

ESTTA Tracking number: **ESTTA1225877**

Filing date: **08/02/2022**

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	Sanctuary Clothing LLC
Granted to date of previous extension	08/03/2022
Address	3611 N. SAN FERNANDO BLVD. BURBANK, CA 91505 UNITED STATES

Attorney information	EDMUND J. FERDINAND, III FERDINAND IP, LLC 450 SEVENTH AVENUE, SUITE 1300 NEW YORK, NY 10123 UNITED STATES Primary email: Jferdinand@FIPLawGroup.com Secondary email(s): LauraS@FIPLawGroup.com, gmonroy@FIPLawGroup.com 212-220-0523
Docket no.	SCI011USL

**Applicant information**

Application no.	90760693	Publication date	04/05/2022
Opposition filing date	08/02/2022	Opposition period ends	08/03/2022
Applicant	Home & Sanctuary LLC STE. 509 387 CORONA STREET DENVER, CO 80218 UNITED STATES		

**Goods/services affected by opposition**

Class 036. First Use: Apr 1, 2019 First Use In Commerce: Apr 1, 2019 All goods and services in the class are opposed, namely: Real estate agency services; Real estate brokerage
Class 042. First Use: Apr 1, 2019 First Use In Commerce: Apr 1, 2019 All goods and services in the class are opposed, namely: Interior decorating; Interior design; Providing information in the field of interior design via a website

**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. registration no.	6185380	Application date	11/26/2013
Register	Principal		
Registration date	10/27/2020	Foreign priority date	NONE
Word mark	SANCTUARY		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 021. First use: First Use: Sep 15, 2020 First Use In Commerce: Sep 15, 2020  Bath accessories, namely, cup holders; Soap dishes; Soap dispensers; Soap holders; Toothbrush holders</p> <p>Class 024. First use: First Use: Sep 15, 2020 First Use In Commerce: Sep 15, 2020  Bath towels; Curtains and towels; Face towels; Hand towels; Hand towels of textile; Hand-towels made of textile fabrics; Large bath towels; Terry towels; Towels; Turkish towel</p> <p>Class 027. First use: First Use: Sep 15, 2020 First Use In Commerce: Sep 15, 2020  Bath mats; Fabric bath mats; Textile bath mats</p>		

U.S. registration no.	6322661	Application date	07/25/2018
Register	Principal		
Registration date	04/13/2021	Foreign priority date	NONE
Word mark	SANCTUARY HOME		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 024. First use: First Use: Sep 14, 2020 First Use In Commerce: Sep 14, 2020  Bath towels; Beach towels; Hand towels; Kitchen towels; Bed blankets; Bed covers; Bed linen; Bed sheets; Bed spreads; Bed throws; Pillow-top, low-profile bed skirts; Quilt covers; Quilts; bed pads; comforters; duvet covers; duvets; covers; throws; blanket throws; mattress covers; mattress pads; pillow cases; pillowshams; Shower curtain liners; Shower curtains; tablecloths of textiles; table linens of textile</p>		

U.S. registration no.	4250277	Application date	01/10/2011
Register	Principal		
Registration date	11/27/2012	Foreign priority date	NONE
Word mark	SANCTUARY		

Design mark	
Description of mark	NONE
Goods/services	Class 025. First use: First Use: 1997 First Use In Commerce: 1997 Clothing, namely, tops, bottoms, jackets, coats, sweaters, hats, belts and shoes

Attachments	85977928#TMSN.png( bytes ) Notice of Opposition Against Home and Sanctuary Mark.pdf(524773 bytes )
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Signature	/ejf/
Name	EDMUND J. FERDINAND, III
Date	08/02/2022

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

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Application Serial. No.: 90/760,693  
Trademark: HOME AND SANCTUARY  
Filing Date: JUNE 8, 2021

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Sanctuary Clothing, LLC,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
Home & Sanctuary LLC,	)	
	)	
Applicant.	)	

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**NOTICE OF OPPOSITION**

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Sanctuary Clothing, LLC, a Delaware limited liability company, having a business address at 3611 North San Fernando Blvd. (“Opposer”), believes that it is and will be damaged by the registration of the mark HOME AND SANCTUARY, which is the subject of U.S. Trademark Application Serial No. 90/760,693, and hereby opposes registration of said mark for the services identified in Classes 36 and 42.

As grounds for the Notice of Opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title and interest in the “SANCTUARY” trademark and brand for use in connection with apparel and a wide variety of goods and services in connection with the popular lifestyle brand. Opposer adopted and began using the trademark “SANCTUARY” in interstate commerce in 1997, and has used the mark widely and continuously in U.S. commerce since that time.

2. Debra and Ken Polanco founded Opposer and the SANCTUARY brand in 1997.  
Since that time, the SANCTUARY brand has exhibited explosive growth into a full collection of apparel, accessories, footwear, and home goods. Opposer's SANCTUARY branded products capture the laid-back aesthetic of California, the effortless attitude of New York, and the adventurous spirit of the world.
3. The SANCTUARY brand, and its related family of marks, including SANCTUARY HOME, SOCIAL STANDARD BY SANCTUARY, SANCTUARY PEACE, SANCTUARY CURVE and SANCTUARY CLOTHING, among others (collectively, the "SANCTUARY Family of Marks"), are available in all channels of distribution in the United States where apparel and accessories are sold, including retail store and online e-commerce store channels, and Opposer's own e-commerce store located at [www.SanctuaryClothing.com](http://www.SanctuaryClothing.com). Opposer markets and promotes its SANCTUARY Family of Marks in all advertising channels, including in traditional media, and through digital marketing and social media marketing.
4. The following is a list of Registrations and pending Applications for the SANCTUARY Family of Marks in the US PTO:

Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead	Class(es)
1	97446730	SOCIAL STANDARD BY SANCTUARY	TSDR	LIVE	
2	97446710	SANCTUARY CLOTHING	TSDR	LIVE	
3	97035813	SOCIAL STANDARD BY SANCTUARY	TSDR	LIVE	
4	97353766	MODERN SURPLUS	TSDR	LIVE	
5	90774926	SOCIAL STANDARD BY SANCTUARY	TSDR	LIVE	
6	90563183	SOCIAL STANDARD BY SANCTUARY	TSDR	LIVE	
7	90563171	SANCTUARY	TSDR	LIVE	
8	90563147	SANCTUARY	TSDR	LIVE	
9	90840336	SANCTUARY	TSDR	LIVE	
10	90826323	SOCIAL STANDARD	TSDR	LIVE	
11	90826315	SANCTUARY	TSDR	LIVE	
12	90563162	SOCIAL STANDARD BY SANCTUARY	TSDR	LIVE	
13	90774895	SANCTUARY HOME	TSDR	LIVE	
14	90145749	SOCIAL STANDARD BY SANCTUARY	TSDR	LIVE	
15	88867172	SANCTUARY CLOTHING	TSDR	LIVE	
16	88983002	6570308 SOCIAL STANDARD BY SANCTUARY	TSDR	LIVE	
17	88981293	6382025 SANCTUARY	TSDR	LIVE	
18	88363116	6335680 SOCIAL STANDARD	TSDR	LIVE	
19	88051660	6322661 SANCTUARY HOME	TSDR	LIVE	
20	88363156	6190635 SOCIAL STANDARD BY SANCTUARY	TSDR	LIVE	
21	88051645	6037872 SANCTUARY	TSDR	LIVE	
22	88066684	5697293 SMART CREATION	TSDR	LIVE	025
23	87862508	5606806 SANCTUARY CURVE	TSDR	LIVE	025
24	86129700	6185380 SANCTUARY	TSDR	LIVE	
25	86147600	5863356 SANCTUARY LOS ANGELES	TSDR	LIVE	025
26	86981249	5157850 SANCTUARY PEACE	TSDR	LIVE	025
27	85977928	4250277 SANCTUARY	TSDR	LIVE	025
28	77687593	4254229 BLOSSOM & CLOVER	TSDR	LIVE	025
29	76402267	2757327 SANCTUARY CLOTHING	TSDR	LIVE	025

5. Of particular relevance to this Opposition, Opposer owns the Federally Registered Marks SANCTUARY (Reg. 6,185,380) for home goods in Classes 21, 24 and 27, and SANCTUARY HOME (Reg. 6,322,661) for home goods in Class 24.
6. Opposer's Registered Marks constitute prima facie evidence of the validity of the Registered Marks and of the registration thereof, and of Opposer's ownership of the marks shown therein. Opposer's Registered Marks also constitute notice to Applicant of its claim of ownership of the marks shown therein as provided in Sections 7(b), 22 and 33(a) of the Trademark Act.
7. Opposer has developed a well-known business reputation in the United States and has dedicated time and effort over twenty-five years to advertise, market and promote Opposer's goods and services in connection with Opposer's Registered Marks and SANCTUARY Family of Marks.

8. As a result of these efforts, and for many years prior to Applicant's filing date of June 8, 2021, Opposer's Registered Marks and SANCTUARY Family of Marks have become an identification of source for Opposer's goods and services. The Registered Marks and SANCTUARY Family of Marks are of significant value to Opposer, including as a valuable symbol of Opposer's goodwill. As a result, Opposer has and will also assert its common law rights resulting from its ownership and use of its SANCTUARY Family of Marks in connection with goods in all categories of fashion, accessories and home goods. Such rights include various prior trademarks uses, which uses have not been abandoned and which have been valid and continuous since a date prior to the filing date of Applicant's Application.
9. On June 8, 2021, Applicant filed Application Serial No. 90/760,693 seeking to register the mark HOME AND SANCTUARY ("Applicant's Mark") for services in Classes 36 and 42, claiming a date of first use in Interstate Commerce of April 1, 2019 for each class.
10. On June 15, 2021, Opposer filed U.S. Trademark Application Serial No. 90/774,895 seeking to register the mark SANCTUARY HOME for home goods in Classes 20, 21, 24 and 27. On September 30, 2021, the Trademark Examining Attorney issued an Office Action refusing registration of Opposer's SANCTUARY HOME mark under Section 2(d) of the Lanham Act because of Applicant's prior filed application for Applicant's Mark. Further examination of Opposer's application for the SANCTUARY HOME mark is now suspended pending the disposition of Applicant's Mark.
11. Opposer has registered and used its Registered Marks and SANCTUARY Family of Marks in the United States long prior to the filing date of Applicant's Application. As a result, Opposer has prior and superior rights as against Applicant in this Opposition.

12. Opposer has established a valuable reputation and goodwill in its Registered Marks and SANCTUARY Family of Marks by reason of its long use, marketing and promotion, and sale of goods and services utilized in association with the Marks.
13. As a result of the widespread use in interstate commerce by Opposer of the aforesaid Registered Marks and SANCTUARY Family of Marks in connection with apparel, accessories and home goods, and the advertisement and promotion of the brands, the Registered Marks and SANCTUARY Family of Marks have acquired extensive goodwill, have developed a high degree of distinctiveness, and are well-known and recognized as identifying quality products which have their origin with or have been authorized exclusively by Opposer.
14. Applicant's Mark is confusingly similar to Opposer's Registered Marks and SANCTUARY Family of Marks in sight, sound and commercial impression.
15. The services for which Applicant seeks to register Applicant's Mark are legally related to the goods for which Opposer uses and/or has registered its Registered Marks and SANCTUARY Family of Marks.
16. Applicant's Mark falsely suggests a connection with the identity of Opposer's Registered Marks and SANCTUARY Family of Marks.

**GROUND FOR RELIEF**  
**LIKELIHOOD OF CONFUSION – 15 U.S.C. 1052(d)**

17. Opposer realleges each and every allegation set forth in paragraphs 1 through 16 herein.
18. Applicant's Mark so resembles Opposer's Registered Marks and SACNTUARY Family of Marks, when used on or in connection with the services of Applicant, as to be likely to cause confusion, or to cause mistake, or to deceive.



19. Opposer will be damaged by registration of the Application in that Applicant's Mark so resembles Opposer's Registered Marks and SANCTUARY Family of Marks, including as registered in the United States Patent and Trademark Office, and in which Opposer owns common law trademark rights, as to be likely, when used on or in connection with the services as they are identified in the Application, as to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer prays that its opposition to the registration of U.S. Trademark Application Serial No. 90/760,693 for the mark HOME AND SANCTUARY be sustained and that Applicant's Mark be refused registration, and for such further relief that the Board deems just and proper.

Dated: August 2, 2022

Respectfully submitted,

FERDINAND IP LAW GROUP

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