

ESTTA Tracking number: **ESTTA615118**

Filing date: **07/11/2014**

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	Rag & Bone Holdings, LLC
Granted to Date of previous extension	07/12/2014
Address	425 West 13th Street, 3rd Floor New York, NY 10014 UNITED STATES
Correspondence information	Ted Sabety Hand Baldachin & Amburgey LLP 8 West 40th Street, 12th Floor New York, NY 10018 UNITED STATES doctet@sabety.net Phone:212-481-8686

Applicant Information

Application No	86024388	Publication date	05/13/2014
Opposition Filing Date	07/11/2014	Opposition Period Ends	07/12/2014
International Registration No.	NONE	International Registration Date	NONE
Applicant	BAROCCO ROMA s.r.l. Unipersonale Via Santo Spirito 10 20121 Milan, ITALY		

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: Perfumes; cosmetics; lipsticks, essential oils, sun-tanning oils, mascara, coldcreams, foundation, vanishing creams, shaving creams, anti-wrinkle creams, nailvarnish, nail polish, toothpastes, skinlotions, hair lotions, eye shadow, eyeliners, deodorants for personal use, liquid soaps, soaps for personal use; after-shave lotions, beauty masks, eyebrow pencils, make up powder, make up remover; shampoos, talcum powder
Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Spectacles; sunglasses; eyeglass frames; eyeglass cases; eyeglass chains
Class 014. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Costume jewellery; earrings, necklaces,pendants, bracelets and rings; jewellery; rings, jewellery chains, bracelets, ornamental pins; wristwatches, pocket watches; clocks; watch cases; watch chains
Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: leather and imitation leather bags; tote

bags; handbags, travelling bags, trunks, suitcases; leather garment bags for travel; briefcases; purses; umbrellas

Class 025. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Clothing, namely, dresses, skirts, coats, raincoats, overcoats, jackets, trousers, suits, chemises, overcoats; pullovers, waistcoats, vests, cardigans, foulards, bathrobes, bathing suits, beach cover-ups, sunsuits, overalls, ties, scarves, stockings, socks, hats, gloves, footwear, leather belts for clothing

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	(1) Application is void ab initio because applicant lacked and lacks a bona fide intent-to-use the mark in commerce in the U.S. (2) Applicant's application should not have been allowed because Applicant failed to submit a signed and sworn declaration in support of its Section 44(e) and Section 1(b) bona fide intent to use claims.

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4049025	Application Date	04/06/2011
Registration Date	11/01/2011	Foreign Priority Date	NONE
Word Mark	RB		
Design Mark			
Description of Mark	The mark consists of the lower case letters "rb". The letters are positioned next to each other so that the end of the "r" is connected to the "b".		
Goods/Services	Class 025. First use: First Use: 2005/01/01 First Use In Commerce: 2005/01/01 Clothing, namely, jeans, shirts and jackets		

Attachments	85288222#TMSN.jpeg(bytes) RB, Notice of Opposition.pdf(255594 bytes) Exhibit A.pdf(67918 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	/ted sabety/
Name	Ted Sabety
Date	07/11/2014

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

In the matter of U.S. App. Serial No. 86/024,388



For the mark roccobarocco

Published in the *Official Gazette of Trademarks* on May 13, 2014

Rag & Bone Holdings, LLC,

Opposer,

BAROCCO ROMA s.r.l. Unipersonale,

Applicant.

Opposition No.

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Arlington, Virginia 22313-1451

NOTICE OF OPPOSITION

Opposer, Rag & Bone Holdings, LLC, located and doing business at 425 West 13th Street, 3rd Floor, New York, NY 10014 (“Opposer” or “Rag & Bone”), has been damaged by the U.S. trademark application for “rb roccobarocco” (“rb roccobarocco Application”), identified in U.S. Application Serial No. 86/024,388, filed by BAROCCO ROMA s.r.l. Unipersonale (“Applicant”), and believes that it will be further damaged by the maintenance and registration of Applicant’s rb roccobarocco Application by the U.S. Patent and Trademark Office (“USPTO”). Opposer previously filed for and was granted one extension of time to oppose the rb roccobarocco Application, and now hereby opposes the same.

I. OPPOSER’S GROUNDS FOR OPPOSITION

a. Opposer’s Prior and Superior Common Law Rights In and To The “rb” Logo and its Standing to Oppose Applicant’s rb roccobarocco Application

1. Opposer is a famous fashion brand that was founded in 2002, and is well-known for its clothing, footwear, eyewear, jewelry, bags, and accessories goods, which are sold to consumers in the U.S. and around the world.

2. Opposer is well known for its use of the “rb” logo trademark (“rb logo mark”), which is comprised of a lower case r and a lower case b that are closely adjoined, examples of which are provided below:



3. Opposer is the owner of U.S. Trademark Registration No. 4,049,025, for the rb logo in class 25 for “Clothing, namely, jeans, shirts and jackets” filed on April 6, 2011, registered on November 1, 2011, with a first use date of “at least as early as January 1, 2005” (“Opposer’s rb logo Registration”) (Exhibit A).

4. Opposer has common law rights in the rb logo mark based on use of the rb logo mark in commerce in the U.S. and elsewhere for clothing goods since at least as early as January 1, 2005.

5. Opposer's rb logo trademark is inherently distinctive and fanciful as applied to Opposer's clothing goods.

6. Opposer obtained federal trademark registration rights over the rb logo in the U.S. since well before July 31, 2013, the filing date and constructive first use date of Applicant's rb roccobarocco Application, or any other priority date that could be claimed with respect to Applicant's rb roccobarocco Application.

7. Opposer had offered for sale, sold, and continues to sell in the U.S. and elsewhere, its world famous clothing branded with the rb logo mark, all since well before July 31, 2013, the filing date and constructive first use date of Applicant's rb roccobarocco Application, or any other priority date that could be claimed with respect to Applicant's rb roccobarocco Application.

8. Opposer had advertised and promoted, and continues to advertise and promote in the U.S. and elsewhere, its world famous clothing branded with the rb logo mark, all since well before July 31, 2013, the filing date and constructive first use date of Applicant's rb roccobarocco Application, or any other priority date that could be claimed with respect to Applicant's rb roccobarocco Application.

9. Opposer's rb logo mark had acquired, and continues to enjoy, secondary meaning, as a result of extensive promotion, ongoing media coverage, successful ongoing sales, and widespread consumer recognition, all since well before July 31, 2013, the filing date and constructive first use date of Applicant's rb roccobarocco Application, or any other priority date that could be claimed with respect to Applicant's rb roccobarocco Application.

10. Opposer's rb logo mark became, and continues to be, famous, as a result of extensive promotion, ongoing media coverage, successful ongoing sales, and widespread

consumer recognition, all since well before July 31, 2013, the filing date and constructive first use date of Applicant's rb roccobarocco Application, or any other priority date that could be claimed with respect to Applicant's rb roccobarocco Application.

11. Opposer has been damaged by Applicant's rb roccobarocco Application and will continue to be damaged if Applicant's rb roccobarocco Application is allowed for registration.

12. Applicant's rb roccobarocco logo employs the use of an rb logo that is the dominant feature of Applicant's mark and is confusingly similar and analogous to Opposer's rb logo.

13. Applicant's use of the rb roccobarocco logo that is confusingly similar to Opposer's rb logo in class 25 and related goods in classes 3, 9, 14, and 18 is likely to confuse, mislead, or confuse consumers into believing that Applicant's rb roccobarocco goods originate with, are authorized by, or are somehow sponsored or associated with Applicant and Applicant's famous rb logo mark.

14. Opposer has further standing to oppose Applicant's rb roccobarocco Application because Opposer's rb logo mark became famous long before July 31, 2013, the filing date and constructive first use date of Applicant's rb roccobarocco Application, or any other priority date that could be claimed with respect to Applicant's rb roccobarocco Application, and Applicant's registration of the rb roccobarocco mark for classes 3, 9, 14, 18, and 25 goods is likely to dilute by blurring and/or tarnishment the strength, value, and/or distinctive quality of Opposer's famous rb logo mark.

II. APPLICANT'S MISCONDUCT IN THE PROSECUTION OF THE RB ROCCOBAROCCO APPLICATION

15. On or around July 31, 2013, Applicant filed the rb roccobarocco Application with the USPTO in classes 3, 9, 14, 18, and 25, based on Section 44(e) with a claim to an Italian

Registration and on Section 1(b), both with a claimed *bona fide* intent-to-use the rb roccobarocco mark in commerce in the United States for all the designated goods.

16. On or around July 31, 2013, Applicant was obligated to submit a signed and sworn declaration in support of its Section 44(e) and Section 1(b) bona fide intent-to-use claims.

17. On or around July 31, 2013, Applicant failed to submit a signed and sworn declaration in support of its Section 44(e) and Section 1(b) bona fide intent-to-use claims.

18. Applicant's rb roccobarocco Application failed to meet the requirements of 15 U.S.C. §1126(e). Therefore, allowance of the rb roccobarocco Application was improper.

19. On information and belief, when Applicant filed the rb roccobarocco Application, Applicant lacked a bona fide intent to use the rb roccobarocco mark in all the goods designed in classes 3, 9, 14, 18, and 25.

20. On information and belief, the USPTO Examiner allowed the rb roccobarocco Application to publish in reliance on the Applicant's false statements of bona fide intent-to-use.

III. FIRST CLAIM FOR RELIEF:

APPLICANT'S MARK SHOULD BE REFUSED REGISTRATION BECAUSE OPPOSER HAS PRIORITY OVER THE rb LOGO MARK IN THE UNITED STATES AND APPLICANT'S rb roccobarocco MARK IS ANALOGOUS AND CONFUSINGLY SIMILAR

21. Opposer repeats and realleges each and every allegation contained in the paragraphs above of the Opposition as though fully set forth herein.

22. Applicant's rb roccobarocco mark and Opposer's rb mark are analogous and nearly identical in sound, appearance, and spelling.

23. Applicant's rb roccobarocco Application class 25 for "Clothing, namely, dresses, skirts, coats, raincoats, overcoats, jackets, trousers, suits, chemises, overcoats; pullovers, waistcoats, vests, cardigans, foulards, bathrobes, bathing suits, beach cover-ups, sunsuits,

overalls, ties, scarves, stockings, socks, hats, gloves, footwear, leather belts for clothing ” include goods that directly overlap with the Opposer’s rb logo Registration class 25 goods for “Clothing, namely, jeans, shirts and jackets” and its common law rb logo usage for clothing.

24. Applicant’s rb roccobarocco Application goods in classes 3, 9, 14, and 18, as well as the goods in class 25 goods other than “Clothing, namely, jeans, shirts and jackets” are closely analogous to Opposer’s clothing goods.

25. Opposer’s federal trademark rights and common law priority rights in and to the distinctive rb logo precede July 31, 2013, the filing date and constructive first use date of Applicant’s rb roccobarocco Application, or any other priority date that could be claimed with respect to Applicant’s rb roccobarocco Application.

IV. SECOND CLAIM FOR RELIEF:

APPLICANT’S MARK SHOULD BE REFUSED REGISTRATION BECAUSE CONSUMERS ARE LIKELY TO BE CONFUSED BY APPLICANT’S JUNIOR RB MARK

26. Opposer repeats and realleges each and every allegation contained in the paragraphs above of the Opposition as though fully set forth herein.

27. Applicant’s class 3, 9, 14, 18, and 25 rb roccobarocco goods overlap with and are closely related to the goods Opposer offers under its rb logo mark, for which Opposer has prior and superior rights.

28. On information and belief, Applicant’s class 3, 9, 14, 18, and 25 rb roccobarocco goods will be sold in the same or similar types of trade channels as Opposer’s rb logo goods.

29. On information and belief, Applicant’s class 3, 9, 14, 18, and 25 rb roccobarocco goods will be advertised in the same or similar types of media as Opposer’s rb logo goods.

30. On information and belief, Applicant's class 3, 9, 14, 18, and 25 rb roccobarocco goods will be offered and sold to the same or similar customers as Opposer's rb logo goods.

31. Applicant's rb roccobarocco mark as designated in the rb roccobarocco Application is nearly identical to Opposer's rb logo mark, for which Opposer has prior and superior rights, the Applicant's class 3, 9, 14, 18, and 25 goods overlap and are closely related to Opposer's rb logo clothing goods, and the application of the rb roccobarocco mark to Applicant's class 3, 9, 14, 18, and 25 goods is likely to cause confusion, mistake, or to deceive consumers, and interferes with Opposer's ability to use its marks to indicate a single quality control source of goods, all in injury to Opposer and the general purchasing public, and therefore violates of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) and should be refused registration.

V. THIRD CLAIM FOR RELIEF:

APPLICANT'S RB ROCCOBAROCCO APPLICATION IS VOID AB INITIO BECAUSE APPLICANT LACKED AND LACKS A BONA FIDE INTENT TO USE RB ROCCOBAROCCO IN COMMERCE IN THE UNITED STATES FOR THE DESIGNATED GOODS

32. Opposer repeats and realleges each and every allegation contained in the paragraphs above of the Opposition as though fully set forth herein.

33. On information and belief, when Applicant filed the rb roccobarocco Application on or around July 31, 2013, Applicant lacked a *bona fide* intent to use the rb roccobarocco mark in commerce in the United States for all of the goods designated in class 3 by Applicant in the rb roccobarocco Application.

34. On information and belief, when Applicant filed the rb roccobarocco Application on or around July 31, 2013, Applicant lacked a *bona fide* intent to use the rb roccobarocco mark

in commerce in the United States for all of the goods designated in class 9 by Applicant in the rb roccobarocco Application.

35. On information and belief, when Applicant filed the rb roccobarocco Application on or around July 31, 2013, Applicant lacked a *bona fide* intent to use the rb roccobarocco mark in commerce in the United States for all of the goods designated in class 14 by Applicant in the rb roccobarocco Application.

36. On information and belief, when Applicant filed the rb roccobarocco Application on or around July 31, 2013, Applicant lacked a *bona fide* intent to use the rb roccobarocco mark in commerce in the United States for all of the goods designated in class 18 by Applicant in the rb roccobarocco Application.

37. On information and belief, when Applicant filed the rb roccobarocco Application on or around July 31, 2013, Applicant lacked a *bona fide* intent to use the rb roccobarocco mark in commerce in the United States for all of the goods designated in class 25 by Applicant in the rb roccobarocco Application.

38. Applicant filed and maintained the rb roccobarocco Application without the requisite *bona fide* intent to use all of the designated goods in classes 3, 9, 14, 18m and 25 in commerce in the United States, in violation of 15 U.S.C. §§ 1126(e) and 1051(b), and therefore the rb roccobarocco Application in classes 3, 9, 14, 18 and 25 are *void ab initio* and should be refused registration.

VI. FOURTH CLAIM FOR RELIEF:

**APPLICANT'S RB ROCCOBAROCCO APPLICATION SHOULD NOT REGISTER
BECAUSE APPLICANT'S REGISTRATION OF THE RB ROCCOBAROCCO MARK
FOR THE DESIGNATED GOODS IS LIKELY TO DILUTE OPPOSER'S FAMOUS RB
LOGO MARK**

39. Opposer repeats and realleges each and every allegation contained in the paragraphs above of the Opposition as though fully set forth herein.

40. Through extensive promotion, ongoing media coverage, successful ongoing sales, and widespread consumer recognition, the Opposer's rb logo mark has become famous in the U.S.

41. Opposer's rb logo mark became famous prior to the filing date and constructive first use date of Applicant's rb roccobarocco Application.

42. Registration of Applicant's rb roccobarocco mark is likely to cause dilution by blurring and/or tarnishment of the Opposer's famous rb logo mark, including by diluting the distinctive quality of the famous rb logo mark and lessening the capacity of the rb logo mark to identify Opposer's goods.

43. For the foregoing reason, the registration of Applicant's rb roccobarocco Application should be denied based on a likelihood of dilution of Opposer's rb logo mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

WHEREFORE, Opposer respectfully request that this Notice of Opposition be sustained and that Applicant's rb roccobarocco Application, Application Serial No. 86/024,388 be refused registration in classes 3, 9, 14, 18, and 25.

Opposer submits this opposition electronically and requests that the any additional fees to cover the filing fee of this Notice of Opposition, and any additional fees that may be necessary, be deducted from the Deposit Account of Opposer's Attorney, Ted Sabety, Esq. Deposit Account No. 504980.

Respectfully submitted,

Dated: 7/11/2014

By: /Ted Sabety/
Ted Sabety
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Attorneys for Petitioner

CERTIFICATE OF SERVICE

Opposer RAG & BONE HOLDINGS, LLC, hereby certifies that a copy of this NOTICE OF OPPOSITION has been served upon Applicant BAROCCO ROMA s.r.l. Unipersonale and its Domestic Representative on this 11th day of July, 2014, by First Class U.S. Mail, postage prepaid, at the following addresses:

BAROCCO ROMA s.r.l. Unipersonale
Via Santo Spirito 10
Palazzo Bagatti Valsecchi
20121 Milan
ITALY

And

Through Applicant's Attorney of Record and
Domestic Representative:

Michael A. Grow
Arent Fox LLP
1717 K St NW
Washington, District Of Columbia 20036-5342
United States

 /Ted Sabety/
Ted Sabety
Attorney for Petitioner

EXHIBIT A

United States of America

United States Patent and Trademark Office

rb

Reg. No. 4,049,025

Registered Nov. 1, 2011

Int. Cl.: 25

TRADEMARK

PRINCIPAL REGISTER

RAG & BONE HOLDINGS, LLC (NEW YORK LIMITED LIABILITY COMPANY)
425 WEST 13TH STREET, 3RD FLOOR
NEW YORK, NY 10014

FOR: CLOTHING, NAMELY, JEANS, SHIRTS AND JACKETS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 1-1-2005; IN COMMERCE 1-1-2005.

THE MARK CONSISTS OF THE LOWER CASE LETTERS "RB". THE LETTERS ARE POSITIONED NEXT TO EACH OTHER SO THAT THE END OF THE "R" IS CONNECTED TO THE "B".

SER. NO. 85-288,222, FILED 4-6-2011.

ALLISON HOLTZ, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office