

ESTTA Tracking number: **ESTTA578015**

Filing date: **12/20/2013**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Penrod Management Group Inc.
Granted to Date of previous extension	12/21/2013
Address	One Ocean Drive Miami Beach, FL 33139 UNITED STATES

Name	West Indies Trading Company LLC		
Entity	Corporation	Citizenship	Florida
Address	One Ocean Drive Miami Beach, FL 33139 UNITED STATES		

Correspondence information	Penrod Management Group Inc. One Ocean Drive Miami Beach, FL 33139 UNITED STATES stevesavola@nikkibeach.com Phone:786-390-1297
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Applicant Information

Application No	85927395	Publication date	10/22/2013
Opposition Filing Date	12/20/2013	Opposition Period Ends	12/21/2013
Applicant	Cashmere Classics Corp C/O mirus and lautus, Suite 604 New York, NY 10019 NY		

Goods/Services Affected by Opposition

Class 003. First Use: 2012/07/01 First Use In Commerce: 2012/07/01 All goods and services in the class are opposed, namely: Fragrances
Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Sunglasses
Class 025. First Use: 2012/07/01 First Use In Commerce: 2012/07/01 All goods and services in the class are opposed, namely: Clothing, namely, suits, sport coats, shirts, ties, trousers, shoes, jackets and topcoats

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Dilution	Trademark Act section 43(c)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3031488	Application Date	03/15/2004
Registration Date	12/20/2005	Foreign Priority Date	NONE
Word Mark	NIKKI BEACH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 1999/12/01 First Use In Commerce: 1999/12/01 restaurant and bar services		

U.S. Registration No.	3379386	Application Date	09/13/2005
Registration Date	02/05/2008	Foreign Priority Date	NONE
Word Mark	NIKKI BEACH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2006/06/01 First Use In Commerce: 2006/06/01 Restaurant management for others Class 043. First use: First Use: 2006/06/01 First Use In Commerce: 2006/06/01 Cafe-restaurants; restaurant and bar services; restaurant services; restaurants		

U.S. Registration No.	4312500	Application Date	08/01/2012
Registration Date	04/02/2013	Foreign Priority Date	NONE

Word Mark	NIKKI BEACH LIFESTYLE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2009/03/09 First Use In Commerce: 2009/03/09 Bathing suits; Beach cover-ups; Beachwear; Footwear; Head wear; Shirts; Skirts and dresses; Slacks; Sweat suits; T-shirts Class 035. First use: First Use: 2009/03/09 First Use In Commerce: 2009/03/09 Retail store services featuring clothing and accessories

U.S. Registration No.	4183499	Application Date	05/07/2007
Registration Date	07/31/2012	Foreign Priority Date	NONE

Word Mark	NIKKI BEACH HOTELS & RESORTS
Design Mark	
Description of Mark	The mark consists of blue appearing in the Teepee design and in the wording "NIKKI BEACH". The color gray appears in the wording "HOTELS AND RESORTS".
Goods/Services	Class 035. First use: First Use: 2007/04/25 First Use In Commerce: 2007/04/25 Administrative hotel management; Association services, namely, promoting diversity in the restaurant and hotel industries on behalf of employees, vendors, management, and owners; Business management of hotels for others; Hotel management for others; Management of hotel incentive programs of others; Managing and operating resort hotels and business conference centers of others; Providing hotel rate comparison information; Franchising, namely, offering technical assistance in the establishment and/or operation of hotels and restaurants; Offering technical assistance in the establishment and/or operation of restaurants; On-line ordering services in the field of restaurant take-out and delivery; Restaurant franchising; Restaurant management for others Class 043. First use: First Use: 2007/04/25 First Use In Commerce: 2007/04/25 Hotel services; Hotel services for preferred customers; Hotel, bar and restaurant services; Hotels; Making hotel reservations for others; Providing advice to

	tourists and business travelers on hotel and restaurant destinations; Providing on-line reviews of restaurants and hotels; Providing temporary lodging services in the nature of a condominium hotel; Reservation of hotel rooms for travelers; Reservation of hotel rooms for travelers;Resort hotels; Cafe-restaurants; Carry-out restaurants; Delicatessens; Fast food and non-stop restaurant services; Fast-food restaurants; Fast-food restaurantsand snackbars; Reservation of restaurants; Restaurant and bar services; Restaurant services
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Related Proceedings	Nikky Capri serial number 85917397
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Attachments	78384390#TMSN.jpeg(bytes) 78711976#TMSN.jpeg(bytes) 85692318#TMSN.jpeg(bytes) 77174488#TMSN.jpeg(bytes) Trademark Opposition Nikki Verbier-PMG Final.pdf(52967 bytes) Trademark Opposition Nikki Verbier-WIT Final.pdf(51171 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	/Steven Savola/
Name	Penrod Management Group Inc.
Date	12/20/2013

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

In the matter of trademark application Serial No. **85927395**
For the mark Nikky Verbier
Published in the Official Gazette on October 22nd, 2013 page 2013 360

Penrod Management Group Inc.
Petitioner

v.

Cashmere Classics Corp.
Applicant

NOTICE OF OPPOSITION

The Petitioner, Penrod Management Group Inc. a Florida corporation has a principal business address of One Ocean Drive, Miami, Florida 33132.

The above-identified Petitioner believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

JURISDICTION

1. Penrod Management Group Inc., owns the trademark "Nikki Beach" under registration number 3031488.
2. Application for the mark was submitted on 9.3.05 in classes 35 (restaurant management services) and 43 (cafes and restaurants).
3. Registration was issued on 2.5.08.
4. "Nikki Beach" has been trademarked under the Madrid Protocol as well as independently in a number of countries around the world.

5. Thereafter the name “Nikki Beach” was registered with tepee logo by related company Penrod Management International, LLC under registration number 3379386.
6. West Indies Trading Company, LLC is part of the related entities and responsible for all shops selling “Nikki Beach” clothing and related merchandise.
7. West Indies Trading Company, LLC has the tepee logo for the “Nikki Beach” trademark registered for clothing under number 34476603.
8. West Indies Trading Company, LLC has filed other applications in class 25 with the “Nikki Beach” name including “Nikki Beach Clothing”, serial number 78642937 and “Little Nikki”, serial number 78711087. The applications were processed as abandoned by USPTO. The applications will be renewed.
9. West Indies Trading Company, LLC has applied for the trademark “Nikki Beach Lifestyle” in Class 25 under serial number 85692318.
10. Nikki Beach Hotels and Resorts has been trademarked with the USPTO, registration number 4183499 as well as under the Madrid Protocol and other countries around the world.
11. Sun care products and fragrances have been trademarked with the USPTO, by Nikki Beach Beauty, SA for Penrod Management International, LLC under registration number 3814785 and in numerous other countries around the world.

BASIS FOR OPPOSITION

12. Petitioner operates beach clubs in seven different countries around the world in the name “Nikki Beach” including the United States with the first one established in 1998. It also has event venues at the Cannes Film Festival, Sundance Film Festival and Toronto Film Festival. Nikki Beach will open in Phuket, Thailand in early 2014. It is currently negotiating to open at the Venice Film Festival for 2014.

13. Petitioner has launched a hotel concept under the name Nikki Beach Hotels and Resorts. It operates in Koh Samui, Thailand at this time and will open in Greece in 2013.
14. Petitioner has clothing shops at all of its locations selling garments, clothing, hats and beach wear under the name “Nikki Beach”.
15. Nikki Beach has developed into a lifestyle brand, which includes food and beverage, entertainment, music, clothing and hospitality lodging.
16. The “Nikki Beach” mark has become famous on a worldwide basis and granting a trademark for the name Nikky Verbier under classes 3,9 and 25 (clothing) would create a likelihood of confusion.
17. The granting of a trademark to Nikky Verbier would also cause dilution of the distinctive quality of the “Nikki Beach” mark.
18. As such Petitioners opposes the application based upon section 2(d) of the Lanham Act, 15 U.S.C. sec. 1052(d).
19. As such Petitioners further opposes the application based upon section 43(c) of the Lanham Act, 15 U.S.C. sec. 1052(d).

CONCLUSION

20. Petitioner believes that it would be damaged by registration of the mark. The application if approved would result in a lessening of the distinctive quality of the “Nikki Beach” mark and as such should be rejected under sections 2(d) or 43(c) of the Lanham Act sec. 1052(d). Petitioner requests that the application Serial Number 85927395 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of the Petitioner.

Respectfully Submitted

/Steven Savola/

General Counsel

Penrod Management Group Inc.
One Ocean Drive
Miami Beach, Florida 33139

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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For the mark Nikky Verbier

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Applicant

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The above-identified Petitioner believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

JURISDICTION

1. Petitioner, West Indies Trading Company, LLC is part of the “Nikki Beach” worldwide group that operates beach clubs, restaurants and hotels. Specifically West Indies Trading company sells “Nikki Beach” trademarked clothing, sun care products and related merchandise that have included fragrances.
2. Penrod Management Group, Inc., owns the trademark “Nikki Beach” under registration number 3031488.
3. Application for the mark was submitted on 9.3.05 in classes 35 (restaurant management services) and 43 (cafes and restaurants).

4. Registration was issued on 2.5.08.
5. “Nikki Beach” has been trademarked under the Madrid Protocol as well as independently in a number of countries around the world.
6. Thereafter the name “Nikki Beach” was registered with tepee logo by related company Penrod Management International, LLC under registration number 3379386.
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BASIS FOR OPPOSITION

12. Petitioner has clothing shops at all “Nikki Beach” locations selling garments, clothing, hats and beach wear under the name “Nikki Beach”.
13. “Nikki Beach” has developed into a lifestyle brand, which includes food and beverage, entertainment, music, clothing, sun care products, fragrances and hospitality lodging.

14. The “Nikki Beach” mark has become famous on a worldwide basis and granting a trademark for the name Nikky Verbier under classes 3,9 and 25 (clothing) would create a likelihood of confusion.

15. The granting of a trademark to Nikky Verbier would also cause dilution of the distinctive quality of the “Nikki Beach” mark.

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17. As such Petitioners further opposes the application based upon section 43(c) of the Lanham Act, 15 U.S.C. sec. 1052(d).

CONCLUSION

18. Petitioner believes that they would be damaged by registration of the mark. The application if approved would result in a lessening of the distinctive quality of the “Nikki Beach” mark and as such should be rejected under sections 2(d) or 43(c) of the Lanham Act sec. 1052(d). Petitioner requests that the application Serial Number 85927395 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of the Petitioner.

Respectfully Submitted

/Steven Savola/

General Counsel
West Indies Trading Company, LLC
One Ocean Drive
Miami Beach, Florida 33139