

ESTTA Tracking number: **ESTTA612058**

Filing date: **06/25/2014**

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	Kiko S.r.l.
Granted to Date of previous extension	06/25/2014
Address	Via Paglia 1/D Bergamo, 24122 ITALY

Attorney information	Michael J. Leonard Fox Rothschild LLP 997 Lenox Drive, Building 3 Lawrenceville, NJ 08648-2311 UNITED STATES ipdocket@foxrothschild.com, mleonard@foxrothschild.com, colszyk@foxrothschild.com
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**Applicant Information**

Application No	86053930	Publication date	02/25/2014
Opposition Filing Date	06/25/2014	Opposition Period Ends	06/25/2014
Applicant	DOOYEON Corp. 25, Seolleung-ro 161-gil, Gangnam-gu Seoul, 135-897 KOREA, REPUBLIC OF		

**Goods/Services Affected by Opposition**

Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Eyebrow pencils; Lip liner; Mascara; Make-up foundations; Hair colorants; Cosmetic preparations for bath and shower; Body lotions; Bath lotion; Shower gels; Skin lotions; Eyeliner; Eye cream; Face and body lotions; Perfumes; Hair gel; Hair-spray; Make-up powder; Make-up removinglotions
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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.	3689438	Application Date	06/01/2005
Registration Date	09/29/2009	Foreign Priority Date	NONE

Word Mark	KIKO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre and after shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes

U.S. Registration No.	3650052	Application Date	09/23/2008
Registration Date	07/07/2009	Foreign Priority Date	NONE

Word Mark	KIKO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Make-up for women

U.S. Registration No.	4065381	Application Date	04/27/2010
Registration Date	12/06/2011	Foreign Priority Date	11/16/2009
Word Mark	KIKO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Spectacles, cases and chains for spectacles, frames for spectacles, optical lenses Class 014. First use: First Use: 0 First Use In Commerce: 0 Jewellery and costume jewellery, namely rings, bracelets, necklaces, tie-bars, scarf rings, pendants, ear clips, tie clips, cufflinks, earrings, key holders made of precious metals, brooches, pins being jewelry; clocks, watches, chronographs for use as watches, chronometers

U.S. Registration No.	1837925	Application Date	08/10/1989
Registration Date	05/31/1994	Foreign Priority Date	NONE
Word Mark	KIKO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1985/04/09 First Use In Commerce: 1985/05/22 APPAREL AND CLOTHING; NAMELY, BLOUSES, SHIRTS, TANK TOPS, SHORTS, PANTS, SKIRTS, DRESSES, JACKETS, TRENCH COATS, COATS, SWEATERS, SCARVES AND BELTS		

U.S. Application No.	85884151	Application Date	03/22/2013
Registration Date	NONE	Foreign Priority Date	03/06/2013
Word Mark	KIKO MAKE UP MILANO		
Design Mark			
Description of Mark	The mark consists of the word KIKO in larger type and the phrase MAKE UP MILANO in smaller type underneath.		
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils;		

	<p>make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre- and after-shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes, excluding goods for infants and children up to 11 years old</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>Retail department store services, excluding goods for infants and children up to 11 years old; retail store services featuring a wide variety of consumer goods of others, excluding goods for infants and children up to 11 years old; retail variety stores, excluding goods for infants and children up to 11 years old</p>
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Attachments	<p>78641087#TMSN.jpeg( bytes )  77576761#TMSN.jpeg( bytes )  79095635#TMSN.jpeg( bytes )  85884151#TMSN.jpeg( bytes )  KICHO NOTICE OF OPPOSITION 26124159_1.pdf(16961 bytes )</p>
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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	/Michael J. Leonard/
Name	Michael J. Leonard
Date	06/25/2014

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

RE: U.S. Trademark Application Serial No. 86/053,930  
Published in the Official Gazette on 25 February 2014

<b>KIKO S.r.L.</b>	)	
	)	
Opposer	)	
	)	Opposition No. _____
-v-	)	
	)	
<b>DOOYEON CORP.</b>	)	
	)	
Applicant	)	
	)	
_____	)	

**NOTICE OF OPPOSITION**

Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22314

Commissioner:

In the matter of Application Serial No. 86/053,930 filed 3 September 2013, by Dooyeon Corp. (“Applicant”), to register the mark KICHO and Design for goods described as “Eyebrow pencils; Lip liner; Mascara; Make-up foundations; Hair colorants; Cosmetic preparations for bath and shower; Body lotions; Bath lotion; Shower gels; Skin lotions; Eyeliner; Eye cream; Face and body lotions; Perfumes; Hair gel; Hair spray; Make-up powder; Make-up removing lotions” in International Class 03 (“Applicant’s Goods”), which was published in the Official Gazette on 25 February 2014, Kiko S.r.L. (“Opposer”) of Bergamo, Italy, believes it will be damaged by the registration of the KICHO and Design mark and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is a South Korean corporation, having an address at 25, Seolleung-ro 161-gil, Gangnam-gu, South Korea. On 3 September 2013, Applicant filed Application Serial No. 86/053,930 for the mark KICHO and Design for Applicant's Goods based on Applicant's claim of an intent to use the mark in commerce.

2. Opposer, Kiko S.r.L., is an Italian company and the owner of the internationally renowned fashion and cosmetics brand KIKO (the "KIKO Marks").

3. Opposer is using its KIKO Marks in the United States, has invested substantial resources in advertising and promoting its goods, and has acquired substantial goodwill and notoriety under its KIKO Marks.

4. Opposer is the owner of U.S. Registration No. 3,689,438 for KIKO covering "perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams; oils and lotions; pre and after shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes."

5. Opposer is the owner of U.S. Registration No. 3,650,052 for KIKO covering "make-up for women."

6. Opposer is also the owner of U.S. Registration No. 4,065,381 for "spectacles, cases and chains for spectacles, frames for spectacles, optical lenses" in Class 9 and "Jewelry and costume jewelry, namely rings, bracelets, necklaces, tie-bars, scarf rings, pendants, ear clips, tie clips, cufflinks, earrings, key holders made of precious metals, brooches, pins being

jewelry; clocks, watches, chronographs for use as watches, chronometers;” in Class 14; and owns incontestable U.S. Trademark Registration No. 1,837,925 for KIKO issued 31 May 1994 and covering goods described as “apparel and clothing, namely, blouses, shirts, tank tops, shorts, pants, skirts, dresses, jackets, trench coats, coats, sweaters, scarves and belts”. The goods set forth in Registration Nos. 3,689,438, 3,650,052 1,837,925, and 4,065,381 are collectively referred to herein as “Opposer’s Goods”.

7. Opposer is also the owner of pending U.S. Trademark Application Ser. No. 85/884,151 for the mark KIKO MAKEUP MILANO, filed 22 March 2013, covering “perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre- and after-shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes, excluding goods for infants and children up to 11 years old” in International Class 003 and “retail department store services, excluding goods for infants and children up to 11 years old; retail store services featuring a wide variety of consumer goods of others, excluding goods for infants and children up to 11 years old; retail variety stores, excluding goods for infants and children up to 11 years old” in International Class 35.

8. The foregoing Registrations are not limited by channels of trade or classes of purchasers. Opposer's Registrations are valid and subsisting, and are *prima facie* evidence of

the validity of the registered Marks set forth therein, and Opposer's exclusive right to use the registered Marks set forth therein in connection with the goods specified in the registrations.

9. Commencing prior to Applicant's filing date and any alleged date of first use that can be claimed by Applicant, Opposer's KIKO Marks became registered covering cosmetics, clothing and apparel.

10. Since the initial use and registration of the KIKO Marks, Opposer's Goods have been advertised, promoted and sold under the KIKO Marks. Opposer's customers and the public in general have come to know and recognize Opposer's KIKO Marks and associate the Marks with Opposer and/or Opposer's Goods.

11. Applicant's KICHO and Design mark is confusingly similar to Opposer's earlier used and registered KIKO Marks (both sharing the identical "KI\_O" lettering and having similar sound) and applies to substantially similar, and in some cases identical, goods to those covered by Opposer's KIKO Registrations and is likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

12. Opposer's Goods and Applicant's Goods, which are substantially similar, and in some cases identical, are likely to be offered and sold through the same channels of trade and purchased by the same class of purchasers.

13. Opposer's customers, and the public in general, are likely to be confused, mistaken, or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Goods sold and marketed under Applicant's KICHO and Design mark and misled into believing

that such goods are produced by, offered by, sold by, emanate from or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

14. Applicant's 3 September 2013 filing date of Application Serial No. 86/053,930 is subsequent to the filing dates of Opposer's pleaded registrations.

15. Applicant's filing of Application Serial No. 86/053,930 for KICHO and Design is without license, authorization or permission from Opposer.

16. Opposer will be damaged by the registration of the KICHO and Design mark as set forth in Application Serial No. 86/053,930, in that the mark is confusingly similar to Opposer's KIKO Marks, thereby violating Opposer's rights to its Marks.

17. Registration of Applicant's KICHO and Design mark should not be granted as it is contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its KIKO Marks.

WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 86/053,930 be refused and that the registration of KICHO and Design as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

Date: 25 June 2014

By: /Michael J. Leonard./  
Michael J. Leonard, Esq.  
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Lawrenceville, NJ 08648-2311

*Attorneys for Opposer Kiko S.r.L.*

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing Notice of Opposition was served on Applicant this 25th day of June 2014 by sending same via First Class Mail, postage prepaid, to:

DOOYEON Corp.  
25, Seolleung-ro 161-gil, Gangnam-gu  
Seoul, 135-897  
REPUBLIC OF KOREA

Jong H. Park, Esquire  
The PL LAW GROUP, PLLC  
11710 Plaza America Dr., Ste. 2000  
Reston, Virginia 20190-4743

By:           /Christopher D. Olszyk, Jr./