

ESTTA Tracking number: **ESTTA660820**

Filing date: **03/12/2015**

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 party opposes registration of the indicated application.

Opposer Information

Name	SAN PATRICK, S.L.
Granted to Date of previous extension	03/28/2015
Address	POL. IND MANSO MATEU S/N 08820 EL PRAT DE LIOBREGAT BARCELONA, SPAIN

Attorney information	CHARLES P. LAPOLLA OSTROLENK FABER LLP 1180 AVENUE OF THE AMERICAS FL7 NEW YORK, NY 10036 UNITED STATES clapolla@ostrolenk.com, smcmahon@ostrolenk.com, tm@ostrolenk.com Phone:(212) 382-0700
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Applicant Information

Application No	86352017	Publication date	01/27/2015
Opposition Filing Date	03/12/2015	Opposition Period Ends	03/28/2015
Applicant	Pronoia Culture, LLC 645 Front Street #1106 San Diego, CA 92101 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Belts for clothing; Headgear, namely, caps, hats, beanies and other headwear; Hooded sweatshirts; Jeans; Knit shirts; Pants; Shirts; Shorts; Socks; Sweatsuits; Swimwear; T-shirts; Tank tops; Woven tops
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2486437	Application Date	07/17/1997
Registration Date	09/11/2001	Foreign Priority	NONE

		Date	
Word Mark	PRONOVIAS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Bride's dresses and gowns; bride's maid's dresses, gowns, women's and girl's dresses, gowns, veils, tiaras, trains, garters, garter belts, brassieres, bustiers, chemises, slips, petticoats, underclothes, footwear and headwear for wedding ceremonies Class 042. First use: First Use: 0 First Use In Commerce: 0 BEAUTY SALON SERVICES, WEDDING DRESS AND GOWN DESIGN, DESIGN OF TIARA, TRAIN, GARTER, GARTER BELT, BRASSIERE, BUSTIER, CHEMISE, SLIP, PETTICOAT, UNDERWEAR, FOOTWEAR AND HEADWEAR FOR WEDDING CEREMONIES		

Attachments	7.4043-1070 - Notice of Opposition.pdf(204354 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	/CPL/
Name	CHARLES P. LAPOLLA
Date	03/12/2015

As grounds for Opposition, it is averred as follows:

1. Pronoia Culture, LLC (hereinafter "Applicant") is not entitled to register as a trademark the designation PRONOIA for the goods set forth in application Serial No. 86/352,017.
2. Applicant is not now and was not entitled to the exclusive use as a trademark of the designation PRONOIA either on or about July 30, 2014, the date of filing of application Serial No. 86/352,017, or on January 27, 2015, the date of publication thereof in the Official Gazette.
3. Opposer is the owner of all rights, titles and interests in and to the following U.S. trademark/service mark registration:

Registration No.	Reg. Date	Mark	Class/Goods/Services
2,486,437	September 11, 2001	PRONOVIAS	"BRIDE'S DRESSES AND GOWNS; BRIDESMAID'S DRESSES, GOWNS, WOMEN'S AND GIRL'S DRESSES, GOWNS, VEILS, TIARAS, TRAINS, GARTERS, GARTER BELTS, BRASSIERES, BUSTIERS, CHEMISES, SLIPS, PETTICOATS, UNDERCLOTHES, FOOTWEAR AND HEADWEAR FOR WEDDING CEREMONIES" IN INT. CLASS 25 and "BEAUTY SALON SERVICES, WEDDING DRESS AND GOWN DESIGN, DESIGN OF TIARA, TRAIN, GARTER, GARTER BELT, BRASSIERE, BUSTIER, CHEMISE, SLIP, PETTICOAT, UNDERWEAR, FOOTWEAR AND HEADWEAR FOR WEDDING CEREMONIES" IN INT. CLASS 42.

4. The aforementioned Registration No. 2,486,437 is valid, presently subsisting and in full force and effect and is also incontestable pursuant to §15 of the Lanham Act, 15 U.S.C. §1065. Pursuant to §33(b) of the Lanham Act, 15 U.S.C. §1115(b), this Registration constitutes conclusive evidence of the validity of the mark, of Opposer's ownership of said mark and the exclusive right to use said mark in commerce on the goods and services set forth in the registration.

5. Since long prior to July 30, 2014, the date Applicant filed its application for the designation PRONOIA, and any use in commerce which may have been made of said designation by Applicant, Opposer has been continuously using the trademark/service mark PRONOVIAS in commerce in connection with the goods and services enumerated in the registration for this mark referred to in Paragraph 3 above.
6. Opposer has expended large sums of money and great time and effort in developing, advertising and promoting its PRONOVIAS trademark/service mark as an indicia of the source of origin of Opposer's goods and services. As a result of the extensive advertising, promotion and long term use of the aforementioned mark, Opposer has achieved large quantities of sales of goods and services under the PRONOVIAS trademark/service mark resulting in significant revenues to Opposer.
7. Opposer's PRONOVIAS trademark/service mark is extremely well-known and famous among the trade and the purchasing public in the United States and this mark has acquired tremendous strength, goodwill, purchaser recognition, fame and secondary meaning, and is therefore strong and entitled to a wide scope of protection.
8. The goods for which Applicant seeks to register the designation PRONOIA in application Serial No. 86/352,017 are the same or similar in nature to Opposer's aforesaid goods and services marketed under the PRONOVIAS trademark/service mark and are likely to be promoted through the same and/or similar media and are likely to be sold and distributed through the same, similar and/or overlapping channels of commerce and are likely to be directed to the same, similar and/or overlapping classes of purchasers.
9. The PRONOIA designation Applicant seeks to register is confusingly similar in overall appearance, pronunciation and connotation to Opposer's PRONOVIAS

trademark/service mark. Therefore, when applied to Applicant's goods, Applicant's PRONOIA designation is likely to cause confusion or mistake or to deceive persons by creating the erroneous impression that Applicant's goods originate with or come from the same source as Opposer's goods and services or are endorsed by, or are sponsored by, or are connected in some way with Opposer, thereby resulting in a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

10. Any use or registration of the designation PRONOIA by Applicant is also likely to cause a dilution of the distinctive quality of Opposer's famous PRONOVIAS trademark/service mark in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).
11. Opposer will be seriously damaged and injured by the granting of registration to Applicant's designation PRONOIA because this designation is a colorable imitation of and causes a dilution of Opposer's PRONOVIAS trademark/service mark and is confusingly similar thereto in sound, appearance, and connotation. Any defect, objection or fault found with Applicant's goods marketed under the designation PRONOIA is likely to reflect upon and injure the reputation which Opposer has established for its high quality goods and services marketed under its PRONOVIAS trademark/service mark.
12. Applicant's adoption and any use of the PRONOIA designation have been without license or permission of Opposer.
13. Applicant's exercise of statutory rights under a U.S. trademark registration for the designation PRONOIA would seriously lessen the value of Opposer's rights in, to and under its PRONOVIAS trademark/service mark, all to Opposer's great loss and detriment. Moreover, if Applicant were permitted to register the confusingly similar

designation PRONOIA for goods which are identical or related to the goods and services upon which Opposer's PRONOVIAS trademark/service mark is used, the public is likely to be deceived.

WHEREFORE, Opposer prays that registration of the designation PRONOIA in application Serial No. 86/352,017 be denied, and that this Opposition be sustained in favor of Opposer.

Dated: March ¹², 2015
New York, New York

Respectfully submitted,



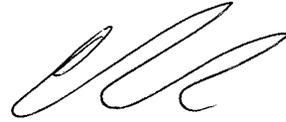
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CPL:mw

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served by First-Class mail, postage prepaid, upon Applicant, this ^{12th} day of March, 2015, addressed as follows:

PRONOIA CULTURE, LLC
645 FRONT STREET, NO. 1106
SAN DIEGO, CALIFORNIA 92101



Charles P. LaPolla