

ESTTA Tracking number: **ESTTA625074**

Filing date: **09/03/2014**

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 | A&H Sportwear Co., Inc. |
| Granted to Date of previous extension | 09/03/2014 |
| Address | 110 Commerce Way Stockertown, PA 19044 UNITED STATES |
| Attorney information | ANDREW KATZ BELLES KATZ LLC 721 DRESHER ROAD SUITE 1100 HORSHAM, PA 19044 UNITED STATES akatz@belleskatz.com Phone:(215) 658-1890 |

Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 86127855 | Publication date | 05/06/2014 |
| Opposition Filing Date | 09/03/2014 | Opposition Period Ends | 09/03/2014 |
| Applicant | ZHANG LI Rm.704, Bldg.2, JIANWAI SOHO, CHAOYANG Beijing, 100022 CHINA | | |

Goods/Services Affected by Opposition

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| Class 025. First Use: 2012/10/12 First Use In Commerce: 2012/10/12 Opposed goods and services in the class: Corsets; Garters; Girdles; Hosiery; Jackets; Jerseys; Leg-warmers; Pajamas; Socks; Trouser socks; Underpants; Underwear; Waterproof jackets and pants |
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Grounds for Opposition

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

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|-----------------------|-------------|-----------------------|------------|
| U.S. Registration No. | 1933826 | Application Date | 10/14/1993 |
| Registration Date | 11/07/1995 | Foreign Priority Date | NONE |
| Word Mark | SLENDERSUIT | | |
| Design Mark | | | |
| Description of | NONE | | |

| | |
|----------------|---|
| Mark | |
| Goods/Services | Class 025. First use: First Use: 1995/06/01 First Use In Commerce: 1995/06/01 swimsuits |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3087945 | Application Date | 06/19/2002 |
| Registration Date | 05/02/2006 | Foreign Priority Date | NONE |

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|-----------|-------------|
| Word Mark | SLENDERBODY |
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|-------------|--------------------|
| Design Mark | SLENDERBODY |
|-------------|--------------------|

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|---------------------|------|
| Description of Mark | NONE |
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| Goods/Services | Class 025. First use: First Use: 2006/02/15 First Use In Commerce: 2006/02/15 Women's, children's and men's leotards;dancewear, namely, tights and unitards;bodywear, namely, body shapers, bodysuits; swimwear; uniforms, active sportswear, namely, shirts, skirts, shorts, pants, leggings, blouses, tops, unitards and undergarments for golfing, skiing, tennis, mountain climbing, kayaking, walking,running, biking and basketball |
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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3402233 | Application Date | 03/05/2004 |
| Registration Date | 03/25/2008 | Foreign Priority Date | NONE |

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|-----------|-------------------------|
| Word Mark | LOOK SLENDER IN SECONDS |
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|-------------|--------------------------------|
| Design Mark | LOOK SLENDER IN SECONDS |
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|---------------------|------|
| Description of Mark | NONE |
|---------------------|------|

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|----------------|--|
| Goods/Services | Class 025. First use: First Use: 2007/12/01 First Use In Commerce: 2007/12/01 Swimwear; shapewear, namely, bodysuits,bodyslips and girdles |
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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3935408 | Application Date | 12/09/2009 |
| Registration Date | 03/22/2011 | Foreign Priority Date | NONE |

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|-----------|-------------|
| Word Mark | SLENDERBODY |
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|---------------------|--|
| Design Mark | SLENDERBODY |
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 2011/01/05 First Use In Commerce: 2011/01/05 Jeans |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1910773 | Application Date | 12/01/1993 |
| Registration Date | 08/08/1995 | Foreign Priority Date | NONE |
| Word Mark | SLENDERTEX | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1994/03/01 First Use In Commerce: 1994/03/01 fabric sold as a component of swimwear and leotards | | |

| | |
|-------------|---|
| Attachments | 76422081#TMSN.png(bytes) 76579207#TMSN.png(bytes) 77889380#TMSN.png(bytes) Notice of Opposition to MAGIC TIGHTS_09-03-2014.pdf(40374 bytes) |
|-------------|---|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Facsimile or email (by agreement only) on this date.

| | |
|-----------|------------------|
| Signature | /Andrew B. Katz/ |
| Name | ANDREW KATZ |
| Date | 09/03/2014 |

1. In 1997, A & H began prominently using the term “Magic” as the dominant portion of several trademarks in connection with many articles of clothing. Since then, A&H has adopted several Magic-formative marks covering apparel in International Class 025. Many of the marks which form A & H’s family of “Magic” marks are registered with the United States Patent and Trademark Office as set forth in the table below. (Collectively, these marks are hereinafter referred to as the “Magic Marks”).

| | Serial Number | Reg. Number | Word Mark | Class | I.D. |
|----|---------------|-------------|-------------|-------|---|
| 1 | 74586397 | 2756417 | MAGICBRA | 25 | women’s and children’s swimwear |
| 2 | 76317741 | 2751093 | MAGICBODY | 25 | men's dancewear, namely, leotards, tights and unitards; bodywear, namely, bodysuiters, bodysuits, and swimwear, men's and women's uniforms, active sportswear, namely, shirts, skirts, shorts, pants, leggings, blouses, tops, unitards, and undergarments for golfing, skiing, tennis, mountain climbing, kayaking, walking, running, biking, and basketball. |
| 3 | 75112509 | 2302377 | MAGICSHAPER | 25 | misses' and juniors' swimwear, leotards and lingerie. |
| 4 | 76368184 | 3181266 | MAGIC MAN | 25 | women's, men's, girls' and boys' apparel for running, skiing, basketball, golf, volleyball, walking, bicycling, soccer, football, baseball, lacrosse, hockey, and bowling, namely, swimwear; shape wear, namely, leotards, bike pants, unitards, t-shirts, vests, underpants; sportswear, namely, tops, bottoms, shorts, pants, jeans; tennis wear, namely, skirts, shorts, tank tops; running wear, namely, socks, shorts, unitards and long pants; and uniforms |
| 5 | 76437161 | 3187721 | MAGIC SUIT | 25 | men's and women's sportswear, namely, shorts, pants, tops, bodysuits, uniforms; intimate apparel, namely, shapers, girdles, figure-controlling underwear; and bodywear, namely, leotards |
| 6 | 78778207 | 3212734 | MAGICSUIT | 25 | swimsuits |
| 7 | 76396625 | 3335611 | MAGIC BRA | 25 | brassieres, lingerie and intimate apparel, namely, shapers, camisoles, tops and panties |
| 8 | 74670471 | 2039746 | MAGICBODY | 25 | women's and children's leotards, dancewear, namely tights and unitards, bodywear, namely body shapers, body suits, and swim wear |
| 9 | 77355731 | 4049527 | MAGIC DRESS | 25 | dresses |
| 10 | 77355724 | 3632390 | MAGIC JEANS | 25 | jeans |
| 11 | 77889385 | 4187166 | MAGICBODY | 25 | jeans; sportswear, namely, tops, bottoms, shirts, blouses, and pants |

2. All of the Magic Marks listed in the table of Paragraph 1 are valid and subsisting.

Further, the Magic Marks identified as Nos. 1, 2, 3, 4, 5, 6, 7, and 8, are incontestable.

3. A & H has taken great care to register and protect its rights in this family of Magic Marks for its goods in the United States and around the world. The Magic Marks have been used long and continuously throughout the United States and have been the subject of extensive advertising and promotion. Because of this, and because of the superior quality of such merchandise bearing the Magic Marks, the Magic Marks have become well known and famous.

4. A & H has invested a substantial sum of money in promoting the Magic Marks in interstate commerce.

5. The goods in Applicants' description of goods for the Opposed Mark are similar to the goods offered by A & H. Further, the Opposed Mark covers goods in International Class 025 and A & H's Magic Marks are all in International Class 025. Moreover, A&H and its related companies, manufacture and sell shapewear, as well as swimwear, lingerie, and other body shaping apparel.

6. A & H's apparel marketed under the Magic Marks are well known in the industry, nationwide and throughout the entire world.

7. The dates of first use of the Magic Marks long precede any date on which Applicants may rely to support its application for registration in International Class 025.

8. The mark Applicant seeks to register is confusingly similar to A & H's family of Magic Marks and would likely be confused as being part of the family.

9. On information and belief, A & H's goods and Applicants' goods are capable of sale to and use by the same class of purchasers.

10. On information and belief, A & H's goods and Applicants' goods would be found in the same channels of trade.

11. The use and registration by Applicant of the designation MAGIC TIGHTS in International Class 025 will enable Applicants to use and trade on the goodwill established by Opposer.

12. The use and registration by Applicants of the designation MAGIC TIGHTS in International Class 025 will dilute, blur and erode the distinctiveness of Opposer's famous Magic Marks.

13. Opposer believes and alleges that Applicants' mark when applied to the goods in International Class 025 of Application Serial No. 86/127054 is likely to cause confusion or mistake or to deceive, and will deceive and mislead the trade and purchasing public into believing that Applicants' goods are the goods of A & H, or that Applicants' goods are sponsored, approved or endorsed by A & H, or that Applicants are affiliated with A & H, or that Applicants are in some way related to A & H.

14. By reason of the foregoing facts, Opposer will be damaged by the registration of Applicants' confusingly similar mark in International Class 025.

WHEREFORE, Opposer prays that this opposition be sustained and that the registration sought by Application Serial No. 86/127054 in International Class 025 be denied.

Opposer appoints the following as its attorneys with full power of substitution, association and revocation in the above-entitled opposition to prosecute same and to transact all business in the United States Patent and Trademark Office in connection with said opposition:

Andrew B. Katz, Esq., U.S.P.T.O. Reg. No. 34,200
Lisa P. London
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This paper is being filed electronically through ESSTA. Payment in the amount of the three hundred dollar (\$300) filing fee is being made via credit card. To the extent that any additional funds are required for this filing, the Commissioner is authorized to charge any such fee to PTO Deposit Account No. 50-3656. The undersigned is an authorized user of this account.

Respectfully submitted,

BELES KATZ LLC

/Andrew B.Katz/
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ATTORNEY FOR A & H SPORTSWEAR CO. INC.

Dated: September 3, 2014

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 3rd day of September 2014 a true and correct copy of the foregoing Notice of Opposition (along with this Certificate of Service) was sent by first class mail, postage pre-paid to Applicants, Bruce Moncada and Yajaira Solano, at the following address:

Bruce Moncada
1 S. Ocean Avenue, Suite 202
Patchogue, New York 11772-3741

_____/Andrew B. Katz/
Andrew B. Katz