

ESTTA Tracking number: **ESTTA654320**

Filing date: **02/05/2015**

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	Antonio Puig, S.A.
Granted to Date of previous extension	02/08/2015
Address	Plaza Europa 46-48, Hospitalet de Llobregat E Barcelona, 08021 SPAIN

Attorney information	Brooks R. Bruneau, Anthony J. DoVale FisherBroyles 100 Overlook Center Second Floor Princeton, NJ 08540 UNITED STATES docketing@fisherbroyles.com, brooks.bruneau@fisherbroyles.com, denise.mcculloch@fisherbroyles.com Phone:609 454-6772
----------------------	---

Applicant Information

Application No	86042404	Publication date	08/12/2014
Opposition Filing Date	02/05/2015	Opposition Period Ends	02/08/2015
Applicant	J PINON ENTERPRISES OF TAMPA,INC 1632 WEST 32 PL. HIALEAH, FL 33012 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Cosmetic soaps; Cosmetics and cosmetic preparations
--

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Section 1(b) no bona fide intent to use the mark.

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2274389	Application Date	08/04/1998
Registration Date	08/31/1999	Foreign Priority Date	NONE

Word Mark	HENO DE PRAVIA
Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 toilet soaps, [deodorant soaps,] [perfume,] eau de toilette, [hair shampoos and conditioners,] bath and shower gels, deodorants and anti- perspirants forpersonal use, body lotions, body talc [, after-shave lotion]

U.S. Registration No.	517892	Application Date	05/25/1948
Registration Date	11/22/1949	Foreign Priority Date	NONE

Word Mark	HENO DE PRAVIA
Design Mark	Heno de Pravia
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 COLOGNES; TOILET LOTIONS; [BAY RUM; BRILLIANTINE OR POMADE IN SALVE FORM TO IMPART LUSTER TO THE HAIR; PERFUME; PETROLEUM JELLY; ROUGE IN CREAM, STICK, AND POWDERED FORM; RICE,] TALCUM [, FACE, AND BODY] POWDER [S; EYE SHADOW AND MAS- CARA; LIQUID AND POWDERED NAIL POLISH; PASTE POWDER, AND LI- QUID DENTIFRICES; AND CREAM AND LIQUID DEODORANT FOR PER- SONAL USE]

U.S. Registration No.	120568	Application Date	02/15/1916
Registration Date	02/19/1918	Foreign Priority Date	NONE

Word Mark	HENO DE PRAVIA
Design Mark	Heno de Pravia
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1911/12/01 First Use In Commerce: 1911/12/01 TOILET SOAP

Attachments	71557769#TMSN.png(bytes) 71092859#TMSN.png(bytes) HENO DE ESPANA Notice of Opp fnl.pdf(141668 bytes)
-------------	---

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	/brooks r. bruneau/
Name	Brooks R. Bruneau, Anthony J. DoVale
Date	02/05/2015

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

ANTONIO PUIG, S.A.,

Opposer,

v.

J. PINON ENTERPRISES OF
TAMPA, INC.,

Applicant.

Opposition No.:

Application No.: 86042404

Mark: HENO DE ESPAÑA

Date of Publication: August 12, 2014

NOTICE OF OPPOSITION

Antonio Puig, S.A., with a business address of Plaza Europa, 46-48, Hospitalet de Llobregat E-08902 Barcelona, Spain (hereinafter “Antonio Puig”), believes it will be damaged by the registration of the mark “HENO DE ESPAÑA” set forth in Application Serial No.86042404, which seeks registration in connection with “cosmetic soaps, cosmetics and cosmetic preparations,” in Class 3 (hereinafter “Applicant’s Goods”), and hereby Opposes said application.

As grounds for this Opposition, it is alleged as follows:

1. At the time of the August 20, 2013 filing date of the HENO DE ESPAÑA application, Antonio Puig had incontestable rights in its HENO DE PRAVIA trademark in connection with goods in Class 3 pursuant to the following United States Trademark Registrations (hereinafter collectively referred to as “HENO DE PRAVIA Marks”):

Mark	Registration No.	Goods
HENO DE PRAVIA	2274389	toilet soaps, eau de toilette, bath and shower gels, deodorants and anti- perspirants for personal use, body lotions, body talc
Heno de Pravia	0517892	Toilet lotions; talcum powder
Heno de Právia	0120568	TOILET SOAP

2. Antonio Puig’s rights in it HENO DE PRAVIA Marks were first registered on February 19, 1918 with dates of first use dating back to 1911.

3. All of the above captioned HENO DE PRAVIA Marks are registered with a variety of Class 3 goods, including soaps and other health and beauty aids in Class 3 as set forth above, and hereinafter referred to as “Antonio Puig Goods”.

4. The HENO DE ESPAÑA application was filed based upon intent-to-use.

5. Based upon information and belief, Applicant has not had any use in U.S. commerce of the HENO DE ESPAÑA mark in connection with any of the goods listed in its Application Serial No. 86042404. Moreover, based upon information and belief, the Applicant did not have a bona fide intent to use the mark in connection with all the goods listed in the application at the time of filing.

6. There is no doubt as to seniority in this case. Antonio Puig's use of its HENO DE PRAVIA Mark in connection with soaps alone predate Applicant's intent-to-use application by over 100 years.

7. Use of the HENO DE ESPAÑA mark by Applicant for Applicant's goods at the same time Antonio Puig is utilizing its HENO DE PRAVIA Marks in connection with its Class 3 goods, is likely to cause confusion or cause mistake or deception in the industry and among purchasers and potential purchasers of Antonio Puig's goods offered under its duly registered HENO DE PRAVIA Marks, resulting in damage to Antonio Puig, and in violation of Lanham Act Section 2(d).

8. Antonio Puig asserts that the HENO DE ESPAÑA mark sought to be registered is a close proximity of the HENO DE PRAVIA Mark and name previously used by Antonio Puig.

9. The HENO DE ESPAÑA mark would be recognized as a close approximation of the HENO DE PRAVIA Mark and name used by another person or institution, namely, Antonio Puig.

10. The mark HENO DE ESPAÑA would be recognized as that close approximation such that consumers are likely to recognize the mark HENO DE ESPAÑA as pointing unmistakably to Antonio Puig and its HENO DE PRAVIA Mark.

11. Antonio Puig is not connected or affiliated with Applicant, Applicant's activities or Applicant's HENO DE ESPAÑA mark.

12. The fame or reputation of Antonio Puig and its HENO DE PRAVIA Mark is of such a nature that a connection between Applicant and Antonio Puig's HENO DE PRAVIA Mark would be presumed by consumers when Applicant's mark is used on its Class 3 goods listed in the application.

13. Accordingly, Applicant's HENO DE ESPAÑA mark falsely suggests a connection with Antonio Puig and its HENO DE PRAVIA Mark, in violation of Lanham Act Section 2(a), and is not entitled to registration.

14. Because of the confusing similarity between Applicant's HENO DE ESPAÑA mark and Antonio Puig's HENO DE PRAVIA Marks, Antonio Puig's use of its HENO DE PRAVIA Marks in connection with the Antonio Puig Goods at the same time as Applicant's use of its HENO DE ESPAÑA mark in connection with Applicant's Goods, is likely to cause consumers to believe that Applicant's goods are those of Antonio Puig or are otherwise endorsed, sponsored, licensed or approved by Antonio Puig, causing damage to Antonio Puig. Accordingly, consumers are likely to be deceived into believing there is some affiliation or association between Antonio Puig and Applicant. Moreover, any fault, disappointments, complaints or other dissatisfaction a consumer might experience upon using the Applicant's HENO DE ESPAÑA products would inure to the detriment to Antonio Puig. As such, Applicant is not entitled to registration pursuant to 15 U.S.C. 1052(a) and (d).

15. Applicant's registration of the HENO DE ESPAÑA mark will cause confusion or mistake, or will deceive consumers in the industry as to the source of products bearing the HENO DE PRAVIA Mark and the HENO DE ESPAÑA mark. Accordingly, such registration of HENO DE ESPAÑA will handicap and damage the legitimate present and future activities of Antonio Puig by placing Applicant in a position to raise doubts as to the rights of Antonio Puig to use its HENO DE PRAVIA Marks in connection with its Class 3 goods identified above. Should the application herein opposed be granted registration, the Applicant would have the presumptive right to use that trademark in connection with Applicant's Goods, such that the use would blur the identification of Antonio Puig as the source of the Antonio Puig's Goods and other

products bearing the HENO DE PRAVIA Marks, and tarnish the association with which said marks have come to convey. As a result, Antonio Puig will eventually be deprived of all distinctiveness in its HENO DE PRAVIA Marks.

WHEREFORE, Antonio Puig requests that registration of Application Serial No 86042404 be denied and this Opposition sustained.

Respectfully submitted:

ANTONIO PUIG, S.A.

Date: February 5, 2015

BY: /Brooks R. Bruneau/
Brooks R. Bruneau, Esq.
Attorney for Opposer
FISHERBROYLES
100 Overlook Center
Second Floor
Princeton, NJ 08540
Tel: 609-454-6772

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this Notice of Opposition was electronically filed with the Trademark Trial and Appeal Board this 5th day of February, 2015.

/Brooks R. Bruneau/
(Signature)
February 5, 2015
(Date of Signature)

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Notice of Opposition to Application Serial No. 86042404 was served upon Applicant's counsel, via First Class Mail, postage prepaid, and Email, on this 5th day of February, 2015, addressed as follows:

Francisco J. Ferreiro, Esq.
Malloy & Malloy, P.L.
2800 S.W. 3rd Avenue
Miami, FLORIDA 33129

ANTONIO PUIG, S.A.

Date: February 5, 2015

BY: /Brooks R. Bruneau/
Brooks R. Bruneau, Esq.
Attorney for Opposer
FISHERBROYLES
100 Overlook Center
Second Floor
Princeton, NJ 08540
Tel: 609-454-6772