

ESTTA Tracking number: **ESTTA555402**

Filing date: **08/21/2013**

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	Mary Kay Inc.
Granted to Date of previous extension	08/21/2013
Address	16251 Dallas Parkway11.300 TMKB Addison, TX 75001 UNITED STATES

Attorney information	Richard J. Groos Fulbright & Jaworski LLP 98 San Jacinto Blvd., Suite 1100 Austin, TX 78701 UNITED STATES aoipdocket@nortonrosefulbright.com, sheri.hunter@nortonrosefulbright.com, kellie.pfertner@nortonrosefulbright.com Phone:512.474.5201
----------------------	---

**Applicant Information**

Application No	85622261	Publication date	04/23/2013
Opposition Filing Date	08/21/2013	Opposition Period Ends	08/21/2013
Applicant	Michael Kors, L.L.C. 11 West 42nd Street New York, NY 10036 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 018. First Use: 2007/12/01 First Use In Commerce: 2007/12/01 All goods and services in the class are opposed, namely: Bags, namely, handbags, tote bags; purses; clutches; wristlet handbags; wallets; coin purses; credit card cases; key cases
Class 025. First Use: 2007/09/01 First Use In Commerce: 2007/09/01 All goods and services in the class are opposed, namely: Clothing, namely, belts, gloves, arm warmers, neck warmers, scarves, stoles, ear muffs, coats, vests, jackets, leather jackets, rain wear and swim wear; footwear and headwear

**Grounds for Opposition**

Other	Breach of Contract
-------	--------------------

Attachments	Notice of Opposition.pdf(18006 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	/Richard J. Groos/
Name	Richard J. Groos
Date	08/21/2013

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

MARY KAY INC.	)	
	)	Opposition No. _____
	)	
v.	)	Serial No. 85/622,261
	)	
MICHAEL KORS, L.L.C.	)	Mark: MK MICHAEL KORS & DESIGN

**NOTICE OF OPPOSITION**

Opposer Mary Kay Inc. (“Mary Kay”), a Delaware corporation having its principal place of business located at 16251 Dallas Parkway, Addison, Texas 75001, believes it will be damaged by registration of Application Serial No. 85/622,261 (the “Application”) in the name of Michael Kors, L.L.C. (“Applicant”) for the design mark MK MICHAEL KORS, and hereby opposes the same under the provisions of 15 U.S.C. § 1063. The grounds for opposition are as follows:

1. Mary Kay is a global manufacturer and wholesale distributor of cosmetics, toiletries, skin care, and related products. In 2012, Mary Kay’s global sales surpassed \$3 billion and its number of independent beauty consultants grew to approximately 2.4 million worldwide. The worldwide success and recognition of the Mary Kay brand is undeniable as the Company’s products are now sold in over thirty-five (35) markets around the world. Founded in 1963, Mary Kay has become one of the best known direct sellers of skin care products and color cosmetics in the United States. Moreover, its founder, Mary Kay Ash, has been widely recognized as one of the most influential businesswomen in history.
2. Applicant is a luxury apparel, fragrance, footwear, accessories, cosmetics and cosmetic products company.
3. In 2003, Applicant attempted to register the mark ‘MK MICHAEL KORS’ for use with various goods including cosmetics, fragrances and related goods. Mary Kay objected to the 2003 application on the basis of its prior registrations, use of, and rights in various “MK” marks and filed an opposition proceeding in May 2005.

4. Mary Kay and Applicant subsequently settled the opposition proceeding (No. 91165106) entering into a Settlement and Coexistence Agreement (the “Coexistence Agreement”) in November 2005. The Coexistence Agreement places restrictions and limitations on Applicant’s use and registration of certain ‘MK’ marks. These restrictions include Applicant’s agreement not to register the mark ‘MK’ standing alone in any International Class or to register or use ‘MK’ in combination with ‘Michael Kors’ in International Class 3 or for any cosmetic products or services in any International Class.
5. Contrary to and in breach of the Coexistence Agreement, Applicant filed two unauthorized applications, Application Serial No. 85/622,286 (for the encircled mark ‘MK’) and the current Application herein opposed.
6. Thereafter, Mary Kay filed the civil case *Mary Kay Inc. v. Michael Kors LLC*, No. DC13-01663, currently pending in the District Court of Dallas County, Texas, 68<sup>th</sup> Judicial District. The lawsuit asserts violations of the Coexistence Agreement, including breach of contract claims related to Applicant’s filing of the unauthorized applications. Subsequent to the filing of the lawsuit, Applicant expressly abandoned Application Serial No. 85/622,286, but did not abandon the current Application.
7. Mary Kay now files this Opposition on the grounds that Applicant’s filing of the Application and attempt to register the mark therein constitutes a breach of the Coexistence Agreement, as set forth herein.

**Applicant’s Agreement Not to Register**

8. On July 24, 2003, Applicant filed Application Serial No. 78/278,276 seeking registration of the typed words “MK MICHAEL KORS” (the “Kors Original Application”) for use with various goods including cosmetics, fragrances, and related goods. Given Mary Kay’s prior registrations, use of, and rights to various “MK” marks, Mary Kay challenged the Kors Original Application, filing its Notice of Opposition with the United States Patent and Trademark Office on May 6, 2005 (No. 91165106).

9. On November 21, 2005, Mary Kay and Applicant executed the Coexistence Agreement to resolve the parties' dispute. Mary Kay agreed to withdraw its opposition to the Kors Original Application, but only in exchange for strict and specific limitations on Applicant's use and registration of certain "MK" marks.
10. Specifically, with respect to goods and services within International Class 3 and "all cosmetic products and services in any class," Applicant agreed it would: (a) "not use or register 'MK', standing alone, on or in connection with any products whatsoever in international class 3, or any cosmetic products or services[;]" (b) "not use or register 'MK', even in close proximity with 'Michael Kors', in connection with any class 3 products, or any cosmetics products or services[;]" and (c) "not seek to register any trademark that includes 'MK' in international class 3, or for any cosmetic products or services." (Coexistence Agreement §§ 2.1-2.3.) Significantly, Section 2 of the Coexistence Agreement broadly prohibits Applicant from any use or registration whatsoever of the mark "MK" standing alone, or even in close proximity with "Michael Kors," on or in connection with any Class 3 products or any cosmetic products or services.
11. In August 2011 and again in October 2011, Applicant asked Mary Kay to agree to modify the Coexistence Agreement to allow Applicant to register the encircled "MK" mark outside of International Class 3. Mary Kay did not agree to modify the terms of the Coexistence Agreement to allow the registration of the encircled "MK" mark. Notwithstanding the restrictive covenants of the Coexistence Agreement and without Mary Kay's consent, Applicant filed two unauthorized applications for trademark registration on May 12, 2012, one of which is the subject Application.
12. Applicant's Application constitutes a breach of Sections 2 and 3 of the Coexistence Agreement. Applicant's broad goods identification would include, among other things, cosmetic products, which places the Application squarely within the restrictions imposed on Applicant in Sections 2 and 3 of the Coexistence Agreement. Pursuant to these

provisions, Applicant is prohibited from applying to register either an “MK” mark standing alone or an “MK” mark with “Michael Kors” for use with cosmetic products or services in any International Class.

13. Further, the filing of the Application violates Applicant’s agreement under Sections 2.5 and 3.5 of the Coexistence Agreement with respect to Mary Kay’s rights to use and register the “MK” mark. Section 2.5 provides that Applicant will not place any restrictions whatsoever on Mary Kay’s use or registration of “MK” in International Class 3 or its use or registration thereof with any cosmetic products and services in any International Class. Section 3.5 states that Mary Kay shall have the unrestricted right to use and register “MK” consistent with Mary Kay’s past practice in any International Class. In contradiction to its agreement under these two provisions of the Coexistence Agreement, Applicant’s filing of the Application interferes with Mary Kay’s unrestricted use and registration rights in that the Application by its nature claims rights in “MK” superior to those of Mary Kay. Accordingly, the Application violates the proscriptions imposed on Applicant in Sections 2 and 3 of the Coexistence Agreement.
14. Notwithstanding the prohibitions against registration in the Coexistence Agreement, Applicant nevertheless filed the Application in breach of the agreement.

WHEREFORE, Mary Kay respectfully requests that the registration sought by the Applicant be refused in accordance with the provisions of the Lanham Act, that no registration be issued, and that this Opposition be sustained in its favor.

Respectfully submitted,

Dated: August 21, 2013

By: /Richard J. Groos/

Richard J. Groos  
Sheri M. Hunter  
FULBRIGHT & JAWORSKI L.L.P.  
98 San Jacinto Blvd., Suite 1100  
Austin, Texas 78701  
Tel: 512.474.5201  
Fax: 512.536.4598

Attorneys for Opposer, Mary Kay Inc.

**CERTIFICATE OF SERVICE**

I hereby certify that on August 21, 2013, a copy of the foregoing Notice of Opposition was served on Applicant via International First Class Mail to Applicant at the correspondence address of record, as follows:

NANCY DICONZA  
FROSS ZELNICK LEHRMAN & ZISSU, P.C.  
866 UNITED NATIONS PLZ  
NEW YORK, NEW YORK 10017-1822

/Sheri M. Hunter/  
Attorney for Opposer