

ESTTA Tracking number: **ESTTA1166616**

Filing date: **10/18/2021**

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	STEFANO RICCI S.P.A.
Granted to Date of previous extension	10/17/2021
Address	VIA FAENTINA, 171 FIESOLE (FI), I-50010 ITALY
Attorney information	LUKIANA PILYUGIN MCGLEW AND TUTTLE, PC SCARBOROUGH STATION, SCARBOROUGH STATION SCARBOROUGH, NY 10510 UNITED STATES Primary Email: mandt@mcglewtuttle.com Secondary Email(s): mandt@mcglewtuttle.com 9149415600
Docket Number	T74817

Applicant Information

Application No.	90248130	Publication date	04/20/2021
Opposition Filing Date	10/18/2021	Opposition Period Ends	10/17/2021
Applicant	The Skin Room USA LLC 5385 PARK CENTRAL CT. NAPLES, FL 34109 UNITED STATES		

Goods/Services Affected by Opposition

Class 044. First Use: 2020/03/18 First Use In Commerce: 2020/04/01
All goods and services in the class are opposed, namely: Cosmetic skin care services, namely, facials

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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.	4961905	Application Date	08/05/2013
Registration Date	05/24/2016	Foreign Priority Date	02/20/2013
Word Mark	SR		
Design Mark			
Description of Mark	The mark consists of the stylized letters "S" and "R" wherein the "S" and "R" are intertwined with the "S" being at a higher level and slightly to the left of the "R".		
Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 Soaps, shaving soaps, after-shave lotions, cosmetic preparations for baths, shampoos, perfumery, eau de toilette, essential oils, aromatic potpourris and oils, hair lotions, balms other than for medical purposes, namely, lip balms, body balms, face balms, after shave; dentifrices, cosmetics</p> <p>Class 008. First use: First Use: 0 First Use In Commerce: 0 Silver plated tableware, namely, knives, forks and spoons; cutlery; side arms, other than firearms, namely, hunting knives; razors, razor cases</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes, namely, gold, platinum, jewelry boxes made of gold; jewellery, precious stones; horological and chronometric instruments</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 Albums for photographs, coins, stamps; engravings, lithographic works of art; paper, cardboard and goods made from these materials, not included in other classes, namely, cardboard boxes; bookbinding material; photographs; stationery; inkwells; adhesives for stationery or household purposes; paint brushes; typewriters; paperweights; drawing inks, calligraphy inks; pencil leads, pencil lead holders, pencils, pencil holders, pens, penholders, drawing pens, fountain pens, blankwriting or drawing books, magazines in the field of art, culture, fashion, and sports; newspapers, books in the field of art, culture, fashion, sports; writing instruments, drawing instruments, painting instruments, namely, brushes, paint brushes, palettes for painting</p> <p>Class 020. First use: First Use: 0 First Use In Commerce: 0 Furniture, tables, chairs, sofas, armchairs, mirrors, picture frames, wardrobes, works of art of wood, wax, plaster or plastic, animal horns, plant stands, um-</p>		

	<p>rella stands, bins not of metal, costumedisplay stands, hat stands, decorative mobiles, cupboards, cots, cushions, casks of wood, pillows, coat hangers, lecterns, mannequins, mattresses, magazine racks, hat racks, bookcases, umbrella stands, furniture partitions of wood, book rests, magazine racks, doors for furniture, flower-pot pedestals, magazine racks and filing cabinets, ladders of wood, bins of wood, writing desks, desks, easy chairs, footstools, sofas, corks for bottles, interior textile window blinds, dressing tables, office furniture, furniture, namely, showcases</p> <p>Class 021. First use: First Use: 0 First Use In Commerce: 0</p> <p>beverage glassware, indoor aquaria, works of art of porcelain, terracotta or glass; drinking glasses, glass bowls, bottles sold empty, jugs, busts of china, terra-cotta or glass, goblets, shoe horns,non-electric candelabras, decanters, corkscrews, bottle openers, epergnes, knife rests for the table, statuettes of porcelain, ceramic, earthenware or glass; flower pots, flasks, salad bowls, shaving-brushes, shaving brush stands, table plates, perfume sprayers sold empty, perfume vaporizers sold empty, coffee and teaservices being tableware, cups, teapots, sugar bowls, soup bowls</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0</p> <p>suits, bathrobes, bathing suits, bathing trunks, beach clothes, namely, swimsuits, swim trunks; berets, body linen, underwear, blouses, suspenders, footwear, sports footwear, stockings, socks, dressing gowns, shirts, hats, overcoats, beltsbeing clothing, layettes, ties, papillon being ties, pocket squares, foulards being clothing articles, sashes for wear,sashes for smoking suits, coats, stuff jackets, great coats, gloves being clothing, raincoats, leather clothing, namely, vests, coats, overcoats, trousers; singlets, polo-neck sweaters, sweaters, pullover, pelerines, trousers, slippers, pelisses, fur clothing, namely, vests, coats, great coats; hosiery, pajamas, sandals, shoes, scarves, half-boots, boots, T-shirts</p> <p>Class 034. First use: First Use: 0 First Use In Commerce: 0</p> <p>Tobacco; smokers' articles, namely, cigar glue, hookah charcoal; cigar and cigarette lighters for smokers; tobacco pouches, cigar cases, tobacco pipes, ashtrays for smokers, match holders, cigarette cases, cigarette and cigar cases with humidors, cigar cutters</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>Advertising; business management; business administration; office functions; services consisting of bringing together, for the benefit of others, various itemsso that customers can view and purchasethem; retail store services, also for others, of perfumery, cosmetics, eyeglasses, lightening apparatus, vehicles, crafts, aircrafts, jewellery, horological and chronometric instruments, stationery, printed matters, leather goods, umbrellas, furniture, mirrors, frames, works of art, household goods, glassware, porcelain and earthenware, clothing articles, footwear, wines, distillates, smokers' articles</p>
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U.S. Registration No.	5332108	Application Date	04/29/2016
Registration Date	11/14/2017	Foreign Priority Date	02/18/2016
Word Mark	SR		

Design Mark	
Description of Mark	<p>Consisting in a regular octagon formed by a frame containing points of circular-form; within the octagon the letters "SR", intertwined and partly not aligned, are surrounded by fancy ornaments with different thickness.</p>
Goods/Services	<p>Class 003. First use: First Use: 0 First Use In Commerce: 0 soaps; shaving soaps; after-shave lotions; cosmetic preparations for baths; shampoos; perfumery; eau de toilette; essential oils; aromatic potpourris and oils; hair lotions; balms other than for medical purposes, namely, lip balms, body balms and after-shave face balms; dentifrices; cosmetics</p> <p>Class 008. First use: First Use: 0 First Use In Commerce: 0 silver plated tableware, namely, knives, forks and spoons; razors; razor cases; cutlery; side arms, other than firearms, namely, hunting knives</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 eyeglasses, spectacle frames and eyeglass cases</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 albums for photographs, coins and stamps; engravings; lithographic works of art; stationery; paperweights; typewriters; paintbrushes; printed photographs; drawing inks and calligraphy inks; bookbinding material; paper, cardboard and goods made from these materials, not included in other classes, namely, cardboard boxes; pencil leads; pencil lead holders; pencils; pencil holders; pens; penholders; drawing pens; fountain pens; writing or drawing books; magazines, newspapers and books, all in the fields of art, culture, fashion and sports; writing instruments, drawing instruments, painting instruments, namely, brushes, paint brushes, palettes for painting; inkwells; adhesives for stationery or household purposes</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 leather key cases; canes; umbrella sticks; travelling trunks; handbags; leather-travelling bags; reins; leather credit card cases; leather briefcases; coverings of skins, namely, fur pelts; briefcases; animal hides; pocket wallets; purses; suitcases; attaché cases; duffle bags; rucksacks; saddlery; horse halters; horse collars; horse blankets; riding saddles; horseshoes</p> <p>Class 020. First use: First Use: 0 First Use In Commerce: 0 furniture; tables; chairs; sofas; armchairs, mirrors; picture frames; wardrobes; works of art of wood, wax, plaster or plastic; animal horns; display stands; bins</p>

not of metal; costume stands; hat stands; decorative mobiles; cupboards; cots; cushions, casks of wood; pillows; coat hangers; lecterns; mannequins; mattresses; magazine and hat racks; bookcases; umbrella stands; furniture partitions of wood; book rests; magazine racks; doors for furniture; flower-pot pedestals; magazine racks and filing cabinets; ladders of wood; bins of wood; writing desks; desks; easy chairs; footstools; corks for bottles; interior textile window blinds; dressing tables; office furniture; furniture, namely, showcases

Class 021. First use: First Use: 0 First Use In Commerce: 0

cleaning brushes for household use; household or kitchen utensils, namely, spatulas, strainers, graters, serving scoops; containers for household or kitchen use; beverage glassware made of porcelain or earthenware; indoor aquaria; works of art of porcelain, terracotta or glass; non-electric candelabra; decanters; corkscrews; bottle openers; combs; sponges for household purposes; shoe horns, goblets; busts of china, terra-cotta or glass; epergnes; ceramic tissue box covers for household purposes; knife rests; statuettes of porcelain, ceramics or earthenware; flower pots; flasks; salad bowls; shaving brushes; shaving brush stands; drinking glasses; glass bowls; bottles, sold empty; jugs; table plates, perfume sprayers sold empty; perfume vaporizers sold empty; coffee and tea services in the nature of tableware; cups; teapots; sugar bowls; soup bowls

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

jodhpurs; riding clothing other than hats, namely, boots, gloves, shoes; golf pants; golf shirts; horse-riding jackets; golf clothing, namely, shoes, shorts, skirts; tennis wear; golf trousers; golf caps; motorcycle jackets; riding and polo clothing, namely, shirts and knit tops; suits, bathrobes; bathing suits; bathing trunks; berets; body linen; underwear; blouses; suspenders; footwear; sports footwear; stockings; socks; dressing gowns; shirts; hats, overcoats; belts; clothing layettes; ties; pocket squares; foulards; sashes for wear; sashes for smoking suits; coats; stuff jackets; great coats; gloves; raincoats; leather clothing, namely, coats, boots, jackets, pants, shirts, skirts, vests, shoes, slippers, hats, belts; singlets; polo-neck sweaters; sweaters; pullovers; pelerines; trousers; slippers; pelisses; furs being clothing; pyjamas; sandals; shoes; scarves; beachwear; half-boots; boots; t-shirts; riding coats

Class 028. First use: First Use: 0 First Use In Commerce: 0

In-line roller skates; hunting game calls; golf accessories, namely, divot repair tools golf; board games; billiard tables; billiard cues; ice skates; roller skates; foils for fencing; darts; bags specially designed to hold cricket equipment; machines for physical exercises; skittles; billiard balls; tennis uprights; tennis rackets; shaped covers for tennis rackets; stuffed toy bears; snow sleds for recreational use; snow skis; pool cue bridges; cases for playing cards; sports articles, namely, hunting stands; hunting bows; sports articles, namely, golf flags; golf ball retrievers; shaped covers for golf bags; gaming equipment, namely, poker chips; cricket balls; bowling pins; tabletop basketball games; cases for archery bows; cricket bats; arrows for archery; targets for archery; quivers for archery; toy vehicles; playing cards; tables for table tennis; rackets; chessboards; chess games; golf clubs; playing balls; archery implements; bows for archery; toy arrows; toy gliders; table tennis balls; soft sculpture toys; soft sculpture plush toys; sports articles, namely, hunting blinds; chest protectors for sports use; billiard cue bridges; foils for fencing; ski poles; bowling balls; bags adapted for bowling balls; bindings for alpine skis; foosball tables; snowboards; dice games; dart games; tennis ball throwing apparatus; teddy bears; scooters toys; scale model vehicles; golf bags, with or without wheels; targets; play balloons; balls for games; soccer balls; tennis ball retrievers; target games; table tennis net posts; squash rackets; shaped covers for squash rackets; shoulder pads for sports use; manually operated exercise equipment; shaped covers for golf club heads; firearm targets; field hockey balls; building games; bocce balls; chip markers for bingo; table tennis rackets; golf articles, namely, putting practice mats; golf tees; golf club shafts; golf club heads; shaped covers for golf clubs; golf balls; cases for tennis balls; golf bag carts; stuffed toys; foosball tables; balls for racket

	<p>sports; snowshoes; plush toys; fencing weapons; apparatus for games, namely, video game joysticks; parlor games; dominoes; dice; checkers games; hockey sticks; tennisballs; billiard equipment; throat protectors for sports use; snowboard bindings; cases for pool cues; holders for pool cue chalk; pinball games; sports articles, namely, leg guards; ice hockey sticks; grip tapes for rackets; grip tapes for golf clubs; golf putters; shaped covers for golf putters; golf irons; dart carrying cases; dartboards; dartboard cases; cases for play accessories; basketballs; bags adapted for snow skis; toys, namely, mechanical action toys; monoskis; snow ski bindings; sole coverings for snowskis</p> <p>Class 034. First use: First Use: 0 First Use In Commerce: 0</p> <p>smokers' articles, namely, cigar glue and hookah charcoal; lighters for smokers; tobacco pouches; cigar cases; tobacco pipes; ashtrays for smokers; match holders; cigarette cases; cigarette and cigarholders also with humidors; cigar cutters; tobacco</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>the bringing together, for the convenience and benefit of others, of a variety of goods, enabling customers to view and purchase those goods, in the field of general merchandise; advertising, including promoting the goods and services of others through sponsorship and license agreements relating to international sporting events; organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; providing office functions; business administration services; business management; organization of exhibitions and events for commercial or advertising purposes; arranging and conducting of fairs and exhibitions for business and advertising purposes; retail store services featuring perfumery, cosmetics, eyeglasses, lightening apparatus, vehicles, crafts, aircrafts, jewelry, horological and chronometric instruments, stationery, printed matter, leather goods, umbrellas, furniture, mirrors, frames, works of art, household goods, glassware, porcelain and earthenware, clothing articles, footwear, wines, distillates and smokers' articles; retail store services featuring household linen and bed linen</p>
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Attachments	<p>79140651#TMSN.png(bytes) 79201691#TMSN.png(bytes) T77282.NoticeofOpposition.pdf(539908 bytes)</p>
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Signature	/Lukiana Pilyugin/
Name	LUKIANA PILYUGIN
Date	10/18/2021

ATTORNEY DOCKET NO. T74817
THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No: 90248130
For the Mark: SR and Design
Filed: October 12, 2020
Published in the Official Gazette on: April 20, 2021

STEFANO RICCI S.P.A.,)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
The Skin Room USA LLC,)	
)	
Applicant.)	

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

NOTICE IS HEREBY given that STEFANO RICCI S.P.A., a Corporation organized under the laws of Italy, with the address of 171 Via Faentina, FIESOLE (FI) ITALY, I-50010, believes that it would be damaged by the registration on the Principal Register of the mark shown in the above-identified application, and hereby opposes the same, pursuant to 15 USC §1063, 37 CFR §2.101 and 37 CFR §2.104.

As grounds for Opposition, it is respectfully alleged that:

1. STEFANO RICCI S.P.A. is and has been engaged in the manufacture, sale and marketing of soaps; shaving soaps; after-shave lotions; cosmetic preparations for baths; shampoos; perfumery; eau de toilette; essential oils; aromatic potpourris and oils; hair lotions; balms other than for medical purposes, namely, lip balms, body balms and after-shave face balms; dentifrices; cosmetics, and other goods and services in International Classes 8, 9, 16, 18, 20, 21, 25, 28, 34, and 35; all under its SR trademarks. Said use has been valid and continuous since its first use and has not been abandoned. The goods and services on which the Opposer's marks appear are either identical, substantially similar or highly related to those services recited by Applicant Skin Room USA LLC, in its Application to register the trademark SR.

2. STEFANO RICCI S.P.A. is the owner of the following valid and existing U.S. Registrations: SR – Registration No. 4961905 and SR– Registration No. 5332108 (TSDR record attached).

3. STEFANO RICCI S.P.A.'s registrations are *prima facie* proof of ownership of Opposer's SR marks from at least the original date of filing of its applications, and proof of the exclusive right to use its registered marks in commerce.

5. Opposer STEFANO RICCI S.P.A.'s marks have been used and continue to be in use in United States commerce. STEFANO RICCI S.P.A. has acquired considerable and valuable goodwill and recognition for its marks. The public has come to associate the trademarks SR with Opposer STEFANO RICCI S.P.A. and with soaps; shaving soaps; after-shave lotions; cosmetic preparations for baths; shampoos; perfumery; eau de toilette; essential oils; aromatic potpourris and oils; hair lotions; balms other than for medical purposes, namely, lip balms,

body balms and after-shave face balms; dentifrices; cosmetics, and all other goods and services in International Classes 8, 9, 16, 18, 20, 21, 25, 28, 34, and 35.

6. On October 12, 2020, the Applicant filed an application to register a trademark containing the words SR for the services: cosmetic skin care services, namely facials.

7. STEFANO RICCI S.P.A.'s SR registrations predated the filing date of Applicant's use-based application and first use dates.

8. STEFANO RICCI S.P.A.'s marks have been used in connection with soaps; shaving soaps; after-shave lotions; cosmetic preparations for baths; shampoos; perfumery; eau de toilette; essential oils; aromatic potpourris and oils; hair lotions; balms other than for medical purposes, namely, lip balms, body balms and after-shave face balms; dentifrices; cosmetics, and all other goods and services in International Classes 8, 9, 16, 18, 20, 21, 25, 28, 34, and 35; all under its SR trademarks, since well before the filing date of Applicant's use-based application and first use dates.

9. Applicant's mark is confusingly similar to STEFANO RICCI S.P.A.'s registered marks and is likely, when applied to the services of the Applicant, to cause confusion, or to cause mistake or to deceive. Applicant's mark makes a highly similar commercial impression to Opposer's marks due to its virtually identical appearance and sound. The overall commercial impression of Applicant's mark, when applied to the same, similar or related goods and services as those bearing Opposer's SR marks, would cause confusion, and/or would be likely to cause confusion, mistake, or deception.

10. Upon information and belief, Applicant uses its confusingly similar mark with the following services: cosmetic skin care services, namely facials.

11. Upon information and belief, both the Applicant's mark and Opposer STEFANO RICCI S.P.A.'s marks are applied to identical, substantially similar and highly related goods and services and said goods and services are likely to be sold or advertised through the same or similar channels of distribution and/or to the same general class of purchasers.

12. Applicant's SR mark resembles Opposer STEFANO RICCI S.P.A.'s Registrations and well-known SR marks, as used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive. Applicant's mark includes similar and identical parts of terms or phrases which appear in Registrant's marks, such as the intertwined "S" and "R" linked together in the same font with the "S" sitting slightly above the "R", resulting in applicant's mark being confusingly similar and confusingly similar in appearance and sound to Registrant's well-known and famous marks.

13. Applicant's SR mark is so similar to Opposer STEFANO RICCI S.P.A.'s famous and distinctive SR marks that Applicant's mark impairs the distinctiveness of the famous SR marks.

14. The SR trademarks have become famous nationwide for its use on soaps; shaving soaps; after-shave lotions; cosmetic preparations for baths; shampoos; perfumery; eau de toilette; essential oils; aromatic potpourris and oils; hair lotions; balms other than for medical purposes, namely, lip balms, body balms and after-shave face balms; dentifrices; cosmetics, and all other goods and services in International Classes 8, 9, 16, 18, 20, 21, 25, 28, 34, and 35; all under its SR trademarks, prior to the filing date of Applicant's application and first use dates.

15. Said use of SR by Opposer is symbolic of extensive good will and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the

goods of the respective parties to which the marks are applied, it is alleged that Applicant's mark so resembles Opposer's SR marks previously used and registered in the United States, and not abandoned, as likely to cause confusion, or to cause mistake, or to deceive.

16. Use and registration by the Applicant of the mark SR in association with its services of cosmetic skin care services, namely facials, is likely to cause dilution of the distinctive quality of Opposer's famous SR marks by tarnishment and blurring, in view of Opposer's long prior use of the distinctive trademarks SR in association with soaps; shaving soaps; after-shave lotions; cosmetic preparations for baths; shampoos; perfumery; eau de toilette; essential oils; aromatic potpourris and oils; hair lotions; balms other than for medical purposes, namely, lip balms, body balms and after-shave face balms; dentifrices; cosmetics, and all other goods and services in International Classes 8, 9, 16, 18, 20, 21, 25, 28, 34, and 35.

17. Opposer has a direct and personal stake in the proceeding in that, if Applicant is granted the registration opposed herein, and Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, Applicant will obtain unlawful gain and advantage to which it is not entitled under the Trademark Act of 1946, all to the detriment and harm of Opposer.

WHEREFORE, Opposer STEFANO RICCI S.P.A. prays that the herein referenced Application Serial No. 90248130, be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of STEFANO RICCI S.P.A.

