

ESTTA Tracking number: **ESTTA51391**

Filing date: **11/01/2005**

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 party opposes registration of the indicated application.

Opposer Information

Name	May Department Stores International, Inc.
Granted to Date of previous extension	11/02/2005
Address	615 Olive St.Suite 1750 St. Louis, MO 63101 UNITED STATES

Attorney information	Jane Anne Crane The May Department Stores Company 611 Olive St.Suite 1750 St. Louis, MO 63101 UNITED STATES ip_group@may-co.com Phone:(314) 342-6726
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Applicant Information

Application No	78161279	Publication date	07/05/2005
Opposition Filing Date	11/01/2005	Opposition Period Ends	11/02/2005
Applicant	ODIMO ACQUISITION CORP. 1400 N.W. 4TH STREET SUNRISE, FL 33325		

UNITED STATES

Goods/Services Affected by Opposition

Class 003.

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

Class 014.

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

Class 016.

All goods and services in the class are opposed, namely: Fountain pens, ink pens, and ball-point pens; newsletters, magazines, and books concerning a wide variety of luxury goods and services, food items, wine, travel and recreational activities

Class 018.

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

Class 025.

All goods and services in the class are opposed, namely: Clothing, namely, belts and ties

Class 035.

All goods and services in the class are opposed, namely: Providing information regarding the goods and services of others in the nature of a buyers' guide, by means of the Internet; dissemination of advertising for others via the Internet; telephone directory assistance services and providing on-line directory information services also featuring hyperlinks to other web sites to help locate people, organizations, phone numbers, home pages, and electronic mail address; promoting the goods and services of others by awarding purchase points for credit card use; promoting the credit card accounts services of others through the administration of incentive award programs; on-line retail store services featuring luxury goods, namely watches, watch winders, watch bands, clocks, diamonds, jewelry, hair ornaments, belts, writing accessories, leather goods, sunglasses, handbags, ties, cummerbunds, cufflinks, scarves, fragrances, pocket knives, crystal items, artwork, picture frames and picture albums; retail store services featuring luxury goods, namely watches, watch winders, watch bands, clocks, diamonds, jewelry, hair ornaments, belts, writing accessories, leather goods, sunglasses, handbags, ties, cummerbunds, cufflinks, scarves, fragrances, pocket knives, crystal items, artwork, picture frames and picture albums; on-line auctions

Class 038.

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

Class 042.

All goods and services in the class are opposed, namely: Providing consumer product and service testing and evaluation information via the Internet computer services, namely, providing search engines for obtaining data on global computer networks; hosting the web sites of others on computer servers for a global computer information networks;

creating indices of information, sites, and other resources available on global communications and computer information networks

Related Proceedings

Opposition to Serial No. 78161282

Attachments

78161279 Opposition (11-01-05).pdf (6 pages)

Signature

/jane anne crane/

Name

Jane Anne Crane

Date

11/01/2005

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

In the Matter of Application Serial No. 78-161,279
Published for Opposition in the Official Gazette on July 5, 2005
Mark: ASHFORD.COM

International Classes: 3, 14, 16, 18, 25, 35, 38, 42

MAY DEPARTMENT STORES
INTERNATIONAL,

Opposer,

Against

ODIMO ACQUISITION
CORPORATION,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer May Department Stores International (“MDSI”) believes it will be damaged by registration of the mark ASHFORD.COM as shown in the above-identified application and hereby opposes the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the “Lanham Act”), 15 U.S.C. § 1064(a).

As grounds for the opposition, Opposer alleges that:

1. Opposer MDSI, a Delaware corporation with its principal place of business located at 615 Olive Street, St. Louis, Missouri 63101, owns and operates an international merchandise development and production business.
2. For many years and long before September 6, 2002, the filing date of the intent-to-use application herein opposed, Opposer has used the trademark JOHN ASHFORD and variations thereof (hereinafter, the “JOHN ASHFORD Marks”) in connection with its development and production of consumer goods.

3. For many years and long before September 6, 2002, the filing date of the intent-to-use application herein opposed, Opposer's affiliated businesses (the "Affiliated Businesses") have used the JOHN ASHFORD Marks on or in connection with the sale of a wide variety of goods and services, including men's apparel.

4. Opposer actively seeks to identify and stop perceived infringers of the JOHN ASHFORD Marks.

5. During its long, widespread and continuous use of the JOHN ASHFORD Marks, Opposer and its Affiliated Businesses have expended considerable time, effort and money in advertising and publicizing the sale of goods and services bearing these marks.

6. Opposer and its Affiliated Businesses have sold, and offered for sale, goods and services bearing the JOHN ASHFORD Marks in a trading area of broad geographical scope encompassing, inter alia, over thirty (30) of the states in the United States and the District of Columbia.

7. Opposer's widespread use of the JOHN ASHFORD Marks on a variety of goods and services, coupled with the extensive advertising and publicity of such goods and services by Opposer's Affiliated Businesses, has contributed to the powerful consumer association between the JOHN ASHFORD Marks and Opposer's Affiliated Businesses and has made these marks famous.

8. The JOHN ASHFORD Marks have a high degree of distinctiveness due to the duration and extent of Opposer's and its Affiliated Businesses' use, advertising and publicity of these marks.

9. In addition to Opposer's common law rights in the JOHN ASHFORD Marks, Opposer owns a federal registration for the following JOHN ASHFORD Mark:

<u>Reg. No.</u>	<u>Mark/Design</u>	<u>International Class(es)</u>	<u>First Use</u>
1990097	JOHN ASHFORD	25	March 12, 1986

The above registration is incontestable, pursuant to 15 U.S.C. §1065.

10. By the application hereby opposed, Applicant seeks to register the mark ASHFORD.COM in International Classes 3, 14, 16, 18, 25, 35, 38, and 42. The application was filed on the basis of Applicant's intent to use the mark ASHFORD.COM on the following goods/services:

CLASS 3: For perfume.

CLASS 14: For jewelry and watches.

CLASS 16: For fountain pens, ink pens, and ball-point pens, newsletters magazines, and books concerning a wide variety of luxury goods and services, food items, wine, travel and recreational activities.

CLASS 18: For handbags.

CLASS 25: For clothing, namely, belts and ties.

CLASS 35: For providing information regarding the goods and services of others in the nature of a buyers' guide, by means of the Internet, dissemination of advertising for others via the Internet, telephone directory assistance services and providing on-line directory information services also featuring hyperlinks to other web sites to help locate people, organizations, phone numbers, home pages, and electronic mail address; promoting the goods and services of others by awarding purchase points for credit card use; promoting the credit card accounts services of others through the administration of incentive award programs; on-line retail store services featuring luxury goods, namely watches, watch winders, watch bands, clocks, diamonds, jewelry, hair ornaments, belts, writing accessories, leather goods, sunglasses, handbags, ties [sic], cummerbunds, cufflinks, scarves, fragrances, pocket knives, crystal items, artwork, picture frames and picture albums, retail store services featuring luxury goods, namely watches, watch winders, watch bands, clocks, diamonds, jewelry, hair ornaments, belts, writing accessories, leather goods, sunglasses, handbags, ties, cummerbunds, cufflinks,

scarves, fragrances, pocket knives, crystal items, art-work, picture frames and picture albums, on-line auctions.

CLASS 38: For electronic mail.

CLASS 42: For providing consumer product and service testing and evaluation information via the Internet computer services, namely, providing search engines for obtaining data on global computer networks, hosting the web sites of others on computer servers for a global computer information networks, creating indices of information sites, and other resources available on global communications and computer information networks.

11. The goods for which Applicant seeks registration are similar to the goods in connection with which the JOHN ASHFORD Marks are in use and for which Opposer owns Registration No. 1990097.

12. Upon information and belief, Applicant intends to sell its unauthorized and unlicensed goods to consumers across the United States, in the same trade areas in which Opposer's JOHN ASHFORD goods are sold.

13. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

14. Registration should be refused pursuant to Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), on the grounds that Applicant's use of the proposed mark ASHFORD.COM will falsely suggest a connection between Applicant and Opposer, to the damage of Opposer.

15. Registration should be refused pursuant to Sections 2(d) and 32(l) of the Lanham Act, 15 U.S.C. §§ 1052(d) and 1114(l), on the grounds that Applicant's proposed ASHFORD.COM mark so resembles the JOHN ASHFORD Marks used consistently by

Opposer and its Affiliated Businesses in the United States, as to be likely, when used on or in connection with the goods identified in the Application, to cause confusion, or to cause mistake, or to deceive, with consequent injury to Opposer and to the public.

16. Registration should be refused pursuant to Sections 2(f) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(f) and 1125(c), on the grounds that Opposer will be damaged by the registration sought by Applicant because the registration will dilute the distinctive and famous quality of the JOHN ASHFORD Marks.

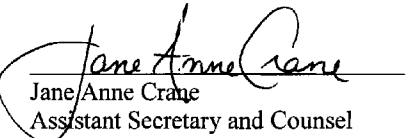
WHEREFORE, Opposer believes it will be damaged by the registration by Applicant of ASHFORD.COM for the goods identified in Application Serial Number 78-161,279 and respectfully requests that the Opposition be sustained and registration of said mark be denied.

This Notice of Opposition is filed in duplicate as required by 37 C.F.R. §2.104(a). Pursuant to 37 C.F.R. §2.6(a)(17), Opposers respectfully request that the statutory filing fees be charged to the account number specified in the on-line filing.

All communication should be addressed to Opposers' counsel, at the below stated address.

Dated: St. Louis, Missouri
November 1, 2005

Respectfully submitted,

By: 
Jane Anne Crane
Assistant Secretary and Counsel
May Department Stores International
611 Olive Street, Suite 1750
St. Louis, Missouri 63101

ATTORNEY FOR OPPOSER

MAY DEPARTMENT STORES
INTERNATIONAL

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