

ESTTA Tracking number: **ESTTA877438**

Filing date: **02/14/2018**

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	Naked Brand Group, Inc.
Granted to Date of previous extension	04/04/2018
Address	311 S. Division Street Carson City, NV 89703 UNITED STATES
Attorney information	Michael J. Leonard Fox Rothschild LLP 997 Lenox Drive, Bldg. 3 Lawrenceville, NJ 08648-2311 UNITED STATES Email: ipdocket@foxrothschild.com, mleonard@foxrothschild.com

Applicant Information

Application No	87574339	Publication date	12/05/2017
Opposition Filing Date	02/14/2018	Opposition Period Ends	04/04/2018
Applicant	MeCommerce, Inc. 350 Rhode Island St. Ste 360 San Francisco, CA 94103 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2017/08/14 First Use In Commerce: 2017/08/14 All goods and services in the class are opposed, namely: Bras; Lingerie; Panties; Undergarments; Underwear
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Applicant Information

Application No	87574340	Publication date	12/05/2017
Opposition Filing Date	02/14/2018	Opposition Period Ends	
Applicant	MeCommerce, Inc. 350 Rhode Island St. Ste 360 San Francisco, CA 94103 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2017/08/14 First Use In Commerce: 2017/08/14 All goods and services in the class are opposed, namely: Bras; Lingerie; Panties; Undergar-

ments;Underwear

Applicant Information

Application No	87574337	Publication date	12/05/2017
Opposition Filing Date	02/14/2018	Opposition Period Ends	
Applicant	MeCommerce, Inc. 350 Rhode Island St. Ste 360 San Francisco, CA 94103 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2017/08/14 First Use In Commerce: 2017/08/14
All goods and services in the class are opposed, namely: Bras; Lingerie; Panties; Undergarments;Underwear

Applicant Information

Application No	87574343	Publication date	12/05/2017
Opposition Filing Date	02/14/2018	Opposition Period Ends	
Applicant	MeCommerce, Inc. 350 Rhode Island St. Ste 360 San Francisco, CA 94103 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2017/08/14 First Use In Commerce: 2017/08/14
All goods and services in the class are opposed, namely: Bras; Lingerie; Panties; Undergarments;Underwear

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3669650	Application Date	10/23/1998
Registration Date	08/18/2009	Foreign Priority Date	NONE
Word Mark	NAKED		

Design Mark	<h1>NAKED</h1>
Description of Mark	NONE
Goods/Services	<p>Class 025. First use: First Use: 1998/06/01 First Use In Commerce: 2009/05/09 [MEN'S CLOTHING, namely, CAPS;] T-SHIRTS, TOPS, [TANK TOPS, JACKETS, PANTS, TROUSERS, JEANS, SHORTS;] LOUNGEWEAR, [ROBES, BATHROBES,] PAJAMAS, BOXER SHORTS, UNDERGARMENTS, [SWIMWEAR, BATHING TRUNKS; WOMEN'S CLOTHING, NAMELY, CAPS; T-SHIRTS,] TANK TOPS, [CROP TOPS, BLOUSES, DRESSES, SKIRTS, PANTS, JEANS, COATS,] LINGERIE, BRAS, [UNDERGARMENTS, UNDERGARMENT THONGS, BUSTIERS, CORSETS,] CAMISOLES, CHEMISES, NIGHTGOWNS, PEIGNOIRSETS, TEDDIES, PAJAMAS, ROBES, BATHROBES, [SWIMWEAR, BATHING SUITS, BEACH THONGS]</p>

Attachments	75568492#TMSN.png(bytes) NAKED 1-4 Notice of Opposition.pdf(18274 bytes)
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Signature	/mjl/
Name	Michael J. Leonard
Date	02/14/2018

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

RE: U.S. Trademark Application Serial No. 87/574339
U.S. Trademark Application Serial No. 87/574340
U.S. Trademark Application Serial No. 87/574337
U.S. Trademark Application Serial No. 87/574343
Published in the Official Gazette on 5 December 2017

NAKED BRAND GROUP, INC.)
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Opposer)
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-v-)
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MECOMMERCE, INC. DBA THIRDLOVE)
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Applicant)
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_____)

Opposition No. _____

CONSOLIDATED NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

In the matter of Application Serial No. 87/574339 for NAKED-1; Application Serial No. 87/574340 for NAKED-2; Application Serial No. 87/574337 for NAKED-3; and Application Serial No. 87/574343 for NAKED-4, all filed 18 August 2017 by Mecommerce, Inc. DBA Thirdlove (“Applicant”), to register the foregoing marks for goods described as "Bras; Lingerie; Panties; Undergarments; Underwear” in International Class 025 (“Applicant’s Goods”), which were published in the Official Gazette on 5 December 2017, Naked Brand Group Inc. (“Opposer”) of Carson City, Nevada believes it will be damaged by the registration of the

NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is a Delaware Corporation having an address at 350 Rhode Island St. Ste 360, San Francisco, CA 94103.

2. On 18 August 2017, Applicant filed Application Serial Nos. 87/574339 for NAKED-1; 87/574340 for NAKED-2; 87/574337 for NAKED-3; and 87/574343 for NAKED-4 for Applicant's Goods based on Applicant's alleged claim of use in the United States since 14 August 2017.

3. Opposer, Naked Brand Group Inc., is a Nevada corporation and the owner of the NAKED fashion brand.

4. Opposer is using, has invested substantial resources in advertising, promoting and selling its goods, and has acquired substantial goodwill and notoriety in its NAKED trademark.

5. Opposer is the owner of U.S. Registration No. 3,669,650 for the mark NAKED, covering goods described as “t-shirts, tops, loungewear, pajamas, boxer shorts, undergarments, tank tops, lingerie, bras, camisoles, chemises, nightgowns, peignoir sets, teddies, pajamas, robes, bathrobes,” in International Class 025 (collectively “Opposer’s Goods”). Opposer’s U.S. Registration No. 3,669,650 is incontestable and entitled to a constructive date of first use of 23 March 1998.

6. The foregoing Registration is not limited by channels of trade or classes of purchasers. Opposer's Registration is valid, subsisting and is *prima facie* evidence of the validity of the registered Mark set forth therein, and Opposer's exclusive right to use the registered Mark set forth therein in connection with the goods specified in the registration.

7. The filing date and registration date of Applicant's NAKED Registration precedes Applicant's 18 August 2017 filing dates and Applicant's alleged 14 August 2017 dates of first use.

8. Commencing prior to Applicant's filing dates, Opposer commenced its use of the NAKED Mark on various items of clothing, including those goods set forth in Registration No. 3,669,650.

9. Opposer will rely upon its ownership of its federal trademark registration for the mark NAKED and the common law rights it has obtained through its prior and continuous use of its NAKED Mark in commerce throughout the United States dating back to at least as early as June of 1998.

10. Since its initial use of the NAKED Mark, Opposer has made a substantial investment in advertising, promoting and selling Opposer's Goods under its NAKED Mark. Opposer has extensively used, advertised, promoted, offered, and sold Opposer's Goods to the public through various channels of trade in commerce, including the internet. Opposer's customers and the public in general know and recognize Opposer's NAKED Mark and associate same with Opposer and/or Opposer's Goods. Opposer has built extensive notoriety and goodwill in connection with the offering of goods under Opposer's NAKED Mark.

11. Applicant's filing of Application Serial Nos. 87/574339 for NAKED-1; 87/574340 for NAKED-2; 87/574337 for NAKED-3; and 87/574343 for NAKED-4 is without license, authorization or permission from Opposer.

**FIRST GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - FEDERAL)**

12. Opposer re-alleges the allegations contained in paragraphs 1 through 11 of this Notice of Opposition.

13. Applicant's NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks fully incorporate Opposer's NAKED Mark, and are likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

14. Applicant's filing dates of 18 August 2017 are subsequent to the filing and registration dates of Opposer's NAKED Registration as set forth above.

15. Opposer's and Applicant's Goods are identical and are offered or are likely to be offered through the same channels of trade and purchased and used by the same class of purchasers. Applicant's Goods are not limited and are thus, presumed to travel in the same channels of trade, including those utilized for Opposer's Goods, to the same class(es) of consumers. The inclusion of the -1, -2, -3 and -4 terms in conjunction with the NAKED term to form Applicant's composite NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks is insufficient to avoid confusion, mistake or wrongful association between the respective parties' goods, especially given the fact that Applicant's Goods are identical to those of Opposer.

16. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement and sponsorship of Applicant's Goods sold, offered for sale, and marketed under Applicant's NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks and misled into believing that such Goods are produced, distributed, offered, sold, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

17. Opposer will be damaged by Applicant's registration of the NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks as set forth in Application Serial Nos. 87/574339, 87/574340, 87/574337 and 87/574343 in that Applicant's marks are confusingly similar to Opposer's NAKED Mark and are intended to be used in connection with Goods identical to, and/or closely related to Opposer's Goods.

18. Applicant's registration of the NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its NAKED Mark.

**SECOND GROUND FOR OPPOSITION
(LIKELIHOOD OF CONFUSION - COMMON LAW)**

19. Opposer re-alleges the allegations contained in paragraphs 1 through 18 of this Notice of Opposition.

20. Opposer uses the NAKED Mark to identify Opposer's Goods, specifically its clothing products.

21. Applicant's NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks fully incorporate Opposer's NAKED Mark and are likely, when used in connection with Applicant's Goods, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

22. Applicant's alleged 14 August 2017 date of first use as set forth in Application Serial Nos. 87/574339, 87/574340, 87/574337 and 87/574343 is subsequent to Opposer's date of first use of its NAKED Mark.

23. Opposer's Goods and Applicant's Goods are identical and are offered through the same channels of trade and purchased by the same class of purchasers.

24. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Goods sold and marketed under Applicant's NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks and misled into believing that such goods are produced by, offered by, sold by, emanate from or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

25. Opposer will be damaged by the registration of the NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks as set forth in Application Serial Nos. 87/574339, 87/574340, 87/574337 and 87/574343 in that Applicant's marks are confusingly similar in appearance, sound and commercial impression to Opposer's NAKED Mark, thereby violating Opposer's common law rights in its trademark.

26. Registration of Applicant's NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks should not be granted as it is contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its NAKED Mark.

WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial Nos. 87/574339, 87/574340, 87/574337 and 87/574343 for the NAKED-1, NAKED-2, NAKED-3 and NAKED-4 marks be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

Date: 14 February 2018

By: s/michael leonard/
Michael J. Leonard
Gerard P. Norton
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Lawrenceville, NJ 08648-2311
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*Attorneys for Opposer
Naked Brand Group Inc.*

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served on Applicant this 14th day of February 2018 by sending same via e-mail to:

Kent M. Walker
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San Diego, CALIFORNIA UNITED STATES 92128
kwalker@lewiskohn.com

By: /michael leonard./