

ESTTA Tracking number: **ESTTA1012333**

Filing date: **10/30/2019**

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	Kurt Geiger Limited		
Entity	Corporation	Citizenship	United Kingdom
Address	75 Bermondsey Street London, SE13XF UNITED KINGDOM		

Attorney information	James L. Scott Warner Norcross + Judd LLP 1500 Warner Building 150 Ottawa Ave. NW Grand Rapids, MI 49503 UNITED STATES trademarks@wnj.com 616-752-2000		
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Applicant Information

Application No	88330617	Publication date	10/01/2019
Opposition Filing Date	10/30/2019	Opposition Period Ends	10/31/2019
Applicant	JOHN GEIGER COLLECTION LLC 53 CALLE PALMERAS STE 601 SAN JUAN, 00901 PUERTO RICO		

Goods/Services Affected by Opposition

Class 025. First Use: 2016/10/27 First Use In Commerce: 2016/10/27 All goods and services in the class are opposed, namely: (Based on Use in Commerce) Shirts; Shoes; Socks; Sweat shirts; Hooded sweat shirts; Leather shoes (Based on Intent to Use) Jeans; Pants; Ankle socks; Denim jeans; Jogging pants; Sports pants

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.	3554312	Application Date	05/25/2007
Registration Date	12/30/2008	Foreign Priority Date	NONE
Word Mark	KURT GEIGER		

Design Mark	KURT GEIGER
Description of Mark	NONE
Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 [Soaps; perfumery, essential oils, cosmetics, non-medicated toiletries, hair care and hair coloring preparations, bodylotions, hand lotions, non-medicated foot lotions; dentifrices; shoe cream, shoe polish, shoe wax]</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Magnetically encoded credit cards, debit cards, reward cards, and payment cards; blank magnetic cards; blank smart cards; magnetically encoded bank cards; [blank magnetic data carriers; blank recorddiscs; pre-recorded cd's, cd-rom's, audio tapes and video discs featuring music;] sunglasses; spectacles; sunglasses and spectacles cases and frames; [contact lenses and contact lens containers; protective footwear]</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 [Jewelry, clocks and watches; cuff-links; precious stones; precious metals and their alloys; jewel chains and jewel pendants in precious metals or coated therewith, namely, gold, silver, platinum and rhenium; horological and chronometric instruments]</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Leather and imitations of leather; goods made of leather and imitations of leather, namely, [attache cases, leather trunks, suitcases, briefcases, briefcase-type portfolios, key cases,] credit cardholders, shoulder bags, rucksacks, backpacks, [garment bags for travel, vanity cases sold empty;] cosmetic cases sold empty; [carry on bags;] handbags, purses and wallets; [leather jewelry rolls and pouches;] and bags made of fabric, namely, shoulder bags, rucksacks, backpacks, [garment bags for travel, carryon bags] and handbags [; umbrellas, parasols and walking sticks]</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, namely, [dresses, suits, coats, jackets, pants, skirts, shirts, blouses, sweaters, belts, hosiery, nightwear, bathrobes, dressing gowns, shorts,] scarves, [gloves, t-shirts, rugby shirts, cardigans, clothing for sport and gymnastics, namely, leotards, unitards, sweatsuits, jogging suits, tracksuits, headbands, sports bras and tops; shawls and pashminas;] headwear, namely, hats and caps; footwear; shoes, boots, slippers and sandals</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Retail services, namely, retail store services, mail-order catalog retail services and on-line retail store services, featuring [cosmetics, toiletries, perfumery products and essential oils, hair care and hair coloring products, dentifrices, shoe care products, jewellery, clocks and watches,] sunglasses, spectacles, [contact lenses and containers and cases for sunglasses, spectacles and contact lenses,] leather goods, handbags, purses and wallets, [luggage and travelling bags, umbrellas, clothing, footwear, headgear and belts; advice and assistance in the selection of goods of others, namely, comparison shopping services; advertising and promotional services; customer loyalty services for commercial, promotional and advertising purposes;] the bringing together, for the benefit of others, of a variety of goods, namely, [cosmetics, toiletries, perfumery products and essential oils, hair care and hair colouring products, dentrices, shoe care products, jewellery, clocks and watches,] sunglasses, spectacles, [contact lenses and containers and cases for sunglasses, spectacles and contact lenses,] leather goods, handbags, purses and wallets, [luggage and travelling bags, umbrellas, clothing,] footwear, [headgear and belts,] enabling customers to conveniently view and purchase those goods in a retail store environment, by mail-order or via a global communications system</p>

Attachments	79043847#TMSN.png(bytes) Notice of Opposition.pdf(292015 bytes)
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Signature	/JS/
Name	James L. Scott
Date	10/30/2019

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

Re: Application Serial No. 88330617
Published on October 1, 2019

Kurt Geiger Limited

Opposer

v.

John Geiger Collection LLC

Applicant

Opposition No.

NOTICE OF OPPOSITION

1. Opposer, Kurt Geiger Limited, is a United Kingdom corporation with an address of 75 Bermondsey Street, London SE13XF, United Kingdom.

2. Applicant, John Geiger Collection LLC, is a Puerto Rican Limited Liability Company with an address of 53 Calle Palmeras Ste 601, San Juan, Puerto Rico 00901.

3. On March 7, 2019, Applicant filed U.S. Application Serial No. 88330617, to register the mark JOHN GEIGER. Application Serial No. 88330617 seeks registration of the mark JOHN GEIGER for use with the following goods in International Class 25:

Class 25: Shirts; Shoes; Socks; Sweat shirts; Hooded sweat shirts;
Leather shoes; Jeans; Pants; Ankle socks; Denim jeans;
Jogging pants; Sports pants

4. Opposer owns U.S. Trademark Registration No. 3554312 for the mark KURT GEIGER (“**Opposer’s Registration**”).

5. Opposer's Registration is valid and subsisting and in full force and effect.
6. A true and correct copy of a current printout of information from the electronic database records of the USPTO is attached hereto and shows the current status and title of Opposer's Registration.
7. Opposer has for years, and since prior to the filing date of Applicant's application and Applicant's first use of the mark JOHN GEIGER, used the KURT GEIGER mark in association with footwear, clothing, and accessories including bags and eyewear ("**Opposer's Goods**"), along with online stores featuring the same.
8. Opposer has expended substantial resources to advertise and promote its goods under the KURT GEIGER mark.
9. Opposer has used the KURT GEIGER mark, and the relevant public recognizes the KURT GEIGER mark as identifying goods emanating exclusively from Opposer, since before Applicant first used the mark JOHN GEIGER and before March 7, 2019.
10. Opposer's KURT GEIGER mark is inherently distinctive and is used in connection with Opposer's Goods and services.
11. Through Opposer's advertising and promotion of Opposer's Goods and services under the KURT GEIGER mark, the relevant public has come to recognize the mark as signifying Opposer and its goods, and Opposer has built up extensive and valuable goodwill in the mark.
12. Opposer believes that it will be damaged by registration of the mark in Applicant's application. Opposer, therefore, has standing under Lanham Act §13(a), 15 U.S.C. § 1063(a), to oppose the application.

13. The goods covered by Applicant's application are identical to, related to, and overlap with, the goods provided by Opposer under the KURT GEIGER mark.

14. There is no issue of priority. The date of the opposed application is later than Opposer's use of the KURT GEIGER mark in interstate commerce in the United States.

15. The JOHN GEIGER mark in the opposed application is substantially similar in sight to Opposer's KURT GEIGER mark.

16. The JOHN GEIGER mark in the opposed application is substantially similar in meaning and overall impression to Opposer's mark KURT GEIGER.

17. Applicant's application is not restricted by trade channel.

18. Applicant's goods are likely to be offered to a class of purchasers that are the same as or similar to those to whom Opposer markets and sells its goods and services under the KURT GEIGER mark.

19. The mark in the opposed application when used in connection with the goods identified in the application so resembles Opposer's KURT GEIGER mark that it is likely to cause confusion, mistake, or deception as to the origin of Applicant's goods and to confuse, mislead, and deceive members of the public into believing that Applicant's goods originate from, or are sponsored, approved, or licensed by Opposer, or are in some way connected to Opposer and its goods.

20. Applicant's use and registration of the JOHN GEIGER mark for the goods identified in the opposed application is likely to cause confusion, deception, and/or mistake among the relevant public.

21. Applicant's use and registration of the JOHN GEIGER mark for the goods identified in the opposed application is likely to falsely suggest a connection with Opposer and Opposer's KURT GEIGER mark.

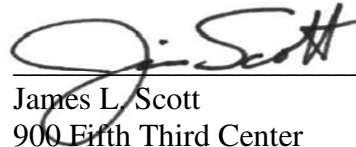
22. If Applicant were granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to use the mark. The registration would be a source of damage and injury to Opposer.

Opposer requests that the application be rejected and registration of the mark denied.

Respectfully submitted,

Kurt Geiger Limited

By: Warner Norcross + Judd LLP



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Grand Rapids, MI 49503
(616) 752-2469
Attorneys for Opposer

BULK DATA: Since May 7 at 12 a.m., the TSDR Application Programming Interface (API) has not included all information. Images of trademark registration certificates issued since July 2016 and some office actions are absent in the API. Customers who need to retrieve a copy of a registration certificate or an office action should download it directly from the TSDR documents tab.

INTERMITTENT SYSTEM ISSUES: 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.

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Mark: KURT GEIGER

KURT GEIGER

US Serial Number: 79043847

Application Filing Date: May 25, 2007

US Registration Number: 3554312

Registration Date: Dec. 30, 2008

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office

Status: A partial Section 71 declaration has been accepted.

Status Date: Jan. 02, 2019

Publication Date: Oct. 14, 2008

Mark Information

Mark Literal Elements: KURT GEIGER

Standard Character Claim: No

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

Color(s) Claimed: Color is not claimed as a feature of the mark.

Name Portrait Consent: The name "KURT GEIGER" does not identify a living individual.

Related Properties Information

International Registration [0937460](#)
Number:

International Registration May 25, 2007
Date:

Claimed Ownership of US [3047247](#)
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: [Soaps; perfumery, essential oils, cosmetics, non-medicated toiletries, hair care and hair coloring preparative lotions, non-medicated foot lotions; dentifrices; shoe cream, shoe polish, shoe wax]

International Class(es): 003 - Primary Class **U.S Class(es):** 001, 004, 006, 050, 051

Class Status: SECTION 71 - CANCELLED

Basis: 66(a)

For: Magnetically encoded credit cards, debit cards, reward cards, and payment cards; blank magnetic cards; blank magnetically encoded bank cards; [blank magnetic data carriers; blank record discs; pre-recorded cd's, cd-discs featuring music;] sunglasses; spectacles; sunglasses and spectacles cases and frames; [contact lens containers; protective footwear]

International Class(es): 009 - Primary Class **U.S Class(es):** 021, 023, 026, 036, 037

Class Status: ACTIVE

Basis: 66(a)

For: [Jewelry, clocks and watches; cuff-links; precious stones; precious metals and their alloys; jewel chains and metals or coated therewith, namely, gold, silver, platinum and rhenium; horological and chronometric instruments]

International Class(es): 014 - Primary Class **U.S Class(es):** 002, 027, 028, 050

Class Status: SECTION 71 - CANCELLED

Basis: 66(a)

For: Leather and imitations of leather; goods made of leather and imitations of leather, namely, [attache cases, briefcases, briefcase-type portfolios, key cases,] credit card holders, shoulder bags, rucksacks, back packs vanity cases sold empty;] cosmetic cases sold empty; [carry on bags;] handbags, purses and wallets; [leather pouches;] and bags made of fabric, namely, shoulder bags, rucksacks, back packs, [garment bags for travel handbags [; umbrellas, parasols and walking sticks]

International Class(es): 018 - Primary Class **U.S Class(es):** 001, 002, 003, 022, 041

Class Status: ACTIVE

Basis: 66(a)

For: Clothing, namely, [dresses, suits, coats, jackets, pants, skirts, shirts, blouses, sweaters, belts, hosiery, night gowns, shorts,] scarves, [gloves, t-shirts, rugby shirts, cardigans, clothing for sport and gymnastics, namely sweatsuits, jogging suits, tracksuits, headbands, sports bras and tops; shawls and pashminas;] headwear, footwear; shoes, boots, slippers and sandals

International Class(es): 025 - Primary Class **U.S Class(es):** 022, 039

Class Status: ACTIVE

Basis: 66(a)

For: Retail services, namely, retail store services, mail-order catalog retail services and on-line retail store services; toiletries, perfumery products and essential oils, hair care and hair coloring products, dentifrices, shoe care and watches,] sunglasses, spectacles, [contact lenses and containers and cases for sunglasses, spectacle leather goods, handbags, purses and wallets, [luggage and travelling bags, umbrellas, clothing, footwear, hair and assistance in the selection of goods of others, namely, comparison shopping services; advertising and promotion]

customer loyalty services for commercial, promotional and advertising purposes;] the bringing together, for variety of goods, namely, [cosmetics, toiletries, perfumery products and essential oils, hair care and hair care shoe care products, jewellery, clocks and watches,] sunglasses, spectacles, [contact lenses and container spectacles and contact lenses,] leather goods, handbags, purses and wallets, [luggage and travelling bags footwear, [headgear and belts,] enabling customers to conveniently view and purchase those goods in a mail-order or via a global communications system

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 66(a)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: Yes

Filed 66A: Yes

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Kurt Geiger Limited

Owner Address: 75 Bermondsey Street
London SE13XF
UNITED KINGDOM

Legal Entity Type: CORPORATION

State or Country Where Organized: UNITED KINGDOM

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Dyan M. House

Docket Number: 39277446

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Attorney Email Authorized: Yes

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Domestic Representative

Domestic Representative: Nicole B. Emmons

Phone: 214-978-3000

Name:

Fax: 214-978-3099

Domestic Representative e-mail: nicole.emmons@bakermckenzie.com

Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Sep. 12, 2019	PARTIAL INVALIDATION OF REG EXT PROTECTION SENT TO IB	
Sep. 12, 2019	INVALIDATION PROCESSED	71529
Sep. 12, 2019	NEW REPRESENTATIVE AT IB RECEIVED	
Sep. 02, 2019	PARTIAL INVALIDATION OF REG EXT PROTECTION CREATED	
Jan. 02, 2019	NOTICE OF ACCEPTANCE OF SEC. 71 - E-MAILED	
Jan. 02, 2019	REGISTERED - PARTIAL SEC 71 ACCEPTED	69471
Dec. 31, 2018	TEAS SECTION 71 RECEIVED	
Dec. 30, 2017	COURTESY REMINDER - SEC. 71 (10-YR) E-MAILED	
Jul. 27, 2017	INTERNATIONAL REGISTRATION RENEWED	
Sep. 04, 2015	PARTIAL INVALIDATION PROCESSED BY THE IB	
Aug. 17, 2015	PARTIAL INVALIDATION OF REG EXT PROTECTION SENT TO IB	
Aug. 17, 2015	INVALIDATION PROCESSED	67445
Jun. 18, 2015	PARTIAL INVALIDATION OF REG EXT PROTECTION CREATED	
May 01, 2015	NEW REPRESENTATIVE AT IB RECEIVED	
Dec. 04, 2014	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Dec. 04, 2014	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Oct. 18, 2014	NOTICE OF ACCEPTANCE OF SEC. 71 - E-MAILED	
Oct. 18, 2014	REGISTERED - PARTIAL SEC 71 ACCEPTED	69471
Oct. 18, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	69471
Oct. 08, 2014	TEAS SECTION 71 RECEIVED	
Jan. 06, 2013	FINAL DECISION TRANSACTION PROCESSED BY IB	
Aug. 28, 2012	CHANGE OF NAME/ADDRESS REC'D FROM IB	
Apr. 08, 2009	FINAL DISPOSITION NOTICE SENT TO IB	
Apr. 08, 2009	FINAL DISPOSITION PROCESSED	68359
Mar. 30, 2009	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
Feb. 05, 2009	NEW REPRESENTATIVE AT IB RECEIVED	
Dec. 30, 2008	REGISTERED-PRINCIPAL REGISTER	
Oct. 14, 2008	PUBLISHED FOR OPPOSITION	
Sep. 24, 2008	NOTICE OF PUBLICATION	
Sep. 09, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	70468
Sep. 05, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 20, 2008	AMENDMENT FROM APPLICANT ENTERED	70468

Aug. 20, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	70468
Aug. 14, 2008	PAPER RECEIVED	
May 22, 2008	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
May 22, 2008	NON-FINAL ACTION E-MAILED	6325
May 22, 2008	NON-FINAL ACTION WRITTEN	75601
May 03, 2008	AMENDMENT FROM APPLICANT ENTERED	70468
May 03, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	70468
May 02, 2008	ASSIGNED TO LIE	70468
Apr. 30, 2008	PAPER RECEIVED	
Nov. 25, 2007	REFUSAL PROCESSED BY IB	
Oct. 29, 2007	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
Oct. 26, 2007	REFUSAL PROCESSED BY MPU	68359
Oct. 26, 2007	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
Oct. 25, 2007	NON-FINAL ACTION WRITTEN	75601
Oct. 19, 2007	ASSIGNED TO EXAMINER	75601
Oct. 19, 2007	NEW APPLICATION ENTERED IN TRAM	
Oct. 18, 2007	SN ASSIGNED FOR SECT 66A APPL FROM IB	

International Registration Information (Section 66a)

International Registration Number: 0937460

International Registration Date: May 25, 2007

Intl. Registration Status: REQUEST FOR EXTENSION OF PROTECTION PROCESSED

Date of International Registration Status: Oct. 18, 2007

Notification of Designation Date: Oct. 18, 2007

Date of Automatic Protection: Apr. 18, 2009

International Registration Renewal Date: May 25, 2027

First Refusal Flag: Yes

TM Staff and Location Information

TM Staff Information

TM Attorney: BOAGNI, MARY E

Law Office Assigned: LAW OFFICE 114

File Location

Current Location: Not Found

Date in Location: Jan. 02, 2019

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