

ESTTA Tracking number: **ESTTA746587**

Filing date: **05/16/2016**

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	French Connection Limited
Granted to Date of previous extension	05/15/2016
Address	20-22 Bedford Row London, WC1R4JS UNITED KINGDOM
Attorney information	Lisa W. Rosaya, Lindsey Utrata Baker & McKenzie LLP 452 Fifth Avenue New York, NY 10018 UNITED STATES lisa.rosaya@bakermckenzie.com, lindsey.utrata@bakermckenzie.com, nyc-trademarks@bakermckenzie.com Phone:212.626.4557

Applicant Information

Application No	86149788	Publication date	11/17/2015
Opposition Filing Date	05/16/2016	Opposition Period Ends	05/15/2016
Applicant	Fresh Connection Brand, LLC 7548 S. Emerald Ave. Chicago, IL 60620 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2011/03/15 First Use In Commerce: 2012/01/23 All goods and services in the class are opposed, namely: Baseball caps and hats; Button down shirts; Collared shirts; Hats; Hooded sweatshirts; Hooded sweatshirts; Long-sleeved shirts; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleevedt-shirts; Short-sleeved shirts; Shorts;Sweatshirts; T-shirts; Tank tops; Tank-tops

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1310145	Application Date	01/24/1983
Registration Date	12/18/1984	Foreign Priority Date	NONE
Word Mark	FRENCH CONNECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1973/05/01 First Use In Commerce: 1973/05/01 Women's and Girls' Wearing Apparel-Namely, Dresses, Skirts, Sweaters, Blouses, Suits, Pants, Jackets, Jeans, Hats, Scarves, Gloves, Shoes, Belts, Shorts, Jumpsuits, T-Shirts		

U.S. Registration No.	1527886	Application Date	10/28/1987
Registration Date	03/07/1989	Foreign Priority Date	NONE
Word Mark	FRENCH CONNECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1978/10/00 First Use In Commerce: 1979/04/00 SUNGLASSES Class 018. First use: First Use: 1978/10/00 First Use In Commerce: 1979/04/00 LUGGAGE Class 025. First use: First Use: 1978/10/00 First Use In Commerce: 1979/04/00 CLOTHING, NAMELY, SHIRTS, JACKETS, JEANS, TROUSERS, SHORTS, SWEATERS, SWEATSHIRTS, T-SHIRTS, COATS, TIES, SOCKS, SHOES,HATS AND BELTS		

U.S. Registration No.	4167155	Application Date	10/21/2011
Registration Date	07/03/2012	Foreign Priority Date	NONE
Word Mark	FRENCH CONNECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1983/08/01 First Use In Commerce: 1983/08/01		

	Retail stores featuring clothing and footwear, eyewear, jewelry and watches, leather goods, and bath and beauty products; catalog mail order services featuring clothing and footwear, jewelry, belts and bags; and online retail stores featuring clothing and footwear, eyewear, jewelry and watches, leather goods, and bath and beauty products
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U.S. Registration No.	4094254	Application Date	04/22/2010
Registration Date	01/31/2012	Foreign Priority Date	NONE
Word Mark	UK STYLE BY FRENCH CONNECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 2011/04/25 First Use In Commerce: 2011/04/25 Articles made wholly or principally of imitation leather, namely, handbags, belts</p> <p>Class 025. First use: First Use: 2011/02/01 First Use In Commerce: 2011/02/01 Articles of clothing, namely, jackets, trousers, rainwear, shorts, shirts, dresses, blouses, parkas, sweaters, waistcoats, skirts, headwear, gloves, footwear, T-shirts, sweatshirts, scarves, shawls, swimwear, jeans and tuxedos</p>		

U.S. Registration No.	3081564	Application Date	04/18/2003
Registration Date	04/18/2006	Foreign Priority Date	03/17/2003
Word Mark	FRENCH CONNECTION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 014. First use: First Use: 0 First Use In Commerce: 0 Clocks, watches, watch straps and cases; articles made of precious metal or coated therewith, namely, necklaces, bracelets, [broaches,] earrings, [cuff links, tie pins, nose rings;] jewelry</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0 [Toys, games and playthings, namely, board games, card games, bean bags; gymnastic and sporting articles, namely, soccer balls, volleyballs, rugby balls, batting gloves, baseball gloves, softball gloves, golf bags, head covers for golf clubs; surfboards, bags adapted to carry surfboards, surfboards with sails]</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Retail department store services featuring a wide variety of consumer goods of others; retail store services featuring a wide variety of consumer goods of others; retail home furnishing store; catalogue mail order services and on-line retail services all featuring a wide variety of consumer goods of others</p>		

Attachments	85452975#TMSN.png(bytes) 85020240#TMSN.png(bytes) Notice of Opposition_Fresh Connection_App. No. 86149788.pdf(555687 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	/LEU/
Name	Lindsey Utrata
Date	05/16/2016

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

French Connection Limited)	Opposition No.: _____
)	
Opposer,)	Serial No.: 86149788
)	
v.)	Mark: Fresh Connection
)	
Fresh Connection Brands, LLC,)	
)	
Applicant.)	
)	
)	

NOTICE OF OPPOSITION

French Connection Limited, a limited company incorporated under the laws of the United Kingdom, whose business address is 20-22 Bedford Row, London, United Kingdom WC1R4JS (hereinafter "Opposer") believes it is and will be damaged and injured by the registration of the mark **Fresh Connection** for "[b]aseball caps and hats; button down shirts; collared shirts; hats; hooded sweat shirts; hooded sweatshirts; long-sleeved shirts; shirts; shirts and short-sleeved shirts; short-sleeved or long-sleeved t-shirts; short-sleeved shirts; shorts; sweatshirts; t-shirts; tank tops; tank-tops" in International Class 25 ("Applicant's Goods"), as shown in Application Serial No. 86149788 (hereinafter the "Application") filed on December 20, 2013 by Fresh Connection Brand, LLC (hereinafter "Applicant"), and published for opposition on November 17, 2015 in the *Official Gazette for Trademarks*. Opposer hereby opposes registration of the Application.

Opposer alleges, solely for the purpose of this proceeding, as grounds for opposition, the following:

1. Opposer is the owner of the following U.S. registrations for **FRENCH CONNECTION** and marks containing the wording **FRENCH CONNECTION** (the **FRENCH**

CONNECTION Marks") which cover goods and services that are identical or highly related to the goods covered in Applicant's Application, namely:

Reg. No.	Mark	Goods/Services
1310145	FRENCH CONNECTION	Class 25: Women's and girls' wearing apparel-namely, dresses, skirts, sweaters, blouses, suits, pants, jackets, jeans, hats, scarves, gloves, shoes, belts, shorts, jumpsuits, t-shirts
1527886	FRENCH CONNECTION	Class 9: Sunglasses; Class 18: Luggage; Class 25: Clothing, namely, shirts, jackets, jeans, trousers, shorts, sweaters, sweatshirts, t-shirts, coats, ties, socks, shoes, hats and belts
4167155	FRENCH CONNECTION	Class 35: Retail stores featuring clothing and footwear, eyewear, jewelry and watches, leather goods, and bath and beauty products; catalog mail order services featuring clothing and footwear, jewelry, belts and bags; and online retail stores featuring clothing and footwear, eyewear, jewelry and watches, leather goods, and bath and beauty products
4094254	UK STYLE BY FRENCH CONNECTION	Class 18: Articles made wholly or principally of imitation leather, namely, handbags, belts; Class 25: Articles of clothing, namely, jackets, trousers, rainwear, shorts, shirts, dresses, blouses, parkas, sweaters, waistcoats, skirts, headwear, gloves, footwear, T-shirts, sweatshirts, scarves, shawls, swimwear, jeans and tuxedos
3081564	FRENCH CONNECTION	Class 14: Clocks, watches, watch straps and cases; articles made of precious metal or coated therewith, namely, necklaces, bracelets, [broaches,] earrings, [cuff links, tie pins, nose rings,] jewelry; Class 35: Retail department store services featuring a wide variety of consumer goods of others; retail store services featuring a wide variety of consumer goods of others;

		retail home furnishing store; catalogue mail order services and on-line retail services all featuring a wide variety of consumer goods of others
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2. Since at least as early as 1973, Opposer has provided and sold certain of Opposer's Goods and Services, including clothing articles and retail services related to such goods, in the U.S., and thus has used its **FRENCH CONNECTION** Marks in U.S. interstate commerce or commerce that may be lawfully regulated by the U.S. Congress.

3. Applicant's Application, which is based on Applicant's alleged current use the applied-for mark in U.S. commerce, purportedly since March 15, 2011, seeks registration of the mark **Fresh Connection** for "*[b]aseball caps and hats; button down shirts; collared shirts; hats; hooded sweat shirts; hooded sweatshirts; long-sleeved shirts; shirts; shirts and short-sleeved shirts; short-sleeved or long-sleeved t-shirts; short-sleeved shirts; shorts; sweatshirts; t-shirts; tank tops; tank-tops*" in International Class 25.

4. Opposer's use of its **FRENCH CONNECTION** Marks as set forth in Paragraphs 1 and 2 is earlier than any date upon which Applicant can rely in relation to its Application. Thus, Opposer's rights in its **FRENCH CONNECTION** Marks are senior to any purported rights of Applicant in the purported **Fresh Connection** mark.

5. As a result of Opposer's advertising and promotional efforts, as well as its prominent and continuous use of its **FRENCH CONNECTION** Marks, Opposer's **FRENCH CONNECTION** Marks has become widely recognized by Opposer's customers and the purchasing public as being associated with Opposer's high quality goods and related services and has become synonymous with the goodwill and reputation of Opposer. By virtue of the

forgoing, Opposer's **FRENCH CONNECTION** Marks has become and is famous and is therefore entitled to a high degree and wide zone of protection.

6. Opposer's **FRENCH CONNECTION** Marks became famous well prior to December 20, 2013, the filing date of Applicant's Application, and March 15, 2011, Applicant's claimed first date of use of its applied-for mark.

7. Applicant's alleged **Fresh Connection** mark, which is the subject of the opposed Application, possesses visual and phonetic similarities of Opposer's registered **FRENCH CONNECTION** Marks, in fact there is only one letter difference between the marks, and thus is confusingly similar in appearance and commercial impression to Opposer's **FRENCH CONNECTION** Marks.

8. Applicant's Goods which are to be sold under the **Fresh Connection** mark are highly related to Opposer's Goods and Services which are sold under the **FRENCH CONNECTION** Marks.

9. Upon information and belief, Opposer's Goods and Services and Applicant's Goods are likely to be offered, promoted and sold to the same class of purchasers.

10. Upon information and belief, Opposer's Goods and Services and Applicant's Goods are likely to be offered, promoted or sold in the same channels of trade.

11. Due to the confusingly similar nature of Applicant's alleged **Fresh Connection** mark and of Opposer's registered **FRENCH CONNECTION** Marks and the relatedness of the parties' respective goods and services, Applicant's alleged **Fresh Connection** mark falsely suggests a connection with Opposer, *e.g.*, that Opposer sponsors, approves or endorses Applicant's Goods, that Applicant is authorized, licensed or controlled by Opposer, or that

Applicant is a division or subsidiary of, or in some way related to Opposer, which is not the case. Accordingly, Applicant's alleged mark "[c]onsists of ... matter which may disparage or falsely suggest a connection with [Opposer] ... or bring it into contempt, or disrepute." 15 U.S.C. § 1052 (a).

12. Due to the confusingly similar nature of the respective parties' marks and the goods and services at issue, Opposer believes and alleges that Applicant's alleged mark, when applied to the Applicant's Goods, is likely to cause confusion or mistake or to deceive, and will deceive and mislead the purchasing public into believing that Opposer is the source of Applicant's Goods. Accordingly, Applicant's alleged mark "so resembles a mark ... previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d).

13. Due to the confusingly similar nature of Applicant's alleged **Fresh Connection** mark and Opposer's registered **FRENCH CONNECTION** Marks and the relatedness of the parties' respective goods and services, it is clear that the similarity between Applicant's alleged mark and Opposer's famous **FRENCH CONNECTION** Marks will create an association with Opposer's famous **FRENCH CONNECTION** Marks "that impairs the distinctiveness of ... [Opposer's] famous mark" 15 U.S.C. § 1125 (c)(2)(B). Accordingly, Applicant's alleged mark will lead to dilution by blurring with respect to Opposer's mark.

14. Due to the confusingly similar nature of Applicant's alleged **Fresh Connection** mark and Opposer's registered **FRENCH CONNECTION** Marks and the relatedness of the parties' respective goods and services, it is clear that the similarity between Applicant's alleged mark and Opposer's famous **FRENCH CONNECTION** Marks will "harm the reputation of ...

[Opposer's] famous mark. 15 U.S.C. § 1125 (c)(2)(C). Accordingly, Applicant's alleged mark will lead to dilution by tarnishment with respect to Opposer's mark.

15. If Applicant is permitted to register its alleged mark captioned above in connection with Applicant's Goods, a likelihood of consumer confusion and dilution of Opposer's **FRENCH CONNECTION** Marks resulting in damage and injury to Opposer would be caused and would result by reason of the identical nature of Applicant's alleged mark and Opposer's **FRENCH CONNECTION** Marks. Furthermore, any misrepresentation, objection or fault found with Applicant's Goods promoted or sold under its alleged mark would necessarily reflect on and seriously injure the reputation that Opposer has established through use of the **FRENCH CONNECTION** Marks.

16. If Applicant is granted registration of its alleged **Fresh Connection** mark, it would thereby obtain at least a *prima facie* exclusive right to use its alleged mark. This would be a source of further damage and injury to Opposer.

17. For the reasons set forth in the foregoing paragraphs, Applicant is not entitled to register its alleged **Fresh Connection** mark and the Application should be refused registration in accordance with Sections 2(a), 2(d) and 43(c) of the Lanham Act.

WHEREFORE, Opposer prays that Application Serial No. 86149788 be rejected, that registration of Applicant's alleged mark shown therein be refused and that this Opposition be sustained in favor of Opposer.

Opposer hereby gives notice under Rule 2.122(d) of the Trademark Rules of Practice that at hearing and in any appeal on this opposition proceeding, it will rely on Opposer's United States registrations as referenced above as evidence in support of this Notice of Opposition.

Respectfully submitted,

By:



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Date: May 16, 2016

Attorneys for Opposer

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing **NOTICE OF OPPOSITION** was served via First Class mail on Attorney for Applicant, Esther Barron, Esq., Northwestern University School of Law, 375 E. Chicago Avenue, Chicago, Illinois 60611-3059 on this 16th day of May, 2016.



Sonia Allahdad