

ESTTA Tracking number: **ESTTA948023**

Filing date: **01/16/2019**

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	Jean Patou
Granted to Date of previous extension	01/16/2019
Address	24/32 rue Jean Goujon Paris, 75008 FRANCE

Attorney information	Ronald E. Shapiro Shapiro and Silverstein PLLC 11350 Random Hills Road, Suite 740 Fairfax, VA 22030 UNITED STATES rshapiro@sasiplaw.com 703-273-7680
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Applicant Information

Application No	79223318	Publication date	09/18/2018
Opposition Filing Date	01/16/2019	Opposition Period Ends	01/16/2019
International Registration No.	1380724	International Registration Date	02/22/2017
Applicant	PROFUMI DI PANTELLERIA S.R.L. Strada Scaglia Est, 144 I-41126 Modena (MO) ITALY		

Goods/Services Affected by Opposition

Class 003. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Bleaching preparations for laundry use; other substances for laundry use, namely scented laundry detergents and fabric softeners; cleaning, polishing, scouring and abrasive preparations; non-medicated soap; perfumery, essential oils, cosmetics, hair lotions; dentifrices; color cosmetics for the eyes; beauty care cosmetics; cosmetics for animals; eye make-up; cosmetic preparations for eyelashes; lip cosmetics; eyebrow cosmetics; cosmetics for protecting the skin from sunburn; cosmetics for dermatological use; cosmetics in the form of oils; cosmetics in the form of milks; cosmetics in the form of gels; cosmetics in the form of powders; cosmetics in the form of lotions; cosmetics in the form of eye shadow; cosmetics in the form of rouge; cosmetics in the form of creams; cosmetic kits comprised primarily of cosmetics and make-up; cotton wool for cosmetic purposes; lotions for cosmetic purposes; glitter in spray form for use as cosmetics; make-up preparations; beauty masks; cosmetic pencils; coloring preparations for cosmetic purposes; sun-tanning cosmetic preparations; decorative cosmetics; cosmetic hair dressing preparations; cos-


metic facial preparations; cosmetic preparations for the shower; pre-moistened cosmetic wipes; wipes impregnated with cleaning preparations; cosmetic body scrubs; serums for cosmetic purposes; temporary tattoos for cosmetic purposes; cosmetic dyes; toners for cosmetic use; artificial nails for cosmetic purposes; perfumed toilet waters; perfumed face powder for cosmetic use; deodorants for human beings or for animals; extracts of perfumes; scented wood; essential oils as perfume for laundry purposes; essential oils for use in the manufacture of scented products; natural oils for perfumes; perfumed talcum powder, perfumed potpourris; perfumery; air fragrancing preparations; products for perfuming linen in the nature of perfume; natural perfumery; synthetic perfumery; perfumes for cardboard; perfumes for ceramics; perfumes for industrial purposes; liquid perfumes; solid perfumes; perfuming sachets; scented bathing salts, not for medical purposes; perfumed extracts for tissues and perfumes; non-medicated scented soaps; perfumed soaps

Grounds for Opposition

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

U.S. Registration No.	529337	Application Date	03/19/1948
Registration Date	08/22/1950	Foreign Priority Date	NONE
Word Mark	JOY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1931/10/00 First Use In Commerce: 1931/10/00 PERFUMES AND TOILET WATERS		

U.S. Registration No.	5255628	Application Date	01/05/2017
Registration Date	08/01/2017	Foreign Priority Date	NONE
Word Mark	JOY		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 003. First use: First Use: 2007/00/00 First Use In Commerce: 2007/00/00 Bar soap; Body cream

Attachments	71552488#TMSN.png(bytes) 87289979#TMSN.png(bytes) Notice of Opposition.pdf(173012 bytes)
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Signature	/Ronald E. Shapiro/
Name	Ronald E. Shapiro
Date	01/16/2019

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

JEAN PATOU,

Opposer,

v.

PROFUMI DI PANTELLERIA S.R.L.,

Applicant.

Opposition No. _____

Serial No. 79223318

Mark: JOYANN

NOTICE OF OPPOSITION

In the matter of Application Serial No. 79223318 (“the Opposed Application”), filed by PROFUMI DI PANTELLERIA S.R.L. (“Applicant”) on February 22, 2017, and published in the Official Gazette on September 18, 2018, Jean Patou (“Opposer”), a company organized under the laws of France, with a place of business at 24/32 rue Jean Goujon, 75008 Paris, France, believes that it will be damaged by registration of the mark shown in the Opposed Application. The time for Opposer to file this Notice of Opposition has been extended to January 16, 2019.

The grounds for this opposition are:

1. Opposer owns the United States trademark registrations listed below in this paragraph for the mark JOY (“Opposer’s Mark”).

<u>Registration No.</u>	<u>Registration Date</u>	<u>Goods</u>
529,337	August 22, 1950	Perfumes and toilet waters
5,255,628	August 1, 2017	Bar soap and body cream

The listed registrations are referred to in this Notice of Opposition as “Opposer’s Registrations,” and the goods covered by Opposer’s Registrations are referred to in this Notice of Opposition as “Opposer’s Goods.”

2. Printouts from the electronic records of the United States Patent and Trademark Office showing the status and title of Opposer’s Registrations are attached to this Notice of Opposition as Exhibit A.

3. The Opposed Application seeks to register the mark JOYANN (“Applicant’s Mark”) for the following goods (“Applicant’s Goods”):

Bleaching preparations for laundry use; other substances for laundry use, namely scented laundry detergents and fabric softeners; cleaning, polishing, scouring and abrasive preparations; non-medicated soap; perfumery, essential oils, cosmetics, hair lotions; dentifrices; color cosmetics for the eyes; beauty care cosmetics; cosmetics for animals; eye make-up; cosmetic preparations for eyelashes; lip cosmetics; eyebrow cosmetics; cosmetics for protecting the skin from sunburn; cosmetics for dermatological use; cosmetics in the form of oils; cosmetics in the form of milks; cosmetics in the form of gels; cosmetics in the form of powders; cosmetics in the form of lotions; cosmetics in the form of eye shadow; cosmetics in the form of rouge; cosmetics in the form of creams; cosmetic kits comprised primarily of cosmetics and make-up; cotton wool for cosmetic purposes; lotions for cosmetic purposes; glitter in spray form for use as cosmetics; make-up preparations; beauty masks; cosmetic pencils; coloring preparations for cosmetic purposes; sun-tanning cosmetic preparations; decorative cosmetics; cosmetic hair dressing preparations; cosmetic facial preparations; cosmetic preparations for the shower;

pre-moistened cosmetic wipes; wipes impregnated with cleaning preparations; cosmetic body scrubs; serums for cosmetic purposes; temporary tattoos for cosmetic purposes; cosmetic dyes; toners for cosmetic use; artificial nails for cosmetic purposes; perfumed toilet waters; perfumed face powder for cosmetic use; deodorants for human beings or for animals; extracts of perfumes; scented wood; essential oils as perfume for laundry purposes; essential oils for use in the manufacture of scented products; natural oils for perfumes; perfumed talcum powder, perfumed potpourris; perfumery; air fragrancng preparations; products for perfuming linen in the nature of perfume; natural perfumery; synthetic perfumery; perfumes for cardboard; perfumes for ceramics; perfumes for industrial purposes; liquid perfumes; solid perfumes; perfuming sachets; scented bathing salts, not for medical purposes; perfumed extracts for tissues and perfumes; non-medicated scented soaps; perfumed soaps.

4. Opposer's Registration No. 529,337 was issued before the filing date of the Opposed Application and, on information and belief, before any use of Applicant's Mark in commerce in connection with Applicant's Goods.

5. The application that matured into Opposer's Registration No. 5,255,628, was filed before the Opposed Application and, on information and belief, before any use of Applicant's Mark in commerce in connection with Applicant's Goods.

6. Applicant's Goods and Opposer's Goods are identical or related.

7. Applicant's Goods and Opposer's Goods are likely to be advertised and sold in the same or similar channels of trade.

8. Applicant's Goods and Opposer's Goods are likely to be purchased by the same classes of consumers.

9. Applicant's Mark so closely resembles Opposer's Mark as to be likely, when used in connection with Applicant's Goods, to cause confusion, or to cause mistake, or to deceive.

10. For the reasons stated above, Opposer is likely to be damaged by the registration of Applicant's Mark.

WHEREFORE, Opposer prays that this opposition be sustained.

Respectfully submitted,

Date: January 16, 2019

/Ronald E. Shapiro/
Ronald E. Shapiro
Shapiro and Silverstein PLLC
11350 Random Hills Road, Suite 740
Fairfax, Virginia 22030
Tel: 703-273-7680
Email: rshapiro@sasiplaw.com
Attorneys for Opposer

Exhibit A to Notice of Opposition

JEAN PATOU v. PROFUMI DI PANTELLERIA S.R.L.

Opposition to Application Serial No. 79223318

Due to high-volume usage, you may experience intermittent issues on the Trademark Status and Document Retrieval (TSDR) system between 6 – 8 a.m. ET. Refreshing your web browser should resolve the issue. If you still need assistance accessing a document, email teas@uspto.gov and include your serial number, the document you are looking for, and a screenshot of any error messages you have received.

Starting Oct. 4, 2018, bulk data customers should no longer obtain direct access to TSDR data through tsdrsec.uspto.gov. [There are two alternative ways to receive bulk data from TSDR.](#)

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Mark: JOY

JOY

US Serial Number: 71552488

Application Filing Date: Mar. 19, 1948

US Registration Number: 529337

Registration Date: Aug. 22, 1950

Register: Principal

Mark Type: Trademark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: May 21, 2010

Mark Information

Mark Literal Elements: JOY

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

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: PERFUMES AND TOILET WATERS

International Class(es): 003

U.S Class(es): 051 - Primary Class

Class Status: ACTIVE

Basis: 1(a)

First Use: Oct. 1931

Use in Commerce: Oct. 1931

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: JEAN PATOU

Owner Address: 24/32 RUE JEAN GOUJON
75008 PARIS FRANCE

Legal Entity Type: COMPANY

State or Country Where Organized: FRANCE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Ronald E. Shapiro

Docket Number: TM-11258

Attorney Primary Email rshapiro@sasiplaw.com
Address:

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Ronald E. Shapiro
Shapiro and Silverstein PLLC
11350 Random Hills Road, Suite 740
Fairfax, VIRGINIA UNITED STATES 22030

Phone: 703-273-7680

Fax: 703-273-7684

Correspondent e-mail: rshapiro@sasiplaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Ronald E. Shapiro

Phone: 703-273-7680

Fax: 703-273-7684

Domestic Representative e-mail: rshapiro@sasiplaw.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Sep. 12, 2018	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Nov. 17, 2017	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Nov. 17, 2017	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Mar. 14, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
May 21, 2010	REGISTERED AND RENEWED (FOURTH RENEWAL - 10 YRS)	75184
May 21, 2010	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Apr. 22, 2010	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	75184
Apr. 22, 2010	TEAS RESPONSE TO OFFICE ACTION-POST REG RECEIVED	
Apr. 14, 2010	POST REGISTRATION ACTION MAILED - SEC. 8 & 9	75184
Apr. 11, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75184
Apr. 09, 2010	TEAS SECTION 8 & 9 RECEIVED	
Oct. 09, 2008	CASE FILE IN TICRS	
Sep. 09, 2006	REVIEW OF CORRESPONDENCE COMPLETE	74215
Aug. 21, 2006	PAPER RECEIVED	
Nov. 07, 2000	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	
Nov. 07, 2000	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Mar. 10, 2000	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Jun. 04, 1990	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	
Mar. 07, 1990	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Aug. 22, 1970	REGISTERED AND RENEWED (FIRST RENEWAL - 20 YRS)	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Aug. 22, 2010

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: May 21, 2010

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Mark: JOY

JOY

US Serial Number: 87289979

Application Filing Date: Jan. 05, 2017

US Registration Number: 5255628

Registration Date: Aug. 01, 2017

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:

The trademark application has been registered with the Office.



Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Aug. 01, 2017

Publication Date: May 16, 2017

Mark Information

Mark Literal Elements: JOY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US [0529337](#), [4516831](#)

Registrations:

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: Bar soap; Body cream

International Class(es): 003 - Primary Class

U.S Class(es): 001, 004, 006, 050, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: 2007

Use in Commerce: 2007

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: JEAN PATOU

Owner Address: 24/32 RUE JEAN GOUJON
75008 PARIS FRANCE

Legal Entity Type: COMPANY

State or Country Where Organized: FRANCE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Ronald E. Shapiro

Docket Number: TM-11180

Attorney Primary Email Address: rshapiro@sasiplaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: RONALD E. SHAPIRO
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FAIRFAX, VIRGINIA UNITED STATES 22030

Phone: 703-273-7680

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Correspondent e-mail: rshapiro@sasiplaw.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: Ronald E. Shapiro

Phone: 703-273-7680

Fax: 703-273-7684

Domestic Representative e-mail: rshapiro@sasiplaw.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Sep. 12, 2018	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 01, 2017	REGISTERED-PRINCIPAL REGISTER	
Jun. 09, 2017	CHANGES/CORRECTIONS AFTER PUB APPROVAL ENTERED	67832
Jun. 09, 2017	ASSIGNED TO PETITION STAFF	67832
Jun. 06, 2017	TEAS POST PUBLICATION AMENDMENT RECEIVED	1111
May 16, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
May 16, 2017	PUBLISHED FOR OPPOSITION	
Apr. 26, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Apr. 05, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 30, 2017	ASSIGNED TO EXAMINER	93410
Jan. 12, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 09, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PETITIONS OFFICE

Date in Location: Jun. 09, 2017

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