

ESTTA Tracking number: **ESTTA1137150**

Filing date: **05/29/2021**

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	Dooney & Bourke, Inc.
Granted to Date of previous extension	05/29/2021
Address	1 REGENT STREET NORWALK, CT 06855 UNITED STATES
Attorney information	EDWARD B. CHANSKY, ESQ. GREENBERG TRAUIG, LLP 10845 GRIFFITH PEAK DRIVE SUITE 600 LAS VEGAS, NV 89135 UNITED STATES Primary Email: lvpto@gtlaw.com Secondary Email(s): CooperK@gtlaw.com, ChanskyE@gtlaw.com, FerrergarciaC@gtlaw.com 7027923773
Docket Number	113570010000

**Applicant Information**

Application No.	88929617	Publication date	03/30/2021
Opposition Filing Date	05/29/2021	Opposition Period Ends	05/29/2021
Applicant	Qingdao Dinghai Hengtong Import and Export Co., Ltd. LINGCANG DISTRICT 305-60 ROOM 1577-10# JINSHUI ROAD QINGDAO, SHANDONG, 266000 CHINA		

**Goods/Services Affected by Opposition**


Class 003. First Use: 2020/03/01 First Use In Commerce: 2020/04/01 All goods and services in the class are opposed, namely: Adhesives for cosmetic purposes; BB creams; Body oils; CC creams; Eye make-up; Eyeliner; Eyeliners; Eyeshadows; Face and body milk; Facial beauty masks; Facialcream; Facial washes; False eyelashes; False nails; Foundation make-up; Lipsticks; Make-up; Mascara; Skin moisturizer masks; Sun creams
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**Grounds for Opposition**


Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application	Trademark Act Sections 1(a) and (c)

or amendment to allege use was filed	
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2771012	Application Date	05/09/2002
Registration Date	10/07/2003	Foreign Priority Date	NONE
Word Mark	DB		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2001/01/10 First Use In Commerce: 2001/01/10 eyeglass cases, camera cases, binocularcases, mobile phone holsters, compact disc cases</p> <p>Class 016. First use: First Use: 2001/01/10 First Use In Commerce: 2001/01/10 personal organizers, checkbook wallets,checkbook covers, checkbook holders</p> <p>Class 018. First use: First Use: 2001/01/10 First Use In Commerce: 2001/01/10 wallets, purses, coin purses, clutches,handbags, shoulder bags, shoulder straps, tote bags, backpacks, luggage, suitcases, trunks, empty cosmetics cases, leather key cases, leather key fobs, fanny packs</p>		

U.S. Registration No.	3000026	Application Date	04/19/2004
Registration Date	09/27/2005	Foreign Priority Date	NONE
Word Mark	DB		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2002/07/15 First Use In Commerce: 2002/09/01 hats, gloves, shoes

Attachments	76406189#TMSN.png( bytes ) 76588082#TMSN.png( bytes ) Notice of Opposition DB DORVEY BEAUTY 88929617.pdf(312010 bytes )
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Signature	/Edward B. Chansky/
Name	EDWARD B. CHANSKY, ESQ.
Date	05/29/2021

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

Dooney & Bourke Inc., a Connecticut corporation,

Opposer,

v.

Qingdao Dinghai Hengtong Import and Export Co., Ltd., a limited company,

Applicant.

Opposition No. \_\_\_\_\_



Mark: **DORVEY BEAUTY**

Ser. No.: 88929617

Published: March 30, 2021

Class: 3



**NOTICE OF OPPOSITION**

Pursuant to 15 U.S.C. § 1063 and 37 C.F.R. §§ 2.101 and 2.104(a), Opposer Dooney & Bourke Inc. (“D&B”) believes it will be damaged by registration of the mark set forth in serial number 88929617 (the “Opposed Mark”), and hereby opposes the same.

As grounds for opposition, D&B alleges that:

1. Dooney & Bourke Inc. is a Connecticut corporation with its headquarters at 1 Regent Street, Norwalk, Connecticut 06855.
2. Upon information and belief, applicant Qingdao Dinghai Hengtong Import and Export Co., Ltd. (“Applicant”) is a company with an address at Lingcang District, 305-60 Room 1577-10# Jinshui Road, Qingdao, Shandong CHINA 266000.
3. D&B is a maker of fine leather goods, apparel, and accessories.
4. D&B was founded in 1975 and since then it has become a globally recognized fashion brand.
5. For more than 20 years, D&B has used the stylized letters “DB” in connection with D&B’s goods.
6. D&B’s rights are evidenced by its ownership of the following registrations in the

United States Patent and Trademark Office (“USPTO”):

-  (Reg. No. 2771012) filed May 9, 2002 in Classes:
  - 09 for “eyeglass cases, camera cases, binocular cases, mobile phone holsters, compact disc cases”
  - 16 for “personal organizers, checkbook wallets, checkbook covers, checkbook holders”
  - 18 for “wallets, purses, coin purses, clutches, handbags, shoulder bags, shoulder straps, tote bags, backpacks, luggage, suitcases, trunks, empty cosmetics cases, leather key cases, leather key fobs, fanny packs”
  
-  (Reg. No. (Reg. No. 3000026) filed April 19, 2004 in Class 25 for “hats, gloves, shoes”

(collectively, the “Signature Logo”).

7. D&B’s Registrations Nos. 2771012 and 3000026 have been deemed incontestable by the USPTO.

8. D&B also holds registrations for its Signature Logo in multiple foreign countries, including the European Union, China, Macau, Singapore, Japan, Turkey, and Russia.

9. D&B has spent, and continues to invest, a substantial amount of time, resources and money in protecting, advertising and promoting its Signature Logo in the United States and throughout the world.

10. D&B advertises its goods in such venerable fashion and life style magazines as Vogue, Elle, Harper’s Bazaar, Southern Living, and Marie Claire and in newspapers with a wide national circulation such as the New York Times and Wall Street Journal.

11. D&B’s branded goods are often featured in “Top 20” fashion lists, editor’s picks, and fashion trend reports.

12. D&B’s branded goods are sold in brick and mortar department stores across the United States such as Nordstrom and Dillard’s and through online e-commerce sites including

D&B's website.

13. D&B's branded goods are also sold through tele-commerce channels such as QVC and the Home Shopping Network.

14. D&B generates millions of dollars in revenue from U.S. based sales of D&B's goods annually.

15. As a result of D&B's long-time, extensive use of and investment in its Signature Logo, the Signature Logo has become exclusively associated with D&B's goods and is immediately identified by consumers as originating from D&B.

16. Because of D&B's significant investment in its Signature Logo, the Signature Logo has become famous, distinct, and has acquired tremendous goodwill in the United States and throughout the world.

17. On or about May 22, 2020, Applicant filed an application for the Opposed Mark in Class 3 for "Adhesives for cosmetic purposes; BB creams; Body oils; CC creams; Eye make-up; Eyeliner; Eyeliners; Eyeshadows; Face and body milk; Facial beauty masks; Facial cream; Facial washes; False eyelashes; False nails; Foundation make-up; Lipsticks; Make-up; Mascara; Skin moisturizer masks; Sun creams" ("Applicant's Goods").

18. The stylized letters "DB" in the Opposed Mark are virtually identical to the stylization of D&B's Signature Logo as seen here:

**Applicant's Mark**



**D&B's Signature Logo**



19. The "DB" stylized letters are the most dominant feature of the Opposed Mark

because the “DB” letters are prominently placed above the text “DORVEY BEAUTY” and are displayed in a much larger font size.

20. Applicant’s Goods are highly related to D&B’s goods because skin preparations, cosmetics, and other personal care products are the type of goods consumers have come to expect from fine fashion brands such as D&B.

21. For example, fine fashion brands such as Fendi, Yves Saint Laurent, Coach, Chanel, Gucci, and Louis Vuitton have existing U.S. Registrations for monogram marks in Class 03 for personal care related products and fine leather goods in Class 18 as follows:



, U.S. Registration No. 5563158, for “Fragrances; make-up” in Class 03 and “Leather and imitations of leather; animal skins and hides; trunks and travelling bags; umbrellas and parasols; walking sticks; whips; harnesses; saddlery; bags, namely, leather bags, weekend bags and all-purpose carrying bags; shoulder bags; travelling bags; hand bags; boston bags; waist packs; sling bags for carrying infants; duffle bags; tote bags; clutch bags; wallets; purses; briefcases; attaché cases; pouches of leather; pouches of textile, not for packaging; school bags; suitcases; garment bags for travel; key cases made of leather; backpacks; rucksacks; vanity cases sold empty; carry-on bags; beach bags; umbrellas” in Class 18;



, U.S. Registration No. 4036925, for “Leather and imitation leather; furs; [ umbrellas; parasols; walking sticks; saddlery; ] animal skins; animal hides; goods made of leather and imitation leather, namely, [ traveling bags, ] handbags, shoulder bags, briefcases, [ attache cases, trunks, ] leatherwear, namely, key cases, purses, wallets, [

suitcases, ] backpacks, [ rucksacks, cosmetic cases sold empty, business card cases, sport bags, waist bags, beach bags, boxes made of leather, ] pouches, leather straps [ , trolley bags ]” in Class 18;



, U.S. Registration No. 1267539, for “Perfumes, Toilet Water, [ Face Soap, Bath Soap, Skin Cleansing and Moisturizing Creams and Lotions, Hair Creams and Lotions, Lipstick, Eye Shadow, Mascara, Rouge, Face Powder, Talcum Powder ]” in Class 03;



, U.S. Registration No. 1025591, for “[ BUBBLE BATH, ] BODY LOTION, AFTERSHAVE LOTION, AFTER-SHAVE BALM, [ SKIN BRONZER, ] COLOGNE AND SOAP” in Class 03;



, U.S. Registration No. 0855232, for PERFUME, TOILET WATER, BATH OIL, AND DUSTING POWDER” in Class 03;

**YSL**, U.S. Registration No. 1712999, for “HANDBAGS, LUGGAGE, TOTE BAGS, BRIEFCASES, WALLETS, BILLFOLDS, CHANGE PURSES, AND KEY FOBs” in Class 18;



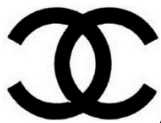
, U.S. Registration No. 3396554, for “Fragrances for personal use; [Lipsticks]” in Class 03;



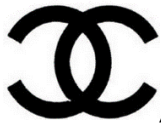
, U.S. Registration No. 2626565, for “HANDBAGS, PURSES,



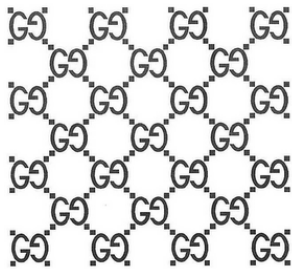
CLUTCHES, SHOULDER BAGS, PORTFOLIOS, TOTE BAGS, WAIST POUCHES, BACKPACKS, COSMETIC CASES SOLD EMPTY, TOILETRY CASES SOLD EMPTY, BRIEFCASES, LUGGAGE, GARMENT BAGS, BILLFOLDS, WALLETS, KEY CASES, BUSINESS CARD CASES, CREDIT CARD CASES, PASSPORT HOLDERS, IDENTIFICATION CASES, [TIE CASES] AND COIN POUCHES” in Class 18;



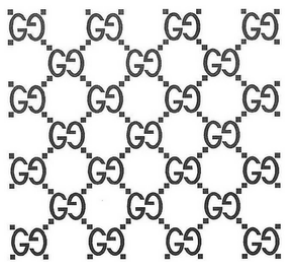
, U.S. Registration No. 4505433, for “Cosmetics; Non-medicated skin care preparations; Perfumery” in Class 03;



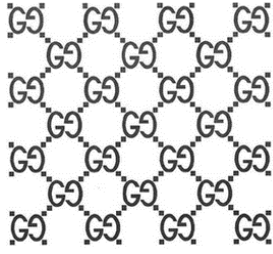
, U.S. Registration No. 1734822, for “leather goods; namely, handbags, wallets, travel bags, luggage, business card cases, change purses, tote bags, and cosmetic bags sold empty “ in Class 18;



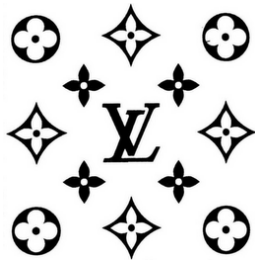
, U.S. Registration No. 4739354, for “Cosmetics” in Class 03;



, U.S. Registration No. 4773549, for “Skin care products, namely, non-medicated skin care preparations; nail polish and fragrances” in Class 03;



, U.S. Registration No. 4229081, for “Wallets, purses, handbags, shoulder bags, clutch bags, tote bags, business card cases, credit card cases partly and wholly of leather, key cases, cosmetic cases sold empty, briefcases, attaché cases, valises, suitcases and duffel bags” in Class 18; and



, U.S. Registration No. 4192541, for “[ Soaps for personal use; ] perfumery[ ; essential oils; cosmetics; creams for the hair, face, and body; lotions for the hair, face, and body; shower and bath gels; shower and bath preparations; shampoos; make-up preparations, namely, foundations, lipsticks, eye shadows, mascara, make-up powder, and nail polish ]” in Class 03 and “Boxes of leather or imitation leather for packaging and carrying goods; traveling bags; leather traveling sets of luggage; trunks; suitcases; garment bags for travel; vanity cases sold empty; toiletry bags sold empty; backpacks; handbags; attaché cases; leather document cases; wallets; purses; leather key cases [ ; umbrellas ]” in Class 18.

22. Applicant’s alleged use of the Opposed Mark is without authorization, permission, or a license from D&B.

23. In its application, Applicant claimed a date of first use of March 1, 2020 and a date of first use in commerce of April 1, 2020.

24. In support of its alleged use, Applicant submitted a specimen described, in part, as a “[w]ebpage of store and photo of products” (“Applicant’s Specimen”).

25. On or about August 28, 2020, the examining attorney issued an office action refusing registration, in part, on grounds that Applicant’s Specimen appeared to be mockups or digitally altered images of the Opposed Mark on the goods. More specifically, the examining attorney claimed that in some photos the Opposed Mark was printed on a sticker which was adhered to the goods, while other photos appeared to be nearly identical product photos found on the website for Pudaier Cosmetics, a third party unrelated to Applicant.

26. On or about October 21, 2020, Applicant filed a substitute specimen in response to the examining attorney’s refusal of Applicant’s Specimen.

27. Applicant’s substitute specimen consisted of, in part, an order detail page that identified July 22, 2020 as the order date and Qingdao Dorvey Import and Export Co. Ltd. as the seller (“Order Page”).

28. Upon information and belief, Applicant is not the seller identified on the Order Page.

29. Upon information and belief, Applicant did not use the Opposed Mark in connection with Applicant’s Goods in interstate commerce on or at any time prior to Applicant’s filing date of May 22, 2020.

**Applicant’s Mark is Likely to Cause Consumer Confusion**

30. D&B hereby repeats and re-alleges the allegations contained in the preceding paragraphs as though fully set forth herein.

31. The Opposed Mark is virtually identical to D&B’s Signature Logo.

32. The Opposed Mark conveys the same commercial impression as D&B’s Signature Logo.

33. The Opposed Mark so resembles D&B’s Signature Logo as to be likely, when applied to Applicant’s Goods, to cause confusion or mistake or to deceive by creating the erroneous impression that Applicant’s Goods originate with or come from D&B or that Applicant

or Applicant's Goods are authorized, endorsed, sponsored, and/or licensed by D&B or are connected in some way with D&B or its goods.

34. Upon information and belief, Applicant had knowledge of D&B's rights in its Signature Logo.

35. D&B will be damaged by registration of the Opposed Mark.

36. Based on the foregoing, the Opposed Mark should not be allowed to register.

**The Opposed Mark Dilutes and Tarnishes D&B's Marks**

37. D&B hereby repeats and re-alleges the allegations contained in the preceding paragraphs as though fully set forth herein.

38. The Opposed Mark dilutes the distinctiveness of D&B's Signature Logo.

39. As a result of the long and extensive advertising, promotion, and sale of D&B's goods under the Signature Logo, the Signature Logo has acquired fame.

40. The Signature Logo was famous and distinctive before Applicant filed its application for the Opposed Mark on May 22, 2020.

41. The Opposed Mark is virtually identical to D&B's Signature Logo.

42. Without D&B's consent, and after D&B's trademarks became famous and distinctive, Applicant seeks registration for the Opposed Mark for goods highly related to those offered by D&B under its Signature Logo.

43. Because the Opposed Mark is virtually identical to D&B's Signature Logo, consumers encountering the Opposed Mark will naturally associate it with D&B.

44. Even if consumers identify the goods bearing the Opposed Mark as originating from Applicant, they are likely to mistakenly believe Applicant is affiliated with or endorsed by D&B, which it is not.

45. D&B has no control over Applicant's use of the Opposed Mark in association with Applicant's Goods.

46. D&B has been in business for over 45 years and has built a substantial reputation for fine quality products in the United States and worldwide.

47. D&B will suffer damage including irreparable injury to its reputation and goodwill if the Opposed Mark is allowed to register.

48. D&B requests that the Opposed Mark not be allowed to register because D&B's trademark rights are prior and senior to Applicant's rights in the Opposed Mark and the Opposed Mark dilutes the distinctiveness of D&B's Signature Logo and will tarnish D&B's reputation and goodwill.

**The Application is Void for No Use in Commerce at the Time of Filing**

49. D&B hereby repeats and re-alleges the allegations contained in the preceding paragraphs as though fully set forth herein.

50. Applicant filed its application based on use in commerce. Applicant's application was approved and published based on Applicant's allegation of use of the Opposed Mark in commerce as set forth in Applicant's substitute specimen.

51. Upon information and belief, Applicant is not the seller identified in the Order Page submitted as part of Applicant's substitute specimen.

52. Upon information and belief, Applicant does not sell and has never sold Applicant's Goods in interstate commerce in association with the Opposed Mark.

53. Upon information and belief, the earliest date Applicant may have used the Opposed Mark in connection with Applicant's Goods was the date of July 22, 2020 identified on the Order Page.

54. Upon information and belief, Applicant did not use the Opposed Mark in connection with Applicant's Goods in interstate commerce on or at any time prior to Applicant's filing date of May 22, 2020.

55. Applicant's failure to use the Opposed Mark in commerce at or before the filing date of the application renders Applicant's application void.

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**RELIEF REQUESTED**

WHEREFORE, D&B prays that the Opposed Mark, Ser. No. 88929617, not be allowed to register and that the Board sustain this Opposition.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Dated: May 29, 2021

By: /Edward B. Chansky/  
Edward B. Chansky  
10845 Griffith Peak Drive  
Suite 600  
Las Vegas, Nevada 89135  
(702) 792-3773

**CERTIFICATE OF SERVICE**

I hereby certify that, on May 29, 2021, a true and complete copy of the foregoing **NOTICE OF OPPOSITION** has been served via electronic mail, on the Applicant through its Attorney of

Record to:

JIE LUO  
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