

ESTTA Tracking number: **ESTTA705964**

Filing date: **11/02/2015**

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	Kiko S.p.A.
Granted to Date of previous extension	11/01/2015
Address	via Paglia 1/D Bergamo, 24122 ITALY

Attorney information	Michael J. Leonard Fox Rothschild LLP 997 Lenox Drive, Bldg. 3 Lawrenceville, NJ 08648-2311 UNITED STATES ipdocket@foxrothschild.com, mleonard@foxrothschild.com
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Applicant Information

Application No	86480450	Publication date	05/05/2015
Opposition Filing Date	11/02/2015	Opposition Period Ends	11/01/2015
Applicant	Chris Chon 8521 Beech Tree Road Bethesda, MD 20817 UNITED STATES		

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: cosmetics; nail polish and nail care preparations; blush; blush pencils; eye cream; eye pencils; eye shadow; facial cleansers; foundations; lip gloss; lipstick; mascara; shower gels; skin cream
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Grounds for Opposition

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

U.S. Registration No.	3689438	Application Date	06/01/2005
Registration Date	09/29/2009	Foreign Priority Date	NONE
Word Mark	KIKO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre and after shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes

U.S. Registration No.	3650052	Application Date	09/23/2008
Registration Date	07/07/2009	Foreign Priority Date	NONE
Word Mark	KIKO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Make-up for women		

U.S. Registration No.	4690585	Application Date	03/22/2013
Registration Date	02/24/2015	Foreign Priority Date	03/06/2013
Word Mark	KIKO MAKE UP MILANO		

Design Mark	
Description of Mark	The mark consists of the word "KIKO" in larger type and the phrase "MAKE UP MILANO" in smaller type underneath.
Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 Perfumes, toilet soaps, cosmetics, namely, deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams, oils and lotions; pre- and after-shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes, excluding goods for infants and children up to 11 years old</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Retail department store services, excluding goods for infants and children up to 11 years old; retail store services featuring a wide variety of consumer goods of others, excluding goods for infants and children up to 11 years old; retail variety stores, excluding goods for infants and children up to 11 years old</p>

Related Proceedings	91221465
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Attachments	78641087#TMSN.png(bytes) 77576761#TMSN.png(bytes) 85884151#TMSN.png(bytes) KOKIE and Design opposition.pdf(114472 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	/michael leonard/
Name	Michael J. Leonard
Date	11/02/2015

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

RE: U.S. Trademark Application Serial No. 86/480,450
Published in the Official Gazette on 5 May 2015

KIKO S.p.A.)	
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Opposer)	
)	Opposition No. _____
-v-)	
)	
CHRIS CHON)	
)	
Applicant)	
)	
)	
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NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

In the matter of Application Serial No. 86/480,450 filed 15 December 2014, by Chris Chon (“Applicant”), to register the mark KOKIE and Design for goods described as “cosmetics; nail polish and nail care preparations; blush; blush pencils; eye cream; eye pencils; eye shadow; facial cleansers; foundations; lip gloss; lipstick; mascara; shower gels; skin cream” in International Class 03 (“Applicant’s Goods”), which was published in the Official Gazette on 5 May 2015, Kiko S.p.A. (“Opposer”) of Bergamo, Italy, believes it will be damaged by the registration of the KOKIE and Design mark and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is an individual having an address at 8521 Beech Tree Road, Bethesda, MD 20817. On 15 December 2014, Applicant filed Application Serial No. 86/480,450 for the mark KOKIE and Design for Applicant's Goods based on Applicant's claim of intent to use the mark in commerce.

2. Opposer, Kiko S.p.A., is an Italian company and the owner of the internationally renowned cosmetics brand KIKO (the "KIKO Marks").

3. Opposer is using its KIKO Marks in the United States, has invested substantial resources in advertising and promoting its goods, and has acquired substantial goodwill and notoriety under its KIKO Marks.

4. Opposer is the owner of U.S. Registration No. 3,689,438 for KIKO covering "perfumes, toilet soaps, cosmetics, namely deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams; oils and lotions; pre and after shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes."

5. Opposer is the owner of U.S. Registration No. 3,650,052 for KIKO covering "make-up for women."

6. Opposer is the owner of U.S. Registration No. 4,690,585 for KIKO MAKE-UP MILANO (stylized) covering "Perfumes, toilet soaps, cosmetics, namely, deodorants for personal use; creams, lotions and oils for the face and body; skin cleansing milks, creams and oils; make-up creams; beauty masks; make-up removers; eye shadows; lipsticks; mascara, rouge; crayons for the eyes and lips; face and body powders; suntanning and after sun exposure creams,

oils and lotions; pre- and after-shave lotions; talcum powders, bath salts, bath foam, bath oil; hair shampoo, hair lotions; depilatory preparations; nail enamels and polishes, excluding goods for infants and children up to 11 years old;’ in Class 3; and “Retail department store services, excluding goods for infants and children up to 11 years old; retail store services featuring a wide variety of consumer goods of others, excluding goods for infants and children up to 11 years old; retail variety stores, excluding goods for infants and children up to 11 years old;” in Class 35.

7. The goods and services set forth in Registration Nos. 3,689,438; 3,650,052; and 4,690,585 are collectively referred to herein as “Opposer’s Goods and Services.”

8. Opposer's Registrations are valid and subsisting, and are *prima facie* evidence of the validity of the registered Marks set forth therein, and Opposer's exclusive right to use the registered Marks set forth therein in connection with the goods and services specified in the registrations.

9. Commencing prior to Applicant’s filing date and, upon information and belief, any alleged date of first use that can be claimed by Applicant, Opposer’s KIKO Marks became registered covering cosmetics and related goods and services.

10. Commencing prior to Applicant’s filing date and, upon information and belief, any alleged date of first use that can be claimed by Applicant, Opposer’s KIKO mark has been used in United States commerce on KIKO-branded goods and services.

11. Since the initial use and registration of the KIKO Marks, Opposer’s Goods and Services have been advertised, promoted and sold under the KIKO Marks. Opposer’s customers and the public in general have come to know and recognize Opposer’s KIKO Marks and associate the Marks with Opposer and/or Opposer’s Goods and Services.

12. Applicant's KOKIE portion of its mark is confusingly similar to Opposer's earlier used and registered KIKO Marks (both beginning with a "K" and containing a second "K" in between various vowels) and applies to substantially similar, and in some cases identical, goods to those covered by Opposer's KIKO Registrations and is likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

13. Opposer's Goods and Services and Applicant's Goods, which are substantially similar, and in many cases identical, are likely to be offered and sold through the same channels of trade and purchased by the same class of purchasers.

14. Opposer's customers, and the public in general, are likely to be confused, mistaken, or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Goods sold and marketed under Applicant's KOKIE mark and misled into believing that such goods are produced by, offered by, sold by, emanate from or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

15. Applicant's 15 December 2014 filing date of Application Serial No. 86/480,450 is subsequent to the filing dates of Opposer's pleaded registrations and Opposer's dates of first use in commerce.

16. Applicant's filing of Application Serial No. 86/480,450 for KOKIE and Design is without license, authorization or permission from Opposer.

17. Opposer will be damaged by the registration of the KOKIE mark as set forth in Application Serial No. 86/480,450, in that the mark is confusingly similar to Opposer's KIKO Marks, thereby violating Opposer's rights to its Marks.

18. Registration of Applicant's KOKIE and Design mark should not be granted as it is contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its KIKO Marks.

WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 86/480,450 be refused and that the registration of KOKIE and Design as a trademark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

Date: 2 November 2015

By: /michael leonard./
Michael J. Leonard, Esq.
Christopher D. Olszyk, Jr., Esq.
FOX ROTHSCHILD LLP
997 Lenox Drive, Building 3
Lawrenceville, NJ 08648-2311

Attorneys for Opposer Kiko S.p.A.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served on Applicant this 2nd day of November 2015 by sending same via First Class Mail, postage prepaid, to:

Martin P. Hoffman
Stein IP, LLC
1400 Eye St NW, Ste. 300
Washington, DC 20005-6500

By: /michael leonard./