

ESTTA Tracking number: **ESTTA560019**

Filing date: **09/18/2013**

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	AIRLIE CREATIONS, LLC
Granted to Date of previous extension	09/18/2013
Address	600 HOPSCOTCH CT WILMINGTON, NC 28411 UNITED STATES

Attorney information	Thomas G. Varnum Brooks, Pierce, McLendon, Humphrey & Leonard, LLP 1213 Culbreth Drive Wilmington, NC 28405 UNITED STATES tvarnum@brookspierce.com Phone:3362713161
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Applicant Information

Application No	85802212	Publication date	05/21/2013
Opposition Filing Date	09/18/2013	Opposition Period Ends	09/18/2013
Applicant	The Home T., LLC 3489 ELMWOOD AVE ROCHESTER, NY 14610 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: T-shirts and sweatshirts; baby clothing, namely, one piece garments for infants and toddlers
Class 035. All goods and services in the class are opposed, namely: on-line retail store services featuring clothing

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Mere ornamentation; failure to function as a mark.

Mark Cited by Opposer as Basis for Opposition

U.S. Application/	NONE	Application Date	NONE
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Registration No.			
Registration Date	NONE		
Word Mark	The word "home." within an image of the state of Colorado.		
Goods/Services	Tee shirts and other clothing items, as well as vinyl sticker goods.		

Related Proceedings	Proceeding No. 91212463, Filed on 9-13-13 by Zeke Vantreese.
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Attachments	The Home T. Notice of Opposition - FINAL.pdf(168409 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	/Thomas G. Varnum/
Name	Thomas G. Varnum
Date	09/18/2013

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

In re Trademark Application Serial No. 85802212
For the Mark: HOME.
Filed: December 13, 2012
Published for Opposition: May 21, 2013

AIRLIE CREATIONS, LLC,

Opposer,

v.

THE HOME T., LLC,

Applicant.

Opposition No. _____

Commissioner for Trademarks
Attn: Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
Transmitted via ESTTA

NOTICE OF OPPOSITION

Opposer Airlie Creations, LLC ("Opposer") hereby opposes registration of the word "home." depicted inside an image of the state of Colorado (the "Design"), as sought in Application Serial No. 85802212 (the "Application"), filed by The Home T., LLC ("Applicant") on December 13, 2012. Having been granted extensions of time to oppose the Application up to and including September 18, 2013, Opposer now opposes the Application, by and through undersigned counsel, pursuant to 15 U.S.C. § 1063, on grounds of prior use, likelihood of confusion, false suggestion of a connection, and mere ornamentation.

As set forth in more detail below, Opposer believes it will be damaged by the registration of the Design as a mark because the Design is identical, or at a minimum confusingly similar, to a "home." design Opposer used on t-shirts and other items well before: (i) the filing date of the intent-

to-use Application, (ii) Applicant's first use of the Design *in commerce*, and (iii) Applicant's first use of the Design *anywhere*. Further, Applicant does not use the Design as a source-identifying mark—rather, Applicant uses the Design merely as an ornamental design in a series of other similar t-shirt designs. Upon information and belief, Applicant tried and failed to register the applied-for mark (along with similar marks for each of the 50 states) as a design with the U.S. Copyright Office, but such registration was rejected. Now, as an end-run around copyright law's protection of the public domain, Applicant is seeking trademark registration to manufacture exclusive rights to an ornamental design Applicant did not create.

As more specific grounds for opposition, Opposer alleges and says the following:

1. Opposer is a North Carolina limited liability company with a principal place of business in Wilmington, North Carolina.
2. The Application recites that the Applicant is The Home T., LLC, a New York limited liability company with an address in Rochester, New York.

**OPPOSER'S PRIOR USE, LIKELIHOOD OF CONFUSION,
AND FALSE SUGGESTION OF A CONNECTION
Sections 2(a) and 2(d) of the Lanham Act**

3. The allegations of all preceding paragraphs are re-alleged and incorporated herein by reference.
4. Even were Applicant to use the Design in a source-identifying manner (such is not the case—*see infra*), Opposer will be damaged by the registration because Opposer began using the Design (or, at least, a design confusingly similar thereto) in commerce well before Applicant applied to register the Design or began using the Design.
5. Applicant filed the intent-to-use Application challenged herein on December 13, 2012, seeking registration the Design as a mark in connection with t-shirts and other clothing items in Class 025, and on-line retail store services featuring clothing in Class 035.

6. The Design is phonetically, aesthetically, and visually identical to and/or confusingly similar to a design (used in connection with t-shirts, and other clothing and non-clothing items) that Opposer marketed, sold, and distributed in commerce throughout the entire United States prior to the filing date of the Application or Applicant's first use of the Design.
7. Upon information and belief, Opposer's customers have actually been, and will continue to be, deceived as to the origin of Applicant's clothing and online retail store as a result of Applicant's junior use of the Design.
8. Opposer used a design identical to the Design and otherwise had rights in the Design prior to the filing date of the Application.
9. Opposer used a design identical to the Design and otherwise had rights in the Design prior Applicant's first use of the Design, both in commerce or anywhere.
10. As an example, Opposer began actively marketing, distributing, and selling vinyl decals with a design identical to the Design on-line in international and interstate commerce by at least as early as June 2012.
11. As another example, Opposer began actively marketing, distributing, and selling t-shirts with a design identical to the Design on-line in international and interstate commerce by at least as early as September 2012.
12. There is no genuine question of priority in this proceeding. Opposer used a design identical to the Design for many months prior to Applicant's filing of its "intent-to-use" Application and prior to any actual use of the Design by Applicant.
13. Opposer's prior use of the Design extended throughout the entire United States and beyond.
14. Opposer has not granted Applicant any form of permission, authorization, or license in connection with the Design.

15. Opposer has built up valuable goodwill in its design—to which the Design is identical or confusingly similar—as a result of the extensive use, sale and promotion of its products and services offered in connection with that design.
16. Upon information and belief, prior to the filing of the Application, Applicant was aware of Opposer’s goods and services, including Opposer’s prior use of the Design on t-shirts and other clothing, and Applicant nevertheless opted to seek registration of the Design.
17. Among other factors, substantial similarities and overlaps exist between: (i) the Design and the identical design that Opposer previously used throughout the United States and has not abandoned; (ii) the products and services offered by Opposer and Applicant, respectively; and (iii) the respective trade channels of the parties’ goods and services.
18. The Design so resembles Opposer’s prior design as to be likely, when used on or in connection with Applicant’s goods and services, as identified in the Application, to cause confusion, to cause mistake, and/or to deceive. Additionally, any future use of the Design as Applicant describes in the Application would falsely suggest a connection between Applicant and Opposer.
19. The Design is therefore unregistrable under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). The Application should also be denied due to violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

MERELY ORNAMENTATION
Sections 1, 2 and 45 of the Lanham Act
(in the alternative)

20. The allegations of all preceding paragraphs are re-alleged and incorporated herein by reference.
21. Upon information and belief, Applicant’s intended use of the Design (consistent with Applicant’s use of the Design subsequent to the filing of the Application) is merely as a decorative or ornamental feature of the Applicant’s clothing and does not function as a

mark used to identify and distinguish applicant's clothing or services from those of others, or to indicate the source of the clothing and services.

22. Accordingly, the Application should be denied registration under Sections 1, 2 and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052 & 1127.
23. Upon information and belief, Applicant's intended use of the Design will fail to function as a mark and/or be ornamental due to Applicant's intention to use it prominently on the clothing as ornamentation rather than as a mark or indicia of source
24. The Design ("home." written inside the boundary of Colorado) is merely one of 50 decorative and ornamental designs offered by the Applicant and is not used to identify the Applicant as the source of the clothing.
25. The Design is located in large format, centered, and on the upper half of the clothing in a position and manner not typically perceived by consumers as trademark use.
26. Upon information and belief, Applicant instead attempts to use the term "The Home T." (which Applicant also seeks to register with the USPTO for the same goods and services) to identify the source of clothing and services offered by Applicant. For example, "The Home T." is placed in small font underneath the word "Home." in Applicant's designs, and in a position and manner typically perceived by consumers as an identification of source.
27. Applicant markets, offers for sale, and distributes clothing including the Design and similarly decorative designs for each of the 50 states of the United States, which include the outline of each state with the word "home." written inside, all in a common and unoriginal font.
28. As Opposer is informed and believes, in or about October, 2012, Applicant applied for federal copyright registration of the Design, along with an entire series of similar designs including the outline of each of the 50 states with the word "home." written inside, in a common and unoriginal font.

29. As Opposer is further informed and believes, the United States Copyright Office denied the Applicant's attempted registration stating that it did not satisfy the authorship and originality requirements for registration (*i.e.* the designs were geographic areas with a commonly used word written in a commonly used font, and therefore others must remain free to copy the design).
30. In turn, by falsely representing that his use of the Design will be as a source-identifying mark, the Applicant now attempts to secure trademark registration of this ornamental Design, all to circumvent Copyright law, which will not protect this unoriginal and now fairly common Design.
31. Opposer believes it will be damaged if the Mark is registered.
32. In light of this likelihood of confusion and false suggestion of a connection, and due to Opposer's trademark priority, or for the alternate grounds of Applicant's merely ornamental use of the Design, the Application should be denied, registration should be refused, and the Design ought to be deemed unregistrable.

WHEREFORE, the Opposer believes it will be damaged if the Mark is registered and respectfully requests that this opposition be sustained, the Application be denied, registration of the Design be refused, and the Design be deemed unregistrable.

Please recognize as attorneys for the Opposer in this proceeding Thomas G. Varnum of the law firm Brooks, Pierce, McLendon, Humphrey & Leonard, L.L.P., 1213 Culbreth Drive, Wilmington, NC 28405. All correspondence and communications should be directed to Thomas G. Varnum at the address listed below.

Respectfully submitted, this the 18th day of September, 2013, by:

Opposer Airlie Creations, LLC, *by and through its attorney:*

/ Thomas G. Varnum /

Thomas G. Varnum

N.C. State Bar No. 38567

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on the Applicant by mailing said copy on this day, via First Class Mail, postage prepaid, and addressed to:

Stephen J. Huggins, Esq.
Dentons US LLP
P.O. BOX 061080 WACKER DRIVE STATION, WILLIS TOWER
CHICAGO, IL 60606-1080
Applicant attorney of record in the Office

This is the 18th day of September, 2013.

/ Thomas G. Varnum /

Thomas G. Varnum
N.C. State Bar No. 38567

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