

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

In the matter of Trademark Application Serial No. 78/143316
Filed on July 12, 2002
For the mark "PERRY RICHARDS"
Published in the Official Gazette on March 25, 2003 at Page TM 288



04-24-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #58

TORI RICHARD, LTD.,)
a Hawaii corporation)
)
Opposer,)
)
v.)
)
ROYTEX, INC.,)
a Delaware corporation)
)
Applicant.)
_____)

Opposition No.: _____

NOTICE OF OPPOSITION

TORI RICHARD, LTD., a Hawaii corporation ("**Opposer**"), whose mailing address is 1334 Moonui Street, Honolulu, Hawaii 96817, believes it will be damaged by the registration of the mark "PERRY RICHARDS" shown in Application Serial No. 78/143316 in the name of ROYTEX, INC., a Delaware corporation ("**Applicant**"), for clothing, namely knit and woven shirts, in International Class 25 (the "**Application**") and hereby opposes the Application on the following grounds:

1. Applicant seeks to register "PERRY RICHARDS" as a trademark in connection with clothing, namely knit and woven shirts, in International Class 25.

2. The Application was filed on July 12, 2002, pursuant to Section 1(b) of the Trademark Act, based upon Applicant's claimed bona fide intention to use the mark "PERRY RICHARDS" in commerce.

3. Opposer owns renewed U.S. Trademark Registration No. 1,120,583 for its mark, "TORI RICHARD" covering "women's dresses, shirts, blouses, skirts, pants and caps; and men's and boys' shirts and pants" in International Class 25 ("Opposer's Registration"), two true and correct certified copies of the original registration are attached hereto as Exhibit "A" and are being submitted into evidence to be made a part of the record of this opposition, pursuant to 37 C.F.R. section 2.122(d)(1).

4. Opposer's Registration is valid and subsisting and remains in full force and effect, as evidence of the validity of, and of Opposer's exclusive ownership of, and the right to use, "TORI RICHARD", or any mark confusingly similar thereto, or which causes the dilution thereof, for goods covered by Opposer's Registration or related thereto.

5. Opposer's Registration has become "incontestable" under Section 15 of the Lanham Act, 15 U.S.C. § 1065.

6. For many years, Opposer has advertised, sold and distributed its goods listed in Opposer's Registration under its mark "TORI RICHARD" throughout the United States and the world. Opposer has developed an exceedingly valuable good-will with respect to its mark "TORI RICHARD".

7. By virtue of its efforts, the expenditure of considerable sums for advertising and promotional activities, and by virtue of the excellence of its goods, Opposer has gained for its mark "TORI RICHARD" a most valuable reputation.

8. Opposer's mark "TORI RICHARD" is famous under 15 U.S.C. § 1125(c)(1).

9. Opposer's mark "TORI RICHARD" is famous as to clothing under 15 U.S.C. § 1125(c)(1).

10. The goods set forth in the Application are related or similar to those in connection with which Opposer has used and is using its mark "TORI RICHARD", including, but not limited to, the goods listed in Opposer's Registration.

11. Both the Application and Opposer's Registration cover shirts.

12. Applicant's goods listed in the Application are included in the goods covered by Opposer's Registration.

13. The goods listed in the Application (clothing, namely knit and woven shirts) are not restricted to any particular channel of trade.

14. The second words of each mark, "RICHARD" and "RICHARDS", are confusingly similar.

15. The second words of each mark, "RICHARD" and "RICHARDS", would both be recognized as surnames by the class of purchasers who purchase Opposer's goods and Applicant's goods.

16. The first words of each mark, "TORI" and "PERRY", both have the same number of syllables (two) and rhyme.

17. The phonemes of the first syllables of the first words of each mark, "TORI" and "PERRY", are both voiceless plosives.

18. The second syllables of the first words of each mark, "TORI" and "PERRY", are both identically pronounced as "rē".

19. The first words of each mark, "TORI" and "PERRY", would both be recognized as given names by the class of purchasers who purchase Opposer's goods and Applicant's goods.

20. Opposer's registered mark, "TORI RICHARD", and Applicant's mark, "PERRY RICHARDS", would be confusingly similar to many potential purchasers of clothing products.

21. Applicant's mark so closely resembles Opposer's registered mark, that, if used in connection with the applied-for goods, it would be likely to cause confusion, mistake and/or deception of the relevant trade and public, to the damage of Opposer.

22. The use and registration of Applicant's mark, as indicated above, would result in confusion, mistake and/or deception as to the source or origin of Applicant's goods, leading consumers to believe that they are somehow affiliated with, approved, sponsored, or licensed by Opposer.

23. A likelihood of confusion exists under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), between Opposer's mark and Applicant's mark.

24. If Applicant is permitted to use and register Applicant's mark for the goods specified in the Application, confusion in trade, resulting in irreparable damage and injury to Opposer, inevitably would result by reason of the similarity between Applicant's and Opposer's mark and the goods sold thereunder. Any defect, objection, or fault found with goods marketed under Applicant's mark, "PERRY RICHARDS" would reflect on, and injure, the reputation Opposer has established for goods sold under its mark "TORI RICHARD".

25. If Applicant is granted the registration herein opposed, Applicant would obtain a *prima facie* exclusive right to use the mark set forth in the Application. Such registration would become a source of damage and injury to Opposer through the generation of confusion, mistake and/or deception, the dilution of Opposer's registered mark, and the diminution of Opposer's ability to control the quality of goods and services sold thereunder.

26. Moreover, such registration would run contrary to the requirement that all doubts as to the likelihood of confusion must be resolved in favor of Opposer, and against Applicant, who has a legal duty to select a mark totally dissimilar to marks already in use.

27. Applicant's mark as used on the goods listed in the Application, would dilute the distinctiveness of Opposer's mark "TORI RICHARD".

28. There is no issue as to priority. As evidenced by Opposer's Registration identified above, Opposer has been using its mark "TORI RICHARD" since at least as early as December 1956.

29. On information and belief, Applicant did not use the trademark "PERRY RICHARDS" in commerce in the United States prior to filing the Application.

WHEREFORE, Opposer prays that this Opposition be sustained, that the Application be refused and the mark applied for therein refused registration. A duplicate copy of this Notice of Opposition and the fee required in 37 C.F.R. § 2.6(a)(17) are enclosed herewith.

DATED: Honolulu, Hawaii, April 17, 2003.

Respectfully submitted,



Martin E. Hsia, Reg. No. 32,471
CADES SCHUTTE
A Limited Liability Law Partnership LLP
P.O. Box 939
Honolulu, HI 96808
Tel: (808) 544-3835

Attorney for TORI RICHARD, LTD.

EXHIBIT "A"

[Two (2) certified copies of U.S. Trademark Registration No. 1,120,583 attached hereto.]

680694

THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME:
UNITED STATES DEPARTMENT OF COMMERCE**

United States Patent and Trademark Office

January 27, 2003

THE ATTACHED U.S. TRADEMARK REGISTRATION 1,120,583 IS
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 20 YEARS FROM *June 19, 1979*
1st RENEWAL FOR A TERM OF 10 YEARS FROM *June 19, 1999*
SECTION 8 & 15

SAID RECORDS SHOW TITLE TO BE IN:

REGISTRANT



By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS

N. Woodson
N. WOODSON
Certifying Officer

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,120,583
Registered, June 19, 1979

TRADEMARK

Principal Register

TORI RICHARD

Tori Richard, Ltd. (Hawaii Corporation)
849 Cooke St.
Honolulu, Hawaii 96810

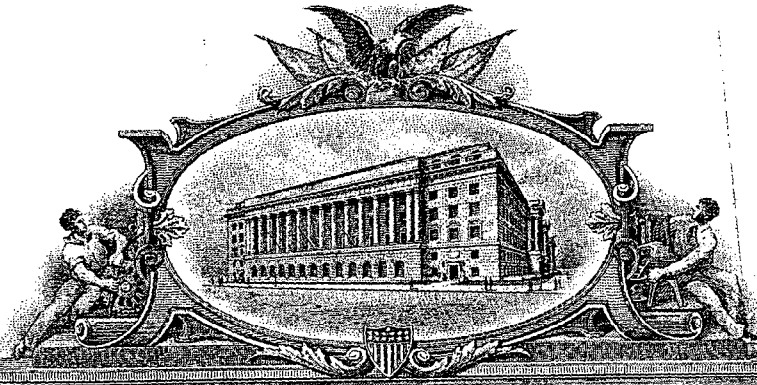
For: WOMEN'S DRESSES, JACKETS, SHIRTS,
BLOUSES, SKIRTS, PANTS AND CAPS; AND MEN'S
AND BOYS' JACKETS, SHIRTS, VESTS AND PANTS,
in CLASS 25 (U.S. CL. 39).

First use December 1956; in commerce July 1959.

"Tori Richard" is not the name of a particular living
individual, but is fanciful.

Ser. No. 154,085, filed Jan. 3, 1977

688741



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

April 14, 2003

THE ATTACHED U.S. TRADEMARK REGISTRATION 1,120,583 IS
CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND
EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN
THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES
PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 20 YEARS FROM *June 19, 1979*
1st RENEWAL FOR A TERM OF 10 YEARS FROM *June 19, 1999*
SECTION 8 & 15
LESS GOODS

SAID RECORDS SHOW TITLE TO BE IN:

Registrant



By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS

E. Bornett

E. BORNETT
Certifying Officer

..: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,120,583
Registered, June 19, 1979

TRADEMARK
Principal Register

TORI RICHARD

Tori Richard, Ltd. (Hawaii corporation)
849 Cooke St.
Honolulu, Hawaii 96813

For: WOMEN'S DRESSES, JACKETS, SHIRTS,
BLOUSES, SKIRTS, PANTS AND CAPS; AND MEN'S
AND BOYS' JACKETS, SHIRTS, VESTS AND PANTS,
in CLASS 25 (U.S. CL. 39).

First use December 1956; in commerce July 1959.
"Tori Richard" is not the name of a particular living
individual, but is fanciful.

Ser. No. 154,085, filed Jan. 3, 1977.

CERTIFICATE OF MAILING

I HEREBY CERTIFY that this NOTICE OF OPPOSITION is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to Box TTAB, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on this 21st day of April, 2003.



Dean M. Uehara