

ESTTA Tracking number: **ESTTA772481**

Filing date: **09/23/2016**

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	CALIDA AG
Granted to Date of previous extension	09/25/2016
Address	BAHNSTRASSE OBERKIRCH, 6208 SWITZERLAND
Attorney information	Randolph E. Digges, III Rankin, Hill & Clark LLP 23755 Lorain Road, Suite 200 North Olmsted, OH 44070 UNITED STATES 75628@rankinhill.com Phone:2165669700

Applicant Information

Application No	86752439	Publication date	03/29/2016
Opposition Filing Date	09/23/2016	Opposition Period Ends	09/25/2016
Applicant	Callidae, LLC 9212 Hazen Drive Beverly Hills, CA 90210 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2015/01/01 First Use In Commerce: 2015/01/01 All goods and services in the class are opposed, namely: Sweaters; shirts; riding breeches; vests; riding coats

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1477811	Application Date	05/29/1987
Registration Date	02/23/1988	Foreign Priority Date	NONE
Word Mark	CALIDA		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 ARTICLES OF CLOTHING, NAMELY PULLOVERS, T-SHIRTS, NIGHTSHIRTS, NIGHT-GOWNS, NIGHT-DRESSES, PAJAMAS, HOUSE-GOWNS, HOME-DRESSES AND UNDERWEAR, ALL FOR MEN, LADIES AND CHILDREN

Attachments	MTZ-41078-Notice_Opposition.pdf(1190476 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	/Randolph E. Digges, III/
Name	Randolph E. Digges, III
Date	09/23/2016

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

CALIDA AG,	:	Opposition No. _____
	:	
Opposer,	:	Application Ser. No. 86/752,439
	:	
v.	:	Mark: CALLIDAE
	:	
Callidae, LLC,	:	Published in the <i>Official Gazette</i> of
	:	March 29, 2016 - Time to Oppose
Applicant.	:	Extended to September 25, 2016

NOTICE OF OPPOSITION

Calida AG, an aktiengesellschaft (corporation) organized under the laws of Switzerland located and doing business at Bahnstrasse, CH-6208 Oberkirch, Switzerland, on behalf of itself and its affiliates, related companies, and licensees (collectively “Opposer”), believes it will be damaged by registration of the CALLIDAE mark shown in U.S. App. Ser. No. 86/752,439 (the “CALLIDAE Application”), in International Class 025 for “sweaters; shirts; riding breeches; vests; riding coats” of Callidae, LLC (“Applicant”) on the Principal Register, and hereby opposes the same.

As grounds for this Opposition, Opposer alleges:

1. Since long before the January 1, 2015 date of claimed first use and the September 10, 2015 filing date of the CALLIDAE Application, Opposer has been extensively marketing, selling and distributing clothing goods in International Class 025 including, but not limited to, pullovers, T-shirts, nightshirts, night-gowns, night-dresses, pajamas, house-gowns, home-dresses and underwear, all for men, ladies and children, via retail stores and online in U.S. commerce using the mark CALIDA.

2. Opposer owns U.S. Reg. No. 1,477,811, a copy of which is attached hereto together with a current printout of information from the electronic database records of the U.S. Patent and Trademark Office showing the current status and title of

the registration. This registration is valid, subsisting and owned by Opposer. This registration is incontestable pursuant to 15 U.S.C. §§1064 and 1115(b).

3. Opposer also owns common law rights in the CALIDA mark for clothing goods in International Class 025 by virtue of Opposer's first and exclusive use of the CALIDA mark in connection therewith in commerce. Opposer owns and uses, among others, the domain name: <http://www.calida.com/>, and has done so since at least as early as 1998.

4. In addition to the United States, Opposer owns trademark registrations that show the CALIDA mark for use in connection with clothing goods identified in International Class 025 in at least the following jurisdictions: Switzerland; Armenia; Austria; Bosnia and Herzegovina; Bulgaria; Benelux; Belarus; Canada; China; Czech Republic; Germany; Egypt; Spain; France; Great Britain; Croatia; Hungary; Ireland; Italy; Kazakhstan; Liechtenstein; Morocco; Monaco; Montenegro; Macedonia; Portugal; Romania; Serbia; Slovenia; Slovakia; San Marion; Tunisia; Ukraine; and Viet Nam.

5. Through its advertising and promotion of the CALIDA mark and the popularity of the goods and services sold and provided in connection with the mark, Opposer has built and owns extremely valuable goodwill symbolized by and associated with the CALIDA mark.

6. The CALIDA mark is widely recognized by the general consuming public of the United States as a unique source of Opposer's clothing goods, and Opposer's CALIDA mark has become famous in accordance with 15 U.S.C. §1125(c).

7. Applicant's use and effort to register the CALLIDAE mark for clothing goods is without Opposer's consent or permission.

8. Applicant's use and registration of the CALLIDAE mark for the goods identified in International Class 025 of the CALLIDAE Application is damaging to Opposer.

COUNT I – LIKELIHOOD OF CONFUSION

9. Opposer incorporates its allegations of Paragraphs 1 through 8.

10. Applicant's use and registration of the CALLIDAE mark in connection with clothing goods is likely to cause confusion, mistake, or deception in that consumers are likely to believe Applicant's goods are Opposer's goods or the goods of a person or entity that is sponsored, authorized, or licensed by, or in some other way legitimately connected with, Opposer.

11. The mark CALLIDAE incorporates applicant's registered CALIDA mark entirely, with the only minor differences being two L's instead of one, and an E at the end.

12. The identification of goods for the CALLIDAE Application includes goods that are identical to or nearly identical to goods identified in the CALIDA registration.

COUNT II - DILUTION

13. Opposer incorporates its allegations of Paragraphs 1 through 12.

14. Prior to the filing date of the CALLIDAE Application, Opposer's CALIDA mark had acquired wide recognition by the general consuming public of the United States as a unique source of Opposer's clothing goods, and the CALIDA mark had become famous in accordance with 15 U.S.C. §1125(c).

15. Opposer's use of the CALIDA mark in connection with clothing is substantially exclusive.

16. Applicant's use of CALLIDAE on articles of clothing is likely to dilute Opposer's famous CALIDA mark by impairing the distinctiveness of the CALIDA mark (blurring).

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Application Ser. No. 86/752,439 be denied registration for all goods in International Class 025.

The filing fee has been submitted with this paper. If there are any additional necessary fees, please debit our Deposit Account Account No. 18-0160, our Order No. MTZ-41078. Please address all correspondence to the undersigned attorney, who consents to electronic service only of all documents in this matter.

Respectfully submitted,

RANKIN, HILL & CLARK LLP

By: /Randolph E. Digges, III/
Randolph E. Digges, III (OH# 0059298)
23755 Lorain Road, Suite 200
North Olmsted, OH 44070
Tel: (216) 566-9700
Fax: (216) 566-9711
Email: digges@rankinhill.com

Attorneys for Opposer

Dated: September 23, 2016

CERTIFICATE OF SERVICE

I, Randolph E. Digges, III, hereby certify that a copy of this NOTICE OF OPPOSITION has been served upon:

Noam J. Kritzer
BAKOS & KRITZER
147 Columbia Turnpike, Suite 102
Florham Park, NJ 07932-2188
Applicant's Attorney of Record and Correspondence Address

by first class mail, postage prepaid, with a courtesy copy to the email address which Applicants have used during prosecution of the CALI DAZE Application (trademark@bakoskritzer.com) this 23rd day of September 2016.

By: /Randolph E. Digges, III/
Randolph E. Digges, III
Rankin, Hill & Clark LLP
Attorneys for Opposer

Int. Cl.: 25

Prior U.S. Cl.: 39

Reg. No. 1,477,811

United States Patent and Trademark Office Registered Feb. 23, 1988

**TRADEMARK
PRINCIPAL REGISTER**

CALIDA

CALIDA LTD. (SWITZERLAND CORPORATION)
SURSEE
LUCERNE, SWITZERLAND

FOR: ARTICLES OF CLOTHING, NAMELY
PULLOVERS, T-SHIRTS, NIGHTSHIRTS,
NIGHT-GOWNS, NIGHT-DRESSES, PAJAMAS,
HOUSE-GOWNS, HOME-DRESSES AND UN-
DERWEAR, ALL FOR MEN, LADIES AND
CHILDREN, IN CLASS 25 (U.S. CL. 39).

OWNER OF SWITZERLAND REG. NO.
232991, DATED 7-15-1968, EXPIRES 7-15-1988.

THE ENGLISH TRANSLATION OF THE
WORD "CALIDA" IN THE MARK IS "HOT, PI-
QUANT".

SER. NO. 663,528, FILED 5-29-1987.

CRAIG K. MORRIS, EXAMINING ATTORNEY

Generated on: This page was generated by TSDR on 2016-09-22 10:13:16 EDT

Mark: CALIDA

US Serial Number: 73663528

Application Filing Date: May 29, 1987

US Registration Number: 1477811

Registration Date: Feb. 23, 1988

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Nov. 19, 2007

Publication Date: Dec. 01, 1987

Mark Information

Mark Literal Elements: CALIDA

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Translation: THE ENGLISH TRANSLATION OF THE WORD "CALIDA" IN THE MARK IS "HOT, PIQUANT".

Foreign Information

Foreign Registration Number: 232991

Foreign Registration Date: Jul. 15, 1968

Foreign Application/Registration Country: SWITZERLAND

Foreign Expiration Date: Jul. 15, 1988

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: ARTICLES OF CLOTHING, NAMELY PULLOVERS, T-SHIRTS, NIGHTSHIRTS, NIGHT-GOWNS, NIGHT-DRESSES, PAJAMAS, HOUSE-GOWNS, HOME-DRESSES AND UNDERWEAR, ALL FOR MEN, LADIES AND CHILDREN

International Class(es): 025 - Primary Class

U.S Class(es): 039

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No
Filed 44E: Yes
Filed 66A: No
Filed No Basis: No

Currently 44D: No
Currently 44E: Yes
Currently 66A: No
Currently No Basis: No

Amended 44D: No
Amended 44E: No

Current Owner(s) Information

Owner Name: CALIDA AG
Owner Address: BAHNSTRASSE
OBERKIRCH 6208
SWITZERLAND
Legal Entity Type: CORPORATION
State or Country Where Organized: SWITZERLAND

Attorney/Correspondence Information

Attorney of Record

Attorney Name: LAWRENCE E. ABELMAN
Docket Number: 935254

Correspondent

Correspondent Name/Address: LAWRENCE E. ABELMAN
ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE
NEW YORK, NEW YORK 10017-5621
UNITED STATES

Domestic Representative

Domestic Representative Name: LAWRENCE E. ABELMAN
Phone: 212-9499022
Fax: 212-9499190

Prosecution History

Date	Description	Proceeding Number
Apr. 24, 2013	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Nov. 19, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	60132
Nov. 19, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Nov. 16, 2007	ASSIGNED TO PARALEGAL	60132
Nov. 14, 2007	TEAS SECTION 8 & 9 RECEIVED	
Apr. 30, 2007	CASE FILE IN TICRS	
Sep. 09, 2006	REVIEW OF CORRESPONDENCE COMPLETE	74215
Aug. 21, 2006	PAPER RECEIVED	
Aug. 11, 2006	REVIEW OF CORRESPONDENCE COMPLETE	77315
Sep. 16, 2002	PAPER RECEIVED	
Feb. 10, 1994	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Sep. 30, 1993	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Feb. 23, 1988	REGISTERED-PRINCIPAL REGISTER	
Dec. 01, 1987	PUBLISHED FOR OPPOSITION	
Oct. 31, 1987	NOTICE OF PUBLICATION	
Sep. 30, 1987	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 23, 1987	EXAMINER'S AMENDMENT MAILED	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted
Affidavit of Incontestability: Section 15 - Accepted
Renewal Date: Feb. 23, 2008

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Nov. 19, 2007

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: CALIDA LTD.

Assignment 1 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [2598/0283](#)

Pages: 3

Date Recorded: Sep. 16, 2002

Supporting Documents: [assignment-tm-2598-0283.pdf](#)

Assignor

Name: [CALIDA LTD.](#)

Execution Date: Jul. 01, 2002

Legal Entity Type: CORPORATION

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [CALIDA HOLDING AG](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: SWITZERLAND

Address: BAHNSTRASSE, 6208
OBERKIRCH, SWITZERLAND

Correspondent

Correspondent Name: ABELMAN FRAYNE & SCHWAB

Correspondent Address: LAWRENCE E. ABELMAN
150 EAST 42ND STREET
NEW YORK, NY 10017-561

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [5007/0941](#)

Pages: 4

Date Recorded: Apr. 16, 2013

Supporting Documents: [assignment-tm-5007-0941.pdf](#)

Assignor

Name: [CALIDA HOLDING AG](#)

Execution Date: Mar. 26, 2013

Legal Entity Type: CORPORATION

State or Country Where Organized: SWITZERLAND

Assignee

Name: [CALIDA AG](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: SWITZERLAND

Address: BAHNSTRASSE
OBERKIRCH, SWITZERLAND 6208

Correspondent

Correspondent Name: RANDOLPH E. DIGGES, III

Correspondent Address: 23755 LORAIN ROAD, SUITE 200
NORTH OLMSTED, OH 44070

Domestic Representative

Domestic: RANDOLPH E. DIGGES, III

Representative
Name:

Domestic Representative Address: 23755 LORAIN ROAD, SUITE 200
NORTH OLMSTED, OH 44070

Proceedings

Summary

Number of Proceedings: 2

Type of Proceeding: Opposition

Proceeding Number: [91224655](#)

Filing Date: Nov 02, 2015

Status: Terminated

Status Date: Feb 22, 2016

Interlocutory Attorney: ANN LINNEHAN VOGLER

Defendant

Name: Tony Bustamante, David Thomas

Correspondent Address: TONY BUSTAMANTE
5671 ENGINEER DR
HUNTINGTON BEACH CA , 92649-1123
UNITED STATES

Correspondent e-mail: Tony@Speedwear.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CALI DAZE	Abandoned - After Inter-Partes Decision	86439282	

Plaintiff(s)

Name: Calida AG

Correspondent Address: RANDOLPH E DIGGES III
RANKIN HILL & CLARK LLP
23755 LORAIN ROAD, SUITE 200
NORTH OLMSTED OH , 44070
UNITED STATES

Correspondent e-mail: 75628@rankinhill.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CALIDA	Renewed	73663528	1477811

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 02, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 02, 2015	Dec 12, 2015
3	PENDING, INSTITUTED	Nov 02, 2015	
4	NOTICE OF DEFAULT	Jan 11, 2016	
5	BD DECISION: SUSTAINED	Feb 22, 2016	
6	TERMINATED	Feb 22, 2016	

Type of Proceeding: Opposition

Proceeding Number: [91222207](#)

Filing Date: Jun 03, 2015

Status: Pending

Status Date: Jun 03, 2015

Interlocutory Attorney: ELIZABETH WINTER

Defendant

Name: American Sports Licensing, Inc.

Correspondent NADYA M SAND

Address: ALSTON & BIRD LLP
ONE ATLANTIC CTR, 1201 W PEACHTREE ST
ATLANTA GA , 30309-3424
UNITED STATES

Correspondent e-mail: nadya.sand@alston.com , bob.lee@alston.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CALIA	Opposition Pending	86344087	

Plaintiff(s)

Name: Calida AG

Correspondent Address: RANDOLPH E DIGGES III
RANKIN HILL & CLARK LLP
23755 LORAIN ROAD, SUITE 200
NORTH OLMSTED OH , 44070
UNITED STATES

Correspondent e-mail: diggess@rankinhill.com , 75628@rankinhill.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CALIDA	Renewed	73663528	1477811

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jun 03, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jun 03, 2015	Jul 13, 2015
3	PENDING, INSTITUTED	Jun 03, 2015	
4	ANSWER	Jul 13, 2015	
5	ANSWER (AMENDED SIGNATURE)	Jul 13, 2015	
6	P MOT TO SUSP W/ CONSENT PEND SETTLE NEGOTIATIONS	Sep 10, 2015	
7	SUSPENDED	Sep 10, 2015	
8	D UNOPPOSED MOT FOR EXT	May 09, 2016	
9	EXTENSION OF TIME GRANTED	May 13, 2016	
10	D MOT FOR EXT W/ CONSENT	Jun 03, 2016	
11	EXTENSION OF TIME GRANTED	Jun 03, 2016	
12	MOT TO DIVIDE APPLICATION	Aug 01, 2016	
13	D CONF MOT TO DIVIDE APPLICATION	Aug 04, 2016	
14	P MOT TO SUSP W/ CONSENT PEND SETTLE NEGOTIATIONS	Aug 16, 2016	