

ESTTA Tracking number: **ESTTA694868**

Filing date: **09/09/2015**

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	The Chachi Gonzales Brands, LLC
Granted to Date of previous extension	09/09/2015
Address	645 W 9th St, 110-124 Los Angeles, CA 90015 UNITED STATES
Attorney information	Victor K. Sapphire, Esq. Michelman & Robinson LLP 15760 Ventura Blvd.5th Floor Encino, CA 91436 UNITED STATES vsapphire@mrlip.com,trademarks@mrlip.com

Applicant Information

Application No	86490522	Publication date	05/12/2015
Opposition Filing Date	09/09/2015	Opposition Period Ends	09/09/2015
Applicant	Guadalupe Gonzales 6602 Wesleyan Street Houston, TX 77005 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2011/04/01 First Use In Commerce: 2011/04/01 All goods and services in the class are opposed, namely: On-line retail store services featuring clothing, duffel bags, bracelets; Retail store services featuring clothing, bracelets, duffel bags

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	CHACHI		
Goods/Services	entertainment services; clothing and wearing apparel		

Attachments	CHACHI OPPOSITION 522 CHACHI MOMMA.pdf(127615 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 First Class Mail on this date.

Signature	/vsapphire/
Name	Victor K. Sapphire, Esq.
Date	09/09/2015

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

Olivia Gonzales, and
Chachi Gonzales Brands, LLC,

Opposers,

v.

Guadalupe Gonzales dba Chachimomma,

Applicant

Opposition No. _____

Application No. 86490522

Mark: CHACHI

Filing Date: December 24, 2014

NOTICE OF OPPOSITION

Commissioner for Trademarks
PO Box 1451
Alexandria, VA 22313-1451

Olivia Gonzales, a United States citizen and the Chachi Gonzales Brands, LLC, a Texas limited liability company (collectively, "Opposer" or "Opposers"), believe that they will be damaged by the registration of CHACHI in connection with the goods and/or services identified in the application. The mark is the subject of federal trademark Application Serial No. 86490522 (the "'522 Appl."), allegedly owned by Guadalupe Gonzales dba Chachimomma ("Applicant"), and Opposers hereby oppose the registration thereof.

As grounds for this Opposition, it is alleged that:

1. Opposer OLIVIA “CHACHI” GONZALES is a 19 year-old dance sensation whose work as a dancer and dance choreographer is widely revered throughout America and the world. She rose to wide renown through her appearances on the popular nationally televised dance show, MTV’s “America’s Best Dance Crew” (the “MTV Show”), in 2011 as the season’s show winner. Her renown has continued to increase with the success of her career as a dancer, choreographer and actress, and as a result of an active schedule of public and broadcast appearances as a soloist and as part of the I.aM.mE dance group.
2. Her nickname, “CHACHI”, which she has had since before she attained professional renown, quickly became the popular professional name by which she is known to audiences in the dance and television entertainment worlds. Her professional appearances as an entertainer on and off television have been seen by hundreds of thousands, if not millions of consumers throughout the United States and North America. As a result, the CHACHI name and mark has become indelibly associated with Opposer CHACHI GONZALES.
3. In or about 2011, CHACHI GONZALES designed her own dance apparel items, namely, stylized pants that she wore on the MTV Show. She called the pants “Chachimomma pants” (the “Pants”). She brought the idea and design to her mother, Applicant GUADALUPE GONZALES, who sewed the pants at and according to CHACHI GONZALES’ direction.

4. CHACHI GONZALES and GUADALUPE GONZALES began manufacturing and selling the Pants at CHACHI GONZALES' workshop after one of CHACHI GONZALES' fellow students saw her wearing a pair of them.
5. As a result of their exposure via the MTV Show and other public events where they were worn by CHACHI GONZALES, and due to Opposer's growing renown, the Pants became wildly popular, which was reflected in online sales.
6. On December 25, 2014, GUADALUPE GONZALES filed federal trademark applications to register the mark CHACHI in the United States Patent and Trademark office.
7. In the application, Applicant declared under oath that, "being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration," that "[she] believe[d] the applicant to be the owner of the trademark/service mark sought to be registered" and that, "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true." However, nowhere in the application materials did she reference her daughter CHACHI GONZALES or her daughter's rights in the subject mark

8. The foregoing Declaration was made in bad faith: Applicant clearly knew at the time that she did not (nor does she now) own the subject mark.
9. The foregoing Declaration made as part of the '522 Appl. falsely represented material facts; namely, that (a) Applicant was not the owner of the mark; (b) Opposer had (and have) rights in the mark at the time of filing; and (c) to the extent Applicant had any rights at all in the mark, her rights were not exclusive.
10. Applicant was aware of the use of the identical mark by Opposer at the time the declaratory oath in the '522 Appl. was signed.
11. Applicant was aware that Opposer had superior rights in the subject mark of the '522 Appl. at the time of making the declaratory oath and filing the Application. Applicant knew or should have known that a likelihood of confusion would result from her use; she had no reasonable basis for believing otherwise.
12. In failing to disclose the foregoing facts to the Trademark Office and signing and filing the foregoing Declaration, Applicant intended willfully to induce the Trademark Office to grant her a federal trademark registration to which she is not entitled.
13. Applicant did not create the subject mark of the '522 Appl., nor is she the owner of the mark.
14. Applicant filed the '522 Appl. in bad faith with the intent to damage CHACHI GONZALES and Opposers.
15. Applicant's '522 Appl. is thus fraudulent and should be denied.

16. If the subject Application of this Opposition is granted registration, Applicant would illicitly retain at least a prima facie exclusive right to use of the CHACHI mark in connection with the goods/services identified in the '522 Appl.
17. Such registration will be a source of damage and injury to Opposer.
18. GUADALUPE GONZALES knew at the time of signing the foregoing application that her daughter, CHACHI GONZALES, had a claim of ownership to the subject mark and the subject mark's component term "CHACHI", which had by then for several years already been CHACHI GONZALES' professional name.
19. GUADALUPE GONZALES has traded off the name, identity and mark of Opposers in connection with the sale of goods and services through her unincorporated retail business operating under the misleading name "CHACHIMOMMA INC.", using the marks CHACHI, CHACHIMOMMA, and CHACHI PANTS in connection with the marketing and sale of the Pants and other dance-related merchandise.
20. Without the authorization of CHACHI GONZALES, GUADALUPE GONZALES has entered into licensing arrangements with Infusion, Inc., a marketing services company based in Michigan, and others (the "Licensing Agreements"), in connection with certain products and services associated with CHACHI GONZALES, including the Pants.
21. Infusion claimed to have the resources and capacity necessary to market the Pants and other CHACHI-related products, as well as to produce, sell and distribute the Pants, which had become popular items.

22. CHACHI GONZALES was an unemancipated minor at the time of execution of the Licensing Agreement and was identified as a party thereto, despite being unaware of the existence of the agreement.
23. Without CHACHI GONZALES' consent, authorization, or knowledge, GUADALUPE GONZALES signed as "Olivia Gonzales, a minor", and as "providing consent to this agreement as mother and legal guardian of Olivia Gonzales".
24. Infusion made payments pursuant to the terms of the Licensing Agreement of at least \$90,000.00 as of November 2012, by Infusion's own allegation.
25. Under the express terms of the Licensing Agreement, Infusion paid Applicant \$10,000.00 per month for an extendable term of 24 months.
26. Even though they were California residents at the time of execution of the Licensing Agreement, GUADALUPE GONZALES failed to seek or obtain approval of the California Courts as required by California Family Code 6750 et. seq., nor did she set aside required funds in trust for the benefit of the then-minor CHACHI GONZALES.
27. As a result of Applicant's conduct described herein, CHACHI GONZALES has never received any portion of the compensation and/or revenues due her resulting from the Licensing Agreement, nor was any of the revenue put into trust on her behalf.
28. After learning of the Licensing Agreement, CHACHI GONZALES confronted her mother GUADALUPE GONZALES concerning the matters herein described. As a result of the confrontation they became estranged, and

CHACHI GONZALES shortly thereafter was adjudicated an emancipated minor.

29. Applicant made no effort to seek Opposers' consent for the use and/or registration of the CHACHI marks (including CHACHI) and CHACHI GONZALES' name and likeness, nor has Applicant compensated Opposers for her unauthorized use of the foregoing properties.
30. GUADALUPE GONZALES has recently also filed several United States federal trademark applications for the marks CHACHI, CHACHI MOMMA and CHACHIPANTS in connection with a range of apparel and merchandise goods and associated retail services (collectively, the "Applications"). Said Applications include United States Application Serial Nos. 86490522, 86490522, 86590522, 86590576, 86590522, and 86590522.
31. The CHACHI mark and name is owned by OLIVIA "CHACHI" GONZALES and has been used professionally by her in connection with her activities as a dancer, performer, choreographer, designer and actress since before the filing date of the instant application, including without limitation on apparel goods and other goods and services sold to the public.
32. Opposers are marketing their own brand of apparel and the presence of the misleading CHACHI branded goods and services of Applicant in the market and on the Principal Register is likely to cause confusion among consumers in the market, who may mistakenly believe that Applicant's goods are sponsored, authorized, endorsed, affiliated and/or otherwise associated with Opposers, which is not the case.

33. Said registration will also affect Opposers' ability to enjoy and exploit their rights in the CHACHI marks.
34. Opposers and their associates working on Opposers' behalf have expended great effort and substantial sums of money in making and overseeing performances and merchandise under the officially licensed/endorsed imprimatur of CHACHI GONZALES, which has become well-known to relevant consumer audiences throughout the United States and the world. In so doing, the CHACHI mark has come to symbolize a certain level of quality and consistency in connection with all products bearing, sold under, and/or in conjunction with the mark. The CHACHI marks symbolize the goodwill created by Opposers' creative endeavors in dance and entertainment and associated ancillary merchandise.
35. As a result of the high quality of products sold under and/or in conjunction with CHACHI GONZALES and Opposers' CHACHI marks, and as a result of the subsequent success of advertising, sale and consumer acceptance of those products, consumers have come to view the CHACHI marks as exclusively identifying products associated with the group comprising Opposer CHACHI GONZALES.
36. Opposer's success in her entertainment endeavors has resulted in significant audience curiosity and excitement for the CHACHI name and mark, leading to interest in ancillary merchandise including apparel associated with or authorized by Opposers.
37. CHACHI GONZALES and THE CHACHI GONZALES BRANDS, an entity of which CHACHI GONZALES is a principal member and which she controls,

- have the sole and exclusive worldwide rights to use and/or to control the use of the CHACHI marks, and colorable imitations thereof, in connection with dance-related goods and services including live performances, audiovisual recordings and ancillary merchandise such as dance apparel like the Pants, in order to prevent the infringement, disparagement, dilution and/or other misappropriation thereof.
38. Opposer CHACHI GONZALES is the senior user of the CHACHI marks vis. Applicant.
 39. The CHACHI mark has not been assigned nor licensed to the Applicant for any purpose, and Applicant uses the mark without the consent or authorization of Opposers.
 40. Applicant has appropriated Opposer CHACHI GONZALES' name and likeness in adopting and marketing products popularized by Opposer under the names CHACHI and CHACHIMOMMA / CHACHI MOMMA.
 41. Said appropriation, being in connection with the commercial sale of apparel and other merchandise, was and is to Applicant's commercial and other advantage, at the expense of Opposers.
 42. Applicant's unauthorized and misleading use of the CHACHI marks has and will continue to cause great injury to Opposers.

APPLICANT'S UNLAWFUL ACTIVITIES

43. Opposers are informed and believe, and thereupon allege, that each of the foregoing actions of the Applicant, including without limitation the registration of the subject mark of this Opposition, will falsely mislead and/or confuse

consumers about the source of origin, association, sponsorship, approval or other business relationship between the Opposers on the one hand, and the Applicant's goods and services on the other.

44. Applicant's mark creates a false suggestion of a connection and/or association with a living individual, namely, Opposer CHACHI GONZALES.
45. Applicant's mark is likely, when used in connection with the subject goods in the application, to cause confusion, mistake, or deception. Because the mark has always been associated with Opposer, consumers may believe that Applicant's use of the mark in connection with the goods and/or services identified in the '522 Appl. is in some way associated with or connected with or sponsored, authorized or warranted by Opposers, which is not the case. Any objection to or fault with Applicant's products offered in connection with the mark would reflect upon and injure Opposers' reputation in connection with goods and services offered by Opposers.
46. Applicant's use of the CHACHI mark, or colorable or confusingly similar imitations thereof like CHACHI MOMMA / CHACHIMOMMA, is unfair, unlawful, and is likely to lead consumers to mistakenly and/or falsely believe that Applicant's goods are associated with, or made, sponsored, or approved by CHACHI GONZALES and/or THE CHACHI GONZALES BRANDS, which is not the case. Applicant will likely unfairly benefit from Opposers' valuable goodwill and hard-earned reputation for excellence, quality and consistency.
47. As a result, Applicant has acquired a cachet and salability for her products which she would not otherwise have had. These consequences were foreseeable

CERTIFICATE OF SERVICE

I hereby certify that on this 9th day of September, 2015 a true and correct copy of the NOTICE OF OPPOSITION was served on Applicant Guadalupe Gonzales, 4103 Norfolk St., Houston, Texas 77027, via first class mail.

/s/

Victor K. Sapphire