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December 30, 2010

VIA REGULAR MAIL

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Notice of Opposition to Trademark Application for Galina Sobolev
Application Serial Number: 77887986

Dear Sir/Madam:

Enclosed please find a Notice of Opposition which we were unable to electronically file with the United States Patent and Trademark Office Trial and Appeal Board with regard to the above matter. We had erroneously believed that this had been successfully electronically filed on December 8, 2010 due to an internal office miscommunication.

Should you have any further questions, please do not hesitate to contact this office. Thank you very much.

Very truly yours,


Lisa J. Reppert

Enclosure

LJR:mf



01-05-2011

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

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DAVID'S BRIDAL, INC. AND DBD, INC.

In the Matter of the Trademark Application
Serial No.: 77887986

v.

GALINA SOBOLEV

NOTICE OF OPPOSITION

For the Mark "GALINA SOBOLEV"
Published in the Official Gazette on
October 26, 2010

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DBD, Inc. ("DBD") and David's Bridal, Inc. ("DBI"), having a business address of 1001 Washington Street, Conshohocken, Pennsylvania 19428 hereby submit the within Notice of Opposition for the pending trademark application by Michael Solobev ("Applicant") for "GALINA SOLOBEV" based on an intent to use basis in international category 25 for clothing.

The above identified opposers (collectively referred to as "Registrant") will be damaged by the registration of "GALINA SOLOBEV" in the pending trademark application, serial number 77887986 and hereby opposes same on the following grounds:

1. DBD, a Delaware corporation is the holder of intellectual property for DBI. DBD entered into a licensing agreement with DBI through which DBI is the exclusive licensee of certain marks and has the ability, among other things, to manufacture and sell goods and services.
2. DBD is a wholly owned subsidiary of DBI.
3. DBD is the owner of the registered trademark "GALINA®" in international class 25 for "wedding gowns, bridesmaids' dresses and bridal veils".
4. The registered mark consists of "GALINA®" written in black upper case letters.

5. The above noted mark has been in use since 1994 and was registered by the United States Patent & Trademark Office on November 21, 1995.

6. DBI possesses the exclusive license of this mark and has the ability, among other things, to manufacture and sell goods and services under this mark.

7. DBI is a well known national wedding apparel and accessory retailer in business since the 1950's. DBI has over three hundred store locations in forty nine states throughout the United States and a website which sells dresses under various labels including "GALINA®" and GALINA SIGNATURE ("GALINA"), which are available nationally and internationally.

8. DBI has spent a great deal of money advertising its brands and establishing and promoting its position in the dress industry.

9. GALINA includes a line of dresses, both short and long which are intended to be worn at weddings, formal celebrations and special events. (See Exhibit A)

10. This line is well known in the bridal and apparel industry.

11. If a search of "Galina dresses" is entered in the Google search bar numerous listings for GALINA dresses by DBI appear. (See Exhibit B)

12. Applicant's application to register "GALINA SOBOLEV" will cause consumer confusion with the opposer's registered mark.

13. Applicant seeks registration in category 25 for dresses as well as blouses, coats, jackets, pants, scarves, skirts, shorts, T-shirts, tank tops and tops based on an intent to use basis.

14. The "GALINA SOBOLEV" mark is also written in black upper case letters.

15. The addition of "Sobolev" does not dispel potential consumer confusion and misassociation with the Applicant's goods being associated with those belonging to the Registrant.

16. "Sobolev" is not a well-known surname for apparel that stands on its own.
17. Therefore the implication of the Applicant putting "Sobolev" after "Galina" will not dispel any risk of confusion.
18. Marks have been found to be confusingly similarly in appearance where there are similar terms or phrases or parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear, Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).
19. "Names-both surnames and first names-are regarded as descriptive terms and therefore one who claims federal trademark rights in a name must prove that the name has acquired a secondary meaning. *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir.1990); *815 Tonawanda St. Corp. v. Fay's Drug Co., Inc.*, 842 F.2d 643, 648 (2d Cir.1988) (same); *see also* 15 U.S.C. § 1052(e) (providing that if a mark is 'primarily merely a surname' the United States Patent and Trademark Office may deny it federal registration); *Conagra, Inc. v. Singleton*, 743 F.2d 1508, 1513 (11th Cir. 1984) (requiring a showing of secondary meaning for a surname to give rise to enforceable trademark rights)." *Tana v. Dantanna's*, 611 F.3d 767, 774 (11th Cir. 2010).

20. There are “four factors in assessing secondary meaning: (1) ‘the length and nature of the name's use,’ (2) ‘the nature and extent of advertising and promotion of the name,’ (3) ‘the efforts of the proprietor to promote a conscious connection between the name and the business,’ and (4) ‘the degree of actual recognition by the public that the name designates the proprietor's product or service.’” Tana v. Dantanna's, 611 F.3d 767, 776 (11th Cir. 2010) (internal citation omitted).

21. Clearly where the applicant has filed on an intent to use basis it has not established any secondary meaning.

22. The proposed use will trade off of the Registrant's well known registered mark and will only dilute its strength.

23. The Applicant's mark when used on or in connection with the identified goods, resembles the Registrant's trademark under United States registration number 1937208 and is likely to cause confusion, mistake or deception in violation of TMEP §1207.

24. The examining attorney must compare the marks for similarities in sound, appearance, meaning or connotation. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarities in any one of these elements is sufficient to find a likelihood of confusion. *In re Mack* 197 USPQ 755 (TTAB 1977).

25. Applicant's proposed mark is “GALINA SOBOLEV”. The Registrant's mark is “GALINA®”. Applicant has appropriated the Registrant's mark by simply adding “SOBOLEV”. The addition of a surname does not sufficiently differentiate the proposed use from the registered “GALINA®” mark. Consumers familiar with the Registrant's mark will believe that the Applicant's mark belongs or is associated with the Registrant's mark.

26. The similarity of goods or services and channels of a trade are an extremely important consideration.

27. The goods or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus, Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1974); TMEP § 1207.01(a)(i).

28. The goods or services and channels of trade need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods or services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rextel, Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products, Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

29. The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208; 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

30. The Applicant intends to make dresses, a use which has already been well established by the Registrant.

31. The Applicant seeks registration for a category and description which has already been registered by the Registrant.

32. The Applicant and Registrant are in the same channels of trade and will target and appeal to the same consumers.


33. The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP § 1207.01(a)(i); *see, e.g., On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

34. If the goods and/or services of the respective parties are "similar in kind and/or closely related," the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would be required with diverse goods and/or services. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

35. Any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP § 1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F. 2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

36. For the aforementioned reasons, it is respectfully requested that the Applicant's application for registration be refused based upon the Trademark Act §2(b).

Dated: December 6, 2010

By: s/Lisa J. Reppert 
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