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

Proceeding	91165903
Party	Plaintiff L.C. LICENSING, INC. L.C. LICENSING, INC. 1441 BROADWAY NEW YORK, NY 10018
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Date	01/02/2007
Attachments	letter to ttab.pdf ( 2 pages )(68072 bytes )

January 2, 2007

*Via ESTTA and Fed Ex*

Ms. Clara Vela  
Paralegal Specialist  
United States Patent & Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Re: Opposition Nos. 91161547 and others (L.C. Licensing, Inc. v. Lancome Parfums et Beaute & Cie)

This will respond to your notice dated November 30, 2006 ("Notice"). Opposer, L.C. Licensing, Inc. acknowledges Applicant, Lancome Parfums et Beaute & Cie's, submission to the Board, in response to the Notice, of the decision and order of Judge Cote resolving the proceedings in the District Court. However, the question of likelihood of confusion in the district court proceeding presented issues sufficiently different from those arising in the opposition proceedings before the Trademark Trial and Appeal Board, so that neither res judicata nor collateral estoppel should bar Opposer from pursuing these oppositions. See Mayer/Berkshire Corp. v. Berkshire Fashions, Inc., 424 F.3d 1229, 1234 (Fed. Cir. 2005). Also See generally J.T. McCarthy, McCarthy on Trademark and Unfair Competition, § 32:82 at 32:143 (4<sup>th</sup> ed. 2004) ("A claim for infringement is not the same as an *inter partes* claim for opposition or cancellation against another's registration of a mark. Thus an opposer would not necessarily be barred by the rule of claim preclusion when it lost a previous infringement claim in court".)

By the time the parties went to trial in the lower court, the only trademarks at issue were Applicant's "Juicy Wear" mark (as used on lip glosses) and "Juicy Pop" and "Juicy Gossip" marks as used *in advertising*. In contrast, the pending Oppositions involve many different marks, and several of the applications involved (including the mark "Juicy" by itself) include a much broader array of goods (including fragrance) than that which was before the lower court. In American Hygienic Labs., Inc. v. Tiffany & Co., 228 USPQ 855, 857 (TTAB 1986), the Court stated "a claim of infringement before the court and a claim of priority and likelihood of confusion before this Board are different claims. The former claim is, in essence, a claim of injury resulting from applicant's use of its mark in commerce; the latter claim, in essence, is a claim that opposer believes it would be damaged by registration of applicant's mark".

Because the issues involved in the subject opposition proceedings are different from the issues addressed in the lower court opinion and order, Opposer should be allowed to proceed with the oppositions, as it still believes, and has a right to prove, that it will be damaged by the registrations Applicant seeks.

Sincerely,

A handwritten signature in black ink, appearing to read "Gene Bolmarcich". The signature is fluid and cursive, with a large initial "G" and "B".

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