

ESTTA Tracking number: **ESTTA1186712**

Filing date: **01/25/2022**

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	F21 IPCO, LLC
Granted to date of previous extension	01/26/2022
Address	1411 BROADWAY, 21ST FLOOR NEW YORK, NY 10018 UNITED STATES

Attorney information	BRIDGETTE FITZPATRICK 1411 BROADWAY, 21ST FLOOR NEW YORK, NY 10018 UNITED STATES Primary email: trademark@authenticbrands.com Secondary email(s): bfitzpatrick@authenticbrands.com 6464909839
Docket no.	

Applicant information

Application no.	90507350	Publication date	09/28/2021
Opposition filing date	01/25/2022	Opposition period ends	01/26/2022
Applicant	Dear Brightly, Inc. 3338 17TH STREET, STE 100 SAN FRANCISCO, CA 94110 UNITED STATES		

Goods/services affected by opposition

Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Beauty serums; Retinol cream for cosmetic purposes; Sunscreen creams; Skin cleansers; Skin moisturizer

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)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols	Trademark Act Section 2(a)

Marks cited by opposer as basis for opposition

U.S. registration no.	2836546	Application date	03/26/2003
Register	Principal		
Registration date	04/27/2004	Foreign priority date	NONE
Word mark	FOREVER 21		
Design mark			
Description of mark	NONE		
Goods/services	Class 003. First use: First Use: 2002/06/19 First Use In Commerce: 2002/06/19 Cosmetics		

U.S. registration no.	2583457	Application date	07/07/2000
Register	Principal		
Registration date	06/18/2002	Foreign priority date	NONE
Word mark	FOREVER 21		
Design mark	FOREVER 21		
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: 2001/01/04 First Use In Commerce: 2001/01/04 Men's, women's and children's clothing,namely, t-shirts, shirts, blouses, pants, shorts, skirts, dresses, vests, sweaters, jackets and coats		

U.S. registration no.	6557011	Application date	12/30/2020
Register	Principal		
Registration date	11/09/2021	Foreign priority date	NONE
Word mark	FOREVER 21		

Design mark	<h1>FOREVER 21</h1>		
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: 2021/06/01 First Use In Commerce: 2021/06/01 Beachwear; Belts; Bottoms as clothing; Tops as clothing; Caps being headwear; Hats; Coats; Jackets; Rainwear; Dresses; Footwear; Hosiery; Jeans; Pants; Shirts;Skirts; Shorts; Socks; Swimwear; Sweatshirts; Sweatpants; Sweaters; Underwear; Vests; Sleepwear; Pajamas; Jumpsuits; Jumpers; Overalls; Suits; Scarves; Gloves;Mittens; Earmuffs; Ear Warmers; Neckties; Suspenders		

U.S. registration no.	4022660	Application date	02/11/2011
Register	Principal		
Registration date	09/06/2011	Foreign priority date	NONE
Word mark	FOREVER 21		

Design mark	<h1>FOREVER 21</h1>		
Description of mark	NONE		
Goods/services	Class 014. First use: First Use: 2001/10/01 First Use In Commerce: 2001/10/01 Bracelets; Charms; Earrings; Necklaces;Rings		

U.S. registration no.	2913132	Application date	11/17/2003
Register	Principal		
Registration date	12/21/2004	Foreign priority date	NONE
Word mark	FOREVER 21		

Design mark	<h1>FOREVER 21</h1>
Description of mark	NONE
Goods/services	Class 035. First use: First Use: 1998/03/01 First Use In Commerce: 1998/03/01 RETAIL STORE SERVICES FEATURING COSMETICS; EYEWEAR, NAMELY, SUNGLASSES; JEWELRY, NAMELY, BRACELETS, EARRINGS, NECKLACES, RINGS AND WATCHES; ACCESSORIES, SHOES, HANDBAGS; AND CLOTHING, NAMELY, PANTS, SHIRTS, JACKETS, SKIRTS, DRESSES, SWEATERS, HATS, GOWNS, SCARFS, BELTS, ROBES, PAJAMAS, VESTS AND HATS; TUBE TOPS, TANK TOPS, CORSETS, BRAS, UNDERWEAR AND SHAWLS

U.S. registration no.	6427978	Application date	12/01/2020
Register	Principal		
Registration date	07/20/2021	Foreign priority date	NONE
Word mark	FOREVER 21		
Design mark	<h1>FOREVER 21</h1>		
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: 2017/08/15 First Use In Commerce: 2017/08/15 eyeglasses; sunglasses; spectacles; optical frames; optical lenses		

Attachments	76085191#TMSN.png(bytes) 90432633#TMSN.png(bytes) 85240534#TMSN.png(bytes) 78328871#TMSN.png(bytes) 90352240#TMSN.png(bytes) FOREVER FIVE_Serial No. 90507350_Notice of Opposition.pdf(129057 bytes)
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Signature	/Bridgette Fitzpatrick/
Name	BRIDGETTE FITZPATRICK
Date	01/25/2022

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

Applicant: Dear Brightly, Inc.
Serial No.: 90507350
Filing Date: February 3, 2021
Mark: FOREVER FIVE

Published in the Official Gazette on September 28, 2021

F21 IPCO, LLC,)	
)	
Opposer,)	
)	
vs.)	Opposition No. _____
)	
Dear Brightly, Inc.,)	
)	
Applicant.)	

FILED ELECTRONICALLY VIA ESTAA

NOTICE OF OPPOSITION

Opposer F21 IPCO, LLC (“Opposer”), a limited liability company organized and existing under the laws of the State of Delaware, having a place of business at 1411 Broadway, New York, New York 10018, United States of America, believes that it will be damaged by registration of the mark “FOREVER FIVE” (“Applicant’s Mark”) as applied for in Application Serial No. 90507350 (the “Opposed Application”) filed by Dear Brightly, Inc. (“Applicant”). Accordingly, Opposer hereby opposes registration of Applicant’s Mark under the Opposed Application. Opposer has obtained the necessary extension of time in which to oppose the Opposed Application following its publication on September 28, 2021 in the Official Gazette.

The grounds for the opposition are as follows:

1. Opposer is the owner of the world-famous FOREVER 21 brand, a global retailer of men’s, women’s and children’s clothing and accessories, as well as beauty products. The Los Angeles-born brand, which was established in 1984, is known for offering a broad selection of on-trend and fashion-forward merchandise at a value. For more than three decades, Opposer and its predecessors-in-interest

have promoted and sold apparel and accessories globally and spent millions of dollars promoting FOREVER 21 stores and products through extensive advertising. Opposer operates over 500 brick and mortar locations around the world throughout North and South America, the Middle East, and Asia, as well as the official FOREVER 21 website, www.forever21.com. Today, the FOREVER 21 brand has a global reach with sales of FOREVER 21 apparel and other products exceeding \$2 billion in total retail volume and \$450 million in e-commerce.

2. Commencing long prior to the filing date of the Opposed Application, which was filed on an intent-to-use basis, Opposer and its predecessors-in-interest have engaged and Opposer is now engaged in the distribution, promotion and/or sale in commerce of apparel and accessories, as well as other items under the FOREVER 21 trademark and other marks that incorporate FOREVER 21.
3. Opposer is the owner of, and will rely herein on, the federal trademark registrations listed below for the FOREVER 21 word mark, which demonstrate the breadth of product and service categories offered under the FOREVER 21 brand (collectively, the “FOREVER 21 Trademarks”):

MARK	REG. NO.	ISSUE DATE	GOODS
FOREVER 21	2836546	April 27, 2004	Class 3: Cosmetics.
FOREVER 21	2583457	June 18, 2002	Class 25: Men's, women's and children's clothing, namely, t-shirts, shirts, blouses, pants, shorts, skirts, dresses, vests, sweaters, jackets and coats
FOREVER 21	6557011	November 9, 2021	Class 25: Beachwear; Belts; Bottoms as clothing; Tops as clothing; Caps being headwear; Hats; Coats; Jackets; Rainwear; Dresses; Footwear; Hosiery; Jeans; Pants; Shirts; Skirts; Shorts; Socks; Swimwear; Sweatshirts; Sweatpants; Sweaters; Underwear; Vests; Sleepwear; Pajamas; Jumpsuits; Jumpers; Overalls; Suits; Scarves; Gloves; Mittens; Earmuffs; Ear Warmers; Neckties; Suspenders
FOREVER 21	4022660	September 6, 2011	Class 14: bracelets; charms; earrings; necklaces; rings.

FOREVER 21	2913132	December 21, 2004	Class 35: retail store services featuring cosmetics; eyewear, namely, sunglasses; jewelry, namely, bracelets, earrings, necklaces, rings and watches; accessories, shoes, handbags; and clothing, namely, pants, shirts, jackets, skirts, dresses, sweaters, hats, gowns, scarfs, belts, robes, pajamas, vests and hats; tube tops, tank tops, corsets, bras, underwear and shawls.
FOREVER 21	6427978	July 20, 2021	Class 9: eyeglasses; sunglasses; spectacles; optical frames; optical lenses.

4. The above registrations (the “FOREVER 21 Registrations”) are valid, subsisting and, in most cases, incontestable, and constitute prima facie evidence of Opposer’s exclusive right to use the FOREVER 21 Trademarks in commerce for the goods and services specified in said registrations and related goods and services (the “FOREVER 21 Goods and Services”).
5. Opposer and its predecessors-in-interest have extensively sold, advertised, and promoted goods and services bearing the FOREVER 21 Trademarks, including the FOREVER 21 Goods and Services, to the public through various channels of trade in commerce for many years prior to the filing date of the Opposed Application.
6. As a result of the widespread advertising, promotion, and sale by Opposer and its predecessors-in-interest, Opposer’s FOREVER 21 Trademarks have acquired a high degree of recognition, fame and distinctiveness in the United States as designating goods, including the FOREVER 21 Goods and Services, originating exclusively from Opposer since well prior to the filing date of the Opposed Application.
7. Notwithstanding Opposer’s rights in and to the FOREVER 21 Registrations, Applicant filed the Opposed Application on February 3, 2021, seeking registration of “FOREVER FIVE” for “beauty serums; retinol cream for cosmetic purposes; sunscreen creams; skin cleansers; skin moisturizer” in International Class 3.
8. The goods for which Applicant seeks to register “FOREVER FIVE” in the Opposed Application are identical or very closely related to the goods upon which Opposer has used and currently uses its

FOREVER 21 Trademarks, including the FOREVER 21 Goods and Services, and, upon information and belief, both parties' goods would move through substantially the same channels of trade and be sold online and in traditional retail stores, among other locations.

9. The mark sought to be registered in the Opposed Application consists of the words "FOREVER" and "FIVE," which is nearly identical to the FOREVER 21 Trademarks, namely, "FOREVER" plus a number denoting youthfulness, and confusingly similar when applied to the goods and services of the parties.
10. Applicant's Mark is the same or a close approximation of Opposer's previously and extensively used name or identity.
11. Opposer's name or identity is of sufficient fame or reputation that when Applicant's Mark is used on the goods covered by the Opposed Application, a connection with Opposer would be presumed.
12. Registration of Applicant's Mark to Applicant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant's goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related to or associated with Opposer, all to Opposer's irreparable damage.
13. As a result of Opposer's long use, extensive advertising and promotion, and successful sales for at least 30 years, the FOREVER 21 Trademarks have become distinctive and famous, long prior to any date which may be claimed by Applicant.
14. Based on the Applicant's filing of the Opposed Application, Applicant intends to trade on the FOREVER 21 Trademarks and Opposer's goodwill associated therewith, thus causing damage to Opposer.

FIRST CAUSE OF ACTION

15. Opposer incorporates and alleges paragraph nos. 1-14.
16. The registration of Applicant's Mark to Applicant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant's Goods are made by,

licensed by, controlled by, sponsored by, or in some way related to or connected or associated with Opposer, in violation of §2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and all to Opposer's irreparable damage.

SECOND CAUSE OF ACTION

17. Opposer incorporates and alleges paragraph nos. 1-16.
18. The association that would arise from the similarity between Applicant's Mark and Opposer's FOREVER 21 Trademarks will harm the reputation of Opposer and the FOREVER 21 Trademarks, thereby resulting in dilution by tarnishment in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).
19. There is an overwhelming likelihood the association will impugn Opposer's goods covered by the FOREVER 21 Registrations and injure its business reputation.

THIRD CAUSE OF ACTION

20. Opposer incorporates and alleges paragraph nos. 1-19.
21. The association which would arise from the similarity between Applicant's Mark and the FOREVER 21 Trademarks will impair the distinctiveness of the FOREVER 21 Trademarks and thereby result in dilution by blurring in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).
22. There is an overwhelming likelihood the association will impugn Opposer's goods covered by the FOREVER 21 Registrations and injure its business reputation.

FOURTH CAUSE OF ACTION

23. Opposer incorporates and alleges paragraph nos. 1-22.
24. Applicant's mark falsely suggests a connection with Opposer, and or will bring Opposer into contempt or disrepute, in violation of §2(a) of the Lanham Act, 15 U.S.C., §1052(a), all to Opposer's irreparable damage.
25. Applicant's use of Applicant's Mark points uniquely and unmistakably to the Opposer.

26. Consumers that encounter Applicant's Mark will recognize Applicant's Mark as pointing uniquely and unmistakably to the Opposer.

WHEREFORE, Opposer, F21 IPCO, LLC, respectfully requests that application Serial No. 90507350, filed on February 3, 2021, be denied and that this opposition be sustained.

Dated: New York, New York

January 25, 2022

Respectfully submitted,

F21 IPCO, LLC
1411 Broadway
New York, New York 10018
(646) 490-9839

By: / Bridgette Fitzpatrick /
Bridgette Fitzpatrick
Senior Vice President, Associate General
Counsel – Intellectual Property

CERTIFICATE OF SERVICE

I hereby certify that on the 25th day of January 2022, the foregoing Notice of Opposition was served upon Applicant's attorney, Edward Steakley by email at the following email addresses:
esteakley@cognitionip.com.

Dated: January 25, 2022

/ Bridgette Fitzpatrick /
Bridgette Fitzpatrick