

ESTTA Tracking number: **ESTTA260237**

Filing date: **01/13/2009**

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	Asco Group Limited
Granted to Date of previous extension	01/14/2009
Address	Chancery House, The Mall Freeport, BAHAMAS

Attorney information	Brian R. McGinley Sonnenschein Nath & Rosenthal LLP P. O. Box 061080, Wacker Drive Station Chicago, IL 60606-1080 UNITED STATES ttab@sonnenschein.com, dsmisemer@sonnenschein.com, bmcginley@sonnenschein.com, dmarquis@sonnenschein.com, wprecht@sonnenschein.com Phone:816 460-2400
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Applicant Information

Application No	78845340	Publication date	09/16/2008
Opposition Filing Date	01/13/2009	Opposition Period Ends	01/14/2009
Applicant	GEORGE, LARA L. 6516 CALLANDER DRIVE BETHESDA, MD 20817 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, shirts, T-shirts, polo shirts, rugby shirts, pants, pant suits, caps, hats, shoes, socks, bathing suits, suits, dress shirts, sweat shirts, sweat pants, underwear, belts, hoods, jerseys, shifts, short sets, skirts and dresses, ties, tops and wraps, wrap-arounds, coats, dresses, gym suits, sweat shorts, knit shorts, dress suits

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3050911	Application Date	06/04/2003
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Registration Date	01/24/2006	Foreign Priority Date	12/06/2002
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 bags; namely, all purpose athletic bags, tote bags, rucksacks, and backpacks</p> <p>Class 025. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 footwear and clothing, namely headwear, shirts, and t-shirts, not in the nature of underwear</p>		

U.S. Registration No.	3112568	Application Date	06/04/2003
Registration Date	07/04/2006	Foreign Priority Date	12/06/2002
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 2006/01/01 First Use In Commerce: 2006/01/01 wallets, umbrellas, parasols, namely, all purpose handbags, purses, satchels, traveling bags, duffel bags, garment bags for travel, briefcase type portfolios, attache cases, briefcases, trunks for traveling, and suitcases</p> <p>Class 025. First use: First Use: 2006/01/01 First Use In Commerce: 2006/01/01 clothing, namely, headwear, hosiery, jackets, jerseys, jumpers, leggings, shorts; singlets, skirts, sports jerseys, sweaters, sweat shirts, not in the nature of underwear, and trousers; athletic wear, namely, golf shirts, jogging shirts, caps, warm up suits, and sweatpants</p>		

U.S. Registration No.	1354345	Application Date	12/24/1984
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Registration Date	08/13/1985	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1984/11/20 First Use In Commerce: 1984/11/20 CLOTHING, NAMELY, ATHLETIC SHOES, SHORTS, SHIRTS, JACKETS, PANTS, VESTS, TIGHTS, HOODED JACKET, SHIRT WITH HOOD, SWEATSHIRT WITH HOOD, WARMUP SUIT AND ALL WEATHER SUIT		

U.S. Registration No.	1269968	Application Date	09/29/1982
Registration Date	03/13/1984	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1982/07/29 First Use In Commerce: 1982/07/29 Shoes		

U.S. Registration No.	1272790	Application Date	09/25/1981
Registration Date	04/03/1984	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1981/08/19 First Use In Commerce: 1981/08/19 Shoes

U.S. Registration No.	1253032	Application Date	07/09/1982
Registration Date	10/04/1983	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1982/05/26 First Use In Commerce: 1982/05/26 Shoes		

Attachments	78975501#TMSN.gif (1 page)(bytes) 78258283#TMSN.gif (1 page)(bytes) 73514863#TMSN.gif (1 page)(bytes) 73393723#TMSN.gif (1 page)(bytes) 73329593#TMSN.gif (1 page)(bytes) 73373723#TMSN.gif (1 page)(bytes) LaraGeorgeNOO.pdf (8 pages)(30007 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/brmcginley/
Name	Brian R. McGinley
Date	01/13/2009

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

In the Matter of)	
Serial No. 78/845,340)	
ASCO GROUP LIMITED)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
LARA L. GEORGE)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer Asco Group Limited (“Asco”), a corporation organized under the laws of the Bahamas, having offices at Chancery House, The Mall, Freeport, Bahamas, believes that it will be damaged by the registration of U.S. Serial No. 78/845,340 and hereby opposes registration of the same under § 13 of the Lanham Act of 1946, 15 U.S.C. § 1063.

Applicant Lara L. George (“Applicant”) filed an intent-to-use application on March 24, 2006, U.S. Serial No. 77/159,456, for a trademark consisting of a stylized kangaroos design (“Applicant’s Trademark”) for “[c]lothing, namely, shirts, T-shirts, polo shirts, rugby shirts, pants, pant suits, caps, hats, shoes, socks, bathing suits, suits, dress shirts, sweat shirts, sweat pants, underwear, belts, hoods, jerseys, shifts, short sets, skirts and dresses, ties, tops and wraps, wrap-arounds, coats, dresses, gym suits, sweat shorts, knit shorts, dress suits” in Class 25 (“Application”).

The United States Patent & Trademark Office (“USPTO”) published the Application for opposition in the *Official Gazette* on September 15, 2008, allowing time to oppose the

Application up to and including October 15, 2008. On October 14, 2008, Asco filed a First 90 Day Request for Extension of Time to Oppose the Application until January 14, 2009. The Trademark Trial and Appeal Board (“TTAB”) granted Asco’s First Request. Accordingly, Asco has timely filed this Notice of Opposition.

Asco’s Well-Known and Famous Kangaroo Trademark

1. Asco is a well-known manufacturer of a wide range of clothing, footwear and personal accessories, among other things, all of which Asco distributes in the United States and around the world under its famous Kangaroo design trademark. (“Asco’s Kangaroo Trademark”). Specifically, Asco has registered and uses its famous Kangaroo Trademark in connection with numerous goods in International Classes 018 and 025, including, without limitation, headwear, hosiery, jackets, jerseys, jumpers, leggings, shorts, singlets, skirts, sports jerseys, sweaters, sweat shirts, athletic wear, golf shirts, jogging shirts, caps, warm up suits, sweatpants, shirts and t-shirts, footwear, wallets, umbrellas, parasols, all purpose handbags, purses, satchels, traveling bags, tote bags, rucksacks, backpacks, duffel bags, garment bags, briefcases, attaché cases, traveling trunks and suitcases (“Asco Goods”).

2. For more than 25 years, Asco has promoted and sold the Asco Goods in the United States under its well-known and famous Kangaroo Trademark. Asco has built a large and profitable business in the United States under the Kangaroo Trademark.

3. Asco owns several U.S. registrations for its well-known and famous Kangaroo Trademark for a wide variety clothing items, footwear, purses, bags and various other personal accessories. Asco’s registrations for its Kangaroo Trademark are identified below:

Kangaroo Trademark	Registration No.	Registration Date	Goods
	3,050,911	January 24, 2006	bags; namely, all purpose athletic bags, tote bags, rucksacks, and backpacks (Class 018); footwear and clothing, namely headwear, shirts, and t-shirts, not in the nature of underwear (Class 025)
	3,112,568	July 4, 2006	wallets, umbrellas, parasols, namely, all purpose handbags, purses, satchels, traveling bags, duffel bags, garment bags for travel, briefcase type portfolios, attache cases, briefcases, trunks for traveling, and suitcases (Class 018); clothing, namely, headwear, hosiery, jackets, jerseys, jumpers, leggings, shorts; singlets, skirts, sports jerseys, sweaters, sweat shirts, not in the nature of underwear, and trousers; athletic wear, namely, golf shirts, jogging shirts, caps, warm up suits, and sweatpants (Class 025)
	1,354,345	August 13, 1985	Clothing, namely, athletic shoes, shorts, shirts, jackets, pants, vests, tights, hooded jacket, shirt with hood, sweatshirt with hood, warmup suit, and all weather suit (Class 025)

	1,269,968	March 13, 1984	Shoes
	1,253,032	October 4, 1983	Shoes
	1,272,790	April 3, 1984	Shoes

4. Beginning at least as early 1981, Asco has used its Kangaroo Trademark in United States interstate commerce on and in connection with shoes. Since at least as early as 1984, Asco also has used the Kangaroo Trademark on an in connection with a vast array of clothing items and personal accessories, such as handbags, briefcases, suitcases and umbrellas. By virtue of Asco's extensive and continuous usage, coupled with substantial sales in interstate commerce and significant promotional and advertising activities, Asco has achieved widespread recognition with the relevant trade and public of its Kangaroo Trademark for the Asco Goods, creating a substantial and valuable goodwill among the relevant trade and public with respect to the Kangaroo Trademark.

5. Asco began using the Kangaroo Trademark in United States interstate commerce in 1981 and first obtained registration in the United States in 1984. Such use and registration clearly predates the filing date of the Application, March 12, 2006. Accordingly, priority is not an issue in this proceeding.

COUNT I:

LIKELIHOOD OF CONFUSION

6. Applicant's intended or actual use of Applicant's Trademark for clothing items so resembles Asco's Kangaroo Trademark as to be likely to create confusion, mistake, or deception under § 2 of the Lanham Act, 15 U.S.C. § 1052(d).

7. Applicant's Trademark is nearly identical to Asco's well-known and famous Kangaroo Trademark. Consumers encountering such a similar kangaroo design trademark in connection with Applicant's clothing will reasonably believe that such clothing items are offered or otherwise sponsored or endorsed by Asco.

8. Moreover, Applicant's clothing items are identical to, and therefore directly competitive with, Asco's clothing items sold under its Kangaroo Trademark.

9. Applicant's clothing items can or could be purchased by the very same class of purchasers and are or may be sold in the same trade channels as the clothing items offered by Asco under its under its Kangaroo Trademark.

10. As the Application has no limitation on trade channels, Applicant's goods are presumed to move through all of the ordinary and usual channels of trade for such clothing merchandise, further exacerbating the likelihood of confusion between Applicant's Trademark and Asco's Kangaroo Trademark.

11. Asco has established considerable goodwill in connection with its Kangaroo Trademark. Having established such goodwill, Asco is entitled to protection against use of confusingly similar marks.

12. If Applicant's Trademark is allowed to register, purchasers are likely to believe that Applicant's Trademark and the clothing items offered thereunder originated with or are connected or associated with, or sponsored, licensed, endorsed or approved by Asco, all to Asco's detriment. Undoubtedly, registration of Applicant's Trademark will allow Applicant to wrongfully appropriate Asco's valuable goodwill and reputation associated with its Kangaroo Trademark.

COUNT II:

DILUTION

13. Asco repeats and realleges the allegations contained in Paragraphs 1 through 12 as though set forth fully herein.

14. Asco's Kangaroo Trademark is famous under the Lanham Act.

15. The Application to register Applicant's Mark was filed after Asco's Kangaroo Trademark became famous.

16. Registration of Applicant's Trademark would likely dilute the distinctive quality of the Kangaroo Trademark because the registration of Applicant's Trademark would lessen the capacity of Asco's Kangaroo Trademark to identify and distinguish goods and services offered exclusively by Asco.

17. Registration of Applicant's Trademark is likely to dilute Asco's Kangaroo Trademark in violation of Section 2(f) of the Lanham Act, 15 U.S.C. §1052(f).

18. As a consequence of all of the foregoing, Asco is likely to be harmed by registration of Applicant's Trademark.

WHEREFORE, Asco believes that as a result of the likelihood of confusion with and likelihood of dilution caused by Applicant's Trademark, Asco will be damaged by the registration of Applicant's Trademark and prays that the Board sustain this Notice of Opposition and refuse to register Serial No. 78/845,340.

Asco Group Ltd. hereby appoints Brian R. McGinley, Dianne M. Smith-Misemer and Sonnenschein Nath & Rosenthal, P.O. Box #061080, Wacker Drive Station, Sears Tower, Chicago, IL 60606-1080, as its representative upon whom notices and process in proceedings affecting this proceeding may be served.

Respectfully submitted,

Asco Group Ltd.

Dated: January 13, 2009

By: /s/ Dianne M. Smith-Misemer
Brian R. McGinley
Dianne M. Smith-Misemer
Attorney for Asco Group Ltd.
SONNENSCHN NATH & ROSENTHAL LLP
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CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing NOTICE OF OPPOSITION to be served upon:

Lara L. George
6516 Callander Drive
Bethesda, MD 28017

Richard C. Litman
Litman Law Offices, LTD.
Crystal City Station
P.O. Box 15035
Arlington, VA 22215

by placing same in an envelope, properly sealed and addressed, with postage prepaid and depositing same with the United States Postal Service on this 13th day of January, 2009.

/dsmisemer/
Dianne M. Smith-Misemer

Filed with the TTAB via
ESSTA on January 13, 2009