

ESTTA Tracking number: **ESTTA550171**

Filing date: **07/24/2013**

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	Ermenegildo Zegna Corporation
Granted to Date of previous extension	08/03/2013
Address	100 West Forest Avenue - Unit A, Englewood, NJ 07631 UNITED STATES

Attorney information	John M. Cone Hitchcock Evert LLP PO Box 131709 Dallas, TX 75313-1709 UNITED STATES jcone@hitchcockevert.com, docket@hitchcockevert.com, ksimpson@hitchcockevert.com Phone:2148807002
----------------------	--

Applicant Information

Application No	85821205	Publication date	06/04/2013
Opposition Filing Date	07/24/2013	Opposition Period Ends	08/03/2013
Applicant	Laurie Marvald 15F 360 West 22nd St New York, NY 10011 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Boot accessories, namely, fitted decorative covers for boots

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	941547	Application Date	07/26/1971
Registration Date	08/22/1972	Foreign Priority Date	NONE
Word Mark	ZEGNA		
Design Mark			

Description of Mark	NONE
Goods/Services	Class U042 (International Class 024). First use: First Use: 1938/00/00 First Use In Commerce: 1938/00/00 PIECE GOODS OF VARIOUS DIFFERENT FABRICS, BED COVERS AND TABLE COVERS

U.S. Registration No.	1258643	Application Date	09/28/1982
Registration Date	11/22/1983	Foreign Priority Date	NONE
Word Mark	ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1982/06/16 First Use In Commerce: 1982/06/16 Shoes, Belts, Hats, Ties, Scarves, Robes, Suits, Sports Jackets, Topcoats, Overcoats, Raincoats, Leather Coats and Jackets, Car Coats, Slacks, Vests, Knit and Woven Shirts, Formal and Sport Shirts, Bathing Suits, Short Pants, Sweaters, Socks, Quilted Jackets and Coats, Long Pants, [Long and Short Woven and Knit Underwear,] Athletic Shorts, Sleeveless and Sleeved Knit and Woven Shirts, [Boxer Shorts, Waistbands,] Gloves, Balaklava, [Jumpsuits, Skirts and Blouses]		

U.S. Registration No.	2640485	Application Date	07/10/2000
Registration Date	10/22/2002	Foreign Priority Date	NONE
Word Mark	ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2001/03/00 First Use In Commerce: 2001/03/00 retail stores and departments in retail stores featuring men's clothing, footwear and accessories		

U.S. Registration No.	3592574	Application Date	12/17/2007
Registration Date	03/17/2009	Foreign Priority Date	NONE
Word Mark	Z ZEGNA		
Design Mark			
Description of Mark	The mark consists of the letter "Z" and the word "ZEGNA".		
Goods/Services	Class 018. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 leather goods, namely, wallets, credit card holders, business card cases, key chains, key cases, brief cases, bags Class 025. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 clothing, namely, suits, jackets, coats, pants, shorts, shirts, sweaters, T-shirts, tops, ties, scarves, hats, caps, belts, shoes, sweaters, overcoats		

U.S. Registration No.	3121451	Application Date	10/13/2003
Registration Date	07/25/2006	Foreign Priority Date	NONE
Word Mark	ZEGNASPORT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2005/05/00 First Use In Commerce: 2005/10/00 clothing, namely, coats, pants, shorts, shirts, T-shirts, sweatshirts, sweatpants, fleece tops, fleece jackets, sweaters, hats, caps, scarves, swimwear, footwear		

U.S. Registration No.	3143118	Application Date	06/29/2004
Registration Date	09/12/2006	Foreign Priority Date	NONE
Word Mark	ZEGNASPORT Z		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2004/07/00 First Use In Commerce: 2004/07/00 Clothing, namely, sports jackets, coats, pants, trousers, slacks, jeans, shorts, shirts, T-shirts, tops, sweatshirts, sweatpants, fleece tops, fleece jackets, sweaters, cardigans, vests, hats, caps, scarves, gloves, socks, swimwear, footwear		

U.S. Registration No.	4017152	Application Date	10/11/2010
Registration Date	08/23/2011	Foreign Priority Date	NONE
Word Mark	ZEGNASPORT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/10/00 First Use In Commerce: 2003/10/00 retail stores featuring men's clothing and accessories		

U.S. Registration No.	4075069	Application Date	10/11/2010
Registration Date	12/20/2011	Foreign Priority Date	NONE
Word Mark	ZEGNASPORT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2000/06/00 First Use In Commerce: 2000/06/00 leather goods, namely, wallets, credit card holders, business card cases, tie cases for travelling, key chains, key cases, brief cases, bags, backpacks		

U.S. Registration	612666	Application Date	11/30/1953
-------------------	--------	------------------	------------

No.			
Registration Date	09/20/1955	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U042 (International Class 024). First use: FABRICS OF WOOL, HAIR, VEGETABLE HAIR, SILK, RAYON, JUTE, HEMP, FLAX, COTTON		

U.S. Registration No.	1077923	Application Date	08/20/1974
Registration Date	11/22/1977	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1937/00/00 First Use In Commerce: 1938/00/00 SUITS, COATS, NECKTIES, AND SCARVES		

U.S. Registration No.	1232762	Application Date	05/21/1981
Registration Date	03/29/1983	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1980/11/15 First Use In Commerce: 1980/11/15 Small Leather Goods-Namely, Wallets, Billfolds, Change Purses, Credit Card Holders, Briefcases and Attache Cases, Business Card Cases, Tie Cases for Traveling, Cosmetic Cases Sold Empty and Tote Bags		

U.S. Registration No.	1232830	Application Date	04/27/1981
Registration Date	03/29/1983	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1937/00/00 First Use In Commerce: 1938/00/00 Shoes, Belts, Hats, Ties, Scarves, Robes, Suits, Sports Jackets, Topcoats, Overcoats, Raincoats, Leather Coats and Jackets, Car Coats, Slacks, Vests, Knit and Woven Shirts, Formal and Sport Shirts, Bathing Suits, Short Pants, Sweaters, Socks, Quilted Jackets and Coats, Long Pants, Long and Short Woven and Knit Underwear, Athletic Shorts, Sleeveless and Sleeved Knit and Woven Shirts, Boxer Shorts, Waistbands, Gloves, [Balaklava, Jumpsuits, Skirts and Blouses]		

U.S. Registration No.	1235315	Application Date	04/27/1981
Registration Date	04/19/1983	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 1978/10/11 First Use In Commerce: 1978/10/11 Piece Goods of Natural and/or Synthetic Fibers, [Bed Covers,] Blankets, [Handkerchiefs,] Bed Throws [, and Towels]		

U.S. Registration No.	1273447	Application Date	01/03/1983
Registration Date	04/10/1984	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1981/07/24 First Use In Commerce: 1981/07/24 Jewelry		

U.S. Registration No.	1999495	Application Date	07/19/1995
Registration Date	09/10/1996	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1937/00/00 First Use In Commerce: 1992/00/00 sportswear, namely sweatshirts, [sweatpants], scarves, hats, caps, gloves, belts, [bathing suits], shirts, vests, [T-shirts]		

U.S. Registration No.	1999496	Application Date	07/19/1995
Registration Date	09/10/1996	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1993/00/00 First Use In Commerce: 1993/00/00 [eau de toilette] Class 025. First use: First Use: 1946/00/00 First Use In Commerce: 1992/00/00 [underwear, namely briefs,] [undershirts], socks; outerwear, namely coats, jackets, sportswear, namely sweatshirts, sweatpants, scarves, [hats, caps, gloves], belts, bathing suits, shirts, vests, T-shirts, sweaters, shirts, jackets,		

	slacks, shorts		
U.S. Registration No.	2161723	Application Date	03/25/1997
Registration Date	06/02/1998	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 retail stores featuring men's clothing, accessories and toiletries		
U.S. Registration No.	3130777	Application Date	06/29/2004
Registration Date	08/15/2006	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA Z		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2004/07/00 First Use In Commerce: 2004/07/00 leather goods, namely, wallets, credit card holders, business card cases, tie cases for traveling, cosmetic cases sold empty, key chains, key fobs, key cases Class 025. First use: First Use: 2004/07/00 First Use In Commerce: 2004/07/00 clothing, namely, suits, jackets, coats, pants, shorts, shirts, sweaters, T-shirts, socks, ties, scarves		
U.S. Registration No.	3465506	Application Date	05/14/2007
Registration Date	07/15/2008	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2006/02/00 First Use In Commerce: 2006/03/00 on-line retail store services featuring men's clothing, accessories and toiletries		
U.S. Registration No.	3576300	Application Date	11/21/2006
Registration Date	02/17/2009	Foreign Priority Date	09/27/2006
Word Mark	ERMENEGILDO ZEGNA COUTURE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: clothing, namely, overcoats, coats, suits, tuxedos, jackets, sports coats, blazers, pants, trousers, shirts, sweaters, pullovers, cardigans, vests, ties, pocket		

	squares, scarves; belts; footwear and headwear		
U.S. Registration No.	3857681	Application Date	03/05/2009
Registration Date	10/05/2010	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2010/05/00 First Use In Commerce: 2010/05/00 watches		
U.S. Registration No.	3857682	Application Date	03/05/2009
Registration Date	10/05/2010	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2010/05/00 First Use In Commerce: 2010/05/00 writing instruments		
U.S. Registration No.	4068320	Application Date	09/08/2010
Registration Date	12/06/2011	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA DUO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2010/06/00 First Use In Commerce: 2010/06/00 clothing, namely, suits, jackets		
U.S. Application No.	85704065	Application Date	08/15/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ERMENEGILDO ZEGNA E Z		
Design Mark			
Description of Mark	The mark consists of a circle design; in the outer portion of the circle across the top are the words "ERMENEGILDO ZEGNA"; in the outer portion of the circle across the bottom are five star-like designs; in the middle of the circle is a crest with the letters "E" and "Z" separated by a star design in the upper portion and a lion design in the lower portion.		
Goods/Services	Class 014. First use: watches, cufflinks Class 016. First use: writing instruments		

	<p>Class 018. First use: leather goods, namely, wallets, credit card holders, business card cases, tie cases for traveling, cosmetic cases sold empty, key chains, key cases, brief cases, bags, backpacks</p> <p>Class 025. First use: clothing, namely, overcoats, raincoats, coats, suits, tuxedos, jackets, sports jackets, blazers, pants, trousers, jeans, shorts, shirts, T-shirts, tops, sweatshirts, sweatpants, sweaters, pullovers, cardigans, vests, swimwear, ties, pocket squares, gloves, scarves, belts, headwear, footwear</p> <p>Class 035. First use: retail stores featuring men's clothing and accessories; departments in retail stores featuring men's clothing and accessories; on-line retail store services featuring men's clothing and accessories</p>
--	---

Attachments	130724 Notice of Opposition 85-821205.pdf(13885 bytes)
-------------	---

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	/s/ John M. Cone
Name	John M. Cone
Date	07/24/2013

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

In the Matter of Application Serial No. 85/821,205 ZEGZ

<hr/> ERMENEGILDO ZEGNA CORPORATION, Opposer,	§	
	§	
	§	
v.	§	Opposition No. _____
	§	
LAURIE MARVALD,	§	
Applicant.	§	
<hr/>		

TO THE HONORABLE TRADEMARK TRIAL AND APPEAL BOARD:

NOTICE OF OPPOSITION

1. Opposer is the owner of the famous ZEGNA brand of men’s clothing and fabric which has been sold in the U.S. since as long ago as 1938 under various trademarks that consist of or include the term ZEGNA, including ZEGNA, ERMENEGILDO ZEGNA, Z ZEGNA and ZEGNASPORT. Worldwide sales of ZEGNA goods in 2012 were estimated to be \$1.61 billion.

2. Opposer is the owner of the following valid and subsisting U.S. Trademark Registrations consisting of or including ZEGNA:

<u>Reg./App. No.</u>	<u>Mark</u>
941,547	ZEGNA
1,258,643	ZEGNA
2,640,485	ZEGNA
3,592,574	Z ZEGNA
3,121,451	ZEGNASPORT
3,143,118	ZEGNASPORT Z & Design
4,017,152	ZEGNASPORT
4,075,069	ZEGNASPORT
612,666	ERMENEGILDO ZEGNA & Design
1,077,923	ERMENEGILDO ZEGNA
1,232,762	ERMENEGILDO ZEGNA
1,232,830	ERMENEGILDO ZEGNA
1,235,315	ERMENEGILDO ZEGNA

<u>Reg./App. No.</u>	<u>Mark</u>
1,273,447	ERMENEGILDO ZEGNA
1,999,495	ERMENEGILDO ZEGNA
1,999,496	ERMENEGILDO ZEGNA & Design
2,161,723	ERMENEGILDO ZEGNA
3,130,777	ERMENEGILDO ZEGNA Z & Design
3,465,506	ERMENEGILDO ZEGNA
3,576,300	ERMENEGILDO ZEGNA & Design
3,857,681	ERMENEGILDO ZEGNA
3,857,682	ERMENEGILDO ZEGNA
4,068,320	ERMENEGILDO ZEGNA DUO
85/704,065	ERMENEGILDO ZEGNA EZ & Design

3. Each of the registrations identified in paragraph 2 constitutes *prima facie* evidence of the validity of the registered mark, and of the registration of the mark, and of Opposer's exclusive right to use the registered mark in commerce on the goods of the registration and is constructive notice of Opposer's ownership of the mark.

4. In addition, Opposer's right to use the marks of Registrations Nos. 941,547, 1,077,923, 1,232,762, 1,232,830, 1,235,315, 1,258,643, 1,273,447, 1,999,495, 1,999,496, 2,161,723, 2,640,485, and 3,121,451 has become incontestable under 15 U.S.C. § 1065 and those registrations are conclusive evidence of the validity of the registered marks, of the registrations of the marks, of Opposer's ownership of the marks, and of Opposer's exclusive right to use the registered marks in commerce for the goods of the registration

5. Upon information and belief, and according to the records of the United States Patent and Trademark Office, Applicant has filed Application Serial No. 85/821,205 ZEGZ for "Boot accessories, namely, fitted decorative covers for boots" in International Class 25.

6. Opposer's rights in the name and mark ZEGNA were established long before the priority date of Applicant's mark ZEGZ.

7. Opposer's name and mark ZEGNA are famous and entitled to a wide ambit of protection. Opposer has used its name and registered and used its marks for goods that are complementary to those of Application Serial No. 85/821,205.
8. Upon information and belief, the trademark sought to be registered by Applicant in Application Serial No. 85/821,205 consists of a mark which is so similar to Opposer's trademarks identified in Section 2 previously used and registered and its trade name ZEGNA previously used in U.S. commerce, as to be likely, when applied to the goods of Applicant, to cause confusion or to cause mistake or to deceive, and to thereby cause damage to Opposer.
9. Registration of the mark ZEGZ for the goods of Application Serial No. 85/821,205 would damage Opposer's established rights in the mark ZEGNA.

WHEREFORE, Opposer prays that Applicant be required to answer this Notice of Opposition; that Application Serial No. 85/821,205 be denied; that the mark ZEGZ be refused registration; and that Opposer be awarded such other and further relief as may be deemed to be just and proper.

Dated: July 24, 2013

Respectfully submitted,

/s/ John M. Cone
John M. Cone
Hitchcock Evert LLP
P.O. Box 131709
Dallas, Texas 75313-1709
(214) 880-7002 Telephone
(214) 953-1121 Facsimile
jcone@hitchcockevert.com

ATTORNEY FOR OPPOSER
ERMENEGILDO ZEGNA CORPORATION

CERTIFICATE OF SERVICE

I certify that on the 24th day of July, 2013 this Notice of Opposition was served on the Applicant by mailing a copy thereof to:

Laurie Marvald DBA Zegz
15F 360 West 22nd St
New York NEW YORK 10011

/s/John M. Cone