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

Proceeding	91212768
Party	Plaintiff INTS It Is Not The Same, GmbH
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/836,544
Published in the Official Gazette on August 27, 2013

INTS It Is Not The Same, GmbH,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91212768
	§	
Disidual Clothing, LLC,	§	
	§	
Applicant.	§	

REVISED FIRST AMENDED NOTICE OF OPPOSITION

The Opposer, INTS It Is Not The Same, GmbH ("Opposer"), a Corporation organized under the laws of Switzerland and located at Baarerstrasse 98, Zug, Switzerland, CH-6302, believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

As grounds for opposition, it is alleged that:

1. The Applicant, Disidual Clothing, LLC ("Applicant"), a Limited Liability Company organized under the laws of Washington and located at 4208 Meridan Street, Bellingham, Washington, 98226, has filed an application to register the "DISIDUAL" mark for use in connection with "apparel, namely, t-shirts, tank-tops, shorts, hats, jackets, sweatshirts, hooded sweatshirts, beanies, socks, pants, dresses, swimsuits, knit face masks, gloves, belts" in International Class 025. Said application was filed on January 30, 2013 under Section 1(a) of the Trademark Act, was assigned U.S. Application No. 85/836,544 and was published for Opposition in the Official Gazette on August 27, 2013. Applicant's application was filed based on use of the mark claiming a date of

first use of at least as early as June 1, 2010 and a date of first use in commerce of at least as early as June 1, 2010.

2. Opposer is a leading manufacturer and seller of various products in various international classes, including clothing in International Class 025.

COUNT 1 - PRIORITY AND LIKELIHOOD OF CONFUSION

3. Commencing long prior to Applicant's filing date and alleged date of first use in commerce, Opposer has engaged, and is now engaged in the manufacture, distribution, sale, advertising and promotion in interstate commerce of clothing in International Class 025.

4. In connection therewith, Opposer is the owner of the following marks:

- a. the "DESIGUAL AND DESIGN" mark, U.S. Registration No. 2,088,319, filed on January 23, 1996 and registered on the Principal Register on August 12, 1997, for "clothing, namely footwear and headwear" in International Class 025. *See* [Exhibit A, U.S. Reg. No. 2,088,319].
- b. the "DESIGUAL (Stylized)" mark, U.S. Registration No. 3,737,499, filed on October 25, 2007 and registered on the Principal Register on January 12, 2010, for "bleaching preparations for household use and other substances, namely, laundry detergent for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices" in International Class 003, "sunglasses, spectacle cases, spectacle frames, sports glasses, contact lenses, cases for contact lenses, chains and cords for glasses, namely, pince-nez; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring,

signaling, checking, supervision, life-saving and teaching apparatus and instruments, namely, sensing and signaling devices for measurement and quality control of materials processing by laser; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, splices for electrical transmission lines, power-line transmission machines and apparatus; apparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers, blank record discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus" in International Class 009, "handbags, purses, traveling bags, backpacks, haversacks, traveling sets made of leather, namely, suitcases; trunks; umbrellas; parasols and walking sticks; purses made of leather; whips, harnesses and saddlery; wallets made of leather" in International Class 018, and "ready-made clothing for women, men and children, namely, pants, shorts, shirts, T-shirts, jackets, blouses, skirts, dresses; footwear; headgear, namely, hats and caps" in International Class 025. *See* [Exhibit B, U.S. Reg. No. 3,737,499].

- c. the "DESIGUAL AND DESIGN" mark, U.S. Registration No. 3,982,329, filed on February 12, 2010 and registered on the Principal Register on June 21, 2011, for "bleaching preparations for household use and other substances, namely, laundry detergent for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair

lotions; dentifrices" in International Class 003, "sunglasses, spectacle cases, spectacle frames, sports glasses, contact lenses, cases for contact lenses, chains and cords for glasses, namely, pince-nez; scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signaling, checking, supervision, life-saving and teaching apparatus and instruments, namely, sensing and signaling devices for measurement and quality control of materials processing by laser; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, splices for electrical transmission lines, power-line transmission machines and apparatus; apparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers, blank record discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus" in International Class 009, "handbags, purses, traveling bags, backpacks, haversacks, traveling sets made of leather, namely, suitcases; trunks; umbrellas; parasols and walking sticks; purses made of leather; whips, harnesses and saddlery; wallets made of leather" in International Class 018, "ready-made clothing for women, men and children, namely, pants, shorts, shirts, T-shirts, jackets, blouses, skirts, dresses; footwear; headgear, namely, hats and caps" in International Class 025, "retail shops for clothing, fashion and home design accessories of all kinds; dissemination of advertisements; modelling for advertising or sales

promotion; organisation of trade fairs for commercial or advertising purposes; advertising services; direct mail advertising" in International Class 035, and "distribution services, namely, delivery of clothing, fashion and home design accessories" in International Class 039. *See* [Exhibit C, U.S. Reg. No. 3,982,329].

- d. the "DESIGUAL (Stylized)" mark, U.S. Registration No. 4,113,640, filed on May 26, 2011 and registered on the Principal Register on March 20, 2012, for "bed linen, namely, bed blankets, bed spreads, bed covers, bed pads, pillow cases, mattress covers, bed sheets, sheet sets, duvets; table linen, namely, table cloths, not of paper, place mats, not of paper; towels; travelling rugs; bath linen, except clothing, namely, shower curtains" in International Class 024 and "retail store services featuring all kinds of ready-made clothing and accessories in the fields of fashion and design; dissemination of advertising matter; modeling for advertising or sales promotion; organization of trade fairs for commercial or advertising purposes; advertising; direct mail advertising" in International Class 035. *See* [Exhibit C, U.S. Reg. No. 4,113,640].
- e. the "DESIGUAL (Stylized)" mark, U.S. Registration No. 4,269,396, filed on October 17, 2011 and registered on the Principal Register on January 1, 2013, for "precious metals and their alloys; goods of precious metals or coated therewith, not included in other classes, namely, rings, bracelets, necklaces and watches; jewelry, precious stones; horological and chronometric

instruments" in International Class 014 and "furniture mirrors, picture frames; goods, not included in other classes, of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials or of plastics, namely, chairs, poufs, pillows, armchairs, stools, umbrella stands, tables" in International Class 020. *See* [Exhibit C, U.S. Reg. No. 4,269,396].

- f. the "DESIGUAL" mark, a common law mark used by Opposer since at least as early as 1995 for "clothing, footwear, and headwear" in International Class 025.

[Hereinafter collectively referred to as Opposer's "DESIGUAL" Marks].

5. Opposer's use of its "DESIGUAL AND DESIGN" mark, as reflected by U.S. Reg. No. 2,088,319, has been continuous, exclusive, public, and substantial since a date of first use in commerce at least as early as March 17, 1995. Opposer's use of its common law "DESIGUAL" mark has been continuous, exclusive, public, and substantial since a date of first use in commerce at least as early as 1995. Opposer's use of its "DESIGUAL (Stylized)" mark, as reflected by U.S. Reg. No. 3,737,499, has a constructive first use date of October 25, 2007. Opposer's use of its "DESIGUAL AND DESIGN" mark, as reflected by U.S. Reg. No. 3,982,329, has a constructive first use date of February 12, 2010. Opposer's use of its "DESIGUAL (Stylized)" mark, as reflected by U.S. Reg. No. 4,113,640, has a constructive first use date of May 26, 2011. Opposer's use of its "DESIGUAL (Stylized)" mark, as reflected by U.S. Reg. No. 4,269,396, has a constructive first use date of October 17, 2011.

6. Such first use dates and constructive first use dates for Opposer's "DESIGUAL" Marks are long prior to the filing date of Applicant's "DISIDUAL" mark, Application No. 85/836,544, filed on January 30, 2013 and claiming a date of first use in commerce of June 1, 2010.

7. Applicant's "DISIDUAL" mark would be confusingly similar because:

- a. the mark is confusingly similar in appearance to Opposer's "DESIGUAL" Marks;
- b. the mark is confusingly similar in sound to Opposer's "DESIGUAL" Marks;
- c. the mark is confusingly similar in connotation to Opposer's "DESIGUAL" Marks;
- d. the goods of Opposer and the goods of Applicant are closely related and/or marketed through the same or overlapping channels of trade and/or to the same classes of consumers;
- e. Opposer's "DESIGUAL" Marks enjoy a high level of distinctiveness.

8. Since Opposer's initial use of Opposer's "DESIGUAL" Marks, Opposer has made a substantial investment in advertising and promoting its goods under its trademarks. Opposer has extensively used, advertised, promoted and offered Opposer's goods and rendered services bearing Opposer's "DESIGUAL" Marks to the public through various channels of trade in commerce, with the result that Opposer's customers and the public in general have come to know and recognize Opposer's "DESIGUAL" Marks and associate the same with Opposer and/or goods sold by Opposer and/or services rendered by Opposer. As a result of such extensive use and advertisement, Opposer's customers and the public in general will in the future know and recognize Opposer's "DESIGUAL" Marks and associate the same with Opposer and/or the goods sold by Opposer and/or services rendered by Opposer.

9. Opposer's "DESIGUAL" Marks constitute the lawful, valued, subsisting, and exclusive property of the Opposer. As a result of the high quality of Opposer's goods and services that are sold under Opposer's "DESIGUAL" Marks, and the extensive sales and advertising made

under Opposer's "DESIGUAL" Marks, the aforementioned marks have become an intrinsic and essential part of the valuable goodwill and property of Opposer, and are recognizable and associated by the public as a symbol identifying and distinguishing Opposer's goods and services as those of exceptional quality.

10. Applicant's "DISIDUAL" mark, U.S. Application No. 85/836,544, so resembles Opposer's "DESIGUAL" Marks as to be likely to cause confusion or mistake, to suggest a connection, or to deceive purchasers into believing that Applicant's goods originate with the Opposer and/or are endorsed or sponsored by the Opposer, and/or that Applicant and/or its goods are otherwise affiliated with the Opposer and its goods.

11. Use of Applicant's "DISIDUAL" mark will inexorably have an adverse effect upon the value of Opposer's "DESIGUAL" Marks. If this Opposition is not sustained, any defect, objection to, or fault found with Applicant's goods provided under the "DISIDUAL" mark would necessarily reflect on and seriously injure the valuable goodwill and reputation that Opposer has established, and will establish, for its goods and services.

12. Based on the foregoing arguments, registration of the mark "DISIDUAL" for use in connection with "apparel, namely, t-shirts, tank-tops, shorts, hats, jackets, sweatshirts, hooded sweatshirts, beanies, socks, pants, dresses, swimsuits, knit face masks, gloves, belts" in International Class 025, as found in U.S. Application No. 85/836,544, filed on January 30, 2013 and published for Opposition in the Official Gazette on August 27, 2013, will cause injury and damage to Opposer.

13. Opposer therefore respectfully requests that this opposition be sustained and Applicant's application to register the "DISIDUAL" mark be refused.

COUNT 2 - APPLICANT'S MARKS IS VOID AB INITIO FOR FAILURE TO USE THE MARK AT THE TIME THE USE-BASED APPLICATION WAS FILED

14. During discovery in this matter, Applicant produced no documentary or other evidence of its use of the "DISIDUAL" mark in commerce on belts, gloves, dresses, and knit face masks at the time of filing its use-based "DISIDUAL" trademark application.

15. Despite Opposer's Requests for documents, Applicant produced no documents relating to its creation, development, marketing, advertising and/or sale of belts, gloves, dresses, and knit face masks bearing the "DISIDUAL" trademark at the time it filed its trademark application.

16. Applicant admitted in Response to Opposer's Requests for Production #2 that it has not used the "DISIDUAL" mark on dresses, belts, and gloves.

17. At the time Applicant filed its "DISIDUAL" trademark application, Applicant did not use the "DISIDUAL" mark in U.S. commerce in connection with all of the goods identified in the "DISIDUAL" application, as required by 15 U.S.C. § 1051(a).

18. Opposer therefore respectfully requests that the implicated goods be removed from the application, because Applicant's application is *void ab initio* for failure to use the mark at the time the use-based application was filed.

COUNT 3 - APPLICANT HAS ABANDONED ITS MARK THROUGH NONUSE

19. At the time Applicant filed its "DISIDUAL" trademark application, Applicant did not use the "DISIDUAL" mark in U.S. commerce in connection with all of the goods identified in the "DISIDUAL" application, as required by 15 U.S.C. § 1051(a).

20. During discovery in this matter, Applicant produced no documentary or other evidence of its use of the "DISIDUAL" mark in commerce on belts, gloves, dresses, and knit face masks at the time of filing its use-based "DISIDUAL" trademark application.

21. Despite Opposer's Requests for documents, Applicant produced no documents relating to its creation, development, marketing, advertising and/or sale of belts, gloves, dresses, and knit face masks bearing the "DISIDUAL" trademark at the time it filed its trademark application.

22. Applicant admitted in Response to Opposer's Requests for Production #2 that it has not used the "DISIDUAL" mark on dresses, belts, and gloves, despite the fact that the trademark application was filed based on use in commerce.

23. Applicant's trademark application claims a first use in commerce date of June 1, 2010. Applicant has abandoned the "DISIDUAL" trademark as a result of the past six years of non-use of the mark on belts, gloves, dresses, and knit face marks.

24. Applicant abandoned its "DISIDUAL" mark long prior to the filing of this Notice of Opposition, and Applicant has no intention of commencing or resuming use of the mark on belts, gloves, dresses, and knit face masks in the future.

25. Opposer therefore respectfully requests that the implicated goods be removed from the application, because Applicant's mark is abandoned with regard to those goods.

COUNT 4 - FRAUD ON THE USPTO

26. At the time Applicant filed its "DISIDUAL" trademark application, Applicant did not use the "DISIDUAL" mark in U.S. commerce in connection with all of the goods identified in the "DISIDUAL" application, as required by 15 U.S.C. § 1051(a).

27. Applicant claimed a June 1, 2010 date of first use and first use in commerce of its mark in association with all of its goods, which include "Apparel, namely, t-shirts, tank-tops, shorts, hats, jackets, sweatshirts, hooded sweatshirts, beanies, socks, pants, dresses, swimsuits, knit face masks, gloves, belts."

28. During discovery in this matter, Applicant produced no documentary or other evidence of its use of the "DISIDUAL" mark in commerce on belts, gloves, dresses, and knit face masks at the time of filing its use-based "DISIDUAL" trademark application.

29. Despite Opposer's Requests for documents, Applicant produced no documents relating to its creation, development, marketing, advertising and/or sale of belts, gloves, dresses, and knit face masks bearing the "DISIDUAL" trademark at the time it filed its trademark application.

30. Applicant admitted in Response to Opposer's Requests for Production #2 that it has not used the "DISIDUAL" mark on dresses, belts, and gloves, despite the fact that the trademark application was filed based on use in commerce.

31. In Applicant's trademark application, filed January 30, 2013, Applicant declared under oath, being warned that willful false statements, and the like, may jeopardize the validity of the declaration, that "The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended." The Applicant went on to state that "[t]he mark was first used at least as early as 06/01/2010 and first used in commerce at least as early as 06/01/2010 , and is now in use in such commerce."

32. Applicant knowingly, with an intent to deceive the United States Patent and Trademark Office, included within its use-based trademark application a number of goods on which the mark was not in use, including, dresses, belts, gloves, and knit face masks in International Class 025.

33. Such knowing false or fraudulent statements were relied on by authorized agents of the U.S. Patent and Trademark Office to publish for opposition U.S. Trademark Application No.

85/836,544 for the mark "DISIDUAL", and, reasonably relying on the truth of such false statements, the U.S. Patent and Trademark Office did, in fact, publish the mark for opposition in the name of Applicant.

34. Applicant is therefore not entitled to continue to seek to register U.S. Trademark Application No. 85/836,544 for the mark "DISIDUAL", because Applicant committed fraud in filing its trademark application based on use in commerce. The Declarations accompanying the trademark application also contained fraudulent statements regarding Applicant's alleged use of its mark in commerce on all of the goods in the Identification of Goods for the mark. The Applicant's trademark application is therefore void.

WHEREFORE, Opposer respectfully requests that the Trademark Trial and Appeal Board find and order that registration by Applicant of the mark "DISIDUAL" in class 025 be denied as damaging to the Opposer and that this opposition is sustained.

Opposer has already submitted the requisite filing fee of \$300.00 for opposing Applicant's application in International Class 025.

Respectfully submitted,

August 12, 2016
Date

/1433-55/
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CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the foregoing document is being sent by regular mail on August 12, 2016, to the following attorney of record for the Applicant:

Gregory Chinlund, Esq.
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