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

Proceeding	91202382
Party	Plaintiff Tibi, LLC
Correspondence Address	GORDON E R TROY ESQ GORDON E R TROY PC PO BOX 368 Charlotte, VT 05445 UNITED STATES gtroy@webtm.com
Submission	Motion to Amend Pleading/Amended Pleading
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Date	05/04/2012
Attachments	Motion.pdf (3 pages)(14096 bytes) Amended Opp.pdf (5 pages)(18907 bytes)

**United States Patent and Trademark Office
Trademark Trial and Appeal Board**

In re Trademark Application

Trademark: TYBIDIOT
Serial No. 85082909
Published: July 5, 2011

Tibi, LLC,

Opposer,

- v -

Jenny Orr by assignment from John Branigin,

Applicant.

Opposition No. 91202382

**Opposer’s Motion for Leave To
Amend Notice of Opposition**

Opposer Tibi, LLC (“Opposer”), by its attorney, hereby moves, pursuant to Trademark Rule 2.107, for leave to amend its Notice of Opposition to add two additional grounds for opposition to the application of Jenny Orr by assignment from John Branigin (“Applicant”) for the proposed “TYBIDIOT” mark. Specifically, Opposer has added as bases on which to oppose Applicant’s application, (a) dilution by tarnishment of Opposer’s mark, and (b) the fact that Applicant’s proposed mark does not function as a trademark but is merely ornamental or decorative in nature.

Pursuant to Trademark Rule 2.107, “Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court...” Rule 15 of the Federal Rules of Civil Procedure provides that a party may amend a pleading once as a matter of course at any time before a responsive pleading is served. Since no

responsive pleading has yet been served by Applicant, Opposer serves its Amended
Notice of Opposition as of right.

Dated: May 4, 2012

Respectfully submitted:
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Certificate of Service

The undersigned hereby certifies that a copy of the forgoing Motion for Leave to Amend Notice of Opposition, together with the Amended Notice of Opposition have been served upon Applicant's counsel electronically by email to the following address:

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on: May 4, 2012

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Amended Notice of Opposition

Tibi, LLC, a limited liability company organized and existing under the laws of the State of Delaware, with its principal place of business at 666 Broadway, 10th Floor, New York, New York 10012 (“Opposer”), believes that it will be damaged by registration of the mark shown in application Serial No. 85082909, and pursuant to 37 C.F.R. § 2.101(b), 15 U.S.C. § 1052(d), C.F.R. § 2.107 and Rule 15(a) of the Federal Rule of Civil Procedure, hereby files its Amended Notice of Opposition and opposes said registration.

The grounds for the opposition are as follows:

1. Opposer is the owner of incontestable U.S. Registration Nos. 2399688 and 2446419 for TIBI, covering “Clothing for women, namely sweaters, tops, shirts, blouses, skirts, dresses, pants and shorts, bathing suits, shoes, underwear, and hats” and “Clothing for men, women and children, namely sweaters, tops, shirts, t-shirts, jackets, jeans, vests, scarves, blouses, skirts, dresses, pants and shorts, bathing suits, shoes, underwear, hats, bathrobes, loungewear, sleepwear, brassieres, bustiers, camisoles, chemises, corselettes,

corsets, foundation garments, dressing gowns, dusters, garter belts, girdles, housecoats, lingerie, negligees, night gowns, night shirts, pajamas, peignoirs, robes, underclothes, undergarments, underpants, undershirts, underwear, sweat shirts, sweat pants, socks, head bands” in Class 25. Opposer has used its TIBI mark in commerce throughout the United States since at least as early as August 1, 1997 and has claimed a priority date of August 1, 1997 in its registrations. Opposer is the owner of additional trademark registrations.

2. Opposer maintains premises within the State of Georgia and conducts a substantial part of its operations through such offices.

3. Opposer has invested substantial sums over the years in creating good will for its TIBI mark and it operates a significant nationwide, as well as international, business with market channels that reach millions of potential customers for Opposer’s products. Opposer continues to expend substantial investments in developing and promoting its TIBI mark.

4. Notwithstanding Opposer’s rights to its TIBI mark discussed herein, on July 12, 2010, Applicant filed an application to register the mark TYBIDIOT as shown in application Serial No. 85082909, covering “Bathing suits; Hats; Shorts; Sweat pants; Sweat shirts; T-shirts; Tank tops; Visors” in Class 25.

5. Applicant’s address is indicated to be situated in the State of Georgia.

6. On August 9, 2010, an Amendment to Use was filed claiming dates of first use of July 31, 2010.

7. Clearly the goods recited in application Serial No. 85082909 are not only identical to the goods used by Opposer, they are the goods that are registered by Opposer,

and are without question the same type of products and are necessarily by their very nature competitive with each other.

8. By virtue of Opposer's registration of its TIBI mark with a priority date of August 1, 1997, Opposer has priority over Applicant's constructive priority date of July 12, 2010 for the Application opposed herein. There is a strong likelihood of confusion in the present circumstances for the reasons set forth herein.

9. Opposer's mark is TIBI, while Applicant's mark is TYBIDIOT. The two marks would appear to consumers and potential consumers to be related, sponsored by, or otherwise authorized when in fact no such relationship exists.

10. Applicant is trading upon the sound, meaning, and appearance of Opposer's well-known mark TIBI.

11. The marks are confusingly similar to lead a consumer to believe that the source of the goods is the same entity, or if not the same entity, then such consumers would likely believe that Applicant is seeking to trade upon the good will established by Opposer by disparaging Opposer and its products through such false association.

12. The Application opposed herein was published for opposition on July 5, 2011. Opposer obtained an extension to file its Opposition through November 2, 2011. Accordingly, this Notice of Opposition is timely.

13. There is a strong likelihood of confusion between Opposer's mark and Applicant's mark.

14. Should Applicant be permitted to register its mark, it will interfere with Opposer's continuing use and registration of its mark, Opposer's present and future business in its products, as well as Opposer's planned natural business extensions of its

product line. Opposer is and will be damaged by the use and registration of the mark opposed herein.

15. In view of the strength of Opposer's mark, its widespread use and degree of recognition among the consuming public and the trade, and the duration and extent of Opposer's use and advertising of its mark, its mark has become famous. The consuming public recognizes Opposer's mark as a famous mark and associates TIBI with Opposer.

16. Opposer's mark was famous prior to the filing date of Applicant's application to register the mark TYBIDIOT.

17. Applicant's mark and application are likely to cause, and will cause, dilution of the distinctive value of Opposer's mark as described in § 43(c) of the Lanham Act, as amended, 15 U.S.C. § 1125(c).

18. Applicant's mark does not function as a trademark as required by §§ 1, 2 and 45 of the Lanham Act, as amended, 15 U.S.C. §§ 1051, 1052 and 1127, in that TYBIDIOT is a decorative or ornamental feature on Applicant's goods and does not identify and distinguish Applicant's goods. Consequently, registration of Applicant's mark should be denied.

WHEREFORE, Opposer respectfully requests, pursuant to 37 C.F.R. § 2.101(b) and 15 U.S.C. § 1052(d), that the mark TYBIDIOT, application Serial No. 85082909, be denied registration on the grounds of confusing similarity with Opposer's TIBI mark, dilution of Opposer's famous TIBI mark, the failure of Applicant's mark to function as a trademark, and as otherwise pleaded herein.

Dated: May 4, 2012

Respectfully submitted:
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