

ESTTA Tracking number: **ESTTA742341**

Filing date: **04/26/2016**

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 | Icon DE Holdings LLC |
| Granted to Date of previous extension | 05/11/2016 |
| Address | 103 Foulk Road Wilmington, DE 19803 UNITED STATES |
| Attorney information | Theodore R. Remaklus Wood, Herron & Evans, L.L.P. 441 Vine Street 2700 Carew Tower Cincinnati, OH 45202 UNITED STATES tremaklus@whe-law.com Phone:5132412324 |

Applicant Information

| | | | |
|--------------------------------|---|---------------------------------|------------|
| Application No | 86726110 | Publication date | 01/12/2016 |
| Opposition Filing Date | 04/26/2016 | Opposition Period Ends | 05/11/2016 |
| International Registration No. | NONE | International Registration Date | NONE |
| Applicant | Cherrykat Limited 59 Chesterton Road London, E138BD UNITED KINGDOM | | |

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: Cosmetic preparations for the hair and scalp; Cosmetics; Essential oils; Hair conditioners; Hair creams; Hair gel; Hairlotions; Hair oils; Hair rinses; Perfumery; Shampoos; Hair moisturizers |
|---|

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
| Deceptiveness | Trademark Act Section 2(a) |

Marks Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|------------|------------------|------------|
| U.S. Registration No. | 1157373 | Application Date | 01/11/1978 |
| Registration Date | 06/09/1981 | Foreign Priority | NONE |

| | | | |
|---------------------|---|------|--|
| | | Date | |
| Word Mark | CANDIE'S | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1977/11/15 First Use In Commerce: 1977/11/15 CLOTHING-NAMELY, BOOTS, SHOES, AND SLIPPERS | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1154885 | Application Date | 03/07/1979 |
| Registration Date | 05/19/1981 | Foreign Priority Date | NONE |

| | | | |
|---------------------|---|--|--|
| Word Mark | CANDIE'S | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 018. First use: First Use: 1978/12/11 First Use In Commerce: 1978/12/11 Handbags Class 025. First use: First Use: 1979/02/23 First Use In Commerce: 1979/02/23 Jeans | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1199658 | Application Date | 04/21/1981 |
| Registration Date | 06/29/1982 | Foreign Priority Date | NONE |

| | | | |
|---------------------|--|--|--|
| Word Mark | CANDIE'S | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1979/03/01 First Use In Commerce: 1979/03/15 Belts, Shirts, Sweat Shirts, T-Shirts, Tops [and Sun Visors] | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1206758 | Application Date | 04/27/1979 |
| Registration Date | 08/31/1982 | Foreign Priority Date | NONE |

| | | | |
|-----------|----------|--|--|
| Word Mark | CANDIE'S | | |
|-----------|----------|--|--|

| | | | |
|---------------------|---|--|--|
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1977/11/00 First Use In Commerce: 1977/11/00 Shoes | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1240430 | Application Date | 11/02/1981 |
| Registration Date | 05/31/1983 | Foreign Priority Date | NONE |

| | | | |
|---------------------|--|--|--|
| Word Mark | CANDIE'S | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1981/09/24 First Use In Commerce: 1981/09/24 Swimsuits, Sweatsuits[, Panty Hose], Stretch Bikini Pants and Brassieres [and Socks] | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1255032 | Application Date | 11/02/1981 |
| Registration Date | 10/25/1983 | Foreign Priority Date | NONE |
| Word Mark | CANDIE'S | | |

| | |
|---------------------|--|
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 003. First use: First Use: 1981/09/24 First Use In Commerce: 1981/09/24 [Suntan Oil,] Nail Polish, Cologne, Perfume and Toilet Water |

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1291227 | Application Date | 04/25/1983 |
| Registration Date | 08/21/1984 | Foreign Priority Date | NONE |
| Word Mark | CANDIE'S | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1982/05/13 First Use In Commerce: 1982/05/13 Womens' and Childrens' Articles of Clothing, Underwear, [Sleepwear] and Outerwear-Namely, Tank Tops, Dresses, Skirts, Jumpsuits, [Culottes, Sweatsuits; Socks, Pantyhose, Hosiery;] Swimsuits; Panties, Stretch Bikini Pants, Brassieres, Camisoles; [Nightgowns, Robes, Pajamas;] Overcoats, Jackets, Raincoats, Rain Jackets and Wind Resistant Jackets | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1378107 | Application Date | 06/04/1985 |
| Registration Date | 01/14/1986 | Foreign Priority Date | NONE |
| Word Mark | CANDIE'S | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 018. First use: First Use: 1983/04/28 First Use In Commerce: 1983/04/28 PURSES, [WALLETS,] CLUTCHES, HANDBAGS, COSMETIC CASES SOLD EMPTY, [BRIEFCASE-TYPE PORTFOLIOS,] TOTE BAGS, DUFFEL BAGS,[SOFT-SIDED LUGGAGE, LUGGAGE TAGS AND STRAPS,] SATCHELS, BACKPACKS, KNAPSACKS,[KEY CASES,] BILLFOLDS, COIN PURSES, [CREDIT CARD WALLETS,] AND UMBRELLAS, ALL FOR MEN, WOMEN, AND CHILDREN | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2754867 | Application Date | 06/08/2000 |
| Registration Date | 08/26/2003 | Foreign Priority Date | NONE |

| | |
|---------------------|---|
| Word Mark | CANDIE'S |
| Design Mark | CANDIE'S |
| Description of Mark | NONE |
| Goods/Services | Class 035. First use: First Use: 1996/09/00 First Use In Commerce: 1996/09/00 retail store services featuring footwear, wearing apparel;[luggage,] hand-bags,small leather goods[, business cases]; eyewear; jewelry and[watches;] belts, scarves and neckwear; fragrances; accessories |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2993562 | Application Date | 11/06/2000 |
| Registration Date | 09/13/2005 | Foreign Priority Date | NONE |
| Word Mark | CANDIE'S | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 2000/09/01 First Use In Commerce: 2000/09/01 optical goods, namely, eyeglass frames [, eyeglass lenses] and eyeglass cases | | |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3256932 | Application Date | 12/16/2004 |
| Registration Date | 06/26/2007 | Foreign Priority Date | NONE |
| Word Mark | CANDIE'S | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| Design Mark | <h1>CANDIE'S</h1> | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 003. First use: First Use: 2006/06/30 First Use In Commerce: 2006/06/30 [NON-MEDICATED SKIN CARE PREPARATIONS; HAIR CARE PREPARATIONS;] BODY CARE PRODUCTS, NAMELY, [BODY SOAPS, BODY CREAMS,]BODY LOTIONS, [BODY POWDERS, NON-MEDICATED DEODORANTS AND ANTI-PERSPIRANTS; NON-MEDICATED SUNCARE PRODUCTS, NAMELY, SUNSCREEN, SUN BLOCK AND SUN TANNING PREPARATIONS; PREPARATIONS TO PROTECT THE SKINFROM THE SUN, NAMELY, SUN CREAMS AND AFTER-SUN LOTIONS;] BATH PRODUCTS, NAMELY, [BATH BEADS, BATH FOAM,] BATH GELS, BATH LOTION, [BATH OIL, BATH POWDER, AND NON-MEDICATED BATH SALTS;] PERFUME, COLOGNE, COSMETICS AND MAKEUP | | |
| U.S. Registration No. | 3256934 | Application Date | 12/16/2004 |
| Registration Date | 06/26/2007 | Foreign Priority Date | NONE |
| Word Mark | CANDIE'S | | |

| | |
|---------------------|--|
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 2005/06/30 First Use In Commerce: 2005/06/30 SCARVES [, MUFFLERS, MITTENS, EARMUFFS,GLOVES, HATS, HEAD-WEAR] |

| | |
|-------------|--|
| Attachments | 73206403#TMSN.png(bytes) 73213391#TMSN.png(bytes) 73335242#TMSN.png(bytes) 73335241#TMSN.png(bytes) 76067132#TMSN.png(bytes) 76159600#TMSN.png(bytes) 78533734#TMSN.png(bytes) 78533843#TMSN.png(bytes) Notice of opposition.pdf(38090 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 | /theodore r remaklus/ |
| Name | Theodore R. Remaklus |
| Date | 04/26/2016 |

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

| | |
|-------------------------|-----------------------------|
| _____) | |
| Icon DE Holdings LLC,) | Opposition No. _____ |
|) | |
| Opposer,) | |
|) | Application No. 86/726,110 |
| v.) | Published: January 12, 2016 |
|) | |
| Cherrykat Limited,) | |
|) | |
| Applicant.) | |
| _____) | |

NOTICE OF OPPOSITION

Opposer, Icon DE Holdings LLC, a Delaware limited liability company, having a place of business at 103 Foulk Road, Wilmington, Delaware 19803 ("Opposer"), believes that it will be damaged by registration of the trademark CURL CANDIES of Application No. 86/726,110 for "Cosmetic preparations for the hair and scalp; Cosmetics; Essential oils; Hair conditioners; Hair creams; Hair gel; Hair lotions; Hair oils; Hair rinses; Perfumery; Shampoos; Hair moisturizers" in International Class 3, and hereby opposes the same.

GROUND'S FOR OPPOSITION

As grounds for this opposition, Opposer alleges as follows:

1. Opposer is the owner of the CANDIE'S brand, which was created in 1977, and became famous internationally for the CANDIE'S slide, millions of which were sold by the mid 1980s. The CANDIE'S brand is now a lifestyle brand targeted to young women, often used in the stylized version and color shown to the right. Opposer is the owner of the following family of United States trademark registrations for its CANDIE'S mark:



- CANDIE'S U.S. Registration No. 1157373 in Class 25, filed January 11, 1978, registered on June 9, 1981, and claiming a first use date of November 15, 1977
- Class 25 – Clothing, namely, boots, shoes, and slippers
- Candie's* U.S. Registration No. 1154885 in Classes 18 and 25, filed March 7, 1979, registered on May 19, 1981, and claiming a first use date of December 11, 1978 in Class 18 and February 23, 1979 in Class 25
- Class 18 – Handbags
- Class 25 - Jeans
- CANDIE'S U.S. Registration No. 1199658 in Class 25, filed April 21, 1981, registered on June 29, 1982 and claiming a first use date of March 15, 1979
- Class 25 - Belts, Shirts, Sweat Shirts, T-Shirts, Tops
- Candie's* U.S. Registration No. 1206758 in Class 25, filed April 27, 1979, registered on August 31, 1982, and claiming a first use date of November 1977
- Class 25 – Shoes
- Candie's* U.S. Registration No. 1240430 in Class 25, filed November 2, 1981, registered on May 31, 1983, and claiming a first use date of September 24, 1981
- Class 25 - Swimsuits, Sweatsuits, Stretch Bikini Pants and Brassieres
- Candie's* U.S. Registration No. 1255032 in Class 3, filed November 2, 1981, registered on October 25, 1983, and claiming a September 24, 1981 first use date
- Class 3 - Nail Polish, Cologne, Perfume and Toilet Water
- CANDIE'S U.S. Registration No. 1291227 in Class 25, filed April 25, 1983, registered on August 21, 1984, and claiming a first use date of May 13, 1982
- Class 25 - Womens' and Childrens' Articles of Clothing, Underwear, and Outerwear-Namely, Tank Tops, Dresses, Skirts, Jumpsuits; Swimsuits; Panties, Stretch Bikini Pants, Brassieres, Camisoles; Overcoats, Jackets, Raincoats, Rain Jackets and Wind Resistant Jackets
- CANDIE'S U.S. Registration No. 1378107 in Class 18, filed June 4, 1985, registered on January 14, 1986, and claiming a first use date of April 28, 1983

- Class 18 - Purses, clutches, handbags, cosmetic cases sold empty, tote bags, duffel bags, satchels, backpacks, knapsacks, billfolds, coin purses, and umbrellas, all for men, women, and children
- CANDIE'S U.S. Registration No. 2754867 in Class 35, filed June 8, 2000, registered on August 26, 2003, and claiming a first use date of September, 1996
- Class 35 - Retail store services featuring footwear, wearing apparel; handbags, small leather goods; eyewear; jewelry; belts, scarves and neckwear; fragrances; accessories
-  U.S. Registration No. 2993562 in Class 9, filed November 6, 2000, registered on September 13, 2005, and claiming a first use date of September 1, 2000
- Class 9 - Optical goods, namely, eyeglass frames and eyeglass cases
- CANDIE'S U.S. Registration No. 3256932 in Class 3, filed December 16, 2004, registered on June 26, 2007, and claiming a first use date of June 30, 2006
- Class 3 - Body care products, namely, body lotions; bath products, namely, bath gels, bath lotion; perfume, cologne, cosmetics and makeup
- CANDIE'S U.S. Registration No. 3256934 in Class 25, filed December 16, 2004, registered on June 26, 2007, and claiming a first use date of June 30, 2006
- Class 25 - scarves

The above registrations are all valid and subsisting, and are referred to collectively herein as the "CANDIE'S Marks".

2. Opposer's CANDIE'S Marks have been the subject of substantial marketing and advertising in the United States in connection with the goods of Opposer; and Opposer, its predecessors and licensees have spent millions of dollars in promoting the goods under the CANDIE'S Marks. Opposer, its predecessors and licensees, have sold tens of millions of dollars of CANDIE'S branded products. As a result of the long and continuous use and promotion of the

CANDIE'S Marks, those marks have come to be associated exclusively with Opposer, as identifying goods and services emanating from Opposer.

3. On information and belief, Applicant Cherrykat Limited is a United Kingdom limited company with an address of 59 Chesterton Road, London, United Kingdom E13 8BD (hereinafter "Applicant").

4. On information and belief, Applicant filed on August 15, 2015, Application No. 86/726,110 under Section 44(e) of the Lanham Act, 15 U.S.C. § 1126(e), based on a prior United Kingdom trademark registration (hereinafter "the '110 Application"). The '110 Application is for the mark CURL CANDIES for use with "Cosmetic preparations for the hair and scalp; Cosmetics; Essential oils; Hair conditioners; Hair creams; Hair gel; Hair lotions; Hair oils; Hair rinses; Perfumery; Shampoos; Hair moisturizers" in International Class 3.

5. The '110 Application was published for opposition on January 12, 2016. Opposer timely filed on February 12, 2016 for, and obtained, a 30-day extension of time to oppose the '110 Application through and including March 12, 2016; and it timely filed on March 7, 2016 for, and obtained, a further 60-day extension of time to oppose the '110 Application through and including May 11, 2016.

6. Applicant's filing date is subsequent to Opposer's filing dates, first use dates and registration dates for the CANDIE'S Marks.

7. The CURL CANDIES mark incorporates the CANDIES term which is identical to the CANDIES Marks, and simply adds the non-distinctive term "CURL" to that mark. In fact, Applicant disclaimed the term "CURL" as being descriptive of the goods. Thus, the term "CANDIES" is the dominant and only distinctive term in Applicant's CURL CANDIES mark.

8. Likewise, the goods in International Class 3 of the '110 Application with which the CURL CANDIES mark are allegedly intended to be used, are identical and/or highly related to the goods with which the CANDIES Marks are used and have been registered.

9. As a result of the similarity of the marks and goods, the use by Applicant of the CURL CANDIES mark would be likely to cause confusion among consumers of those goods.

10. The CURL CANDIES mark is likely to cause confusion or to cause mistake or to deceive consumers by creating the false impression that Applicant's goods originate with or are from the same source as Opposer's goods and services, or are endorsed by, sponsored by, or otherwise connected or affiliated in some way with Opposer and its CANDIE'S Marks.

11. Under Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b), if a certificate of registration were to issue to Applicant it would be *prima facie* evidence of, among other things, its right to use the mark in commerce on the goods recited in the application, and such use would be likely to cause confusion, or to cause mistake, or to deceive purchasers by reason of the similarity thereof to Opposer's CANDIE'S Marks.

WHEREFORE, Icon DE Holdings LLC believes that it will be damaged by registration of the CURL CANDIES trademark, and prays that the '110 Application be refused and registration denied.

The fee required under 37 C.F.R. § 2.6(a)(17) is being submitted herewith. The Commissioner is authorized to charge Deposit Account No. 23-3000 for any deficiencies in the filing fee and any and all other fees associated with filing the Notice of Opposition.

Respectfully submitted,

Icon DE Holding LLC

Date: April 26, 2016

By: /s/ Theodore R. Remaklus/
Theodore R. Remaklus
tremaklus@whe-law.com
WOOD, HERRON & EVANS, L.L.P.
2700 Carew Tower
441 Vine Street
Cincinnati, Ohio 45202-2917
(513) 241-2324
(513) 241-6234 (Facsimile)

Attorneys for Opposer
IP Holdings LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Notice of Opposition** has been served by first class mail, postage prepaid, upon Applicant at the following address on this 26th day of April, 2016.

Cherrykat Limited
59 Chesterton Road
London, United Kingdom E13 8BD

/s/ Theodore R. Remaklus
Theodore R. Remaklus

Attorney for Opposer
IP Holdings LLC