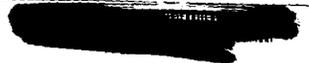


TTAB



02-12-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #0

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

Opposer's Ref: ASC USA TC-0207384

In the Matter of Application Serial No. 76/303,797  
Published in the Official Gazette on October 15, 2002  
Mark: KANGAROO & Design

-----X  
ASCO GROUP LIMITED,  
  
                  Opposer,  
  
      - against -  
  
KANGAROO CO., LTD,  
  
                  Applicant.  
-----X

Opposition No.

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

BOX TTAB FEE

02/26/2003 KGIBBONS 00000051 76303797

01 FC:6402

300.00 OP

**NOTICE OF OPPOSITION**

Opposer, Asco Group Limited, a corporation organized and existing under the laws of the Bahamas, with an office and place of business at 3333 New Hyde Park Road, New Hyde Park, New York 11042, believes that it would be damaged by the issuance of a registration for the trademark KANGAROO & Design, as applied for in Application Serial No. 76/303,797, and hereby opposes the same. As grounds for its opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. For many years, and since long before any date upon which Applicant can rely, Opposer has been using the marks KANGAROOS, KANGAROOS & Design, and the design

mark shown in Exhibit C (collectively, "Opposer's Marks") in connection with shoes in the United States. Opposer's Marks have come to represent enormous goodwill of Opposer.

2. Opposer is the owner of all rights, title and interest in Opposer's Marks and of, *inter alia*, the following trademark registrations for such marks:

- (a) U.S. Registration No. 2,096,351, issued September 16, 1997, for the mark KANGAROOS in International Class 25 for, among other things, footwear, shoes, and sport shoes;
- (b) U.S. Registration No. 2,096,350, issued September 16, 1997, for the mark KANGAROOS & Design in International Class 25 for, among other things, footwear, shoes, and sports shoes;
- (c) U.S. Registration No. 1,253,032, issued October 4, 1983 for the design mark shown in Exhibit C in International Class 25 for shoes; and
- (d) U.S. Registration No. 1,384,447, issued March 13, 1984 for KANGAROOS (Stylized) in International Class 25 for footwear.

Copies of the foregoing trademark registrations are attached hereto as Exhibits A through D.

3. Opposer's aforementioned registrations are valid, subsisting, and in full force and effect. Pursuant to Sections 7(b) and 33 of the Lanham Act, 15 U.S.C. §§ 1057(b), 1115, such registrations constitute evidence (and with respect to U.S. Reg. Nos. 1,253,032 and 1,384,447, conclusive evidence) of Opposer's exclusive rights in and ownership of these marks.

4. The rights of Opposer in Opposer's Marks are prior to any alleged rights of Applicant in the mark herein opposed.

5. Upon information and belief, Applicant is a corporation organized under the laws of Korea, with a place of business at 419 Chongchon-Dong, Bupyeong-Gu, Incheon, Korea.

6. On August 23, 2001, Applicant filed the application at issue to register the mark KANGAROO & Design on an intent-to-use basis for “furniture and floor polish; automobile polish; creams for leather; windshield cleaner fluids; polishing wax for automobiles; shoe polish; leather waxes; glass cleaners; and polishing creams for automobiles” in Class 3.

7. Goods listed in Applicant’s application, namely shoe polish, creams for leather, and leather waxes (“Applicant’s Shoe Products”), are closely related to the goods for which Opposer owns registrations and which Opposer offers under Opposer’s Marks.

8. Applicant’s KANGAROO & Design mark is identical or substantially similar to Opposer’s Marks in sight, sound, meaning, and commercial impression.

9. Applicant’s KANGAROO & Design mark so resembles Opposer’s Marks as to be likely, when applied to Applicant’s Shoe Products, to cause confusion, mistake or deception, and cause the public to believe that the goods sold under the Applicant’s KANGAROO & Design mark emanate from or are otherwise sponsored by or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), with consequent damage to Opposer and the public.

10. Upon information and belief, Applicant applied to register its KANGAROO & Design mark with full knowledge of Opposer’s prior use and exclusive rights in Opposer’s Marks and with full knowledge of Opposer’s existing federal trademark registrations for Opposer’s Marks. In addition, Applicant was on constructive notice of Opposer’s prior rights by virtue of Opposer’s federal registrations for Opposer’s Marks.

11. Opposer will be damaged by the registration of Applicant’s KANGAROO & Design mark to Applicant for Applicant’s Shoe Products because such registration will support and assist Applicant in the confusing and misleading use of Applicant’s mark, and will give color of rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought of Applicant's KANGAROO & Design mark with respect to Applicant's Shoe Products in Application Serial No. 76/303,797 be denied.

The Opposition fee in the amount of \$300.00 for one class is filed herewith. If for any reason this amount is insufficient, it is requested that Opposer's attorneys' Deposit Account No. 23-0825-0576900 be charged with any deficiency. This paper is filed in duplicate.

Please recognize as attorney for Opposer in this proceeding Craig Mende, J. Allison Strickland and Tamar Niv Bessinger, attorneys admitted to practice in the State of New York, whose address is Fross Zelnick Lehrman & Zissu, P.C., 866 United Nations Plaza, New York, New York 10017, telephone number (212) 813-5900.

Dated: New York, New York  
February 12, 2003

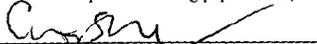
"Express Mail" mailing label No. EL 718086845 US

Date of Deposit: February 12, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

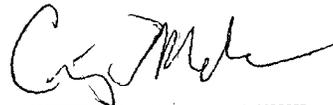
Craig S. Mende

(Printed name of person mailing paper or fee)

  
(Signature)

Respectfully submitted,

FROSS ZELNICK LEHRMAN  
& ZISSU, P.C.

By:   
Craig Mende  
J. Allison Strickland  
Tamar Niv Bessinger  
866 United Nations Plaza  
New York, New York 10017  
(212) 813-5900  
Attorneys for Opposer

Int. Cls.: 18, 25 and 28

Prior U.S. Cls.: 1, 2, 3, 22, 23, 38, 39, 41 and 50

United States Patent and Trademark Office

Corrected

Reg. No. 2,096,351

Registered Sep. 16, 1997

OG Date Feb. 9, 1999

**TRADEMARK  
PRINCIPAL REGISTER**

**KANGAROOS**

ASCO GROUP LIMITED (BAHAMAS CORPORATION)  
3333 NEW HYDE PARK ROAD  
NEW HYDE PARK, NY 11042

OWNER OF BAHAMAS REG. NO. 16,754, DATED 9-20-1994, EXPIRES 9-20-2008.

OWNER OF BAHAMAS REG. NO. 16,753, DATED 9-20-1994, EXPIRES 9-20-2008.

OWNER OF BAHAMAS REG. NO. 16,752, DATED 9-20-1994, EXPIRES 9-20-2008.

OWNER OF BAHAMAS REG. NO. 16,751, DATED 9-20-1994, EXPIRES 9-20-2008.

OWNER OF U.S. REG. NOS. 1,220,046, 1,323,336 AND OTHERS.

FOR: BAGS, NAMELY, ALL PURPOSE SPORTS BAGS, HANDBAGS, PURSES, RUCKSACKS, SATCHELS, TRAVELING BAGS, DUFFEL BAGS, GARMENT BAGS FOR TRAVEL, BACKPACKS; BRIEFCASE TYPE PORTFOLIOS, ATTACHE CASES, WALLETS, BRIEFCASES, TRUNKS FOR TRAVELING, SUITCASES; UMBRELLAS AND PARASOLS,

IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FOR: FOOTWEAR, SHOES, SPORTS BOOTS, SPORTS SHOES; CLOTHING, NAMELY, HEADWEAR, HOSIERY, HATS, HEADBANDS, JACKETS, JERSEYS, JUMPERS, LEGGINGS, SHIRTS, SHORTS, SINGLET, SKIRTS, SOCKS, SPORTS JERSEYS, SWEATERS, SWEAT SHIRTS, T-SHIRTS NOT IN THE NATURE OF UNDERWEAR, TROUSERS; AND WATER-PROOF CLOTHING, NAMELY, WATER PROOF JACKETS AND COATS; ATHLETIC WEAR, NAMELY, WARM UP SUITS, SWEAT SHIRTS AND SWEATPANTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FOR: TOYS, GAMES AND PLAYTHINGS, NAMELY, STUFFED TOYS; GYMNASTIC AND SPORTING ARTICLES, NAMELY, ELBOW GUARDS FOR ATHLETIC USE, KNEE GUARDS FOR ATHLETIC USE, SHIN GUARDS FOR ATHLETIC USE, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

SER. NO. 74-675.837. FILED 5-17-1995.

EXHIBIT A

Int. Cls.: 18, 25 and 28

Prior U.S. Cls.: 1, 2, 3, 22, 23, 38, 39, 41 and 50

United States Patent and Trademark Office

Corrected

Reg. No. 2,096,350

Registered Sep. 16, 1997

OG Date Feb. 9, 1999

TRADEMARK  
PRINCIPAL REGISTER



**Kangaroo**

ASCO GROUP LIMITED (BAHAMAS CORPORATION)  
3333 NEW HYDE PARK ROAD  
NEW HYDE PARK, NY 11042

OWNER OF BAHAMAS REG. NO. 16758, DATED 9-20-1994, EXPIRES 9-20-2008.

OWNER OF BAHAMAS REG. NO. 16757, DATED 9-27-1994, EXPIRES 9-27-2008.

OWNER OF BAHAMAS REG. NO. 16756, DATED 9-20-1994, EXPIRES 9-20-2008.

OWNER OF BAHAMAS REG. NO. 16755, DATED 9-20-1994, EXPIRES 9-20-2008.

OWNER OF U.S. REG. NOS. 1,220,046, 1,323,336 AND OTHERS.

FOR: BAGS, NAMELY, ALL PURPOSE SPORTS BAGS, HANDBAGS, PURSES, RUCKSACKS, SATCHELS, TRAVELING BAGS, DUFFEL BAGS, GARMENT BAGS FOR TRAVEL, BACKPACKS; BRIEFCASE TYPE PORTFOLIOS, ATTACHE CASES, WALLETS, BRIEFCASES, TRUNKS FOR TRAVELING, SUIT-

CASES; UMBRELLAS AND PARASOLS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FOR: FOOTWEAR, SHOES, SPORTS BOOTS, SPORTS SHOES; CLOTHING, NAMELY, HEADWEAR, HOSIERY, HATS, HEADBANDS, JACKETS, JERSEYS, JUMPERS, LEGGINGS, SHIRTS, SHORTS, SINGLETS, SKIRTS, SOCKS, SPORTS JERSEYS, SWEATERS, SWEAT SHIRTS, T-SHIRTS NOT IN THE NATURE OF UNDERWEAR, TROUSERS; AND WATER-PROOF CLOTHING, NAMELY, WATER PROOF JACKETS AND COATS; ATHLETIC WEAR, NAMELY, WARM UP SUITS, SWEAT SHIRTS AND SWEATPANTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FOR: TOYS, GAMES AND PLAYTHINGS, NAMELY, STUFFED TOYS; GYMNASTIC AND SPORTING ARTICLES, NAMELY, ELBOW GUARDS FOR ATHLETIC USE, KNEE GUARDS FOR ATHLETIC USE, SHIN GUARDS FOR ATHLETIC USE, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

SER. NO. 74-675,825, FILED 5-17-1995.

Int. Cl.: 25

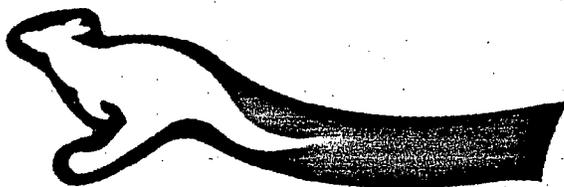
Prior U.S. Cl.: 39

Reg. No. 1,253,032

Registered Oct. 4, 1983

**United States Patent and Trademark Office**

**TRADEMARK**  
Principal Register



Envoys U.S.A., Inc. (Missouri corporation)  
48 Worthington Dr.  
Maryland Heights, Mo. 63043

For: SHOES, in CLASS 25 (U.S. Cl. 39).  
First use May 26, 1982; in commerce May 26,  
1982.

Ser. No. 373,723, filed Jul. 9, 1982.

CRAIG R. GILBERT, Examining Attorney

Int. Cl.: 25

Prior U.S. Cl.: 39

**United States Patent and Trademark Office**

Reg. No. 1,384,447

Registered Feb. 25, 1986

**TRADEMARK  
PRINCIPAL REGISTER**

**KangarooS**

KANGAROOS U.S.A., INC. (MISSOURI CORPORATION)  
48 WORTHINGTON DRIVE  
MARYLAND HEIGHTS, MO 63043

OWNER OF U.S. REG. NOS. 1,287,436, 1,342,852  
AND OTHERS.

SER. NO. 553,613, FILED 8-15-1985.

FOR: FOOTWEAR, IN CLASS 25 (U.S. CL. 39).  
FIRST USE 2-0-1980; IN COMMERCE  
2-0-1980.

STEWART J. BELLUS, EXAMINING ATTORNEY

EXHIBIT D