

ESTTA Tracking number: **ESTTA485483**

Filing date: **07/25/2012**

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	EMPIRE STATE BUILDING COMPANY LLC
Granted to Date of previous extension	07/29/2012
Address	Malkin Holdings LLC, 60 East 42nd Street New York, NY 10165 UNITED STATES

Attorney information	Maya L. Tarr Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES trademark@cll.com, wmb@cll.com, mxt@cll.com Phone:212-790-9200
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Applicant Information

Application No	85291507	Publication date	01/31/2012
Opposition Filing Date	07/25/2012	Opposition Period Ends	07/29/2012
Applicant	Empire Movers, LLC 6736 80th Street Middle Village, NY 11379 UNITED STATES		

Goods/Services Affected by Opposition

Class 039. First Use: 2008/05/11 First Use In Commerce: 2008/05/11 All goods and services in the class are opposed, namely: Furniture moving; moving and storage of household goods; office and residential moving company services
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Grounds for Opposition


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.	2411972	Application Date	05/13/1999
Registration Date	12/12/2000	Foreign Priority Date	NONE
Word Mark	EMPIRE STATE BUILDING		

Design Mark	EMPIRE STATE BUILDING		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing		

U.S. Registration No.	2413667	Application Date	05/13/1999
Registration Date	12/19/2000	Foreign Priority Date	NONE
Word Mark	EMPIRE STATE BUILDING		
Design Mark	EMPIRE STATE BUILDING		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 REAL ESTATE SERVICES, NAMELY THE MANAGEMENT AND LEASING OF REAL ESTATE		

U.S. Registration No.	2429297	Application Date	05/13/1999
Registration Date	02/20/2001	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of the shape of the exterior of a skyscraper with a pointed, spindled top.		
Goods/Services	Class 036. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 REAL ESTATE SERVICES, NAMELY THE MANAGEMENT AND LEASING OF REAL ESTATE		

U.S. Registration No.	2430828	Application Date	05/13/1999
Registration Date	02/27/2001	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of the shape of the exterior of a skyscraper with a pointed, spindled top.		
Goods/Services	Class 041. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 ENTERTAINMENT SERVICES, NAMELY, PROVIDING OBSERVATION DECKS IN A SKYSCRAPER FOR PURPOSES OF SIGHTSEEING		

Attachments	75705741#TMSN.gif (1 page)(bytes) 75705740#TMSN.gif (1 page)(bytes) 75705772#TMSN.gif (1 page)(bytes) 75705756#TMSN.gif (1 page)(bytes) EMPIRE MOVERS and Design NOO.pdf (5 pages)(28568 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 First Class Mail on this date.

Signature	/Maya L. Tarr/
Name	Maya L. Tarr
Date	07/25/2012

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

In re Application Serial No. 85/291,507
Filed: April 11, 2011
For Mark: EMPIRE MOVERS and Design
Published in the Official Gazette: January 31, 2012

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EMPIRE STATE BUILDING COMPANY L.L.C.,	:	Opposition No.
	:	
Opposer,	:	
	:	
v.	:	<u>NOTICE OF OPPOSITION</u>
	:	
EMPIRE MOVERS, LLC,	:	
	:	
Applicant.	:	
	:	
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Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer, Empire State Building Company L.L.C. (“Opposer”), a New York limited liability company with offices at c/o Malkin Holdings, 60 East 42nd Street, New York, New York 10165, believes that it will be damaged by registration of the following EMPIRE MOVERS and Design mark:



(“Applicant’s Mark”) for “Furniture moving; moving and storage of household goods; office and residential moving company services” in International Class 39 (“Applicant’s Services”), as

shown in Application Serial No. 85/291,507 (the “Application”), and having been granted extensions of time to oppose up to and including July 29, 2012, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Since long prior to May 11, 2008, Applicant’s claimed first use date, Opposer, its predecessors, and its affiliated and related entities, and/or licensees have used the word mark EMPIRE STATE BUILDING and various marks depicting the visual equivalent of the world-renowned Empire State Building, which is located in New York City, including, without limitation, the following distinctive stylizations:



, alone or with other word, letter and/or design elements (“Opposer’s Empire State Building Marks”), in connection with real estate services, entertainment services, and a wide variety of goods and services.

2. Opposer owns U.S. federal registrations for Opposer’s Empire State Building Marks in International Classes 36 and 41, namely, Registration Nos. 2411972, 2413667, 2429297 and 2430828, which are all incontestable.

3. Since long prior to May 11, 2008, Applicant’s claimed first use date, Opposer, its predecessors, and their affiliated and related entities, and/or licensees have promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer’s Empire State Building Marks, including, but not limited to, real estate services, entertainment services and a wide variety of goods and services.

4. Opposer has built up highly valuable goodwill in Opposer's Empire State Building Marks, and said goodwill has become closely and uniquely identified and associated with Opposer.

5. On April 11, 2011, Applicant filed the Application for Applicant's Mark for Applicant's Services, claiming a first use date of May 11, 2008.

6. Upon information and belief, Applicant did not use Applicant's Mark in United States commerce for any of Applicant's Services covered in the Application prior to its claimed first use date of May 11, 2008.

7. A prominent feature of Applicant's Mark is the image of the Empire State Building.

8. The services covered by the Application are closely related to the goods offered and services rendered in connection with Opposer's Empire State Building Marks.

9. Applicant's Mark so resembles Opposer's Empire State Building Marks as to be likely, when used in connection with Applicant's Services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's Services have their origin with Opposer and/or that such services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's Mark.

10. Opposer's Empire State Building Marks are distinctive and famous and were so prior to May 11, 2008, Applicant's claimed first use date of Applicant's Mark for Applicant's Services. Registration of Applicant's Mark will also injure Opposer by causing a likelihood of dilution by blurring of the distinctive quality of Opposer's Empire State Building Marks.

11. Applicant's Mark violates Section 2(a) of the Lanham Act in that it would falsely suggest a connection between Applicant and Opposer. More specifically, Applicant's Mark violates Section 2(a) of the Lanham Act because (a) Applicant's Mark contains as an important element of its mark a design of Opposer's famous Empire State Building previously used by Opposer; (b) Applicant's Mark would be recognized as being associated with the Empire State Building in that Applicant's Mark points uniquely and unmistakably to that building; (c) Opposer is not connected with the activities performed by Applicant under Applicant's Mark; and (4) Opposer's identity is of sufficient fame or reputation that a connection with Opposer would be presumed when Applicant's Mark is used with Applicant's Services.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Mark and requests that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding William M. Borchard, Mary L. Kevlin, and Maya L. Tarr (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Mary L. Kevlin, Esq. at the address listed below.

Dated: New York, New York
July 25, 2012

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Maya L. Tarr/

William M. Borchard
Mary L. Kevlin
Maya L. Tarr

1133 Avenue of the Americas
New York, New York 10036
(212)790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on July 25, 2012, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant, Empire Movers, LLC, 6736 80th Street, Middle Village, New York 11379-2925 and a courtesy copy to David Giampietro at davidgiampietro@gmail.com.

/Maya L. Tarr/
Maya L. Tarr