

ESTTA Tracking number: **ESTTA498047**

Filing date: **10/03/2012**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Armando E Figueroa		
Entity	Individual	Citizenship	MEXICO
Address	Boulevard Aeropuerto Miguel Aleman S/D Nave 11, Rancho El Rosario C.P. Lerma Estado de Mexico, 5200 MEXICO		

Name	Carlo D Figueroa		
Entity	Individual	Citizenship	MEXICO
Address	Boulevard Aeropuerto Miguel Aleman S/D Nave 11, Rancho El Rosario C.P. Lerma Estado de Mexico, 5200 MEXICO		

Attorney information	Kourtney A. Mulcahy Hinshaw & Culbertson LLP 222 N. LaSalle Street Suite 300 Chicago, IL 60601-1081 UNITED STATES kmulcahy@hinshawlaw.com, trademarks@hinshawlaw.com, ebrown@hinshawlaw.com Phone:312-704-3336		
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Applicant Information

Application No	79110124	Publication date	09/11/2012
Opposition Filing Date	10/03/2012	Opposition Period Ends	10/11/2012
International Registration No.	1077048	International Registration Date	03/31/2011
Applicant	JULIAN IMAZ VILLAR PolÀ-gono Industrial Vall de Gata Draper C/A Parcela 3; E-08350 Arenys deMar (Barcelona) SPAIN		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Commercial business management and administration; franchising services in connection with commercial company operation or management assistance; retail store services and online retail store services featuring clothing, footwear and headgear; import-export services; advertising
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Dilution	Trademark Act section 43(c)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2226033	Application Date	02/12/1998
Registration Date	02/23/1999	Foreign Priority Date	NONE
Word Mark	SHASA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: Blouses, ensembles, clothes, shirts, trousers, jackets, bags, sneakers, jeans, Bermuda shorts, sweaters, pants, stockings, vests, foundation garments, panties, halters, underwear, bathing suits, shorts, nightgowns, brassieres, and shoes		

U.S. Registration No.	2763116	Application Date	02/07/2000
Registration Date	09/16/2003	Foreign Priority Date	NONE
Word Mark	SHASA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: Retail store services featuring clothes, shoes, purses, earrings, necklaces, bracelets and rings		

U.S. Registration No.	3483744	Application Date	09/27/2007
Registration Date	08/12/2008	Foreign Priority Date	NONE
Word Mark	SHASA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: Sunglasses Class 014. First use:		

	<p>Precious metals and the alloys thereof, items made from precious metals or plated therewith, namely, bracelets, earrings, cuff links, figurines, sculptures, jewelry boxes; jewelry; precious stones; clocks, watches and chronometric instruments</p> <p>Class 018. First use:</p> <p>Leather and imitation leather, bags, namely, all-purpose athletic bags, traveling bags; ladies' bags, namely, purses, clutch bags, beach bags, all-purpose athletic bags, school bags, traveling bags; products made from leather and imitation leather, namely, handbags, briefcases, wallets, suitcases, animal furs, chests and suitcases, parasols and walking sticks, riding crops and saddlery</p>
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Attachments	77290147#TMSN.jpeg (1 page)(bytes) SHANA Not of Opposition.pdf (12 pages)(283493 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	/kourtney mulcahy/
Name	Kourtney A. Mulcahy
Date	10/03/2012

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

ARMANDO ERNESTO DOLLERO FIGUEROA)	
and)	
CARLO DOLLERO FIGUEROA (Individuals))	
)	
Opposers,)	
)	
)	Opposition No.
)	Application No. 79110124
)	
v.)	
)	
JULIAN IMAZ VILLAR (Individual))	Mark: SHANA (and Design)
)	
Applicant.)	Filed: February 10, 2012
)	Published: September 11, 2012
)	Applicant: Julian Imaz Villar
)	

**NOTICE OF OPPOSITION TO
APPLICATION SERIAL NO. 79110124**

ARMANDO ERNESTO DOLLERO FIGUEROA and CARLO DOLLERO FIGUEROA are individuals residing in Mexico at Boulevard Aeropuerto Miguel Aleman S/D, nave 11, Rancho El Rosario, C.P. 5200 Lerma, Edo. De Mexico MEXICO (hereinafter referred to as "Opposers"). Opposers believe that they will be damaged by the use and/or registration of the mark SHANA and Design as shown in Application Serial No. 79110124 (hereinafter referred to as the "SHANA Mark"), and hereby opposes same.

As grounds for opposition, Opposers state:

1. Applicant applied for registration of the SHANA Mark in connection with the Class 35 services of "commercial business management and administration; franchising services in connection with commercial company operation or management assistance; retail store services and online retail store services featuring clothing, footwear and headgear; import-export

services; advertising” by an Application filed on February 10, 2012. This Application was filed on the basis of Section 66(a) – an Application based upon International Registration No. 1077048.

2. Opposers are engaged in the clothing industry and sell clothing and related accessory items (such as sunglasses, jewelry and leather goods) at retail store locations under the mark SHASA.

3. Since long prior to Applicant’s filing date, Opposers have used its mark SHASA in commerce on or in connection with goods/services that are substantially similar or identical to those covered by the Application for the SHANA Mark.

4. Opposers have and continue to promote its SHASA Mark in interstate commerce within the United States to identify Opposers’ goods and services, including, but not limited to, clothing, shoes, sunglasses, jewelry, leather goods, and retail store services featuring these goods that are substantially similar or identical to those covered by the Application for the SHANA Mark.

5. Opposers are the owners of U.S. Reg. No. 2,226,033 for the word mark SHASA for “blouses, ensembles, clothes, shirts, trousers, jackets, bags, sneakers, jeans, Bermuda shorts, sweaters, pants, stockings, vests, foundation garments, panties, halters, underwear, bathing suits, shorts, nightgowns, brassieres, and shoes” in International Class 25. This application was filed on February 12, 1998 and the Registration issued on February 23, 1999. A copy of the Registration is attached hereto as Exhibit A. This Registration has become incontestable, and the mark encompassed by the Registration remains in use. Opposers have used and registered this

mark prior to any use or application made by Applicant. The mark shown in U.S. Reg. No. 2,226,033 became famous before any use or application made by Applicant.

6. Opposers are the owners of U.S. Reg. No. 2,763,116 for the word mark SHASA for “retail store services featuring clothes, shoes, purses, earrings, necklaces, bracelets and rings” in International Class 35. This application was filed on February 7, 2000 and the Registration issued on September 16, 2003. A copy of the Registration is attached hereto as Exhibit B. This Registration has become incontestable, and the mark encompassed by the Registration remains in use. Opposers have used and registered this mark prior to any use or application made by Applicant. The mark shown in U.S. Reg. No. 2,763,116 became famous before any use or application made by Applicant.

7. Opposers are the owners of U.S. Reg. No. 3,483,744 for the word mark SHASA for “sunglasses” in Class 9; “precious metals and the alloys thereof, items made from precious metals or plated therewith, namely, bracelets, earrings, cuff links, figurines, sculptures, jewelry boxes; jewelry; precious stones; clocks, watches and chronometric instruments” in Class 14; and “leather and imitation leather, bags, namely, all-purpose athletic bags, traveling bags; ladies' bags, namely, purses, clutch bags, beach bags, all-purpose athletic bags, school bags, traveling bags; products made from leather and imitation leather, namely, handbags, briefcases, wallets, suitcases, animal furs, chests and suitcases, parasols and walking sticks, riding crops and saddlery” in Class 18. This application was filed on September 27, 2007 and the Registration issued on August 12, 2008. A copy of the Registration is attached hereto as Exhibit C. This Registration is valid and subsisting, and the mark encompassed by the Registration remains in use. Opposers have used and registered this mark prior to any use or application made by

Applicant. The mark shown in U.S. Reg. No. 3,483,744 became famous before any use or application made by Applicant.

8. For purposes of this Opposition, all of the foregoing trademarks and services marks of Opposers, including the U.S. Registrations, shall be referred to as the "SHASA Marks."

LIKELIHOOD OF CONFUSION

9. Opposers' SHASA Marks are distinctive and uniquely associated with Opposers in connection with Opposers' goods and services by reason of Opposers' continuous use and promotion of its marks through advertising, promotion and use. Such advertising, promotion and use occurred prior to Applicant's filing date.

10. The Application for the SHANA Mark so resembles Opposers' SHASA Marks as to likely, when used in conjunction with Applicant's services, to cause confusion, and mistake, and to deceive consumers. The SHANA Mark is confusingly similar and deceptively similar to Opposers' SHASA Marks when used in connection with Applicant's services.

11. Applicant's services are directed to the same or related class of consumers as those for Opposers' goods and services and are available in the same channels of trade. Accordingly, Applicant's services and Opposers' goods and services are so commercially related that the mark sought to be registered and Opposers' marks, when used in connection with their respective goods and services, are confusingly similar.

12. Applicant's use of the SHANA Mark, which so resembles and is colorably imitative of Opposers' SHASA Marks, is likely to cause confusion, mistake, or deception of

purchasers as to the source of Applicant's services and will inevitably falsely suggest a trade connection between Opposers and Applicant.

DILUTION

13. As noted above, the SHASA Marks are famous and became famous prior to any use or application made by Applicant.

14. Applicant's SHANA Mark is substantially similar to Opposers' SHASA Marks, as the marks only differ by one letter.

15. As such, the application, registration, and/or use of the SHANA Mark has caused or will likely cause dilution of the distinctiveness of Opposers' SHASA Marks mentioned in the preceding paragraph and otherwise injures Opposers reputation and unique identity in the minds of the consumers.

WHEREFORE, Opposers pray that Application No. 79110124 be refused, and that no registration be issued from or in connection with the SHANA mark, and that this Opposition be sustained in favor of Opposers.

A duplicate copy of this Notice of Opposition and the filing fee of \$300.00 are enclosed.

Respectfully submitted,

AMANDO ERNESTO DOLLERO FIGUEROA
and CARLO DOLLERO FIGUEROA

By: /s/ Kourtney A. Mulcahy

Kourtney A. Mulcahy
Hinshaw & Culbertson LLP
222 North LaSalle Street, Ste. 300
Chicago, Illinois 60601
312-704-3336

EXHIBIT "A"

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,226,033

United States Patent and Trademark Office

Registered Feb. 23, 1999

**TRADEMARK
PRINCIPAL REGISTER**

SHASA

COMERCIALIZADORA DASH S.A. DE C.V.
(MEXICO CORPORATION)
PLAZA 20 DE NOVIEMBRE NO. 26, 6 PISO
LOCAL E., COLONIA OBRERA
06800 MEXICO, D.F., MEXICO

FOR: BLOUSES, ENSEMBLES, CLOTHES,
SHIRTS, TROUSERS, JACKETS, BAGS, SNEAK-
ERS, JEANS, BERMUDA SHORTS, SWEATERS,
PANTS, STOCKINGS, VESTS, FOUNDATION
GARMENTS, PANTIES, HALTERS, UNDER-
WEAR, BATHING SUITS, SHORTS, NIGHT-

GOWNS, BRASSIERES, AND SHOES, IN CLASS
25 (U.S. CLS. 22 AND 39).

OWNER OF MEXICO REG. NO. 561,900,
DATED 10-30-1997, EXPIRES 10-1-2007.

OWNER OF MEXICO REG. NO. 488,507,
DATED 4-24-1995, EXPIRES 1-17-2005.

SER. NO. 75-433,348, FILED 2-12-1998.

ANGELA M. MICHELI, EXAMINING ATTOR-
NEY

EXHIBIT "B"

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,763,116

United States Patent and Trademark Office

Registered Sep. 16, 2003

**SERVICE MARK
PRINCIPAL REGISTER**

SHASA

DOLLERO FIGUEROA, ARMANDO ERNESTO
(MEXICO INDIVIDUAL)
BOULEVARD AEROPUERTO MIGUEL ALEMAN
S/D, NAVE 11, RANCHO EL ROSARIO, C.P. 5200
LERMA, EDO. DE MEXICO, MEXICO AND
DOLLERO FIGUEROA, CARLO (MEXICO INDIVI-
DUAL)
BOULEVARD AEROPUERTO MIGUEL ALEMAN
S/D, NAVE 11, RANCHO EL ROSARIO, C.P. 5200
LERMA, EDO. DE MEXICO, MEXICO

FOR: RETAIL STORE SERVICES FEATURING
CLOTHES, SHOES, PURSES, EARRINGS, NECKLA-

CES, BRACELETS AND RINGS, IN CLASS 35 (U.S.
CLS. 100, 101 AND 102).

OWNER OF MEXICO REG. NO. 528,902, DATED 8-
26-1996, EXPIRES 8-26-2006.

OWNER OF U.S. REG. NO. 2,226,033.

SER. NO. 75-912,158, FILED 2-7-2000.

HENRY S. ZAK, EXAMINING ATTORNEY

EXHIBIT "C"

Int. Cls.: 9, 14 and 18

Prior U.S. Cls.: 1, 2, 3, 21, 22, 23, 26, 27, 28, 36, 38, 41
and 50

Reg. No. 3,483,744

United States Patent and Trademark Office

Registered Aug. 12, 2008

TRADEMARK
PRINCIPAL REGISTER

SHASA

ARMANDO ERNESTO DOLLERO FIGUEROA
AND CARLO DOLLERO FIGUEROA (MEXI-
CO INDIVIDUAL)
COL. RANCHO EL ROSARIO
BOULEVARD AEROPUERTO NO. 154 NAVE 11
LERMA ESTADO DE MEXICO, MEXICO 520000

FOR: SUNGLASSES, IN CLASS 9 (U.S. CLS. 21, 23,
26, 36 AND 38).

FOR: PRECIOUS METALS AND THE ALLOYS
THEREOF, ITEMS MADE FROM PRECIOUS ME-
TALS OR PLATED THEREWITH, NAMELY, BRA-
CELETS, EARRINGS, CUFF LINKS, FIGURINES,
SCULPTURES, JEWELRY BOXES; JEWELRY; PRE-
CIOUS STONES; CLOCKS, WATCHES AND
CHRONOMETRIC INSTRUMENTS, IN CLASS 14
(U.S. CLS. 2, 27, 28 AND 50).

FOR: LEATHER AND IMITATION LEATHER,
BAGS, NAMELY, ALL-PURPOSE ATHLETIC BAGS,
TRAVELING BAGS; LADIES' BAGS, NAMELY,
PURSES, CLUTCH BAGS, BEACH BAGS, ALL-PUR-
POSE ATHLETIC BAGS, SCHOOL BAGS, TRAVEL-
ING BAGS; PRODUCTS MADE FROM LEATHER
AND IMITATION LEATHER, NAMELY, HAND-

BAGS, BRIEFCASES, WALLETS, SUITCASES, ANI-
MAL FURS, CHESTS AND SUITCASES, PARASOLS
AND WALKING STICKS, RIDING CROPS AND
SADDLERY, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND
41).

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

OWNER OF MEXICO REG. NO. 686251, DATED
10-19-2000, EXPIRES 10-19-2010.

OWNER OF MEXICO REG. NO. 918632, DATED 1-
9-2006, EXPIRES 1-9-2016.

OWNER OF U.S. REG. NOS. 2,226,033 AND
2,763,116.

THE WORDING "SHASA" HAS NO MEANING IN
A FOREIGN LANGUAGE.

SER. NO. 77-290,147, FILED 9-27-2007.

RON FAIRBANKS, EXAMINING ATTORNEY

CERTIFICATE OF FILING

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via the Electronic System for the Trademark Trial and Appeal Board on October 3, 2012.

/s/ Kourtney A. Mulcahy