

ESTTA Tracking number: **ESTTA1027638**

Filing date: **01/08/2020**

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	Montblanc-Simplo GmbH		
Entity	limited liability company	Citizenship	Germany
Address	Hellgrundweg 100 Hamburg, 22525 GERMANY		
Attorney information	John P. Margiotta Fross Zelnick Lehrman & Zissu, P.C. 151 West 42nd Street, 17th Floor New York, NY 10036 UNITED STATES jmargiotta@fzlz.com, skipen@fzlz.com, ttabfiling@fzlz.com 212-813-5900		

**Applicant Information**

Application No	88199340	Publication date	12/10/2019
Opposition Filing Date	01/08/2020	Opposition Period Ends	01/09/2020
International Registration No.	NONE	International Registration Date	NONE
Applicant	POLETTI CONSEIL 102 clos des Praz Conduits Chamonix Mont-Blanc, 74400 FRANCE		

**Goods/Services Affected by Opposition**

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Wearable pouches for running, namely, armbands specially adapted for carrying personal electronic devices, namely, mobile phones and MP3 players while running, all of these goods not belonging to the medical field</p>
<p>Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Leather and imitation leather backpacks; all-purpose leather and imitation leather straps; pouches made from leather and imitation leather; animal skins and hides; trunks being luggage and travelling bags; umbrellas, parasols and walking sticks; whips; harnesses and saddlery; sports bags; bags for climbers in the nature of all-purpose carrying bags; rucksacks; bags for running, namely, athletic bags, belt bags and hip bags; rucksacks in the nature of general purpose sports bags containing pockets for holding drinks; gym sacks, namely, gym bags; handbags; belt bags, namely, hipsacks; bags for campers, namely, backpacks, hiking bags, sportsman's hunting bags; wheeled bags, namely, trolley cases with wheels; beach bags; school bags; net bags for shopping; string bags for shopping; reusable shopping bags; leather satchels; bags, namely, envelopes and pouches of leather for packaging; suitcases; travelling trunks; travel</p>

bags; vanity cases, not fitted; toiletry bags sold empty; satchels; business card holders in the nature of wallets; purses; pocket wallets; briefcases; holdalls; leather key cases; key cases; walking stick seats containing a sharpened end which can be stuck firmly in the ground; mountaineering sticks; all of these goods not belonging to the medical field

Class 025. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Clothing, namely, tops, bottoms and dresses; footwear; headwear, namely, hats and caps; sports clothing, namely, boots, uniforms, shoes, sports overuniforms, sports caps and hats; union suits; bodysuits; articles of outer clothing, namely, coats, jackets, overcoats and hats; overalls; jackets; blouson jackets; raincoats; hoods; jumpsuits; sports suits, namely, uniforms; tracksuits; clothing of leather, namely, jackets, pants, gloves and skirts; clothing of imitations of leather, namely, jackets, pants, gloves and skirts; windcheaters; shirts; sports shirts; pullovers; T-shirts; sweatshirts; trousers; shorts; body suits; sweaters; singlets; sports vests; swimsuits; pantyhose; stockings; socks; fur coats and jackets; scarves; sashes; neckties; bandanas; headbands for clothing; caps; gloves as clothing; gloves for hiking, namely, outdoor gloves; visors being headwear; belts; number-holder belts, namely, race number belts that hold a paper number on the race participant's front or back during competition; belts as clothing; money-belts as clothing; underwear; hosiery; sports footwear, namely, athletic shoes, boxing shoes, cycling shoes, golf shoes, running shoes; sports shoes; skiing shoes; climbing boots; footwear for hiking; boots; beach shoes; espadrilles; sandals; infant sleepers; slippers; all of these goods not belonging to the medical field


Class 041. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Entertainment in the nature of competitions in the field of athletics; entertainment event booking agencies; entertainment information; organizing community sporting and cultural events; Athletic and sports events services, namely, arranging, organizing, operating, and conducting marathon, triathlon, trail running, and hiking races; arranging and conducting sports competitions; arranging athletics competitions; providing sports facilities; sport camp services; coaching in the field of sports; timing of sports events; ski resorts featuring sports installations; providing sports facilities for physical education and gymnastics; health club services, namely, providing instruction and equipment in the field of physical exercise; entertainment services in the nature of competitions in the field of sports; organizing live conferences in the field of sports; film editing; film production; motion picture rental; entertainment services, namely, displaying a series of cinematographic and motion picture films; providing sports information on sports competitions via computer networks; rental of sports and exercise equipment, except vehicles; rental of outdoor recreational facilities for sports training and competitions; provision of sports facilities for athletic sports; providing sports information; providing information relating to sports, sports events, and college athletics; providing a website featuring sports information; arranging and operating fan clubs in the field of sports; sports club services in the nature of fan clubs; booking of tickets for sports events; operating of lotteries; providing sports camp services; all of these services not belonging to the medical field

## 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.	5592387	Application Date	07/14/2017
Registration Date	10/30/2018	Foreign Priority Date	NONE
Word Mark	MONTBLANC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 0 First Use In Commerce: 0		

	Cigar cutters; ashtrays for smokers, not of precious metal; lighters for smokers; cigarette cases and cigarette holders; cigar cases and cigar holders; pipe cleaners for tobacco and smoking pipes; tobacco pouches, tobacco jars not of precious metal
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U.S. Registration No.	2415189	Application Date	03/22/1999
Registration Date	12/26/2000	Foreign Priority Date	10/14/1998
Word Mark	MONTBLANC		
Design Mark	<b>MONTBLANC</b>		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 clothing accessories, namely, dress belts made of leather with belt buckles of precious and semi-precious metals distributed in channels of commerce where luxury articles are sold and promoted		

U.S. Registration No.	2202465	Application Date	09/18/1996
Registration Date	11/10/1998	Foreign Priority Date	NONE
Word Mark	MONTBLANC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 [toilet soaps,] perfume, cologne, eau de toilette, [ essential oils for personal use, ] perfumed body cream, [ body milk, dusting powder, ] hair and body shampoo, deodorant, after shave lotion, [ andhair lotions ]		

U.S. Registration No.	1884842	Application Date	01/21/1994
Registration Date	03/21/1995	Foreign Priority Date	NONE
Word Mark	MONTBLANC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 0 First Use In Commerce: 0 jewelry; watches and time pieces Class 018. First use: First Use: 0 First Use In Commerce: 0 purses, handbags, small leather articles and accessories, namely wallets and billfolds, and luggage		

U.S. Registration No.	1825001	Application Date	03/25/1993
Registration Date	03/08/1994	Foreign Priority Date	NONE
Word Mark	MONTBLANC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 [optical apparatus and instruments; namely,] spectacles, [ magnifying glasses, ] sunglasses, [and parts therefor]		

U.S. Registration No.	776208	Application Date	12/24/1963
Registration Date	09/01/1964	Foreign Priority Date	NONE
Word Mark	MONTBLANC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1913/00/00 First Use In Commerce: 1913/00/00 Fountain Pens, Cases for Fountain Pens, Ball Point Pens, Ball Point Cartridges, Ball Point Paste, Mechanical Pencils, Lead for Mechanical Pencils		

U.S. Registration No.	4669133	Application Date	05/22/2013
Registration Date	01/13/2015	Foreign Priority Date	11/23/2012
Word Mark	MONT BLANC		
Design Mark			
Description of Mark	The mark consists of the stylized word "MONT" appearing above the stylized word "BLANC". A six-lobed star design within a circle appears to the upper right of the wording "MONT".		
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Soaps; perfumery; essential oils; cosmetic preparations for body and beauty care Class 009. First use: First Use: 0 First Use In Commerce: 0		

	<p>Eyeglasses, sunglasses; eyeglass frames and cases; magnifying glasses; computer and tablets carrying cases and bags; holders and cases for telephones, portable telephones and smartphones; accessories for portable telephones, smartphones and tablets, namely, cases, bags; data recording and storage media device and instruments, namely, blank USB flash drive; graduated rulers</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0</p> <p>Jewelry; precious stones; precious metals and their alloys; cufflinks; tie clips; rings; bracelets; earrings; necklaces; brooches; key rings of precious metal; jewelry cases; boxes of precious metals; horological and chronometric instruments; watches; chronometers; clocks; small clocks; watch cases; watch bands; watch bracelets; key rings, trinkets, or fobs of precious metal</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0</p> <p>Stationery; articles of paper or cardboard, namely, boxes, bags, envelopes and pouches for packaging; wrapping paper; writing instruments; pouches for writing instruments; cases for writing instruments; inks and ink refills for writing instruments; desk sets; writing books; calendars, note books, card and document files, announcement cards; writing paper, envelopes, index cards; business cards; writing pads; writing instrument holders; paperweights; diaries, cover for diaries, replacement papers for diaries; inkwells; check book holders, passport holders; document holders and cases; photo albums; bookends; money clips; writing cases for writing instruments</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0</p> <p>Handbags, travelling bags, rucksacks, garment bags for travel, traveling sets comprised of luggage, suitcases, bags for sports, wheeled bags, wallets, purses, name cards cases, briefcases, attaché cases, key cases of leather or imitation leather; travelling trunks; unfitted vanity cases; evening purses; leather straps; boxes of leather or leather board, trunks and suitcases; credit card holder</p>
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Attachments	<p>79215776#TMSN.png( bytes )  75665264#TMSN.png( bytes )  79138632#TMSN.png( bytes )  Notice of Opposition UTMB MONT-BLANC.PDF(177485 bytes )</p>
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Signature	/John Margiotta/
Name	John P. Margiotta
Date	01/08/2020

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

MONTBLANC-SIMPLO GMBH,

Opposer,

-against-

POLETTI CONSEIL,

Applicant.

**NOTICE OF OPPOSITION**

Montblanc-Simplo GmbH (“Opposer”), a German limited liability company located and doing business at Hellgrundweg 100, Hamburg 22525, Germany, believes that it would be damaged by the issuance of registrations for the mark UTMB MONT-BLANC and Design, applied for in Application Serial No. 88/199,340, and therefore opposes the same. As grounds for its opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

A. Opposer and Opposer’s MONTBLANC Mark

1. Opposer is one of the most famous sellers of luxury goods in the world, including high quality watches, writing instruments, jewelry, and leather goods. Over more than 100 years, Opposer has built an excellent reputation due to its master craftsmen who work diligently and meticulously to create fine products. Today, Opposer is one of the world’s most renowned and prestigious brands and is distributed in more than 400 stores around the world.

2. Since 1909, Opposer has used the mark MONTBLANC in connection with one of its luxury goods throughout the United States, resulting in substantial sales.

3. Opposer has invested a significant amount of time, effort, and money in developing and promoting its goods under the MONTBLANC mark. As a result of these efforts and the success of the products offered under the MONTBLANC mark, Opposer's MONTBLANC mark has come to identify Opposer's goods exclusively and uniquely, has become well-known, and represents enormous goodwill of Opposer.

4. In addition to the common law rights accruing to Opposer in the MONTBLANC mark, Opposer owns the following United States trademark registrations for the MONTBLANC mark:

- a. U.S. Trademark Registration No. 5,592,387 for MONTBLANC for use in connection with, "Cigar cutters; ashtrays for smokers, not of precious metal; lighters for smokers; cigarette cases and cigarette holders; cigar cases and cigar holders; pipe cleaners for tobacco and smoking pipes; tobacco pouches, tobacco jars not of precious metal" in International Class 34;
- b. U.S. Trademark Registration No. 2,415,189 for MONTBLANC for use in connection with, "clothing accessories, namely, dress belts made of leather with belt buckles of precious and semi-precious metals distributed in channels of commerce where luxury articles are sold and promoted" in International Class 25;
- c. U.S. Trademark Registration No. 2,202,465 for MONTBLANC for use in connection with, "perfume, cologne, eau de toilette, perfumed body cream, hair and body shampoo, deodorant, after shave lotion" in International Class 3;
- d. U.S. Trademark Registration No. 1,884,842 for MONTBLANC for use in connection with, "jewelry; watches and time pieces" in International Class 14 and "purses, handbags, small leather articles and accessories, namely wallets and billfolds, and luggage" in International Class 18;

- e. U.S. Trademark Registration No. 1,825,001 for MONTBLANC for use in connection with, “spectacles, sunglasses” in International Class 9; and
- f. U.S. Trademark Registration No. 776,208 for MONTBLANC for use in connection with, “Fountain Pens, Cases for Fountain Pens, Ball Point Pens, Ball Point Cartridges, Ball Point Paste, Mechanical Pencils, Lead for Mechanical Pencils” in International Class 16.
- g. U.S. Trademark Registration No. 4,669,133 for MONTBLANC and Design for use in connection with “soaps; perfumery; essential oils; cosmetic preparations for body and beauty care” in International Class 3; “Eyeglasses, sunglasses; eyeglass frames and cases; magnifying glasses; computer and tablets carrying cases and bags; holders and cases for telephones, portable telephones and smartphones; accessories for portable telephones, smartphones and tablets, namely, cases, bags; data recording and storage media device and instruments, namely, blank USB flash drive; graduated rulers” in International Class 9; “Jewelry; precious stones; precious metals and their alloys; cufflinks; tie clips; rings; bracelets; earrings; necklaces; brooches; key rings of precious metal; jewelry cases; boxes of precious metals; horological and chronometric instruments; watches; chronometers; clocks; small clocks; watch cases; watch bands; watch bracelets; key rings, trinkets, or fobs of precious metal” in International Class 14; Stationery; articles of paper or cardboard, namely, boxes, bags, envelopes and pouches for packaging; wrapping paper; writing instruments; pouches for writing instruments; cases for writing instruments; inks and ink refills for writing instruments; desk sets; writing books; calendars, note books, card and document files, announcement cards; writing paper, envelopes, index cards; business cards; writing pads; writing instrument holders; paperweights; diaries, cover for diaries, replacement papers for diaries; inkwells; check book holders, passport holders; document holders and cases; photo albums; bookends;



money clips; writing cases for writing instruments” in International Class 16; and “Handbags, travelling bags, rucksacks, garment bags for travel, traveling sets comprised of luggage, suitcases, bags for sports, wheeled bags, wallets, purses, name cards cases, briefcases, attaché cases, key cases of leather or imitation leather; travelling trunks; unfitted vanity cases; evening purses; leather straps; boxes of leather or leather board, trunks and suitcases; credit card holder” in International Class 18.

5. The foregoing registrations are valid and subsisting, and serve as conclusive evidence of Opposer’s exclusive right in and to use the MONTBLANC mark. In addition, many of the above registrations have become incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and therefore serves as conclusive proof of Opposer’s exclusive right to use the MONTBLANC mark in connection with the goods identified therein, as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

B. Applicant and Its Application

6. Upon information and belief, Poletti Conseil is a France company with an address of 102 clos des Praz Conduits, Chamonix Mont-Blanc France 74400.

7. On November 19, 2018, Applicant filed Application Serial No. 88/199,340 (the “Application”) to register the design mark UTMB MONT-BLANC and Design (“Applicant’s Mark”) in connection with the following goods and services:

- a. “Wearable pouches for running, namely, armbands specially adapted for carrying personal electronic devices, namely, mobile phones and MP3 players while running, all of these goods not belonging to the medical field” in International Class 9;
- b. “Leather and imitation leather backpacks; all-purpose leather and imitation leather straps; pouches made from leather and imitation leather; animal skins and hides; trunks being luggage and travelling bags; umbrellas, parasols and walking sticks; whips; harnesses and

saddlery; sports bags; bags for climbers in the nature of all-purpose carrying bags; rucksacks; bags for running, namely, athletic bags, belt bags and hip bags; rucksacks in the nature of general purpose sportsbags containing pockets for holding drinks; gym sacks, namely, gym bags; handbags; beltbags, namely, hipsacks; bags for campers, namely, backpacks, hiking bags, sportsman's hunting bags; wheeled bags, namely, trolley cases with wheels; beach bags; school bags; net bags for shopping; string bags for shopping; reusable shopping bags; leather satchels; bags, namely, envelopes and pouches of leather for packaging; suitcases; travelling trunks; travel bags; vanity cases, not fitted; toiletry bags sold empty; satchels; business card holders in the nature of wallets; purses; pocket wallets; briefcases; holdalls; leather key cases; key cases; walking stick seats containing a sharpened end which can be stuck firmly in the ground; mountaineering sticks; all of these goods not belonging to the medical field” in International Class 18;

- c. “Clothing, namely, tops, bottoms and dresses; footwear; headwear, namely, hats and caps; sports clothing, namely, boots, uniforms, shoes, sports overuniforms, sports caps and hats; union suits; bodysuits; articles of outer clothing, namely, coats, jackets, overcoats and hats; overalls; jackets; blouson jackets; raincoats; hoods; jumpsuits; sports suits, namely, uniforms; tracksuits; clothing of leather, namely, jackets, pants, gloves and skirts; clothing of imitations of leather, namely, jackets, pants, gloves and skirts; windcheaters; shirts; sports shirts; pullovers; T-shirts; sweatshirts; trousers; shorts; body suits; sweaters; singlets; sports vests; swimsuits; pantyhose; stockings; socks; fur coats and jackets; scarves; sashes; neckties; bandanas; headbands for clothing; caps; gloves as clothing; gloves for hiking, namely, outdoor gloves; visors being headwear; belts; number-holder belts, namely, race number belts that hold a paper number on the race participant's front or back during competition; belts as clothing; money-belts as clothing;

underwear; hosiery; sports footwear, namely, athletic shoes, boxing shoes, cycling shoes, golf shoes, running shoes; sports shoes; skiing shoes; climbing boots; footwear for hiking; boots; beach shoes; espadrilles; sandals; infant sleepers; slippers; all of these goods not belonging to the medical field” in International Class 25; and

- d. “Entertainment in the nature of competitions in the field of athletics; entertainment event booking agencies; entertainment information; organizing community sporting and cultural events; Athletic and sports events services, namely, arranging, organizing, operating, and conducting marathon, triathlon, trail running, and hiking races; arranging and conducting sports competitions; arranging athletics competitions; providing sports facilities; sport camp services; coaching in the field of sports; timing of sports events; ski resorts featuring sports installations; providing sports facilities for physical education and gymnastics; health club services, namely, providing instruction and equipment in the field of physical exercise; entertainment services in the nature of competitions in the field of sports; organizing live conferences in the field of sports; film editing; film production; motion picture rental; entertainment services, namely, displaying a series of cinematographic and motion picture films; providing sports information on sports competitions via computer networks; rental of sports and exercise equipment, except vehicles; rental of outdoor recreational facilities for sports training and competitions; provision of sports facilities for athletic sports; providing sports information; providing information relating to sports, sports events, and college athletics; providing a website featuring sports information; arranging and operating fan clubs in the field of sports; sports club services in the nature of fan clubs; booking of tickets for sports events; operating of lotteries; providing sports camp services; all of these services not belonging to the medical field” in International Class 41.

8. Applicant's Mark encompasses Opposer's MONTBLANC mark in its entirety, simply putting a dash between the words "mont" and "blanc," thus it is identical in sight, sound, and commercial impression to Opposer's MONTBLANC mark.

9. Applicant is not connected to Opposer in any way, and has not been authorized by Opposer to use Applicant's Mark.

10. Opposer's rights in the MONTBLANC mark are prior and superior to any rights Applicant may claim in Applicant's Mark.

11. Any use by Applicant is long after Opposer's date of first use in the MONTBLANC mark and long after Opposer's the MONTBLANC mark was first registered in the U.S. Patent and Trademark Office in connection with a variety of goods and services.

12. The goods and services identified in the Application are identical and/or highly related to goods Opposer offers under the MONTBLANC mark and, upon information and belief, will be offered to the same customers or types of customers to whom goods offered under the MONTBLANC mark are being offered.

13. Upon information and belief, Applicant had actual knowledge of Opposer's prior rights to and interest in the MONTBLANC mark before adopting, using, or seeking to register Applicant's Mark for identical or closely related goods. At a minimum, as a matter of law, Applicant was on constructive notice of Opposer's rights in the MONTBLANC mark based on Opposer's registrations therefore.

14. The registration of Applicant's Mark would be inconsistent with Opposer's prior rights in the MONTBLANC mark, as well as inconsistent with Opposer's statutory grant of exclusivity of use of its registered mark, and would destroy Opposer's investment and goodwill in its mark.

**CLAIM FOR RELIEF UNDER SECTION 2(d)**

15. Opposer repeats and re-alleges each and every allegation contained in paragraphs 1 through 14 as if fully set forth herein.

16. Opposer's MONTBLANC mark is exclusively associated with Opposer and has been used continuously by Opposer since a date prior to any date on which Applicant can rely.

17. Applicant's Mark is confusingly similar in appearance and commercial impression to Opposer's MONTBLANC mark, and is likely to create an association with Opposer's MONTBLANC mark.

18. Applicant is not connected to Opposer in any way, and has not been authorized by Opposer to use Applicant's Mark.

19. Applicant seeks to register Applicant's Mark for goods identical or closely related to those that have been provided by Opposer under Opposer's MONTBLANC mark.

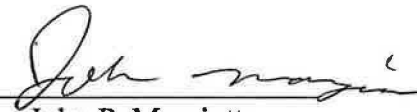
20. By virtue of Opposer's longstanding use of Opposer's MONTBLANC mark, the goodwill associated with the mark, and Opposer's incontestable registrations therefor, the registration by Applicant of a mark confusingly similar to Opposer's MONTBLANC mark for goods identical or closely related to those offered by Opposer under Opposer's MONTBLANC mark is likely to cause confusion or cause mistake or to deceive the purchasing public into mistakenly believing that Applicant's goods offered under Applicant's Mark originate from, come from, or are otherwise associated with Opposer, or that Applicant's goods offered under Applicant's Mark are endorsed, sponsored, or in some way connected with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

21. By reason of the foregoing, Opposer is likely to be harmed by registration of the Application for Applicant's Mark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Applicant in Application Serial No. 88/199,340 be denied.

Dated: January 8, 2020  
New York, New York

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 

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