

ESTTA Tracking number: **ESTTA697275**

Filing date: **09/22/2015**

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	PETER COPPOLA BEAUTY LLC
Granted to Date of previous extension	09/26/2015
Address	7000 West Camino Real, Suite 200 Boca Raton, FL 33433 UNITED STATES
Attorney information	Michael B. Chesal Peretz Chesal & Herrmann, P.L. 2 South Biscayne Blvd., Suite 3700 Miami, FL 33131 UNITED STATES trademarks@pch-iplaw.com Phone:305.341.3000

Applicant Information

Application No	86481296	Publication date	07/28/2015
Opposition Filing Date	09/22/2015	Opposition Period Ends	09/26/2015
Applicant	GMYL, L.P. 916 Kearny Street San Francisco, CA 94133 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 2009/09/16 First Use In Commerce: 2009/09/16 All goods and services in the class are opposed, namely: Hotel services and resort lodging services

Grounds for Opposition

The mark is primarily merely a surname	Trademark Act section 2(e)(4)
Other	The mark is not in use in U.S. commerce. (Trademark Act section 45)
Related Proceedings	1. Prior Opposition No. 91221209. 2. Pending federal litigation in the Northern District of California (Case 4:15-cv-03724-KAW)
Attachments	Opposition - Peter Coppola Beauty, LLC v. GMYL, L.P. (00065684).PDF(131434 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	/Michael B. Chesal/
Name	Michael B. Chesal
Date	09/22/2015

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

Peter Coppola Beauty, LLC,

Opposer

v.

GMYL, L.P.,

Applicant.

In re Application Serial No.: 86/481,296

Mark: COPPOLA

NOTICE OF OPPOSITION

1. Opposer, Peter Coppola Beauty, LLC (“**Opposer**”), a Delaware Limited Liability Company located at 7000 West Camino Real, Suite 240 Boca Raton, Florida 33433 believes it will be damaged by registration of the mark claimed in Application Serial No. 86/481,296 (the “**Contested Application**”) covering “Hotel services and resort lodging services” in International Class 43, and accordingly hereby opposes the Contested Application pursuant to Trademark Act Section 13, 15 U.S.C. § 1063, and alleges:

Introduction

2. This Notice of Opposition is based upon the lack of use in U.S. commerce of the mark in the Contested Application, namely, COPPOLA (the “**Contested Mark**”), and lack of acquired distinctiveness. Based upon such lack of use in U.S. commerce and lack of acquired distinctiveness, the Contested Application should be refused.

The Contested Application

3. Upon information and belief, Applicant, GMYL, L.P. (“**Applicant**”) is a California corporation with its principal place of business located at 916 Kearny Street, San Francisco, California 94133.

4. The Contested Application alleges that the Contested Mark was first used anywhere and in commerce at least as early as September 16, 2009.

5. The Contested Application was filed on December 15, 2014 and was published for opposition on July 28, 2015.

6. On August 25, 2015, Opposer filed a request for extension of time to oppose the Contested Application. The Board granted Opposer's request, which extended the opposition period until September 26, 2015.

Opposition Based on Lack of Use in Commerce

7. On December 16, 2014, Applicant submitted a specimen purporting to show use of the Contested Mark in U.S. commerce for "hotel services and resort lodging services."

8. Applicant's specimen shows five (5) hotels or resorts purportedly offering hotel and resort services under the Contested Mark, but these hotels are all located outside the United States in Belize, Guatemala, Argentina and Italy.

9. Upon information and belief, none of Applicant's COPPOLA hotels or resorts are located in the United States.

10. Upon information and belief, at the time the Contested Application was filed, Applicant was not offering hotel or resort lodging services under the Contested Mark in U.S. commerce.

11. Upon information and belief, Applicant does not currently offer hotel or resort lodging services under the Contested Mark in U.S. commerce.

Opposition Based on Lack of Distinctiveness

12. The Contested Mark consists entirely of a surname, which is not inherently distinctive.

13. The surname "COPPOLA" has not become distinctive in connection with the services set forth in the Contested Application. Applicant's purported use of the Contest Mark is for hotels and resorts located exclusively in foreign countries, which is not a use in U.S. commerce, and is additionally insufficient for such mark to acquire distinctiveness in the United States.

14. Since the term “COPPOLA” is merely a surname which lacks distinctiveness for Applicant’s services identified in the Contested Application and has not acquired distinctiveness, the Contested Application should not have been approved for publication.

The Harm to Opposer

15. Opposer manufactures and sells hair care products and related accessories under the PETER COPPOLA brand. Some of Opposer’s products are labeled with the term COPPOLA appearing adjacent to the mark PETER COPPOLA.

16. On March 24, 2015, Applicant opposed Opposer’s trademark application for the mark COPPOLA for “hair care preparations” in Class 3 (the “**Prior Opposition**”, Opposition No. 91221209).

17. In the Prior Opposition, Applicant asserted claims of likelihood of confusion and dilution against Opposer and maintained that the Contested Mark and the Contested Application supported its claims for likelihood of confusion and dilution.

18. On August 14, 2015, Applicant filed a lawsuit (the “**Federal Litigation**”) against Opposer in the Northern District of California (Case 4:15-cv-03724-KAW), asserting, *inter alia*, claims for trademark infringement and trademark dilution of Applicant’s COPPOLA mark.

19. In the Federal Litigation, Applicant asserts that the Contested Mark and the Contested Application support its claims for trademark infringement and dilution.

20. If Applicant is granted registration of the Contested Application, Applicant would thereby obtain a prima facie exclusive right to use the mark COPPOLA for hotel services and resort lodging services, which would be a source of damage to Opposer as such registration would cast a shadow upon Opposer’s right to use, develop and expand the use of its PETER COPPOLA and COPPOLA marks for hair care products and related goods in the United States as evidenced by Applicant asserting the Contested Mark and Contested Application as a basis for its likelihood

of confusion and trademark infringement and dilution claims against Opposer. The Contested Application is thus a source of damage and injury to Opposer.

WHEREFORE, Opposer, Peter Coppola Beauty, LLC, respectfully requests that registration of the mark claimed in the Contested Application Serial No. 86/481,296 be refused and that this Opposition be sustained in favor of Opposer.

Dated: September 22, 2015

Respectfully submitted,

PERETZ CHESAL & HERRMANN, P.L.

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CERTIFICATE OF SERVICE

I hereby certify that on September 22, 2015 a copy of the foregoing was served via First Class Mail, to the following:

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By: /Josh E. Saltz/
Josh E. Saltz