

ESTTA Tracking number: **ESTTA575287**

Filing date: **12/09/2013**

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	LeVian Corp
Granted to Date of previous extension	12/08/2013
Address	235 Great Neck Road Great Neck, NY 11021 UNITED STATES

Attorney information	Joshua M. Dalton, Esq. Bingham McCutchen LLP One Federal Street Boston, MA 02110 UNITED STATES joshua.dalton@bingham.com, lawrence.stanley@bingham.com Phone:617-951-8000
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Applicant Information

Application No	85858799	Publication date	06/11/2013
Opposition Filing Date	12/09/2013	Opposition Period Ends	12/08/2013
Applicant	Anaya Gems, Inc. 5th Floor Long Island City, NY 11101 NY		

Goods/Services Affected by Opposition

Class 014. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Gold, Silver and Bronze Jewelry, namely, pendants, earrings, rings, bracelets, necklaces, pins and anklets

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.	3407745	Application Date	04/23/2007
Registration Date	04/08/2008	Foreign Priority Date	NONE
Word Mark	LE VIAN CHOCOLATIER		

Design Mark	LE VIAN CHOCOLATIER		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2006/11/00 First Use In Commerce: 2006/12/00 Jewelry, watches, jewelry watches, jewelry chains, jewelry pins, jewelry amulets and jewelry rings		

U.S. Registration No.	3641551	Application Date	04/16/2007
Registration Date	06/23/2009	Foreign Priority Date	NONE
Word Mark	CHOCOLATE DIAMONDS		
Design Mark	CHOCOLATE DIAMONDS		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2000/10/00 First Use In Commerce: 2001/10/00 Jewelry, watches, timepieces, jewelry watches, jewelry chains, jewelry pins, jewelry amulets and jewelry rings all madein whole or in part of diamonds		

U.S. Registration No.	3585082	Application Date	04/23/2007
Registration Date	03/10/2009	Foreign Priority Date	NONE
Word Mark	LE VIAN CHOCOLATE DIAMONDS		
Design Mark	LE VIAN CHOCOLATE DIAMONDS		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2000/10/00 First Use In Commerce: 2001/10/00 Jewelry, watches, timepieces, jewelry watches, jewelry chains, jewelry pins, jewelry amulets and jewelry rings all madein whole or in part of diamonds		

U.S. Registration No.	4300102	Application Date	12/21/2011
Registration Date	03/12/2013	Foreign Priority Date	NONE
Word Mark	CHOCOLATE QUARTZ		

Design Mark	<h1>CHOCOLATE QUARTZ</h1>		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2009/10/02 First Use In Commerce: 2009/10/02 Bracelets; Earrings; Gems; Jewelry; Necklaces; Pendants; Rings; Watches		

U.S. Registration No.	4315623	Application Date	12/21/2011
Registration Date	04/09/2013	Foreign Priority Date	NONE
Word Mark	CHOCOLATE PEARLS		
Design Mark	<h1>CHOCOLATE PEARLS</h1>		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2007/08/14 First Use In Commerce: 2007/08/14 Pearl bracelets; pearl earrings; gems in the nature of pearls; pearl jewelry; pearl necklaces; pearl pendants; pearl rings; pearl watches		

U.S. Registration No.	4367919	Application Date	11/20/2012
Registration Date	07/16/2013	Foreign Priority Date	NONE
Word Mark	CHOCOLATE WEDDING		

Design Mark	<h1>Chocolate Wedding</h1>
Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 2012/03/14 First Use In Commerce: 2012/03/14 Bracelets; Earrings; Gems; Jewelry; Necklaces; Pendants; Pins being jewelry; Rings; Watches

Attachments	76675853#TMSN.gif(bytes) 76675559#TMSN.gif(bytes) 76675849#TMSN.gif(bytes) 85501111#TMSN.jpeg(bytes) 85501156#TMSN.jpeg(bytes) 85784329#TMSN.jpeg(bytes) 12092013 Notice of Opposition - Chocolate Sensations.pdf(52919 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	/s/ Joshua M. Dalton
Name	Joshua M. Dalton
Date	12/09/2013

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

)	
In re Application Serial No. 85/858799)	
Published in the Official Gazette of June 11, 2013)	
)	
Mark: CHOCOLATE SENSATIONS)	
)	
Application Filing Date: February 25, 2013)	
)	
Le Vian Corp.,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
Anaya Gems, Inc.,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer Le Vian Corp. (“Opposer”), believes that it will be damaged by the issuance of a registration for the mark CHOCOLATE SENSATIONS (“Applicant's Mark”), with respect to the goods in international class 14, as applied for in Application Serial No. 85/858799, filed by Anaya Gems, Inc. (“Applicant”), and hereby opposes the same.

As grounds for this Opposition, Opposer alleges as follows:

1. Opposer Le Vian Corp. is a company organized under the laws of New York, with a principal place of business at 235 Great Neck Road, Great Neck, NY 11021.
2. Anaya Gems, Inc., is, upon information and belief, a corporation organized and existing under the laws of New York, with a principal place of business at 3100 47th Avenue, 5th Floor, Long Island City, NY 11101.

3. Commencing at least as early as 2000, long prior to February 25, 2013 (the filing date of Applicant's Application Serial No. 85/858799), Opposer adopted and continuously used the name and mark CHOCOLATE DIAMONDS and variants thereof in interstate commerce in connection with jewelry, watches, timepieces, jewelry watches, jewelry chains, jewelry pins, jewelry amulets, and jewelry rings.

4. Since at least 2006, also long prior to the February 25, 2013 filing date of Applicant's Application Serial No. 85/858799, Opposer adopted and continuously used the name and mark CHOCOLATIER and variants thereof in interstate commerce in connection with jewelry, watches, jewelry watches, jewelry chains, jewelry pins, jewelry amulets, and jewelry rings.

5. Since at least 2007, also long prior to the February 25, 2013 filing date of Applicant's Application Serial No. 85/858799, Opposer adopted and continuously used the name and mark CHOCOLATE PEARLS and variants thereof in interstate commerce in connection with pearl bracelets, pearl earrings, gems in the nature of pearls, pearl jewelry, pearl necklaces, pearl pendants, pearl rings, and pearl watches.

6. Since at least 2009, also long prior to the February 25, 2013 filing date of Applicant's Application Serial No. 85/858799, Opposer adopted and continuously used the name and mark CHOCOLATE QUARTZ and variants thereof in interstate commerce in connection with bracelets, earrings, gems, jewelry, necklaces, pendants, rings and watches.

7. Since at least 2012, also long prior to the February 25, 2013 filing date of Applicant's Application Serial No. 85/858799, Opposer adopted and continuously used the name and mark CHOCOLATE WEDDING and variants thereof in interstate commerce in

connection with bracelets, earrings, gems, jewelry, necklaces, pendants, pins being jewelry, rings and watches.

8. Since its initial use of the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof, Opposer has invested considerable time, money, and effort in advertising and promoting its goods under such names and marks.

9. Opposer has extensively used, advertised, promoted and offered for sale to the public, through various channels of trade and commerce, Opposer's goods in association with the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof, with the result that Opposer's customers and the public in general have come to know and recognize the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof, and associate the same with Opposer and/or the goods sold and provided by Opposer.

10. In addition to Opposer's association with the mark CHOCOLATE through its use of the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, and CHOCOLATE WEDDING, Opposer has also developed a close association with the name and mark CHOCOLATE on its goods through its use of other marks that incorporate CHOCOLATE, including without limitation PAVE CHOCOLATES, SWEET CHOCOLATE, CHUNKY CHOCOLATES, CHOCOLATE TRUFFLES, and variants thereof.

11. As a result of Opposer's extensive use and promotion of the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof, and its extensive communications, sales and provision of goods under such names and marks, the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof have become widely known in Opposer's field, and indeed have become famous.

12. Moreover, since its initial use of the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof, Opposer has also invested considerable time, money, and effort in building up the goodwill associated with such names and marks.

13. By virtue of these efforts, Opposer has developed substantial recognition and goodwill in connection with the sale and provision of its goods under the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof.

14. In view of Opposer's use and close association with the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof, Opposer has used and owns common law rights in such names and marks, which significantly pre-date Applicant's filing date of February 25, 2013.

15. Indeed, Opposer owns a trademark registration for the mark LE VIAN CHOCOLATIER (Registration No. 3407745) for use on the following goods in international

class 14: jewelry, watches, jewelry watches, jewelry chains, jewelry pins, jewelry amulets, and jewelry rings.

16. Opposer also owns trademark registrations for the marks CHOCOLATE DIAMONDS (Registration No. 3641551) and LE VIAN CHOCOLATE DIAMONDS (Registration No. 3585082) for use in connection with the following goods in international class 14: jewelry, watches, timepieces, jewelry watches, jewelry chains, jewelry pins, jewelry amulets, and jewelry rings all made in whole or in part of diamonds.

17. Opposer also owns trademark registrations for the marks CHOCOLATE QUARTZ (Registration No. 4300102) for use in connection with bracelets, earrings, gems, jewelry, necklaces, pendants, rings, and watches; CHOCOLATE PEARLS (Registration No. 4315623) for use in connection with pearl bracelets, pearl earrings, gems in the nature of pearls, pearl jewelry, pearl necklaces, pearl pendants, pearl rings, and pearl watches; and CHOCOLATE WEDDING (Registration No. 4367919) for use in connection with bracelets, earrings, gems, jewelry, necklaces, pendants, pins being jewelry, rings, and watches.

18. By reason of these registrations on the Principal Register, Opposer's LE VIAN CHOCOLATIER mark, CHOCOLATE DIAMONDS mark, LEVIAN CHOCOLATE DIAMONDS mark, CHOCOLATE QUARTZ mark, CHOCOLATE PEARLS mark, and CHOCOLATE WEDDING mark, as used by Opposer in connection with its goods, are presumed to constitute distinctive marks, which serve uniquely to identify Opposer as the source of its goods.

19. Notwithstanding Opposer's prior rights in and to the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof and Opposer's close association

with the name and mark CHOCOLATE, Applicant, a competitor of Opposer, seeks to register the mark CHOCOLATE SENSATIONS in connection with identical categories of goods that Opposer provides.

20. Specifically, on or about February 25, 2013, Applicant filed an intent-to-use application, Application No. 85/858799 (“Applicant’s Application”), to register the mark CHOCOLATE SENSATIONS in international class 14 for use in connection with, “Gold, Silver and Bronze Jewelry, namely, pendants, earrings, rings, bracelets, necklaces, pins and anklets” (“Applicant's Goods”).

21. Upon information and belief, Applicant’s Application was filed with the PTO with knowledge of Opposer’s prior use of and rights in the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof on and with the same or similar or related goods.

22. Applicant’s use of a confusingly similar mark in connection with the same or similar or related goods is likely to cause significant confusion as to source, sponsorship, and affiliation.

GROUND I – LIKELIHOOD OF CONFUSION

23. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 22 hereof as if fully set forth herein.

24. Applicant’s Mark, CHOCOLATE SENSATIONS, when used in connection with Applicant’s Goods, is likely to cause confusion, deception, and mistake with Opposer’s names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof because

Applicant's Mark is virtually the same as Opposer's names and marks, sharing the same dominant and distinctive word CHOCOLATE for use on jewelry, and is used on and with goods that are the same as or similar or related to the goods sold and provided by Opposer under its names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof.

25. Moreover, Applicant and Opposer are competitors, and consequently the goods provided by the parties in connection with their respective marks will both be offered in the same and/or similar channels of trade, and to the same and/or similar customers.

26. Registration by Applicant of the Applicant's Mark for use in connection with Applicant's Goods would seriously damage Opposer and should be refused because use and/or registration of the Applicant's Mark is likely to cause confusion in the minds of the public and mislead or deceive purchasers. The public, upon seeing or learning of Applicant's Mark used in connection with Applicant's Goods, would believe that such goods originate with, or have some connection with, Opposer, and Opposer avers that Applicant's use of said mark interferes with Opposer's exclusive rights to use its names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof.

27. Applicant's use of Applicant's Mark will and does impede Opposer in the free use of the names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof; and registration of Applicant's Mark for use in connection with Applicant's Goods will seriously damage Opposer under 15 U.S.C. § 1052(d).

28. Registration of Applicant's Mark for use in connection with Applicant's Goods would be prima facie evidence of rights of Applicant under 15 U.S.C. § 1057(b), to the detriment of Opposer's rights in its names and marks CHOCOLATE DIAMONDS, CHOCOLATIER, CHOCOLATE QUARTZ, CHOCOLATE PEARLS, CHOCOLATE WEDDING, and variants thereof.

29. Pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the infringing use of its CHOCOLATE SENSATIONS mark sought to be registered, and will give colorable exclusive statutory rights to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

30. For the reasons set forth herein, pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes that registration by Applicant of Applicant's Mark for use in connection with Applicant's Goods would seriously damage Opposer and should be refused because use and/or registration of Applicant's Mark is likely to cause customer confusion as to source, origin, affiliation, or sponsorship between Applicant and Opposer and/or their respective goods.

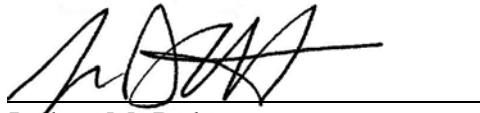
WHEREFORE, Opposer, Le Vian Corp., believes and avers that it will be damaged by said registration and prays that registration of Applicant's Mark for use in connection with the Class 14 goods shown in Application Serial No. 85/858799, filed by Applicant, be refused, and that this Opposition be sustained.

The filing fee for this Notice of Opposition in the amount of \$300.00 is enclosed, for Opposer's opposition to registration of the mark CHOCOLATE SENSATIONS.

Please recognize as attorneys for Opposer in this proceeding Joshua M. Dalton, Rachelle A. Dubow, and Lawrence T. Stanley, Jr. (members of the Bar of the Commonwealth of Massachusetts) and the firm of Bingham McCutchen LLP, One Federal Street, Boston, Massachusetts 02110.

All correspondence should be addressed to Joshua M. Dalton, Esq., Rachelle A. Dubow, Esq., and Lawrence T. Stanley, Jr., Esq. of Bingham McCutchen LLP, One Federal Street, Boston, Massachusetts 02110 or by electronic mail to josh.dalton@bingham.com, rachelle.dubow@bingham.com, and lawrence.stanley@bingham.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'J. Dalton', written over a horizontal line.

Joshua M. Dalton
Rachelle A. Dubow
Lawrence T. Stanley, Jr.
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One Federal Street
Boston, MA 02110
(617) 951-8000

Dated: December 9, 2013

Attorneys for Opposer,
Le Vian Corp.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Le Vian Corp.,)
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Opposer,)
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v.) Opposition No. _____
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Anaya Gems, Inc.,)
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Applicant.)
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **NOTICE OF OPPOSITION** and this **CERTIFICATE OF SERVICE** were duly served upon Applicant by email and U.S. Mail, postage prepaid, on December 9, 2013 to the address set out below:

Tal Hirshberg
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DATED: Boston, MA, December 9, 2013

By: 

Joshua M. Dalton
Rachelle A. Dubow
Lawrence T. Stanley, Jr.

Attorneys for Opposer