

ESTTA Tracking number: **ESTTA707912**

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

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 | 11/11/2015                                 |
| Address                               | Via Paglia, 1/D<br>Bergamo, 24122<br>ITALY |

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

**Applicant Information**

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 86525465  | Publication date       | 07/14/2015 |
| Opposition Filing Date | 11/11/2015  | Opposition Period Ends | 11/11/2015 |
| Applicant              | Trinh, Tho H.<br>707 South Webster Ave., #118<br>Anaheim, CA 92804<br>UNITED STATES |                        |            |

**Goods/Services Affected by Opposition**

|   |
|---|
| Class 003. First Use: 2012/12/07 First Use In Commerce: 2012/12/07<br>All goods and services in the class are opposed, namely: Acrylic nail POWDER preparations for shaping or sculpting nails; Adhesives for artificial nails; Adhesives for attaching artificial fingernails and/or eyelashes; Adhesives for false eyelashes, hair and nails; Artificial fingernails; Artificial fingernails not of precious metal; Cosmetic preparations for nail drying; Cosmetic preparations for removing gel nails, acrylic nails, and nail polish; False nails; False nails made of POLYMER RESIN; Fingernail decals; Fingernail sculpting liquid; Fingernail sculpturing overlays; Nail art pens; Nail buffing preparations; Nail care kits comprising nail polish; Nail care preparations; Nail care preparations, namely, nail softeners; Nail cream; Nail enamel removers; Nail enamels; Nail gel |
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**Grounds for Opposition**

|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

**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<br>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<br>Make-up for women     |                       |            |

|             |  |
|-------------|--|
| Attachments | 78641087#TMSN.png( bytes )<br>77576761#TMSN.png( bytes )<br>AIKO Notice of Opposition.pdf(115426 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      | 11/11/2015         |

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

RE: U.S. Trademark Application Serial No. 86/525465  
Published in the Official Gazette on 14 July 2015

|                      |   |                      |
|----------------------|---|----------------------|
| <b>KIKO S.p.A.</b>   | ) |                      |
|                      | ) |                      |
| Opposer              | ) |                      |
|                      | ) | Opposition No. _____ |
| -v-                  | ) |                      |
|                      | ) |                      |
| <b>TRINH, THO H.</b> | ) |                      |
|                      | ) |                      |
| Applicant            | ) |                      |
|                      | ) |                      |
| _____                | ) |                      |

**NOTICE OF OPPOSITION**

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

Commissioner:

In the matter of Application Serial No. 86/525465 filed 5 February 2015 by Tho H. Trinh, (“Applicant”), to register the mark AIKO and design for goods described as “Acrylic nail POWDER preparations for shaping or sculpting nails; Adhesives for artificial nails; Adhesives for attaching artificial fingernails and/or eyelashes; Adhesives for false eyelashes, hair and nails; Artificial fingernails; Artificial fingernails not of precious metal; Cosmetic preparations for nail drying; Cosmetic preparations for removing gel nails, acrylic nails, and nail polish; False nails; False nails made of POLYMER RESIN; Fingernail decals; Fingernail sculpting liquid; Fingernail sculpturing overlays; Nail art pens; Nail buffing preparations; Nail care kits comprising nail polish; Nail care preparations; Nail care preparations, namely, nail softeners;

Nail cream; Nail enamel removers; Nail enamels; Nail gel” in International Class 03 (“Applicant’s Goods”), which was published in the Official Gazette on 14 July 2015, Kiko S.p.A. (“Opposer”) of Bergamo, Italy, believes it will be damaged by the registration of the AIKO and design mark and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is a United States citizen having an address at 707 South Webster Ave., #118, Anaheim, California 92804. On 15 February 2015, Applicant filed Application Serial No. 86/525465 for the mark AIKO and design for Applicant's Goods based on Applicant's claim of use in commerce since 7 December 2012.

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

3. Opposer is the owner of incontestable 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.”

4. Opposer is the owner of incontestable U.S. Registration No. 3,650,052 for KIKO covering “make-up for women.”

5. The foregoing Registrations are collectively referred to herein as the “KIKO Marks.” The goods and services set forth in Registration Nos. 3,689,438 and 3,650,052 are collectively referred to herein as “Opposer’s Goods.”

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

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

8. Applicant's filing of Application Serial No. 86525465 for AIKO and design is without license, authorization or permission from Opposer.

9. Applicant's filing date of 15 February 2015 is subsequent to the filing dates of Opposer's KIKO Registrations as set forth above.

10. Applicant's 7 December 2012 date of first use anywhere and in commerce as claimed in Application Serial No. 86/525465 is subsequent to Opposer's date of first use of its KIKO Mark.

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 AIKO and design mark is confusingly similar to Opposer's KIKO Marks in that the KIKO and AIKO terms appear visually similar and will be pronounced similarly by consumers, and thus, when the AIKO mark is used in connection with Applicant's

Goods, it is likely to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

13. Applicant's AIKO mark is confusingly similar to Opposer's earlier used and registered KIKO Marks, as both marks end in the identical I-K-O letters/term. Opposer's registration and use of its KIKO mark in commerce encompasses goods identical to those set forth in the AIKO and design Application (nail enamels) and other goods that are substantially similar and related to Applicant's Goods. As such, the use and registration of Applicant's Mark for Applicant's Goods is likely to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

14. The inclusion of the flower design element over the "I" appearing in Applicant's composite AIKO and design mark does not serve to sufficiently distinguish the respective marks given that nature of the respective marks when considered as a whole.

15. Opposer's Goods and Applicant's Goods are offered or are likely to be offered through the same channels of trade, and are purchased and used by the same class of purchasers.

16. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement and sponsorship of Applicant's Goods sold, offered for sale, and marketed under Applicant's AIKO and design mark and misled into believing that such Goods are produced, distributed, offered, sold, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

17. Opposer will be damaged by Applicant's registration of the AIKO and design mark as set forth in Application Serial No. 86/525465, in that Applicant's AIKO and

design mark is confusingly similar in appearance, sound and commercial impression to Opposer's KIKO Marks and covers related and overlapping goods.

18. Applicant's registration of the AIKO and design mark would be 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. 86/525465 for the AIKO and design mark be refused and for such other relief as may be deemed just and proper.

Respectfully submitted,

Date: 11 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's counsel this 11<sup>th</sup> day of November 2015 by sending same via First Class Mail, postage prepaid, to:

Mike N. Vo  
Law Offices of Mike N Vo  
15355 Brookhurst St., Ste 202  
Westminster, CA 92683-7078

By:   /michael leonard./