

ESTTA Tracking number: **ESTTA387326**

Filing date: **01/07/2011**

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	The Timberland Company
Granted to Date of previous extension	01/08/2011
Address	200 Domain Drive Stratham, NH 03885 UNITED STATES

Attorney information	Larry C. Jones Alston & Bird LLP 101 S. Tryon Street Suite 4000 Charlotte, NC 28280-4000 UNITED STATES Larry.Jones@Alston.com Phone:704.444.1019
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**Applicant Information**

Application No	77913710	Publication date	11/09/2010
Opposition Filing Date	01/07/2011	Opposition Period Ends	01/08/2011
Applicant	THE TIANBOOLUN (US) LLC. 113 Barksdale Professional Center Newark City County of New Castle, DE 19711 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 018. First Use: 2009/02/16 First Use In Commerce: 2009/02/16 All goods and services in the class are opposed, namely: Backpacks; Briefcases; Handbags; Imitation leather; Purses; School bags; Sports bags; Traveling bags; Valises; Wallets
Class 025. First Use: 2009/03/17 First Use In Commerce: 2009/03/17 All goods and services in the class are opposed, namely: Bathing suits; Belts; Caps; Down jackets; Football shoes; Gloves; Gym suits; Hats; Hosiery; Jackets; Layettes; Leisure suits; Neckties; Overcoats; Shirts; Shoes; Trousers

**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.	1523598	Application Date	04/12/1988
Registration Date	02/07/1989	Foreign Priority	NONE

		Date	
Word Mark	TIMBERLAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1973/10/00 First Use In Commerce: 1973/10/00 CLOTHING, namely, COATS, JACKETS, RAINWEAR, SWEATERS, SHIRTS, PANTS, CAPS, HATS, GLOVES, SCARFS, BELTS, T-SHIRTS AND VESTS		

U.S. Registration No.	2932268	Application Date	03/11/2002
Registration Date	03/15/2005	Foreign Priority Date	NONE
Word Mark	TIMBERLAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1973/10/00 First Use In Commerce: 1973/10/00 Footwear; clothing, namely coats, jackets, rainwear, sweaters, shirts, pants, shorts, headwear, gloves, neckwear, belts, sweatshirts, t-shirts, vests, socks		

U.S. Registration No.	1552963	Application Date	04/12/1988
Registration Date	08/22/1989	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1973/10/00 First Use In Commerce: 1973/10/00		

	CLOTHING, NAMELY COATS, JACKETS, RAINWEAR, SWEATERS, SHIRTS, PANTS, CAPS, HATS, GLOVES, SCARFS, BELTS, T-SHIRTS AND VESTS
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U.S. Registration No.	2947228	Application Date	03/11/2002
Registration Date	05/10/2005	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1973/10/00 First Use In Commerce: 1973/10/00 Footwear; clothing, namely coats, jackets, rainwear, sweaters, shirts, pants, shorts, headwear, gloves, neckwear, belts, sweatshirts, t-shirts, vests, socks		

U.S. Registration No.	3235977	Application Date	07/11/2005
Registration Date	05/01/2007	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 2004/08/31 First Use In Commerce: 2004/08/31 Metal fuel bottles, sold empty; metal key fobs</p> <p>Class 018. First use: First Use: 1987/09/30 First Use In Commerce: 1987/09/30 Umbrellas; wallets; duffle bags; backpacks; daypacks; waist packs; briefcases; luggage; cosmetic cases, sold empty; handbags; textile shopping bags; coin purses; messenger bags; tote bags; and gym bags</p> <p>Class 021. First use: First Use: 2004/08/31 First Use In Commerce: 2004/08/31 Beverageware; vacuum bottles; plastic water bottles, sold empty; brushes for suede; brushes for footwear</p>		

	Class 024. First use: First Use: 2001/08/31 First Use In Commerce: 2001/08/31 Bed blankets; blanket throws; blankets for outdoor use
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U.S. Registration No.	1502205	Application Date	12/18/1987
Registration Date	08/30/1988	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1987/09/00 First Use In Commerce: 1987/09/00 LEATHER GOODS, NAMELY, [KEY FOBS, LUGGAGE TAGS,] CREDIT CARD CASES, WALLETS, PORTFOLIO TYPE BRIEFCASES, DUFFLE BAGS, BACKPACKS AND BRIEFCASES		

U.S. Registration No.	1355531	Application Date	11/14/1984
Registration Date	08/20/1985	Foreign Priority Date	NONE
Word Mark	TIMBERLAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1973/10/00 First Use In Commerce: 1973/10/00 CLOTHING, NAMELY FOOTWEAR, SHIRTS, JACKETS, COATS, SWEATSHIRTS, T-SHIRTS, JERSEYS, SWEATERS, VESTS, BELTS AND HATS		

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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	/Larry C. Jones/
Name	Larry C. Jones
Date	01/07/2011

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

In the matter of Trademark Application  
Serial No. 77/913,710  
Filed: January 17, 2010  
Trademark: TIANBOOLUN (Stylized) & Tree Design  
Published: November 9, 2010

-----X	)	
The Timberland Company,	)	
	)	
Opposer	)	
	)	Opposition No. _____
v.	)	
	)	
The Tianboolun (US) LLC,	)	
	)	
Applicant.	)	
-----X	)	

**NOTICE OF OPPOSITION**

The Timberland Company, a Delaware corporation with its principal place of business at 200 Domain Drive, Stratham, New Hampshire 03885, believes that it will be damaged by the registration of the mark shown in Application Serial No. 77/913,710, filed January 17, 2010, by The Tianboolun (US) LLC, a Delaware limited liability company having a mailing address of 113 Barksdale Professional Center, Newark, DE 19711 ("Applicant"), and hereby opposes the registration of said mark.

As grounds of opposition, it is alleged that:

**THE TIMBERLAND MARK**

1. Since long prior to January 17, 2010, the filing date of the subject application, or Applicant's claimed dates of first use of the subject mark Applicant (i.e., February 16, 2009 (Class 18 goods) and March 17, 2009 (Class 25 goods)), Opposer has used continuously the

TIMBERLAND mark and variations of that mark on or in connection with various goods and services in the United States. Among those goods sold by Opposer in the United States under the TIMBERLAND mark are a variety of clothing goods, as well as backpacks, briefcases, and other leather and imitation leather bags and goods. The availability of such products and services under the TIMBERLAND mark has been advertised to the public at considerable expense.

2. By reason of the adoption and continuous use of the TIMBERLAND mark, that designation has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying Opposer and its goods and services. Opposer's TIMBERLAND mark has become famous and distinctive through, *inter alia*, Opposer's extensive use, advertising and promotion of that mark throughout the United States, over a substantial period of time, for a variety of goods, including clothing goods, backpacks, briefcases, and other leather and imitation leather bags and goods.

3. Consequently, through such usage and recognition, Opposer has acquired common-law rights in the TIMBERLAND designation as a proprietary trademark, which rights extend, without limitation, to the exclusive right to use such designation nationwide in conjunction with Opposer's goods and services, including, without limitation, clothing goods, backpacks, briefcases, and other leather and imitation leather bags and goods.

4. Opposer is also the owner of several U.S. registrations for the TIMBERLAND mark, including, without limitation, the following registrations pertaining to clothing goods in Class 25: (i) Registration No. 1,523,598 for TIMBERLAND (Stylized); and (ii) Registration No. 2,932,268 for TIMBERLAND. (The registrations listed in this paragraph shall be identified as "Opposer's TIMBERLAND Registrations"). The stylized version of Opposer's TIMBERLAND mark made the subject of Registration No. 1,523,598 is shown below:

# Timberland

5. Opposer's TIMBERLAND Registrations are valid, subsisting, and in full force and effect. Moreover, Opposer's Registration No. 1,523,598 for its TIMBERLAND (Stylized) clothing mark is incontestable, and, as such, serves as conclusive evidence of Opposer's exclusive rights to use the TIMBERLAND (Stylized) mark on the clothing goods listed in said registration.

## THE TIMBERLAND TREE DESIGN MARK

6. Further, since long prior to January 17, 2010, the filing date of the subject application, or the claimed dates of first use of the subject mark by Applicant, Opposer has used continuously the mark shown below (the "Timberland Tree Design Mark") and variations of that mark on or in connection with various goods and services in the United States.



7. Among those goods sold by Opposer in the United States under the Timberland Tree Design Mark are footwear, headwear, gloves, and a broad array of other clothing goods, as well as backpacks, briefcases, and other leather and imitation leather bags and goods. Since 1973, Opposer has used its Timberland Tree Design Mark on such goods, and the availability of those products under the Timberland Tree Design Mark has been advertised to the public at considerable expense.

8. By reason of the adoption and the longstanding and continuous use of the Timberland Tree Design Mark, that designation has a distinctive quality and has acquired special

and particular significance and very valuable goodwill as identifying Opposer and its footwear, headwear, gloves, other clothing goods, backpacks, briefcases, other leather and imitation leather bags, and other related goods. Opposer's Timberland Tree Design Mark has become famous and distinctive for such goods.

9. Consequently, through such usage and recognition, Opposer has acquired common-law rights in the Timberland Tree Design Mark as a proprietary trademark, which rights extend, without limitation, to the exclusive right to use such designation nationwide in conjunction with Opposer's goods and services, including, without limitation, footwear, headwear, gloves, other clothing goods, backpacks, briefcases, other leather and imitation leather bags, and other related goods.

10. Opposer is also the owner of several U.S. registrations for the Timberland Tree Design Mark, including, without limitation, the following registrations: (i) Registration No. 1,552,963 for use on clothing, namely coats, jackets, rainwear, sweaters, shirts, pants, caps, hats, gloves, scarfs, belts, t-shirts and vests; (ii) Registration No. 2,947,228 for use on: footwear; clothing, namely coats, jackets, rainwear, sweaters, shirts, pants, shorts, headwear, gloves, neckwear, belts, sweatshirts, t-shirts, vests, socks; (iii) Registration No. 1,502,205 for use on, *inter alia*: leather goods, namely, wallets, duffle bags, backpacks and briefcases; (iv) Registration No. 3,235,977 for use on, *inter alia*, luggage, handbags, tote bags and gym bags. (The registrations listed in this paragraph shall be identified as "Opposer's Timberland Tree Design Mark Registrations").

11. Opposer's Timberland Tree Design Mark Registrations are valid, subsisting, and in full force and effect. Moreover, Opposer's Registration Nos. 1,502,205 and 1,552,963 for its Timberland Tree Design Mark are incontestable and, as such, serve as conclusive evidence of

Opposer's exclusive right to use the Timberland Tree Design Mark on the goods listed in said registrations.

**THE COMPOSITE TIMBERLAND & TREE LOGO MARK**

12. Still further, since long prior to January 17, 2010, the filing date of the subject application, or the claimed dates of first use of the subject mark by Applicant, Opposer has continuously used the composite mark shown below (the "TIMBERLAND & Tree Logo Mark") on and in conjunction with various goods and services in the United States.



13. Among those goods sold by Opposer in the United States under the composite TIMBERLAND & Tree & Logo Mark are footwear, headwear, gloves, and a broad array of other clothing goods. Since 1973, Opposer has used its composite TIMBERLAND & Tree Logo Mark on such goods, and the availability of those products under the TIMBERLAND & Tree Logo Mark has been advertised to the public at considerable expense.

14. By reason of the adoption and the longstanding and continuous use of the TIMBERLAND & Tree Logo Mark, that designation has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying Opposer and its footwear, headwear, gloves, other clothing goods, and other related goods. Opposer's TIMBERLAND & Tree Logo Mark has become famous and distinctive for such goods.

15. Consequently, through such usage and recognition, Opposer has acquired common-law rights in the composite TIMBERLAND & Tree Logo Mark as a proprietary trademark, which rights extend, without limitation, to the exclusive right to use such designation

nationwide in conjunction with Opposer's goods and services, including, without limitation, footwear, headwear, gloves, and other clothing goods.

16. Opposer is also the owner of an incontestable U.S. registration for the composite TIMBERLAND & Tree Logo mark, Registration No. 1,355,531 for use on clothing, namely footwear, shirts, jackets, coats, sweatshirts, t-shirts, jerseys, sweaters, vests, belts and hats.

**THE OPPOSED APPLICATION AND MARK**

17. On January 17, 2010, Applicant filed the application at issue to register the composite mark TIANBOOLUN (Stylized) & Tree Design ("Applicant's Mark") for use on certain goods in Classes 18 and 25, namely:

Class 18: Backpacks; briefcases; handbags; imitation leather; purses; school bags; sports bags; traveling bags; valises; wallets

Class 25: Bathing suits; belts; caps; down jackets; football shoes; gloves; gym suits; hats; hosiery; jackets; layettes; leisure suits; neckties; overcoats; shirts; shoes; trousers

18. The composite TIANBOOLUN (Stylized) & Tree Design Mark made the subject of this Notice of Opposition is shown below:



19. Applicant's Mark consists of two components, one of which is the term "TIANBOOLUN." The term TIANBOOLUN is visually and aurally similar to Opposer's TIMBERLAND mark. These characteristics create a likelihood of confusion. Further, the other component of Applicant's composite mark is an encircled tree design, such that it is similar to

the Timberland Tree Design Mark, thus enhancing the likelihood of confusion. Still further, and as reflected above, the combination of the two components into Applicant's composite mark mimics Opposer's composite TIMBERLAND & Tree Logo Mark, further enhancing the likelihood of confusion. Moreover, the goods listed in Applicant's application are, in some instances, the same as, and, in other instances, substantially related to, the goods on which Opposer has used and registered its TIMBERLAND mark, its Timberland Tree Design Mark, and its composite TIMBERLAND & Tree Logo Mark. Thus, Applicant's TIANBOOLUN (Stylized) & Tree Design mark, when used on or in connection with the goods listed in the application at issue, is likely to deceive or cause confusion or mistake as to the source or sponsorship of Applicant's goods in relation to Opposer.

#### SUMMARY

20. Applicant's application for registration should be refused on the basis that it consists of or comprises, according to 15 U.S.C. § 1052(d):

A mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion or to cause mistake, or to deceive.

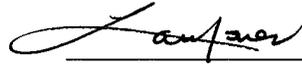
21. Accordingly, Opposer asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for the TIANBOOLUN (Stylized) & Tree Design mark to Applicant as sought in Trademark Application Serial No. 77/913,710.

WHEREFORE, Opposer, The Timberland Company, prays that the application for registration of Applicant's Mark be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Please charge all fees incurred by Opposer in conjunction with this proceeding to the firm's Deposit Account No. 16-0605.

Date: January 7, 2011

Respectfully submitted,



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Larry C. Jones  
Jason M. Sneed  
Attorneys for Opposer

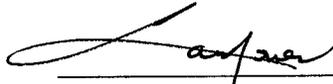
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[Jason.Sneed@alston.com](mailto:Jason.Sneed@alston.com)

CERTIFICATE OF SERVICE

I hereby certify that copies of the foregoing "Notice of Opposition" were duly served on Applicant by depositing copies of same in the United States mail, first-class postage prepaid, on the 7th day of January, 2011, addressed to Applicant as follows:

Zhang Honglu  
1461A First Ave. #360  
New York, NY 10021

The Tianboolun (US) LLC  
113 Barksdale Professional Center  
Newark, DE 19711



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Larry C. Jones