

ESTTA Tracking number: **ESTTA732299**

Filing date: **03/09/2016**

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	Gap (Apparel), LLC
Granted to Date of previous extension	03/09/2016
Address	2 Folsom Street San Francisco, CA 94105 UNITED STATES

Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza 6th Floor New York, NY 10017 UNITED STATES jweinberger@fzlj.com, fkohn@fzlj.com Phone:(212) 813-5900
----------------------	--

Applicant Information

Application No	86438962	Publication date	11/10/2015
Opposition Filing Date	03/09/2016	Opposition Period Ends	03/09/2016
Applicant	VERSACE 19.69 ABBIGLIAMENTO SPORTIVO S.R.L. Via Daniele Crespi, 1 Busto Arsizio (VA), I-21052 ITALY		

Goods/Services Affected by Opposition

<p>Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: After shave lotions; After sun creams; After sun moisturisers; Aftershave; Aftershave cologne; Aftershave moisturising cream; After-shave balms; After-shave lotions; After-sun gels; After-sun oils; Age retardant lotion; Age spot reducing creams; Aloe vera gel for cosmetic purposes; Antibacterial skin soaps; Antiperspirant soap; Antiperspirants and deodorants for personal use; Anti-aging cleanser; Anti-aging cream; Anti-aging moisturizer; Anti-wrinkle cream; Argan oil for cosmetic purposes; Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated footcream; Aromatic oils for the bath; Bathcrystals; Bath foam; Bath gel; Bath lotion; Bath oils; Bath oils and bath salts; Bath oils for cosmetic purposes; Bath pearls; Bath soaps in liquid, solid or gel form; Beauty balm creams; Beauty lotions; Beauty masks; Beauty serums; Bergamot oil; Blush; Body and beauty care cosmetics; Body butter; Body creams; Body powder; Body scrub; Cleansing milk for cosmetic purposes; Cocoa butter for cosmetic purposes; Cosmetic creams; Cosmetic hand creams; Cosmetic nourishing creams; Cosmetics and make-up; Cosmetics in general, including perfumes; Cosmetics, namely, compacts; Cosmetics, namely, lip primer; Creamy face powder; Creamy rouges; Cuticle conditioners; Eau de colognes; Eau de parfum; Eau de toilette; Exfoliant creams for skin; Eye cream; Eye liner; Eye make-up; Eye make-up remover; Eye shadow; Eyebrow colors; Eyebrow cosmetics; Eyebrow gel; Eyebrow pencils; Eyelash tint; Eye-</p>
--

liner; Eyeliner pencils; Facial concealer; False nails; Fingernail decals; Fingernail embellishments; Fingernail jewelry; Foundation make-up; Fragrances and perfumery; Gels for cosmetic purposes; Hair care kits comprising non-medicated hair care preparations, namely, shampoo, conditioner, gel; Hair care products, namely, heat protection sprays; Hair conditioner; Hair curling preparations; Hair gel and hair mousse; Hair spray; Hair styling spray; Handmade soap bars; Lipsticks; Liquid perfumes; Loose face powder; Mascara; Nail care kits comprising nail polish; Nail glitter; Nail varnish for cosmetic purposes; Night cream; Perfumes and colognes; Pre-moistened cosmetic towelettes; Self-tanning preparations; Shampoo-conditioners; SPF sun block sprays; Foundation, Powder, Concealer, Lip Gloss, Face cream, Lotions for skin, Eye cream, Facial Washes, Facial Cleansers, Facial Masks, Hand Lotions; Hand Cream, Nail polish, Nail Cream, Cuticle Oils, Shampoo, Conditioner, Hair care preparations and Hair relaxers

Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2449575	Application Date	05/26/1998
Registration Date	05/08/2001	Foreign Priority Date	NONE
Word Mark	1969		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1999/02/04 First Use In Commerce: 1999/02/04 CLOTHING, namely, PANTS, JEANS, [OVERALLS,] SHORTS, KHAKI PANTS, SWEATSHIRTS, SHIRTS, T-SHIRTS, [SOCKS, CAPS] AND JACKETS		

U.S. Registration No.	3873549	Application Date	04/08/2010
Registration Date	11/09/2010	Foreign Priority Date	NONE
Word Mark	1969		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/02/04 First Use In Commerce: 1999/02/04 Retail store services in the field of clothing		

U.S. Registration	4161684	Application Date	04/08/2010
-------------------	---------	------------------	------------

No.			
Registration Date	06/19/2012	Foreign Priority Date	NONE
Word Mark	1969		
Design Mark	<h1>1969</h1>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/02/04 First Use In Commerce: 1999/02/04 Retail store services in the field of clothing, accessories, footwear, and bags; on-line retail store services in the field of clothing, accessories, footwear, and bags		

U.S. Registration No.	4221697	Application Date	03/02/2012
Registration Date	10/09/2012	Foreign Priority Date	NONE
Word Mark	1969		
Design Mark	<h1>1969</h1>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2011/11/10 First Use In Commerce: 2011/11/10 Magnetic coded gift cards		

U.S. Registration No.	4481405	Application Date	06/11/2010
Registration Date	02/11/2014	Foreign Priority Date	NONE
Word Mark	1969		

Design Mark	<h1>1969</h1>
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 2013/11/01 First Use In Commerce: 2013/11/01 Bags, namely, tote bags, handbags, and all-purpose carrying bags

U.S. Application No.	85948003	Application Date	05/31/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	1969		
Design Mark	<h1>1969</h1>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Fragrances, Perfume, Cologne, Skin lotions, Aftershave, Liquid soap, Bath soapsin liquid, solid or gel form		

Related Proceedings	Opp. No. 91222574, Canc. No. 92062578
---------------------	---------------------------------------

Attachments	85009804#TMSN.png(bytes) 85009864#TMSN.png(bytes) 85559179#TMSN.png(bytes) 85060649#TMSN.png(bytes) 85948003#TMSN.png(bytes) Notice of Opposition (19 V 69) (Class 3) (F1896575x96B9E).pdf(52120 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	/s/ James D. Weinberger
Name	James D. Weinberger
Date	03/09/2016

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

In the Matter of Application Serial No. 86/438,962
Published in the *Official Gazette* on November 10, 2015
Mark: 19 V 69 ITALIA & Design

GAP (APPAREL), LLC,

Opposer,

-against-

VERSACE 19.69 ABBIGLIAMENTO
SPORTIVO S.R.L.,

Applicant.

NOTICE OF OPPOSITION

Opposer Gap (Apparel), LLC, a California limited liability company with a place of business at 2 Folsom Street, San Francisco, California 94105 (“Opposer”), believes that it will be damaged by the issuance of a registration for the trademark 19 V 69 ITALIA & Design applied for in Application Serial No. 86/438,962, filed on October 29, 2014 by Versace 19.69 Abbigliamento Sportivo S.R.L. (“Applicant”), and therefore opposes the same. As grounds for the opposition, Opposer alleges as follows:

1. Opposer is one of the world’s leading retailers of, among other things, clothing and accessories.
2. Opposer has used the mark 1969 (“1969 Mark”) in connection with the above goods, including in store locations throughout the United States dedicated to Opposer’s 1969 brand and on websites located at *www.gap.com* and *www.gap1969.com*.

3. Opposer is the owner of all right, title and interest in and to the 1969 Mark in connection with retail clothing based on first use in commerce as early as 1999. Opposer has also used the 1969 Mark in interstate commerce in connection with a line of fragrances prior to any date which may be relied upon by Applicant. Additionally, Opposer owns numerous U.S. trademark registrations for the 1969 Mark for a variety of goods and services, including the following:

- 1969, U.S. Reg. No. 2,449,575, registered May 8, 2001, based on first use in February 1999, for “clothing, namely, pants, jeans, shorts, khaki pants, sweatshirts, shirts, t-shirts, and jackets” in International Class 25;
- 1969, U.S. Reg. No. 3,873,549, registered November 9, 2010, based on first use in February 1999, for “Retail store services in the field of clothing” in International Class 35;
- 1969, U.S. Reg. No. 4,161,684, registered June 19, 2012, based on first use in February 1999, for “Retail store services in the field of clothing, accessories, footwear, and bags; online retail store services in the field of clothing, accessories, footwear, and bags” in International Class 35;
- 1969, U.S. Reg. No. 4,221,697, registered October 9, 2012, based on first use in November 2011, for “Magnetic coded gift cards” in International Class 9; and
- 1969, U.S. Reg. No. 4,481,405, registered February 11, 2014, based on first use in November 2013, for “Bags, namely, tote bags, handbags, and all-purpose carrying bags” in International Class 18.

4. The above-listed registrations are valid, subsisting and in full effect and serve as prima facie evidence of the validity of the mark and of Opposer’s exclusive right to use the mark

in connection with the goods and services identified therein, pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(a). Additionally, U.S. Registration No. 2,449,575 has become incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065.

5. Opposer is also the owner of U.S. Application Serial No. 85/948,003 for the mark 1969, filed on May 31, 2013 on an intent-to-use basis in connection with “Fragrances, Perfume, Cologne, Skin lotions, Aftershave, Liquid soap, Bath soaps in liquid, solid or gel form” in International Class 3.

6. Upon information and belief, Applicant is a limited liability company organized under the laws of Italy, located and doing business at Via Daniele Crespi, 1, Busto Arsizio (VA) I-21052, Italy.

7. On October 29, 2014, Applicant filed Application Serial No. 86/438,962 to register the mark 19 V 69 ITALIA & Design based on an alleged intent to use that mark in connection with “After shave lotions; After sun creams; After sun moisturisers [sic]; Aftershave; Age retardant lotion; Age spot reducing creams; Aloe vera gel for cosmetic purposes; Antibacterial skin soaps; Antiperspirant soap; Antiperspirants and deodorants for personal use; Anti-aging cleanser; Anti-aging cream; Anti-aging moisturizer; Anti-wrinkle cream; Argan oil for cosmetic purposes; Aromatic body care products, namely, body lotion, shower gel, cuticle cream, shampoo, conditioner, non-medicated lip balm, soap, body polish, body and foot scrub and non-medicated foot cream; Aromatic oils for the bath; Bath crystals; Bath foam; Bath gel; Bath lotion; Bath oils; Bath oils and bath salts; Bath oils for cosmetic purposes; Bath pearls; Bath soaps in liquid, solid or gel form; Beauty balm creams; Beauty lotions; Beauty masks; Beauty serums; Bergamot oil; Blush; Body and beauty care cosmetics; Body butter; Body creams; Body powder; Body scrub; Cleansing milk for cosmetic purposes; Cocoa butter for cosmetic purposes;

Cosmetic creams; Cosmetic hand creams; Cosmetic nourishing creams; Cosmetics and make-up; Cosmetics in general, including perfumes; Cosmetics, namely, compacts; Cosmetics, namely, lip primer; Creamy face powder; Creamy rouges; Cuticle conditioners; Eau de colognes; Eau de parfum; Eau de toilette; Exfoliant creams for skin; Eye cream; Eye liner; Eye make-up; Eye make-up remover; Eye shadow, Eyebrow colors; Eyebrow cosmetics; Eyebrow gel; Eyebrow pencils; Eyelash tint; Eyeliner; Eyeliner pencils; Facial concealer; False nails; Fingernail decals; Fingernail embellishments; Fingernail jewelry; Foundation make-up; Fragrances and perfumery; Gels for cosmetic purposes. Hair care kits comprising non-medicated hair care preparations, namely shampoo, conditioner, gel; Hair care products, namely, heat protection sprays; Hair conditioner; Hair curling preparations; Hair gel and Hair mousse; Hair spray; Hair styling spray; Handmade soap bars; Lipsticks; Liquid perfumes; Loose face powder; Mascara; Nail care kits comprising nail polish; Nail glitter; Nail varnish for cosmetic purposes; Night cream; Perfumes and colognes; Pre-moistened cosmetic towelettes; Self-tanning preparations; Shampoo-conditioners; SPF sun block sprays; Foundation, Powder, Concealer; Lip Gloss; Face cream, Lotions for skin, Eye cream, Facial Washes, Facial Cleansers, Facial Masks, Hand Lotions; Hand Cream, Nail polish, Nail Cream, Cuticle Oils, Shampoo, Conditioner, Hair care preparations and Hair relaxers” in International Class 3 (the “Application”).

8. Upon information and belief, prior to any date on which Applicant can rely, Applicant was on actual notice of Opposer’s prior rights in and to the 1969 Mark.

9. The filing date of Applicant’s application, October 29, 2014, which is the earliest date upon which Applicant can rely, is more than a decade after the acquisition of rights in the 1969 Mark by Opposer or its predecessors in interest. As such, Opposer’s rights in the 1969 Mark are prior and superior to any rights Applicant may claim in Applicant’s Mark. The

registration of Applicant's Mark is inconsistent with Opposer's prior rights and statutory grant of exclusivity of use.

10. Applicant's 19 V 69 ITALIA & Design mark is confusingly similar to Opposer's prior used and registered 1969 Mark. The marks of the parties are confusingly similar in sight, sound, and commercial impression. Applicant's use and registration of the 19 V 69 ITALIA & Design mark in connection with the goods identified in its application is therefore likely to cause confusion, cause mistake or to deceive consumers to falsely believe that Applicant's goods emanate from or otherwise are authorized, sponsored by, or affiliated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. Moreover, Opposer's 1969 Mark is a famous mark for clothing and retail store goods and services. Applicant's use and registration of the mark 19 V 69 ITALIA & Design will damage Opposer by trading on the enormous goodwill associated with the 1969 Mark and diluting its distinctiveness. Thus, Applicant's use and registration of 19 V 69 ITALIA & Design in connection with the goods identified in its application is likely to cause dilution of Opposer's famous 1969 Mark, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

12. By reason of the foregoing, Opposer will be harmed by registration of Applicant's 19 V 69 ITALIA & Design mark.

/

/

(INTENTIONALLY LEFT BLANK)

/

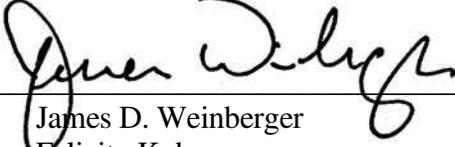
/

/

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 86/438,962 be denied.

Dated: March 9, 2016
New York, New York

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
James D. Weinberger
Felicity Kohn

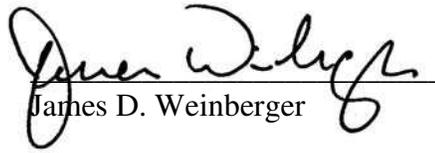
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

Attorneys for Opposer Gap (Apparel), LLC

CERTIFICATE OF SERVICE

I hereby certify that on March 9, 2016, a copy of the foregoing **NOTICE OF OPPOSITION** was sent by first-class mail postage pre-paid to Applicant's counsel:

J. MICHAEL KEYES
DORSEY & WHITNEY LLP
COLUMBIA CENTER
701 FIFTH AVENUE, SUITE 6100
SEATTLE, WASHINGTON 98104


James D. Weinberger