

ESTTA Tracking number: **ESTTA536198**

Filing date: **05/03/2013**

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	Guru Denim, Inc. dba True Religion Brand Jeans
Granted to Date of previous extension	05/05/2013
Address	2263 East Vernon Avenue Vernon, CA 90058-1631 UNITED STATES

Name	True Religion Apparel, Inc.		
Entity	Corporation	Citizenship	California
Address	2263 East Vernon Avenue Vernon, CA 90058 UNITED STATES		

Attorney information	Susan G. L. Glovsky Hamilton, Brook, Smith & Reynolds, P.C. 530 Virginia Road, P.O. Box 9133 Concord, MA 01742-9133 UNITED STATES susan.glovsky@hbsr.com, maria.cedroni@hbsr.com, cheryl.thomas@hbsr.com, carrie.howder@hbsr.com Phone:978-341-0036
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Applicant Information

Application No	85530144	Publication date	11/06/2012
Opposition Filing Date	05/03/2013	Opposition Period Ends	05/05/2013
Applicant	TRUE & CO. 855 FOLSOM STREET SUITE 916 SAN FRANCISCO, CA 94107 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2012/05/30 First Use In Commerce: 2012/05/30 All goods and services in the class are opposed, namely: the bringing together, for the benefit of others, of a variety of goods and services, enabling customers to conveniently view and purchase those goods and services from an Internet web site particularly specializing in the marketing of the sale of goods and services of others
Class 045. First Use: 2012/05/30 First Use In Commerce: 2012/05/30 All goods and services in the class are opposed, namely: providing personal shopping services for others over the Internet

Grounds for Opposition

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.	2917187	Application Date	09/26/2002
Registration Date	01/11/2005	Foreign Priority Date	NONE
Word Mark	TRUE RELIGION BRAND JEANS WORLD TOUR FASHION FOR THE SENSES SECTION ROW SEAT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2002/10/01 First Use In Commerce: 2002/10/01 Label for Clothing, namely, men's, women's, and children's pants, slacks, jeans, shorts, overalls, shirts, t-shirts, blouses, vests, skirts, jackets, [coats,] sweaters, sweatshirts, sweatpants, and hats		

U.S. Registration No.	3162614	Application Date	12/08/2005
Registration Date	10/24/2006	Foreign Priority Date	NONE
Word Mark	TRUE RELIGION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2002/08/01 First Use In Commerce: 2002/08/01 Clothing, namely, pants, jeans, jackets, skirts, shorts, sweatpants, sweatshirts, and vests		

U.S. Registration No.	3120797	Application Date	12/08/2005
Registration Date	07/25/2006	Foreign Priority Date	NONE
Word Mark	TRUE RELIGION BRAND JEANS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2002/08/01 First Use In Commerce: 2002/08/01 Clothing, namely, pants, jeans, jackets, skirts, shorts, sweatpants, sweatshirts, and vests		

U.S. Registration No.	3120798	Application Date	12/08/2005
Registration Date	07/25/2006	Foreign Priority Date	NONE
Word Mark	TRUE RELIGION BRAND JEANS		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2005/04/26 First Use In Commerce: 2005/04/26 On-line retail store services featuring clothing; retail store services featuring clothing

U.S. Registration No.	3162615	Application Date	12/08/2005
Registration Date	10/24/2006	Foreign Priority Date	NONE
Word Mark	TRUE RELIGION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2005/04/26 First Use In Commerce: 2005/04/26 On-line retail store services featuring clothing; retail store services featuring clothing		

Attachments	Notice of Opposition.pdf (10 pages)(101647 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	/Susan G. L. Glovsky/
Name	Susan G. L. Glovsky
Date	05/03/2013

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

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GURU DENIM, INC. d/b/a)
TRUE RELIGION BRAND JEANS)
and)
TRUE RELIGION APPAREL, INC.,)
Opposers,)
)
v.) Opposition No.
)
TRUE & CO.,)
)
Applicant.)
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NOTICE OF OPPOSITION

In the matter of an application for registration of the mark TRUE TRUE & CO., Serial No. 85/530,144, filed January 31, 2012 by True & Co., 855 Folsom Street, Suite 916, San Francisco, California 94107, and published for Opposition in the Official Gazette of November 6, 2012, Page 250.

Opposers Guru Denim, Inc., d/b/a True Religion Brand Jeans (“Guru Denim”) and True Religion Apparel, Inc. (“True Religion”) (collectively, “Opposers”), California corporations having their principal place of business at 2263 East Vernon Avenue, Vernon, California 90058, believe that they would be damaged by registration of the mark as sought in the foregoing application and hereby oppose the same.

Opposer Guru Denim has been granted extensions to oppose and this Notice of Opposition is filed before the expiration of the extensions granted. Because Opposer True Religion Apparel, Inc. is the parent corporation of Opposer Guru Denim, Inc., d/b/a True Religion Brand Jeans and therefore Opposers are “related companies” as that term is used and

defined in 15 U.S.C. §§ 1055 and 1127, Opposer True Religion Apparel, Inc. is in privity with Opposer Guru Denim, Inc. *See* 37 C.F.R. § 2.102(b).

The grounds of the opposition are as follows:

1. By the application herein opposed, Applicant seeks to register the mark TRUE TRUE & CO. for services in Classes 35 and 45. The application to register TRUE TRUE & CO. was filed on January 31, 2012 and published for opposition on November 6, 2012. A copy of the page from the Official Gazette on which the mark is published is attached hereto and made a part hereof as Exhibit A. This Opposition opposes the registration of such mark in Classes 35 and 45.

2. Opposers are and have been the owner of all right, title, and interest in the mark TRUE RELIGION for use in their business, particularly in connection with the sale of jeans and other apparel.

3. Opposer True Religion has used “True Religion Apparel, Inc.” as a name in its business and Opposers have used “True Religion” and “True Religion Brand Jeans” as names in their business since at least as early as 2003.

4. Since at least as early as August 1, 2002, Opposers or a predecessor used the mark TRUE RELIGION in commerce on clothing including pants, jeans, jackets, skirts, shorts, sweatpants, sweatshirts, and vests.

5. Continuously, since at least as early as October 1, 2002, Opposers or a predecessor used the mark TRUE RELIGION BRAND JEANS WORLD TOUR FASHION FOR THE SENSES SECTION ROW SEAT and Design in commerce on clothing, including men’s, women’s and children’s pants, slacks, jeans, shorts, overalls, shirts, t-shirts, blouses, vests, skirts, jackets, coats, sweaters, sweatshirts, sweatpants, and hats.

6. Opposer Guru Denim is the owner of the registration of the trademark TRUE RELIGION BRAND JEANS WORLD TOUR FASHION FOR THE SENSES SECTION ROW

SEAT and Design issued on January 11, 2005 for clothing, namely men's, women's and children's pants, slacks, jeans, shorts, overalls, shirts, t-shirts, blouses, vests, skirts, jackets, coats, sweaters, sweatshirts, sweatpants, and hats, with U.S. Registration No. 2,917,187.

7. Since at least as early as December 2002, Opposer Guru Denim has used TRUE RELIGION BRAND JEANS in a design arranged in a circle (hereinafter "TRUE RELIGION BRAND JEANS Circle logo") for pants, jeans, shorts, overalls, shirts, t-shirts, vests, shirts, jackets, sweatshirts, and sweatpants.

8. Opposer Guru Denim is the owner of the registration of the TRUE RELIGION BRAND JEANS Circle logo that issued on August 21, 2007 for pants, jeans, shorts, overalls, shirts, t-shirts, vests, skirts, jackets, sweatshirts, and sweatpants, with U.S. Registration No. 3,282,490.

9. Since at least as early as August 1, 2002, Opposer Guru Denim has used TRUE RELIGION for pants, jeans, jackets, skirts, shorts, sweatpants, sweatshirts, and vests.

10. Opposer Guru Denim is the owner of the registration of the trademark TRUE RELIGION issued on October 24, 2006 for clothing, namely, pants, jeans, jackets, skirts, shorts, sweatpants, sweatshirts, and vests, with U.S. Registration No. 3,162,614.

11. Since at least as early as August 1, 2002, Opposer Guru Denim has used TRUE RELIGION BRAND JEANS for clothing, namely, pants, jeans, jackets, skirts, shorts, sweatpants, sweatshirts, and vests.

12. Opposer Guru Denim is the owner of the registration of the trademark TRUE RELIGION BRAND JEANS issued on July 25, 2006 for clothing, namely, pants, jeans, jackets, skirts, shorts, sweatpants, sweatshirts, and vests, with U.S. Registration No. 3,120,797.

13. Since at least as early as April 26, 2005, Opposer Guru Denim has used the service mark TRUE RELIGION BRAND JEANS continuously in interstate commerce for retail store and on-line retail store services featuring clothing.

14. Opposer Guru Denim is the owner of the registration of the service mark TRUE RELIGION BRAND JEANS issued on July 25, 2006 for on-line retail store services featuring clothing; retail store services featuring clothing, with U.S. Registration No. 3,120,798.

15. Since at least as early as April 26, 2005, Opposer Guru Denim has used the service mark TRUE RELIGION continuously and in interstate commerce for retail store and on-line retail store services featuring clothing.

16. Opposer Guru Denim is the owner of the registration of the service mark TRUE RELIGION issued on October 24, 2006 for on-line retail store services featuring clothing; retail store services featuring clothing, with U.S. Registration No. 3,162,615.

17. As a result of use and registration, Opposers have rights in the trade names TRUE RELIGION and TRUE RELIGION BRAND JEANS and the trademarks and service marks TRUE RELIGION, TRUE RELIGION BRAND JEANS, and TRUE RELIGION BRAND JEANS as part of logos with additional words (hereinafter “trade names, trademarks, and service marks”).

18. The TRUE RELIGION and TRUE RELIGION BRAND JEANS trademarks are the subject of numerous trademark and service mark registrations and applications worldwide.

19. Opposers use four primary distribution channels: in the Opposers’ retail stores, to a network of wholesale accounts, through international distributors, and through Opposers’ website at www.truereligionbrandjeans.com

20. In addition to using the web address truereligionbrandjeans.com, Opposers have secured domain names that include “truebras,” “truereligion,” “truereligionjeans,”

“truereligionbrand,” and “truereligionbrandjeans” followed by a variety of endings, all of which point to the same content that appears at www.truereligionbrandjeans.com.

21. Opposers’ apparel is sold worldwide, including in the United States, Canada, Germany, the United Kingdom, Japan, Korea, France, Spain, Sweden, Greece, Italy, Mexico, Australia, South Africa, and China.

22. Opposers’ worldwide sales of apparel occur, for example, in boutiques, retailers, and Opposers’ branded stores.

23. Opposers’ trade names, trademarks, and service marks have become distinguished and widely known in the fashion and apparel industry, identifying Opposers as leaders in the apparel business.

24. Opposers’ trade names, trademarks, and service marks have become some of the most well known in apparel and accessories in the United States and worldwide.

25. Opposers’ trade names, trademarks, and service marks are valuable assets of Opposers.

26. The strength of Opposers’ trade names, trademarks, and service marks is due to Opposers’ consistent emphasis on innovative and distinctive product designs and product quality.

27. Opposers control the manner in which Opposers’ trade names, trademarks, and service marks are advertised, marketed, and promoted in the United States and worldwide.

28. Opposers’ trade names, trademarks, and service marks and their goods have been showcased in major publications and broadcast media in the United States and worldwide.

29. One of Opposers’ business strategies is to develop recognition of Opposers’ trade names, trademarks, and service marks.

30. Opposers have worldwide trademark and service mark registrations and applications.

31. Opposers generate significant sales revenue from their worldwide sales.

32. Opposers have made a significant financial investment in advertising their trade names, trademarks, and service marks. These investments include significant expenditures to secure search terms with the word “true.”

33. Opposers’ trade names, trademarks, and service marks are of significant value to Opposers in the identification and promotion of their clothing, on-line retail store services featuring clothing, and retail store services featuring clothing, and in connection with their business for current and future clothing, on-line retail store services featuring clothing, and retail store services featuring clothing. Opposers’ trade names, trademarks, and service marks distinguishes such goods and services from the goods and services of others and the marks have acquired substantial secondary meaning in the minds of consumers. Opposers’ trade names, trademarks, and service marks are famous as defined in 15 U.S.C. § 1125(c).

34. The services identified in Classes 35 and 45 in Applicant’s application are intended and designed for use in connection with on-line sales, including the sale of apparel. Thus, the services provided by Applicant are related to the goods and services provided by Opposers under their trade names, trademarks, and service marks.

35. Purchasers and customers, as well as prospective purchasers and customers, familiar with Opposers’ goods and business identified by the trade names, trademarks, and service marks are likely to be misled into believing, contrary to fact, that Applicant’s products provided under the TRUE TRUE & CO. mark opposed herein, emanate from or are in some way sponsored by Opposers, all to Opposers’ irreparable damage through loss and dilution of its goodwill as symbolized by the trade names, trademarks, and service marks.

36. Granting of the registration for the TRUE TRUE & CO., as sought by Applicant through the application herein opposed, would place Applicant in a position to harass and cause

annoyance to Opposers and their customers, to the damage of Opposers. Such registration would inhibit Opposers in the use of the trade names, trademarks, and service marks in promoting their goods, services, and business which would manifest damage upon Opposers. Registration of TRUE TRUE & CO. would constitute *prima facie* evidence of an exclusive right of Applicant to use the TRUE TRUE & CO. mark for the services identified in its application herein opposed and for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade that would further compound confusion on the part of the purchasing public, all to the damage of Opposers.

37. WHEREFORE, Opposers Pray that the application having Serial No. 85/530,144, filed January 31, 2012 for registration of TRUE TRUE & CO. in Classes 35 and 45, be refused and that this Opposition be sustained.

Respectfully submitted,

/Susan G. L. Glovsky/

Susan G. L. Glovsky

Registration No. 30,382

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Dated: May 3, 2013

PROOF OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Notice of Opposition was served by first-class mail, postage-prepaid, upon Applicant True & Co. addressed to the correspondence address of record in the United States Patent and Trademark Office, Jason M. Vogel, Esq., Lisa Pearson, Esq., Kilpatrick Townsend & Stockton LLP, 1114 Avenue of the Americas, 21st Floor, New York, New York, 10036, on May 3, 2013.

/Susan G. L. Glovsky/

Susan G. L. Glovsky

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Exhibit A

SANI KHOURI, EXAMINING ATTORNEY

SN 85-530,144. TRUE & CO., SAN FRANCISCO, CA. FILED 1-31-2012.



NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "& CO", APART FROM THE MARK AS SHOWN. THE MARK CONSISTS OF THE LETTERS "T"."R"."U"."E" IN A CIRCLE FILLED RECTANGLE WITH THE WORDS "TRUE & CO" UNDERNEATH.

CLASS 35—ADVERTISING AND BUSINESS

FOR THE BRINGING TOGETHER, FOR THE BENEFIT OF OTHERS, OF A VARIETY OF GOODS AND SERVICES, ENABLING CUSTOMERS TO CONVENIENTLY VIEW AND PURCHASE THOSE GOODS AND SERVICES FROM AN INTERNET WEB SITE PARTICULARLY SPECIALIZING IN THE MARKETING OF THE SALE OF GOODS AND SERVICES OF OTHERS (U.S. CLS. 100, 101 AND 102).

FIRST USE 5-30-2012; IN COMMERCE 5-30-2012.

CLASS 45—PERSONAL AND LEGAL SERVICES

FOR PROVIDING PERSONAL SHOPPING SERVICES FOR OTHERS OVER THE INTERNET (U.S. CLS. 100 AND 101).

FIRST USE 5-30-2012; IN COMMERCE 5-30-2012. BRIDGETT SMITH, EXAMINING ATTORNEY

SN 85-532,216. UK LOU LOU'S WORLD, LONDON, UNITED KINGDOM, FILED 2-2-2012.



PRIORITY CLAIMED UNDER SEC. 44(D) ON ERPNTY TM OFC APPLICATION NO. 010398931, FILED 11-8-2011, REG. NO. 010398931, DATED 5-8-2012, EXPIRES 11-8-2021.

THE COLOR(S) WHITE, LIGHT BLUE, GRAY, BROWN, AND BLACK IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF THE BROWN WORDING "LOU LOU'S WORLD" COMBINED WITH A WHITE, GRAY AND LIGHT BLUE SHELL OUTLINED IN BLACK. THE MARK APPEARS ON A WHITE BACKGROUND.

CLASS 14—JEWELRY

FOR JEWELRY, NAMELY, NECKLACES (U.S. CLS. 2, 27, 28 AND 50).

CLASS 18—LEATHER GOODS

FOR SUITCASES FOR KIDS AND BABIES; BAGS FOR KIDS AND BABIES, NAMELY, SCHOOL BAGS (U.S. CLS. 1, 2, 3, 22 AND 41).

CLASS 25—CLOTHING

FOR CLOTHING ACCESSORIES RELATING AND LINKED TO KID'S AND BABIES PUBLICATIONS AND BOOKS, NAMELY, MASQUERADE COSTUME MASKS, SCARVES, AND BELTS (U.S. CLS. 22 AND 39).

CLASS 26—FANCY GOODS

FOR CLOTHING ACCESSORIES RELATING AND LINKED TO KID'S AND BABIES PUBLICATIONS AND BOOKS, NAMELY, BUCKLES OF PRECIOUS METAL AND CHARMS FOR ATTACHMENT TO ZIPPER PULLS AND BUTTONS (U.S. CLS. 37, 39, 40, 42 AND 50).

KIM MONINGHOFF, EXAMINING ATTORNEY

SN 85-532,853. JADE SOFTWARE CORPORATION LIMITED, CHRISTCHURCH, NEW ZEALAND, FILED 2-3-2012.

WYNYARD

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

PRIORITY CLAIMED UNDER SEC. 44(D) ON NEW ZEALAND APPLICATION NO. 855982, FILED 2-3-2012, REG. NO. 855982, DATED 2-3-2012, EXPIRES 2-3-2022.

CLASS 9—ELECTRICAL AND SCIENTIFIC APPARATUS

FOR COMPUTER HARDWARE; COMPUTER SOFTWARE FOR MONITORING NETWORK APPLICATIONS FOR DETECTING UNAUTHORIZED ACCESS AND USE; COMPUTER SOFTWARE FOR MONITORING, MANAGING, MANIPULATING AND ANALYZING DATA FOR THE DETECTION AND PREDICTION OF THREATS AND PROACTIVE PREVENTION OF CRIME AND CORRUPTION; COMPUTER SOFTWARE FOR USE IN MANAGING INVESTIGATIVE OPERATIONS FOR ENFORCING LAWS, CODES AND REGULATIONS; COMPUTER SOFTWARE FOR USE IN MONITORING, MANIPULATING AND ANALYZING DATA FOR THE PROVISION OF FORENSIC SERVICES AND ANALYSIS; COMPUTER SOFTWARE FOR MONITORING, DETECTING AND INTERPRETING INPUTS FROM DATA SOURCES AND INITIATING AND HANDLING RESPONSIVE PROCESSES FOR ANTI MONEY-LAUNDERING, FRAUD DETECTION, TRANSACTION MONITORING, REPORTING AND REGISTRY MANAGEMENT PURPOSES; COMPUTER SOFTWARE FOR USE IN EVALUATING COMPLIANCE WITH EXISTING LAWS, REGULATIONS AND STATUTES; COMPUTER SOFTWARE FOR USE IN SECURE TRANSACTION PROCESSING FOR PAYMENTS, CHECK CLEARING AND BANKING; PRE-RECORDED CD-ROMS AND ELECTRONIC DOCUMENTATION AND MANUALS CONTAINING SALES AND MARKETING INFORMATION, PRODUCT INFORMATION AND USER GUIDES, PROMOTIONAL MATERIALS, PRODUCT DEMONSTRATIONS AND ELECTRONIC EVALUATION FORMS SOLD IN CONJUNCTION WITH THE AFOREMENTIONED SOFTWARE OR HARDWARE; PROGRAMS FOR COMPUTERS FOR MONITORING NETWORK APPLICATIONS FOR DETECTING UNAUTHORIZED ACCESS AND USE; PROGRAMS FOR COMPUTERS FOR MONITORING, MANAGING, MANIPULATING AND ANALYZING DATA FOR THE DETECTION AND PREDICTION OF THREATS, AND PROACTIVE PREVENTION OF CRIME AND CORRUPTION; PROGRAMS FOR COMPUTERS FOR USE IN MANAGING INVESTIGATIVE OPERATIONS FOR ENFORCING LAWS, CODES AND REGULATIONS; PROGRAMS FOR COMPUTERS FOR USE IN MONITORING, MANIPULATING AND ANALYZING DATA FOR THE PROVISION OF FORENSIC SERVICES AND ANALYSIS; PROGRAMS FOR