

ESTTA Tracking number: **ESTTA611592**

Filing date: **06/23/2014**

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	Kind LLC
Granted to Date of previous extension	06/22/2014
Address	1372 Broadway New York, NY 10018 UNITED STATES

Attorney information	Margarita Wallach McCarter & English, LLP 245 Park Avenue, 27th Floor New York, NY 10167 UNITED STATES mwallach@mccarter.com, apang@mccarter.com, dlynch@mccarter.com Phone:(212) 609-6800
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**Applicant Information**

Application No	86026016	Publication date	12/24/2013
Opposition Filing Date	06/23/2014	Opposition Period Ends	06/22/2014
Applicant	Flores, Herbert D. PO Box 818 Moss Beach, CA 94038 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. First Use: 2013/08/16 First Use In Commerce: 2013/09/09 All goods and services in the class are opposed, namely: Clothing and apparel, namely, hats, caps, visors, t-shirts, polo shirts, sweat shirts, sweat pants, sweaters, pants, short pants, belts, socks, undergarments, pajamas, jump suits, toddler jump suits, toddler pants, toddler tops, toddler undergarments, infant pants, infant jump suits, infant tops and infant undergarments; institutional clothing, namely, inmate jump suits, inmate t-shirts, inmate undergarments and inmate pants
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**Grounds for Opposition**

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**

U.S. Registration	2984772	Application Date	06/14/2004
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No.			
Registration Date	08/16/2005	Foreign Priority Date	NONE
Word Mark	KIND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2003/02/18 First Use In Commerce: 2003/02/18 Ready to eat, cereal derived food bars containing nuts		

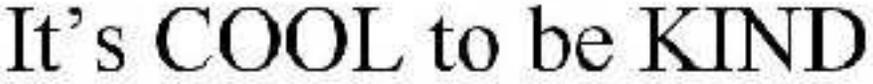
U.S. Registration No.	3971639	Application Date	11/20/2007
Registration Date	05/31/2011	Foreign Priority Date	NONE
Word Mark	KIND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 029. First use: First Use: 2003/02/18 First Use In Commerce: 2003/02/18 Nutrition bars, namely, processed fruit-and-nut-based food bars, nut based snack food bars		

U.S. Registration No.	4161495	Application Date	11/20/2007
Registration Date	06/19/2012	Foreign Priority Date	NONE
Word Mark	KIND		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2011/05/31 First Use In Commerce: 2011/09/26 Clothing and apparel, namely, T-shirts,sweatshirts, caps, vests, jackets Class 029. First use: First Use: 2003/02/18 First Use In Commerce: 2003/02/18 Sweet snacks, namely, fruit based snackfood, dried fruit mixes; snack mixes consisting primarily of processed fruits and processed nuts; nutrition bars, namely, nut and seed based snack bars; fruit based snack food bars also containing grains, cereals, dried fruit, fruit juice;nut based snack food Class 030. First use: First Use: 2011/06/08 First Use In Commerce: 2011/06/08 Snacks, namely, cereal based snack food; cereal based snack food bars, granola based snack food bars, grain based snackfood; Snack foods, namely, granola based mixes, rice based snack food, whole grain based snack food

U.S. Registration No.	4466295	Application Date	06/11/2013
Registration Date	01/14/2014	Foreign Priority Date	NONE

Word Mark	IT'S COOL TO BE KIND
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 029. First use: First Use: 2013/06/10 First Use In Commerce: 2013/06/10 Healthy snacks, namely, food bars comprised primarily of nuts, fruits and nuts,and also containing other ingredients

Attachments	76596770#TMSN.gif( bytes ) 77981723#TMSN.jpeg( bytes ) 77333800#TMSN.jpeg( bytes ) 85956074#TMSN.jpeg( bytes ) Notice of Opposition.pdf(412821 bytes ) Exhibit A.pdf(99603 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	/mw/
Name	Margarita Wallach

Date	06/23/2014
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application  
Serial No. 86/026,016  
Filed: August 1, 2013  
For the mark: **IT'S COOL TO BE KIND**  
Published: December 24, 2013

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KIND LLC, :  
          Opposer, :  
                          :

v. :  
                          :

HERBERT D. FLORES DBA :  
ZONAFELIZ :  
                          :

Applicant. :  
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OPPOSITION NO. \_\_\_\_\_

Commissioner for Trademarks  
United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

Kind LLC (“Kind” or “Opposer”), a limited liability company organized and existing under the laws of the State of Delaware, having its principal place of business at 1372 Broadway, New York, NY 10018 believes that it will be damaged by registration of the mark IT'S COOL TO BE KIND (“Applicant’s Mark”) shown in Application Serial No. 86/026,016, filed by Herbert D. Flores DBA ZonaFeliz, a sole proprietorship having an address at PO Box 818, Moss Beach, California 94038 (“Applicant”) based on use in connection with “clothing and apparel,

namely, hats, caps, visors, t-shirts, polo shirts, sweat shirts, sweat pants, sweaters, pants, short pants, belts, socks, undergarments, pajamas, jump suits, toddler jump suits, toddler pants, toddler tops, toddler undergarments, infant pants, infant jump suits, infant tops and infant undergarments; institutional clothing, namely, inmate jump suits, inmate t-shirts, inmate undergarments and inmate pants” (“Applicant’s Goods”) in International Class 25. Opposer believes that it will be damaged by the registration of Applicant’s Mark and opposes the foregoing application (the “Application”) on the following grounds:

1. Opposer, through its predecessor-in-interest, commenced use of the trademark KIND in connection with snack food bars at least as early as February 18, 2003. Since that time, Opposer, through its predecessor-in-interest, has continuously used the trademark KIND in commerce.

2. Opposer is the owner of the well-known trademark KIND as used in connection with apparel as well as the well-known mark KIND and other “KIND” formative trademarks as used in connection with snack food bars and other snack foods.

3. Opposer owns the trademark registration for KIND, United States Patent and Trademark Office Registration No. 4,161,495, in association with “clothing and apparel, namely, T-shirts, sweatshirts, caps, vests, jackets” in Class 25 which was first used by Opposer on May 31, 2011 and first used in commerce on September 26, 2011.

4. Opposer owns the trademark registration for IT'S COOL TO BE KIND, United States Patent and Trademark Office Registration No. 4,466,295, in connection with “healthy snacks, namely, food bars comprised primarily of nuts, fruits and nuts, and also containing other

ingredients” in Class 29 which was first used by Opposer on June 10, 2013 and first used in commerce on June 10, 2013.

5. Opposer owns the following trademarks (collectively with the foregoing marks, the “KIND Marks”) and registrations on the Principal Register in the United States Patent and Trademark Office (“USPTO”):

<b>Mark</b>	<b>Registration No.</b>	<b>Filing Date / Registration Date</b>	<b>Goods</b>	<b>Date of First Use / First Use In Commerce</b>
KIND	2,984,772	June 14, 2004 / August 16, 2005	“Ready to eat, cereal derived food bars containing nuts” in Class 30	February 18, 2003 February 18, 2003
KIND	3,971,639	November 20, 2007 / May 31, 2011	“Nutrition bars, namely, processed fruit-and-nut-based food bars, nut based snack food bars” in Class 29	February 18, 2003 February 18, 2003
KIND	4,161,495	November 20, 2007 / June 19, 2012	“Clothing and apparel, namely, T-shirts, sweatshirts, caps, vests, jackets” in Class 25  “Sweet snacks, namely, fruit based snack food, dried fruit mixes; snack mixes consisting primarily of processed fruits and processed nuts; nutrition bars, namely, nut and seed based snack bars; fruit based snack food bars also	Class 25: May 31, 2011 September 26, 2011  Class 29: February 18, 2003 February 18, 2003

Mark	Registration No.	Filing Date / Registration Date	Goods	Date of First Use / First Use In Commerce
			containing grains, cereals, dried fruit, fruit juice; nut based snack food” in Class 29  “Snacks, namely, cereal based snack food; cereal based snack food bars, granola based snack food bars, grain based snack food; Snack foods, namely, granola based mixes, rice based snack food, whole grain based snack food” in Class 30	Class 30: June 8, 2011 June 8, 2011
IT'S COOL TO BE KIND	4,466,295	June 11, 2013 / January 14, 2014	“Healthy snacks, namely, food bars comprised primarily of nuts, fruits and nuts, and also containing other ingredients” in Class 29	June 10, 2013 / June 10, 2013

Copies of the registration certificates printed from the USPTO website for the above referenced trademarks are attached as Exhibit A.

6. Opposer has never abandoned and has, through its predecessor-in-interest, continuously used the KIND Marks in connection with the foregoing goods and services.

7. The registrations referenced above are valid and subsisting, in full force and effect. Opposer's Registration No. 2,984,772 for the trademark KIND is incontestable pursuant to the provisions of Section 15 of the Lanham Act, 15 U.S.C. § 1065, and all of the registrations referenced above constitute conclusive evidence of Opposer's exclusive right to use the KIND Marks in commerce in connection with the goods and services specified in the registrations.

8. Opposer is the owner of the trade name KIND which it has continuously used since a date prior to any date of priority that may be asserted by Applicant.

9. During its longstanding, widespread and continuous use of the KIND Marks and the trade name KIND, Opposer has expended considerable time, effort and financial resources in advertising and publicizing the sale of the goods and services under the KIND Marks and sold under the trade name KIND. The KIND Marks and the KIND trade name are symbolic of the extensive goodwill and consumer recognition that Opposer has established through substantial and extensive expenditures of time, effort and other resources that Opposer has expended in the promotion and advertising of the goods and services Opposer offers and sells under the KIND Marks and the KIND trade name. As a result of the foregoing and the high quality of Opposer's snack products the public and the trade have come to recognize the products offered in conjunction with the KIND Marks and the trade name KIND as signifying Opposer and its snack foods.

10. Upon information and belief, Applicant is a sole proprietorship with an address of PO Box 818, Moss Beach, California 94038.

11. On August 1, 2013 Applicant filed the Application based on an intent-to-use the trademark IT'S COOL TO BE KIND in commerce in connection with "clothing and apparel, namely, hats, caps, visors, t-shirts, polo shirts, sweat shirts, sweat pants, sweaters, pants, short pants, belts, socks, undergarments, pajamas, jump suits, toddler jump suits, toddler pants, toddler tops, toddler undergarments, infant pants, infant jump suits, infant tops and infant undergarments; institutional clothing, namely, inmate jump suits, inmate t-shirts, inmate undergarments and inmate pants" in International Class 25. On September 10, 2013, Applicant amended the Application to allege use, asserting a first use date of August 16, 2013 and a first use in commerce date of September 9, 2013. Accordingly, the KIND Marks cited above, and the trade name KIND, have priority of use and/or registration to Applicant's use of and application for Applicant's Mark.

12. The Application was published for opposition on December 24, 2013. Opposer has timely filed a request for extension of the deadline for opposing the Application. The current deadline to oppose the Application is June 23, 2014.

13. The trademark proposed for registration by the Applicant, namely, IT'S COOL TO BE KIND, is identical to and/or confusingly similar to the KIND Marks and Opposer's trade name KIND, and is applied to goods that are similar and closely related to the goods and services offered and sold by Opposer under the KIND Marks and the KIND trade name. Applicant's Mark so closely resembles Opposer's KIND Marks and KIND trade name as to be likely to be confused therewith and mistaken therefor. Applicant's Mark is deceptively similar to Opposer's KIND Marks and KIND trade name so as to cause confusion and lead to deception as to the origin of Applicant's Goods bearing the Applicant's Mark.

14. Upon information and belief, Applicant's Goods bearing Applicant's Mark will be promoted and sold or offered for sale through the same distribution channels and to the same classes of consumers.

15. If Applicant is permitted to use and register its trademark IT'S COOL TO BE KIND for "clothing and apparel, namely, hats, caps, visors, t-shirts, polo shirts, sweat shirts, sweat pants, sweaters, pants, short pants, belts, socks, undergarments, pajamas, jump suits, toddler jump suits, toddler pants, toddler tops, toddler undergarments, infant pants, infant jump suits, infant tops and infant undergarments; institutional clothing, namely, inmate jump suits, inmate t-shirts, inmate undergarments and inmate pants" in Class 25 as specified in its Application, there will be confusion in the trade. As a result, the Opposer will be injured and damaged by reason of the similarity between the Applicant's mark IT'S COOL TO BE KIND and Opposer's KIND Marks and KIND trade name. Consumers will associate Applicant's Goods with those of the Opposer, and mistakenly believe that such goods are provided, endorsed by, or otherwise affiliated with the Opposer.

### **COUNT ONE**

#### **Likelihood of Confusion**

16. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 15.

17. Based on the similarities between Opposer's KIND Marks and KIND trade name and Applicant's Mark, and the similarity and related nature of the goods of the respective parties, Applicant's Mark so resembles Opposer's KIND Marks and KIND trade name, which were

previously and continuously used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake, or to deceive consumers, with consequent injury to Opposer and to the public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

18. The public is likely to falsely associate Applicant's Goods under the IT'S COOL TO BE KIND mark with Opposer or with Opposer's goods, falsely believe that Applicant's Goods emanate from or are sponsored, endorsed or licensed by Opposer, or falsely believe that there is some relationship between Applicant and Opposer.

19. The granting of a trademark registration for the trademark IT'S COOL TO BE KIND to Applicant would be contrary to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and would violate or diminish the prior and superior rights of Opposer in its KIND Marks and KIND trade name.

20. Applicant's Application and the presumption of exclusivity that would arise from a registration to Applicant of the trademark IT'S COOL TO BE KIND are inconsistent with Opposer's prior rights in the KIND Marks and KIND trade name and the rights flowing from Opposer's federal trademark registrations for the KIND Marks.

21. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the Applicant's Mark and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

## **COUNT TWO**

### **Falsely Suggests a Connection with Opposer**

22. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 21.

23. Opposer believes it will be damaged by registration of Applicant's Mark under Section 13 of the Lanham Act, 15 U.S.C. § 1063, on the ground that Applicant's use and registration of the subject mark will falsely suggest a connection between Applicant and Opposer to the damage of Opposer and injury to the public, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a).

## **COUNT THREE**

### **Dilution**

24. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 23.

25. In view of the strength of Opposer's KIND Marks, the duration and extent of Opposer's use and advertising of its KIND Marks, the nationwide use of Opposer's KIND Marks, and the degree of recognition of Opposer's KIND Marks, Opposer's KIND Marks have become famous. Opposer's KIND Marks were famous prior to the filing date of the Application for Applicant's Mark.

26. Applicant's Mark is likely to cause, and will cause, dilution of the distinctive value of Opposer's KIND Marks under Section 43(c) of the Lanham Act of 1946, as amended, 15 U.S.C. § 1125(c).

27. Opposer will be damaged if Applicant's Mark is granted registration because Applicant will obtain statutory rights in the designation IT'S COOL TO BE KIND in violation and derogation of the established prior rights of Opposer.

WHEREFORE, Opposer respectfully requests that said Application Serial No. 86/026,016 be rejected, that no registration be issued thereon to Applicant, that this Opposition be sustained in favor of Opposer and that the Trademark Trial and Appeal Board grant such other and further relief as it deems just and appropriate.

Payment has been provided in the requisite amount to cover the statutory filing fee for filing a Notice of Opposition. All communications should be addressed to Opposer's counsel, McCarter & English at the address stated below.

Dated: June 23, 2014

Respectfully submitted,  
McCarter & English, LLP

By: /s/ Margarita Wallach  
Margarita Wallach  
Gary Fechter  
Attorney for Opposer  
Kind LLC  
245 Park Ave, 27<sup>th</sup> Floor  
New York, NY 10167  
Tel: (212) 609-6800  
Fax: (212) 609-6921

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the foregoing NOTICE OF OPPOSITION against Trademark Application Serial No. 86/026,016 for the trademark IT'S COOL TO BE KIND has been served on Applicant by First Class Mail at the following address:

Herbert D. Flores  
P.O. Box 818  
Moss Beach, CA 94038-0818

Dated: June 23 2014

A handwritten signature in black ink, appearing to read 'Alice Pang', written over a horizontal line.

Alice Pang

# Exhibit A

Int. Cl.: 30

Prior U.S. Cl.: 46

**United States Patent and Trademark Office**

**Reg. No. 2,984,772**

Registered Aug. 16, 2005

**TRADEMARK  
PRINCIPAL REGISTER**

**KIND**

PEACEWORKS (DELAWARE CORPORATION)  
444 PARK AVENUE SOUTH  
NEW YORK, NY 10016

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

FOR: READY TO EAT, CEREAL DERIVED FOOD  
BARS CONTAINING NUTS, IN CLASS 30 (U.S. CL.  
46).

SER. NO. 76-596,770, FILED 6-14-2004.

FIRST USE 2-18-2003; IN COMMERCE 2-18-2003.

CURTIS FRENCH, EXAMINING ATTORNEY

# United States of America

United States Patent and Trademark Office

## KIND

**Reg. No. 3,971,639**

**Registered May 31, 2011**

**Int. Cl.: 29**

**TRADEMARK**

**PRINCIPAL REGISTER**

KIND,LLC (DELAWARE LIMITED LIABILITY COMPANY)  
P.O. BOX 1393  
OLD CHELSEA STATION, NY 10113

FOR: NUTRITION BARS, NAMELY, PROCESSED FRUIT-AND-NUT-BASED FOOD BARS,  
NUT BASED SNACK FOOD BARS, IN CLASS 29 (U.S. CL. 46).

FIRST USE 2-18-2003; IN COMMERCE 2-18-2003.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,984,772.

SN 77-981,723, FILED 11-20-2007.

HOWARD SMIGA, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

**United States of America**  
United States Patent and Trademark Office

**KIND**

**Reg. No. 4,161,495**

**Registered June 19, 2012**

**Int. Cls.: 25, 29, and 30**

KIND LLC (DELAWARE LIMITED LIABILITY COMPANY)  
P.O. BOX 705 MIDTOWN STATION  
NEW YORK, NY 10018

FOR: CLOTHING AND APPAREL, NAMELY, T-SHIRTS, SWEATSHIRTS, CAPS, VESTS, JACKETS, IN CLASS 25 (U.S. CLS. 22 AND 39).

**TRADEMARK**

FIRST USE 5-31-2011; IN COMMERCE 9-26-2011.

**PRINCIPAL REGISTER**

FOR: SWEET SNACKS, NAMELY, FRUIT BASED SNACK FOOD, DRIED FRUIT MIXES; SNACK MIXES CONSISTING PRIMARILY OF PROCESSED FRUITS AND PROCESSED NUTS; NUTRITION BARS, NAMELY, NUT AND SEED BASED SNACK BARS; FRUIT BASED SNACK FOOD BARS ALSO CONTAINING GRAINS, CEREALS, DRIED FRUIT, FRUIT JUICE; NUT BASED SNACK FOOD, IN CLASS 29 (U.S. CL. 46).

FIRST USE 2-18-2003; IN COMMERCE 2-18-2003.

FOR: SNACKS, NAMELY, CEREAL BASED SNACK FOOD; CEREAL BASED SNACK FOOD BARS, GRANOLA BASED SNACK FOOD BARS, GRAIN BASED SNACK FOOD; SNACK FOODS, NAMELY, GRANOLA BASED MIXES, RICE BASED SNACK FOOD, WHOLE GRAIN BASED SNACK FOOD, IN CLASS 30 (U.S. CL. 46).

FIRST USE 6-8-2011; IN COMMERCE 6-8-2011.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,984,772.

SN 77-333,800, FILED 11-20-2007.

HOWARD SMIGA, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

# United States of America

United States Patent and Trademark Office

## It's COOL to be KIND

**Reg. No. 4,466,295**

**Registered Jan. 14, 2014**

**Int. Cl.: 29**

**TRADEMARK**

**PRINCIPAL REGISTER**

KIND LLC (DELAWARE LIMITED LIABILITY COMPANY)  
P.O. BOX 705 MIDTOWN STATION  
NEW YORK, NY 10018

FOR: HEALTHY SNACKS, NAMELY, FOOD BARS COMPRISED PRIMARILY OF NUTS, FRUITS AND NUTS, AND ALSO CONTAINING OTHER INGREDIENTS, IN CLASS 29 (U.S. CL. 46).

FIRST USE 6-10-2013; IN COMMERCE 6-10-2013.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-956,074, FILED 6-11-2013.

MARTHA SANTOMARTINO, EXAMINING ATTORNEY



*Michelle K. Lee*

Deputy Director of the United States  
Patent and Trademark Office