

ESTTA Tracking number: **ESTTA667660**

Filing date: **04/20/2015**

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	Imperial S.p.A.
Granted to Date of previous extension	04/19/2015
Address	Blocco 11, Centergross Via dei Lanaioli, 42 Funo Di Argelato, I-40050 ITALY
Attorney information	Chiara Giuliani Arent Fox LLP 1717 K Street, NW Washington, DC 20006 UNITED STATES giuliani.chiara@arentfox.com, henrye@arentfox.com, tmdocket@arentfox.com Phone:202 857 8920

**Applicant Information**

Application No	85613014	Publication date	10/21/2014
Opposition Filing Date	04/20/2015	Opposition Period Ends	04/19/2015
Applicants	Grande, Eric 1733 Centre Street West Roxbury, MA 02132 UNITED STATES  Grande, Nick 1733 Centre Street West Roxbury, MA 02132 UNITED STATES		

**Goods/Services Affected by Opposition**


Class 026. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Embroidery
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3954451	Application Date	08/30/2010
Registration Date	05/03/2011	Foreign Priority	NONE

		Date	
Word Mark	IMPERIAL TOWN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, namely, suits, skirts, trousers, shirts, jackets, sweaters, pullovers, coats, track suits, windcheaters; scarves; shawls, neckties; gloves, stockings; socks; belts; bathing suits; bathing trunks; beach robes; beachwear; bathrobes; pajamas; dressing gowns; underwear; brassieres; vests; underpants; hats; footwear; gym shoes		

Attachments	85118500#TMSN.png( bytes ) Notice of opposition.pdf(157348 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	/Chiara Giuliani/
Name	Chiara Giuliani
Date	04/20/2015

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

In re Application No. 85/613,014 for the mark I IMPERIAL PROMOTIONAL EMBROIDERY, EST. 1959 & Design, filed on May 1, 2012, and published on October 21, 2014

IMPERIAL S.P.A.

Opposer

v.

Eric Grande and Nick Grande

Applicants

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Opp. No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Imperial S.p.A. (“Opposer”) believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Opposer alleges the following.

1. Opposer is the owner of all right, title and interest in and to several marks containing the word “IMPERIAL” (“the IMPERIAL Marks”) in connection with a variety of clothing products.
2. The PTO has recognized Opposer’s exclusive rights in the IMPERIAL Marks by issuing various registrations, including the following:
  - a. Reg. No. 3,954,451 IMPERIAL TOWN for Clothing, namely, suits, skirts, trousers, shirts, jackets, sweaters, pullovers, coats, track suits, windcheaters; scarves; shawls, neckties; gloves, stockings; socks; belts; bathing suits; bathing trunks; beach robes; beachwear; bathrobes; pajamas; dressing gowns; underwear; brassieres; vests; underpants; hats; footwear; gym shoes, in Int. Class 25, issued on May 3, 2011

3. Opposer is also the owner of the following trademark application:



- a. Application S/N 79/141,142 for Clothing article, namely, suits, skirts, trousers, shirts, jackets, sweaters and pullovers, bomber jackets, coats, overcoats, raincoats, furs as clothing, track suits, windcheaters; scarves, headscarves, shawls; neckties, pocket squares, braces as clothing, gloves, stockings, socks; belts as clothing; bathing costumes and bathing trunks, beach robes and beachwear; bathrobes; pyjamas and dressing gowns, underwear, brassieres, vests, underpants; shoes, gym shoes, boots, sandals, slippers, clogs, in Int. Class 25, filed on July 30, 2013 (“Opposer’s IMPERIAL Application”)

4. Notwithstanding Opposer’s prior rights in Opposer’s IMPERIAL Marks, Applicants filed the above referenced application for registration of the mark



for “embroidery” in Int. Class 26.

5. The USPTO has indicated that it may refuse registration to Opposer’s IMPERIAL Application on the ground that the mark identified in Opposer’s IMPERIAL Application is



confusingly similar to the mark , identified in Applicants’ Application S/N 85/613,014.

6. Upon information and belief, Applicant made no use of its alleged mark in commerce prior to the filing date of the above referenced application.

**COUNT I**

**LIKELIHOOD OF CONFUSION - §2(d)**

7. If the allegations made by the PTO are correct, the mark that Applicant seeks to register so resembles Opposer's IMPERIAL Marks that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's IMPERIAL Marks.

8. On information and belief, Applicant's goods are so related to those sold under Opposer's IMPERIAL Marks that members of the public are likely to be confused to Opposer's irreparable damage.

9. Therefore, registration should be denied on the grounds that Applicant's mark is likely to cause confusion within the meaning of Section 2(a) of the Trademark Act.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

IMPERIAL S.P.A.

By Chiara Giuliani

Michael A. Grow  
Chiara Giuliani  
ARENT FOX LLP  
1717 K St., NW  
Washington, DC 20006  
Telephone: (202) 857-6000

Attorneys for Opposer

**CERTIFICATE OF SERVICE**

It is hereby certified that a true and correct copy of the foregoing (re S/N 85/613,014) is being served upon Applicant's counsel Adam J. Bruno, Bay State IP, LLC, 201 Washington St, Suite 2600 One Boston Place, Boston, MA 02108 on April 20, 2015.

A handwritten signature in blue ink, appearing to read "A. J. Bruno", is written over a solid horizontal line.