

3. Petitioner owns the following U.S. Registrations, among many others, for the mark ESPRIT and variants thereof:

MARK	GOODS/CLASS	REG. NO	REG. DATE
ESPRIT	Women's shoes, in Class 25	765,974	03/03/64
ESPRIT	Watches, in Class 14	1,056,960	01/25/77
ESPRIT	Luggage, in Class 18	1,080,349	12/27/77
ESPRIT DE CORP.	Women's wearing apparel-namely, blouses, knit tops, halters, t-shirts, smock tops, sweaters, jackets, pants and skirts, in Class 25	1,163,810	08/04/81
ESPRIT	Jewelry, in Class 14	1,340,608	06/11/85
ESPRIT	Sunglasses, in Class 9	1,342,393	06/18/85
ESPRIT (Stylized)	Towels, in Class 24	1,351,743	7/30/85
ESPRIT (Stylized)	Women's wearing apparel-namely, blouses, knit tops, halters, t-shirts, smock tops, sweaters, jackets, pants and skirts; and men's wearing apparel-namely, t-shirts and pants, in Class 25	1,401,275	07/15/86
ESPRIT	General merchandise catalogs, in Class 16	1,406,681	8/26/86
ESPRIT DE CORP. (Stylized)	Shoes, in Class 25	1,419,245	12/02/86
CAFFE ESPRIT	Restaurant services, in Class 42	1,453,688	08/18/87
ESPRIT	Belts, scarves, hats, socks, tights, leggings, sweatshirts, sweatpants, vests and coats, in Class 25	1,480,858	03/15/88

ESPRIT (Stylized)	Shoes, slippers, boots, sneakers, athletic shoes, hosiery, socks, tights, leggings, leotards, gloves, hats, scarves, belts, vests, dresses, coats, mufflers, stockings, pajamas, panties, underwear, headbands, shorts, jogging suits, sweatshirts, sweat pants, ski jackets, ski pants, raincoats, robes, nightgowns and swimwear, in Class 25	1,485,327	04/19/88
ESPRIT	Pillow cases, pillow shams, pillows, bedspreads, comforters, dust ruffles, duvet covers, blankets, bath rugs, shower curtains, bed sheets, in Class 24	1,496,788	7/19/88
ESPRIT	Electric lighting fixtures, in Class 11 Shopping carts, in Class 12 Mannequins, desks, picture frames, stools, tables, chairs, shelving units and racks, in Class 20 Carpets, in Class 27	1,525,487	2/14/89
ESPRIT (Stylized)	Note paper, notebooks, address books, envelopes, pens, pencils, pen and pencil holders, paper bags, stationery-type portfolios, clipboards, calendars, posters, cardboard boxes, newspapers, magazines and books pertaining to fashion, lifestyle, architecture, interior design, art, personality, fitness, health and food, in Class 16	1,532,974	4/4/89

ESPRIT	Purses and handbags, in Class 18	1,559,014	10/03/89
ESPRIT (Stylized)	Purses, handbags, tote bags, backpacks, wallets, messenger bags, key cases, hip packs, bookbags, cosmetic cases sold empty, and carry-on bags, in Class 18	1,673,462	01/28/92
ESPRIT	Retail store services for clothing, clothing accessories, bedding, eyewear, jewelry, watches, books, stationery items, bags, shoes and socks, in Class 42	1,709,010	08/18/92
ESPRIT (Stylized)	Watches, in Class 14	1,898,850	06/13/95

The foregoing registrations are valid, subsisting, and in full force and effect. Moreover, Petitioner's Registration Nos. 765,974; 1,163,810; 1,351,743; 1,401,275; 1,406,681; 1,419,245; 1,453,688; 1,480,858; 1,485,327; 1,525,487; 1,532,974; 1,559,014; 1,673,462; 1,709,010; and 1,898,850, among others, have become incontestable. As such, these registrations serve as conclusive evidence of Petitioner's exclusive rights to use the ESPRIT marks.

4. In addition, by virtue of the extensive use of the ESPRIT marks by Petitioner and its predecessors in interest, Petitioner owns common law rights in the ESPRIT marks.

5. The ESPRIT marks have become famous and distinctive through, *inter alia*, Petitioner's and its predecessors in interest's extensive U.S. use, advertising and promotion of the ESPRIT marks for a variety of goods and services over a substantial period of time.

6. Indeed, Petitioner uses the ESPRIT marks as a "lifestyle brand" that encompasses various categories of goods and services in both the U.S. and abroad. Petitioner also intends to

substantially broaden its use of the ESPRIT marks for a variety of additional goods and services in the U.S. in the near future.

7. On February 11, 1998, Respondent Von Schrader Company, a Wisconsin partnership located at 1600 Junction Avenue, Racine Wisconsin 53403, filed an intent-to-use application to register the mark ESPRIT for “upholstery cleaning machines” in International Class 7. It obtained Registration No. 2,344,023 for that mark on April 18, 2000.

8. The filing date of the registration sought to be cancelled, and upon information and belief the only date on which Respondent can rely, is subsequent to Petitioner’s date of first use of the ESPRIT mark, subsequent to the dates on which Petitioner received many of its registrations for the ESPRIT marks, including those noted above, and subsequent to the date on which Petitioner’s ESPRIT marks became famous.

9. Upon information and belief, prior to the filing date of the registration sought to be cancelled, Respondent had actual knowledge of Petitioner’s prior rights to and interest in the ESPRIT marks as well of the recognition and goodwill Petitioner had developed in the ESPRIT marks. In addition, as a matter of law, Respondent was on constructive notice of Petitioner’s rights in the ESPRIT marks based on Petitioner’s registrations therefor.

10. The mark ESPRIT as registered by Respondent is identical and/or confusingly similar to Petitioner’s prior-used ESPRIT marks and otherwise has a similar connotation, sound, appearance and commercial impression to Petitioner’s prior-used ESPRIT marks.

11. The continued registration of Respondent’s mark is inconsistent with Petitioner’s prior rights in its ESPRIT marks, is inconsistent with Petitioner’s statutory grant of exclusivity of

use of the registered ESPRIT marks, harms Petitioner's investment and goodwill in its ESPRIT marks, and dilutes and is likely to dilute Petitioner's ESPRIT marks.

FIRST GROUND FOR RELIEF FOR CANCELLATION
ON THE GROUND OF LIKELIHOOD OF CONFUSION

12. Petitioner repeats and re-alleges each and every allegation contained in paragraphs 1 through 11 as if fully set forth herein.

13. The ESPRIT marks have been used continuously by Petitioner since prior to any date on which Respondent can rely.

14. Respondent's ESPRIT mark trades on and is a colorable imitation of Petitioner's registered and prior-used ESPRIT marks.

15. By virtue of the use of the ESPRIT marks by Petitioner and its predecessors, the goodwill associated with Petitioner's marks, the registrations owned by Petitioner for ESPRIT and variations, including those set forth above, the fame of the ESPRIT marks, and Petitioner's use of the ESPRIT marks as a "lifestyle brand," the registration by Respondent of a mark that is a colorable imitation of Petitioner's ESPRIT marks for Respondent's goods is likely to create the erroneous impression that Respondent's goods originate from, come from or otherwise are associated with Petitioner or that Respondent's goods are endorsed, sponsored, or in some way connected with Petitioner. The continued registration of the mark ESPRIT in connection with the goods set forth in Registration No. 2,344,023 is likely to cause confusion, cause mistake, or to deceive the public into the belief that the goods offered by Respondent under the mark ESPRIT come from or are otherwise sponsored by Petitioner.

16. By reason of the foregoing, Petitioner is and/or is likely to be harmed by the continued registration of Registration No. 2,344,023 for the mark ESPRIT and cancellation is appropriate under 15 U.S.C. §1064.

**SECOND GROUND FOR RELIEF FOR
CANCELLATION ON THE GROUND OF DILUTION**

17. Petitioner repeats and re-alleges each and every allegation contained in paragraphs 1 through 16 as if fully set forth herein.

18. Petitioner's ESPRIT marks are inherently distinctive, have been used for years in connection with goods and services sold and advertised nationally, have become famous among consumers, and are the subject of numerous federal trademark registrations. As a result, the ESPRIT marks are famous marks under the Lanham Act.

19. Respondent's intent-to-use application to register ESPRIT was filed after Petitioner's ESPRIT marks became famous.

20. Continued registration of the mark ESPRIT by Respondent would be likely to dilute, or would continue to dilute, the distinctive quality of Petitioner's ESPRIT marks by lessening their capacity to identify and distinguish goods and services exclusively from Petitioner.

21. By reason of the foregoing, Petitioner is and/or is likely to be harmed by the continued registration of Registration 2,344,023 for the mark ESPRIT and cancellation is appropriate under 15 U.S.C. §1064.

WHEREFORE, it is respectfully requested that this cancellation proceeding be sustained and that Registration No. 2,344,023 be cancelled.

The Cancellation fee in the amount of \$300.00 for one class is filed herewith. To the extent that there is any payment due to the Trademark Trial and Appeal Board or to the extent that there is any overpayment, the Trademark Trial and Appeal Board is hereby authorized to charge any additional opposition filing fee or to credit any extra payment to Petitioner's deposit account No. 23-0825-0576900.

Dated: New York, New York
April 18, 2005

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

Certificate of Express Mailing

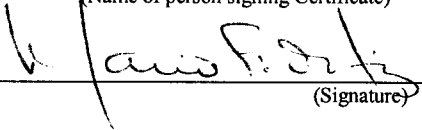
I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on the date indicated below and is addressed to: for Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

"Express Mail" mailing label No. EV 608124299 US
April 18, 2005

(Date of Deposit)

Mario F. Ortiz

(Name of person signing Certificate)


(Signature)

By: 

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