

ESTTA Tracking number: **ESTTA123735**

Filing date: **02/07/2007**

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	Venus Swimwear, Inc.
Granted to Date of previous extension	02/07/2007
Address	11711 Marco Beach Drive Jacksonville, FL 32224-7615 UNITED STATES

Attorney information	Peter A. Chiabotti Akerman Senterfitt 222 Lakeview Avenue; 4th Floor West Palm Beach, FL 33401-6183 UNITED STATES peter.chiabotti@akerman.com Phone:561-653-5000
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**Applicant Information**

Application No	76654748	Publication date	10/10/2006
Opposition Filing Date	02/07/2007	Opposition Period Ends	02/07/2007
Applicant	Monte Catini Corp. 1592 N.W. 159th Street Miami, FL 33160 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 003. All goods and services in the class are opposed, namely: Cosmetics; skin care products, namely, facial and skin creams and lotions; skin lightening cream; hair care products, namely, shampoo, conditioner, straightener and mousse
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Attachments	7150-40 Opposition to AFRICAN VENUS.pdf ( 8 pages )(33975 bytes )
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Signature	/Peter A. Chiabotti/
Name	Peter A. Chiabotti
Date	02/07/2007

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

In the matter of U.S. Trademark Application Serial No.: 76/654748  
Filed: February 7, 2006  
For the mark: AFRICAN VENUS  
Published in the *Official Gazette*: October 10, 2006

VENUS SWIMWEAR, INC.,  
a Florida corporation

Opposer

v.

MONTE CATINI CORP.,  
a Florida corporation

Applicant.

Opposition No. \_\_\_\_\_

**FILED VIA ESTTA**

U. S. Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

Venus Swimwear, Inc., a Florida corporation, having a place of business at 11711 Marco Beach Drive, Jacksonville, Florida 32224-7615 (hereinafter “Venus” or “Opposer”), believes it will be damaged by the issuance of a Trademark Registration to Monte Catini Corp., a Florida corporation, having a place of business at 1592 N.W. 159<sup>th</sup> Street, Miami, Florida 33160 (hereinafter “Applicant”), for U.S. Trademark Application No. 76/654748 for AFRICAN VENUS for “cosmetics, skin care products, namely, facial and skin creams and lotions; skin lightening cream; hair care products, namely, shampoo, conditioner, straightener and mousse” in International Class 3 (the “Application”). Accordingly, under the provisions of 15 U.S.C. §1063, Venus opposes registration of the Application. The Application was

published for opposition in the Official Gazette on October 10, 2006 and the Trademark Trial and Appeal Board granted Venus's First 90 Day Request for Extension of Time to Oppose, providing a Notice of Opposition submission deadline of February 7, 2007. Accordingly, this Notice of Opposition is timely filed.

As grounds for the opposition, Opposer alleges that:

1. In 1984, Opposer adopted and began using the trademark VENUS (the "VENUS Mark") in connection with swimwear. Opposer has used the VENUS Mark continuously and without interruption since at least as early as 1984, approximately twenty-two (22) years prior to Applicant's filing of its Intent-to-Use Application.

2. Over the years, Opposer has expanded its trademark usage beyond swimwear and has adopted and used the VENUS Mark in connection with a host of products that are similar or related to the goods recited in the Application. Such expansion occurred well before Applicant's filing of the Application as an Intent-to-Use Application, on February 7, 2006.

3. Opposer has obtained multiple federal Registrations for its family of "VENUS" marks, including, among others, the following:

A. U.S. Registration No. 1,372,695 for VENUS SWIMWEAR for swimwear in International Class 25;

B. U.S. Registration No. 1,492,352 for VENUS SWIMWEAR for outer wear clothing, namely, swimsuits, tee-shirts, shirts, shorts, wrap skirts, rompers, dresses, coverups and pants in International Class 25;

C. U.S. Registration No. 1,971,354 for VENUS for outer wear clothing, namely swimsuits, tee-shirts, shirts, shorts, wrap skirts, rompers, dresses, coverups, pants, headbands, and caps in International Class 25;

D. U.S. Registration No. 2,268,534 for VENUS for entertainment services in the nature of preliminary and final beauty pageants in International Class 41;

E. U.S. Registration No. 2,866,965 for VENUS for providing information about beauty and fashion, and consultation services in the fields of beauty and fashion in International Class 42;

F. U.S. Registration No. 2,549,941 for VENUS EDGE for clothing and footwear, namely swimwear, pants, shorts, skirts, dresses, shirts, tops, tee shirts, scarfs and body wraps, shoes, sandal, wristbands and headbands in International Class 25;

G. U.S. Registration No. 2,614,787 for THE VENUS EDGE for catalog mail order and online wholesale and retail distributorship services featuring clothing, jewelry, eyewear and cosmetics, namely swimwear, pants, shorts, skirts, dresses, shirts, tops, tee shirts, scarfs and body wraps, shoes, sandals, wristbands and headbands, necklaces and bracelets, swimwear cleaning solution, sunglasses, hair mascara and glitter kit, beaded mirror kit having a beaded bag with mirror and hair clip therein in International Class 35 ;

H. U.S. Registration No. 3,122,353 for VENUS for retail store services, retail catalog services and online retail services featuring outer wear clothing, namely, hats, caps, visors, hoods, head bands, sweat bands, wrist bands, belts, socks, stockings, pantyhose, bodysuits, leotards, leggings, sweat socks, thermal socks, shoes, sneakers, boots, sandals, slippers, kerchiefs, scarves, bandannas, vests, shirts, blouses, knit tops, dresses, skirts,

jumpsuits, pant suits, rompers, tank tops, cotton woven shirts, knit shirts, polo shirts, t-shirts, sweat shirts, crew neck sweaters, v-neck sweaters, turtleneck sweaters, cardigans, jogging suits, shorts, sweat shorts, jeans, pants, slacks, trousers, sweat pants, shawls, blazers, rain coats, overcoats, top coats, sport coats, parkas, jackets, polyester woven shirts, rayon woven shirts, leather coats, elastic waist coats, fixed waist shorts, denim shorts, denim jackets, under wear clothing, namely, pajamas, robes, kimonos, boxer shorts, briefs, underpants, brassieres, bustiers, chemises, teddies, camisoles, slips, negligees, thermal underwear, jewelry, namely, belly chains, belly rings, toe rings, bracelets, earrings, necklaces/chokers, and swimwear cleaner, suntan lotions, sunglasses, coolie cups, fanny bags and tote bags in International Class 35;

I. U.S. Registration No. 3,134,692 for VENUS USA for retail store services, mail order catalog and online retail store services all of the foregoing services featuring, outer wear clothing, namely, swimsuits, shorts, tops, tee-shirts, shirts, sweaters, vests, skirts, jumpsuits, bodysuits, leotards, rompers, dresses, blazers, rain coats, overcoats, leather coats, sport coats, topcoats, parkas, jackets, cover-ups, jeans, pants, yoga pants, jogging suits, sweatbands, wristbands, headbands, bandannas, scarfs, caps, hats, visors, hoods, shawls, body wraps; under wear clothing, namely, lingerie, undershirts, kimonos, pajamas, robes, boxer shorts, briefs, underpants, corsets, corselets; girdles, brassieres, bustiers, chemises, teddies, camisoles, slips, negligees; eyewear; jewelry, namely, belly chains, belly rings, toe rings, earrings, necklaces and bracelets; socks, stockings, leggings; shoes, sneakers; boots, sandals; slippers; belts; swimwear cleaning solution; suntan lotions, sunglasses; thermal insulated cups, fanny bags and tote bags in International Class 35;

J. U.S. Registration No. 3,138,898 for VENUS for lingerie in International Class 25; and

K. U.S. Registration No. 3,178,851 for VENUS for retail store, electronic catalog, mail-order catalog, and Internet retail services in the field of clothing, in International Class 035 (collectively, the “Venus Registrations”).

4. Opposer also has multiple pending Applications of the VENUS Mark, including the following family of marks:

A. U.S. Application Serial No. 76/646,244 for VENUS COUTURE for clothing, namely, swimwear, dresses, jeans, casual pants, dress pants, blouses, tank tops, tee shirts, casual shirts, denim shorts, denim jackets, leather jackets, knit tops, sweaters, skirts, shorts, shoes, hats, caps, visors, hoods, sweat bands, wrist bands, belts, stockings, pantyhose, socks, bodysuits, leotards, sneakers, boots, sandals, slippers, scarves, vests, shirts, jumpsuits, pant suits, rompers, polo shirts, cardigans, shorts, blazers, rain coats, pajamas, robes, kimonos, underpants, brassieres, bustiers, chemises, teddies, camisoles, slips, negligees in International Class 25;

B. U.S. Application Serial No. 78/339,953 for VENUS.COM for providing information and consultation services in the field of beauty in International Class 44, retail store, catalog and online retail store services featuring outer wear clothing, namely, swimsuits, tops, tee-shirts, vests, skirts, jumpsuits, bodysuits, leotards, rompers, dresses, blazers, rain coats, overcoats, leather coats, sportcoats, topcoats, parkas, jackets coverups, pants, yoga pants, jogging suits, sweatbands, wristbands, headbands, bandannas, scarfs, caps, hats, visors, hoods, shawls, bodywraps; under wear clothing, namely, lingerie, thermal

underwear, undershirts, kimonos, pajamas, robes, boxer shorts, briefs, underpants, corsets, corselets; girdles, brassieres, bustiers, chemises, teddies, camisoles, slips, negligees; jewelry, namely, earrings, necklaces and bracelets; socks, stockings, pantyhose, leggings; shoes; sneakers; boots but not ski boots, sandals; slippers; belts; swimwear cleaning solution; sunglasses; fragrances, cosmetics in International Class 35 and providing information and consultation services in the field of fashion in International Class 45; and

C. U.S. Application Serial No. 78/717,721 for VENUS USA for lingerie in International Class 25; (collectively, the “Venus Applications”).

5. The VENUS Mark has been displayed on Opposer’s products and in promotional and advertising materials related thereto in the United States and throughout the world. As a consequence, the VENUS Mark is widely recognized as an indicator of the source of origin for Opposer’s goods and services.

6. Applicant is seeking to obtain, under the provisions of the Trademark Act of 1946, as amended, registration on the Principal Register of the mark AFRICAN VENUS for “cosmetics, skin care products, namely, facial and skin creams and lotions; skin lightening cream; hair care products, namely, shampoo, conditioner, straightener and mousse” in International Class 3.

7. The Application was filed as an Intent-to-Use Application on February 7, 2006, over two decades subsequent to Opposer’s first adoption and use of the Venus Mark. Accordingly, Opposer has rights of priority in the VENUS Mark superior to those of Applicant.

8. The goods set forth in the Application are well within Opposer's natural zone of expansion with respect to products branded with the Venus Mark. Furthermore, on information and belief, Applicant's goods will be offered to a similar class of consumers who purchase the goods in connection with which Opposer uses its VENUS Mark and will be offered through the same channels of trade.

9. The applied-for mark AFRICAN VENUS is confusingly similar to the Opposer's VENUS Mark and the Venus Registrations and Venus Applications in terms of its sight, sound, meaning and overall commercial impression and it is likely to cause confusion, mistake, and deception as to an affiliation, connection or association between Opposer and Applicant, or as to the origin, sponsorship or approval of Applicant's goods and other commercial activities, all to Opposer's detriment, thereby causing Opposer damage. Potential customers are likely to believe that Applicant's goods originate from, or are sponsored or approved by, Opposer, when such is not the case.

10. Applicant is not affiliated with or connected in any way to Opposer and Opposer has not consented to Applicant's use of Opposer's VENUS Mark.

11. If Applicant is granted the Registration herein opposed, it would thereby obtain a *prima facie* exclusive right to the use of the AFRICAN VENUS mark, which would be a further source of damage to Opposer.

12. WHEREFORE, Opposer believes that it will be damaged by the registration of the mark AFRICAN VENUS in the Application, and prays that this Opposition be sustained, that Application Serial No. 76/654748 be rejected and that the mark applied for therein be refused registration on that basis.



Opposition No. \_\_\_\_\_  
Application Serial No.: 76/654748  
Notice of Opposition  
Docket: 7150-40  
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Authorization is given to charge \$300.00 for the filing fee for this Opposition to Deposit Account No. 50-0951. Authorization is also given to charge any deficiencies, or credit any overpayments, to Deposit Account No. 50-0951 throughout the pendency of this Opposition.

Please direct all notices, pleadings and process regarding this matter to:

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Respectfully submitted

**AKERMAN SENTERFITT**

Date: February 7, 2007

/Peter A. Chiabotti/  
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