

ESTTA Tracking number: **ESTTA538107**

Filing date: **05/15/2013**

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 party opposes registration of the indicated application.

Opposer Information

Name	BRS Investment Properties, LLC
Granted to Date of previous extension	05/15/2013
Address	2532 Dupont Drive Irvine, CA 92612 UNITED STATES

Attorney information	Michelle L Mehok Pillsbury Winthrop Shaw Pittman LLP 12255 El Camino Real, Suite 300 San Deigo, CA 92130 UNITED STATES sdipdocket@pillsburylaw.com, michelle.mehok@pillsburylaw.com
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Applicant Information

Application No	85503083	Publication date	01/15/2013
Opposition Filing Date	05/15/2013	Opposition Period Ends	05/15/2013
International Registration No.	NONE	International Registration Date	NONE
Applicant	ZANNIER SAS 6 bis, rue Gabriel Laumain 75010 PARIS, FRANCE		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, sweaters, trousers, jackets, dresses, cardigans, coats, scarves, anoraks, shorts, T-shirts, underwear, shirts, tights, socks, bathing suits, headgear, namely, hats, sun hats, caps, footwear
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	common-law basis

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2494002	Application Date	01/11/2000
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Registration Date	10/02/2001	Foreign Priority Date	NONE
Word Mark	BACARA RESORT & SPA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1999/08/30 First Use In Commerce: 1999/08/30 Full service resort hotel, health spa services, and providing convention facilities		

U.S. Registration No.	2589268	Application Date	02/04/2000
Registration Date	07/02/2002	Foreign Priority Date	NONE
Word Mark	BACARA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2000/05/01 First Use In Commerce: 2000/05/01 NOTE PADS; MEMO PADS; MOUNTED AND UNMOUNTED PHOTOGRAPHS; PAPER BAGS; PENS AND PENCILS; STATIONERY; BROCHURES ABOUT TRAVEL AND HEALTH AND NEWSLETTERS IN THE FIELDS OF TRAVEL AND HEALTH; POSTCARDS; POSTERS		

U.S. Registration No.	2589269	Application Date	02/04/2000
Registration Date	07/02/2002	Foreign Priority Date	NONE
Word Mark	BACARA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2000/09/01 First Use In Commerce: 2000/09/01 UMBRELLAS; BAGS, NAMELY, TOILETRY CASES SOLD EMPTY, HANDBAGS, BACKPACKS, ATHLETIC BAGS, DUFFEL BAGS, COSMETIC BAGS SOLD EMPTY, LUGGAGE		

U.S. Registration No.	2589271	Application Date	02/04/2000
Registration Date	07/02/2002	Foreign Priority Date	NONE
Word Mark	BACARA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2000/09/01 First Use In Commerce: 2000/09/01 CLOTHING, NAMELY, SWEATSHIRTS AND SWEATPANTS, SHIRTS, JACKETS, TIES, SWEATERS, CAPS, VISORS, HATS, ROBES, SWIMWEAR, SOCKS		

U.S. Registration No.	2847711	Application Date	02/04/2000
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Registration Date	06/01/2004	Foreign Priority Date	NONE
Word Mark	BACARA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2004/01/10 First Use In Commerce: 2004/01/10 JAMS, FRUIT PRESERVES, DRIED FRUIT, OLIVE OILS, EDIBLE OILS, [BUTTER, CAVIAR, SALMON FOR FOOD PURPOSES, FOIE GRAS,] SOUP		

Attachments	BECKARONoticeOfOpposition.pdf(2769437 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	/michelle mehok/
Name	Michelle L Mehok
Date	05/15/2013

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

BRS Investment Properties, LLC,

Opposers,

vs.

Zannier SAS,

Applicant.

OPPOSITION NO.

NOTICE OF OPPOSITION

Trademark: BECKARO

US Serial Number 85/503,083

Goods: Clothing, namely, sweaters, trousers, jackets, dresses, cardigans, coats, scarves, anoraks, shorts, T-shirts, underwear, shirts, tights, socks, bathing suits, headgear, namely, hats, sun hats, caps, footwear in class 25.

Filed: December 23, 2011

Published: December 26, 2012

BRS Investment Properties, LLC (“Opposer”), believes that it is or will be damaged by Zannier SAS’s (“Applicant”) registration of the published BECKARO application (Serial No. 85/503,083), and hereby opposes the registration of the mark pursuant to 37 CFR §2.101(b).

An extension of time has been obtained up until May 15, 2013. Therefore, this opposition is timely.

As grounds for opposition, Opposer, by its attorneys, aver as follows:

BACKGROUND

1. Opposer is a limited liability company organized under the laws of California with a business address of 2532 Dupont Drive, Irvine, California 92612.

2. Opposer is the assignee of all right, title and interest to the BACARA marks, set forth below, including all goodwill thereof, such assignment recorded with the USPTO from SB Luxury Marks, LLC to Opposer.

3. In 2013, Opposer acquired the Bacara Resort & Spa.

4. In 1999, the Bacara Resort & Spa opened.

5. The Bacara Resort & Spa is located in Santa Barbara, California.

6. Since the opening of the Bacara Resort & Spa, the mark BACARA RESORT & SPA was used and continues to be used in connection with a full range of resort services and spa services, including providing meeting and convention facilities.

7. The mark BACARA is used in connection with numerous goods including, but not limited to, note pads, memo pads, mounted and unmounted photographs, paper bags, pens and pencils, stationery, brochures about travel and health and newsletters in the fields of travel and health, postcards, posters, umbrellas, bags, luggage, clothing, jams, fruit preserves, dried fruit, olive oils, edible oils, and soups.

THE BACARA MARKS

8. Opposer is the owner of record of the following trademark registrations for BACARA in the United States Patent and Trademark Office (“USPTO”) for a wide variety of goods and services as follows:

Exhibit	Registration No.	Class	Goods	Registration Date	Mark
A	2,494,002	42	Full service resort hotel, health spa services, and providing convention facilities.	October 2, 2001	BACARA RESORT & SPA

B	2,589,268	16	Note pads; memo pads, mounted and unmounted photographs; paper bags; pens and pencils; stationery; brochures about travel and health and newsletters in the fields of travel and health; postcards, posters.	July 2, 2002	BACARA
C	2,589,269	18	Umbrellas; bags, namely, toiletry cases sold empty, handbags, backpacks, athletic bags, duffel bags, cosmetic bags sold empty, luggage.	July 2, 2002	2589268
D	2,589,271	25	Clothing, namely, sweatshirts and sweatpants, shirts, jackets, ties, sweaters, caps, visors, hats, robes, swimwear, socks.	July 2, 2002	BACARA
E	2,847,711	29	[Amended] Jams, fruit preserves, dried fruit, olive oils, edible oils, soup.	June 1, 2004	BACARA

Copies of these registrations are appended to this Notice of Opposition as Exhibits A through E. These registrations are currently valid and subsisting with Registration Numbers 2,494,002; 2,589,268; 2,589,269; 2,589,271 and 2,847,711 being incontestable. Hereinafter, the marks in Exhibits A through E are referred to as Opposer's Marks.

9. Opposer's Marks are distinctive and famous.

THE "BECKARO" APPLICATION

10. Applicant has applied to register the BECKARO mark shown in Serial No. 85/503,083, filed on December 23, 2011, for "clothing, namely, sweaters, trousers, jackets, dresses, cardigans, coats, scarves, anoraks, shorts, T-shirts, underwear, shirts, tights, socks, bathing suits, headgear, namely, hats, sun hats, caps, footwear" in class 25, based on intent to use and based on French Registration No. 92436729, registered on October 1, 1982 (hereinafter, "Applicant's Mark").

11. On information and belief, no actual or constructive use was made in the United States of Applicant's Mark prior to December 23, 2011.

12. There is no issue as to priority. Opposer's first use and its registration dates for the above-identified registrations long precede Applicant's December 23, 2011 application to register the mark BECKARO.

13. Opposer's Marks were used in commerce and registered, and said marks became famous, long prior to the first actual or constructive use of Applicant's Mark.

14. Opposer first used the above-identified registrations for the goods and services listed therein in the United States prior to the first actual or constructive use of Applicant's Mark in the United States, and such use has continued to present.

15. Applicant's Mark has a similar sound to Opposer's Marks (*i.e.*, BEC KAR O vs. BA CAR A).

16. Applicant's Mark is similar in appearance to Opposer's Marks to the extent that both have the same format, structure and syntax.

17. The BACARA mark has no descriptive meaning in the trade or as applied to the goods or services listed in the above-referenced registrations. The BACARA mark is a coined word.

18. The BACARA marks are strong.

19. The BECKARO mark has no English translation or descriptive meaning in the trade or as applied to the goods listed in the application.

20. Applicant's Mark identified eight products (*i.e.*, sweaters, jackets, shirts, socks, bathing suits, hats, sun hats, and caps) identical to the Opposer's Registration No. 2,589,271.

21. Given the similarities between the marks and relatedness of the respective goods, and Opposer's prior registration and use in the United States and not abandoned, Applicant's Mark, when used on or in connection with the goods of Applicant, is likely to cause confusion, and mistake as to the source or sponsorship of Applicant's goods under Section 2(d) of the Act.

22. Consumers are likely to mistakenly presume that there is a connection between Applicant and Opposer that does not exist, or that Applicant's goods are affiliated with, licensed or sponsored by Opposer.

23. Additionally, any defect or fault found with Applicant's goods will necessarily reflect upon and seriously injure the reputation that Opposer has established for its products and services marketed under the BACARA mark.

24. Independently, Applicant's intended use of the BECKARO mark is likely to dilute or will dilute the distinctive quality of Opposer's distinctive and famous BACARA Marks in violation of Section 43(c) of the Act

25. The registration of Applicant's Mark on the Principal Register would be inconsistent with Opposer's rights under the above-referenced registrations and common law, and would be damaging to Opposer.

WHEREFORE, the Board should sustain this opposition and Application 85/503,083 should be refused registration for the goods "Clothing, namely, sweaters, trousers, jackets, dresses, cardigans, coats, scarves, anoraks, shorts, T-shirts, underwear, shirts, tights, socks, bathing suits, headgear, namely, hats, sun hats, caps, footwear" in class 25.

CERTIFICATE OF SERVICE

I, Michelle Mehok, hereby certify that on this 15th day of May, 2013, a true copy of the foregoing **NOTICE OF OPPOSITION** was served on Applicant's counsel of record by depositing said copy, via certified First Class Mail, in the United States mail in a sealed envelope with postage thereon fully prepaid, addressed as follows:

WILLIAM C. WRIGHT
EPSTEIN DRANGEL LLP
60 E 42ND ST STE 2410
NEW YORK, NY 10165-0011

Executed: May 15, 2013

/michelle mehok/
Michelle Mehok

CERTIFICATE OF FILING

I, Michelle Mehok, hereby certify that on this 15th day of May, 2013, an electronic copy of Opposer's' foregoing **NOTICE OF OPPOSITION** was electronically filed in the United States Patent and Trademark Office Before the Trademark Trial and Appeal Board Electronic Filing System.

Executed: May 15, 2013

/michelle mehok/
Michelle Mehok

EXHIBIT A

Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 2,494,002

Registered Oct. 2, 2001

**SERVICE MARK
PRINCIPAL REGISTER**

BACARA RESORT & SPA

HT-SANTA BARBARA, INC. (DELAWARE COR-
PORATION)
C/O MARK KRUGMAN
645 FIFTH AVENUE, 8TH FLOOR
NEW YORK, NY 10022

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "RESORT & SPA", APART FROM
THE MARK AS SHOWN.

FOR: FULL SERVICE RESORT HOTEL, HEALTH
SPA SERVICES, AND PROVIDING CONVENTION
FACILITIES, IN CLASS 42 (U.S. CLS. 100 AND 101).

SER. NO. 75-894,243, FILED 1-11-2000.

FIRST USE 8-30-1999; IN COMMERCE 8-30-1999.

SUSAN HAYASH, EXAMINING ATTORNEY

EXHIBIT B

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50

Reg. No. 2,589,268

United States Patent and Trademark Office

Registered July 2, 2002

**TRADEMARK
PRINCIPAL REGISTER**

BACARA

HT-SANTA BARBARA, INC. (DELAWARE COR-
PORATION)
C/O MARK KRUGMAN
645 FIFTH AVENUE, 8TH FLOOR
NEW YORK, NY 10022

HEALTH; POSTCARDS; POSTERS, IN CLASS 16
(U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 5-1-2000; IN COMMERCE 5-1-2000.

OWNER OF U.S. REG. NO. 2,494,002.

SN 75-911,260, FILED 2-4-2000.

FOR: NOTE PADS; MEMO PADS; MOUNTED
AND UNMOUNTED PHOTOGRAPHS; PAPER
BAGS; PENS AND PENCILS; STATIONERY; BRO-
CHURES ABOUT TRAVEL AND HEALTH AND
NEWSLETTERS IN THE FIELDS OF TRAVEL AND

SUSAN HAYASH, EXAMINING ATTORNEY

EXHIBIT C

Int. Cl.: 18

Prior U.S. Cls.: 1, 2, 3, 22, and 41

United States Patent and Trademark Office

Reg. No. 2,589,269

Registered July 2, 2002

**TRADEMARK
PRINCIPAL REGISTER**

BACARA

HT-SANTA BARBARA, INC. (DELAWARE COR-
PORATION)
C/O MARK KRUGMAN
645 FIFTH AVENUE, 8TH FLOOR
NEW YORK, NY 10022

FIRST USE 9-1-2000; IN COMMERCE 9-1-2000.

OWNER OF U.S. REG. NO. 2,494,002.

FOR: UMBRELLAS; BAGS, NAMELY, TOILETRY
CASES SOLD EMPTY, HANDBAGS, BACKPACKS,
ATHLETIC BAGS, DUFFEL BAGS, COSMETIC
BAGS SOLD EMPTY, LUGGAGE , IN CLASS 18
(U.S. CLS. 1, 2, 3, 22 AND 41).

SN 75-911,261, FILED 2-4-2000.

SUSAN HAYASH, EXAMINING ATTORNEY

EXHIBIT D

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,589,271

Registered July 2, 2002

**TRADEMARK
PRINCIPAL REGISTER**

BACARA

HT-SANTA BARBARA, INC. (DELAWARE COR-
PORATION)
C/O MARK KRUGMAN
645 FIFTH AVENUE, 8TH FLOOR
NEW YORK, NY 10022

FIRST USE 9-1-2000; IN COMMERCE 9-1-2000.

OWNER OF U.S. REG. NO. 2,494,002.

FOR: CLOTHING, NAMELY, SWEATSHIRTS
AND SWEATPANTS, SHIRTS, JACKETS, TIES,
SWEATERS, CAPS, VISORS, HATS, ROBES, SWIM-
WEAR, SOCKS , IN CLASS 25 (U.S. CLS. 22 AND 39).

SN 75-911,266, FILED 2-4-2000.

SUSAN HAYASH, EXAMINING ATTORNEY

EXHIBIT E

Int. Cl.: 29

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 2,847,711

Registered June 1, 2004

**TRADEMARK
PRINCIPAL REGISTER**

BACARA

HT-SANTA BARBARA, INC. (DELAWARE COR-
PORATION)
C/O MARK KRUGMAN
645 FIFTH AVENUE, 8TH FLOOR
NEW YORK, NY 10022

FOR: JAMS, FRUIT PRESERVES, DRIED FRUIT,
OLIVE OILS, EDIBLE OILS, BUTTER, CAVIAR,

SALMON FOR FOOD PURPOSES, FOIE GRAS,
SOUP, IN CLASS 29 (U.S. CL. 46).

FIRST USE 1-10-2004; IN COMMERCE 1-10-2004.

SN 75-911,268, FILED 2-4-2000.

SUSAN HAYASH, EXAMINING ATTORNEY