

ESTTA Tracking number: **ESTTA566576**

Filing date: **10/23/2013**

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	Laverana GmbH & Co. KG
Granted to Date of previous extension	10/23/2013
Address	Am Weingarten 4 D-30974 Wennigsen, GERMANY

Attorney information	Todd A. Denys Porzio, Bromberg & Newman, P.C. 29 Thanet Road, Suite 201 Princeton, NJ 08540 UNITED STATES tadenys@pbnlaw.com Phone:609-924-8555
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Applicant Information

Application No	85720369	Publication date	06/25/2013
Opposition Filing Date	10/23/2013	Opposition Period Ends	10/23/2013
Applicant	ACK Corporation 2095 S. Leo Ave. Commerce, CA 90040 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 2012/08/22 First Use In Commerce: 2012/08/22 All goods and services in the class are opposed, namely: Non-medicated skin care preparations, namely, creams, lotions, gels, toners, facial masks, serum, essential oils, cleaners and peels; Soaps for body care; Perfumeries; Cosmetics and make-up, namely, body care cosmetics, make-up for the face; Hair care preparations, namely, shampoos and conditioners
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2687717	Application Date	02/22/1999
Registration Date	02/18/2003	Foreign Priority Date	NONE
Word Mark	LAVERA		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 003. First use: COSMETICS, NAMELY, FACE CREAMS AND LOTIONS, SKIN CLEANSERS, PERSONAL HYGIENE PRODUCTS, NAMELY, SHOWER GELS, SHAMPOOS AND BODY LOTIONS, SUN SCREEN PREPARATIONS; PRODUCTS FOR BABIES' AND CHILDRENS' CARE, NAMELY, BATHING OILS, SHAMPOOS, SKIN OILS AND CREAMS; MEN'S CARE PRODUCTS, NAMELY, SHAVING CREAM, AFTER-SHAVE BALMS, SHOWER SHAMPOOS AND DEODORANTS; HAIR LOTIONS, DENTIFRICES, [PERFUME, FOOT CREAMS AND LOTIONS; FOOT CARE PRODUCTS, NAMELY, ABRASIVE DEVICES IN THE NATURE OF PUMICE STONES, RASPS, OR FILES FOR TREATING CORNS AND CALLUSES, NON-MEDICATED POWDERS AND LIQUIDS FOR BATHING FEET, AND NON-ELECTRIC MASSAGE DEVICES, SPECIFICALLY, DEVICES DESIGNED FOR MASSAGING FEET;] DECORATIVE COSMETICS, NAMELY, TINTED MOISTURIZING CREAMS, MAKEUP, COMPACT FACE POWDERS AND ROUGES, COVER-UP STICKS, LIPSTICKS, EYE-DECORATING PENCILS AND MASCARA</p> <p>Class 005. First use: [NUTRITIONAL SUPPLEMENTS AND VITAMINS]</p>

U.S. Registration No.	4230293	Application Date	03/24/2009
Registration Date	10/23/2012	Foreign Priority Date	NONE
Word Mark	LAVERA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 1987/11/30 First Use In Commerce: 1999/05/31 After-shave products, namely, lotions, cologne, balms, creams, emulsions, and gels; shaving preparations, namely, foams and gels; after-sun care products, namely, creams, gels, lotions, milks, and oils; age-retardant products, namely, gels, creams, and lotions; deodorants for personal use; anti-aging products, namely, cleansers, creams, moisturizers, and toners; anti-wrinkle creams; aromatherapy body care products, namely, body lotions, shower gels, shampoos, conditioners, non-medicated lip balms, soaps, body polish, body and foot scrub and non-medicated foot creams, oils, and sprays; baby skin and hair care products, namely, lotions, oils, powders, shampoos, hair conditioners; bath and shower products, namely, gels, salts, mineral salts, creams, lotions, oils, and soaps in liquid, or gel form not for medical purposes; beauty products, namely, creams, gels, lotions, masks, milks, and serums; body and beauty care cosmetics, namely, body creams, body deodorants, body lotions, body mask creams, body mask lotions, body milks, body oils, spray used as a personal deodorant and as fragrance, and body washes; cleansing products, namely, creams, milk; colognes and perfumes; color cosmetic products, namely, blush, blush pencils, chalk for cosmetic use, pencils, eyeliners, eye make-up, eye shadows, eyebrow cosmetics, face highlighters, rouges, lip liners, lipsticks, concealers for face and body, make-up, creamy face powder, glitter powder, pressed face powder, mascaras, and creamy rouges; cosmetic preparations, namely, preparations against sunburn, sun-tan preparations, and sun-protecting preparations; eye skin care products, namely, creams, gels, lotions, masks, and make-up removers; facial skin care products, namely, creams, milks, lotions, night cream, beauty masks, cleansers, creams, emulsions, scrubs, washes; hair</p>		

	care products, namely, conditioners, shampoos, hair dressing preparations, lotions, gels, mousse, and sprays; hand skin care products, namely, cleaners, creams, soaps, lotions, and scrubs; lip care products, namely, balms, creams, and gloss; dental care products, namely, dentifrices; essential oils for personal use; exfoliant creams for skin; perfumed and scented skin care products, namely, creams, powder, lotions, cream soaps, and soaps; skin moisturizing products, namely, creams, milks, and lotions; skin clarifiers; skin cleansers; skin fresheners; wrinkle removing skin care preparations; wrinkle resistant creams; wrinkle-minimizing cosmetic preparations for topical facial use
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Attachments	2573236-Notice_of_Opposition_with_Schedule_A.PDF(871112 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	/todd a denys/
Name	Todd A. Denys
Date	10/23/2013

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

Laverana GmbH & Co. KG,]	
]	
Opposer,]	Opposition No.: _____
]	Application No.: 85/720,369
v.]	Mark: LARENA BEAUTY
]	Filed: September 4, 2012
]	Published for Opposition: June 25, 2013
ACK Corporation]	
]	
Applicant.]	
]	

NOTICE OF OPPOSITION

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer, Laverana GmbH & Co. KG, a Limited Partnership of Germany, with a business address of Am Weingarten 4, D-30974 Wennigsen, Germany, believes that it will be damaged by the registration of the mark LARENA BEAUTY for “Non-medicated skin care preparations, namely, creams, lotions, gels, toners, facial masks, serum, essential oils, cleaners and peels; Soaps for body care; Perfumeries; Cosmetics and make-up, namely, body care cosmetics, make-up for the face; Hair care preparations, namely, shampoos and conditioners” in International

Class 3 as set forth in United States Trademark Application Serial No. 85/720,369, filed September 4, 2012, published June 25, 2013, and hereby opposes said application.

As grounds for this opposition, it is alleged that:

1. Prior to September 4, 2012, the filing date by ACK Corporation (hereinafter “Applicant”) for the LARENA BEAUTY application, United States Trademark Application Serial No. 85/720,369, Laverana GmbH & Co. KG (hereinafter “Opposer”), established rights in the following United States trademark registrations:

Registration No.	Trademark	Status	Goods
2,687,717	Lavera	Registered and Incontestable	Goods in International Class 3 Please see Schedule A attached hereto for a full list of goods covered by this registration
4,230,293	Lavera	Registered	Goods in International Class 3 Please see Schedule A attached hereto for a full list of goods covered by this registration

2. Opposer’s registered trademarks set forth above are hereby collectively referred to as “Opposer’s Lavera Mark.”

3. Opposer's rights in Opposer's LAVERA Mark were first registered in the United States on February 18, 2003.

4. Each of the registrations for Opposer's LAVERA Mark are valid and in full force and effect under United States trademark law.

5. United States Trademark Registration No. 2,687,717 for the mark LAVERA is valid, in full force and effect, and incontestable under United States trademark law.

6. Opposer first used the mark LAVERA in United States commerce in connection with products in International Class 3 at least as early as May 31, 1999.

7. Opposer is currently using Opposer's LAVERA Mark in United States commerce in connection with products in International Class 3.

8. Opposer has so used Opposer's LAVERA Mark in United States commerce in connection with products in International Class 3 such that the public has come to associate Opposer's LAVERA Mark with Opposer and as indicating that any LAVERA product in International Class 3 originates with Opposer. As a result, Opposer has created and is the owner of substantial goodwill in Opposer's LAVERA Mark.

9. In view of Opposer's registration and use of Opposer's LAVERA Mark, Opposer has built up substantial rights in Opposer's LAVERA Mark.

10. Applicant filed United States Trademark Application Serial No. 85/720,369 on September 4, 2012 seeking to register the mark LARENA BEAUTY in connection with “Non-medicated skin care preparations, namely, creams, lotions, gels, toners, facial masks, serum, essential oils, cleaners and peels; Soaps for body care; Perfumeries; Cosmetics and make-up, namely, body care cosmetics, make-up for the face; Hair care preparations, namely, shampoos and conditioners” in International Class 3.

11. United States Trademark Application Serial No. 85/720,369 was published in the *Official Gazette* on June 25, 2013.

12. Applicant claims to have first used the mark LARENA BEAUTY at least as early as August 22, 2012 in United States commerce.

13. Upon information and belief, Applicant’s date of first use of the mark LARENA BEAUTY is later than Opposer’s registration and use in United States commerce of Opposer’s LAVERA Mark.

14. The mark LARENA BEAUTY sought to be registered by Applicant is similar in appearance, pronunciation and commercial impression to Opposer’s LAVERA Mark.

15. Applicant’s LARENA BEAUTY mark is confusingly and deceptively similar to Opposer’s previously and duly registered and used Opposer’s LAVERA Mark.

16. Applicant's LARENA BEAUTY mark has the appearance and commercial impression of being similar to Opposer's LAVERA Mark or somehow affiliated with or sponsored by Opposer.

17. The goods identified in United States Trademark Application Serial No. 85/720,369 for the mark LARENA BEAUTY are identical or so closely related to the goods offered by Opposer under Opposer's LAVERA Mark such that consumers are likely to believe that Applicant's goods originate with Opposer or vice versa.

18. Applicant has adopted a trademark so closely resembling Opposer's LAVERA Mark in connection with identical or related goods that it would be viewed by any consumer as emanating from Opposer, either erroneously believing the mark LARENA BEAUTY to be an existing trademark of Opposer, or a new trademark of Opposer or that Applicant is somehow affiliated with or sponsored by Opposer.

19. Upon information and belief, Applicant's and Opposer's goods travel in common channels of trade.

20. Upon information and belief, the consumers for Applicant's goods are the same consumers of Opposer's goods.

21. Due to the confusing similarity between Applicant's LARENA BEAUTY mark and Opposer's LAVERA Mark, which was previously and duly registered and used in United States commerce, the identical and related nature of the parties' goods as well as the overlapping of channels of trade and consumers who are likely to believe that Applicant's goods originate with Opposer or vice versa, the result will be a likelihood of confusion in the marketplace and damage to Opposer. Moreover, registration of the mark LARENA BEAUTY by Applicant is likely to cause a belief by consumers that Applicant's goods are endorsed by, sponsored by or approved by Opposer, causing damage to Opposer.

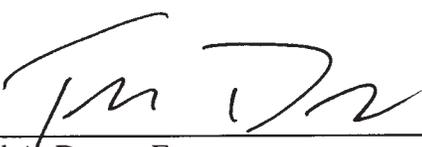
22. Opposer will be further damaged by the registration of the mark LARENA BEAUTY by Applicant, because it will cause confusion and uncertainty in the industry and handicap and damage the legitimate present and future activities of Opposer, by placing Applicant in the position to raise doubts as to the rights of Opposer to use Opposer's LAVERA Mark in connection with its goods. As a result, Opposer will eventually be deprived of all distinctiveness in Opposer's LAVERA Mark since Applicant's use will blur Opposer's LAVERA Mark along with the goods identified with that mark , and the association with which said Opposer's LAVERA Mark has come to convey will be blurred and/or tarnished.

WHEREFORE, Laverana GmbH & Co. KG requests that registration of United States Trademark Application Serial No. 85/720,369 be denied, and this opposition be sustained.

Respectfully Submitted,

Laverana GmbH & Co. KG

Dated: 10/23/2013

BY: 

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Attorney for Opposer

CERTIFICATE OF FILING

I hereby certify that this Notice of Opposition, with Schedule A attached thereto, is being filed with the United States Patent and Trademark Office via the Trademark Trial and Appeal Board's Electronic System for Trademark Trials and Appeals [ESTTA] on-line filing process.

10/23/2013

(Date of Deposit)



(Signature)

10/23/2013

(Date of Signature)

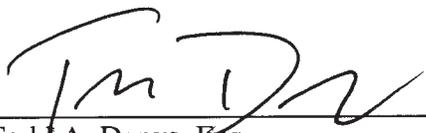
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing Notice of Opposition, with Schedule A attached thereto, was served, this 23rd day of October, 2013, via First Class Mail, Postage Prepaid, addressed as follows:

TONY W. WONG
DAVID AND RAYMOND INTELLECTUAL PROPERTY LAW FIRM
108 N YNEZ AVE STE 128
MONTEREY PARK, CALIFORNIA 91754-1680

Dated: 10/23/2013

BY:



Todd A. Denys, Esq.
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tadenys@pbnlaw.com
Attorney for Opposer

SCHEDULE A

Registration No.	Trademark	Status	Goods
2,687,717	LAVERA	Registered and Incontestable	<p>cosmetics, namely, face creams and lotions, skin cleansers, personal hygiene products, namely, shower gels, shampoos and body lotions, sun screen preparations; products for babies' and childrens' care, namely, bathing oils, shampoos, skin oils and creams; men's care products, namely, shaving cream, after-shave balms, shower shampoos and deodorants; hair lotions, dentifrices, decorative cosmetics, namely, tinted moisturizing creams, makeup, compact face powders and rouges, cover-up sticks, lipsticks, eye-decorating pencils and mascara</p> <p align="center">(International Class 3)</p>
4,230,293	LAVERA	Registered	<p>After-shave products, namely, lotions, cologne, balms, creams, emulsions, and gels; shaving preparations, namely, foams and gels; after-sun care products, namely, creams, gels, lotions, milks, and oils; age-retardant products, namely, gels, creams, and lotions; deodorants for personal use; anti-aging products, namely, cleansers, creams, moisturizers, and toners; anti-wrinkle creams; aromatherapy body care products, namely, body lotions, shower gels, shampoos, conditioners, non-medicated lip balms, soaps, body polish, body and foot scrub and non-medicated foot creams, oils, and sprays; baby skin and hair care products, namely, lotions, oils, powders, shampoos, hair conditioners; bath and shower products, namely, gels, salts, mineral salts, creams, lotions, oils, and soaps in liquid, or gel form not for medical purposes; beauty products, namely, creams, gels, lotions, masks, milks, and serums; body and beauty care cosmetics, namely, body creams, body deodorants, body lotions, body mask creams, body mask lotions, body milks, body oils, spray used as a personal deodorant and as fragrance, and body washes; cleansing products, namely, creams, milk; colognes and perfumes; color cosmetic products, namely, blush, blush pencils, chalk for cosmetic use, pencils, eyeliners, eye make-up, eye shadows, eyebrow cosmetics, face highlighters, rouges, lip liners, lipsticks, concealers for face and body, make-up, creamy face powder, glitter powder, pressed face powder, creamy foundation, foundation make-up, loose face powder, mascaras, and creamy rouges; cosmetic preparations, namely, preparations against sunburn, sun-tan preparations, and sun-protecting preparations; eye skin care products, namely, creams, gels, lotions, masks, and</p>

Registration No.	Trademark	Status	Goods
			<p>make-up removers. facial skin care products, namely, creams, milks, lotions, night cream, beauty masks, cleansers, creams, emulsions, scrubs, washes; hair care products, namely, conditioners, shampoos, hair dressing preparations, lotions, gels, mousse, and sprays; hand skin care products, namely, cleaners, creams, soaps, lotions, and scrubs; lip care products, namely, balms, creams, and gloss; dental care products, namely, dentifrices; essential oils for personal use; exfoliant creams for skin; perfumed and scented skin care products, namely, creams, powder, lotions, cream soaps, and soaps; skin moisturizing products, namely, creams, milks, and lotions; skin clarifiers; skin cleansers; skin fresheners; wrinkle removing skin care preparations; wrinkle resistant creams; wrinkle-minimizing cosmetic preparations for topical facial use</p> <p>(International Class 3)</p>