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Filing date: **07/09/2015**

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

Proceeding	91222582
Party	Plaintiff ETAM
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Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/Dean R. Karau/
Date	07/09/2015
Attachments	Undies Amended Notice of Opposition and Exhibit.pdf(77759 bytes)

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

In the Matter of

Trademark Serial No.: 86296717
For the Mark: undies.com
Filed: May 30, 2014
Published: May 5, 2015

ETAM,

Opposer,

Opposition No. 91222582

v.

Undies E-Commerce LLC,

Applicant.

AMENDED NOTICE OF OPPOSITION

This opposition is made to the application of Applicant, Undies E-Commerce LLC, for registration of the mark undies.com in Application Serial No. 86296717, published on May 5, 2015. Opposer, ETAM, has obtained an extension of time to oppose, to July 4, 2015.

Opposer believes it will be damaged by the registration of undies.com, and hereby opposes the same. As grounds for its opposition, Opposer states and alleges as follows:

1. Opposer is a joint stock company organized under the laws of France, with an address of 57 - 59, rue Henri Barbusse, 92110 Clichy, France.
2. On information and belief, Applicant is a limited liability company organized under the laws of New York, with an address of 7th Floor, 1372 Broadway, New York, New York 10018.
3. Active in more than 40 countries, with more than 4,100 sales outlets and 19,900 employees, Opposer is a major player in women's fashion around the world through its three

brands, Etam, 1.2.3 and Undiz, which cover complementary markets and offer well-recognized expertise in lingerie and beauty, clothing and accessories.

4. Opposer has used and registered its trademark shown to the right in connection with its wide variety of products in countries around the world, and is also the owner of United States Trademark Registration No. 4270721 for the mark, issued on January 8, 2013, based on an application filed on October 28, 2011, for goods identified in International Class 018 as bags, namely, handbags, rucksacks, school bags, traveling bags, traveling trunks, shoe bags for travel and garment bags for travel; valises, traveling trunks, pocket wallets, purses, card cases, namely, calling card cases, credit card cases and name card cases; umbrellas, parasols and walking sticks; and for goods identified in International Class 025 as clothing, namely, frocks, coats, suits, pants, skirts, shirts, blouses, tee-shirts, waistcoats, pullovers, vests, shorts, gloves, stockings, socks, belts, scarves; night clothing, namely, pajamas, dressing gowns, night gowns; lingerie articles, namely, underwear, underpants, slips, brassieres, breeches for wear; beach shoes; shoes except orthopedic shoes, headgear, namely, hats, caps, berets. (“Opposer’s Mark”). Opposer’s U.S. registration is valid and subsisting. A copy of a printout of the TSDR status for the registration is attached hereto as Exhibit A.



5. On May 30, 2014, Applicant filed an intent-to-use application to register undies.com, Application Serial No. 86296717, and the application was published for opposition on May 5, 2015, for goods identified in International Class 025 as bras; camisoles; lingerie; loungewear; negligees; nightgowns; nightwear; panties; t-shirts; tank-tops; underwear, and for services recited in International Class 035 as on-line retail store services featuring clothing.

6. Opposer’s priority date for Opposer’s Mark is long before any date of use or constructive date of use by Applicant of undies.com.

7. Opposer has developed widespread goodwill in Opposer's Mark. By reason of advertising, promotion, and other common activities in Opposer's industry, the consuming public recognizes Opposer's Mark and associates Opposer's Mark exclusively with Opposer and its goods.

8. Opposer's mark is inherently distinctive and is a strong mark and should be accorded the broad protection given to strong marks.

9. Use by Applicant of undies.com for which registration is sought in the application opposed herein, is without Opposer's consent or permission.

10. undies.com is so similar to Opposer's Marks as to be likely to falsely suggest a connection between Applicant and Opposer.

11. undies.com includes the stylized generic term "undies."

12. undies.com includes a non-source-identifying gTLD.

13. undies.com includes a pictorial representation of underwear in the dot of the letter "I" in the word "UNDIES."

14. The combination of the stylized generic term "undies," the non-source-identifying gTLD ".com," and a pictorial representation of underwear in the dot of the letter "I" in the word "UNDIES," is generic and without trademark and service mark significance with respect to the goods and services in the application, and is ineligible for registration on either the Principal or Supplemental registers.

15. The combination of the stylized generic term "undies," the non-source-identifying gTLD ".com," and a pictorial representation of underwear in the dot of the letter "I" in the word "UNDIES," is descriptive with respect to the goods and services in the application and has not acquired secondary meaning or become distinctive of the goods and services identified in the

application.

16. Use by Applicant of undies.com for which registration is sought in the application opposed herein is likely to cause confusion, mistake or deception as to the source of origin, sponsorship or approval of Applicant's goods in that purchasers or others are likely to believe that Applicant's goods are Opposer's, or are in some way legitimately connected with, licensed by, or approved by Opposer. Use by Applicant of undies.com for which registration is sought in the application opposed herein has lessened, and will continue to lessen, the capacity of Opposer's Mark to identify and distinguish goods made by Opposer.

17. Registration of undies.com will cause damage to Opposer by, among other things, interfering with Opposer's right to use various elements of undies.com and various combinations of those elements in connection with its goods, and if Applicant is granted the registration opposed herein, it would thereby obtain at least a prima facie exclusive right to undies.com and various elements of undies.com and various combinations of those elements.

18. Applicant is not entitled to registration of undies.com in that Applicant is not entitled to exclusive use of undies.com in commerce on the goods and services specified and further, that undies.com does not function to identify Applicant's goods and services and distinguish them from those offered by others.

Please address all communications to Dean R. Karau, Fredrikson & Byron, P.A., 200 South Sixth Street, Suite 4000, Minneapolis, Minnesota 55402-1425.

WHEREFORE, registration by Applicant of undies.com for the aforesaid goods and services would be damaging to Opposer.

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Mark: UNDIZ



US Serial Number: 85459205

Application Filing Date: Oct. 28, 2011

US Registration Number: 4270721

Registration Date: Jan. 08, 2013

Register: Principal

Mark Type: Trademark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jan. 08, 2013

Publication Date: Aug. 21, 2012

Mark Information

Mark Literal Elements: UNDIZ

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of the term "UNDIZ " in stylized lettering directly beneath a line that curves up on the left side of the mark and curves down on the right side of the mark.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Translation: The wording "UNDIZ" has no meaning in a foreign language.

Design Search Code(s): 26.17.02 - Bands, wavy; Bars, wavy; Lines, wavy; Wavy line(s), band(s) or bar(s)
26.17.04 - Bands, vertical; Bars, vertical; Vertical line(s), band(s) or bar(s); Lines, vertical
26.17.05 - Bands, horizontal; Horizontal line(s), band(s) or bar(s); Bars, horizontal; Lines, horizontal

Foreign Information

Foreign Registration Number: 073477662

Foreign Registration Date: Jan. 29, 2007

Foreign Application/Registration Country: FRANCE

Foreign Expiration Date: Jan. 29, 2017

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: (Based on 44(e)) Bags, namely, handbags, rucksacks, school bags, traveling bags, traveling trunks, shoe bags for travel and garment bags for travel; valises, traveling trunks, pocket wallets, purses, card cases, namely, calling card cases, credit card cases and name card cases; umbrellas, parasols and walking sticks

International Class(es): 018 - Primary Class

U.S Class(es): 001, 002, 003, 022, 041

Class Status: ACTIVE

Basis: 44(e)

For: (Based on 44(e)) Clothing, namely, frocks, coats, suits, pants, skirts, shirts, blouses, tee-shirts, waistcoats, pullovers, vests, shorts, gloves, stockings, socks, belts, scarves; night clothing, namely, pajamas, dressing gowns, night gowns; lingerie articles, namely, underwear, underpants, slips, brassieres, breeches for wear; beach shoes; shoes except orthopedic shoes, headgear, namely, hats, caps, berets

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: Yes	Currently 44E: Yes	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: ETAM
Owner Address: 57 - 59, rue Henri Barbusse
 92110 Clichy
 FRANCE
Legal Entity Type: JOINT STOCK COMPANY
State or Country Where Organized: FRANCE

Attorney/Correspondence Information

Attorney of Record

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Docket Number: 2356-63
Attorney Email Authorized: No

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Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Jan. 08, 2013	REGISTERED-PRINCIPAL REGISTER	
Nov. 30, 2012	1(B) BASIS DELETED; PROCEED TO REGISTRATION	76874
Nov. 29, 2012	NOTICE OF ALLOWANCE CANCELLED	76874
Nov. 29, 2012	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76874
Nov. 29, 2012	TEAS POST PUBLICATION AMENDMENT RECEIVED	
Oct. 16, 2012	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Sep. 10, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 21, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 21, 2012	PUBLISHED FOR OPPOSITION	
Aug. 01, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 17, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
Jul. 17, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jul. 17, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	77312
Jul. 17, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	77312
Jul. 13, 2012	ASSIGNED TO LIE	77312
Jul. 10, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 07, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325

Jun. 07, 2012	NON-FINAL ACTION E-MAILED	6325
Jun. 07, 2012	NON-FINAL ACTION WRITTEN	76507
Jun. 07, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	67287
Jun. 07, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	67287
May 24, 2012	ASSIGNED TO LIE	67287
May 11, 2012	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
May 11, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Feb. 21, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Feb. 21, 2012	NON-FINAL ACTION E-MAILED	6325
Feb. 21, 2012	NON-FINAL ACTION WRITTEN	76507
Feb. 15, 2012	ASSIGNED TO EXAMINER	76507
Nov. 02, 2011	NOTICE OF DESIGN SEARCH CODE MAILED	
Nov. 01, 2011	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Nov. 01, 2011	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jan. 08, 2013