

ESTTA Tracking number: **ESTTA417499**

Filing date: **07/01/2011**

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	Hearst Communications, Inc.
Granted to Date of previous extension	07/03/2011
Address	300 W. 57th Street New York, NY 10019 UNITED STATES

Attorney information	Bridgette Fitzpatrick Hearst Communications, Inc. 300 W. 57th Street - Office of General Counsel New York, NY 10019 UNITED STATES trademarks@hearst.com Phone:212-649-2059
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Applicant Information

Application No	85136870	Publication date	01/04/2011
Opposition Filing Date	07/01/2011	Opposition Period Ends	07/03/2011
Applicant	Samsonite IP Holdings S.À r.l. 20, Avenue Monterey Luxembourg, L-2163 LUXEMBOURG		

Goods/Services Affected by Opposition

Class 018. First Use: 2008/11/00 First Use In Commerce: 2008/11/00 All goods and services in the class are opposed, namely: Luggage
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Grounds for Opposition

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.	630028	Application Date	08/10/1955
Registration Date	07/03/1956	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U038 (International Class 016). First use: First Use: 1886/03/00 First Use In Commerce: 1886/03/00 MAGAZINE OR PERIODICAL PUBLISHED MONTHLY OR AT OTHER INTERVALS

U.S. Registration No.	1911389	Application Date	08/31/1994
Registration Date	08/15/1995	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1994/07/01 First Use In Commerce: 1994/07/01 books of general interest		

U.S. Registration No.	2518660	Application Date	01/20/1999
Registration Date	12/11/2001	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1997/11/00 First Use In Commerce: 1997/11/00 COMPUTER SERVICES, NAMELY PROVIDING AN INTERACTIVE ON-LINE COMPUTER DATABASE FEATURING PORTIONS OF VARIOUS MAGAZINES AND ARTICLES AND ILLUSTRATIVE MATERIALS IN THE FIELDS OF PERSONAL RELATIONSHIPS, BEAUTY AND FASHION, HEALTH AND FITNESS, PERSONAL HYGIENE, STARS AND ENTERTAINMENT NEWS, AND LIFE AND WORK, RENDERED BY MEANS OF A GLOBAL COMPUTER NETWORK		

U.S. Registration No.	3372644	Application Date	06/01/2007
Registration Date	01/22/2008	Foreign Priority Date	NONE
Word Mark	COSMO		

Design Mark	<h1>COSMO</h1>		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2007/05/08 First Use In Commerce: 2007/05/08 Magazines featuring information on women's services, beauty, health, and human relationships		

U.S. Registration No.	3791802	Application Date	03/22/2007
Registration Date	05/25/2010	Foreign Priority Date	NONE

Word Mark	COSMO
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Design Mark	<h1>COSMO</h1>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2002/03/29 First Use In Commerce: 2002/03/29 PUBLICATION OF ELECTRONIC MAGAZINE PORTIONS AND PUBLICATION OF ELECTRONIC MAGAZINE ARTICLES AND ILLUSTRATIVE MATERIALS IN THE FIELDS OF PERSONAL RELATIONSHIPS, BEAUTY AND FASHION, HEALTH AND FITNESS, AND PERSONAL HYGENE		

U.S. Registration No.	2969534	Application Date	04/29/2004
Registration Date	07/19/2005	Foreign Priority Date	NONE

Word Mark	COSMO QUIZ
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Design Mark	COSMO QUIZ		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1997/05/00 First Use In Commerce: 1997/05/00 section of a magazine featuring topics such as relationships		

U.S. Registration No.	3346423	Application Date	02/21/2007
Registration Date	11/27/2007	Foreign Priority Date	NONE
Word Mark	COSMO COMMANDMENTS		
Design Mark	COSMO COMMANDMENTS		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2001/11/30 First Use In Commerce: 2001/11/30 MAGAZINE DEPARTMENTS IN THE FIELD OF ADVICE FOR RELATIONSHIPS, HEALTH, FITNESS, BEAUTY, AND FINANCE, PUBLISHED MONTHLY AND AT OTHER PERIODIC INTERVALS		

U.S. Registration No.	3342296	Application Date	02/26/2007
Registration Date	11/20/2007	Foreign Priority Date	NONE
Word Mark	COSMO HAIR		

Design Mark	<h1>COSMO HAIR</h1>		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2001/02/28 First Use In Commerce: 2001/02/28 Magazine departments in the field of FASHION, BEAUTY, BEAUTY PRODUCT REVIEWS, AND CELEBRITY NEWS, PUBLISHED MONTHLY AND AT OTHER PERIODIC INTERVALS		

U.S. Registration No.	3342295	Application Date	02/23/2007
Registration Date	11/20/2007	Foreign Priority Date	NONE

Word Mark	COSMO GYNO		
Design Mark	<h1>COSMO GYNO</h1>		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2001/01/31 First Use In Commerce: 2001/01/31 Magazine departments in the field of HEALTH, AND FITNESS PUBLISHED MONTHLY AND AT OTHER PERIODIC INTERVALS		

U.S. Registration No.	3346425	Application Date	02/22/2007
Registration Date	11/27/2007	Foreign Priority Date	NONE
Word Mark	COSMO WEEKEND		

Design Mark	COSMO WEEKEND		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2001/01/31 First Use In Commerce: 2001/01/31 MAGAZINE DEPARTMENTS IN THE FIELD OF ENTERTAINMENT, BEAUTY, HEALTH, HUMAN RELATIONSHIPS, PUBLISHED MONTHLY AND AT OTHER PERIODIC INTERVALS		

U.S. Registration No.	3694454	Application Date	05/28/2009
Registration Date	10/06/2009	Foreign Priority Date	NONE

Word Mark	COSMO MEN		
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Design Mark	COSMO MEN		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2003/12/01 First Use In Commerce: 2003/12/01 Magazine sections in the field of relationships, beauty, fitness, and entertainment published yearly and/or at other periodic intervals		

U.S. Registration No.	3414487	Application Date	09/28/2007
Registration Date	04/22/2008	Foreign Priority Date	NONE

Word Mark	COSMO MOBILE		
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Design Mark	COSMO MOBILE		
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 2006/01/09 First Use In Commerce: 2006/01/09 Communications by mobile phones; Mobile media services in the nature of electronic transmission of entertainment media content; Wireless communications services, namely, transmission of graphics to mobile telephones		

U.S. Registration No.	3414488	Application Date	09/28/2007
Registration Date	04/22/2008	Foreign Priority Date	NONE
Word Mark	COSMO KISSES		
Design Mark	COSMO KISSES		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2007/05/22 First Use In Commerce: 2007/05/22 Entertainment services, namely, providing on-line computer games		

U.S. Registration No.	3414485	Application Date	09/28/2007
Registration Date	04/22/2008	Foreign Priority Date	NONE
Word Mark	COSMOLICIOUS		

Design Mark	<h1>COSMOLICIOUS</h1>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2007/05/22 First Use In Commerce: 2007/05/22 Providing on-line publications in the nature of magazines featuring photos, video, and prose in the field of personal relationships, beauty and fashion, health and fitness, celebrity news, and personal hygiene		

U.S. Registration No.	3731391	Application Date	06/08/2009
Registration Date	12/29/2009	Foreign Priority Date	NONE

Word Mark	COSMO BACHELORS		
Design Mark	<h1>COSMO BACHELORS</h1>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2007/05/30 First Use In Commerce: 2007/05/30 Entertainment services, namely, conducting contests; Entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring personal relationships, beauty and fashion, health and fitness, and humor		

U.S. Application No.	85088202	Application Date	07/20/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	LOVE COSMO X		

Design Mark	LOVE COSMO X		
Description of Mark	NONE		
Goods/Services	Class 018. First use: Cosmetic carrying cases sold empty; Handbags; Luggage; Luggage tags; Reusable shopping bags		

U.S. Registration No.	1448513	Application Date	11/24/1986
Registration Date	07/21/1987	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1986/10/28 First Use In Commerce: 1986/10/28 TOTE BAGS		

U.S. Registration No.	3335656	Application Date	01/23/2004
Registration Date	11/13/2007	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark	COSMOPOLITAN		
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 2007/06/01 First Use In Commerce: 2007/06/01 cosmetic brushes		

Attachments	77195652#TMSN.jpeg (1 page)(bytes) 77137373#TMSN.jpeg (1 page)(bytes) 76589302#TMSN.gif (1 page)(bytes)
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	77112303#TMSN.jpeg (1 page)(bytes) 77116031#TMSN.jpeg (1 page)(bytes) 77114876#TMSN.jpeg (1 page)(bytes) 77113826#TMSN.jpeg (1 page)(bytes) 77746634#TMSN.jpeg (1 page)(bytes) 77291126#TMSN.jpeg (1 page)(bytes) 77291131#TMSN.jpeg (1 page)(bytes) 77291121#TMSN.jpeg (1 page)(bytes) 77754029#TMSN.jpeg (1 page)(bytes) 85088202#TMSN.jpeg (1 page)(bytes) 76572404#TMSN.gif (1 page)(bytes) S35C-111070111180.pdf (8 pages)(1782800 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	/Bridgette Fitzpatrick/
Name	Bridgette Fitzpatrick
Date	07/01/2011

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

HEARST COMMUNICATIONS, INC.,)	
)	In re Serial No. 85/136,870
Opposer,)	
)	
)	Mark: COSMOLITE
vs.)	
)	Opposition No. _____
Samsonite IP Holdings S.à r.l.)	
)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

Opposer Hearst Communications, Inc. will be damaged by the registration of the COSMOLITE Application Serial No. 85/136,870 and states the following for its Notice of Opposition:

1. Opposer Hearst Communications, Inc. ("HCI") is a Delaware corporation with a principal place of business at 300 West 57th Street, New York, New York 10019. HCI is a subsidiary of The Hearst Corporation, one of the world's largest diversified media companies. Among its other activities, HCI is a publisher of magazines and other printed materials and a provider of online content.

2. Beginning in 1886, more than a century prior to the September 23, 2010 filing date of Applicant's application, HCI's predecessors-in-interest began using the COSMOPOLITAN mark in connection with a magazine. Each issue of COSMOPOLITAN magazine contains

candid discussions of a variety of “lifestyle” issues, including discussions of beauty, cosmetics, fashion, and other related topics.

3. For more than 120 years, HCI and its predecessors have invested a substantial amount of time, effort, and money in promoting the internationally famous and well-known COSMOPOLITAN magazine. COSMOPOLITAN magazine has consistently been one of the top 20 selling magazines in the United States and one of the top 5 selling women’s magazines. COSMOPOLITAN magazine has a monthly paid circulation of over 2,900,000 and an estimated readership in the United States of over 15,000,000. It has 63 international editions, is published in 32 languages and is distributed in more than 100 countries, making it the largest monthly magazine franchise in the world.

4. HCI’s COSMOPOLITAN mark is subject to Registration Nos. (i) 630,028, issued July 3, 1956, for a “magazine or periodical published monthly or at intervals” in International Class 16 (this registration is incontestable); (ii) 1,911,389, issued August 15, 1995, for “books of general interest” in International Class 16 (this registration is incontestable). Since 1996, more than a decade prior to the December 8, 2009 filing date of Applicant’s application, HCI has been distributing its copyrighted magazine content, including the content contained in COSMOPOLITAN magazine, via the popular web site www.cosmopolitan.com. Hearst maintains a number of websites, including www.cosmopolitan.com.

5. HCI’s COSMOPOLITAN.COM mark is subject to Registration No. 2,518,660, issued December 11, 2001 (this registration is incontestable), for “computer services, namely interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and

fitness, personal hygiene, stars and entertainment news and life and work, rendered by means of a global computer network” in International Class 42.

6. References to HCI’s registered COSMOPOLITAN mark are often abbreviated by HCI and by the public to COSMO. Since 1964, more than 45 years prior to the September 23, 2010 filing date of Applicant’s application, HCI has used the COSMO mark in its COSMOPOLITAN magazine.

7. HCI has obtained Registrations for COSMO the subject of Registration Nos. (i) 3,372,644, issued January 22, 2008 for “magazines featuring information on women's services, beauty, health, and human relationships” in International Class 16; and subject of Registration No. (ii) 3,791,802, issued May 25, 2010 for “publication of electronic magazine portions and publication of electronic magazine articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, and personal hygiene” in International Class 41.

8. HCI is the owner of many marks featuring the element COSMO, such as the following:

- COSMO QUIZ, Registration No. 2,969,534 with a first use date of May 1, 1997 in International Class 16;
- COSMO COMMANDMENTS Registration No. 3,346,423 with a first use date of November 30, 2001 in International Class 16;
- COSMO HAIR Registration No. 3,342,296 with a first use date of February 28, 2001 in International Class 16;
- COSMO GYNO Registration No. 3,342,295 with a first use date of January 31, 2001 in International Class 16;

- COSMO WEEKEND Registration No. 3,346,425 with a first use date of January 31, 2001 in International Class 16;
- COSMO MEN Registration No. 3,694,454 with a first use date of December 1, 2003 in International Class 16;
- COSMO MOBILE Registration No. 3,414,487 with a first use date of January 9, 2006 in International Class 38;
- COSMO KISSES Registration No. 3,414,488 with a first use date of May 22, 2007 in International Class 41;
- COSMOLICIOUS Registration No. 3,414,485 with a first use date of February 22, 2007 in International Class 41;
- COSMO BACHELORS Registration No. 3,731,391 with a first use date of May 30, 2007 in International Class 41.

9. Over the years the fame and popularity of COSMO and COSMOPOLITAN has extended into other media platforms, such as COSMO RADIO channel on SiriusXM which launched in 2006, COSMO TV, COSMO MOBILE (US Registration No. 3,414,487), various COSMO and COSMOPOLITAN books; and several smart phone applications.

10. In addition, over the years Hearst has extended its use of COSMO and COSMOPOLITAN into merchandising classes to include handbags, sunglasses, apparel, jewelry, and watches which include the following: .

- LOVE COSMO X, Application Serial No. 85/088,202 in Class 18
- COSMOPOLITAN Registration No. 1,448,513 with a first use date of October 28, 1986 in Class 18

- COSMOPOLITAN Registration No. 3,335,656 with a first use date of June 1, 2007 in Class 21

11. Taken together, HCI's marks based on the elements COSMO and COSMOPOLITAN constitute a family of marks. Beginning over a hundred and twenty years ago, HCI and its predecessors have expended considerable sums of money into developing consumer brand recognition for its family of COSMO and COSMOPOLITAN marks.

12. As a result of widespread advertising and promotion by HCI and its predecessors, the marks making up HCI's family of COSMO and COSMOPOLITAN marks acquired a high degree of recognition, fame, and distinctiveness as symbols of the high quality products and services offered by HCI prior to the September 23, 2010 filing date of Applicant's application. The public and trade are familiar with and identify HCI's marks with HCI and, by reason of this identification, goods and services associated with the marks are understood by the public and trade to be produced, marketed, and supplied under HCI's authority, or otherwise derived from HCI.

13. The marks making up HCI's family of COSMO and COSMOPOLITAN marks are important factors employed by the public in identifying the source of HCI's products and services and are distinctive of those products and services. As a result of their fame and notoriety, HCI's marks are entitled to a broad scope of protection.

14. On September 23, 2010, Applicant filed an Application Serial No. 85/136,870 to register COSMOLITE on the Principal Register for "luggage" in International Class 41.

15. The word COSMO in the mark that Applicant seeks to register is identical in appearance, sound, meaning, and commercial impression to the salient element of HCI's

COSMO marks, and will be used for services related those used in connection with HCI's COSMO and COSMOPOLITAN family of marks.

16. Based on the similarities of the marks and the services, the relevant public is likely to be confused into believing that Applicant's services, as offered under the COSMOLITE mark, emanate from HCI, or are authorized, licensed, endorsed, or sponsored by HCI. Registration of Applicant's COSMOLITE mark on the Principal Register thus would be inconsistent with HCI's prior rights in its family of well-known COSMO and COSMOPOLITAN marks.

17. HCI will be damaged by the registration of Applicant's COSMOLITE mark because it so resembles HCI's previously used and well-known marks as to be likely, when used on or in connection with Applicant's goods identified in the subject application, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052.

18. HCI will be damaged by the registration of Applicant's COSMOLITE mark because the mark is likely to dilute the distinctiveness of the famous marks making up HCI's family of COSMO and COSMOPOLITAN marks by eroding consumers' exclusive identification of these marks with HCI, and/or by otherwise lessening the capacity of the marks to identify and distinguish HCI's goods and services in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

19. HCI therefore requests that registration of the mark underlying Application Serial No. 85/136,870 be refused, and this Notice of Opposition be sustained in HCI's favor.

This 3rd day of July 2011

Respectfully submitted,

/Bridgette Fitzpatrick/

HEARST COMMUNICATIONS, INC.

300 West 57th Street

New York NY 10019

Bfitzpatrick@hearst.com

(212) 649-2059 (telephone)

(646) 280-2059 (facsimile)

Attorney for Opposer

CERTIFICATE OF SERVICE

This is to certify that the attached Notice of Opposition has been served upon Applicant's filing correspondent by depositing a copy in the United States mail as first class mail, postage pre-paid, addressed as follows:

Lisa A. Osman
Dorsey & Whitney LLP
IP Department
1400 Wewatta Street; Suite 400
Denver CO 80202

This 3rd day of July 2011



Samantha Favitta