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

Proceeding	91227989
Party	Plaintiff Grey Global Group LLC
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	05/19/2016
Attachments	First Amended Notice of Opposition COLORS GRAYS.PDF(28583 bytes)

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

GREY GLOBAL GROUP LLC,

Opposer,

v.

JOHN MARKUS,

Applicant.

FIRST AMENDED NOTICE OF OPPOSITION

Opposer, Grey Global Group LLC, a Delaware limited liability 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.

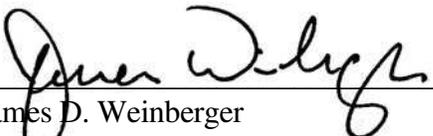
10. Registration of the COLORS GRAY Mark in connection with the Opposed Services is likely to cause confusion, cause mistake, or to deceive the public into the false belief that such services come from or are otherwise sponsored by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

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
May 19, 2016

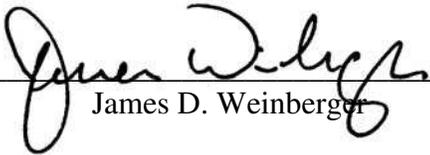
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Attorneys for Opposer

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 19th day of May, 2016, upon applicant's attorneys, RA Peter Kraus, Freidrichstraße 95, 10117 Berlin GERMANY.


James D. Weinberger