERVICE**

It is hereby certified that a true and complete copy of the foregoing NOTICE OF OPPOSITION was served by first-class mail, postage pre-paid, upon counsel for Applicant at the following address:

Robert S. Taylor  
1451 East 55<sup>th</sup> Street  
Suite 317N  
Chicago, IL 60615-5450

Dated: September 8, 2010

/Tonya T. Owens/

Tonya T. Owens