

ESTTA Tracking number: **ESTTA619519**

Filing date: **08/05/2014**

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	TBL Licensing LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	200 Domain Drive Stratham, NH 03885 UNITED STATES		

Attorney information	Larry C. Jones Alston & Bird LLP 101 South Tryon Street Suite 4000 Charlotte, NC 28280-4000 UNITED STATES Larry.Jones@alston.com, Carla.Clements@Alston.com Phone:704 444 1019		
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Applicant Information

Application No	86071240	Publication date	08/05/2014
Opposition Filing Date	08/05/2014	Opposition Period Ends	09/04/2014
Applicant	Summit Entertainment, LLC 2700 Colorado Ave., 2nd Floor Santa Monica, CA 90404 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Battery chargers for use with mobile phones; computer games downloadable from the internet and mobile devices; computergame discs, cartridges and software; decorative magnets; digital music downloadable from the internet and mobile devices; downloadable computer wallpaper or screensaver software; downloadable files containing audio and video content relating to motion pictures, documentaries, and music; downloadable files containing images relating to motion pictures; downloadable graphics; downloadable podcasts featuring content relating to motion pictures; downloadable ringtones; eyewear; eyewear cases; headphones and earbuds; magnetically encoded gift cards; motion picture films in the fields of drama, romance, and science fiction; mouse pads; musical sound

Applicant Information

Application No	86071241	Publication date	08/05/2014
Opposition Filing Date	08/05/2014	Opposition Period Ends	09/04/2014
Applicant	Summit Entertainment, LLC 2700 Colorado Ave., 2nd Floor Santa Monica, CA 90404 UNITED STATES		

Goods/Services Affected by Opposition

Class 014. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Clocks; cuff bracelets; jewelry, namely, dog tags for wear by humans for decorative purposes; jewelry; jewelry boxes or cases; ornamental pins; rubber or silicon wristbands in the nature of a bracelet; watches

Applicant Information

Application No	86071243	Publication date	08/05/2014
Opposition Filing Date	08/05/2014	Opposition Period Ends	09/04/2014
Applicant	Summit Entertainment, LLC 2700 Colorado Ave., 2nd Floor Santa Monica, CA 90404 UNITED STATES		

Goods/Services Affected by Opposition

Class 018. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: All-purpose carrying bags; all-purpose carrying cases; back packs; beach bags; business card cases; canvas lunch bags; clips that attach to bags or purses as a decorative accessory; coin purses; cosmetic or toiletry bags sold empty; credit-card holders; diaper bags; duffel bags; handbags; key chains of leather or imitation leather; luggage handle wraps; luggage; luggage tags; messenger bags; reusable shopping bags; travel valets; umbrellas; wallets; wine carrying bags; animal collars; animal clothing; animal tags adapted for attaching to leashes or collars

Applicant Information

Application No	86071244	Publication date	08/05/2014
Opposition Filing Date	08/05/2014	Opposition Period Ends	09/04/2014
Applicant	Summit Entertainment, LLC 2700 Colorado Ave., 2nd Floor Santa Monica, CA 90404 UNITED STATES		

Goods/Services Affected by Opposition

Class 020. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Decorative boxes of wood or plastic; non-metal key hangers; mirrors; non-metal animal tags; non-metal key chains; non-metal novelty license plates; picture frames; pillows; plastic banners or flags; plastic yard signs; and vinyl appliques for attachment to walls, windows, mirrors, and other solid surfaces

Applicant Information

Application No	86071246	Publication date	08/05/2014
Opposition Filing Date	08/05/2014	Opposition Period Ends	09/04/2014
Applicant	Summit Entertainment, LLC 2700 Colorado Ave., 2nd Floor Santa Monica, CA 90404 UNITED STATES		

Goods/Services Affected by Opposition

Class 024. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Blanket throws; beach towels; bed linen; duvet covers; duvets; placemats not of paper; shower curtains; table cloths not of paper; table linen; textile wall hangings; textile window hangings

Applicant Information

Application No	86071248	Publication date	08/05/2014
Opposition Filing Date	08/05/2014	Opposition Period Ends	09/04/2014
Applicant	Summit Entertainment, LLC 2700 Colorado Ave., 2nd Floor Santa Monica, CA 90404 UNITED STATES		

Goods/Services Affected by Opposition

Class 026. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Armbands; belt buckles; ornamental patches for clothing; hair accessories, namely, hair clips and hair bands; ornamental novelty buttons; shoelaces

Applicant Information

Application No	86071249	Publication date	08/05/2014
Opposition Filing Date	08/05/2014	Opposition Period Ends	09/04/2014
Applicant	Summit Entertainment, LLC 2700 Colorado Ave., 2nd Floor Santa Monica, CA 90404 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Action figures; action figure cases; action skill games; balloons; balls for games; board games; card games; Christmas tree ornaments; Christmas stockings; dolls and accessories therefor; golf balls; magnetic story kits consisting of positionable printed magnetic pieces for use in games; party favors in the nature of small toys; plastic toy figures; plush toys; puzzles; snow globes; sports balls; toy planes and vehicles and accessories therefor; toy weapons; yoga mats; and fitted plastic films known as skins for covering and protecting gaming devices, consoles, and controllers

Grounds for Opposition

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 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, BACK-PACKS AND BRIEFCASES

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		

U.S. Registration No.	1607424	Application Date	09/07/1989
Registration Date	07/24/1990	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1987/12/21 First Use In Commerce: 1987/12/21 WATCHES		

U.S. Registration No.	1607768	Application Date	02/01/1989
Registration Date	07/24/1990	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1982/04/15 First Use In Commerce: 1983/03/18 RETAIL CLOTHING, FOOTWEAR AND OUTERWEARSTORE SERVICES		

U.S. Registration No.	1610987	Application Date	10/13/1989
Registration Date	08/28/1990	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 003. First use: First Use: 1981/12/14 First Use In Commerce: 1981/12/14 SHOE CARE PRODUCTS, NAMELY WATER REPELLANT FOR SHOES

U.S. Registration No.	1843478	Application Date	07/31/1990
Registration Date	07/05/1994	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark comprises a tree logo.		
Goods/Services	Class 009. First use: First Use: 1993/07/22 First Use In Commerce: 1993/07/22 sunglasses		

U.S. Registration No.	2786702	Application Date	06/17/1998
Registration Date	11/25/2003	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 1995/07/00 First Use In Commerce: 1995/07/00 Furniture; [magazine racks, wooden signboards, key fobs, not of metal]		

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	Class 006. First use: First Use: 2004/08/31 First Use In Commerce: 2004/08/31 [Metal fuel bottles, sold empty; metalkey fobs] Class 018. First use: First Use: 1987/09/30 First Use In Commerce: 1987/09/30		

	<p>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; plasticwater bottles, sold empty;] brushes for suede; brushes for footwear</p> <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]</p>
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Related Proceedings	Opposition No. 91217666
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Attachments	<p>73701653#TMSN.png(bytes)</p> <p>73721905#TMSN.png(bytes)</p> <p>73824199#TMSN.png(bytes)</p> <p>73778475#TMSN.png(bytes)</p> <p>73831211#TMSN.png(bytes)</p> <p>74083463#TMSN.png(bytes)</p> <p>75504014#TMSN.png(bytes)</p> <p>76381869#TMSN.png(bytes)</p> <p>78667488#TMSN.png(bytes)</p> <p>TBL Notice of Opposition 080514.PDF(469690 bytes)</p>
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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	08/05/2014

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

In the matter of Trademark Applications

Serial Nos. 86/071,240, 86/071,241, 86/071,243, 86/071,244, 86/071,246, 86/071,248 and
86/071,249

Filed: September 22, 2013

Trademark: Summit Tree Mark

Published: August 5, 2014

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TBL Licensing LLC,)
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Opposer)
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v.)
)
Summit Entertainment, LLC,)
)
)
Applicant.)
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Opposition No. _____

CONSOLIDATED NOTICE OF OPPOSITION

TBL Licensing LLC, a Delaware limited liability company having a mailing address of 200 Domain Drive, Stratham, New Hampshire 03885 (“Opposer” or “Timberland”), believes that it will be damaged by the registration of the designation shown in each of Applications Serial Nos. 86/071,240, 86/071,241, 86/071,243, 86/071,244, 86/071,246, 86/071,248 and 86/071,249, each of which applications was filed September 22, 2013, by Summit Entertainment, LLC, a Delaware limited liability company having a mailing address of 2700 Colorado Avenue, 2nd Floor, Santa Monica, California 90404 (“Applicant” or “Summit”), and hereby opposes the registrations of said designation as a trademark.

As grounds of opposition, it is alleged that:

1. Since at least as early as October 1973, and, in any event, since long prior to either September 22, 2013, the filing date of the subject ITU applications, or Summit’s actual

dates of first use of the subject mark, Timberland (directly and/or through its predecessors-in-interest and/or their licensees) has used the designation shown below (the “Timberland Tree Mark”) as a trademark and as a service mark on and in connection with a broad range of goods and services in the United States.



Among those goods and services are goods which are classified in International Classes 9, 14, 18, 20, 24 and 26. The availability of such products under the Timberland Tree Mark has been promoted and advertised to the public at considerable expense.

2. By reason of the use, advertising and promotion of the Timberland Tree Mark throughout the United States on and in connection with goods and services sold or provided by or under license from Timberland and its predecessors-in-interest, that designation has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying Timberland and its goods and services in this country.

3. Consequently, through such usage and recognition, Timberland has acquired common-law rights in the Timberland Tree Mark as a proprietary trademark and service mark, which rights extend, without limitation, to the exclusive right to use such designation nationwide in conjunction with Timberland’s goods and services, including, without limitation, goods which are classified in International Classes 9, 14, 18, 20, 24 and 26.

4. Timberland is also the owner of multiple U.S. registrations for the Timberland Tree Mark, including the following subsisting registrations:

U.S. Registration No.	Int'l Class	Original Goods/Services	Current Goods/Services
1,502,205	18	Leather goods, namely, key fobs, luggage tags, credit card cases, wallets, portfolio type briefcases, duffle bags, backpacks and briefcases	Leather goods, namely, credit card cases, wallets, portfolio type briefcases, duffle bags, backpacks and briefcases
1,552,963	25	Clothing, namely coats, jackets, rainwear, sweaters, shirts, pants, caps, hats, gloves, scarfs, belts, t-shirts and vests	Clothing, namely coats, jackets, rainwear, sweaters, shirts, pants, caps, hats, gloves, scarfs, belts, t-shirts and vests
1,607,424	14	Watches	Watches
1,607,768	42	Retail clothing, footwear and outerwear store services	Retail clothing, footwear and outerwear store services
1,610,987	3	Shoe care products, namely water repellent for shoes	Shoe care products, namely water repellent for shoes
1,843,478	9	Sunglasses	Sunglasses
2,786,702	20	Furniture; magazine racks, wooden signboards, key fobs, not of metal	Furniture; key fobs, not of metal
2,947,228	25	Footwear; clothing, namely coats, jackets, rainwear, sweaters, shirts, pants, shorts, headwear, gloves, neckwear, belts, sweatshirts, t-shirts, vests, socks	Footwear; clothing, namely coats, jackets, rainwear, sweaters, shirts, pants, shorts, headwear, gloves, neckwear, belts, sweatshirts, t-shirts, vests, socks
3,235,977	6	Metal fuel bottles, sold empty; metal key fobs	Metal fuel bottles, sold empty; metal key fobs
	18	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	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
	21	Beverageware; vacuum bottles; plastic water bottles, sold empty; brushes for suede; brushes for footwear	Beverageware; vacuum bottles; plastic water bottles, sold empty; brushes for suede; brushes for footwear
	24	Bed blankets; blanket throws; blankets for outdoor use	

5. Each of Opposer’s registrations of the Timberland Tree Mark listed above is valid, subsisting, in full force and effect, and most of such registrations are incontestable. Moreover, each of those registrations serves as prima facie evidence of Timberland’s exclusive right to use the Timberland Tree Mark in conjunction with the goods or services currently listed in the respective registration thereof.

6. Moreover, although Timberland has not registered its common law rights subsisting in the Timberland Tree Mark as used on such goods, Timberland and/or its predecessors-in-interest have also used that designation on various additional goods, including, without limitation: cell phone and tablet cases (International Class 9); and shoelaces (International Class 26). As such, Timberland’s common law trademark rights extend to the use of the Timberland Tree Mark on such goods.

7. On September 22, 2013, Summit filed the applications at issue to register the mark shown below (the “Summit Tree Mark”).



8. More particularly by the opposed applications, Summit seeks to register the Summit Tree Mark for use on the following goods in International Classes 9, 14, 18, 20, 24, 26 and 28:

Application No.	Int’l Class	Goods
86/071,240	9	Battery chargers for use with mobile phones; computer games downloadable from the internet and mobile devices; computer game discs, cartridges and software; decorative magnets; digital music downloadable from the internet and mobile devices; downloadable computer wallpaper or screensaver

Application No.	Int'l Class	Goods
		software; downloadable files containing audio and video content relating to motion pictures, documentaries, and music; downloadable files containing images; downloadable graphics; downloadable podcasts featuring content relating to motion pictures; downloadable ringtones; eyewear; eyewear cases; headphones and earbuds; magnetically encoded gift cards; motion picture films in the fields of drama, romance, and science fiction; mouse pads; musical sound recordings; musical video recordings; pre-recorded electronic media featuring trailers, motion pictures, documentaries, literary works, and music; USB power banks for charging multiple devices; USB flash drives sold blank or with prerecorded content relating to motion pictures, documentaries, literary works and music; video game discs and cartridges; cases for portable electronic devices, namely, mobile phones, e-book readers, personal digital assistants, tablet computers, and digital media players; covers or fitted vinyl films known as skins for covering and protecting headphones, speakers, and portable electronic devices, namely, cell phones, PDAs, media players, laptop computers, tablet computers, e-book readers, GPS units, computer accessories and peripherals, cameras, and camcorders
86/071,241	14	Clocks; cuff bracelets; dog tags for wear by humans for decorative purposes; jewelry; jewelry boxes or cases; ornamental pins; rubber or silicon wristbands in the nature of a bracelet; watches
86/071,243	18	All-purpose carrying bags; all-purpose carrying cases; back packs; beach bags; business card cases; canvas lunch bags; clips that attach to bags or purses as a decorative accessory; coin purses; cosmetic or toiletry bags sold empty; credit card holders; diaper bags; duffel bags; handbags; insulated lunch bags; key chains of leather or imitation leather; luggage handle wraps; luggage; luggage tags; messenger bags; reusable shopping bags; travel valets; umbrellas; wallets; wine carrying bags; animal collars; animal clothing; animal tags adapted for attaching to leashes or collars
86/071,244	20	Decorative boxes of wood or plastic; key hangers; mirrors; non-metal animal tags; non-metal key chains; non-metal novelty license plates; picture frames; pillows; plastic banners or flags; plastic yard signs; and vinyl appliques for attachment to walls, windows, mirrors, and other solid surfaces
86/071,246	24	Blanket throws; beach towels; bed linen; duvet covers; duvets; placemats; shower curtains; table covers; table linen; textile wall hangings; textile window hangings

Application No.	Int'l Class	Goods
86/071,248	26	Armbands; belt buckles; ornamental patches for clothing; hair clips and headbands; ornamental novelty buttons; shoelaces
86/071,249	28	Action figures; action figure cases; action skill games; balloons; balls for games; board games; card games; Christmas ornaments; Christmas stockings; dolls and accessories therefor; golf balls; magnetic story kits; party favors in the nature of small toys; plastic toy figures; plush toys; puzzles; snow globes; sports balls; toy planes and vehicles and accessories therefor; toy weapons; yoga mats; and fitted plastic films known as skins for covering and protecting gaming devices, consoles, and controllers

9. The Timberland Tree Mark and the Summit Tree Mark are shown below:



10. Each party's mark is generally circular in shape and includes a single tree as its most prominent element. Each mark has no textual element. Each mark includes within approximately the lower fourth of the circle a graphic depiction of the roots or terrestrial base of the tree. Individual details of the tree's leaves (if any) are not visible in either mark.

11. Thus, the Summit Tree Mark is quite similar visually to the Timberland Tree Mark. This characteristic contributes significantly to a likelihood of confusion. Moreover, the goods listed in Summit's applications are the same as, or are closely related to, the goods on which Timberland and its predecessors-in-interest and their licensees have used and, in some cases, registered the Timberland Tree Mark. This further enhances the likelihood of confusion. Thus, the Summit Tree Mark, when used on or in connection with the goods listed in the applications at issue, is likely to deceive or cause confusion or mistake as to the source or sponsorship of Summit's goods in relation to Timberland.

12. Still further, the Timberland Tree Mark is not only a distinctive mark, but also a famous mark, and that designation acquired its status as a famous mark prior to either the first usage in commerce of the Summit Tree Mark (if any such usage has been made) or the filing date of the opposed applications.

13. Hence, each of the applications to register the Summit Tree Mark should be refused on the basis that the usage of that mark on the goods listed in the subject applications: (i) is likely to cause confusion with the Timberland Tree Mark; and (ii) is likely to cause dilution by blurring of the famous Timberland Tree Mark.

SUMMARY

14. Each of Summit's Applications Nos. 86/071,240, 86/071,241, 86/071,243, 86/071,244, 86/071,246, 86/071,248 and 86/071,249 for registration of the Summit Tree Mark should be refused under either or both 15 U.S.C. § 1052(d) and 15 U.S.C. § 1063(a).

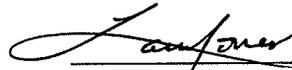
15. Accordingly, Timberland asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of registrations for the Summit Tree Mark to Applicant as sought in Trademark Applications Serial Nos. 86/071,240, 86/071,241, 86/071,243, 86/071,244, 86/071,246, 86/071,248 and 86/071,249.

WHEREFORE, Timberland prays that said applications for registration of the Summit Tree Mark be rejected, that no registration be issued thereon to Summit, and that these oppositions be sustained in favor of Timberland.

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

Date: August 5, 2014

Respectfully submitted,

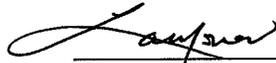


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CERTIFICATE OF SERVICE

I hereby certify that the foregoing "Consolidated Notice of Opposition" was duly served on Applicant by depositing a copy of same in the United States mail, first-class postage prepaid, on the 5th day of August, 2014, addressed to Applicant's attorney of record as follows:

Jill Pietrini
Sheppard Mullin Richter & Hampton LLP
1901 Avenue of the Stars, Suite 1600
Los Angeles, CA 90067-6017



Larry C. Jones