

ESTTA Tracking number: **ESTTA739508**

Filing date: **04/12/2016**

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	Grey Global Group LLC
Granted to Date of previous extension	04/17/2016
Address	200 Fifth Avenue New York, NY 10010-3372 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, lapolzon@fzlj.com Phone:(212) 813-5900

Applicant Information

Application No	79157494	Publication date	10/20/2015
Opposition Filing Date	04/12/2016	Opposition Period Ends	04/17/2016
International Registration No.	1228917	International Registration Date	03/07/2014
Applicant	Markus John Schlossberg 3 79639 Grenzach-Wyhlen, GERMANY		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 Opposed goods and services in the class: Advertising; business management and administration; providing office functions; organization and conducting of exhibitions and trade fairs for commercial or advertising purposes; compilation and systematization of data into computer databases; dissemination of business prospectuses; distribution and dissemination of advertising matter
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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.	2469398	Application Date	03/20/2000
Registration Date	07/17/2001	Foreign Priority	NONE

		Date	
Word Mark	GREY		
Design Mark	GREY		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1917/00/00 First Use In Commerce: 1917/00/00 house mark of an advertising and marketing communications agency		

U.S. Registration No.	1913691	Application Date	12/16/1993
Registration Date	08/22/1995	Foreign Priority Date	NONE
Word Mark	GREY		
Design Mark	GREY		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1917/00/00 First Use In Commerce: 1917/00/00 advertising agency services		

U.S. Registration No.	2548233	Application Date	03/10/2000
Registration Date	03/12/2002	Foreign Priority Date	NONE
Word Mark	GREY GLOBAL GROUP		

Design Mark	GREY GLOBAL GROUP		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2000/04/00 First Use In Commerce: 2000/04/00 advertising agency services and marketing communications consulting services		

U.S. Registration No.	4095737	Application Date	05/04/2011
Registration Date	02/07/2012	Foreign Priority Date	NONE
Word Mark	GREYGROUP		
Design Mark	GREY group		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2006/00/00 First Use In Commerce: 2006/00/00 Advertising, marketing, and public relations services		

U.S. Registration No.	4145602	Application Date	07/18/2011
Registration Date	05/22/2012	Foreign Priority Date	NONE
Word Mark	GREY ALLIANCE		
Design Mark	GREY ALLIANCE		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 Advertising, marketing, promotional, and publicity services; advertising, market-		

	ing, promotional, and publicity services for the benefit of entertainment and sports-oriented properties; public relations; event planning and management for marketing, branding, promoting or advertising the goods and services of others; promoting the goods and services of others by arranging for businesses to affiliate their goods and services with the goods and services of third parties by means of sponsorship relationships and product placement
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U.S. Registration No.	4353094	Application Date	09/12/2012
Registration Date	06/18/2013	Foreign Priority Date	NONE
Word Mark	GREYWORKS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2009/04/00 First Use In Commerce: 2012/03/00 Advertising services; production of advertising materials, advertising matter and commercials		

Attachments	76004034#TMSN.png(bytes) 74470228#TMSN.png(bytes) 75941681#TMSN.png(bytes) 85312585#TMSN.png(bytes) 85374302#TMSN.png(bytes) 85726967#TMSN.png(bytes) Notice of Opposition (COLORS GRAYS) (F1922324x96B9E).pdf(30672 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	/s/ James D. Weinberger
Name	James D. Weinberger
Date	04/12/2016

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

GREY GLOBAL GROUP INC.,

Opposer,

v.

JOHN MARKUS,

Applicant.

NOTICE OF OPPOSITION

Opposer, Grey Global Group Inc., a Delaware corporation with an address at 200 Fifth Avenue, New York, New York 10010-3372, believes that it will be damaged by registration of the mark COLORS GRAYS (and design), App. Ser. No. 79/157,494, published in the Official Gazette on October 20, 2015, and hereby opposes same. As grounds for the opposition, Opposer alleges as follows:

1. Opposer is the owner of the trademarks GREY, GREY GLOBAL GROUP, GREYgroup, GREY ALLIANCE, GREYWORKS (collectively, the “GREY Marks”), which it has used in connection with advertising and marketing services and related services, and of all common law rights and associated goodwill in those trademarks. Opposer has continuously used those marks in commerce for those services since at least as early as 1917, April 2000, 2006, September 1, 1996 and March 2012, respectively.
2. The GREY Marks constitute a family of marks.
3. Opposer has invested a substantial amount of time, effort, and money advertising and promoting the GREY Marks. By virtue of the extensive use and promotion of those marks, and the sale and promotion of services under those marks, the GREY Marks have come to be

recognized as identifying services finding their origin exclusively in or otherwise associated with Opposer. Opposer's GREY Marks have become distinctive of Opposer's services, and they represent enormous goodwill of Opposer.

4. Opposer is the owner of the following U.S. federal trademark registrations for the GREY Marks:

- Reg. No. 2,469,398 for the mark GREY in International Class 35 for "house mark of an advertising and marketing communications agency," based on a first use in commerce in 1917.
- Reg. No. 1,913,691 for the mark GREY in International Class 35 for "advertising agency services," based on a first use in commerce in 1917;
- Reg. No. 2,548,233 for the mark GREY GLOBAL GROUP in International Class 35 for "advertising agency services and marketing communications consulting services," based on a first use in commerce in April 2000;
- Reg. No. 4,095,737 for the mark GREYgroup in International Class 35 for "Advertising, marketing, and public relations services," based on a first use in commerce in 2006;
- Reg. No. 4,145,602 for the mark GREY ALLIANCE in International Class 35 for "Advertising, marketing, promotional, and publicity services; advertising, marketing, promotional, and publicity services for the benefit of entertainment and sports-oriented properties; public relations; event planning and management for marketing, branding, promoting or advertising the goods and services of others; promoting the goods and services of others by arranging for businesses to affiliate their goods and services with the goods and services of third parties by

means of sponsorship relationships and product placement,” based on a first use in commerce in September 1, 1996; and

- Reg. No. 4,353,094 for the mark GREYWORKS in International Class 35 for “Advertising services; production of advertising materials, advertising matter and commercials” based on a first use in commerce in March 2012.

(These registrations are referred to collectively as “Opposer’s Registrations.”) Opposer’s Registrations are valid, subsisting, in full force and effect, and are evidence of Opposer’s exclusive rights to use such marks in connection with the services listed pursuant to 15 U.S.C. §§ 1057 and 1115.

5. Upon information and belief, Applicant is a German citizen with an address of Schlossberg 3, 79639 Grenzach-Wyhlen, Federal Republic of Germany.

6. On March 7, 2014, Applicant filed Application Ser. No. 79/157,494 to register the mark COLORS GRAYS (and design) for the following goods and services:

- “Printed materials, namely, books, magazines, journals, posters, postcards, calendars in the field of art; photographs; photo-engravings; photograph stands; paper; cardboard; printers' type; printing blocks” in International Class 16;
- “Clothing items, namely, shirts, pants, jackets, shorts, blouses, pullovers, jeans, coats, underwear, dresses, suits; footwear; headgear, namely, hats, caps, hoods” in International Class 25;
- “Advertising; business management and administration; providing office functions; on-line wholesale store and retail store services featuring works of art; organization and conducting of exhibitions and trade fairs for commercial or advertising purposes; auctioneering; procurement services, namely, purchasing

works of art and works of photographers for others; procurement of contracts for others for the purchase of works of art; compilation and systematization of data into computer databases; dissemination of business prospectuses; distribution and dissemination of advertising matter; art galleries; art gallery services, on-line art galleries” in International Class 35; and

- “Education and entertainment services, namely, classes, seminars, conferences and workshops in the field of art; art exhibition services; publication of books, magazines, journals and electronic publications; artists' services, namely, photography services and painting services” in International Class 41,

pursuant to Section 66A of the Lanham Act, 15 U.S.C. 1141f(a) (the “COLORS GRAY Mark”).

7. The GREY Marks have been registered and used continuously by Opposer since a date long prior to any date on which Applicant can rely.

8. The COLORS GRAY Mark is legally identical to the prior-registered and prior-used GREY Marks in sight, sound and commercial impression.

9. Applicant’s registration of the COLORS GRAY Mark for advertising; business management and administration; providing office functions; organization and conducting of exhibitions and trade fairs for commercial or advertising purposes; compilation and systematization of data into computer databases; dissemination of business prospectuses; distribution and dissemination of advertising matter in International Class 35 (the “Opposed Services”) is likely to create the erroneous impression that Applicant’s services originate from or are otherwise associated with Opposer, or that the COLORS GRAY Mark is endorsed by or in some way connected with Opposer, all to Opposer’s injury and harm.

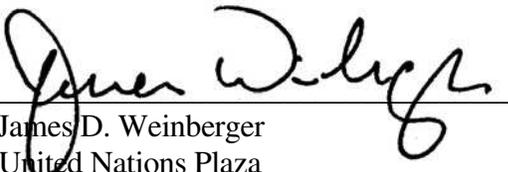
10. Registration of the COLORS GRAY Mark in connection with the Opposed Services is likely to cause confusion, cause mistake, or to deceive the public into the false belief that such services come from or are otherwise sponsored by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. Opposer is and will continue to be damaged by the registration of the COLORS GRAY Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 79/157,494 be denied.

Dated: New York, New York
April 12, 2016

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

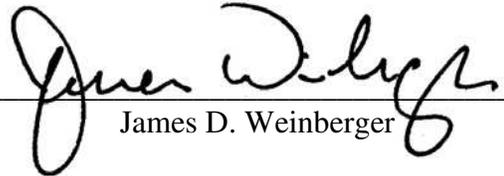
By: 

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the **NOTICE OF OPPOSITION** to be served by prepaid, first-class mail on this 12th day of April, 2016, upon applicant's attorneys, RA Peter Kraus, Freidrichstraße 95, 10117 Berlin GERMANY.


James D. Weinberger