

ESTTA Tracking number: **ESTTA407137**

Filing date: **05/04/2011**

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	Luxottica Group S.p.A.
Granted to Date of previous extension	05/04/2011
Address	Via Cesare Cantu, 2 Milan, 20123 ITALY

Attorney information	Michael A. Grow Arent Fox LLP 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES henrye@arentfox.com, giuliani.chiara@arentfox.com, TMDocket@arentfox.com Phone:202 857 6389
----------------------	--

Applicant Information

Application No	85013734	Publication date	01/04/2011
Opposition Filing Date	05/04/2011	Opposition Period Ends	05/04/2011
Applicant	Luxautica, LLC 4190 Millenia Drive Orlando, FL 32839 UNITED STATES		

Goods/Services Affected by Opposition

Class 039. First Use: 2008/01/01 First Use In Commerce: 2008/01/01 All goods and services in the class are opposed, namely: Car sharing services, namely, providing temporary use of exotic cars for transportation purposes
Class 041. First Use: 2008/01/01 First Use In Commerce: 2008/01/01 All goods and services in the class are opposed, namely: Providing vehicle drive training simulators for educational and entertainment purposes; entertainment services in the nature of exhibitions for entertainment purposes featuring exotic cars and private car collections; entertainment services, namely, arranging, organizing and hosting private social entertainment events for members of a car club

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)

Other	abandonment
-------	-------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1254409	Application Date	04/22/1982
Registration Date	10/18/1983	Foreign Priority Date	NONE
Word Mark	LUXOTTICA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1971/00/00 First Use In Commerce: 1971/00/00 Eyeglasses, Sunglasses, Templates and Eyeglass Frames		

U.S. Registration No.	1511615	Application Date	02/19/1988
Registration Date	11/08/1988	Foreign Priority Date	NONE
Word Mark	LUXOTTICA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1975/00/00 First Use In Commerce: 1975/00/00 EYEGLASSES, SUNGLASSES, TEMPLES AND EYEGLASS FRAMES		

U.S. Registration No.	3239979	Application Date	09/23/2005
Registration Date	05/08/2007	Foreign Priority Date	09/21/2005
Word Mark	LUXOTTICA MEMORIZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: GLASSES, NAMELY, EYEGLASSES, SUNGLASSES, EYEGLASS LENSES, GLASS FRAMES AND THEIR PARTS; SCIENTIFIC, NAUTICAL, SURVEYING, PHOTO-GRAPHIC, CINEMATOGRAPHIC, OPTICAL, WEIGHING,		

	MEASURING, SIGNALING,CHECKING, SUPERVISION, LIFE-SAVING AND TEACHING APPARATUS AND INSTRUMENTS, NAMELY, SENSING AND SIGNALING DEVICES FOR MEASUREMENT AND QUALITY CONTROL OF MATERIALS PROCESSING BY LASER, SURVEYING MACHINES, CAMERAS; APPARATUS AND INSTRUMENTS FOR CONDUCTING,SWITCHING, TRANSFORMING, ACCUMULATING, REGULATING OR CONTROLLING ELECTRICITY, NAMELY, ELECTRICITY CONDUITS; APPARATUS FOR RECORDING,TRANSMISSION OR REPRODUCTION OF SOUND OR IMAGES; BLANK MAGNETIC DATA CARRIERS, BLANK RECORDING DISCS; AUTOMATIC VENDING MACHINES AND MECHANISMS FOR COIN-OPERATED APPARATUS, NAMELY, VENDING MA-CHINES WITH COIN-OPERATED MECHANISMS; CASH REGISTERS, CALCULATORS AND DATA PROCESSORS AND COMPUTERS; FIRE-EXTINGUISHERS
--	---

Attachments	73712067#TMSN.gif (1 page)(bytes) 79016783#TMSN.jpeg (1 page)(bytes) Luxautica.pdf (7 pages)(316323 bytes)
-------------	---

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	/Michael A. Grow/
Name	Michael A. Grow
Date	05/04/2011

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

In re Application No. 85013734 for the mark LUXAUTICA filed on April 14, 2010, and published on January 4, 2011

LUXOTTICA GROUP S.P.A.	:	
	:	
Opposer	:	
	:	
v.	:	Opp. No.
	:	
LUXAUTICA, LLC	:	
	:	
Applicant	:	

NOTICE OF OPPOSITION

Luxottica Group S.p.A. (“Opposer”), having an address of Via Cesare Cantù, 2 I-20123 Milan, Italy, believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of all right, title and interest in and to the famous mark and trade name LUXOTTICA, and the marks LUXOTTICA & Design and LUXOTTICA MEMORIZE & Design for eyewear (collectively, “Opposer's Mark”).

2. The Patent and Trademark Office has recognized Opposer’s exclusive right to use its Mark by issuing the following registrations: Registration No. 1254409, LUXOTTICA, issued on October 18, 1983; Registration No. 1511615, LUXOTTICA & Design, issued on November 8, 1988; and Registration No. 3239979, LUXOTTICA MEMORIZE & Design, issued on May 8, 2007.

3. The registrations are valid and subsisting, and Registration No. 1254409 and Registration No. 1511615 are incontestable. Accordingly, they provide conclusive evidence of Opposer's ownership of its Mark, and of its exclusive right to use said Mark in commerce.

4. Opposer is the world's leading designer, manufacturer and distributor of sunglasses, eyeglasses, frames and accessories. There are more than 5,800 optical and sunglass retail stores in North America, Asia-Pacific, China and Europe that sell Opposer's products.

5. Opposer owns numerous other marks including the world's leading brand for sunglasses and prescription eyewear, RAY-BAN and other well-known marks such as WAYFARER, REVO, PERSOL and ARNETTE.

6. Opposer's LUXOTTICA Mark has been used extensively in connection with a wide variety of sunglasses and eyeglasses.

7. Since long prior to the acts complained of herein, Opposer has continuously used its Mark directly or through its related companies for eyewear.

8. Opposer's Mark was first used at least as early as 1971 on or in connection with eyewear. Opposer's high quality products were very successful and Opposer's Mark quickly became well known and famous among members of the public as a distinctive indicator of Opposer's goods.

9. For many years, Opposer has promoted its products in the automotive field. For example, since at least as early as 2004, Opposer has jointly promoted its RAY-BAN products with The Honda Racing Formula 1 Team.

10. In addition, Luxottica's products have been publicized and promoted through prominent placement in dozens of movies and television programs.

11. Opposer's Mark is immediately identifiable as a fanciful designation that evokes images associated with luxury, high quality eyewear sold by Opposer or its related companies.

12. The popularity of Opposer's Mark has generated an extraordinary demand for merchandise bearing said mark. As a result, Opposer's Mark has become famous as a distinctive indicator of the origin of Opposer's goods and services and it is an extraordinarily valuable symbol of Opposer's goodwill.

13. Some of Applicant's products are sold in very high end boutiques in locations such as Rodeo Drive in Beverly Hills, California, and in Palm Beach Gardens, Florida.

14. Notwithstanding Opposer's prior rights in LUXOTTICA, Applicant filed the above referenced application for registration of LUXAUTICA, a counterfeit imitation of Opposer's mark, for car sharing services, namely, providing temporary use of exotic cars for transportation purposes; and providing vehicle drive training simulators for educational and entertainment purposes; entertainment services in the nature of exhibitions for entertainment purposes featuring exotic cars and private car collections; entertainment services, namely, arranging, organizing and hosting private social entertainment events for members of a car club.

15. Upon information and belief, Applicant made no use of its alleged mark in commerce prior to the date of first use alleged in its above referenced application.

16. Upon information and belief, if Applicant ever used its alleged mark, it has discontinued all such use with an intention not to resume use.

17. Upon information and belief, Applicant knew of or had reason to know of Opposer's famous Mark when Applicant filed its application.

LIKELIHOOD OF CONFUSION - §2(d)

18. The mark that Applicant seeks to register so resembles Opposer's Mark that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's Mark.

19. The services of Applicant are so related to the goods sold under Opposer's Mark, that the public is likely to be confused, to be deceived and to assume erroneously that Applicant's services are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage.

20. Likelihood of confusion in this case is enhanced by the extraordinary fame of Opposer's Mark, and by the fact that consumers associate said marks with goods sold, approved or endorsed by Opposer.

21. Likelihood of confusion in this case is enhanced by the fact that Applicant's alleged mark LUXAUTICA is nearly identical to Opposer's LUXOTTICA Mark, the pronunciation of Opposer's Mark and Applicant's alleged mark is identical, and the services listed in the opposed application are closely related to the products sold for decades under Opposer's Mark.

22. Likelihood of confusion is further enhanced by the fact that the parties' products are offered to the same classes of purchasers.

23. Likelihood of confusion is further enhanced by the fact that Opposer has manufactured products for companies and designers that are well known in the automotive field.

DECEPTION/FALSE SUGGESTION OF CONNECTION - §2(a)

24. Applicant's alleged mark so closely resembles Opposer's Mark that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the goods, purchasers are likely to believe that the misdescription actually describes the nature or origin of the services, and this is likely to materially alter purchasers' decisions to acquire Applicant's services.

25. Applicant's alleged mark so closely resembles Opposer's Mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that goods offered under Applicant's alleged mark are connected with Opposer.

DILUTION - §43(c)

26. For many years, Opposer's Mark has been widely used in the United States and, therefore, the name and mark have become well known and famous as distinctive symbols of Opposer's goodwill.

27. On information and belief, Applicant intends to use its alleged mark in commerce with the willful intent to trade on Opposer's reputation or to cause dilution of Opposer's famous Mark.

28. Opposer's Mark was well known and famous before Applicant used or applied to register its alleged mark.

29. The mark shown in Applicant's application will cause dilution of the distinctive quality of Opposer's Mark.

30. Use or registration of Applicant's alleged mark will lessen the capacity of Opposer's famous Mark to identify and distinguish Opposer's goods and services.

31. Use and registration of Applicant's alleged mark will deprive Opposer of the ability to protect its reputation, persona and goodwill.

32. Applicant's use or registration of its alleged mark for the goods listed in its application will tarnish the goodwill symbolized by Opposer's Mark.

33. Likelihood of tarnishment and damage to Opposer's goodwill is enhanced by the fact that prospective customers who are dissatisfied with or encounter defects in the quality of Applicant's services will attribute those defects to Opposer.

ABANDONMENT

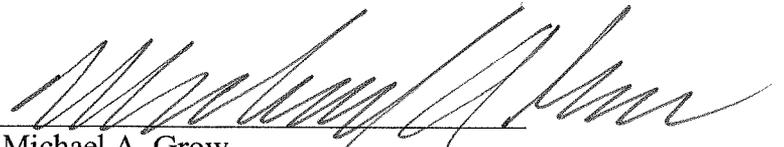
34. Registration of Applicant's alleged mark should be denied because Applicant has discontinued use of its alleged mark with an intent not to resume use.

35. Any rights in the alleged mark LUXAUTICA that Applicant might have claimed have been abandoned.

36. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's alleged mark and registration should be refused.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

LUXOTTICA GROUP S.P.A.

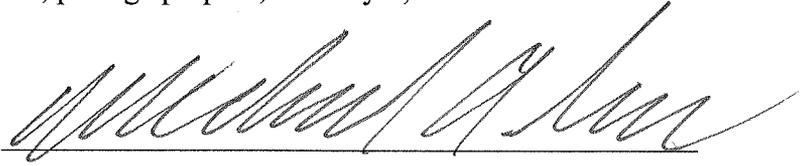
By 

Michael A. Grow
Chiara Giuliani
ARENT FOX LLP
1050 Connecticut Avenue, NW
Washington, DC 20036
Telephone: (202) 857-6000
Attorneys for Opposer

May 4, 2011

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing has been served upon Applicant's counsel Jeanne L. Seewald of Hahn Loeser & Parks LLP at Suite 600, 800 Laurel Oak Drive, Naples, Florida 34108 by first class mail, postage prepaid, on May 4, 2011.

A handwritten signature in black ink, appearing to read "Michael J. Seewald", is written over a horizontal line.