

ESTTA Tracking number: **ESTTA419289**

Filing date: **07/12/2011**

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	Macy's, Inc.
Granted to Date of previous extension	07/13/2011
Address	7 West Seventh Street Cincinnati, OH 45202 UNITED STATES

Attorney information	Holly Pekowsky, Esq. Amster, Rothstein & Ebenstein LLP 90 Park Avenue New York, NY 10016 UNITED STATES ptodocket@arelaw.com Phone:212-336-8000
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Applicant Information

Application No	85137183	Publication date	03/15/2011
Opposition Filing Date	07/12/2011	Opposition Period Ends	07/13/2011
Applicant	Strategic Marks, LLC 25 Ridgeview Irvine, CA 92603 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Retail department store and on-line retail department store services; retail and on-line retail clothing boutiques; retail and on-line retail clothing stores; retail and on-line retail apparel stores; retail and on-line retail store services featuring clothing and fashion accessories

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	lack of bona fide intent to use mark

Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	JORDAN MARSH
Goods/Services	retail department store services

Attachments	JORDAN MARSH_Opposition.pdf (9 pages)(397571 bytes)
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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 Overnight Courier on this date.

Signature	/Holly Pekowsky/
Name	Holly Pekowsky, Esq.
Date	07/12/2011

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of

*Application Serial No. 85/137,183
of Strategic Marks, LLC
for the mark JORDAN MARSH
Filed on September 24, 2010*

Published for Opposition on March 15, 2011

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MACY'S, INC.,	:	Opposition No.
	:	
Opposer,	:	NOTICE OF OPPOSITION
	:	
v.	:	
	:	
STRATEGIC MARKS, LLC,	:	
	:	
Applicant.	:	
	:	

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In the matter of U.S. Trademark Application Serial No. 85/137,183, filed on September 24, 2010 by Strategic Marks, LLC (“Applicant”) and published for opposition in the March 15, 2011 issue of the Official Gazette of the United States Patent and Trademark Office, for the service mark JORDAN MARSH as applied to retail department store and on-line retail department store services; retail and on-line retail clothing boutiques; retail and on-line retail clothing stores; retail and on-line retail apparel stores; retail and on-line retail store services featuring clothing and fashion accessories (the “Infringing Application”).

Macy’s Inc., a Delaware corporation maintaining its principal place of business at 7 West Seventh Street, Cincinnati, Ohio 45202 (“Opposer”), believes that it will be

damaged by the registration of the JORDAN MARSH mark (the “Infringing Mark”) and hereby opposes the same.

As grounds for the opposition, Opposer, by and through its attorneys, alleges as follows:

FIRST CLAIM
LIKELIHOOD OF CONFUSION

1. Opposer owns the trademark and service mark JORDAN MARSH in connection with retail department store services and clothing and related goods and services (the “JORDAN MARSH Mark”).

2. Goods and services provided under the JORDAN MARSH Mark have been widely advertised to the purchasing public and the trade in the United States of America.

3. The JORDAN MARSH Mark, by reason of the high quality retail and other services provided under the Mark and by reason of the style and design excellence and quality of workmanship of the wearing apparel and related goods sold under the Mark, has come to be known to the purchasing public throughout the United States of America as representing products and services of the highest quality, which are provided under the best merchandising and customer service conditions. As a result thereof, the JORDAN MARSH Mark and the goodwill associated therewith are of inestimable value to Opposer.

4. By virtue of the wide renown and high esteem acquired by the JORDAN MARSH Mark, the JORDAN MARSH Mark has developed a secondary meaning, fame and a significance in the minds of the purchasing public, and products and services offered

under the Mark are immediately identified by the purchasing public with a single, albeit anonymous source, namely, Opposer.

5. Although Opposer is not currently offering goods or services under the JORDAN MARSH Mark, the JORDAN MARSH Mark has not been abandoned, Opposer maintains a bona fide intention to resume use, and Opposer continues to enjoy secondary meaning and residual goodwill such that the Mark is still associated with a single, albeit anonymous source, namely, Opposer.

6. Upon information and belief, long after Opposer's predecessor-in-interest to the JORDAN MARSH Mark commenced use of the Mark in conjunction with wearing apparel and retail store services and related goods and services, and long after the JORDAN MARSH Mark acquired secondary meaning, Applicant applied to register, on an intent-to-use basis, the Infringing Mark in connection with services identical to those for which the JORDAN MARSH Mark has been used, namely, retail department store services, as well as closely related services such as online retail store services.

7. Upon information and belief, no one associated with Applicant is named JORDAN MARSH or has JORDAN or MARSH as a first or last name.

8. The Infringing Mark is confusingly similar to Opposer's JORDAN MARSH Mark.

9. Applicant's application and/or use of the Infringing Mark, in view of Opposer's rights in the JORDAN MARSH Mark, is likely to cause confusion, to cause mistake or to deceive.

10. Upon information and belief, Applicant was well aware of the JORDAN MARSH Mark prior to filing the Infringing Application, and selected the Infringing Mark with the specific intent to create confusion.

11. Accordingly, it is Opposer's belief that if Applicant is granted the registration opposed herein, Opposer will suffer irreparable harm and damage.

SECOND CLAIM
FALSELY SUGGEST A CONNECTION

12. Opposer repeats and realleges the allegations of the preceding Paragraphs as if fully set forth herein.

13. Registration of the Infringing Mark should be refused since the Mark falsely suggests a connection with "persons, living or dead," pursuant to Section 2(a) of the Lanham Act.

14. In particular, the Infringing Mark falsely suggests a connection with Eben Jordan ("Mr. Jordan") and Benjamin L. Marsh ("Mr. Marsh"), whose last names comprise the JORDAN MARSH Mark.

15. Mr. Jordan and Mr. Marsh each possessed a property right to commercially exploit their respective last names and did so commercially exploit such right throughout the United States during their lifetime by, *inter alia*, using the JORDAN MARSH Mark in connection with their well known retail stores and related clothing.

16. Opposer owns an exclusive property right to commercially exploit Mr. Jordan and Mr. Marsh's names in connection with the JORDAN MARSH Mark.

17. By the efforts of Mr. Jordan and Mr. Marsh, during their lifetime to commercially exploit the JORDAN MARSH Mark, and the subsequent efforts of their

successors-in-interest, and the tremendous success of retail store services and clothing offered under the JORDAN MARSH Mark, such mark/name now occupies a permanent place in American history.

18. The Infringing Mark is identical to the composite of Mr. Jordan and Mr. Marsh's names, and would be recognized as such, in that it points uniquely and unmistakably to Mr. Jordan and Mr. Marsh. Neither Mr. Jordan or Mr. Marsh, nor Opposer, who has the right to commercially exploit the JORDAN MARSH Mark, is connected with the activities performed by Applicant under the Infringing Mark. The fame and reputation of the JORDAN MARSH Mark is such that, when the Infringing Mark is used with Applicant's services, a connection with Mr. Jordan and Mr. Marsh and/or Opposer would be presumed.

19. The Infringing Mark falsely suggests a connection with Opposer and/or Mr. Jordan and Mr. Marsh.

20. The Infringing Mark is confusingly similar to Mr. Jordan and Mr. Marsh's name and would be taken by the public as an endorsement by Mr. Jordan and Mr. Marsh's successors-in-interest and Opposer of Applicant's services used in connection with the Infringing Mark. Further, any defect, objection or fault found with Applicant's services provided under the Infringing Mark would necessarily reflect upon and seriously injure Mr. Jordan and Mr. Marsh's and/or Opposer's reputation.

21. Upon information and belief, Applicant was well aware of the JORDAN MARSH Mark prior to filing the Infringing Application, and selected the Infringing Mark with the specific intent to falsely suggest a connection with Mr. Jordan and Mr. Marsh and/or Opposer.

22. Accordingly, it is Opposer's belief that if Applicant is granted registration of the Application opposed herein, Opposer will suffer irreparable harm and damage.

THIRD CLAIM
LACK OF BONA FIDE INTENTION TO USE MARK

23. Opposer repeats and realleges the allegations of the preceding Paragraphs as if fully set forth herein.

24. Registration of the Infringing Mark should be refused since Applicant lacks a bona fide intention to use the Infringing Mark.

25. Applicant's lack of a bona fide intent to use the Infringing Mark is demonstrated, by way of example only, by the fact that Applicant filed an excessive number of other intent-to-use Applications for the identical services covered by the Infringing Application.

26. In particular, on the same day that Applicant filed the Infringing Application (i.e., September 24, 2010), Applicant filed **eight** other Applications for different marks for the exact same services covered by the Infringing Application - i.e., retail department store and on-line retail department store services; retail and on-line retail clothing boutiques; retail and on-line retail clothing stores; retail and on-line retail apparel stores; retail and on-line retail store services featuring clothing and fashion accessories:

MAY COMPANY	Serial No. 85/137,181
ROBINSON'S	Serial No. 85/137,185
JOSEPH MAGNIN	Serial No. 85/137,187
THE BROADWAY	Serial No. 85/137,191

THE BON MARCHE	Serial No. 85/137,193
ABRAHAM AND STRAUS	Serial No. 85/137,194
FILENE'S	Serial No. 85/137,196
GOTTSCHALKS	Serial No. 85/137,197

27. Moreover, the day before Applicant filed the Infringing Application and the aforementioned eight other Applications (i.e., September 23, 2010), Applicant filed an Application for yet another mark for the same services:

BULLOCK'S DEPARTMENT STORE	Serial No. 85/136,164
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28. All of the marks for which Applicant applied on September 23 and 24, 2010 (including the Infringing Mark) are well known if not famous department store brands.

29. Applicant's lack of a bona fide intent to use the Infringing Mark is further illustrated by the fact, upon information and belief, Applicant is not currently providing, and has never provided the services covered by the Infringing Application and the nine other intent-to-use Applications - i.e., retail department store and on-line retail department store services; retail and on-line retail clothing boutiques; retail and on-line retail clothing stores; retail and on-line retail apparel stores; retail and on-line retail store services featuring clothing and fashion accessories.

30. Upon information and belief, Applicant is trafficking in trademarks - i.e., reserving what Applicant perceives to be desirable names (including, without limitation, the Infringing Mark) with the intent to sell or license them to others, and therefore, does not have a bona fide intent to use the Infringing Mark.

31. Accordingly, it is Opposer's belief that if Applicant is granted registration of the Application opposed herein, Opposer will suffer irreparable harm and damage.

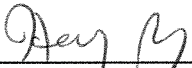
* * *

WHEREFORE, Opposer respectfully requests that the mark shown in U.S. Trademark Application Serial No. 85/137,183 be refused registration and that this Opposition be sustained.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Opposer
90 Park Avenue
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(212) 336-8000

Dated: New York, New York
July 12, 2011

By: 

Chester Rothstein
Holly Pekowsky

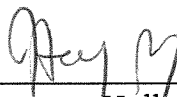
CERTIFICATE OF SERVICE

The undersigned hereby certifies that she is one of the attorneys for Opposer in the above-captioned Opposition proceeding and that on the date which appears below, caused a copy of the foregoing NOTICE OF OPPOSITION to be served on Applicant by Federal Express addressed as follows:

Ellia Kassoff
Strategic Marks, LLC
25 Ridgeview
Irvine CA 92603

with a courtesy copy, via Federal Express to:

Chris Ditico, Esq.
Raj Abhyanker, P.C.
1580 W. El Camino Real, Suite 8
Mountain View, CA 94040



Holly Pekowsky

Dated: New York, New York
July 12, 2011