

ESTTA Tracking number: **ESTTA556846**

Filing date: **08/29/2013**

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	Tre Milano, L.L.C.		
Entity	Limited Liability Company	Citizenship	California
Address	5826 Uplander Way Culver City, CA 90230 UNITED STATES		

Attorney information	C. Dennis Loomis Baker & Hostetler LLP 12100 Wilshire Blvd., 15th Floor Los Angeles, CA 90025 UNITED STATES cdloomis@bakerlaw.com Phone:310-442-8865		
----------------------	---	--	--

**Applicant Information**

Application No	85704678	Publication date	08/06/2013
Opposition Filing Date	08/29/2013	Opposition Period Ends	09/05/2013
Applicant	Gennaro, John 305 Country Club Lane Scotch Plains, NJ 07076 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 011. All goods and services in the class are opposed, namely: Hand held electric hair dryers and attachments for styling hair for hand held hair dryers sold together as a unit therewith
--

**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.	4260589	Application Date	03/19/2012
Registration Date	12/18/2012	Foreign Priority Date	NONE
Word Mark	INSTYLER PROFESSIONAL		
Design Mark			
Description of	The mark consists of the letters "IN" inside a dark circle, the perimeter of the		

Mark	circle is outlined and the entire circle is encased in a tube-like design which also includes the word "STYLER"; to the right of the design appears the word "PROFESSIONAL" in upper case type.
Goods/Services	Class 008. First use: First Use: 2012/03/01 First Use In Commerce: 2012/03/01 electric irons for styling hair

U.S. Registration No.	3496525	Application Date	02/14/2007
Registration Date	09/02/2008	Foreign Priority Date	NONE
Word Mark	INSTYLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2008/06/27 First Use In Commerce: 2008/06/27 Electric irons for styling hair		

U.S. Application No.	85370079	Application Date	07/13/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INSTYLER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: hair care preparations, namely shampoos, conditioners, rinses, mists, thermal protective sprays, spray conditioners, hair gels, spray gels, sculpting foam, styling serum, styling sprays, styling gels, styling lotions, straightening creams, hair sprays, pomades, shine sprays, hair strengthening preparations, hair straightening preparations Class 011. First use: hair dryers; hand-held electric hair dryers Class 021. First use: hair brushes, hair combs		

Attachments	notice of opposition - istyler.pdf(504618 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	/cdl/
Name	C. Dennis Loomis
Date	08/29/2013

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

TRE MILANO, L.L.C., a California  
limited liability company

*Opposer*

v.

JOHN GENNARO, an individual

*Applicant.*

---

§  
§  
§  
§  
§  
§  
§  
§  
§  
§

OPPOSITION NO. \_\_\_\_\_

**NOTICE OF OPPOSITION**

In re Application of John Gennaro

Serial No. 85/704,678  
Filed: August 15, 2012  
Trademark: **ISTYLER**  
Filing Basis: 1(b)  
Published: August 6, 2013

Opposer Tre Milano, L.L.C., a California limited liability company having a mailing address of 5826 Uplander Way, Culver City, California 90230 (“Opposer”) hereby opposes registration of the mark **ISTYLER** in International Class 011 for “Hand held electric hair dryers and attachments for styling hair for hand held hair dryers sold together as a unit therewith” (the “Opposed Mark”) of applicant John Gennaro, an individual having a mailing address of record with the United States Patent and Trademark Office (“USPTO”) of 305 Country Club Lane, Scotch Plains, New Jersey 07076 (“Applicant”), and as grounds therefore alleges as follows:

1. Opposer is the owner by assignment of U.S. Trademark Registration No. 3,496,525 for the mark **INSTYLER** in International Class 009, for use in connection with “electric irons for styling hair” with a date of first use in commerce of June 27, 2008 (the “**INSTYLER** ‘525 Registration”). The **INSTYLER** ‘525 Registration was registered on

September 2, 2008, to owner Revolutionary Products, Inc., and all rights in the INSTYLER '525 Registration were assigned by Revolutionary Products, Inc. to Opposer by assignment recorded on October 28, 2008.

2. Opposer is the owner of U.S. Trademark Registration No. 4,260,589 for the mark INSTYLER PROFESSIONAL in International Class 008, for use in connection with "electric irons for styling hair" with a date of first use in commerce of March 1, 2012 (the "INSTYLER '589 Registration"). The INSTYLER '589 Registration disclaims the exclusive right to use "Professional" apart from the mark as shown.

3. Opposer is the owner of U.S. Trademark Application Serial No. 85/370,079 for the mark INSTYLER, in: International Class 003, for use in connection with hair care preparations, including (among others) shampoos, conditioners, rinses and mists; in International Class 011, for use with hair dryers and hand-held electric hair dryers; and in International Class 021, for use with hair brushes and hair combs (the "INSTYLER Application"). The INSTYLER Application was filed on July 13, 2011, under Section 1(b). It was published for opposition on February 28, 2012. The Notice of Allowance for the INSTYLER Application was issued on April 24, 2012. Opposer has requested and has been granted extensions of time to file its Statement of Use for the INSTYLER Application, and that Application is in good standing.

4. Opposer has continuously used the INSTYLER mark on the goods covered by the INSTYLER '525 Registration since the date of first use declared therein, and has continuously used the INSTYLER PROFESSIONAL mark on the goods covered by the INSTYLER '589 Registration since the date of first use declared therein. Opposer intends in good faith to commence use in commerce on the goods covered by the INSTYLER Application within the

time allowed, specifically including on hair dryers and hand-held electric hair dryers in Class 011.

5. Opposer has regularly and routinely taken such action as it deemed necessary and appropriate under the circumstances to enforce Opposer's exclusive trademark rights as against third parties believed or suspected to be infringing, diluting or otherwise unlawfully interfering with Opposer's rights in the INSTYLER mark.

6. Opposer has, for more than five years, continuously used the INSTYLER mark on its famous, patented and market leading "InStyler" brand rotating heated hair styling tool, has engaged in extensive advertising and promotional efforts displaying the INSTYLER mark and product, has expended considerable sums to market those products, and has realized tremendous sales success for the INSTYLER brand of products, in the United States and worldwide, selling over eight million INSTYLER brand hair styling tools, representing more than \$500,00,000 in retail sales revenue. Opposer has extended and expanded the scope of its rights in the INSTYLER mark since March, 2012, by advertising, marketing, promoting and selling a professional grade "InStyler" brand rotating heated hair styling tool for the hair styling salon trade under the INSTYLER PROFESSIONAL mark.

7. By virtue of this long, continuous, prominent and successful use in commerce, as well as the excellence of the goods sold by Opposer under the INSTYLER and INSTYLER PROFESSIONAL marks, Opposer has acquired and maintained a valuable reputation and good will among consumers, retailers and the public at large associating the INSTYLER mark with Opposer and with Opposer's distinctive, high quality, market leading hair tool products, making INSTYLER one of the most well known and readily identifiable brands in the consumer and the professional hair tool marketplace. The INSTYLER mark is uniformly associated with and

recognized as the source identifier for Opposer's products. The INSTYLER marks are therefore famous as that term is defined and understood under the Lanham Trademark Act.

8. On or about August 15, 2012, Applicant filed its intent-to-use application under Section 1(b) with the USPTO for registration of the Opposed Mark INSTYLER, assigned Serial No. 85/704,678, in International Class No. 011, for use in connection with "Hand-held electric dryers for household use and styling devices that attach thereto" (the "Application").

9. On or about June 11, 2013, Applicant amended the Application by amending the description of goods to read as follows: "Hand held electric hair dryers and attachments for styling hair for hand held hair dryers sold together as a unit therewith."

10. The Application was published for Opposition on or about August 6, 2013.

11. Opposer believes that it will be damaged by registration of the Opposed Mark, in that:

a. the Opposed Mark "INSTYLER" is substantially identical to the INSTYLER mark covered by the INSTYLER '525 Registration and to the core element, namely, INSTYLER, of the INSTYLER '589 Registration, and the goods that Applicant proposes to market and sell under the Opposed Mark are directly and immediately related, in terms of function, target audience, product category and sales channels, with the goods sold under Opposer's INSTYLER mark, so that Applicant's registration and use of the Opposed Mark is likely to cause confusion and mistake and to deceive the public, injuring Opposer and the public;

b. The goods that Applicant proposes to market and sell under the Opposed Mark are identical to and directly competitive with the goods in Class 011 that Opposer proposes to market and sell under the INSTYLER Application, namely, "hand-held electric hair dryers." Opposer's INSTYLER Application is prior in time to the Opposed Application, giving Opposer

paramount and superior rights in its INSTYLER mark for the described goods over Applicant's claim of rights in the confusingly similar and nearly identical ISTYLE mark. Further, these goods are squarely within the zone of natural expansion of Opposer's rights under its INSTYLER '525 Registration and its INSTYLER '589 Registration.

c. Opposer is informed and believes and on that ground alleges that Applicant intends to gain notoriety and financial success by confusing the public by using the Opposed Mark, which so closely resembles Opposer's established and famous INSTYLER mark, as to exploit and trade upon Opposer's success for Applicant's unjust advantage; and

d. Applicant's registration and use of the Opposed Mark will dilute the distinctive quality of Opposer's famous INSTYLER mark as identifying a single source of goods, thereby causing irreparable damage to Opposer and to Opposer's INSTYLER mark under Section 43(c) of the Lanham Act.

WHEREFORE, Opposer prays for the following relief:

A. That judgment be entered in favor of Opposer and against Applicant, refusing registration of the Opposed Mark; and

B. That Opposer be granted such further relief, in law or in equity, to which it may be justly entitled.

Dated: August 28, 2013

Respectfully submitted,

/C. Dennis Loomis/

C. Dennis Loomis  
California State Bar No. 82359  
BAKER & HOSTETLER LLP  
12100 Wilshire Boulevard, 15<sup>th</sup> Floor  
Los Angeles, California 90025  
Tel.: (310) 820-8800  
Fax: (310) 820-8859  
email: cdloomis@bakerlaw.com

ATTORNEYS FOR OPPOSER  
TRE MILANO, LLC

**CERTIFICATE OF FILING**

I certify that the foregoing Notice of Opposition was filed electronically with the Commissioner for Trademarks, Trademark Trial and Appeal Board, via ESTTA on the 29th day of August, 2013.

/C. Dennis Loomis/  
C. Dennis Loomis

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **Notice of Opposition** was served this 29th day of August, 2013, by first-class U.S. mail, postage prepaid, upon counsel for the Applicant:

Margaret Polson  
Oppedahl Patent Law Firm LLC  
12000 Pecos St., Suite 252  
Westminster, Colorado 80234-2011

/C. Dennis Loomis/  
C. Dennis Loomis