

ESTTA Tracking number: **ESTTA634399**

Filing date: **10/22/2014**

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                                  | Lyle & Scott Limited   |
| Granted to Date of previous extension | 10/25/2014   |
| Address                               | 45A Waterlinks House, Richard Street<br>Birmingham, West Midlands, B7 4AA<br>UNITED KINGDOM  |
| Attorney information                  | Susan B. Flohr<br>Blank Rome LLP<br>600 New Hampshire Avenue NW<br>Washington, DC 20006<br>UNITED STATES<br>trademarks@blankrome.com |

### Applicant Information

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 86241729  | Publication date       | 08/26/2014 |
| Opposition Filing Date | 10/22/2014  | Opposition Period Ends | 10/25/2014 |
| Applicant              | T.D.C. USA, INC.<br>14 Madison Road<br>Fairfield, NJ 07004<br>UNITED STATES |                        |            |

### Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Jackets; Jeans; Pajamas; Pants; Shirts;Socks

### Grounds for Opposition

|                                      |   |
|--------------------------------------|---|
| Priority and likelihood of confusion | Trademark Act section 2(d)                        |
| Dilution                             | Trademark Act section 43(c)                       |
| Other                                | Dilution by blurring; Trademark Act Section 13(a) |

### Marks Cited by Opposer as Basis for Opposition

|                       |              |                       |            |
|-----------------------|--------------|-----------------------|------------|
| U.S. Registration No. | 1202089      | Application Date      | 01/22/1980 |
| Registration Date     | 07/20/1982   | Foreign Priority Date | NONE       |
| Word Mark             | LYLE & SCOTT |                       |            |

|                     |   |
|---------------------|---|
| Design Mark         |   |
| Description of Mark | NONE  |
| Goods/Services      | Class 025. First use: First Use: 1874/00/00 First Use In Commerce: 1937/00/00<br>Knitted Articles of Clothing and Articles of Clothing Made from Knitted Material-<br>Namely, Sweaters, Pullovers, Cardigans and Sweat Shirts for Men, Women, and<br>Children |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 4103589    | Application Date      | 04/15/2010 |
| Registration Date     | 02/28/2012 | Foreign Priority Date | 10/19/2009 |

|           |              |
|-----------|--------------|
| Word Mark | LYLE & SCOTT |
|-----------|--------------|

|             |                         |
|-------------|-------------------------|
| Design Mark | <b>LYLE &amp; SCOTT</b> |
|-------------|-------------------------|

|                     |      |
|---------------------|------|
| Description of Mark | NONE |
|---------------------|------|

|                |  |
|----------------|--|
| Goods/Services | <p>Class 009. First use: First Use: 0 First Use In Commerce: 0<br/>Optical apparatus and instruments, namely, spectacles, glasses, sunglasses; clip-on sunglasses; lenses for spectacles; spectacle cases, spectacle chains, spectacle cords, spectacle frames, spectacle holders, spectacle earstems, nose pieces being parts of spectacle frames, spectacle accessories, namely, foam padding for nose bridges and suspension cords to prevent the loss of glasses, mountings all for spectacles and sunglasses, in the nature of frames; glasses for optical use; anti-glare eyewear; eye glasses; eye glass shields to prevent damage and/or breakage, and eye glass restraining straps; monocles; pince-nez; safety eyewear; eye protectors; contact lenses; contact lens cases, containers and holders; replacement parts for all the aforesaid goods; all the aforesaid goods excluding goods for sports and sporting activities</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0<br/>Articles made of leather and imitation leather, namely, wallets, purses, handbags, document cases, tote bags, beach bags, duffle bags, bags for sports clothing, all-purpose sports bags, toilet bags, namely, toilet cases sold empty, vanity cases sold empty, key cases, trunks, travelling bags, backpacks, messenger bags, shopping bags and courier bags; trunks and travelling bags; luggage; holdalls; handbags; key cases, wallets, purses, briefcases; carriers for clothing in the nature of luggage; attaché cases; checkbook wallets; passport wallets; credit-card cases; umbrellas, parasols; walking sticks</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0<br/>Clothing, namely, jerseys, jumpers, tops, slipovers, sweaters, pullovers, sweat-shirts, cardigans, gilets, scarves, shawls, wraparounds, wraps, mufflers, trousers, slacks, pants, jeans, shorts, skirts, shirts, blouses, tee shirts, polo shirts, jackets, sleeveless jackets, ties, gloves, socks, footwear and head wear and belts</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0<br/>Advertising; business management; business administration of the business affairs of retail stores; retail store services in the field of, optical apparatus and instruments, spectacles, glasses, sunglasses, clip-on sunglasses, lenses, spectacle cases, chains, cords, frames, holders, earstems, nose pieces, foam padding and suspension cords, mountings all for spectacles and sunglasses, glasses for optical use, anti-glare eyewear, eye glasses, eye glass shields and eye glass restraining straps, eye pieces and instruments containing eye pieces, monocles, pince-nez, eye shades and eyewear, eye cups, magnifying glasses, glare and light filters, contact lenses, contact lens cases, containers and holders, parts and</p> |
|----------------|--|

|  |  |
|--|--|
|  | <p>fittings for all the aforesaid goods, all of the aforesaid goods excluding goods for sports and sporting activities, clothing, clothing accessories, headgear, footwear, phonological and chronometrical apparatus and instruments, watches, clocks, watch straps, watch bands, jewelry, costume jewelry, key rings, key holders, key chains, necklaces, bracelets, earrings, brooches and rings, articles made of precious metal or coated therewith, containers adapted to carry the aforesaid goods, parts and fittings for all the aforesaid goods, articles made wholly or principally of leather or of imitation leather and goods made of these materials, trunks and travelling bags, luggage, holdalls, handbags, key-cases, wallets, purses, briefcases, belts, carriers for clothing in the nature of luggage, attache cases, checkbook holders, passport holders, credit card holders, umbrellas, parasols, walking sticks, textiles and textile goods, bed and table covers, games and playthings, gymnastic and sporting articles, all the aforesaid retail service-provided via retail shop outlets, mail order or online via the Internet or other interactive electronic platforms; information, advisory and consultancy services relating to all of the aforesaid services</p> |
|--|--|

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1765979   | Application Date      | 09/09/1992 |
| Registration Date     | 04/20/1993  | Foreign Priority Date | NONE       |
| Word Mark             | LYLE & SCOTT  |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 025. First use: First Use: 1962/00/00 First Use In Commerce: 1962/00/00 sweaters, shirts, slacks, trousers, jackets, headwear, socks and golf shoes |                       |            |

|             |  |
|-------------|--|
| Attachments | 79086417#TMSN.png( bytes )<br>Notice of Opp. LYONSCOTT.pdf(30825 bytes ) |
|-------------|--|

### 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 | /sbf/          |
| Name      | Susan B. Flohr |
| Date      | 10/22/2014     |



3. On or about 1962 Opposer began using the famous LYLE & SCOTT brand in connection with shirts, slacks, trousers, headwear and golf shoes in the United States as well.
4. Opposer has used its famous and distinctive LYLE & SCOTT trademarks continuously in commerce for over 75 years.
5. Opposer is the owner of and relies upon its valid and incontestable Registration Nos. 1202089 and 1765979 for its LYLE & SCOTT trademark for such apparel dated July 20, 1982 and April 20, 1993, respectively, as well as Reg. No. 4103589 for the mark under section 66A, dated February 28, 2012, which covers the expanded goods and services of:

IC 009. US 021 023 026 036 038. G & S: Optical apparatus and instruments, namely, spectacles, glasses, sunglasses; clip-on sunglasses; lenses for spectacles; spectacle cases, spectacle chains, spectacle cords, spectacle frames, spectacle holders, spectacle earstems, nose pieces being parts of spectacle frames, spectacle accessories, namely, foam padding for nose bridges and suspension cords to prevent the loss of glasses, mountings all for spectacles and sunglasses, in the nature of frames; glasses for optical use; anti-glare eyewear; eye glasses; eye glass shields to prevent damage and/or breakage, and eye glass restraining straps; monocles; pince-nez; safety eyewear; eye protectors; contact lenses; contact lens cases, containers and holders; replacement parts for all the aforesaid goods; all the aforesaid goods excluding goods for sports and sporting activities

IC 018. US 001 002 003 022 041. G & S: Articles made of leather and imitation leather, namely, wallets, purses, handbags, document cases, tote bags, beach bags, duffle bags, bags for sports clothing, all-purpose sports bags, toilet bags, namely, toilet cases sold empty, vanity cases sold empty, key cases, trunks, travelling bags, backpacks, messenger bags, shopping bags and courier bags; trunks and travelling bags; luggage; holdalls; handbags; key cases, wallets, purses, briefcases; carriers for clothing in the nature of luggage; attaché cases; checkbook wallets; passport wallets; credit-card cases; umbrellas, parasols; walking sticks

IC 025. US 022 039. G & S: Clothing, namely, jerseys, jumpers, tops, slipovers, sweaters, pullovers, sweatshirts, cardigans, gilets, scarves, shawls, wraparounds, wraps, mufflers, trousers, slacks, pants, jeans, shorts, skirts, shirts, blouses, tee shirts, polo shirts, jackets, sleeveless jackets, ties, gloves, socks, footwear and head wear and belts

IC 035. US 100 101 102. G & S: Advertising; business management; business administration of the business affairs of retail stores. retail store services in the field of, optical apparatus and instruments, spectacles, glasses, sunglasses, clip-on

sunglasses, lenses, spectacle cases, chains, cords, frames, holders, earstems, nose pieces, foam padding and suspension cords, mountings all for spectacles and sunglasses, glasses for optical use, anti-glare eyewear, eye glasses, eye glass shields and eye glass restraining straps, eye pieces and instruments containing eye pieces, monocles, pince-nez, eye shades and eyewear, eye cups, magnifying glasses, glare and light filters, contact lenses, contact lens cases, containers and holders, parts and fittings for all the aforesaid goods, all of the aforesaid goods excluding goods for sports and sporting activities, clothing, clothing accessories, headgear, footwear, phonological and chronometrical apparatus and instruments, watches, clocks, watch straps, watch bands, jewelry, costume jewelry, key rings, key holders, key chains, necklaces, bracelets, earrings, brooches and rings, articles made of precious metal or coated therewith, containers adapted to carry the aforesaid goods, parts and fittings for all the aforesaid goods, articles made wholly or principally of leather or of imitation leather and goods made of these materials, trunks and travelling bags, luggage, holdalls, handbags, key-cases, wallets, purses, briefcases, belts, carriers for clothing in the nature of luggage, attache cases, checkbook holders, passport holders, credit card holders, umbrellas, parasols, walking sticks, textiles and textile goods, bed and table covers, games and playthings, gymnastic and sporting articles, all the aforesaid retail services provided via retail shop outlets, mail order or online via the Internet or other interactive electronic platforms. information, advisory and consultancy services relating to all of the aforesaid services.

6. Opposer and its LYLE & SCOTT brand have become synonymous with quality and style worldwide. Over the past decades, Opposer has developed a reputation as a high quality brand with a 140 year history in the design and manufacture of authentic apparel, handled with the well honed skills of generations of fine craftsmen and women.
7. Opposer's distinctive and famous LYLE & SCOTT trademark has been extensively used, advertised and promoted throughout the United States since as early as the aforementioned dates on, or in connection with, the goods covered by the referenced registrations and others. As a result of such long term and widespread use and promotion, such marks have developed valuable goodwill, substantial recognition by the relevant public as an indication of origin of the goods so identified in Opposer, all prior to the filing date of the application herein opposed.

8. Opposer has priority based on its issued and incontestable registrations and by virtue of having adopted and used its LYLE & SCOTT trademark for many years prior to Applicant's filing of its herein opposed application or any use of the marks it may have made, if any.
9. The mark herein opposed is likely to cause confusion, mistake or to deceive relevant prospective purchasers because of the public association attaching to Opposer's LYLE & SCOTT trademark as applied to its various items of apparel, due to the similarities in appearance, meaning and sound.
10. Concurrent use of the mark herein opposed with Opposer's marks is, for all the foregoing reasons, likely to cause confusion to the public. The application herein opposed should therefore be refused under section 2(d) of the Lanham Act.
11. The use and registration of the mark herein opposed dilutes, and is likely to continue diluting, the distinctive quality of Opposer's famous mark.
12. If Applicant is permitted to use and register LYONSCOTT, it would dilute the distinctiveness of Opposer's famous LYLE & SCOTT mark, lessening its capacity to identify and distinguish the goods and services of Opposer from those of others. The application herein opposed should therefore be refused under sections 13(a) and 43(c) of the Lanham Act.
13. If Applicant is granted registration for the mark herein opposed, it would thereby obtain at least a *prima facie* exclusive right to use of the mark for the subject goods in class 25. Such registration also would put a cloud over Opposer's right to register and use its LYLE & SCOTT trademark in the United States and would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays that this opposition be granted; that Application Serial No. 86241729 be denied and refused.

The filing fee for this Notice of Opposition has been charged to Deposit Account No. 23-2185.

Respectfully submitted,

BLANK ROME LLP

Date: October 22, 2014

By:           /sbf/            
Susan B. Flohr, Esq.  
600 New Hampshire Ave., N.W.  
Washington, D.C. 20037  
Phone: (202) 772-5870  
Attorneys for Opposer  
[flohr@blankrome.com](mailto:flohr@blankrome.com)

