

ESTTA Tracking number: **ESTTA623275**

Filing date: **08/25/2014**

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	Tod's S.p.A.
Granted to Date of previous extension	08/27/2014
Address	Via Filippo Della Valle1 Sant'Elpidio A Mare Ascoli Piceno, 63019 ITALY
Attorney information	Richard S. Mandel & Lindsay M. Rodman Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES rsm@cll.com, lmr@cll.com, rje@cll.com, trademark@cll.com

Applicant Information

Application No	86004044	Publication date	04/29/2014
Opposition Filing Date	08/25/2014	Opposition Period Ends	08/27/2014
Applicant	MYCOSKIE, LLC 5404 Jandy Place Los Angeles, CA 90066 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags;travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags;wheeled shopping bags and purses; jewelry pouches; wallets; credit card holdersof leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animals</p>
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Grounds for Opposition

Other	Please see attached pleading.
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Attachments	Notice of Opposition Toms.pdf(154955 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	/Lindsay Rodman/
Name	Lindsay M. Rodman
Date	08/25/2014

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

In re Application Serial No. 86/004,044
Filed: July 8, 2013
For Mark: TOMS
Published in the Official Gazette: April 29, 2014

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TOD’S S.P.A, :

Opposer, : Opposition No.

v. : **NOTICE OF OPPOSITION**

MYCOSKIE, LLC, :

Applicant. :

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Opposer Tod’s S.p.A., an Italian joint stock company located at Via Filippo Della Valle, 1, Sant’Elpidio A Mare, Ascoli Piceno, 63019, ITALY, believes that it would be damaged by registration of the mark shown in Serial No. 86/004,044 filed July 8, 2013 and having been granted an extension of time to oppose up to and including August 27, 2014, hereby opposes same.

As ground for opposition, it is alleged that:

1. For many years, Opposer, including its affiliated and related companies (collectively, “Opposer”), has been in the business of selling apparel, shoes, bags and other goods and accessories.

2. Since well prior to Applicant's filing of its application for the mark at issue in this proceeding, Opposer has used the mark TOD'S in connection with a wide variety of goods and services, including various goods in Class 18.

3. As a result of the extensive sales and promotion of its goods and services bearing or offered in connection with Opposer's TOD'S mark, Opposer has built up highly valuable goodwill in the TOD'S mark, and said goodwill has become closely and uniquely identified and associated with Opposer.

4. Opposer is the owner of several federal trademark registrations for marks containing the TOD'S mark together with other words and/or design elements, including the following registrations which were obtained prior to the filing date of the Application:

Mark	Reg. No.	Intl. Class	Reg. Date
	2,749,125	16, 18, 25, 35	Aug. 12, 2003
	1,459,226	18, 25	Sept. 29, 1987
	3,602,493	25	April 7, 2009
	3,831,949	3, 8, 9, 14, 16, 19, 20, 21, 24, 35	Aug. 10, 2010

	4,036,992	9, 14, 18, 25	Oct. 11, 2011
TOD'S SIGNATURE	4,333,244	3, 9, 14, 18, 25	May 14, 2013

5. Upon information and belief, on July 8, 2013, Applicant filed an intent-to-use application in the United States Patent and Trademark Office, Serial No. 86/004,044 (the “Application”), to register the mark TOMS (“Applicant’s Mark”) for “Goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags; travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; wheeled shopping bags and purses; jewelry pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animals “ in International Class 18.

6. The goods offered by Applicant under Applicant’s Mark are identical and/or closely related to the goods and services offered by Opposer under Opposer’s TOD’S mark.

7. Applicant’s Mark so resembles Opposer’s TOD’S mark as to be likely, when used in connection with the applied for goods, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant’s goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer.

8. Opposer's TOD'S mark is distinctive and famous and has enjoyed such distinctiveness and fame since long prior to Applicant's filing of the Application.

9. Applicant's Mark is likely to dilute the distinctiveness of Opposer's famous TOD'S Mark by blurring.

10. Opposer would be injured by the granting to Applicant of a registration for Applicant's Mark for the goods recited in the Application because such mark so resembles Opposer's TOD'S mark as to be likely, when used in connection with Applicant's goods, (a) to cause confusion, or to cause mistake, or to deceive; (b) to falsely suggest a connection with Opposer and/or its TOD'S branded goods and services; (c) to damage Opposer's valuable goodwill in its TOD'S mark; (d) to interfere with Opposer's own use and exploitation of its TOD'S mark; and (e) to dilute the distinctiveness of Opposer's TOD'S mark.

WHEREFORE, Opposer, by its attorneys, respectfully requests that its opposition be sustained and the application for registration be denied.

Dated: New York, New York
August 25, 2014

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of this Notice of Opposition was served upon the correspondent for the opposed application by mailing a copy thereof by first class mail, postage prepaid, on August 25, 2014 addressed as follows:

Louis S. Ederer, Esq.
Arnold & Porter LLP
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Washington, D.C. 20004-1206

/Richard S. Mandel/
RICHARD S. MANDEL, ESQ.