

ESTTA Tracking number: **ESTTA429264**

Filing date: **09/07/2011**

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	PRL USA Holdings, Inc.
Granted to Date of previous extension	09/07/2011
Address	550 Seventh Avenue New York, NY 10018 UNITED STATES

Correspondence information	G. Roxanne Elings Greenberg Traurig, LLP 200 Park Avenue New York, NY 10166 UNITED STATES nytmdkt@gtlaw.com, elingsr@gtlaw.com, falbyo@gtlaw.com, biancoc@gtlaw.com Phone: 212.801.9200
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Applicant Information

Application No	78599321	Publication date	05/10/2011
Opposition Filing Date	09/07/2011	Opposition Period Ends	09/07/2011
Applicants	OLEMBERG, FABIAN CLAUDIO La Pampa 2326, Piso 2, Of. 205 Buenos Aires, Capital Federal, 1428 ARGENTINA TASCA, VICENTE La Pampa 2326, Piso 2, Of. 205 Buenos Aires, Capital Federal, 1428 ARGENTINA		

Goods/Services Affected by Opposition

Class 034. All goods and services in the class are opposed, namely: cigar and cigarette holders not made from precious metals; cigar boxes, not made from precious metals; cigar boxes with humidifiers in the nature of cigars humidifiers, ashtrays for smokers not made from precious metals; cigarette boxes not made from precious metals; matches; cigarettes; pure cigars, namely, tobacco; cigarette paper; tobacco smoking pipes; pipe supports for tobacco pipes; rappee, tobacco cases
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Grounds for Opposition

Dilution	Trademark Act section 43(c)
Other	lack of bona fide intent

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	276855	Application Date	05/31/1930
Registration Date	10/28/1930	Foreign Priority Date	NONE
Word Mark	POLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1913/04/16 First Use In Commerce: 1913/04/16 COLLARS		

U.S. Registration No.	1363459	Application Date	10/19/1981
Registration Date	10/01/1985	Foreign Priority Date	NONE
Word Mark	POLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1967/05/00 First Use In Commerce: 1967/05/00 Clothing-Namely, Suits, Slacks, Trousers, Shorts, Wind Resistant Jackets, Jackets, Blazers, Dress Shirts, Sweatshirts, Sweaters, Hats, Belts, Socks, Blouses, Skirts, Coats, and Dresses		

U.S. Registration No.	1468420	Application Date	04/13/1987
Registration Date	12/08/1987	Foreign Priority Date	NONE
Word Mark	POLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1971/00/00 First Use In Commerce: 1971/00/00 MEN'S, WOMEN'S, CHILDREN'S AND ATHLETIC SHOES		

U.S. Registration No.	1532557	Application Date	03/14/1988
Registration Date	04/04/1989	Foreign Priority Date	NONE
Word Mark	POLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1974/07/19 First Use In Commerce: 1974/07/19 [NON-MEDICATED TOILET PREPARATIONS, NAMELY, [BATH SALTS,] TALCUM POWDER, [FACE POWDER,] FACE CREAM, [SCALP STIMULATING PREPARATIONS,] AND] LOTIONS FOR USE AFTER		

	SHAVING; [COSMETIC PREPARATIONS, NAMELY, LIPSTICK; BRILLIANTINE, HAIR LOTION, SHAMPOOS, DENTIFRICES,] [SOAPS,] PERFUMES [, AND ESSENTIAL OILS]
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U.S. Registration No.	3684457	Application Date	12/07/2004
Registration Date	09/15/2009	Foreign Priority Date	NONE
Word Mark	POLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 026. First use: First Use: 1989/07/00 First Use In Commerce: 1989/07/00 Metal belt buckles not of precious metal		

U.S. Registration No.	1446173	Application Date	11/14/1986
Registration Date	07/07/1987	Foreign Priority Date	NONE
Word Mark	POLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1972/09/00 First Use In Commerce: 1972/09/00 FRAMES FOR PRESCRIPTION AND NON-PRESCRIPTION LENSES AND COMPLETE SUNGLASSES		

Attachments	78528483#TMSN.jpeg (1 page)(bytes) Libra POLO Not of opp.pdf (10 pages)(154301 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	/GRE/
Name	G. Roxanne Elings
Date	09/07/2011

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

In re: Application Ser. No. 78599321



Mark:

Published: May 10, 2011

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PRL USA HOLDINGS, INC.,

NOTICE OF OPPOSITION

Opposer,

-against-

FABIAN CLAUDIO OLEMBERG

Applicant.

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PRL USA Holdings, Inc. (“PRL” or “Opposer”) believes that it will be damaged by the registration of the above-identified trademark and hereby opposes the registration thereof:

FACTS

1. Upon information and belief, Applicants Fabian Claudio Olemberg (“Olemberg”) and Vincente Tasca (“Tasca”) (Olemberg and Tasca are collectively referred to hereinafter as “Applicant”) are individuals and citizens of Argentina, residing at and or having a place of business located at La Pampa 2326, Piso 2, Of. 205, Buenos Aires, Capital Federal, Argentina 1428.

2. On or about March 31, 2005, Applicant filed Trademark Application Serial No. 78599321 (the “Application”), pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. §1051(b) to

registration of the mark  (“Applicant’s Mark”).

3. On or about May 10, 2011, Applicant's Mark was published for opposition in the Official Trademark Gazette for the following goods. "cigar and cigarette holders not made from precious metals; cigar boxes, not made from precious metals; cigar boxes with humidifiers in the nature of cigars humidifiers, ashtrays for smokers not made from precious metals; cigarette boxes not made from precious metals; matches; cigarettes; pure cigars, namely, tobacco; cigarette paper; tobacco smoking pipes; pipe supports for tobacco pipes; rappee, tobacco cases in International Class 34.

4. Upon information and belief, Applicant had not commenced use of Applicant's Mark in commerce in connection with the goods identified in the Notice of Publication.

5. PRL is a corporation organized and existing under the laws of the state of Delaware, having a place of business at 550 Seventh Avenue New York, NY 10018.

6. PRL is engaged in the manufacture, promotion and distribution of premium lifestyle products in apparel, home, accessories and fragrances.

7. For more than forty (40) years, PRL's reputation and distinctive image have been consistently developed across an expanding number of products and international markets.

8. As a result, PRL has become one of the top ten largest and most successful apparel companies in the United States.

9. PRL is the owner of several trademarks that incorporate the famous and inherently distinctive trademark, POLO, (the "POLO Trademarks" or "Opposer's Marks").

10. The POLO Trademarks are the subject of the numerous valid and subsisting United States trademark registrations and applications, many of which have become incontestable. A schedule of POLO Trademarks is attached hereto as Exhibit A.

11. PRL markets and sells goods bearing the POLO Trademarks throughout the world and in the United States from approximately 200 PRL retail stores, as well as most major

department and fine retail stores, including Bloomingdale's, Saks, Nordstrom's, Bergdorf Goodman, Macy's, Lord & Taylor, Belk, Dillard's, and Neiman Marcus.

12. PRL also sells its goods on its website located at <www.ralphlauren.com> (the "PRL Website"), and through other online retailers, including, but not limited to, Nordstroms.com, Macys.com and Bloomingdales.com.

13. For over 40 years PRL has built its brands based on quality, success, integrity and a wholesome American lifestyle. PRL's advertisements are specifically designed to evoke these qualities and feature, *inter alia*, clean cut models and children engaged in healthy activities. As a result, PRL and the symbols and marks that are used to identify its goods in the market place have become an American phenomenon in the same vein as apple pie and baseball. PRL has made a substantial investment solidifying this image in the public square in the promotion of its goods that bear the POLO Trademarks.

14. In the course of becoming one of the most recognized brands in the United States, PRL has expended significant resources to protect the strength, goodwill and value of the POLO Trademarks.

15. PRL has expended significant time, effort, and money in advertising and promoting the goods and services sold under the POLO Trademarks in trade publications, magazines of general circulation, television ads, billboards, and the internet, as well as, through sports events sponsorship and authorized retailers.

16. PRL's goods and services marketed under the POLO Trademarks have enjoyed widespread and unsolicited media coverage, in print, on television and the Internet. PRL and its founder, Ralph Lauren, have received consistent recognition for the exceptional quality and design of the goods that bear the POLO Trademarks -- which has heightened consumer awareness of PRL's goods and their quality.

17. PRL's use of the POLO Trademarks predates Opposer's use of Opposer's Mark in commerce.

COUNT I
DILUTION

18. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 17 herein.

19. Through PRL's extensive advertisement and promotion and substantial sales, Opposer's Marks have become famous.

20. Any use in commerce by Applicant of Applicant's Mark has occurred after Opposer's Marks became famous.

21. Relevant consumers are likely to make an association between Applicant's Mark and Opposer's Marks.

22. Applicant's Mark is likely to impair the distinctiveness of Opposer's Marks.

23. Applicant's Mark is likely to blur and/or tarnish the positive associations of the Opposer's Marks.

24. Thus, Applicant's registration and or use of Applicant's Mark is likely to cause dilution of the distinctive quality of the Opposer's Marks, pursuant to Section 43 of the Lanham Act, 15 U.S.C. § 1125(c).

COUNT III
LACK OF BONA FIDE INTENT

25. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 24 herein.

26. Upon information and belief, Applicant did not have a bona fide intent to use Applicant's Mark in connection with the goods identified in the Application, on the date that Applicant filed the Application.

27. The Application is therefore void, *ab initio*, pursuant to 15 U.S.C. §1051(b) and the Application should be refused accordingly.

W H E R E F O R E, Opposer prays that, the Board sustain the Opposition and refuse the registration of Applicant's Mark

Dated: New York, New York
September 7, 2011

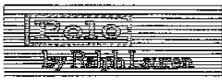
Respectfully submitted,

GREENBERG TRAURIG, LLP

By: /GRE/
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EXHIBIT A

Mark	App. No. Reg. No.	App. Date Reg. Date	Goods
POLO	0276855	October 28, 1930	Collars.
POLO	1,363,459	October 1, 1985	Clothing-namely, suits, slacks, trousers, shorts, wind resistant jackets, jackets blazers, dress shirts, sweat shirts, sweaters, hats, belts, socks, blouses, skirts, coats and dresses
POLO	1,468,420	December 8, 1987	Men's women's and children's athletic shoes
POLO	1532557	April 4, 1989	After shave lotion and perfumes
POLO	3684457	September 15, 2009	Metal belt buckles not of precious metal.
	1212059	October 12, 1982	Cologne, Aftershave, Aftershave Balm, Antiperspirant, Toilet Soap
	3810821	June 29, 2010	eau de toilette and after shave.
POLO  RALPH LAUREN	3306101	October 9, 2007	Clothing, namely, knit shirts, polo shirts, sweaters, shirts, t-shirts, hats, swimwear, pants, jackets, belts, ties, footwear, socks; outerwear, namely, coats, sport coats, raincoats.
POLO  RALPH LAUREN	2077082	July 8, 1997	Grooming kits sold empty, tie cases, coin purses, drawstring pouches, wallets and key cases.
POLO	1446173	July 7, 1987	Frames for prescription and non-prescription lenses and complete sunglasses
POLO RALPH LAUREN	3733341	January 5, 2010	Sweaters, shirts, sweatshirts, pants, shorts, jackets, coats, vests, hats, scarves, gloves, belts, ties, underwear, socks, shoes, sneakers, boots. sleepwear, robes, men's suits.
POLO RALPH LAUREN	3305655	October 9, 2007	Frames for prescription and non-prescription lenses and complete sunglasses

Mark	App. No. Reg. No.	App. Date Reg. Date	Goods
POLO BEAR BY RALPH LAUREN	1,742,330	December 22, 1992	Sweaters, shirts, t-shirts, fleecewear; namely, sweatshirts, sweatpants and sweatshorts, jackets, scarves, bandanas, hats, swimwear, robes and sleepwear
	1,508,314	October 11, 1988	Men's suits, slacks, ties, sweaters, jackets, coats, shoes, shirts, hats, belts and socks and ladies' blouses, skirts, suits and dresses
	978,166	February 5, 1974	Mens' suits, slacks, ties, sweaters, shoes, shirts, hats, belts, socks; and ladies' blouses, skirts, suits and dresses
POLO GOLF	2,686,291	February 11, 2003	Wearing apparel, namely shirts, sweaters, pants, sweatshirts and t-shirts
POLO JEANS CO.	2,049,948	April 1, 1997	Wearing apparel; namely, jeans, t-shirts, knit shirts, sweatshirts, overalls, blouses, skirts, dresses and hats
POLO RALPH LAUREN	1,935,665	November 14, 1995	Infants and children's clothing, namely, layettes, bibs, slippers, sleepwear, underwear, rompers, shorts, shirts, coveralls, pants, socks and booties
POLO SPORT	1,951,601	January 23, 1996	Wearing apparel, namely, pants, shorts, jackets, t-shirts, sport shirts, knit shirts, sweatshirts, hats, socks and footwear
POLO TENNIS	3,066,068	March 7, 2006	Wearing apparel, namely, tennis wear, tennis shoes, shorts, pants, shirts, t-shirts, tank tops, jerseys, body suits, socks, gloves, skirts, jackets, coats, ponchos, swimwear, sweaters, fleece pullovers, sweat suits, jogging suits, rain suits, hats, caps, head bands, wrist bands, slacks, jeans, belts, suspenders, ties, undergarments, scarves, shawls, robes, sleepwear, loungewear and footwear
POLO	2,083,276	July 29, 1997	Providing information in the field of fashion, fragrance, lifestyle and other topics of general interest by means of a global network
POLO BY RALPH LAUREN	0990395	August 6, 1974	Retail clothing store services

Mark	App. No. Reg. No.	App. Date Reg. Date	Goods
POLO COUNTRY STORE	1,674,639	February 4, 1992	Retail clothing store services
POLO RALPH LAUREN and Design	3,306,101	October 9, 2007	Clothing, namely, knit shirts, polo shirts, sweaters, shirts, t-shirts, hats, swimwear, pants, jackets, belts, ties, footwear, socks; outerwear, namely, coats, sport coats, raincoats
POLO SPORT	2,083,277	July 29, 1997	Providing information in the field of fashion, fragrance, lifestyle and other topics of general interest by means of a global computer network
POLO SPORT	2857837	June 29, 2004	Handbags
CAMP POLO	3452078	June 24, 2008	Retail store services and online retail store services featuring clothing and fashion accessories.
BABY'S FIRST POLO	3711116	November 17, 2009	Shirts
POLO BEAR	1745274	January 5, 1993	stuffed toys and clothing and accessories for stuffed toys
POLO BLUE	2782617	November 11, 2003	Eau de toilette, after shave gel, shower gel, and personal deodorant
POLO BLACK	3130913	August 15, 2006	Eau de toilette, after shave splash, after shave gel, shower gel, personal deodorant.
POLO DOUBLE BLACK	3486443	August 12, 2008	After shave gel, personal deodorant, hair and body wash
POLO DOUBLE BLACK	3278057	August 7, 2007	Eau de toilette and after shave splash
POLO EXPLORER	3534693	November 18, 2008	Personal deodorant
POLO EXPLORER	3427963	May 13, 2008	Eau de toilette, after shave splash, after shave gel, bath and shower gel.
POLO RALPH LAUREN BLUE	2728055	June 17, 2003	Eau de toilette, after shave lotions, personal deodorants and shower gel.

Mark	App. No. Reg. No.	App. Date Reg. Date	Goods
POLO RALPH LAUREN BLUE	2854769	June 15, 2004	Body moisturizer, personal soap, and hair shampoo
POLO SPORT	1858094	October 11, 1994	Toilette water, after shave, shaving balm, skin cream, shaving gel, body soap, face moisturizer, deodorants
POLO TRAVEL	2498029	October 16, 2001	Travel agency services, namely making reservations and bookings for transportation; travel agency services, namely, making reservations and booking for temporary lodging.