

ESTTA Tracking number: **ESTTA588600**

Filing date: **02/21/2014**

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 | Marshall Amplification plc |
| Granted to Date of previous extension | 02/23/2014 |
| Address | Denbigh Road Bletchley, Milton Keynes Buckinghamshire, MK1 1DQ UNITED KINGDOM |

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| Attorney information | Heather J. Kliebenstein MERCHANT & GOULD PC 3200 IDS CENTER, 80 S 8TH STREET MINNEAPOLIS, MN 55402 UNITED STATES jclifford@merchantgould.com, aavery@merchantgould.com, dockmpls@merchantgould.com, aries@merchantgould.com, hkliiebenstein@merchantgould.com Phone:612.332.5300 |
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Applicant Information

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| Application No | 85904663 | Publication date | 08/27/2013 |
| Opposition Filing Date | 02/21/2014 | Opposition Period Ends | 02/23/2014 |
| Applicant | Kiaico, Inc. 445 Park Ave. New York, NY 10022 CANADA | | |

Goods/Services Affected by Opposition

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| Class 025. First Use: 1980/01/01 First Use In Commerce: 2013/03/01 All goods and services in the class are opposed, namely: Clothing, namely, shirts, T-shirts, sweatshirts, sweat pants, sweat suits, pants, skirts, shorts, sarongs, vests, boxershorts, underwear, jackets, coats, rainwear, pullovers, sweaters, jumpers, overalls, rompers, infant wear, socks, shoes, slippers, halloween and masquerade costumes, promotional mascot character costumes, sleep wear, robes, hats, caps, bandanas, headbands, gloves, mufflers, scarves, swim wear, beach cover ups |
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Grounds for Opposition

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| Deceptiveness | Trademark Act section 2(a) |
| False suggestion of a connection | Trademark Act section 2(a) |
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

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| U.S. Application No. | 86093877 | Application Date | 10/17/2013 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | M | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of "M" in a stylized format. | | |
| Goods/Services | Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, footwear, headgear; T-shirts, polo shirts, shirts, jogging pants, sweat pants, sweatshirts, hooded sweatshirts, hooded sweaters, tracksuits, fleeces, jackets, vests; jeans, trousers, sweaters, ties, baby romper suits; bibs; underwear; socks, boxer shorts, knickers; nightwear, pyjamas; bandanas; baseball caps, beanie hats; sports shoes, trainers, sneakers; sweat bands; leather wristbands; belts | | |
| U.S. Registration No. | 4303941 | Application Date | 02/02/2012 |
| Registration Date | 03/19/2013 | Foreign Priority Date | NONE |
| Word Mark | M | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of "M" Stylized. | | |
| Goods/Services | Class 009. First use: First Use: 0 First Use In Commerce: 0 Electrical and electronic audio apparatus, namely, sound amplifiers; valve and digital guitar amplifiers; sound reverberation units; sound mixing, processing and synthesizing apparatus; microphones, headphones; loudspeakers; horn-type speakers, loudspeaker cabinets; computer software for recording sound; computer software for use with any of the aforesaid goods; parts and fittings for | | |

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| | the aforesaid goods | | |
| U.S. Registration No. | 3247712 | Application Date | 10/13/2005 |
| Registration Date | 05/29/2007 | Foreign Priority Date | NONE |
| Word Mark | MARSHALL | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 0 First Use In Commerce: 0 Sound amplifiers; sound reverberation units; electric sound mixing, processing and synthesising apparatus; microphones, headphones; loudspeakers, horn-type speakers, loudspeaker cabinets; parts and fittings for the aforesaid goods; calculators; CD cases | | |
| U.S. Registration No. | 3940239 | Application Date | 06/11/2010 |
| Registration Date | 04/05/2011 | Foreign Priority Date | NONE |
| Word Mark | MARSHALL AMPLIFICATION | | |
| Design Mark |  | | |
| Description of Mark | The mark consists of "MARSHALL AMPLIFICATION" in a stylized format. | | |
| Goods/Services | Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, headwear and footwear, namely, T-shirts, polo shirts, shirts, jogging pants, sweat pants, sweatshirts, hooded sweatshirts, tracksuits, fleece tops and pullovers, jackets, vests; baseball caps, beanies; sports shoes, sneakers; sweat bands; belts | | |
| U.S. Registration No. | 936514 | Application Date | 09/17/1970 |
| Registration Date | 06/27/1972 | Foreign Priority Date | NONE |

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| Word Mark | MARSHALL |
| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | Class U021 (International Class 007, 009, 011, 012, 015). First use: First Use: 1962/07/00 First Use In Commerce: 1965/05/26 ELECTRONIC SOUND AMPLIFIERS, [MICROPHONES, HORN-TYPE SPEAKERS,] REVERBERATIONUNITS, [SOUND-MIXER UNITS,] AND SPEAKER CABINETS |

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| U.S. Registration No. | 880220 | Application Date | 06/14/1968 |
| Registration Date | 11/04/1969 | Foreign Priority Date | NONE |

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|---------------------|--|
| Word Mark | MARSHALL |
| Design Mark | MARSHALL |
| Description of Mark | NONE |
| Goods/Services | Class 009. First use: First Use: 1962/07/00 First Use In Commerce: 1965/05/26 ELECTRONIC SOUND AMPLIFIERS |

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| Related Proceedings | None |
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| Attachments | 86093877#TMSN.jpeg(bytes) 85532302#TMSN.jpeg(bytes) 79017061#TMSN.jpeg(bytes) 85060747#TMSN.jpeg(bytes) 72300466#TMSN.gif(bytes) 2014 02 21 Notice of Opposition.pdf(247122 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.

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| Signature | /Heather J. Kliebenstein/ |
| Name | Heather J. Kliebenstein |
| Date | 02/21/2014 |

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

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| _____ |) | |
| Marshall Amplification PLC, |) | |
| Opposer, |) | Opposition No. _____ |
| v. |) | |
| Kiaico, Inc. |) | Serial Nos.: 85/904,663 |
| Applicant. |) | Mark: MARSHAL A.R.T. |
| _____ |) | |

NOTICE OF OPPOSITION

Marshall Amplification PLC, a corporation duly organized and existing under the laws of the United Kingdom, with a mailing address of Denbigh Road, Bletchley, Milton Keynes Buckinghamshire, United Kingdom, believes that it will be damaged by the registration of the MARSHALL A.R.T. mark shown in Application Serial No. 85/904,663, filed April 15, 2013 by Kiaico, Inc., with a mailing address of 445 Park Avenue, New York, New York 10022, and hereby opposes registration of the mark. The grounds for opposition are as follows:

1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946 as amended, registration on the Principal Register of the trademark MARSHAL A.R.T. for:

International Class 25: Clothing, namely, shirts, T-shirts, sweatshirts, sweat pants, sweat suits, pants, skirts, shorts, sarongs, vests, boxer shorts, underwear, jackets, coats, rain wear, pullovers, sweaters, jumpers, overalls, rompers, infant wear, socks, shoes, slippers, halloween and masquerade costumes, promotional mascot character costumes, sleep wear, robes, hats, caps, bandanas, headbands, gloves, mufflers, scarves, swim wear, beach cover ups

This application (Serial No. 85/904,663) is based on Applicant's alleged use of the mark since January 1, 1980 and first use in commerce since March 1, 2013.

2. Applicant's Mark published for opposition on August 27, 2013 and Opposer obtained an extension of time to oppose the application until February 23, 2013. This Notice of Opposition is timely filed.

3. Opposer is the owner of the following U.S. Trademark Registrations and pending trademark application:



, U.S. App. No. 86093877 used in connection with clothing, footwear, headgear; T-shirts, polo shirts, shirts, jogging pants, sweat pants, sweatshirts, hooded sweatshirts, hooded sweaters, tracksuits, fleeces, jackets, vests; jeans, trousers, sweaters, ties, baby romper suits; bibs; underwear; socks, boxer shorts, knickers; nightwear, pyjamas; bandanas; baseball caps, beanie hats; sports shoes, trainers, sneakers; sweat bands; leather wristbands; belts in International Class 25. Said application was filed on October 17, 2013.



, U.S. Reg. No. 4,303,941, used in connection with Electrical and electronic audio apparatus; sound amplifiers; valve and digital guitar amplifiers; sound reverberation units; sound mixing, processing and synthesizing apparatus; microphones, headphones; loudspeakers; horn-type speakers, loudspeaker cabinets; computer software for recording sound; computer software for use with any of the aforesaid goods; parts and fittings for the aforesaid goods, in International Class 9. Said registration was registered on the Principal Register on March 19, 2013.



, U.S. Reg. No. 3,247,712, used in connection with Sound amplifiers; sound reverberation units; electric sound mixing, processing and synthesising apparatus; microphones, headphones; loudspeakers, horn-type speakers, loudspeaker cabinets; parts and fittings for the aforesaid goods; calculators; CD cases, in International Class 9. Said registration was registered on the Principal Register on May 29, 2007.



, U.S. Reg. No. 3,940,239, used in connection with Clothing, headwear and footwear, namely, T-shirts, polo shirts, shirts, jogging pants, sweat pants, sweatshirts, hooded sweatshirts, tracksuits, fleece tops and pullovers, jackets, vests; baseball caps, beanies; sports shoes, sneakers; sweat bands; belts,

in International Class 25. Said registration was registered on the Principal Register on April 5, 2011.

MARSHALL, U.S. Reg. No. 0936514, used in connection with electronic sound amplifiers, [microphones, horn-type speakers,] reverberation units, [sound-mixer units,] and speaker cabinets, in International Class 7, 9, 11, 12, 15. Said registration was registered on the Principal Register on June 27, 1972.

MARSHALL, U.S. Reg. No. 0880220, used in connection with electronic sound amplifiers, in International Class 9. Said registration was registered on the Supplemental Register on November 04, 1969.

4. Opposer is one of the best known and most well respected manufacturers of amplification equipment for live musical performances. Opposer's products have been sought after by musicians and venues for many decades. Opposer has used its name MARSHALL in conjunction with amplifiers and sound making equipment since the early 1960s. Marshall Amplifiers appeared on the Ed Sullivan show when The Beatles first appeared on American television. The MARSHALL name and trademarks have appeared on the front of most of the amplifiers Opposer has sold and the name is seen at musical performances, during televised performances, and is well known. Marshall products have been discussed often in the media, and the fame of the brand has spread by word of mouth advertising, as well as advertising. Nearly all serious musicians who use amplifiers know the brand. Further, Opposer uses MARSHALL as a house mark and brand. MARSHALL is the corporate identity and corporate persona of Opposer. Thus, MARSHALL points uniquely and directly to Opposer. This has been true many years before the date of first use and filing date of the subject mark and application. Opposer's trademark MARSHALL shall be referred to herein as Opposer's mark.

5. Opposer also sells and distributes merchandise bearing the MARSHALL marks, including but not limited to clothing, headwear and footwear, namely, T-shirts, polo shirts, shirts,

jogging pants, sweat pants, sweatshirts, hooded sweatshirts, tracksuits, fleece tops and pullovers, jackets, vests, baseball caps, beanies, sports shoes, sneakers, sweat bands and belts.

6. The word MARSHALL points directly and immediately to Opposer, and serves as Opposer's identity and persona in the eyes of consumers and has done so since long prior to Applicant's application filing date or Applicant's claimed first use in commerce date.

7. Opposer's registrations are valid and subsisting, and are prima facie evidence of Opposer's exclusive right to use those marks in commerce on the goods specified in each registration.

8. Opposer has advertised and promoted its MARSHALL marks extensively. Opposer has also made substantial sales under said mark. As a result of such use and promotion, Opposer's MARSHALL marks have developed and represent valuable goodwill inuring to the benefit of Opposer.

9. Opposer has priority with respect to the mark at issue in this opposition.

10. Applicant's MARSHAL A.R.T. mark is confusingly similar to Opposer's MARSHALL marks. The marks have an overall confusingly similar appearance, sound, meaning and commercial impression. Applicant's goods are highly and closely related to Opposer's goods. Applicant's mark falsely suggests a connection between Opposer and Applicant that does not exist.

11. Applicant's mark is deceptively similar to Opposer's mark. The marks have a confusingly similar appearance, sound, meaning and commercial impression. Consumers will mistakenly believe that Applicant's goods are offered by, affiliated with and/or sponsored by Opposer when the same is not true.

12. Due to the highly similar nature of Applicant's mark and Opposer's mark, the closely related nature of the goods provided by the respective parties, consumers and potential consumers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

13. Upon information and belief, the goods provided by Opposer under its MARSHALL mark and the goods intended to be provided by Applicant under its MARSHAL A.R.T. mark will be promoted and sold in the same channels of trade to the same consumers or class of consumers.

14. The use and registration by Applicant of the mark MARSHAL A.R.T. for Applicant's goods are likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with Opposer's previously used MARSHALL marks, again resulting in damage to Opposer.

15. Because of the highly related nature of the goods, and the highly similar nature of the marks in overall appearance, sound, meaning and commercial impression, use and registration of the term MARSHAL A.R.T. by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.

16. Opposer's MARSHALL marks are famous and distinctive, and were famous prior to any first use of the MARSHAL A.R.T. mark by Applicant. Applicant's mark is likely to cause dilution by blurring and impair the distinctiveness of Opposer's famous MARSHALL marks.

17. If Applicant is granted registration of the mark herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration would be a source of further damage and injury to Opposer.

18. Registration of the mark shown in Application Serial No 85/904,663 will result in damage to Opposer under the provisions of §2(a), §2(d) §43(c) and of the U.S. Trademark Act, 15 U.S.C. § 1052, §1125 pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that the registration of the proposed mark MARSHAL A.R.T. set forth therein be refused.

Please direct all correspondence to the attention of:

John A. Clifford
Merchant & Gould P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910
Tel: 612-336-4616 Fax: 612-332-9081

Opposer hereby appoints: John A. Clifford; Danielle I. Mattessich; Heather Kliebenstein, Brian H. Batzli; Gregory C. Golla; Scott W. Johnston; D; Andrew S. Ehard; Christopher J. Schulte; and Brent Routman as its attorneys with the full power to represent the Opposer in connection with this proceeding.

Respectfully submitted,
MARSHALL AMPLIFICATION PLC

By its attorneys,

Date: February 21, 2014

A handwritten signature in black ink, appearing to read "Heather Kliebenstein", is written over a horizontal line.

John A. Clifford
Heather Kliebenstein
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910
Tel. 612.336.4616
Fax 612.332.9081

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served, via first-class mail, postage prepaid on the following this 21st day of February, 2014.

Dan Healy
KIAICO Inc.
445 Park Avenue, 10th. Floor
New York, NY 10022


Heather Kliebenstein