

ESTTA Tracking number: **ESTTA683133**

Filing date: **07/13/2015**

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	Buckle Brands, Inc.
Granted to Date of previous extension	07/12/2015
Address	2407 W. 24th St. Kearney, NE 68845 UNITED STATES
Attorney information	Aryn M. Emert Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES ame@cll.com, jhe@cll.com, njh@cll.com, trademark@cll.com Phone:212-790-9200

Applicant Information

Application No	79147032	Publication date	01/13/2015
Opposition Filing Date	07/13/2015	Opposition Period Ends	07/12/2015
International Registration No.	1203171	International Registration Date	02/07/2014
Applicant	Salvatore Ferragamo S.p.A. Via dei Tornabuoni, 2 ITALY		

Goods/Services Affected by Opposition


Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Eyeglasses and sunglasses; sports eyewear; lenses, frames, cases, cords and chains for eyeglasses and sunglasses
Class 014. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Watches; wristwatches; diving watches; pocket watches; watch bands and straps; watch chains; watch cases; chronographs for use as timepieces and for use as watches; chronometers


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.	1733841	Application Date	03/10/1992
Registration Date	11/17/1992	Foreign Priority Date	NONE
Word Mark	THE BUCKLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1990/02/00 First Use In Commerce: 1990/02/00 retail clothing store services		

U.S. Registration No.	2348237	Application Date	10/14/1998
Registration Date	05/09/2000	Foreign Priority Date	NONE
Word Mark	BUCKLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1995/08/31 First Use In Commerce: 1995/08/31 "Providing a web-site featuring clothing, footwear and accessory fashion advice and information"		

U.S. Registration No.	2444470	Application Date	04/27/2000
Registration Date	04/17/2001	Foreign Priority Date	NONE
Word Mark	BUCKLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1997/02/26 First Use In Commerce: 1997/02/26 Retail store services in the field of clothing and accessories for young adults		

U.S. Registration No.	3563028	Application Date	03/27/2007
Registration Date	01/20/2009	Foreign Priority Date	NONE
Word Mark	BUCKLE		
Design Mark			
Description of Mark	The mark consists of THE WORD "BUCKLE" AND A "BUCKLE" DESIGN.		
Goods/Services	Class 035. First use: First Use: 2002/06/06 First Use In Commerce: 2002/06/06 Retail store services featuring clothing, footwear and accessories; and providing purchasing information concerning clothing, footwear and accessories Class 045. First use: First Use: 2002/06/06 First Use In Commerce: 2002/06/06 Web site providing fashion advice and information concerning clothing, footwear and accessories		

U.S. Registration No.	4038725	Application Date	05/11/2011
Registration Date	10/11/2011	Foreign Priority Date	NONE
Word Mark	BUCKLE BLACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2007/10/22 First Use In Commerce: 2007/10/22 Credit card services		

U.S. Registration No.	4185395	Application Date	09/19/2011
Registration Date	08/07/2012	Foreign Priority Date	NONE
Word Mark	BUCKLE		

Design Mark	<h1>BUCKLE</h1>
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Description of Mark	NONE
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Goods/Services	<p>Class 003. First use: First Use: 2004/07/22 First Use In Commerce: 2004/07/22 Perfume; toilet water; Perfumes and colognes; Cologne</p> <p>Class 014. First use: First Use: 2003/02/13 First Use In Commerce: 2003/02/13 Bracelets; earrings; necklaces; Jewelry</p> <p>Class 018. First use: First Use: 2004/07/23 First Use In Commerce: 2004/07/23 Backpacks; Wallets</p> <p>Class 025. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 Sweaters, sweatshirts, woven shirts, t-shirts, knit shirts, tops and polo shirts, hats, shoes, jackets, blazers, vests, pullovers, slacks, pants, jeans, shorts, sweat pants, skirts, culottes, dresses, swimwear and outerwear, namely, coats and parkas; caps; Belts for clothing; Blouses, cardigans, dress shirts, bottoms, hooded sweatshirts, sheer cardigan sweaters; Belts; belts made of leather; belts made out of cloth; belts of textile; coveralls, and leggings; tights, socks and hosiery; underwear; shoes; knit tops, shirts; gloves; Blazers, fleece tops, jackets, pants, down jackets and vests, vests and coats made out of imitation leather</p> <p>Class 035. First use: First Use: 1990/08/08 First Use In Commerce: 1990/08/08 Retail store services in the field of clothing and accessories for young adults; Retail store services featuring clothing, footwear and accessories; and providing purchasing information concerning clothing, footwear and accessories</p> <p>Class 045. First use: First Use: 1995/08/31 First Use In Commerce: 1995/08/31 Providing a web site featuring fashion advice and information concerning clothing, footwear and accessories</p>
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U.S. Registration No.	4248331	Application Date	04/07/2011
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Registration Date	11/27/2012	Foreign Priority Date	NONE
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Word Mark	BUCKLE BLACK
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Design Mark	<h1>BUCKLE BLACK</h1>
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Description of	NONE
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Mark	
Goods/Services	<p>Class 003. First use: First Use: 2010/06/24 First Use In Commerce: 2010/06/24 Cologne</p> <p>Class 009. First use: First Use: 2010/03/24 First Use In Commerce: 2010/03/24 Sunglasses</p> <p>Class 014. First use: First Use: 2010/03/24 First Use In Commerce: 2010/03/24 Jewelry, namely, bracelets, necklaces and rings</p> <p>Class 018. First use: First Use: 2010/09/02 First Use In Commerce: 2010/09/02 Messenger bags; backpacks</p> <p>Class 025. First use: First Use: 2009/12/18 First Use In Commerce: 2009/12/18 Clothing, namely, belts, coats, jackets, jeans, knit shirts, tops, polo shirts, shoes, flip flops, shorts, sweaters, sheer cardigan sweaters, sweatshirts, t-shirts, and woven shirts</p>

U.S. Registration No.	4511218	Application Date	12/23/2011
Registration Date	04/08/2014	Foreign Priority Date	NONE

Word Mark	BUCKLE BELIEVES
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: First Use: 2013/04/00 First Use In Commerce: 2013/04/00 Providing via the Internet consumer product information in the fields of supply-chain verification, auditing, certification, internal accountability, internal training and product safety for the purpose of meeting consumer product specifications and eradicating slavery and humantrafficking from the manufacturer's supply chain</p>
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U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
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Word Mark	Marks comprising or containing the term BUCKLE, either alone or in conjunction with other words, letters and/or designs
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Goods/Services	a variety of goods and services, including, without limitation, jewelry, including, without limitation, watches, eyewear, apparel, footwear, headwear, bags, and fragrances
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Attachments	<p>75568022#TMSN.png(bytes)</p> <p>76036354#TMSN.png(bytes)</p> <p>77141233#TMSN.png(bytes)</p>
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	85318552#TMSN.png(bytes) 85426055#TMSN.png(bytes) 85289131#TMSN.png(bytes) 85503275#TMSN.png(bytes) SALVATORE FERRAGAMO BUCKLE.pdf(19737 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	/Aryn M. Emert/
Name	Aryn M. Emert
Date	07/13/2015

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

In re Application Serial No. 79/147,032
Filed: February 7, 2014
For Mark: SALVATORE FERRAGAMO BUCKLE
Published in the Official Gazette: January 13, 2015

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BUCKLE BRANDS, INC., :
Opposer, :
v. : Opposition No.
SALVATORE FERRAGAMO S.P.A., :
Applicant. : **NOTICE OF OPPOSITION**
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Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer, Buckle Brands, Inc. (“Opposer”), a Nebraska corporation with offices at 2407 W. 24th Street, Kearney, Nebraska 68845, believes that it will be damaged by registration of the standard character word mark SALVATORE FERRAGAMO BUCKLE (“Applicant’s Mark”) in International Class 9 for “eyeglasses and sunglasses; sports eyewear; lenses, frames, cases, cords and chains for eyeglasses and sunglasses” and in International Class 14 for “watches; wristwatches; diving watches; pocket watches; watch bands and straps; watch chains; watch cases; chronographs for use as timepieces and for use as watches; chronometers” as shown in Application Serial No. 79/147,032 (the “Application”), and having been granted extensions of time to oppose up to and including July 12, 2015, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer is a wholly-owned subsidiary of The Buckle, Inc. (“Buckle”), one of the country’s foremost manufacturers and retailers of apparel, jewelry, eyewear, footwear and related fashion accessories. Buckle’s fashion products have been sold throughout the United States and have generated billions of dollars in sales over the years.

2. For many years and since long prior to October 16, 2013, Applicant’s claimed priority date, Opposer, through its affiliated companies, predecessors and authorized licensees has been in the business of designing, producing, selling and distributing a variety of goods, including, without limitation, jewelry, including, without limitation, watches, eyewear, apparel, footwear, headwear, bags, and fragrances, under trademarks consisting of or containing the term BUCKLE, either alone or in conjunction with other words, letters and/or designs (collectively, “Opposer’s BUCKLE Marks”).

3. Buckle operates hundreds of BUCKLE retail stores throughout the United States, each of which prominently features the term BUCKLE in its store signage. Additionally, Buckle operates an online store at www.buckle.com, which also prominently features the term BUCKLE on its home page. Each of Buckle’s retail stores, whether online or brick and mortar, have featured and offered a variety of goods, including, without limitation, jewelry, including, but not limited to, watches, eyewear, apparel, footwear, headwear, bags and fragrances bearing or in connection with one or more of Opposer’s BUCKLE Marks.

4. Opposer owns U.S. registrations for Opposer’s BUCKLE Marks in International Classes 3, 9, 14, 18, 25, 35, 36, 42 and 45, namely, 1,733,841; 2,348,237; 2,444,470; 3,563,028; 4,038,725; 4,185,395; 4,248,331; and 4,511,218. Registration Nos. 1,733,841; 2,348,237; 2,444,470; and 3,563,028 are incontestable.

5. Since long prior to October 16, 2013, Applicant's claimed priority date, Opposer, through its affiliated companies, predecessors and authorized licensees, has offered for sale, promoted and advertised goods bearing or in connection with one or more of Opposer's BUCKLE Marks in U.S. commerce, including, without limitation, jewelry, including, without limitation, watches, eyewear, apparel, footwear, headwear, bags, and fragrances.

6. As a result of the extensive advertisement, promotion, sale and distribution of its goods and services bearing or offered in connection with Opposer's BUCKLE Marks, coupled with the brand's potent commercial success, Opposer has acquired tremendous goodwill in Opposer's BUCKLE Marks, and said goodwill has become closely and uniquely identified with Opposer.

7. On February 7, 2014, Applicant filed the Application pursuant to Section 66(a) of the Lanham Act requesting an extension of protection to the United States of an international registration for Applicant's Mark for "Eyeglasses and sunglasses; sports eyewear; lenses, frames, cases, cords and chains for eyeglasses and sunglasses" in International Class 9, and for "Watches; wristwatches; diving watches; pocket watches; watch bands and straps; watch chains; watch cases; chronographs for use as timepieces and for use as watches; chronometers" in International Class 14, claiming a priority date of October 16, 2013.

8. Upon information and belief, Applicant did not use Applicant's Mark in U.S. commerce for the goods covered by the Application prior to Applicant's claimed priority date of October 16, 2013.

9. The goods covered by the Application are identical and/or closely related to the goods offered for sale and sold in U.S. commerce by Opposer under Opposer's BUCKLE Marks.

10. Applicant's Mark contains the term BUCKLE.

11. The term BUCKLE in Applicant's Mark is identical to Opposer's mark, BUCKLE, and to the term BUCKLE in Opposer's BUCKLE Marks.

12. Upon information and belief, the term SALVATORE FERRAGAMO in Applicant's Mark is Applicant's house mark.

13. Upon information and belief, Applicant's Mark is therefore a combination of its house mark, SALVATORE FERRAGAMO, with the term BUCKLE.

14. Applicant has no connection with Opposer, nor has it been authorized by Opposer to use its mark, BUCKLE, either alone or as part of another mark.

15. Applicant's Mark so resembles Opposer's BUCKLE mark and Opposer's BUCKLE Marks as to be likely, when used in connection with Applicant's goods as identified in the Application, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's aforementioned goods have their origin with Opposer and/or that such goods 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.

16. Opposer would be further injured by the granting of a certificate of registration to Applicant because Applicant's Mark, which is a close approximation of Opposer's BUCKLE mark and Opposer's BUCKLE Marks, which such marks point uniquely to Opposer, when used by Applicant in connection with the applied-for goods, would falsely suggest a connection between Applicant, which has no connection with or authorization from Opposer, and Opposer.

18. Opposer's BUCKLE Marks are distinctive and famous and enjoyed such fame long prior to October 16, 2013, Applicant's claimed priority date. Opposer would be further injured by the granting of a certificate of registration to Applicant for Applicant's Mark, because

such mark is likely to dilute the distinctive quality of Opposer's BUCKLE Marks and impair the distinctiveness of Opposer's BUCKLE Marks.

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 Jeffrey H. Epstein and Aryn M. Emert (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 Jeffrey H. Epstein, Esq. at the address listed below.

Dated: New York, New York
July 13, 2015

Respectfully submitted,

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

By: /Aryn M. Emert/

Aryn M. Emert
Jeffrey H. Epstein
1133 Avenue of the Americas
New York, New York 10036
(212)790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on July 13, 2015, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant's Attorney and Correspondent of Record, Andrea L. Calvaruso, Kelley Drye & Warren LLP, 101 Park Avenue, New York, NY 10178.

/Aryn M. Emert/
Aryn M. Emert