

ESTTA Tracking number: **ESTTA383063**

Filing date: **12/10/2010**

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

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| Name | Almod Diamonds Ltd. |
| Granted to Date of previous extension | 01/01/2011 |
| Address | 592 Fifth Ave 9th Floor New York, NY 10036 UNITED STATES |

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| Correspondence information | Almod Diamonds Ltd. Office for Legal Affairs Attn: Elchonon Shagalov 592 Fifth Ave 2nd Floor New York, NY 10036 UNITED STATES es@almod.com |
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Applicant Information

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|------------------------|---|------------------------|------------|
| Application No | 85056431 | Publication date | 11/02/2010 |
| Opposition Filing Date | 12/10/2010 | Opposition Period Ends | 01/01/2011 |
| Applicant | Ilitch Enterprises, LLC Suite 200 131 S. Old Woodward Birmingham, MI 48009 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 035. First Use: 2004/03/26 First Use In Commerce: 2005/03/22 Opposed goods and services in the class: Vending in the field of jewelry |
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Grounds for Opposition

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

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| U.S. Registration No. | 3135536 | Application Date | 08/22/2005 |
| Registration Date | 08/29/2006 | Foreign Priority Date | NONE |
| Word Mark | DI DIAMONDS INTERNATIONAL | | |

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| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 035. First use: First Use: 1999/01/31 First Use In Commerce: 1999/01/31 Retail jewelry stores and retail stores featuring diamonds, watches, and jewelry, namely, loose diamonds, necklaces, rings, bracelets, earrings, pins, cuff links and pendants in precious and semi-precious gemstones and metals, crystal products, namely, figurines, balls, vases, writing instruments, namely, pens and pencils, leather goods, namely, wallets, belts, business card holders, appointment books, attachÃ©s and briefcases, key chains |

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| Attachments | 78697343#TMSN.jpeg (1 page)(bytes) Pleading DID 10122010pdf.pdf (1 page)(24948 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 Overnight Courier on this date.

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| Signature | /Elchonon Shagalov/ |
| Name | Almod Diamonds Ltd. |
| Date | 12/10/2010 |

Standing

- 1 Almod Diamonds Ltd. as registrant of the mark “DI Diamonds International” has standing to oppose the new registration. Allowance of registration would severely damage the “DI Diamonds International” mark, because it would diminish its uniqueness in serving as an identifier for the services being offered in connection with it. Further, opposer’s priority rights as senior mark holder would be violated.

Legal Ground for Opposition

- 2 Legal ground for the opposition is section 2 (d) of the Lanham Act, Confusion, which constitutes a bar to registration of a new mark.
- 3 Presupposition for refusal of registration is, that the new mark consists of or comprises a mark which so resembles a previously federally registered and previously used mark and would, if used in connection with the specified services, likely lead to cause confusion, to cause mistake, or, to deceive customers.
- 4 Opposer has priority rights to the mark as senior mark holder. It has obtained federal registration on August 29, 2006 for the mark “DI Diamonds International” for class 035 and has continuously used the mark in commerce in that class since Januar 31, 1999. Moreover, opposer has actively built up recognition for the mark across the US and the world by constantly advertising and marketing the mark. As a result, it is widely recognized by consumers, not only in the US.
- 5 The new mark consists of the substantial parts of opposer’s mark, namely the letters “D” and “I”, which are easily recognizable parts of the mark as a whole. The senior mark is often referred to as “DI”, a fact which seems to have sparked the idea in the applicant to try to register its mark. In addition, the entirety of the new mark, “DID”, exactly reproduces the beginning of the already registered mark “DI D[...]”, which indicates bad faith intention on behalf of applicant.
- 6 Due to its resemblance and the filing in exactly the same class for exactly the same services, use of the filed for mark would certainly cause confusion and deceive customers with regards to the true origin of the services. In fact, consumers would most likely perceive the new mark mistakenly as belonging to the same corporation as the senior mark.
- 7 Conclusively, the requirements of Lanham Act 2 (d) are met and registration on the principal register for the new mark must be refused.