

ESTTA Tracking number: **ESTTA716771**

Filing date: **12/28/2015**

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	Vitra Patente AG
Granted to Date of previous extension	12/27/2015
Address	Klunefeldstrasse 22 Birsfelden, CH-4127 SWITZERLAND

Name	Visplay International AG		
Entity	Corporation	Citizenship	Switzerland
Address	Klunefeldstrasse 22 Birsfelden, CH-4127 SWITZERLAND		

Attorney information	Robert M. Wasnofski, Jr. Dorsey & Whitney LLP 51 West 52nd Street New York, NY 10019-6119 UNITED STATES ny.trademark@dorsey.com, wasnofski.robert@dorsey.com, osowski.kaydi@dorsey.com Phone:(212) 415-9200
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Applicant Information

Application No	86403590	Publication date	06/30/2015
Opposition Filing Date	12/28/2015	Opposition Period Ends	12/27/2015
Applicant	Vitra S.A. de C.V. 2 calle Noreste Barrio San Fernando 14 a San Pedro Sula, HONDURAS		

Goods/Services Affected by Opposition

Class 006. First Use: 2010/04/20 First Use In Commerce: 2010/04/20 All goods and services in the class are opposed, namely: Doors made primarily of aluminum and also including glass
Class 019. First Use: 2010/04/20 First Use In Commerce: 2010/04/20 All goods and services in the class are opposed, namely: Colored sheet glass; Common sheet glass; Decorative glass; Glass bricks; Glass for building; Glass panes; Glass tiles; Insulated glass; Insulating glass for building; Insulating glass for construction purposes; Insulating glass for windowsfor building purposes; Laminated flat glass; Luminous glass for building; Modified sheet glass; Reinforced glass for building; Safety glass for building purposes; Tempered glass for building; Window glass

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.	1077866	Application Date	03/03/1976
Registration Date	11/22/1977	Foreign Priority Date	NONE
Word Mark	VITRA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 019. First use: First Use: 0 First Use In Commerce: 0 [BUILDING MATERIALS-NAMELY, HANG RAILS, BRACKETS AND WALL ACCESSORIES, INCLUDING DISPLAY HARDWARE, CARD HOLDERS, CORNICE COMPONENTS AND PARTITION POSTS]</p> <p>Class 020. First use: First Use: 0 First Use In Commerce: 0 [PLASTIC IDENTIFICATION MERCHANDISE TAGS, DISPLAY STANDS, TABLES AND SHELVING FOR MERCHANDISE AND POSTERS IN SHOPS AND WINDOWS, DECORATIVE BUSTS, MOULDED DUMMIES, AND] CHAIRS</p> <p>Class 026. First use: First Use: 0 First Use In Commerce: 0 [COAT HANGERS]</p>		

U.S. Registration No.	2288505	Application Date	11/13/1997
Registration Date	10/26/1999	Foreign Priority Date	NONE
Word Mark	VITRA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 1974/00/00 First Use In Commerce: 1985/00/00 Office furniture		

U.S. Registration No.	3655049	Application Date	12/02/2008
Registration Date	07/14/2009	Foreign Priority Date	10/03/2008
Word Mark	VITRA		

Design Mark	VITRA
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 Providing of food and drink; providing temporary accommodation; hotel services; coffee shop, cocktail lounge, snack bar and restaurant services; catering services; preparation of food and beverage; preparation of food and beverage for take-out; rental and provision of assembly halls for special occasions

U.S. Registration No.	4779670	Application Date	12/18/2014
Registration Date	07/28/2015	Foreign Priority Date	07/02/2014
Word Mark	VITRA		
Design Mark	VITRA		
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 0 First Use In Commerce: 0 Electric lamps; apparatus for lighting		

U.S. Registration No.	4783879	Application Date	05/22/2014
Registration Date	08/04/2015	Foreign Priority Date	03/27/2014
Word Mark	VITRA		
Design Mark	VITRA		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 0 First Use In Commerce: 0 Clocks Class 020. First use: First Use: 0 First Use In Commerce: 0 Furniture, namely, chairs, tables, sofas, lounge chairs, stools, benches, desks, and room dividers; decorative objects and art objects, namely, works of art of wood, wax, plaster, marble, porcelain or plastic materials; miniature furniture; cushions; ottomans; furniture partitions; storage containers of plastic materials		

	for household and office use; accessory trays not made of metal sold empty Class 035. First use: First Use: 0 First Use In Commerce: 0 Retail store services featuring furniture, textile materials, bed linen and table lin- en, curtains, cushions and covers,decorative objects, tableware, candle holders, vases, trays and lamps
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Attachments	75389279#TMSN.png(bytes) 79063372#TMSN.png(bytes) 79159519#TMSN.png(bytes) 79151398#TMSN.png(bytes) Vitra Patente - Notice of Opposition - VITRA Logo Mark filed by Vitra S A - v2.pdf(24723 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	/rmw/
Name	Robert M. Wasnofski, Jr.
Date	12/28/2015

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

IN THE MATTER OF APPLICATION

Mark: VITRA VIDRIOS TRANSFORMADOS, S.A. DE C.V. & Design
Applicant: Vitra S.A. de C.V.
Serial No.: 86/403,590
Filed: September 23, 2014
Published in
the **Official Gazette**: June 30, 2015

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VITRA PATENTE AG	:	
	:	
and	:	
	:	
VISPLAY INTERNATIONAL AG.	:	
	:	
Opposers,	:	Opposition No. ____,__
	:	
v.	:	
	:	
VITRA S.A. DE C.V.,	:	
	:	
Applicant.	:	
_____	x	

NOTICE OF OPPOSITION

Vitra Patente AG (hereinafter “Vitra”) and Visplay International AG (hereinafter “Visplay”), both Swiss corporations located at Klünenfeldstrasse 22 CH-4127 Birsfelden, Switzerland (hereinafter collectively “Opposers”), believe that they will be damaged by the registration of the mark VITRA VIDRIOS TRANSFORMADOS, S.A. DE C.V. & Design, Application Serial No. 86/403,590, filed on September 23, 2014, covering various goods in International Classes 6 and 19 (hereinafter “Alleged Mark”) in the name of Vitra S.A. de C.V. (hereinafter “Applicant”) and, having previously been granted extensions of time to oppose, hereby oppose same.

The specific grounds for this opposition are as follows:

1. Opposers belong to the Vitra Group, which is one of the worldwide leading producers and suppliers of high-quality design furniture for home, office, business and shop fitting purposes as well as a full assortment of shop fitting components.

2. Opposer Vitra has long used the trademark VITRA throughout the world in connection with, *inter alia*, furniture for home, office, business and shop fitting purposes. In the United States, Opposer Vitra has used the VITRA mark in connection with such goods since at least as early as 1985. Over the years, significant sums have been spent in marketing and promoting the VITRA mark in the United States, and throughout the world.

3. Opposer Vitra is the owner of the following federal trademark registrations:

<u>Mark</u>	<u>Registration No.</u>
VITRA	1,077,866
VITRA	2,288,505
VITRA	3,655,049
VITRA	4,779,670
VITRA	4,783,879

These registrations are valid and subsisting. Moreover, Reg. Nos. 1,077,866 and 2,288,505 are incontestable pursuant to 15 U.S.C. § 1065.

4. Opposer Visplay is the owner of a valid and subsisting trademark registration for the mark VITRASHOP (Reg. No. 3,864,456).

5. As a result of the supervision and control exercised by Opposer Vitra over the nature and quality of the goods offered in connection with its mark VITRA, and the advertising, promotion, offering and public acceptance thereof, the mark VITRA has acquired significant goodwill in the United States and has become an asset of incalculable value to Opposer Vitra.

6. Since long prior to the filing date of the opposed application and, upon information and belief, since long before use of the Alleged Mark by Applicant, Opposers have used and/or registered the VITRA and VITRASHOP marks, as further alleged above.

7. By the application opposed herein, Applicant seeks to register the mark VITRA VIDRIOS TRANSFORMADOS, S.A. DE C.V. & Design for “doors made primarily of aluminum and also including glass” in International Class 6; and “colored sheet glass; common sheet glass; decorative glass; glass bricks; glass for building; glass panes; glass tiles; insulated glass; insulating glass for building; insulating glass for construction purposes; insulating glass for windows for building purposes; laminated flat glass; luminous glass for building; modified sheet glass; reinforced glass for building; safety glass for building purposes; tempered glass for building; window glass” in International Class 19.

8. Applicant’s Alleged Mark so resembles Opposers’ previously used and/or registered marks, VITRA and VITRASHOP, as to be likely, when used in connection with Applicant’s goods, to cause confusion, to cause mistake, or to deceive, with consequent injury to Opposers and the public.

9. Specifically, and without limitation, the marketing and sale of Applicant’s aforementioned goods under the Alleged Mark is likely to cause consumers to believe that Applicant’s goods are those of Opposers, that Applicant’s goods are associated with the goods of Opposers, and/or that Applicant is somehow related to or sponsored by Opposers. Accordingly, Applicant’s Alleged Mark is not entitled to registration pursuant to 15 U.S.C. § 1052(d).

10. Opposers will be damaged by the registration sought by Applicant within the meaning of 15 U.S.C. § 1063 because such registration would support and assist Applicant in the confusing and misleading use of Applicant’s Alleged Mark and would give color of exclusive

statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposers.

WHEREFORE, Opposers pray that this Notice of Opposition be sustained and that the registration sought by Applicant be denied.

Respectfully submitted,

DORSEY & WHITNEY LLP

Dated: December 28, 2015

By: /rmw/
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Kaydi L. Osowski
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New York, New York 10019
(212) 415-9200

Attorneys for Opposers

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VITRA PATENTE AG	:	
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and	:	
	:	
VISPLAY INTERNATIONAL AG.	:	
	:	
Opposers,	:	Opposition No. ____, ____,
	:	
v.	:	
	:	
VITRA S.A. DE C.V.,	:	
	:	
Applicant.	:	
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing Notice of Opposition is being served upon the “Attorney of Record” for Applicant by mailing a true copy thereof by first class mail, postage prepaid, addressed to:

Debra Hill, Esq.
FisherBroyles, LLP
4600 Touchton Rd E Ste 150
Jacksonville, Florida 32246-8299

on December 28, 2015

/klo/
Kaydi L. Osowski