

ESTTA Tracking number: **ESTTA1126158**

Filing date: **04/09/2021**

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	GALA S.R.L.
Granted to Date of previous extension	04/11/2021
Address	CALLE PROYECTO NO 1 SANTO DOMINGO ESTE, 0 DOMINICAN REPUBLIC
Attorney information	CLEMENS PAULY PAULY P.A. 815 PONCE DE LEON BLVD SUITE 210 CORAL GABLES, FL 33134 UNITED STATES Primary Email: pauly@cpauly.com Secondary Email(s): assistant@cpauly.com 3059676900
Docket Number	

**Applicant Information**

Application No.	88212579	Publication date	10/13/2020
Opposition Filing Date	04/09/2021	Opposition Period Ends	04/11/2021
Applicant	PARFUMS PAROUR 6 AVENUE MATIGNON PARIS, 75008 FRANCE		

**Goods/Services Affected by Opposition**


Class 003. First Use: 0 First Use In Commerce: 0  
Opposed goods and services in the class: fragranced body moisturizer; oils for toiletry purposes; cleansing milk for toilet purposes; toiletries, namely, non-medicated toiletry preparations; shampoos; hair lotions

**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. Application	88955346	Application Date	06/09/2020
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No.			
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	GALA HAIR SYSTEM		
Design Mark			
Description of Mark	The mark consists of the wording GALA HAIR SYSTEM with the stylized image of a leaf appearing above the first letter "a" and next to an elongated letter "l", and the words "HAIR SYSTEM" appearing underneath the word GALA.		
Goods/Services	Class 003. First use: First Use: 2009/06/01 First Use In Commerce: 2011/02/01 Hair shampoos and conditioners; Non-medicated hair treatment preparations for cosmetic purposes in the nature of hair masks, toners, oils, lotions and moisturizers; hair pomades; hair wax; hair glitter		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	GALA BODY CARE		
Goods/Services	Moisturizing creams		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	Gala Cosmetic		
Goods/Services	toiletries, namely body lotions and massage creams		

Attachments	88955346#TMSN.png( bytes ) Notice of Opposition.pdf(473895 bytes )
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Signature	/Clemens Pauly/
Name	CLEMENS PAULY
Date	04/09/2021

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

In the Matter of Application Serial No. 88212579  
For the mark: GALA  
Published: October 13, 2020

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GALA S.R.L.,	:	
a Dominican corporation,	:	Opposition No.
Opposer,	:	
	:	
v.	:	
	:	
PARFUMS PAROUR,	:	
a French joint stock company,	:	
Applicant.	:	
-----X		

**NOTICE OF OPPOSITION**


Opposer, GALA S.R.L., a corporation organized and existing under the laws of the Dominican Republic, with a principal place of business at Calle Proyecto No 1, Santo Domingo Este, Dominican Republic, believes that it will be damaged by the issuance of a registration for the alleged mark shown in Application Serial No. 88212579 filed by Parfums Parour (hereinafter "Applicant"). Opposer hereby opposes same pursuant to Section 13(a) of the Lanham Trademark Act of 1946 ("Lanham Act"), 15 U.S.C. § 1063(a).

As grounds for opposition, Opposer alleges as follows:

1. Opposer was founded in the Dominican Republic in 1989 and markets cosmetics and hair products under the marks Gala, Gala Cosmetic, Gala Body Care, Gala Hair System as well as other marks in 6 countries, including the United States.

2. On June 9, 2020, Opposer filed U.S. Trademark Application No. 88955346 for



GALA HAIR SYSTEM Stylized with Leaf Design, , for registration on the Principal Register in the United States Patent and Trademark Office (hereinafter "GALA HAIR SYSTEM Mark"). Attached as **Exhibit 1** is a true and correct printout from the United States Patent and Trademark Office electronic database showing the status of the application as of April 9, 2021.

3. Opposer has used the GALA HAIR SYSTEM Mark in interstate commerce in the United States continuously since February 1, 2011 in connection with the marketing, advertising, sale, distribution and promotion of hair shampoos and conditioners, hair treatments, such as masks, toners, oils, lotions, and moisturizers, hair pomades, hair wax, hair glitter and related products. Attached hereto as **Exhibit 2** are copies of representative samples of shampoo bottles and other containers and product packaging showing Opposer's use of the GALA HAIR SYSTEM Mark in connection with these goods.

4. As a result of its continuous and exclusive use of the GALA HAIR SYSTEM Mark to identify its goods and Opposer as their source, Opposer owns valid and subsisting common law rights to the GALA HAIR SYSTEM Mark.

5. Opposer's Mark is distinctive to both the consuming public and Opposer's trade.

6. Opposer has expended substantial time, money, and resources marketing, advertising, and promoting the goods sold under the GALA HAIR SYSTEM Mark including through point of purchase displays, print, direct mail, and internet.

7. For more than 10 years, Opposer has been selling its goods in Puerto Rico, as well as in South Florida and New York and the GALA HAIR SYSTEM Mark as well as the Gala Cosmetic and Gala Body Care marks have acquired brand awareness with the consumers.

8. Upon information and belief, Applicant, Parfums Parour, with an address at 6 Avenue Matignon, 75008 Paris, France, on November 30, 2018, filed trademark Application Serial No. 88212579, to register the proposed mark GALA for "perfumery; perfumes; toilet water; scented linen water; perfumed waters; eau de cologne; fragrance products for personal use, namely, body spray used as a personal deodorant and as fragrance, fragranced facial moisturizer, fragranced body moisturizer; perfumed extracts for perfume; essential oils; personal deodorants; cosmetic products in the form of aerosols for skincare; cosmetic preparations for skin scare; oils for toiletry purposes; cleansing milk for toilet purposes; toiletries, namely, non-medicated toiletry preparations; talcum powder for toilet use; oils for cosmetic purposes for the bath; cosmetic preparations for baths; toilet, shaving, skin, beauty soaps; shampoos; hair lotions" in International Class 3.

9. The Applicant's application was published on October 13, 2020 and the Trademark Trial and Appeal Board has granted Opposer's request to extend time to oppose until April 11, 2021.

10. Applicant has not yet begun using the proposed mark.

11. Opposer's trademark mark has priority over the proposed mark because Opposer's use date predates the Applicant's filing date or any other date on which the Applicant may rely for purposes of priority.

12. Applicant's proposed mark GALA is identical to the dominant part of the literal element of Opposer's GALA HAIR SYSTEM Mark and Applicant seeks to register its alleged mark in the same International Class 3 as the Opposer.

13. The goods covered by the Applicant's application are substantially similar to the goods Opposer offers under its GALA HAIR SYSTEM Mark in that the Applicant would directly compete with the shampoos and hair lotion products the Opposer has been offering to the public under the GALA HAIR SYSTEM Mark long prior to the Applicant's filing date.

14. As a result of the similarity the Trademark Office Examiner has cited the Applicant's Application Serial No. 88212579 as obstacle to the registration of Opposer's Application No. 88955346 and on March 31, 2021 issued a Suspension Notice. Attached as **Exhibit 3** is a true and correct copy of the Suspension Notice.

15. In addition to the similar hair products proposed in Applicant's application, Opposer avers Applicant's proposed mark will also be substantially similar to the body lotions and creams, massage creams, powders and feminine hygiene products the Opposer currently sells under its Gala Cosmetic and Gala Body Care marks, in that Applicant's application also seeks to market "body moisturizer," "oils for toiletry purposes" and "toiletries, namely, non-medicated toiletry preparations" under the proposed mark.

16. Opposer avers that its customers, and the general public, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's proposed goods to be marketed under Applicant's proposed mark and misled into believing that such good emanate from, are licensed by, or are in some way directly or indirectly associated with, approved, or sponsored by Opposer, to the damage and detriment of Opposer and its reputation.

17. The proposed mark is barred from registration because it consists of or comprises a mark which so resembles Opposer's previously used mark or marks as to be likely, when used in connection with the proposed goods of the Applicant, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).

WHEREFORE, Opposer respectfully prays that its opposition be sustained and that registration to Applicant be refused.

Respectfully submitted, this 9<sup>th</sup> day of April, 2021.

PAULY P.A.



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Clemens W. Pauly, Esq.  
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# EXHIBIT 1

**Generated on:** This page was generated by TSDR on 2021-04-09 16:35:03 EDT

**Mark:** GALA HAIR SYSTEM



**US Serial Number:** 88955346

**Application Filing Date:** Jun. 09, 2020

**Register:** Principal

**Mark Type:** Trademark

**TM5 Common Status Descriptor:**



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

**Status:** An Office action suspending further action on the application has been sent (issued) to the applicant. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

**Status Date:** Mar. 31, 2021

## Mark Information

**Mark Literal Elements:** GALA HAIR SYSTEM

**Standard Character Claim:** No

**Mark Drawing Type:** 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

**Description of Mark:** The mark consists of the wording GALA HAIR SYSTEM with the stylized image of a leaf appearing above the first letter "a" and next to an elongated letter "l", and the words "HAIR SYSTEM" appearing underneath the word GALA.

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

**Disclaimer:** "HAIR SYSTEM"

**Design Search Code(s):** 05.03.25 - Leaf, single; Other leaves

## 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:** Hair shampoos and conditioners; Non-medicated hair treatment preparations for cosmetic purposes in the nature of hair masks, toners, oils, lotions and moisturizers; hair pomades; hair wax; hair glitter

**International Class(es):** 003 - Primary Class

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

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Jun. 01, 2009

**Use in Commerce:** Feb. 01, 2011

## 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:** GALA S.R.L.

**Owner Address:** Calle Proyecto No 1  
Santo Domingo Este DOMINICAN REPUBLIC

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** DOMINICAN REPUBLIC

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Clemens W. Pauly

**Attorney Primary Email Address:** [pauly@cpauly.com](mailto:pauly@cpauly.com)

**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Clemens W. Pauly  
PAULY P.A.  
815 PONCE DE LEON BOULEVARD  
SUITE 210  
CORAL GABLES, FLORIDA UNITED STATES 33134

**Phone:** 305-967-6900

**Fax:** 7865097490

**Correspondent e-mail:** [pauly@cpauly.com](mailto:pauly@cpauly.com)

**Correspondent e-mail Authorized:** Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2021	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Mar. 31, 2021	LETTER OF SUSPENSION E-MAILED	6332
Mar. 31, 2021	SUSPENSION LETTER WRITTEN	93982
Mar. 03, 2021	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 02, 2021	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 02, 2021	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 18, 2020	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Sep. 18, 2020	NON-FINAL ACTION E-MAILED	6325
Sep. 18, 2020	NON-FINAL ACTION WRITTEN	93982
Sep. 11, 2020	ASSIGNED TO EXAMINER	93982
Jul. 03, 2020	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Jul. 02, 2020	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 12, 2020	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information

**TM Attorney:** PORTARO, ALEXANDRA J

**Law Office Assigned:** LAW OFFICE 126

### File Location

**Current Location:** TMO LAW OFFICE 126- EXAMINING ATTORNEY ASSIGNED

**Date in Location:** Mar. 31, 2021

EXHIBIT 2



## EXHIBIT 3

**To:** GALA S.R.L. ([pauly@cpauly.com](mailto:pauly@cpauly.com))  
**Subject:** U.S. Trademark Application Serial No. 88955346 - GALA HAIR SYSTEM - N/A  
**Sent:** March 31, 2021 04:08:46 PM  
**Sent As:** ecom126@uspto.gov  
**Attachments:**

**United States Patent and Trademark Office (USPTO)**  
**Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application  
Serial No.**  
88955346

**Mark:** GALA  
HAIR SYSTEM

**Correspondence**

**Address:**  
Clemens W.  
Pauly

PAULY P.A.  
SUITE 210  
815 PONCE  
DE LEON  
BOULEVARD

CORAL  
GABLES FL  
33134

**Applicant:**  
GALA S.R.L.

**Reference/Docket  
No.** N/A

**Correspondence  
Email Address:**

[pauly@cpauly.com](mailto:pauly@cpauly.com)

### SUSPENSION NOTICE

#### No Response Required

**Issue date:** **March 31, 2021**

**The application is suspended** for the reason(s) specified below. *See* 37 C.F.R. §2.67; TMEP §§716 *et seq.*

The pending application(s) below has an earlier filing date or effective filing date than applicant's application. If the mark in the application(s) below registers, the USPTO may refuse registration of applicant's mark under Section 2(d) because of a likelihood of confusion with the registered mark(s). 15 U.S.C. §1052(d); *see* 37 C.F.R. §2.83; TMEP §1208.02(c). Action on this application is suspended until the prior-filed application(s) below either registers or abandons. 37 C.F.R. §2.83(c). Information relevant to the application(s) below was sent previously.

- U.S. Application Serial No(s). 88212579; 88212596; 88212584

**Refusal(s) and/or requirement(s) resolved and maintained and continued.** The following refusal(s) and/or requirement(s) is/are satisfied:

- Identification of Goods

*See* TMEP §713.02.

**Suspension process.** The USPTO will periodically check this application to determine if it should remain suspended. *See* TMEP §716.04. As needed, the trademark examining attorney will issue a letter to applicant to inquire about the status of the reason for the suspension. TMEP §716.05.

**No response required.** Applicant may [file a response](#), but is not required to do so.

/Alexandra Portaro/  
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