

ESTTA Tracking number: **ESTTA878683**

Filing date: **02/21/2018**

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	Essential Export, S.A.		
Entity	sociedad anonima	Citizenship	Costa Rica
Address	Santa Ana Forum II Edificio Pacheco Coto San Jose, 0 COSTA RICA		

Attorney information	Mary Catherine Merz Merz & Associates, P.C. 1010 Lake Street, Suite 400 Oak Park, IL 60301 UNITED STATES Email: docket@merz-law.com, jwidmer@merz-law.com, lhar- kins@merz-law.com Phone: 7083838801		
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**Applicant Information**

Application No	79190976	Publication date	01/23/2018
Opposition Filing Date	02/21/2018	Opposition Period Ends	02/22/2018
International Registration No.	1307301	International Registration Date	06/13/2016
Applicant	Fotokinesis 200 Strand London WC2R1DJ UNITED KINGDOM		

**Goods/Services Affected by Opposition**

<p>Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Printed matter, namely, note books, children's activity books, magazines for children; children's educational books in the field of math, science, environment, art, photography and history and magazines for children; books and magazines relating to children's education, namely, math, science, environment, art, photography and history workbooks; paper tags, trading cards; photographs; stationery; artists' materials, namely, paint-brushes, paints, molds for modeling clays, pencils, pencil cases; instructional and teaching material, namely, instructional and teaching materials in the nature of math, science, environment, art, photography, history workbooks, children's activity pamphlets, children's activity brochures, teaching tiles and flash and activity cards, in the field of children's education; children's activity booklets; cardboard; cardboard packaging; cardboard gift boxes; paper; post cards</p>
<p>Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bags, namely, sports bags, beach bags, children's all-purpose bags, cosmetic bags sold empty, gym bags, holdalls, back packs with rolling wheels, lumbar packs, fanny packs, back packs, waist packs, sports packs; suitcases; rucksacks;</p>

trunks and travelling bags; purses; umbrellas and parasols; leather; leather bags; leather pouches; leather cases and passport covers

Class 035. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Retail store services featuring bags, rucksacks, travelling bags, stationery, toys, games and playthings

## Grounds for Opposition


Priority and likelihood of confusion

Trademark Act Section 2(d)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3760012	Application Date	02/04/2009
Registration Date	03/16/2010	Foreign Priority Date	NONE
Word Mark	TOTTO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2006/11/27 First Use In Commerce: 2006/11/27 Suitcases and trunks made of canvas, synthetic materials, leather and leather imitations; traveling bags, carry on bags, duffle bags, brief-case type portfolios, purses, and wallets made of leather and imitation leather, except backpacks designed for the practice of sports Class 025. First use: First Use: 2006/11/27 First Use In Commerce: 2006/11/27 Clothing, namely, shirts, pants, shorts; outerwear, namely, jackets; headwear and footwear, except beachwear and sportswear, and excluding footwear for the practice of sports Class 035. First use: First Use: 2006/11/27 First Use In Commerce: 2006/11/27 Retail store services featuring clothing, headwear, footwear excluding footwear for the practice of sports, and a variety of bags and fashion accessories, except beachwear and goods designed for the practice of sports		

U.S. Application No.	87391110	Application Date	03/29/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TOTTO TÅ#		

Design Mark	
Description of Mark	The mark consists of the wording "TOTTOTÃ#" in stylized font.
Goods/Services	<p>Class 018. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01  Goods of leather, imitation leather, canvas and synthetic materials, namely, trunks, valises, carrying cases, portfoliobags, handbags, wallets and backpacks, except for backpacks designed for the practice of sports; umbrellas, parasols and walking sticks, except goods designed for the practice of sports</p> <p>Class 025. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01  Clothing, namely, shirts, pants, shorts, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports; outerwear, namely, jackets, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports; headwear and footwear, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports</p> <p>Class 035. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01  Retail store services featuring clothing, headwear, footwear and a variety of bags and fashion accessories, except beachwear, sportswear, and footwear for the practice of sports and not including eyewear and backpacks designed for the practice of sports and sporting goods</p>

Attachments	77663337#TMSN.png( bytes ) 87391110#TMSN.png( bytes ) 02.21.18 TOTOPAK notice of opposition 25038.pdf(307876 bytes )
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Signature	/Lisa A. Harkins/
Name	Lisa A. Harkins
Date	02/21/2018

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

In the Matter of U.S. Application Serial No. 79/190,976  
For: TOTOPAK  
Filed: June 13, 2016  
Date of Publication: January 23, 2018

ESSENTIAL EXPORT S.A.	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
FOTOKINESIS	)	
Applicant.	)	
	)	

NOTICE OF OPPOSITION

Opposer, Essential Export, S.A. ("Opposer"), a sociedad anonima organized under the laws of Costa Rica, with its principal place of business at Santa Ana Forum, Il Edificio Pacheco Coto, San Jose, Costa Rica, believes it will be damaged by registration of the TOTOPAK mark, U.S. Serial No. 79/190,976, and hereby opposes the same, in accordance with Section 13 of The Trademark (Lanham) Act of 1946, 15 U.S.C. §1063. This opposition pertains to the goods and services in Classes 16, 18 and 35 only.

As grounds for the opposition, Essential Export, S.A. alleges as follows:

1. Upon information and belief, Fotokinesis is a United Kingdom limited company with its principal place of business at 200 Strand, London, WC2R1DJ, United Kingdom ("Applicant").

2. As evidenced by the publication of Serial No. 79/190,976 in the Official Gazette of January 23, 2018, Applicant seeks to register TOTOPAK (the "Opposed Mark") in connection with the following goods and services:

"Printed matter, namely, note books, children's activity books, magazines for children; children's educational books in the field of math, science, environment, art, photography and history and magazines for children; books and magazines relating to children's education, namely, math, science, environment, art, photography and history workbooks; paper tags, trading cards; photographs; stationery; artists' materials, namely, paintbrushes, paints, molds for modeling clays, pencils, pencil cases; instructional and teaching material, namely, instructional and teaching materials in the nature of math, science, environment, art, photography, history workbooks, children's activity pamphlets, children's activity brochures, teaching tiles and flash and activity cards, in the field of children's education; children's activity booklets; cardboard; cardboard packaging; cardboard gift boxes; paper; post cards" in Class 16;

"Bags, namely, sports bags, beach bags, children's all-purpose bags, cosmetic bags sold empty, gym bags, holdalls, back packs with rolling wheels, lumbar packs, fanny packs, back packs, waist packs, sports packs; suitcases; rucksacks; trunks and travelling bags; purses; umbrellas and parasols; leather; leather bags; leather pouches; leather cases and passport covers" in Class 18;

"Toys, Games and playthings, namely, board games, dice games, playing cards, dolls, card games, soft toys, toy building blocks; play balls, beach balls; gymnastic articles, namely, mats and sporting articles and equipment, namely, tennis balls, footballs, net balls, hand balls, sports rackets, skipping ropes" in Class 28; and

"Retail store services featuring bags, rucksacks, travelling bags, stationery, toys, games and playthings" in Class 35.

3. Upon information and belief, Applicant filed Serial No. 79/190,976 on June 13, 2016 as an extension of protection under the Madrid Protocol in connection with Applicant's International Registration No.1307301.

4. For nearly ten years prior to the filing date of Serial No. 79/190,976, Opposer adopted and has continuously used its TOTTO trademark in connection with various types of bags, including suitcases, trunks, traveling bags, carry-on bags, duffle bags, briefcase-type portfolios, purses, wallets, backpacks and backpacks with a laptop/tablet pocket. Such use has not been abandoned, and the public has come to associate Opposer's goods with the TOTTO mark.

5. Prior to the filing date of Serial No. 79/190,976 Opposer has expanded its trademark use of TOTTO to cover numerous additional products and services including, but not limited to, books, notebooks, pencil cases and retail store services.

6. Opposer is the owner of the following U.S. Trademark registration:

Registration No. 3,760,012 for TOTTO Stylized for "Suitcases and trunks made of canvas, synthetic materials, leather and leather imitations; traveling bags, carry on

bags, duffle bags, brief-case type portfolios, purses, and wallets made of leather and imitation leather, except backpacks designed for the practice of sports" in Class 18, "Clothing, namely, shirts, pants, shorts; outerwear, namely, jackets; headwear and footwear, except beachwear and sportswear, and excluding footwear for the practice of sports" in Class 25, and "Retail store services featuring clothing, headwear, footwear excluding footwear for the practice of sports, and a variety of bags and fashion accessories, except beachwear and goods designed for the practice of sports" in Class 35 (see Exhibit A).

This registration is valid, subsisting, uncancelled and is evidence of Opposer's exclusive right to use TOTTO Stylized in commerce in connection with the goods and services specified in the registration.

7. Opposer also owns the following U.S. Trademark Application, with a filing date of March 29, 2017 and claiming a first use and first use in commerce date of December 1, 2008:

Application Serial No. 87/391,110 for TOTTO TU and Design for "Goods of leather, imitation leather, canvas and synthetic materials, namely, trunks, valises, carrying cases, portfolio bags, handbags, wallets and backpacks, except for backpacks designed for the practice of sports; umbrellas, parasols and walking sticks, except goods designed for the practice of sports" in Class 18; "Clothing, namely, shirts, pants, shorts, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports; outerwear, namely, jackets, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports; headwear and footwear, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports" in Class 25; and "Retail store services featuring clothing, headwear, footwear and a variety of bags and fashion accessories, except beachwear, sportswear, and footwear for the practice of sports and not including eyewear and backpacks designed for the practice of sports and sporting goods" in Class 35 (see Exhibit B).

10. Applicant has no license, consent or permission from Opposer to use or register the Opposed Mark.

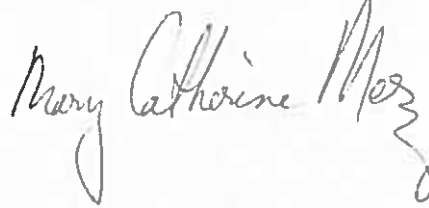
11. The Opposed Mark so resembles Opposer's TOTTO and TOTTO Stylized marks that it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of The Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(d); and more particularly, the Opposed Mark and use thereof are likely to cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that the goods and services in Classes 16, 18 and 35 in Serial No. 79/190,976 originate with Opposer or otherwise are authorized, licensed or sponsored by Opposer.

12. By reason of all the foregoing, Opposer will be damaged by the registration of the Opposed Mark for the goods and services covered by Serial No. 79/190,976 in Classes 16, 18 and 35, because registration of the mark would be in violation of Opposer's trademark rights.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained in favor of Opposer and that the goods and services in Classes 16, 18 and 35 in Serial No. 79/190,976 be denied registration. Essential Export S.A. submits herewith its payment of the \$1,200 filing fee, as required by 37 C.F.R. §2.6(a)(17).

Respectfully submitted,

ESSENTIAL EXPORT S.A.



Date: February 21, 2018 By: \_\_\_\_\_

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EXHIBIT A



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# TOTTO

**Word Mark** TOTTO**Goods and Services** IC 018. US 001 002 003 022 041. G & S: Suitcases and trunks made of canvas, synthetic materials, leather and leather imitations; traveling bags, carry on bags, duffle bags, brief-case type portfolios, purses, and wallets made of leather and imitation leather, except backpacks designed for the practice of sports. FIRST USE: 20061127. FIRST USE IN COMMERCE: 20061127

IC 025. US 022 039. G &amp; S: Clothing, namely, shirts, pants, shorts; outerwear, namely, jackets; headwear and footwear, except beachwear and sportswear, and excluding footwear for the practice of sports. FIRST USE: 20061127. FIRST USE IN COMMERCE: 20061127

IC 035. US 100 101 102. G &amp; S: Retail store services featuring clothing, headwear, footwear excluding footwear for the practice of sports, and a variety of bags and fashion accessories, except beachwear and goods designed for the practice of sports. FIRST USE: 20061127. FIRST USE IN COMMERCE: 20061127

**Mark Drawing Code** (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM**Serial Number** 77663337**Filing Date** February 4, 2009**Current Basis** 1A**Original Filing Basis** 1A**Published for Opposition** December 29, 2009**Change In Registration** CHANGE IN REGISTRATION HAS OCCURRED**Registration Number** 3760012

**Registration Date** March 16, 2010

**Owner** (REGISTRANT) Nalsani, S.A. sociedad anonima COLOMBIA Carrera 43 A No. 20 C-55 Bogota COLOMBIA  
(LAST LISTED OWNER) ESSENTIAL EXPORT S.A. SOCIEDAD ANONIMA COSTA RICA SANTA ANA FORUM IL EDIFICIO PACHECO COTO SAN JOSE COSTA RICA

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Mary Catherine Merz

**Prior Registrations** 2720222;2791616

**Description of Mark** Color is not claimed as a feature of the mark.

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Affidavit Text** SECT 15. SECT 8 (6-YR).

**Live/Dead Indicator** LIVE

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EXHIBIT B


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**Word Mark** TOTTO TÚ

**Translations** The English translation of "TÚ" in the mark is "YOU". The wording "TOTTO" has no meaning in a foreign language.

**Goods and Services** IC 018. US 001 002 003 022 041. G & S: Goods of leather, imitation leather, canvas and synthetic materials, namely, trunks, valises, carrying cases, portfolio bags, handbags, wallets and backpacks, except for backpacks designed for the practice of sports; umbrellas, parasols and walking sticks, except goods designed for the practice of sports. FIRST USE: 20081201. FIRST USE IN COMMERCE: 20081201

IC 025. US 022 039. G & S: Clothing, namely, shirts, pants, shorts, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports; outerwear, namely, jackets, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports; headwear and footwear, except beachwear, sportswear, and footwear for the practice of sports and goods for use in playing sports. FIRST USE: 20081201. FIRST USE IN COMMERCE: 20081201

IC 035. US 100 101 102. G & S: Retail store services featuring clothing, headwear, footwear and a variety of bags and fashion accessories, except beachwear, sportswear, and footwear for the practice of sports and not including eyewear and backpacks designed for the practice of sports and sporting goods. FIRST USE: 20081201. FIRST USE IN COMMERCE: 20081201

**Mark Drawing Code** (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

**Serial Number** 87391110

**Filing Date** March 29, 2017

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** February 20, 2018

**Owner** (APPLICANT) Essential Export S.A. sociedad anonima (sa) COSTA RICA II Edificio Pacheco Coto Santa Ana Forum San Jose COSTA RICA CuartoPis

**Attorney of Record** Mary Catherine Merz

**Prior Registrations** 3760012

**Description of Mark** Color is not claimed as a feature of the mark. The mark consists of the wording "TOTTO TÚ" in stylized font.

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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