

ESTTA Tracking number: **ESTTA459152**

Filing date: **02/29/2012**

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	Vanity Fair, Inc.
Granted to Date of previous extension	02/29/2012
Address	One Fruit of the Loom Drive Legal Department Bowling Green, KY 42103 UNITED STATES

Attorney information	Carrie Shufflebarger Thompson Hine, LLP 312 Walnut Street Fourteenth Floor Cincinnati, OH 45202 UNITED STATES carrie.shufflebarger@thompsonhine.com, sharon.bella@thompsonhine.com, docket@thompsonhine.com, ipdocket@thompsonhine.com, lou.ebling@thompsonhine.com Phone:513.352.6678
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Applicant Information

Application No	85343030	Publication date	11/01/2011
Opposition Filing Date	02/29/2012	Opposition Period Ends	02/29/2012
Applicant	The Vanity Project LLC Suite 3202 1130 N Dearborn St. Chicago, IL 60610 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Hats; Jackets; Pants; Shirts; Shoes; Short-sleeved or long-sleeved t-shirts; Socks; Sweatshirts; T-shirts; Underwear

Grounds for Opposition

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

U.S. Registration No.	918102	Application Date	06/23/1970
Registration Date	08/10/1971	Foreign Priority Date	NONE
Word Mark	VANITY FAIR		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1970/05/28 First Use In Commerce: 1970/05/28 [PAPER SLIPS,] PETTI-SLIPS, AND BRIEFS

U.S. Registration No.	2185908	Application Date	08/07/1997
Registration Date	09/01/1998	Foreign Priority Date	NONE
Word Mark	VANITY FAIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1996/08/00 First Use In Commerce: 1996/08/00 pajamas, [robes, peignoir sets, bed jackets, scuffs, teddies,] nightgowns, [thermal underwear,] slips, chemises, thong underwear, bustiers, camisoles, bras, [panty hose, leggings, socks,] body suits, briefs, panties, pant liners, girdles, bodybriefers, and panty-girdles		

U.S. Registration No.	2808866	Application Date	04/15/2003
Registration Date	01/27/2004	Foreign Priority Date	NONE
Word Mark	VANITY FAIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1915/00/00 First Use In Commerce: 1915/00/00 Foundation garments, lingerie, underwear, bras, slips, loungewear, robes, sleepwear [and hosiery]		

U.S. Registration No.	3127692	Application Date	05/06/2004
Registration Date	08/08/2006	Foreign Priority Date	NONE
Word Mark	VANITY FAIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1992/04/15 First Use In Commerce: 1992/04/15 [retail store services in the field of apparel;] providing consumer product information via the Internet		

U.S. Registration No.	3632523	Application Date	02/15/2008
Registration Date	06/02/2009	Foreign Priority Date	NONE
Word Mark	VANITIES BY VANITY FAIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2008/04/14 First Use In Commerce: 2008/04/14 Panties; Lingerie; Bras		

Attachments	72363405#TMSN.gif (1 page)(bytes) 75337183#TMSN.gif (1 page)(bytes) 78414013#TMSN.jpeg (1 page)(bytes) 77398636#TMSN.jpeg (1 page)(bytes) Opposition.pdf (5 pages)(25280 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	/Carrie Shufflebarger/
Name	Carrie Shufflebarger
Date	02/29/2012

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

In the Matter of

Application No. : 85/343,030
Applicant : The Vanity Project LLC
Mark : THE VANITY PROJECT
Filing Date : June 10, 2011
Publication Date : November 1, 2011
Opposed Class: : 25

VANITY FAIR, INC., :
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Opposer, :
:
v. :
:
THE VANITY PROJECT LLC :
:
Applicant. :
:

Opposition No. _____

NOTICE OF OPPOSITION

Opposer, Vanity Fair, Inc., a corporation duly organized and existing under the laws of the State of Delaware, having a mailing address at One Fruit of the Loom Drive, Bowling Green, Kentucky 42103, believes it will be damaged by registration of the mark THE VANITY PROJECT shown in Application Serial No. 85/343,030, and hereby opposes registration of said mark.

As grounds of opposition, it is alleged that:

1. Opposer is Vanity Fair, Inc., owner of the famous VANITY FAIR brand of apparel. Opposer is the owner of, is currently using, and has itself and through its predecessors-in-interest continuously used in U.S. commerce for nearly a century marks consisting of or incorporating "VANITY FAIR" in connection with, inter alia, foundation garments, apparel, and textile goods (the "VANITY FAIR Marks").

2. Opposer owns numerous federal registrations on the Principal Register for its VANITY FAIR Marks, including without limitation the following, many of which have become incontestable within the meaning of the Lanham Act:

Trademark	Serial/Reg.	First Use	Goods
<i>Vanity Fair</i>	918,102	1970	Petti-slips and briefs
<i>Vanity Fair</i>	2,185,908	1996	pajamas, nightgowns, slips, chemises, thong underwear, bustiers, camisoles, bras, body suits, briefs, panties, pant liners, girdles, bodybriefers, and panty-girdles
VANITY FAIR	2,808,866	1915	Foundation garments, lingerie, underwear, bras, slips, loungewear, robes, sleepwear
VANITY FAIR	3,127,692	1992	providing consumer product information via the Internet
VANITIES BY VANITY FAIR	3,632,523	2008	Panties; Lingerie; Bras

3. Opposer has expended substantial amounts of money, time, and effort in advertising, promoting, and popularizing its VANITY FAIR Marks over many years and in preserving the good will associated therewith.
4. Opposer's VANITY FAIR Marks have become distinctive of and associated in the minds of the trade and purchasing public with Opposer as a well-known provider of its goods.
5. The public has come to know Opposer's VANITY FAIR Marks and recognize that any apparel goods so marked originate with Opposer. By virtue of these efforts and by virtue of the excellence of its goods, Opposer has gained a valuable reputation for its VANITY FAIR Marks.

6. The Vanity Project LLC, a limited liability company organized under the laws of Nevada, filed Application Serial No. 85/343,030 under Section 1(b) of the Lanham Act on June 10, 2011 (“Application”), seeking registration of the trademark THE VANITY PROJECT (“Applicant's Mark”) in International Class 25 for “Hats; Jackets; Pants; Shirts; Shoes; Short-sleeved or long sleeved t-shirts; Socks; Sweatshirts; T-shirts; Underwear.”
7. Priority is not an issue: Opposer’s longstanding use of its VANITY FAIR Marks described above is well prior to the filing date of the Application.
8. The goods identified in the Application are identical and/or highly related to Opposer’s goods sold under the VANITY FAIR Marks, and are likely to be sold through the same channels of trade and to the same class of purchasers as Opposer’s goods sold under its VANITY FAIR Marks.
9. Applicant's Mark so resembles the marks previously used by Opposer in commerce as to be likely, when used in connection with Applicant's goods, to cause confusion, deception or mistake as to the affiliation, connection or association of Applicant with Opposer, and/or the origin, sponsorship, or approval of Applicant's goods or commercial activities by Opposer under 15 U.S.C. § 1052(d). The aforesaid likelihood of confusion will damage Opposer within the meaning of 15 U.S.C. § 1063.
10. Opposer would be damaged by registration of Applicant's Mark because registration would grant Applicant statutory rights under the Trademark Act of 1946, and would tend to restrict, interfere with, and damage Opposer in the unhampered conduct of its business and protection of its legitimate interests.

WHEREFORE, Opposer prays this Opposition be sustained, and registration of the Application cited above be refused.

Please charge the appropriate filing fee to the credit card account of Opposer's counsel, as provided through the ESTTA filing system.

Please direct all correspondence to Carrie A. Shufflebarger, Esq., at Thompson Hine, LLP, 312 Walnut Street, Fourteenth Floor, Cincinnati, Ohio 45202, and all calls to the same at (513) 352-6678.

Respectfully submitted,

/s/ Carrie A. Shufflebarger

Carrie A. Shufflebarger, Esq.
Louis K. Ebling, Esq.
THOMPSON HINE, LLP
312 Walnut Street
Fourteenth Floor
Cincinnati, Ohio 45202
(513) 352-6678
carrie.shufflebarger@thompsonhine.com
lou.ebling@thompsonhine.com

Date: February 29, 2012

CERTIFICATE OF FILING

I certify that this NOTICE OF OPPOSITION is being submitted electronically to the Trademark Trial and Appeal Board at the United States Patent and Trademark Office on this 29th day of February , 2012.

/s/ Carrie A. Shufflebarger
Carrie A. Shufflebarger

CERTIFICATE OF SERVICE

I certify that a copy of this NOTICE OF OPPOSITION is being served via United States mail, postage prepaid, on the following, on this 29th day of February, 2012.

Omri Bojko
Director
The Vanity Project, LLC
1130 N. Dearborn St. Apt. 3202
Chicago, IL 60610-2754

/s/ Carrie A. Shufflebarger
Carrie A. Shufflebarger