

ESTTA Tracking number: **ESTTA1176699**

Filing date: **12/06/2021**

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	12/08/2021
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 9149415600
Docket Number	T77310

Applicant Information

Application No.	90521611	Publication date	08/10/2021
Opposition Filing Date	12/06/2021	Opposition Period Ends	12/08/2021
Applicant	XIAMEN TUOWASEN TECHNOLOGY CO., LTD. UNIT B, 11TH FLOOR, NO.891 FANGHUBEIER ROAD, HULI DISTRICT, XIAMEN, FUJIAN, 361000 CHINA		


Goods/Services Affected by Opposition

Class 025. First Use: 2021/02/03 First Use In Commerce: 2021/02/03
All goods and services in the class are opposed, namely: Blouses; Coats; Dresses; Footwear; Gloves; Hats; Headwear; Pants; Scarfs; Shirts; Shoes; Shorts; Socks; Sweaters; T-shirts; Underwear; Vests; Belts; Jackets; Tops as clothing

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.	4783909	Application Date	02/05/2014
Registration Date	08/04/2015	Foreign Priority Date	08/06/2013
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of the three-dimensional profile of an eagle's head, facing left.		
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 009. First use: First Use: 0 First Use In Commerce: 0 Eyeglasses, spectacle frames, eyeglass cases</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 Wristwatches, pocket watches, table clocks, clocks, horology cases for clock and watch making; chronometers; rings, bracelets, tie clips in precious metal, [ornamental chains in precious metal, namely, neck chains, watch chains, and wristchains;] cuff links, [jewelry, namely, brooches of precious metal;] ornamental buttons of precious metal being jewelry</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Key cases of leather, canes, [umbrellaframes,] umbrellas, [umbrellas and their parts,] traveling trunks, bags, namely, athletic bags, carry-all bags, bookbags, clutch bags, overnight bags, sport bags; traveling bags made of leather, [reins,] credit card cases, business card cases, briefcases being leather goods, [coverings of skins being fur pelts,] briefcases, [animal skins being hides,] pocket wallets, purses; suitcases, [attachÃ© cases,] traveling bags, rucksacks [; saddlery, horse halters, horse collars, horse blankets, riding saddles, horseshoes]</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Suits, bathrobes, bathing suits, bathing trunks, beach clothes, namely, swim</p>		

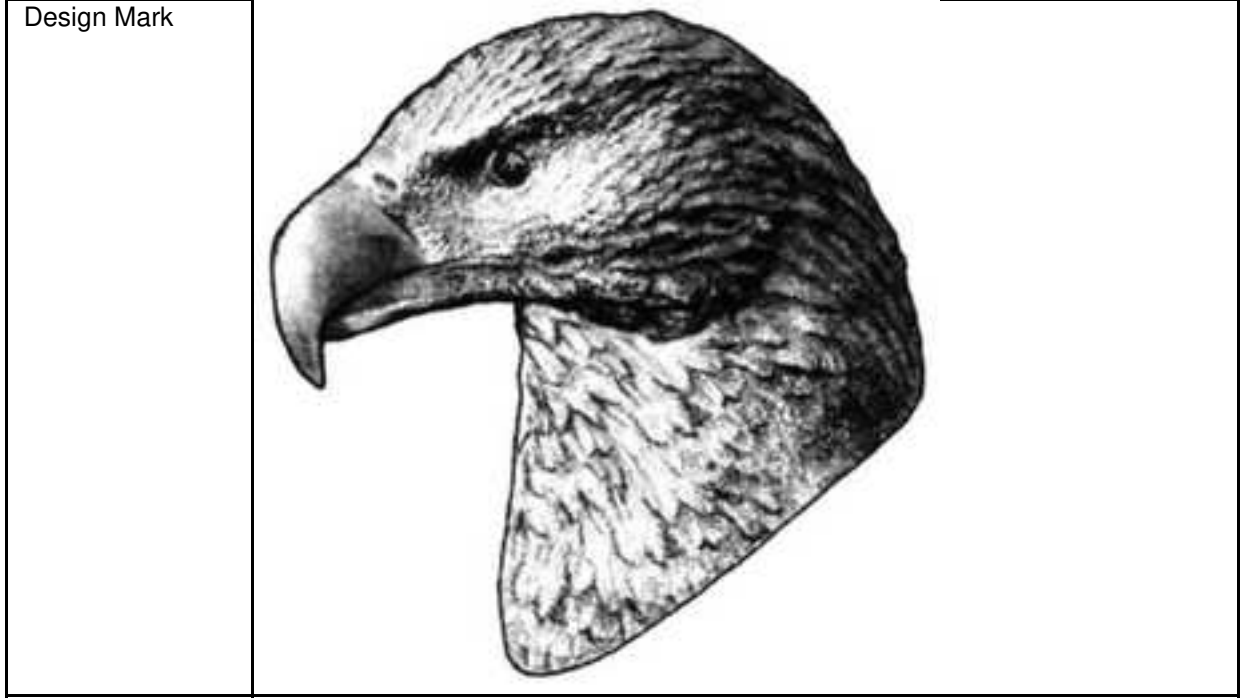
suits, swim trunks, [swim caps;] berets, body linen, underwear, blouses, [suspenders,] footwear, athletic footwear, [swim shoes, stockings,] socks, dressing gowns, shirts, hats, overcoats, belts being clothing, [layettes,] ties, bow ties, pocket squares, silk pocket squares, foulards, [sashes for wear,] sashes for smoking suits, coats, stuff jackets, [duffle coats,] gloves, raincoats, leather clothing, namely, vests, coats, overcoats, [trousers; hosiery, singlets,] turtle-neck sweaters, sweaters, pullover, [pelerines,] trousers, slippers, [pelisses, fur clothing, namely, vests, coats, great coats;] pyjamas, sandals, shoes, scarves, half-boots, boots, T-shirts

Class 035. First use: First Use: 0 First Use In Commerce: 0

Advertising services; [business management; business administration services; providing office functions;] the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of perfumery, cosmetics, eyeglasses, jewelry, horological and chronometric instruments, leather goods, household goods, clothing articles, footwear, cutlery, lighting apparatus, [vehicles, crafts, aircrafts,] smokers' articles; retail store services and online retail store services featuring perfumery, cosmetics, eyeglasses, jewelry, horological and chronometric instruments, leather goods, household goods, clothing articles, footwear, cutlery, lighting apparatus, [vehicles, crafts, aircrafts,] smokers' articles; retail store services and online retail store services for others featuring perfumery, cosmetics, eyeglasses, jewelry, horological and chronometric instruments, leather goods, household goods, household linens and bedlinens, clothing articles, footwear, cutlery, lighting apparatus, [vehicles, crafts, aircrafts,] smokers' articles

U.S. Registration No.	4783910	Application Date	02/05/2014
Registration Date	08/04/2015	Foreign Priority Date	08/06/2013

Word Mark: NONE



Description of Mark: The mark consists of the shaded profile of an eagle's head, facing left.

Goods/Services: Class 003. First use: First Use: 0 First Use In Commerce: 0
Soaps, shaving soaps, after-shave lotions, cosmetic preparations for baths,

	<p>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 009. First use: First Use: 0 First Use In Commerce: 0 Eyeglasses, spectacle frames, eyeglass cases</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 Wristwatches, pocket watches, table clocks, clocks, horology cases for clock and watch making; chronometers; rings, bracelets, tie clips in precious metal, ornamental chains in precious metal, namely, neck chains, watch chains, and wrist chains; cuff links, jewelry, namely, brooches of precious metal; ornamental buttons of precious metal being jewelry</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Key cases of leather, canes, umbrella frames, umbrellas, umbrellas and their parts, traveling trunks, bags, namely, athletic bags, carry-all bags, book bags, clutch bags, overnight bags, sport bags; traveling bags made of leather, reins, credit card cases, business card cases, briefcases being leather goods, coverings of skins being fur pelts, briefcases, animal skins being hides, pocket wallets, purses; suitcases, attaché cases, traveling bags, rucksacks; saddlery, horse halters, horse collars, horse blankets, riding saddles, horseshoes</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Suits, bathrobes, bathing suits, bathing trunks, beach clothes, namely, swim suits, swim trunks, swim caps; berets, body linen, underwear, blouses, suspenders, footwear, athletic footwear, swim shoes, stockings, socks, dressing gowns, shirts, hats, overcoats, belts being clothing, layettes, ties, bow ties, pocket squares, silk pocket squares, foulards, sashes for wear, sashes for smoking suits, coats, stuff jackets, duffle coats, gloves, raincoats, leather clothing, namely, vests, coats, overcoats, trousers; hosiery, singlets, turtleneck sweaters, sweaters, pullover, pelerines, trousers, slippers, pelisses, fur clothing, namely, vests, coats, great coats; pajamas, sandals, shoes, scarves, half-boots, boots, T-shirts</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Advertising services; business management; business administration services; providing office functions; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in the field of perfumery, cosmetics, eyeglasses, jewelry, horological and chronometric instruments, leather goods, household goods, clothing articles, footwear, cutlery, lighting apparatus, vehicles, crafts, aircrafts, smokers' articles; retail store services and online retail store services featuring perfumery, cosmetics, eyeglasses, jewelry, horological and chronometric instruments, leather goods, household goods, clothing articles, footwear, cutlery, lighting apparatus, vehicles, crafts, aircrafts, smokers' articles; retail store services and online retail store services for others featuring perfumery, cosmetics, eyeglasses, jewelry, horological and chronometric instruments, leather goods, household goods, household linens and bed linens, clothing articles, footwear, cutlery, lighting apparatus, vehicles, crafts, aircrafts, smokers' articles</p>
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Attachments	<p>79152333#TMSN.png(bytes) 79152334#TMSN.png(bytes) T77310.Opposition.pdf(439245 bytes)</p>
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Signature	/Lukiana Pilyugin/
Name	LUKIANA PILYUGIN
Date	12/06/2021

ATTORNEY DOCKET NO. T77310
THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application Serial No: 90521611
For the Mark: Design Mark
Filed: Feb. 09, 2021
Published in the Official Gazette on: August 10, 2021

STEFANO RICCI S.P.A.,)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
XIAMEN TUOWASEN TECHNOLOGY CO., LTD.,)	
)	
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 suits, bathrobes, bathing suits, bathing trunks, beach clothes, namely, swim suits, swim trunks, swim caps; berets, body linen, underwear, blouses, suspenders, footwear, athletic footwear, swim shoes, stockings, socks, dressing gowns, shirts, hats, overcoats, belts being clothing, layettes, ties, bow ties, pocket squares, silk pocket squares, foulards, sashes for wear, sashes for smoking suits, coats, stuff jackets, duffle coats, gloves, raincoats, leather clothing, namely, vests, coats, overcoats, trousers; hosiery, singlets, turtleneck sweaters, sweaters, pullover, pelerines, trousers, slippers, pelisses, fur clothing, namely, vests, coats, great coats; pajamas, sandals, shoes, scarves, half-boots, boots, T-shirts, and other goods and services in International Classes 3, 9, 14, 18, 25, and 35; all under its Eagle Head Design 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 XIAMEN TUOWASEN TECHNOLOGY CO., LTD., in its Application to register the Eagle Head Design Mark.

2. STEFANO RICCI S.P.A. is the owner of the following valid and existing U.S. Registrations: Eagle Head Design Mark – Registration No. 4783909 and Eagle Head Design Mark – Registration No. 4783910 (TSDR record attached).

3. STEFANO RICCI S.P.A.'s registrations are prima facie proof of ownership of Opposer's Eagle Head Design 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.

4. 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 Eagle Head Design trademarks with Opposer STEFANO RICCI S.P.A. and with suits, bathrobes, bathing suits, bathing trunks, beach clothes, namely, swim suits, swim trunks, swim caps; berets, body linen, underwear, blouses, suspenders, footwear, athletic footwear, swim shoes, stockings, socks, dressing gowns, shirts, hats, overcoats, belts being clothing, layettes, ties, bow ties, pocket squares, silk pocket squares, foulards, sashes for wear, sashes for smoking suits, coats, stuff jackets, duffle coats, gloves, raincoats, leather clothing, namely, vests, coats, overcoats, trousers; hosiery, singlets, turtleneck sweaters, sweaters, pullover, pelerines, trousers, slippers, pelisses, fur clothing, namely, vests, coats, great coats; pajamas, sandals, shoes, scarves, half-boots, boots, T-shirts, and other goods and services in International Classes 3, 9, 14, 18, 25, and 35.

5. On February 9, 2021, the Applicant filed an application to register a trademark containing the Eagle Head Design Mark for the goods: Blouses; Coats; Dresses; Footwear; Gloves; Hats; Headwear; Pants; Scarfs; Shirts; Shoes; Shorts; Socks; Sweaters; T-shirts; Underwear; Vests; Belts; Jackets; Tops as clothing.

6. STEFANO RICCI S.P.A.'s Eagle Head Design Mark registrations predated the filing date of Applicant's use-based application and first use dates.

7. STEFANO RICCI S.P.A.'s marks have been used in U.S. commerce in connection with suits, bathrobes, bathing suits, bathing trunks, beach clothes, namely, swim suits, swim trunks, swim caps; berets, body linen, underwear, blouses, suspenders, footwear, athletic footwear, swim shoes, stockings, socks, dressing gowns, shirts, hats, overcoats, belts being

clothing, layettes, ties, bow ties, pocket squares, silk pocket squares, foulards, sashes for wear, sashes for smoking suits, coats, stuff jackets, duffle coats, gloves, raincoats, leather clothing, namely, vests, coats, overcoats, trousers; hosiery, singlets, turtleneck sweaters, sweaters, pullover, pelerines, trousers, slippers, pelisses, fur clothing, namely, vests, coats, great coats; pajamas, sandals, shoes, scarves, half-boots, boots, T-shirts, and other goods and services in International Classes 3, 9, 14, 18, 25, and 35; all under its Eagle Head Design trademarks, since well before the filing date of Applicant's use-based application and first use dates.

8. Applicant's mark is confusingly similar to STEFANO RICCI S.P.A.'s registered marks and is likely, when applied to the goods 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. The overall commercial impression of Applicant's mark, when applied to the same, similar or related goods and services as those bearing Opposer's Eagle Head Design marks, would cause confusion, and/or would be likely to cause confusion, mistake, or deception.

9. Upon information and belief, Applicant uses its confusingly similar mark with the following goods: Blouses; Coats; Dresses; Footwear; Gloves; Hats; Headwear; Pants; Scarfs; Shirts; Shoes; Shorts; Socks; Sweaters; T-shirts; Underwear; Vests; Belts; Jackets; Tops as clothing.

10. 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.

11. Applicant's Eagle Head Design mark resembles Opposer STEFANO RICCI S.P.A.'s Registrations and well-known Eagle Head Design marks, as used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive. The Applicant's mark consists of the shaded profile of an eagle's head, facing left, resulting in the Applicant's mark being confusingly similar and confusingly similar in appearance and sound to Registrant's well-known and famous marks.

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

13. The Eagle Head Design trademarks have become famous nationwide for its use on suits, bathrobes, bathing suits, bathing trunks, beach clothes, namely, swim suits, swim trunks, swim caps; berets, body linen, underwear, blouses, suspenders, footwear, athletic footwear, swim shoes, stockings, socks, dressing gowns, shirts, hats, overcoats, belts being clothing, layettes, ties, bow ties, pocket squares, silk pocket squares, foulards, sashes for wear, sashes for smoking suits, coats, stuff jackets, duffle coats, gloves, raincoats, leather clothing, namely, vests, coats, overcoats, trousers; hosiery, singlets, turtleneck sweaters, sweaters, pullover, pelerines, trousers, slippers, pelisses, fur clothing, namely, vests, coats, great coats; pajamas, sandals, shoes, scarves, half-boots, boots, T-shirts, and other goods and services in International Classes 3, 9, 14, 18, 25, and 35; all under its Eagle Head Design trademarks, prior to the filing date of Applicant's application and first use dates.

14. Said use of Eagle Head Design mark 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 Eagle Head Design marks previously used and registered in the United States, and not abandoned, as likely to cause confusion, or to cause mistake, or to deceive.

15. Use and registration by the Applicant of the Eagle Head Design mark in association with its goods of Blouses; Coats; Dresses; Footwear; Gloves; Hats; Headwear; Pants; Scarfs; Shirts; Shoes; Shorts; Socks; Sweaters; T-shirts; Underwear; Vests; Belts; Jackets; Tops as clothing, is likely to cause dilution of the distinctive quality of Opposer's famous Eagle Head Design marks by tarnishment and blurring, in view of Opposer's long prior use of the distinctive Eagle Head Design marks in association with suits, bathrobes, bathing suits, bathing trunks, beach clothes, namely, swim suits, swim trunks, swim caps; berets, body linen, underwear, blouses, suspenders, footwear, athletic footwear, swim shoes, stockings, socks, dressing gowns, shirts, hats, overcoats, belts being clothing, layettes, ties, bow ties, pocket squares, silk pocket squares, foulards, sashes for wear, sashes for smoking suits, coats, stuff jackets, duffle coats, gloves, raincoats, leather clothing, namely, vests, coats, overcoats, trousers; hosiery, singlets, turtleneck sweaters, sweaters, pullover, pelerines, trousers, slippers, pelisses, fur clothing, namely, vests, coats, great coats; pajamas, sandals, shoes, scarves, half-boots, boots, T-shirts, and other goods and services in International Classes 3, 9, 14, 18, 25, and 35.

16. 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. 90521611, be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of STEFANO RICCI S.P.A.

Dated: Scarborough, New York
December 6, 2021

Respectfully submitted for
Opposer STEFANO RICCI S.P.A.

By: /Lukiana Pilyugin/
Attorney for Opposer
Lukiana Pilyugin
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Encs: TSDR Record and Assignment Record for Registration No. 4783909 and No. 4783910

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 13-0410.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING ELECTRONICALLY FILED WITH THE UNITED STATES PATENT AND TRADEMARK OFFICE THROUGH THE ESTTA SYSTEM ON DECEMBER 6, 2021.

McGLEW AND TUTTLE, P.C.

By: _____/Lukiana Pilyugin/_____ Date: December 6, 2021.