

ESTTA Tracking number: **ESTTA810022**

Filing date: **03/28/2017**

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	Fendi Adele S.r.l.
Granted to Date of previous extension	03/29/2017
Address	Palazzo della Civiltà Italiana Quadrato della Concordia, 3 Rome, 00144 ITALY
Attorney information	RALPH H CATHCART LADAS & PARRY LLP 1040 AVENUE OF THE AMERICAS NEW YORK, NY 10018-3738 UNITED STATES rcathcart@ladas.com, jkwon@ladas.com, rroa@ladas.com, mmercado@ladas.com Phone:(212) 708-1920

Applicant Information

Application No	87100281	Publication date	11/29/2016
Opposition Filing Date	03/28/2017	Opposition Period Ends	03/29/2017
Applicant	Li EnJiu LiLaozhuang group Qingfeng Vil. Shunhe Yu'an Dist. Liu'an, CHINA		

Goods/Services Affected by Opposition

Class 025. First Use: 2016/05/12 First Use In Commerce: 2016/06/12 All goods and services in the class are opposed, namely: Boas; Bow ties; Cheongsams (Chinese gowns); Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Down jackets; Dresses; Dressing gowns and bath robes; Ear muffs; Gloves; Headbands; Headwear for adults; Mittens; Petticoats; Removable collars; Scarves; Shawls; Veils; Waistcoats; Wedding dresses; Masquerade costumes
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Grounds for Opposition


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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration	1244466	Application Date	10/29/1976
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No.			
Registration Date	07/05/1983	Foreign Priority Date	04/30/1976
Word Mark	FENDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Traveling Luggage, Trunks, Purses, Rucksacks, Brief Cases, Attache Cases, Wallets, Key Cases, Passport Cases, [DrivingLicense Cases,] Business Card Cases, Cosmetic Cases Sold Empty, Shirt Bags [,Umbrellas, Parasols]</p> <p>Class 024. First use: First Use: 0 First Use In Commerce: 0 [Bed Sheets, Pillow Cases, Tablecloths,Cloth Napkins, Handkerchiefs]</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Fur Coats, Fur Stoles, Fur Jackets, Raincoats, Cloth Coats, Jackets, Skirts, Blouses, Dresses, Hosiery, Shirts, Trousers, Hats, Scarves, Foulards, Gloves, Ties, Neckwear, [Socks, Stockings,] Belts,[Sleepwear,] Swimwear, [Lingerie,] Shoes, Boots [, Slippers]</p>		

U.S. Registration No.	1439955	Application Date	12/24/1985
Registration Date	05/19/1987	Foreign Priority Date	08/02/1985
Word Mark	FF FENDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 0 First Use In Commerce: 0 ATTACHE-CASES, [BACKPACKS,] TOTE BAGS, BRIEFCASES, KEY CASES, CREDIT CARD CASES, GARMENT BAG FOR TRAVEL, HANDBAGS, SHOULDER BAGS, LUGGAGE, PASSPORT CASES, BRIEFCASE TYPE PORTFOLIOS, SUITCASES [, TRUNKS FOR TRAVELLING] [AND UMBRELLAS]</p> <p>Class 024. First use: First Use: 0 First Use In Commerce: 0 [BATH LINEN, BED CLOTHES AND LINEN, BEDSPREADS, HANDKERCHIEFS, HOUSEHOLD LINEN, PILLOWCASES, QUILTS, TABLE NAPKINS ANDCLOTHS , SILK, WOOLEN, VELVET AND COTTON FABRICS USED IN THE MANUFACTURE OF CLOTHING]</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 [BATHING SUITS,] [BATHROBES,] [BEACHWEAR,] BELTS, [BLAZERS, BLOUSES, BLOUSONS,] SHOES, BOOTS [AND SLIPPERS,] [CARDIGANS, COATS,] FUR COATS, [OVERCOATS, DRESSES, GLOVES,] [GOWNS, HATS AND HEADWEAR,] [JACKETS,] JEANS, [JUMPERS,] [RAIN COATS, SCARVES, SHAWLS, SHIRTS, SKIRTS,] [SLEEPWEAR,] [STOCKINGS, SUITS, T-SHIRTS, TIES,] TROUSERS [, VESTS]</p>		

U.S. Registration No.	4409049	Application Date	06/06/2012
Registration Date	10/01/2013	Foreign Priority Date	NONE
Word Mark	FENDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 Perfumes, eau de parfum, eau de Cologne, toilet water, after shave creams, after shave lotions, shaving lotions, shaving creams and foams, hair lotions, shampoos, hair conditioners, essential oils for personal use, beauty masks, cold creams, hand creams, body and facial creams, deodorants for personal use, antiperspirants for personal use, skin cleansers, soaps for personal use, toilet soaps, bath soaps, bath and shower foams, bath and shower gels, body oils, body lotions, skin lotions, lipsticks, lip gloss, face powders, eye pencils, rouge, mascara, eye shadows, foundation make-up, talcum powder, nail polish</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Eyeglasses, sunglasses, eyeglass and sunglass lenses, eyeglass frames and eyeglass cases; telephones and mobile phones; computers, laptop computers, MP3 players, personal digital assistants; cameras and digital cameras; video cameras; bags, cases and sleeves specially adapted for holding or carrying all the above mentioned goods</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 Jewelry of precious and non-precious metal, namely, bracelets, necklaces, neck chains and rings, brooches, earrings, pendants, tie-pins, cuff-links, precious stones, jewelry cases; clocks, 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</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Bags, namely, shoulder bags, travellingbags, handbags, Boston bags, waist packs, sling bags for carrying infants, leather and canvas shopping bags, duffle bags, tote bags, clutch bags, trunks, wallets, purses, briefcases, attach cases, pouches of leather or textile, school bags, suitcases, garment bags for travel, key cases made of leather, backpacks, rucksacks, vanity cases sold empty, carry-onbags, beach bags, umbrellas</p> <p>Class 020. First use: First Use: 0 First Use In Commerce: 0 Furniture, bathroom furniture, kitchen furniture, household furniture, namely, chairs, lounge chairs, armchairs, tables, coffee tables, benches, stools, beds, bedside tables, wardrobes, umbrella stands, desks, coat stands, sofas and divans, ottomans, shelves, drawers, wall cupboards, showcases, television stands, serving trolleys, bookshelves, bathroom cabinets; furniture parts, namely, finished countertops sold separately; shelves; non-metal furniture parts, namely, legs, feet, wheels, handles and knobs; mirrors and picture frames</p> <p>Class 024. First use: First Use: 0 First Use In Commerce: 0 Bath towels, beach towels; bath linen, table supplies of textile, namely, tablelinen of textile, table cloths of textile, napkins of textile; textile coverings, namely, curtains, draperies, unfitted textile slipcovers for bed headboards, sofas and arm-</p>		

	<p>chairs, and textile coverings for beds, namely, bed sheets, pillow cases, blankets, bedspreads, mattress covers, quilts, comforters, bed skirts; bed linen, wash cloths for use as towels, handkerchiefs of textile</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0</p> <p>Articles of clothing for men, women and children, namely, pullovers, cardigans, sweaters, jerseys, jumpers, jackets, sweatshirts, parkas, bathing suits, blouses, shirts, trousers, jeans, waistcoats, skirts, shorts, T-shirts, dresses, men's suits, coats, raincoats, overcoats, furcoats and jackets, overalls, underwear, vests, hosiery and panty hose, bathrobes, shawls, scarves, neckties, gloves for clothing, belts for clothing, shoes, boots, sandals, slippers, clogs, hats and caps</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>The bringing together, for the benefit of others, of a variety of goods excluding the transport thereof, such as perfumery, cosmetics, eyeglasses, telephone equipment, computers, photographic apparatus, video cameras, jewellery, horological instruments, bags, wallets and other leather goods, furniture, mirrors, picture frames, bed and table covers, towels, clothing, footwear, headgear, personal accessories, enabling customers to conveniently view and purchase those goods, as well as retail store services for the above mentioned products</p> <p>Class 043. First use: First Use: 0 First Use In Commerce: 0</p> <p>Resort hotel services, namely, hotel services and hotel accommodation, hotel services for holidays, resort hotel services; providing temporary lodging services in the nature of a condominium and cooperative hotel; restaurant, bar and cocktail lounge services; contract food services; take away restaurant services; bars, restaurants and cafes; catering services; provision of exhibition facilities in the nature of halls; travel agency services, namely, making reservations and bookings for temporary accommodation</p>
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U.S. Registration No.	4549739	Application Date	12/17/2012
Registration Date	06/17/2014	Foreign Priority Date	12/04/2012
Word Mark	FENDI		
Design Mark			

Description of Mark	The mark consists of a succession of tobacco and black vertical stripes and of the word "FENDI" written vertically in tobacco capital letters along the edge of the black vertical stripes.
Goods/Services	<p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Bags, namely, shoulder bags, travellingbags, handbags, Boston bags, waist packs, sling bags for carrying infants, leather and canvas shopping bags, duffle bags, tote bags, clutch bags, trunks, wallets, purses, briefcases, attach cases, pouches of leather, pouches of textile notfor packaging, school bags, suitcases, garment bags for travel, key cases made of leather, backpacks, rucksacks, vanitycases sold empty, carry-on bags, beach bags, umbrellas</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Articles of clothing for men, women and children, namely, pullovers, cardigans, sweaters, jerseys, jumpers, jackets, sweatshirts, parkas, bathing suits, blouses, shirts, trousers, jeans, waistcoats, skirts, shorts, T-shirts, dresses, men's suits, coats, raincoats, overcoats, furcoats and jackets, overalls, underwear, vests, hosiery and panty hose, bathrobes, shawls, scarves, neckties, gloves for clothing, belts for clothing, shoes, boots, sandals, slippers, clogs, hats and caps</p>

Attachments	73575165#TMSN.png(bytes) 79118321#TMSN.png(bytes) 79132722#TMSN.png(bytes) Notice of Opposition - FENDIE.pdf(1238839 bytes)
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Signature	/Ralph H. Cathcart/
Name	RALPH H CATHCART
Date	03/28/2017

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

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FENDI ADELE S.R.L.,	:
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Opposer,	: Opposition No. _____
	:
v.	: Serial No. 87/100,281
	:
LI ENJIU,	:
	:
Applicant.	:
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NOTICE OF OPPOSITION

In the matter of Application Serial No. 87/100,281, filed on July 12, 2016, by Li EnJiu, an individual with an address at LiLaozhuang group Qingfeng Vil. Shunhe Yu'an Dist. Liu'an, CHINA (“Applicant”), seeking registration on the Principal Register of the trademark FENDIE (“Applicant’s FENDIE Mark”) in connection with various clothing goods and accessories, including the following goods in International Class 25:

Boas; Bow ties; Cheongsams (Chinese gowns); Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Down jackets; Dresses; Dressing gowns and bath robes; Ear muffs; Gloves; Headbands; Headwear for adults; Mittens; Petticoats; Removable collars; Scarves; Shawls; Veils; Waistcoats; Wedding dresses; Masquerade costumes;

(“Applicant’s FENDIE Goods”), which application was published for opposition on November 29, 2016, with an extension of time to file a Notice of Opposition granted up to and including March 29, 2017;

Whereas Fendi Adele S.r.l., an Italian limited liability company with an office at Quadrato della Concordia, 3 Palazzo della Civiltà Italiana, I-00144 Rome, Italy (“Opposer”), believes that it is or will be damaged by the registration of FENDIE Application Serial No.

87/100,281 and hereby opposes registration of Applicant's FENDIE Mark on the following grounds:

I.

§ 2(d) Likelihood of Confusion

1. Opposer is the owner of the hugely popular, highly distinctive and world renowned FENDI Marks in connection with various articles of clothing and accessories for men, women and children, including, *inter alia*, pullovers, cardigans, sweaters, jerseys, jumpers, jackets, sweatshirts, parkas, bathing suits, blouses, shirts, trousers, jeans, waistcoats, skirts, shorts, T-shirts, dresses, men's suits, coats, raincoats, overcoats, fur coats and jackets, overalls, underwear, vests, hosiery and panty hose, bathrobes, shawls, scarves, neckties, gloves for clothing, belts for clothing, shoes, boots, sandals, slippers, clogs, hats and caps, and is the owner of numerous FENDI and FENDI composite marks, including, *inter alia*, incontestable FENDI Registration No. 1,244,466 and FF FENDI Registration 1,439,955 and FENDI Registration Nos. 4,409,049 and 4,549,739, respectively, and the goodwill associated with such marks (hereinafter individually and collectively referred to as the "FENDI Marks").

2. Opposer adopted and has continuously used its FENDI Marks in connection with various articles of clothing and accessories for men, women and children, including, *inter alia*, pullovers, cardigans, sweaters, jerseys, jumpers, jackets, sweatshirts, parkas, bathing suits, blouses, shirts, trousers, jeans, waistcoats, skirts, shorts, T-shirts, dresses, men's suits, coats, raincoats, overcoats, fur coats and jackets, overalls, underwear, vests, hosiery and panty hose, bathrobes, shawls, scarves, neckties, gloves for clothing, belts for clothing, shoes, boots, sandals, slippers, clogs, hats and caps, since decades prior to the filing date and alleged first use date of Applicant's FENDIE Application Serial No. 87/100,281.

3. Opposer has extensively advertised, promoted, marketed, and otherwise publicized goods bearing the FENDI Marks such that consumers have come to know and recognize the FENDI Marks as identifying goods which originate with, are authorized by, or otherwise identify, Opposer.

4. Applicant's use and registration of the virtually identical Applicant's FENDIE Mark in connection with the recited goods in International Class 25, which are identical and/or closely related to the goods marketed and sold by Opposer, constitutes use of a mark confusingly similar to Opposer's FENDI Marks.

5. Applicant's FENDIE Mark wholly subsumes Opposer's FENDI Mark, is virtually identical except for the letter "E" after "FENDI", is composed of two syllables, is pronounced the same, and is likely to be perceived by purchasers as either a variation or another of Opposer's FENDI Marks.

6. Applicant's FENDIE Goods are identical and/or at minimum closely related to the goods marketed and sold by Opposer under its FENDI Marks.

7. Applicant's FENDIE Mark is likely to be confused with Opposer's FENDI Marks insofar as the average purchaser is likely to be confused and deceived into believing that Applicant's products originate with, are in some way associated with, or are connected, sponsored or authorized by, Opposer.

8. Insofar as some of the recited goods are arguably not identical to some of the goods in Applicant's applied-for FENDIE application, consumers are likely to believe that Opposer has "bridged the gap" or expanded to additional related and/or complimentary goods within Opposer's Natural Zone of Expansion.

II.

Dilution Claim

9. Opposer respectfully repeats and re-alleges each and every allegation set forth at ¶ 1-8 above, as if fully set forth at length herein.

10. Opposer has been using its FENDI Marks throughout the United States and in many countries throughout the world for over three decades.

11. Opposer has invested substantial time, money and effort in marketing, advertising, promoting and selling its goods and services under the FENDI Marks and the FENDI Marks are both inherently distinctive and have acquired distinctiveness through use.

12. As of 2016, Opposer's sales of goods under the FENDI Marks have exceeded over one billion dollars in sales.

13. At the time that Applicant filed its FENDIE Application on October 21, 2013, Opposer's FENDI Marks were already distinctive and "famous" within the meaning of Lanham Act § 43(c) with the general consuming public of the United States.

14. Applicant's FENDIE Mark is virtually identical to Opposer's FENDI Mark.

15. Applicant's FENDIE Mark so resembles Opposer's FENDI Mark that relevant consumers will associate Applicant's Goods with Opposer's goods, even if they are not confused as to origin.

16. Applicant's applied-for FENDIE mark dilutes Opposer's FENDI Marks by causing dilution by blurring.

17. Upon information and belief, Applicant's Goods are inferior in quality, craftsmanship and style and given that Applicant's FENDIE Mark so resembles Opposer's

FENDI Mark, Applicant's FENDIE Mark will also cause Dilution by Tarnishment by harming the reputation of Opposer's FENDI Marks.

WHEREFORE, Opposer requests that this opposition be sustained and that FENDIE Application Serial No. 87/100,281 be refused registration.

Respectfully submitted,

LADAS & PARRY LLP
Attorneys for Opposer


Dated: March 28, 2017

By: 
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(Our Ref: C16688942)

CERTIFICATE OF TRANSMISSION

I, Reinaldo M. Roa, hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** has been transmitted electronically to the United States Patent and Trademark Office on the date indicated:

Dated: March 28, 2017


Reinaldo M. Roa