

ESTTA Tracking number: **ESTTA147285**

Filing date: **06/22/2007**

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	Bianco Footwear A/S
Granted to Date of previous extension	07/04/2007
Address	Jernet 4 FDK 6000 Kolding, DENMARK

Attorney information	Michael Chiappetta Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza 6th Floor New York, NY 10017 UNITED STATES mchiappetta@fzlz.com Phone:212-813-5900
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**Applicant Information**

Application No	76651076	Publication date	03/06/2007
Opposition Filing Date	06/22/2007	Opposition Period Ends	07/04/2007
Applicant	PAI, PO JEN 3F, NO. 4, ALLEY 12 LANE 151, BAO PING RD. YONG HO CITY, TAIPEI HSIEN, TAIWAN		

**Goods/Services Affected by Opposition**

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, belts, breeches, coats, frocks, gloves, jackets, scarves, neckties, overcoats, pullovers, shirts, singlets, skirts, sport coats, sport shirts, sports jackets, sports jerseys and breeches for sports, suits, trousers; footwear, namely, boots, shoes, athletic shoes, gymnastic shoes, leather shoes, leisure shoes, sports shoes, slippers, sandals, socks, stockings; headgear, namely, caps, hats, hoods
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2346285	Application Date	01/31/1997
Registration Date	05/02/2000	Foreign Priority Date	NONE

Word Mark	BIANCO
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1982/00/00 First Use In Commerce: 1982/00/00 footwear

U.S. Application No.	79006528	Application Date	05/11/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BIANCO.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: footwear Class 035. First use: Retail store services featuring footwear		

Attachments	75234442#TMSN.gif ( 1 page )( bytes ) 79006528#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition (F0069842).PDF ( 4 pages )(96761 bytes )
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Signature	/Michael Chiappetta/
Name	Michael Chiappetta
Date	06/22/2007

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

Opposer's Ref: BIAA USA TC 07/03583

In the Matter of Application Serial No. 76-651,076  
Mark: BB BERNARDO BIANCO (and Design)  
Filed: November 29, 2005  
Published in the *Official Gazette*: March 6, 2007

BIANCO FOOTWEAR A/S,

Opposer,

-against-

PO JEN PAI,

Applicant.

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

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

**NOTICE OF OPPOSITION**

Opposer, Bianco Footwear A/S ("Opposer"), a public limited company organized and existing under the laws of Denmark, whose address is Jernet 4F, DK-6000 Kolding, Denmark, believes it will be damaged by the registration of the mark shown in Application Serial No. 76-651,076, and opposes that application under the provisions of 15 U.S.C. § 1063.

Applicant Neal Elinoff ("Applicant") filed Application Serial No. 76-651,076 for the mark BB BERNARDO BIANCO (and Design) on November 29, 2005. This mark was published for opposition in the Trademark Official Gazette of March 6, 2007, and extensions of time to oppose have been granted to Opposer up to and including July 4, 2007.

As grounds for its opposition, Opposer, by its attorneys, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer and its predecessors in interest have been using the mark BIANCO in connection with footwear in the United States since 1982.

2. Opposer is the record owner of incontestable U.S. Registration No. 2,346,285 for the BIANCO mark in connection with “footwear” in International Class 25, which was registered on May 2, 2000 and states a first use date of 1982. Opposer also owns Application Serial No. 79/006,528 for the mark BIANCO. in connection with “footwear” in International Class 25 and “retail store services featuring footwear” in International Class 35, which Opposer filed as an extension of its International Registration 0836599 on May 11, 2004.

3. In view of the foregoing, Opposer is the owner of statutory and common law rights in the BIANCO mark in connection with, *inter alia*, footwear in the United States.

4. On November 29, 2005, Applicant filed Application Serial No. 76-651,076 based on an alleged intent to use the mark in commerce, to register the mark BB BERNARDO BIANCO (and Design) in International Class 25 for “clothing, namely belts, breeches, coats, frocks, gloves, jackets, scarves, neckties, overcoats, pullovers, shirts, singlets, skirts, sport coats, sport shirts, sports jackets, sports jerseys and breeches for sports, suits, trousers; footwear, namely, boots, shoes, athletic shoes, gymnastic shoes, leather shoes, leisure shoes, sports shoes, slippers, sandals, socks, stockings; headgear, namely, caps, hats, hoods.”

5. As a result of Opposer’s and its predecessor’s use of the BIANCO mark, the BIANCO mark has become famous in the United States long prior to the filing date of Applicant’s trademark application.

6. Applicant's BB BERNARDO BIANCO (and Design) mark incorporates Opposer's BIANCO mark in its entirety and is confusingly similar to Opposer's BIANCO mark. The marks of the parties present similar commercial impressions and are confusingly similar in meaning, appearance and sound.

7. Not only are the marks at issue confusingly similar, but the goods identified by the marks are identical. Applicant states that it intends to use the BB BERNARDO BIANCO (and Design) mark in connection with a variety of clothing products, including footwear. Applicant's footwear is identical to the goods on which Opposer and its predecessors have used and on which Opposer is using the BIANCO mark, and its other clothing products are highly related to Opposer's goods under the BIANCO mark.

8. Upon information and belief, Applicant applied to register the mark BB BERNARDO BIANCO (and Design) with full knowledge of Opposer's rights to the well-known BIANCO mark and with full knowledge of Opposer's existing federal trademark registration for the BIANCO mark.

9. Applicant's application and the presumption of exclusivity that would come from a registration to Applicant of the BB BERNARDO BIANCO (and Design) mark is inconsistent with the prior rights of Opposer in the well-known BIANCO mark and the rights of Opposer flowing from its own federal trademark registration.

10. The use by Applicant of a mark so confusingly similar to Opposer's mark and trade name for identical and highly related goods is likely to create the mistaken impression that Applicant's goods originate from, come from, or are otherwise associated with Opposer's goods and services or that Applicant's goods are endorsed, sponsored, or in some way connected with Opposer. Any use of the mark BB BERNARDO BIANCO (and Design) in connection with the

goods identified in Application Serial No. 76-651,076 is likely to cause confusion or mistake or to deceive the public into the belief that the goods offered under the mark BB BERNARDO BIANCO (and Design) come from or are otherwise authorized or sponsored by Opposer in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. By reason of the foregoing, Opposer will be damaged by the registration of the mark BB BERNARDO BIANCO (and Design) to Applicant.


WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Applicant, Application Serial No. 76-651,076, be denied.

Pursuant to Rule 1.25 of the Trademark Rules of Practice, please charge our deposit account no. 23-0825 for the appropriate filing fee. This paper is filed electronically.

Dated: New York, New York  
June 22, 2007

Respectfully submitted,

FROSS ZELNICK LEHRMAN  
& ZISSU, P.C.

By:   
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Attorneys for Opposer  
Bianco Footwear A/S