

ESTTA Tracking number: **ESTTA268455**

Filing date: **02/24/2009**

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	FENDI ADELE S.r.l.
Granted to Date of previous extension	02/28/2009
Address	Via Flaminia 968 Rome, I-00189 ITALY

Domestic Representative	Keith E. Sharkin Partner King & Spalding LLP 1185 Avenue of the Americas New York, NY 10036 UNITED STATES nytrademarks@kslaw.com Phone:212-556-2100
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Applicant Information

Application No	77389751	Publication date	12/30/2008
Opposition Filing Date	02/24/2009	Opposition Period Ends	02/28/2009
Applicant	PREMIUM HOLDING 2 FLOOR 676 WARREN STREET BROOKLYN, NY 11217 UNITED STATES		

Goods/Services Affected by Opposition


Class 025. All goods and services in the class are opposed, namely: Baseball caps; Boots; Coats; Dresses; Gloves; Hats; Jackets; Jeans; Knit shirts; Knitted caps; Neckties; Shirts; Shoes; Shorts; Skirts; Sneakers; Sport coats; Suits; Sweat shirts; Sweat shorts; Sweaters; T-shirts; Undergarments
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1267539	Application Date	10/29/1976
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Registration Date	02/21/1984	Foreign Priority Date	NONE
Word Mark	FF		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: Perfumes, Toilet Water, Face Soap, Bath Soap, Skin Cleansing and Moisturizing Creams and Lotions, Hair Creams and Lotions, Lipstick, Eye Shadow, Mascara, Rouge, Face Powder, Talcum Powder</p> <p>Class 024. First use: Bed Sheets, Pillow Covers, Bed Covers, Table Cloths, Cloth Napkins, Towels, Fabric Linings Used for Articles of Clothing-Namely, Cloth Coats, Jackets, Hats, Gloves, Shoes, Fur Coats; Handkerchiefs</p> <p>Class 025. First use: Fur Coats, Fur Stoles, Fur Pieces, Rainwear, Cloth Coats, Jackets, Skirts, Trousers, Dresses, Hosiery, Shirts, Blouses, Headwear, Scarves, Foulards, Gloves, Ties, Neckwear, Socks, Stockings, Belts, Swimwear, Lingerie, Shoes, Boots and Slippers</p> <p>Class 026. First use: Belt Buckles, Handbag Clasps, and Zipper Tags and Buttons Used on Items of Clothing</p>		

U.S. Registration No.	1214472	Application Date	06/29/1972
Registration Date	10/26/1982	Foreign Priority Date	NONE
Word Mark	FF		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U001 (International Class 001, 003, 004, 017, 018, 019, 022, 031). First		

	<p>use: Leather and Imitations of Leather Class U003 (International Class 018). First use: Luggage, Trunks and Travelling Bags Class U041 (International Class 018, 022). First use: Umbrellas and Parasols</p>
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U.S. Registration No.	1583578	Application Date	12/16/1988
Registration Date	02/20/1990	Foreign Priority Date	NONE
Word Mark	FF		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: WATCHES, AND PARTS THEREOF		

U.S. Registration No.	1439955	Application Date	12/24/1985
Registration Date	05/19/1987	Foreign Priority Date	08/02/1985
Word Mark	FF FENDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: ATTACHE-CASES, [BACKPACKS,] TOTE BAGS, BRIEFCASES, KEY CASES, CREDIT CARD CASES, GARMENT BAG FOR TRAVEL, HANDBAGS, SHOULDER BAGS, LUGGAGE, PASSPORT CASES, BRIEFCASE TYPE PORTFOLIOS, SUITCASES [, TRUNKS FOR TRAVELLING] [AND UMBRELLAS] Class 024. First use:		

	<p>[BATH LINEN, BED CLOTHES AND LINEN, BEDSPREADS, HANDKERCHIEFS, HOUSEHOLD LINEN, PILLOWCASES, QUILTS, TABLE NAPKINS AND CLOTHS , SILK, WOOLEN, VELVET AND COTTON FABRICS USED IN THE MANUFACTURE OF CLOTHING]</p> <p>Class 025. First use:</p> <p>[BATHING SUITS,] [BATHROBES,] [BEACHWEAR,] BELTS, [BLAZERS, BLOUSES, BLOUSONS,] SHOES, BOOTS [AND SLIPPERS,] [CARDIGANS, COATS,] FUR COATS, [OVERCOATS, DRESSES, GLOVES,] [GOWNS, HATS AND HEADWEAR,] [JACKETS,] JEANS, [JUMPERS,] [RAIN COATS, SCARVES, SHAWLS, SHIRTS, SKIRTS,] [SLEEPWEAR,] [STOCKINGS, SUITS, T-SHIRTS, TIES,] TROUSERS [, VESTS]</p>
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U.S. Registration No.	1845311	Application Date	06/25/1993
Registration Date	07/19/1994	Foreign Priority Date	NONE
Word Mark	FF FENDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use:</p> <p>[eye shadow, foundation cream, eye make-up, eyebrow pencils, lipsticks, cosmetic skin, face and] body lotions, [make-up, face powder, nail varnish, detergent to remove make-up; blusher, eye make-up remover, lip gloss, mascara, nail enamel, nail polish, nail polish remover, night cream, rouge, skin clarifier, skin cleansing cream, skin emollient, skin lightener,] skin moisturizer,[skin toner, hair shampoo, talcum powder, shaving cream]</p>		

Attachments	<p>73104747#TMSN.gif (1 page)(bytes)</p> <p>72428762#TMSN.gif (1 page)(bytes)</p> <p>73769755#TMSN.gif (1 page)(bytes)</p> <p>73575165#TMSN.gif (1 page)(bytes)</p> <p>74407036#TMSN.gif (1 page)(bytes)</p> <p>NOO.PDF (8 pages)(112386 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Keith E. Sharkin/
Name	Keith E. Sharkin
Date	02/24/2009

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

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FENDI ADELE S.R.L., :
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 : Opposer, :
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 : Opposition No.
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 v. :
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 PREMIUM HOLDING, :
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 : Applicant. :
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NOTICE OF OPPOSITION

TO THE COMMISSIONER OF TRADEMARKS:

In the matter of Application Serial No. 77/389,751 for registration of the claimed



trademark **FRESHOUSE** (the "FH Logo") for "baseball caps; boots; coats; dresses; gloves; hats; jackets; jeans; knit shirts; knitted caps; neckties; shirts; shoes; shorts; skirts; sneakers; sport coats; suits; sweat shirts; sweat shorts; sweaters; t-shirts; undergarments" in International Class 25 filed on February 6, 2008 by Premium Holding, a New York corporation located at 676 Warren Street, Brooklyn, New York 11217, which was published in the Official Gazette of December 30, 2008, Fendi Adele S.r.L., a limited liability company located at Via Flaminia 968, Rome, Italy, believes that it would be damaged by such registration and hereby opposes the same.

The grounds of opposition are as follows:

1. Opposer is a well known Italian design company famous for its handbags, clothing, furs, and shoes. Opposer also sells, among other things, cosmetics, luggage, leather products, jewelry, and eyeglasses.





2. Since at least as early as 1976, Opposer has used the famous design logo (“the Fendi Logo”) in interstate commerce on or in connection with clothing products. Opposer has continuously used said mark to identify and distinguish Opposer’s goods from those of others. The Opposer has advertised and promoted its products bearing the Fendi Logo making clear and prominent use of that trademark to identify and distinguish Opposer’s products from those sold by others. As a result of such advertising and promotion, Opposer has enjoyed extensive distribution and sales of its goods offered and sold under the Fendi Logo.




3. Long prior to the filing date of Applicant’s intent-to-use application, the Fendi Logo has been and continues to be used by Opposer for the purposes of identifying and distinguishing Opposer’s products from the goods of others and the trade and the consuming public have come to know and recognize said trademark as identifying the goods of Opposer as the source thereof exclusively.

4. As a result of the care and skill exercised by Opposer in the conduct of its business, the uniform standards of high quality of goods offered and sold under the Opposer’s Fendi Logo, the extensive advertising and promotion of the Fendi Logo, and the widespread goods offered under the Fendi Logo and the public acceptance thereof, goods bearing Opposer’s Fendi Logo have become well and favorably known by the trade and

public with the Fendi Logo identifying and distinguishing Opposer as the exclusive source or origin of Opposer's goods promoted and sold under said mark. Opposer's mark is strong and has become famous, symbolizing and embodying goodwill of inestimable value.


5. Opposer is the owner of the following registrations on the Principal Register in the United States Patent and Trademark Office:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods</u>
	1,267,539	February 21, 1984	Perfumes, toilet water, face soap, bath soap, skin cleansing and moisturizing creams and lotions, hair creams and lotions, lipstick, eye shadow, mascara, rouge, face powder, talcum powder. Fur coats, fur stoles, fur pieces, rainwear, cloth coats, jackets, skirts, trousers, dresses, hosiery, shirts, blouses, headwear, scarves, foulards, gloves, ties, neckwear, socks, stockings, belts, swimwear, lingerie, shoes, boots and slippers.
	1,214,472	October 26, 1982	Leather and imitations of leather. Luggage, trunks and traveling bags. Umbrellas and parasols.

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Goods</u>
	1,583,578	February 20, 1990	Watches, and parts thereof.
	1,439,955	May 19, 1987	Attache-cases, tote bags, briefcases, key cases, credit card cases, garment bag for travel, handbags, shoulder bags, luggage, passport cases, briefcase type portfolios, suitcases. Belts, shoes, boots, fur coats, jeans, trousers.
	1,845,311	July 19, 1994	Body lotions, skin moisturizer.

Said registrations are valid and subsisting, in full force and effect, have not been cancelled, and have become incontestable by operation of law.

6. Applicant's alleged mark contains a stylized design element consisting of the letters "FH" with "Freshouse" below the letters. The letters are positioned in such a way as to be a colorable imitation of the famous Fendi Logo.

7. By the application herein opposed, Applicant seeks to register  as a trademark for "baseball caps; boots; coats; dresses; gloves; hats; jackets; jeans; knit

shirts; knitted caps; neckties; shirts; shoes; shorts; skirts; sneakers; sport coats; suits; sweat shirts; sweat shorts; sweaters; t-shirts; undergarments.”

8. Applicant’s clothing products, which are to be offered under its alleged FH Logo, are virtually identical to the goods on or in connection with which the Opposer has long used and continues to use the Fendi Logo.

9. The goods covered by the application for registration of the alleged FH Logo will be encountered by the same or similar class of purchasers as those who are interested in or familiar with the goods promoted, offered and provided by Opposer under the Fendi Logo.

10. The goods on which Applicant’s claimed mark is intended to be used and the goods on or in connection with which Opposer has used and continues to use its Fendi Logo will be advertised, promoted, offered, and distributed through the same or similar channels of trade to the same or similar classes of purchasers and the use of the same or a similar mark in connection with such goods will be likely to cause confusion, or to cause mistake, or to deceive purchasers, all to the damage of Opposer.

11. Applicant’s claimed FH Logo so closely resembles Opposer’s registered Fendi Logo as to be likely, when applied to Applicant’s goods, to cause confusion, or to cause mistake, or to deceive purchasers, all to the damage of Opposer.

12. Applicant’s claimed FH Logo so closely resembles Opposer’s Fendi Logo so that purchasers will mistakenly believe that Opposer is the source of Applicant’s goods if and when Applicant uses its claimed mark or that Opposer has authorized, sponsored, approved of, or in some manner associated itself with goods of Applicant thereby causing a likelihood of confusion, all to the damage of Opposer.

13. Opposer will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in the confusing and misleading use of Applicant's mark and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer to the well known Fendi Logo.

14. As alleged above, Opposer adopted and used and has continued to use the Fendi Logo in interstate commerce long before Applicant filed the application for the FH Logo. The Fendi Logo has since become a famous mark with strong and distinctive character qualifying for protection under Section 13 (15 U.S.C. § 1063 as amended) and Section 43(c) (15 U.S.C. § 1125(c)) of the Lanham Act.

15. Opposer's Fendi Logo is a famous mark within the meaning of Section 43(c) of the Trademark Act of 1946, as amended, and the use by Applicant of the FH Logo would cause dilution of the distinctive quality of the Opposer's mark under Section 43(c).


16. By reason of the foregoing, Opposer believes it will be damaged by the registration of Applicant's claimed trademark.

WHEREFORE, Opposer requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

Respectfully submitted,

KING & SPALDING LLP
Attorneys for Opposer

Dated: February 24, 2009

By: 
Keith E. Sharkin
Clark W. Lackert

1185 Avenue of the Americas
New York, New York 10036
(212) 556-2100

CERTIFICATE OF SERVICE

This is to certify, in accordance with Rule 2.101(b) of the Trademark Rules of Practice, that I have this day served the foregoing Notice of Opposition on the Applicant, by causing a true and correct copy thereof to be deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to the Applicant as follows:

Mr. Robert Thompson
Premium Holding
676 Warren Street, 2nd Floor
Brooklyn, NY 11217

This 24th day of February, 2009



Keith E. Sharkin