

ESTTA Tracking number: **ESTTA23825**

Filing date: **01/19/2005**

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 parties oppose registration of the indicated application.

#### Opposers Information

<b>Name</b>	Lion Licensing, Ltd.
<b>Granted to Date of previous extension</b>	01/19/2005
<b>Address</b>	1201 Market Street, Suite 1700 Wilmington, DE 19801 UNITED STATES

<b>Name</b>	Jones Investment Co. Inc.		
<b>Entity</b>	Corporation	<b>Citizenship</b>	Delaware
<b>Address</b>	200 West Ninth Street Plaza, Suite 700 Wilmington, DE 19801 UNITED STATES		

<b>Attorney information</b>	Mark D. Engelmann Fross Zelnick Lehrman & Zissu, P.C. 866 UN Plaza New York, NY 10017 UNITED STATES mengelmann@frosszelnick.com, zhilden@frosszelnick.com Phone:212-813-5900
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#### Applicant Information

<b>Application No</b>	78283513	<b>Publication date</b>	09/21/2004
<b>Opposition Filing Date</b>	01/19/2005	<b>Opposition Period Ends</b>	01/19/2005
<b>Applicant</b>	Ali-Khan Designs, Inc. 389 Fifth Avenue New York, NY 10016 UNITED STATES		

### Goods/Services Affected by Opposition

Class 014.

All goods and services in the class are opposed, namely: JEWELRY

<b>Attachments</b>	Notice of Opposition.tif ( 6 pages )
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<b>Signature</b>	/Zoe Hilden/
<b>Name</b>	Zoe Hilden
<b>Date</b>	01/19/2005

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

Opposers's Ref:  
LION USA TC-04/25494

In the Matter of Application Serial No. 78/283,513  
Mark: AK and Design  
Published in the *Official Gazette* on September 21, 2004

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**Jones Investment Co. Inc. and** :  
**Lion Licensing, Ltd.,** :  
 :  
Opposers, :  
 :  
- against - :  
 :  
**Ali-Khan Designs, Inc.,** :  
 :  
Applicant. :  
 :  
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Opposition No. \_\_\_\_\_

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

Jones Investment Co. Inc., a corporation organized and existing under the laws of the State of Delaware, located and doing business at 200 West Ninth Street Plaza, Suite 700, Wilmington, DE 19801 ("JICO") and Lion Licensing, Ltd., a corporation organized and existing under the laws of the State of Delaware, located and doing business at 1201 Market Street, Suite 1700, Wilmington, DE 19801 ("Lion" and, together with its affiliated company JICO, "Opposers"), believe that they would be damaged by the issuance of a registration to Ali-Khan Designs, Inc. ("Applicant") for the trademark shown in Application Serial No. 78/283,513 for the mark AK and Design for jewelry in International Class 14, and therefore oppose the same. The application was

published for opposition on September 21, 2004. The United States Patent and Trademark Office, Trademark Trial and Appeal Board, has granted an extension of time to oppose through January 19, 2005. As grounds for their opposition, Opposers, by their attorneys Fross Zelnick Lehrman & Zissu, P.C., allege as follows:

1. Opposers (through their predecessors in interest, licensees and affiliates) have sold women's clothing, jewelry and fashion accessories in the United States for over thirty years. Opposers' business was founded by the famous fashion designer Anne Klein. Since Ms. Klein's death in 1974, the business she founded has continued to grow and expand, making the ANNE KLEIN name and mark one of the best known in its field.

2. Opposers have used the mark ANNE KLEIN for jewelry and clothing since at least as early as 1968 and used the designation AKII for jewelry beginning in 1992. Opposers began using the mark AK ANNE KLEIN for clothing, belts, coats, watches and eyewear in 2002 and for jewelry at least as early as April 2003. Over the years, jewelry sold under the ANNE KLEIN and related marks, including AK ANNE KLEIN, has at times borne the mark AK engraved onto the jewelry.

3. Opposers own numerous U.S. federal trademark registrations for ANNE KLEIN, including, among others, Registration No. 1,016,832 for jewelry in Class 14 and hair ornaments in Class 26; Registration No. 1,046,318 for watches in Class 14; Registration No. 1,006,943 for coats, suits, jackets, pants, shirts, dresses, blouses, sweaters and belts in Class 25; Registration No. 1,016,890 for pocketbooks in Class 18; Registration No. 1,052,858 for a variety of small leather goods in Class 18; Registration No. 1,049,090 for shoes in Class 25; and Registration No. 1,074,926 for sunglasses. Among the many other registrations Opposers own for variants of the ANNE KLEIN mark are Registration No. 1,032,218 for ANNE KLEIN and Design for jewelry

made of non-precious metals in Class 14 and Registration No. 1,573,264 for ANNE KLEIN II for jewelry in Class 14. (The marks ANNE KLEIN, ANNE KLEIN and Design and ANNE KLEIN II are hereafter referred to collectively as the “ANNE KLEIN Marks.”) All of the foregoing registrations are valid and subsisting and have long since become incontestable under Section 15 of the Federal Trademark (Lanham) Act, 15 U.S.C. § 1065. Accordingly, the registrations serve as conclusive proof of Opposers’ exclusive right to use the ANNE KLEIN Marks in connection with the goods identified in the registrations. 15 U.S.C. § 1115(b).

4. Opposers also own U.S. federal trademark Application Serial No. 78/244,334 for the mark AK ANNE KLEIN for bath rugs in Class 27 and sheets, pillow cases, shams, dust ruffles, duvet covers, blankets, comforters, quilts, bath towels, beach towels, wash cloths, body sheets, hand towels, napkins and placemats in Class 24; and Application Serial No. 78/278,362 for GO AK ANNE KLEIN for women’s footwear in Class 25. (The marks AK ANNE KLEIN and GO AK ANNE KLEIN are hereafter referred to collectively as the “AK ANNE KLEIN Marks.”)

5. As a result of Opposers’ extensive use of the ANNE KLEIN and AK ANNE KLEIN Marks, the marks, when used in connection with clothing, jewelry, fashion accessories, fragrances and cosmetics, home accessories and related products, have become uniquely associated with Opposers, and are associated by the public with products emanating exclusively from or authorized by Opposers.

6. On information and belief, Ali-Khan Designs, Inc., Applicant in this action, is a New York corporation doing business at 389 Fifth Avenue, New York, NY 10016.

7. On August 5, 2003, Applicant filed Application Serial No. 78/283,513 to register the mark AK and Design for jewelry in Class 14. The application is based on an intent to use the mark.

8. Applicant's filing date, and the only date on which it can rely, is subsequent to Opposers' date of first use of their ANNE KLEIN and AK ANNE KLEIN Marks in connection with the identical goods, namely, jewelry.

9. The mark herein opposed consists of the initials AK, which is an abbreviation for ANNE KLEIN and is the initial, dominant portion of Opposers' AK ANNE KLEIN Marks. As such, Applicant's mark has a similar connotation, appearance, sound and commercial impression to Opposers' prior used marks. The "design" aspect of Applicant's mark, which consists of displaying AK in block letters, separated by a small diamond shape, does not distinguish it from Opposers' marks.

10. Applicant seeks to register the mark AK and Design for jewelry. Such goods are identical to those for which Opposers are famous and on which Opposers use their ANNE KLEIN and AK ANNE KLEIN Marks. Given Opposers' renown in the field of jewelry, Applicant's use of its mark in connection with jewelry is likely to cause consumers to mistakenly believe that Applicant's goods are approved, endorsed or sponsored by Opposers, or that Opposers are a source of Applicant's goods, or that the goods of Applicant are in some other way associated with Opposers, all to Opposers' injury and harm.

11. Applicant's goods are presumed to be sold in all channels of trade in which jewelry is generally sold. Such channels of trade would be identical to channels of trade in which Opposers offer jewelry under their marks. In addition, the consumers for goods offered

under Applicant's mark are presumed to be identical to Opposers' consumers since both Applicant and Opposers are offering or intend to offer jewelry under their respective marks.

12. Issuance of a registration to Applicant for the mark AK and Design is inconsistent with Opposers' prior rights in the ANNE KLEIN and AK ANNE KLEIN Marks as well as with Opposers' statutory grant of exclusivity of use of their registered ANNE KLEIN Marks, and would substantially damage Opposers' investment and goodwill in their marks.

CLAIM FOR RELIEF UNDER SECTION 2(d)

13. Opposers repeat and reallege each and every allegation contained in paragraphs 1 through 12 as if fully set forth herein.

14. The ANNE KLEIN and AK ANNE KLEIN Marks have been used continually by Opposers since a date prior to any date on which Applicant may rely.

15. Applicant's AK and Design mark is highly similar in appearance and in commercial impression to Opposers' ANNE KLEIN and AK ANNE KLEIN Marks.

16. The goods of Applicant to be offered under its AK and Design mark are identical to goods offered by Opposers under the ANNE KLEIN and AK ANNE KLEIN Marks.

17. The use by Applicant of its mark for the goods listed in the Application is likely to create the erroneous impression that Applicant's goods originate with, are endorsed, sponsored or promoted by, come from, or are otherwise associated with Opposers or Opposers' goods or services provided under their ANNE KLEIN and AK ANNE KLEIN Marks. Any use of the mark AK and Design by Applicant is therefore likely to cause confusion, cause mistake or deceive the public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

CLAIM FOR RELIEF UNDER SECTION 2(f)

18. Opposers repeat and reallege each and every allegation contained in paragraphs 1 through 17 as if fully set forth herein.

19. Opposers' ANNE KLEIN and AK ANNE KLEIN Marks are strong and famous and have been so from a date prior to the date of the Application at issue herein.

20. Applicant's use of AK and Design in connection with jewelry will cause dilution of the distinctive quality of Opposers' ANNE KLEIN and AK ANNE KLEIN Marks.

21. Applicant's use and registration of AK and Design are in violation of Section 43(c) of the Federal Trademark Act, 15 U.S.C. § 1125(c).

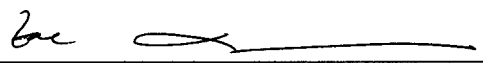
22. By reason of the foregoing, Opposers are likely to be harmed by registration of Application Serial No. 78/283,513 for the mark AK and Design.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Applicant in Application Serial No. 78/283,513 be denied.

Please charge the opposition fee in the amount of \$300.00 to our deposit Account No. 23-0825-0576900.

Dated: New York, New York  
January 19, 2005

FROSS ZELNICK LEHRMAN  
& ZISSU, P.C.

By: 

Mark D. Engelmann  
Zoe Hilden

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