

ESTTA Tracking number: **ESTTA651364**

Filing date: **01/21/2015**

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	Louise D.B. James
Granted to Date of previous extension	01/21/2015
Address	4833 Ben Ave. Valley Village, CA 91607 UNITED STATES

Name	Charles B.H. James
Granted to Date of previous extension	01/21/2015
Address	1993 Kingsley Drive Bethlehem, PA 18018 UNITED STATES

Attorney information	MARK LERNER SATTERLEE STEPHENS BURKE & BURKE LLP 230 PARK AVENUE Suite 1130 NEW YORK, NY 10169-0079 UNITED STATES mlerner@ssbb.com Phone:212-818-9200
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Applicant Information

Application No	86279620	Publication date	09/23/2014
Opposition Filing Date	01/21/2015	Opposition Period Ends	01/21/2015
International Registration No.	NONE	International Registration Date	NONE
Applicant	LUVANIS S.A. 4, rue Dicks Luxembourg, L1417 LUXEMBOURG		

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: Body and beauty care cosmetics; Cosmetics; Fragrances and perfumery
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
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Attachments	2015 01 21 - Notice of Opposition - 86279620.pdf(715227 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	/mark lerner/
Name	MARK LERNER
Date	01/21/2015

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

In the Matter of Trademark Application
Serial No. 86279620 Filed © May 13, 2014
for the Trademark CHARLES JAMES
Published on September 23, 2014

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Charles B. H. James and Louise D. B. :
James, :
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Opposers, :
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- against - :
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Luvanis S.A., :
:
Applicant. :
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NOTICE OF OPPOSITION

Opposition No. _____

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

NOTICE OF OPPOSITION

In the matter of the application of Luvanis S.A., (hereinafter “Applicant”) for registration of the trademark CHARLES JAMES, application Serial No. 86279620, Charles B. H. James and Louise D. B. James (“Opposers” or “the James Children”), believe that they will be damaged by registration of the mark and hereby oppose the same. As grounds for opposition, it is alleged, upon information and belief, as follows:

1. Charles James was a famous designer and couturier of the 20th century.
2. Mr. James, who is often called “America’s First Couturier,” was at his

most prominent and productive in the 1940s and 1950s, designing and creating dramatic ball gowns, women's hats, coats, and day wear, and children's clothes.

3. Mr. James is particularly known for the intricate draperies of his gown creations, and for the structure of his clothing, which he based on architecture and hat-making principals.

4. During his lifetime, Mr. James' work was featured in many style publications, including Vogue, Life, and Harper's Bazaar magazines. His creations appeared on the cover of Vogue magazine three times. He won awards for his creations, including the prestigious Coty award twice, and fashion's Oscar, the Neiman Marcus award. In 2001 he was posthumously awarded a plaque on the New York's Fashion Walk of Fame.

5. Mr. James sold his creations through a number of business ventures incorporating his name, and his clothes regularly bore a "Charles James" label.

6. Mr. James' gowns were highly sought after by women prominent in society. Wearing a James' gown conferred the highest prestige on a woman. Among his clients were Coco Chanel, Diana Vreeland, Marlene Dietrich, Gypsy Rose-Lee, Babe Paley, and Austine Hearst (wife of William Randolph Hearst Jr.). Prices for his gowns were as high as \$1500 in the 1940s and 1950s; one of his gowns reputedly recently sold at auction for nearly \$50,000

7. Charles James died in 1978. His name and his work, however, continue to be renowned and famous in the fashion world and industry.

8. Mr. James' clothes are considered works of art and are highly prized. Many of his creations have been collected by and are shown in museums, both in the US and Great Britain, and his works have been the subject of a number of special exhibitions. The Chicago

History Museum put on a show of James' work in 2011; Brooklyn Museum held an exhibition of his work entitled "The Genius of Charles James" from October 16, 1982 through January 16, 1983 and holds many of his works in its permanent collection; the New York Metropolitan Museum of Art held a retrospective exhibition of Mr. James' work from May 8, 2014 through August 10, 2014. The exhibition presented about 75 of Mr. James' designs, through ball gowns, dresses, sketches, pattern pieces and other items. The exhibition garnered a good deal of publicity and excitement; in its publicity materials, the Museum says of Mr. James "he is now regarded as one of the greatest designers in America to have worked in the tradition of the Haute Couture." In conjunction with the exhibition, the Museum published a commemorative book detailing Mr. James' career and his influence on the world of fashion, entitled *Charles James: Beyond Fashion*.

9. Opposers, Charles B. H. James, an individual residing at 1993 Kingsley Drive, Bethlehem, PA 18018, and Louise D.B. James, an individual residing at 4833 Ben Ave. #2, Valley Village, CA 91607, are the natural children and heirs of Charles James, and are the current owners of his intellectual property rights.

10. The James Children are active in promoting their father's clothing and name. Such activities include the licensing of rights in Mr. James' sketches, drawings and models, as well as the licensing rights in his image and name to various museums for use in connection with exhibitions and associated commemorative books and printed and web-based materials promoting the exhibitions.

11. In addition, the James Children have licensed a third party to create a new clothing line based on their father's designs and work.

12. The James Children have also applied to register the mark CHARLES JAMES, Application Serial No. 86257126, in International Classes 16, 25, and 42, as well as Application Serial No. 86282939 in International Classes 3, 14, 18, 20, and 25. Class 16 of the first application covers “commemorative and biographical books featuring Charles James and his fashion designs”; Class 25 covers “women’s clothing, namely, cocktail and evening dresses, gowns and wedding dresses, skirts, blouses, scarves, shawls, stoles, capes, coats, jackets and outer wear, and hats”; and Class 42 covers “consulting in the field of women’s clothing and fashion design”. International Class 3 in the latter application covers “Bath oils and bath salts; Bath soaps; Body cream; Body lotion; Body oils; Body scrub; Body splash; Body spray used as a personal deodorant and as fragrance; Body sprays; Cosmetic soaps; Cosmetics; Deodorants for personal use; Eau de parfum; Eau de toilette and eau de cologne; Hair gels; Hair lotions; Nail polish; Perfumed talcum powder; Perfumery; Perfumes, aftershaves and colognes; Potpourri; Talcum powder.”

13. On May 14, 2014, Luvanis S.A., identified as a Luxembourg corporation with an address of 4, rue Dicks, Luxembourg L1417, LUXEMBOURG (hereafter “Luvanis” or “Applicant”), filed intent-to-use trademark application Serial No. 86279620 for the mark “Charles James” for “Body and beauty care cosmetics; Cosmetics; Fragrances and perfumery,” (“Applicant’s Goods”), claiming priority from European Community Trade Mark application number 012703864, filed March 18, 2014. Luvanis subsequently relied on Section 44(e) as an additional basis for registration, claiming Benelux Registration Number 0956284, issued May 9, 2014.

14. Application Serial No. 86279620 was published for opposition in the

USPTO Official Gazette of September 23, 2014. Opposers have obtained the necessary extensions of time in which to file this Notice of Opposition, and this notice is timely.

Count I — False Association

15. Applicant's mark CHARLES JAMES is identical to that of the James Children's father's name and will be recognized as pointing to Charles James the famous designer.

16. The Applicant's Goods, identified in the application are closely related to the goods with which the designer Charles James is associated and for which he is famous, since designers are often associated with cosmetics and perfumes in addition to clothing. Indeed, many trademarks for designers' names cover a range of goods including clothing, cosmetics, and perfumery.

17. Opposers, the James Children, are not connected with the Applicant in any way, or with the activities of Applicant, if any, in conjunction with Applicant's mark.

18. Charles James was famous during his lifetime and is still famous as a couturier, so that a connection with Charles James will be presumed when Applicant's mark is used on Applicant's Goods.

19. Upon information and belief, Applicant intends to educate consumers as to the reputation of Charles James and take advantage of the good will associated with his name and/or developed by means of that education of consumers.

20. Applicant's trademark CHARLES JAMES is identical to the name of the couturier CHARLES JAMES so as to be likely, when applied to Applicant's Goods, to falsely suggest a connection to him within the meaning of 15 U.S.C. § 1052(a).

21. Registration should therefore be refused under 15 U.S.C. §1052(a).

22. Registration of Applicant's proposed mark on the Principal Register would be inconsistent with Opposers' rights as the heirs of Charles James, and the owners of the trademarks incorporating his name, and would be damaging to Opposers, who have an interest in not seeing their father's name falsely associated with Applicant, which has no relation to Charles James and has never been granted permission to use the name.

23. Moreover, since Opposers have licensed the mark CHARLES JAMES to a third party to create a new clothing line based on their father's designs and work, the grant of registration excluding Opposers and its licensees from use would clearly be damaging to Opposers.

Dated: New York, New York
January 21, 2015

SATTERLEE STEPHENS BURKE & BURKE LLP

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Attorneys for Opposers

Charles B. H. James and Louise D. B. James v. Luvanis S.A.
CHARLES JAMES (SN. 86279620)
Opposition No.: *to be assigned*

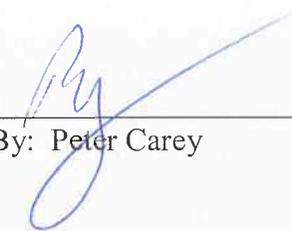
CERTIFICATE OF SERVICE

I hereby certify that on this day, a true and complete copy of the foregoing Notice of Opposition has been served on Applicant and Applicant's counsel of record by mailing copies on January 21, 2015, via Air Mail, postage prepaid to:

Luvanis S.A.
Attn: Arnaud de Lummen 4,
rue Dicks
L-1417 Luxembourg

and via First Class Mail, postage prepaid to:

John L. Welch
Lando & Anastasi
One Main Street
Cambridge, MA 02142



By: Peter Carey