

ESTTA Tracking number: **ESTTA1291230**

Filing date: **06/14/2023**

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	Dept Holding B.V.
Granted to date of previous extension	06/14/2023
Address	1 S. WACKER DR. SUITE 2250 CHICAGO, IL 60606 UNITED STATES
Attorney information	MEGAN RIMOVSKY 1 S WACKER DR SUITE 2250 CHICAGO, IL 60606 UNITED STATES Primary email: megan.rimovsky@deptagency.com Secondary email(s): legal-notices@us.deptagency.com No phone number provided
Docket no.	

Applicant information

Application no.	97181452	Publication date	02/14/2023
Opposition filing date	06/14/2023	Opposition period ends	06/14/2023
Applicant	Gallery Department, LLC 7613 BEVERLY BLVD. LOS ANGELES, CA 90036 UNITED STATES		

Goods/services affected by opposition

Class 025. First Use: Oct 30, 2020 First Use In Commerce: Oct 30, 2020
All goods and services in the class are opposed, namely: Clothing, namely, men's, women's, missy's, juniors', children's and infants' jeans, pants, trousers, capris, leggings, shorts, skorts, overalls, shortalls, skirts, dresses, tops, t-shirts, sweatshirts, blouses, shirts, jackets, coats, sweaters, vests, cardigans, scarves, socks, bandanas, neckties, belts, boots, sandals, footwear, hats, caps being headwear, headwear, underwear, swimwear, gloves and ties

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.	5352713	Application date	11/30/2016
Register	Principal		
Registration date	12/12/2017	Foreign priority date	NONE
Word mark	DEPT		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 035. First use: First Use: None First Use In Commerce: None Advertising and promotion services; consulting services relating to advertising and promotion for others; advertising services, namely, creating corporate and brand identity for others; business marketing consulting services; brand positioning services; business strategic planning services; design of advertising materials for others; business management consulting with relation to marketing, sales, product design and business and marketing strategies</p> <p>Class 042. First use: First Use: None First Use In Commerce: None Scientific and technological services, namely, research and design in the field of computer software; research services in the field of information and telecommunications technology; custom design and development of software; maintenance and updating of computer software; computer programming; providing search engines for the internet; design, development and maintenance of online websites for third parties; product development; new product design services; graphic arts design</p>		

U.S. application no.	79341136	Application date	01/11/2022
Registration date	NONE	Foreign priority date	08/03/2021
Word mark	DEPT		
Design mark			
Description of mark	The mark consists of the stylized word "DEPT" on a shaded square background.		
Goods/services	<p>Class 035. First use: First Use: None First Use In Commerce: None Advertising and promotion services; consulting services relating to advertising and promotion for others; advertising services, namely, creating corporate and brand identity for others; business marketing consulting services; brand positioning services; business strategic planning services; development of advertising concepts; business management consulting with relation to marketing, sales, operations, product design and business and marketing strategies</p> <p>Class 042. First use: First Use: None First Use In Commerce: None Scientific and technological services, namely, research and design in the field of computer hardware and software; research services in the field of information and telecommunications technology; custom design and development of software; maintenance and updating of computer software; computer programming; providing search engines for the internet; design, development and maintenance of online websites for third parties; product development; new product design services; graphic arts design</p>		

Attachments	TTAB Notice of Opposition SN97181452 Likelihood of Confusion -June 14 2023-final.pdf(612638 bytes) Exhibits TTAB Notice of Opposition Exhibits SN97181452 Likelihood of Confu-
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	sion-June 14 2023-final copy 2.pdf(6142569 bytes)
Signature	/mmr/
Name	MEGAN RIMOVSKY
Date	06/14/2023

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

In the Matter of Application Serial No. 97/181,452

For the mark: DEPT.

Published: February 14, 2023

Dept Holding B.V.,	:	
	:	Opposition No. _____
Opposer,	:	
	:	
v.	:	
	:	
Gallery Department, LLC,	:	
	:	
Applicant.	:	

NOTICE OF OPPOSITION

Box TTAB FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

To the Commissioner for Trademarks:

Dept Holding B.V. (“**Opposer**”) believes that it is or will be damaged by the issuance of a registration for the alleged mark shown in Application Serial No. 97/181,452 and owned by Gallery Department, LLC (“**Applicant**”). Opposer hereby opposes same pursuant to Section 13(a) of the Lanham Trademark Act of 1946 (“**Lanham Act**”), 15 U.S.C. § 1063(a).

As grounds for opposition, Opposer alleges as follows:

1. On December 12, 2017, Opposer was issued Reg. No. 5352713 (“**Opposer’s Registration**” or the “**DEPT Mark**”) by the United States Patent and Trademark Office (“**USPTO**”) based on Opposer’s use of “DEPT” in connection with a broad range of services identified in Opposer’s Registration of DEPT in International Classes 35 and 42. Attached

as Exhibit 1 is a true and correct printout from the USPTO electronic database showing the current status and title of the registration as of June 13, 2023.

2. Opposer has used the DEPT Mark in interstate commerce in the United States continuously since at least February 2018 in connection with its digital agency business for the provision, sale, marketing, advertising, and promotion of numerous services relating to digital marketing and technology. Attached hereto as Exhibit 2 are screenshots of representative samples of Opposer's website showing Opposer's use of the DEPT Mark in connection with these services. As example, Opposer's Registration identifies services Opposer provides to third parties relating to advertising, brand design, marketing, promotion, developing brand identities, designing advertising materials, product design consulting, research and custom design of computer software, computer programming, graphic arts designed.

3. Opposer has used the term "DEPT" as a trademark in interstate commerce in the United States continuously since at least October 2020 in connection with its the provision, sale, marketing, advertising, and promotion of apparel, including sweatshirts, socks, t-shirts, bags, scarves, hats and water bottles. Attached hereto as Exhibit 3 are screenshots of representative samples of Opposer's website showing Opposer's use of the term "DEPT" in connection with the sale of such goods, and attached as Exhibit 4 are a sample of the Opposer's goods marketed in connection with the term "DEPT".

4. As a result of its widespread, continuous, and exclusive use of the DEPT Mark to identify its services and goods and Opposer as their source, Opposer owns valid and subsisting federal statutory and common law rights to DEPT Mark.

5. Opposer's DEPT Mark is distinctive to both the consuming public and Opposer's trade.

6. Opposer has expended substantial time, money, and resources marketing, advertising, and promoting the services and goods sold under the DEPT Mark.

7. The services and goods Opposer offers under the DEPT Mark are of high quality.

8. Upon information and belief, Applicant, Gallery Department, LLC, on December 20, 2021, filed trademark Application Serial No. 97/181,452 to register the proposed mark "DEPT." for clothing, namely, men's, women's, missy's, juniors', children's and infants' jeans, pants, trousers, capris, leggings, shorts, skorts, overalls, shortalls, skirts, dresses, tops, t-shirts, sweatshirts, blouses, shirts, jackets, coats, sweaters, vests, cardigans, scarves, socks, bandanas, neckties, belts, boots, sandals, footwear, hats, caps being headwear, headwear, underwear, swimwear, gloves and ties in International Class 025.

9. Applicant allegedly began using the proposed mark on October 30, 2020, approximately 3 years after Opposer began using Opposer's DEPT Mark.

10. Opposer's DEPT Mark has priority over the proposed mark because Opposer's use and registration date predates the Applicant's alleged date of first use or any other date on which the Applicant may rely for purposes of priority.

11. Applicant's proposed mark is nearly identical and confusingly similar to Opposer's DEPT Mark. Both are comprised of a single identical term, "DEPT", and the only difference is the addition of a silent "." following "DEPT" in Applicant's proposed mark.

12. The goods covered by the Applicant's Application Serial No. 97/181,452 are similar to the goods Opposer offers under its common law DEPT Mark and within the zone of expansion of Opposer's rights under its federal registration for the DEPT Mark.

13. The proposed mark is barred from registration because it consists of or comprises a mark which so resembles Opposer's previously used and registered DEPT Mark, as to be likely, when used in connection with the alleged goods of Applicant, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).

WHEREFORE, Opposer respectfully prays that its opposition be sustained and that registration to Applicant be refused.

Dated: June 14, 2023

Respectfully submitted,

Dept Holding B.V.

Megan Rimovsky

Megan Rimovsky, Commercial Counsel

1 S. Wacker Dr.
Suite 2250
Chicago, IL 60622
773-329-0084
Attorney for Dept Holding B.V.

EXHIBIT 1

Generated on: This page was generated by TSDR on 2023-06-13 12:54:58 EDT

Mark: DEPT

DEPT

US Serial Number: 79205803

Application Filing Date: Nov. 30, 2016

US Registration Number: 5352713

Registration Date: Dec. 12, 2017

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Dec. 12, 2017

Publication Date: Sep. 26, 2017

Mark Information

Mark Literal Elements: DEPT

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

International Registration Number: 1340902

International Registration Date: Nov. 30, 2016

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Advertising and promotion services; consulting services relating to advertising and promotion for others; advertising services, namely, creating corporate and brand identity for others; business marketing consulting services; brand positioning services; business strategic planning services; design of advertising materials for others; business management consulting with relation to marketing, sales, product design and business and marketing strategies

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 66(a)

For: Scientific and technological services, namely, research and design in the field of computer software; research services in the field of information and telecommunications technology; custom design and development of software; maintenance and updating of computer software; computer programming; providing search engines for the internet; design, development and maintenance of online websites

EXHIBIT 1

for third parties; product development; new product design services; graphic arts design

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 66(a)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: Yes

Filed 66A: Yes

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Dept Holding B.V.

Owner Address: Generaal Vetterstraat 66
NL-1059 BW Amsterdam
NETHERLANDS

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NETHERLANDS

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Dmitry O. Makarov

Docket Number: DMP 0048 US

Attorney Primary Email Address: mail@iphorgan.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Dmitry O. Makarov
IpHorgan Ltd.
195 Arlington Heights Rd, Suite #125
Buffalo Grove, ILLINOIS UNITED STATES 60089-1768

Phone: 847-808-5500

Fax: 847-808-7238

Correspondent e-mail: mail@iphorgan.com dmakarov@iphorgan.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
May 09, 2023	TEAS SECTION 71 & 15 RECEIVED	
Mar. 30, 2023	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Mar. 30, 2023	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 30, 2023	TEAS WITHDRAWAL OF ATTORNEY RECEIVED-FIRM RETAINS	
Mar. 30, 2023	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 30, 2023	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Mar. 30, 2023	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Dec. 12, 2022	COURTESY REMINDER - SEC. 71 (6-YR) E-MAILED	
Sep. 27, 2018	LIMITATION FROM THE IB EXAMINED, NO ACTION IS NEEDED	72629
Aug. 03, 2018	RESTRICTION OF HOLDER'S RIGHT OF DISPOSAL RECEIVED	
May 12, 2018	FINAL DECISION TRANSACTION PROCESSED BY IB	
Mar. 26, 2018	FINAL DISPOSITION NOTICE SENT TO IB	
Mar. 26, 2018	FINAL DISPOSITION PROCESSED	71529
Mar. 12, 2018	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	

EXHIBIT 1

Dec. 12, 2017	REGISTERED-PRINCIPAL REGISTER	
Sep. 26, 2017	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Sep. 26, 2017	PUBLISHED FOR OPPOSITION	
Sep. 06, 2017	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 23, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 23, 2017	EXAMINER'S AMENDMENT ENTERED	88888
Aug. 23, 2017	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Aug. 23, 2017	EXAMINERS AMENDMENT E-MAILED	6328
Aug. 23, 2017	EXAMINERS AMENDMENT -WRITTEN	91244
Aug. 23, 2017	TEAS/EMAIL CORRESPONDENCE ENTERED	69712
Aug. 23, 2017	CORRESPONDENCE RECEIVED IN LAW OFFICE	69712
Aug. 17, 2017	ASSIGNED TO LIE	69712
Jul. 25, 2017	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 03, 2017	REFUSAL PROCESSED BY IB	
May 15, 2017	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
May 15, 2017	REFUSAL PROCESSED BY MPU	71529
May 08, 2017	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
May 07, 2017	NON-FINAL ACTION WRITTEN	91244
May 02, 2017	APPLICATION FILING RECEIPT MAILED	
Apr. 28, 2017	ASSIGNED TO EXAMINER	91244
Apr. 28, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED	
Apr. 21, 2017	LIMITATION FROM ORIGINAL APPLICATION ENTERED	71529
Apr. 20, 2017	SN ASSIGNED FOR SECT 66A APPL FROM IB	

International Registration Information (Section 66a)

International Registration Number:	1340902	International Registration Date:	Nov. 30, 2016
Intl. Registration Status:	REQUEST FOR EXTENSION OF PROTECTION PROCESSED	Date of International Registration Status:	Apr. 20, 2017
Notification of Designation Date:	Apr. 20, 2017	Date of Automatic Protection:	Oct. 20, 2018
International Registration Renewal Date:	Nov. 30, 2026		
First Refusal Flag:	Yes		

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Dec. 12, 2017

DEPT®

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AN AGENCY FOR TODAY AND TOMORROW

DEPT®

PREPARE TO PIONEER

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Explore the experience

About DEPT®

DEPT® is pioneering tech/marketing to help brands stay ahead. Globally, our team of 4,000+ digital specialists across 30+ locations on 5 continents delivers pioneering work on a global scale with a boutique culture.

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Our Clients

The Twitch logo, featuring the word "twitch" in a bold, black, sans-serif font. The letter "t" is stylized with a horizontal bar that extends to the left.

We value a great working relationship with our clients above all else. It's why many of them have worked with us for years as their trusted partner.

Pioneering Technology

From e-commerce and emerging technology, to customer experiences and cloud architecture, we ideate and implement future-ready technical solutions that set new standards for digital business.



Pioneering Creativity

We build and evolve brands for the digital age, delivering boundary-breaking creative and campaigns that resonate with the right audience, no matter the channel.



Supported by our proprietary marketing technology platform, Ada by DEPT®, we combine creativity, data and tech to ideate and implement winning media strategies that cut through in crowded markets.



Our partners & technologies

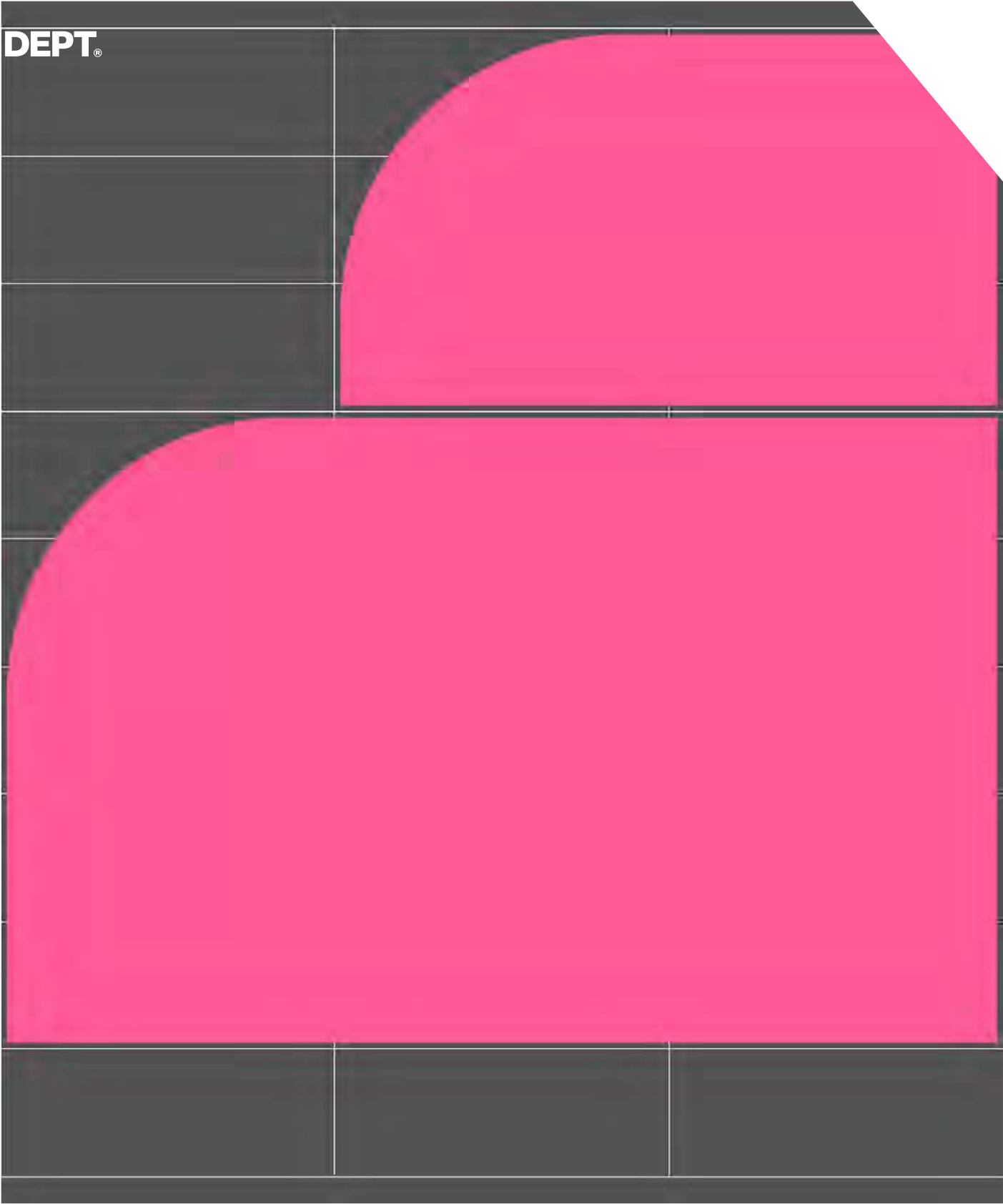


Together with our partners, we push the boundaries of what is possible with technology.

Insights

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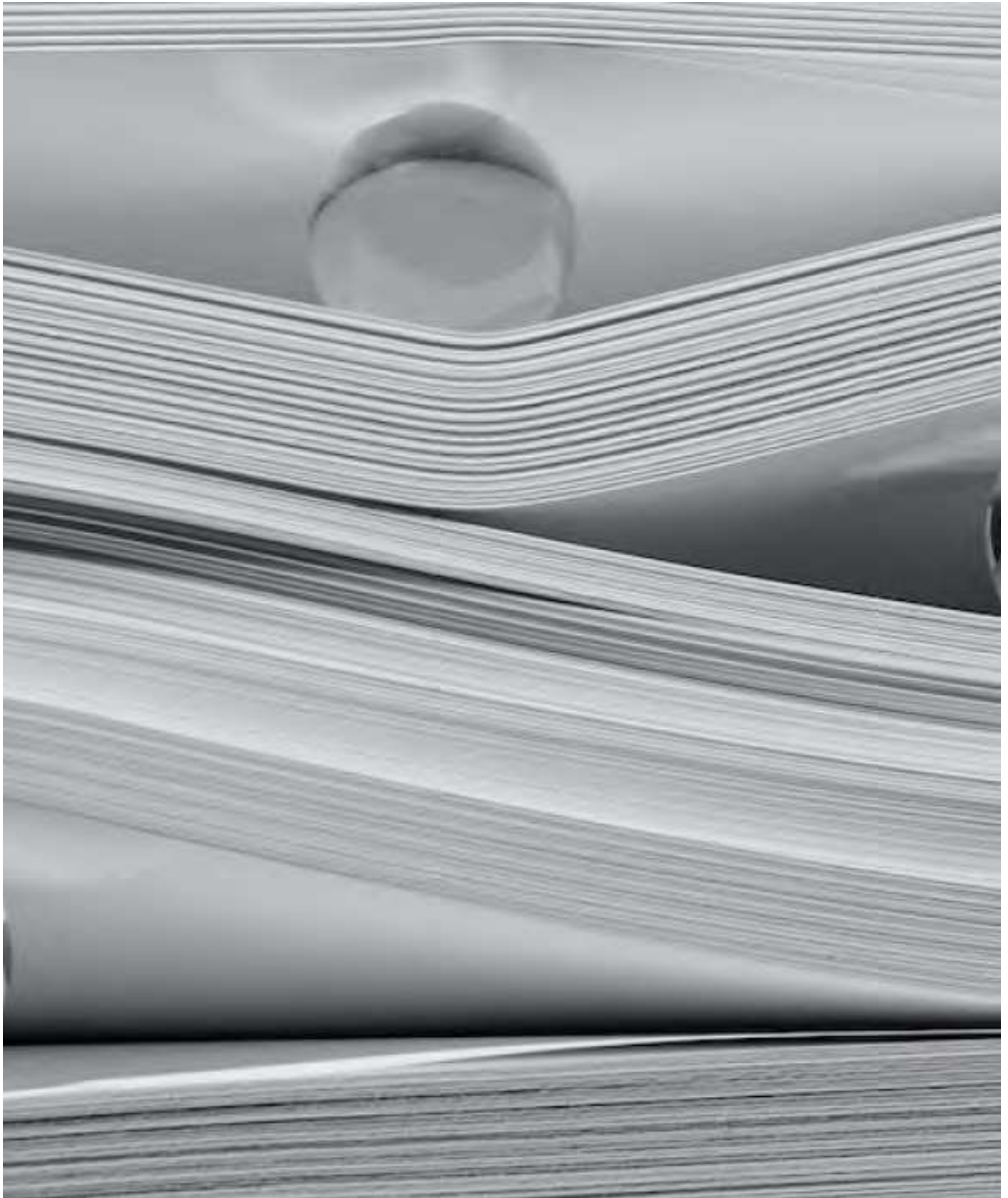
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TikTok Brand Building Guide

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GROWTH • Kelsey Anderson

Beyond Google: The future of search marketing

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DEPT® Sets Record as Network and Agency of the Year at the 2023 Webby Awards

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DEPT® Apparel

/DEPT®

BASIC/DEPT®

DOGSTUDIO/DEPT®

HELLO MONDAY/DEPT®

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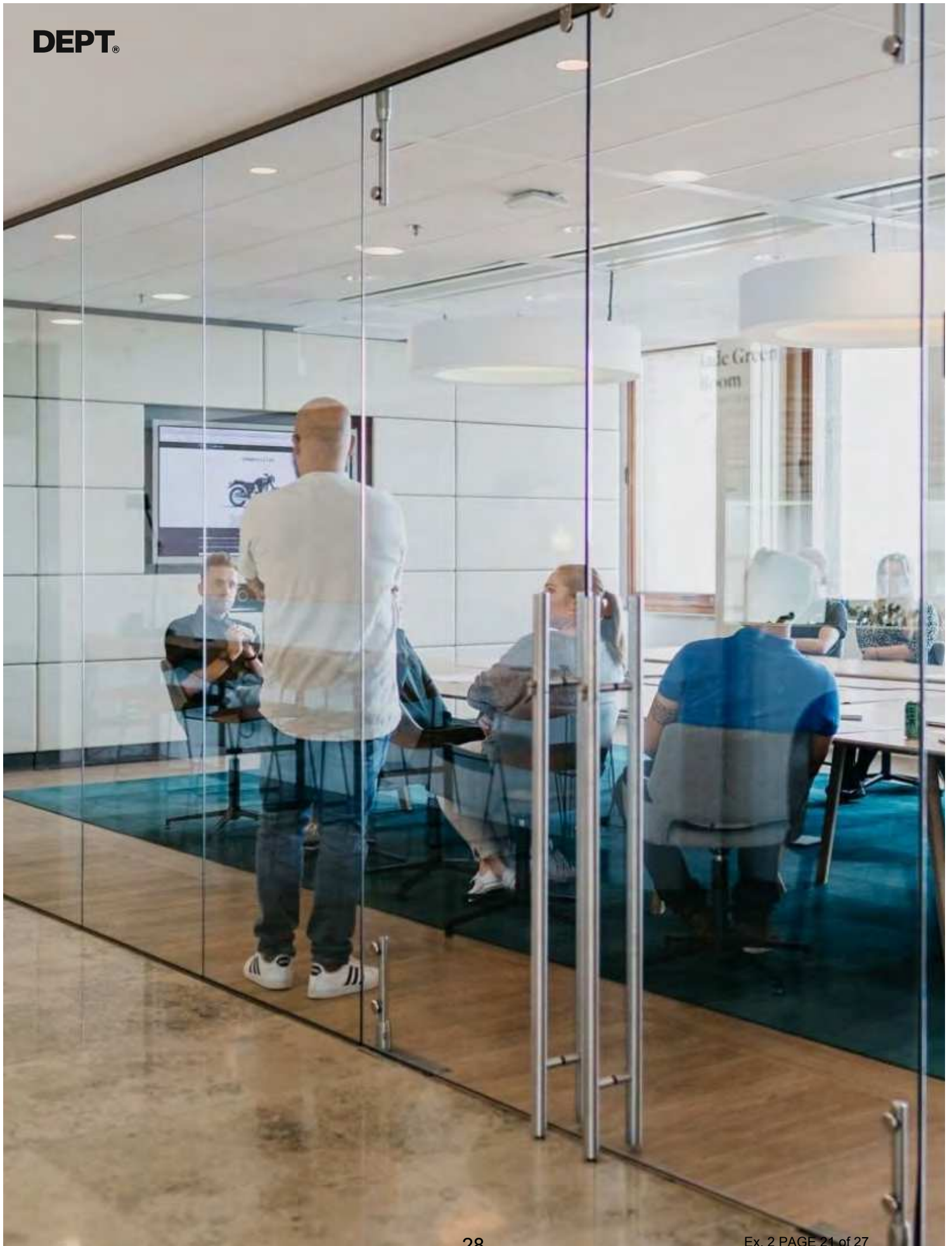


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marketing

- Services
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Artificial Intelligence

DEPT®/AI is your implementation partner. A team of 400+ integrating AI into pioneering creative and product experiences.

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We build brands for the digital age. Pairing creative storytelling that is deeply human with the best of what technology has to offer.

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We partner with your IT organisation to build the technology teams, architecture and platforms that fuel your digital business.

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Experience

We digitise processes, products, services and transactions by designing customer experiences that build your digital business.

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Growth

We leverage your data to create and optimise media experiences while helping to build your digital marketing team and tech stack.

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05 Energy & Utilities

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USD \$



MENU

ALL PRODUCTS



World ide s eater - black
37

~~\$44.04~~
EXHIBIT 3

MENU



Long-sleeve - DEPT APPAREL X D /CREATIVE

~~\$27.53~~ \$22.02

EXHIBIT 3



KNITTED SCARF

\$22.02

EXHIBIT 3

Totebag - Blue
\$22.02



Totebag - Red

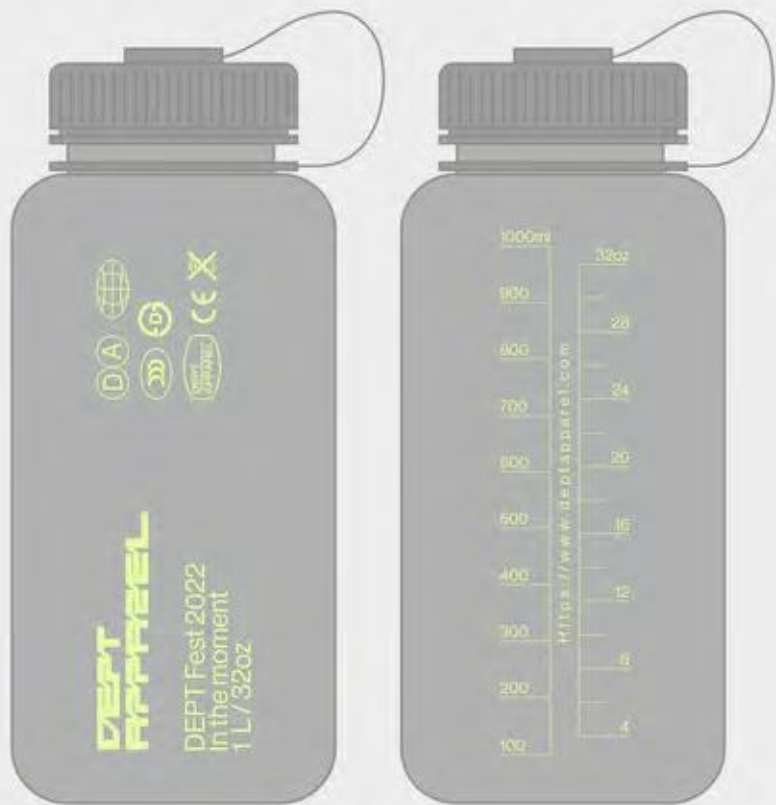
\$22.02

EXHIBIT 3

01 - Jacket Earth Bod Mind
\$55.05

EXHIBIT 3

03 - Jacket World ide
\$55.05



DEPT Fest Water Bottle - Black

\$16.52 \$11.01



DEPT Fest Water Bottle - Blue

\$16.52 \$11.01

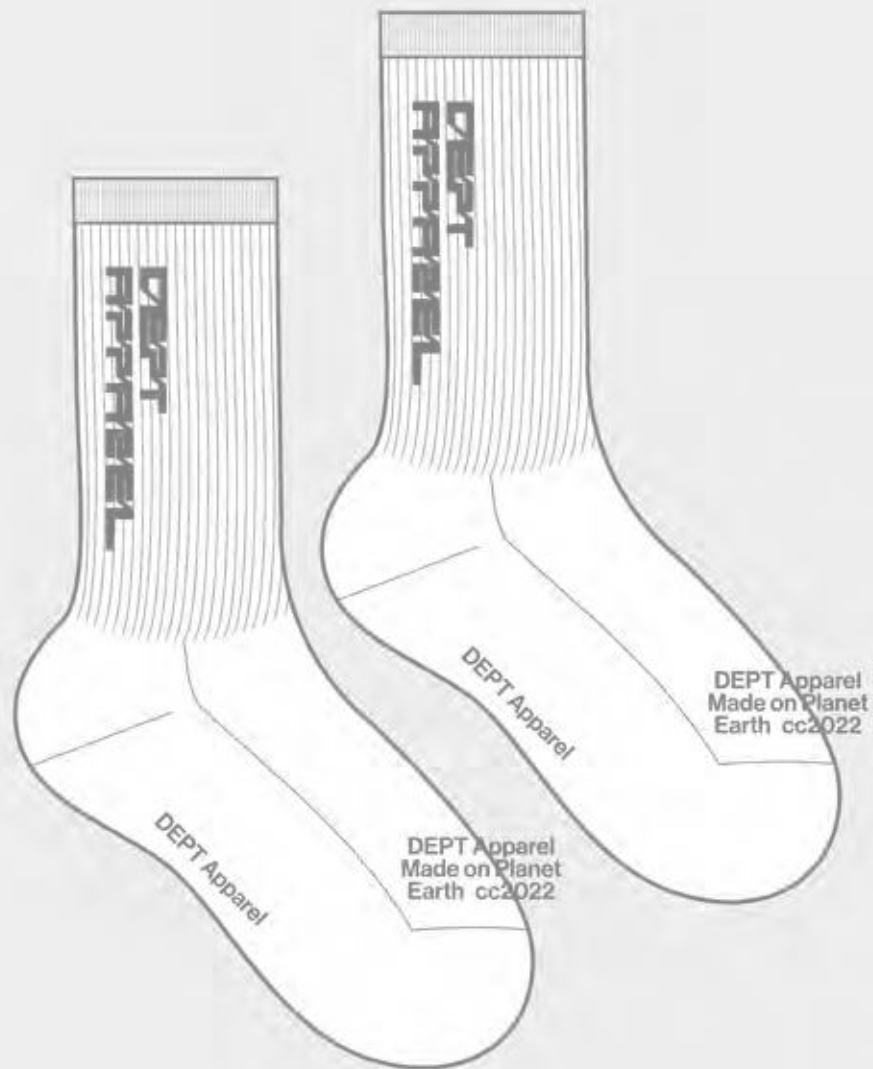
DEPT Fest Water Bottle - Orange
~~\$16.52~~ \$11.01



Longsleeve Embroider - Black

~~\$33.03~~ \$27.53

Longsleeve World Wide - Black
~~\$33.03~~ \$27.53



Sport Socks - White / Black

~~\$11.01~~ \$7.71

Sport Socks - White / Green
~~\$11.01~~ \$7.71



Sport Socks - White / Lilac

~~\$11.01~~ \$7.71

Sale

EXHIBIT 3

T-shirt Planet Earth - White
~~\$27.53~~ \$22.02

Sale

Baseball Cap - Black
~~\$22.02~~ \$16.52

Sale

EXHIBIT 3

Totebag Dance - Blue

~~\$22.02~~ \$16.52

Sale

Totebag Dance - Orange

~~\$22.02~~ \$16.52

Sold Out

EXHIBIT 3
Totebag Flower - Beige
~~\$22.02~~ \$16.52

Sale

Longsleeve World Wide - White
~~\$33.03~~ \$27.53

EXHIBIT 3



United States (USD \$)





KNITTED SCARF

\$22.02

Tax incl ded.

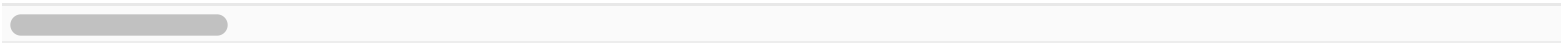
Pick-up location

Select or pick-up location

ADD TO CART

- 100% Acrylic Yarns
- 1 color a
- Made in Europe
- Limited Edition

EXHIBIT 3



← BACK TO ALL PRODUCTS

USD \$











