

ESTTA Tracking number: **ESTTA634661**

Filing date: **10/23/2014**

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

Proceeding	91218997
Party	Plaintiff Lyle & Scott Limited
Correspondence Address	Susan B. Flohr Blank Rome LLP 600 New Hampshire Avenue NW Washington, DC 20006 UNITED STATES trademarks@blankrome.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Susan B. Flohr
Filer's e-mail	trademarks@blankrome.com
Signature	/sbf/
Date	10/23/2014
Attachments	Motion to Amend and Amended Notice of Opposition.pdf(106231 bytes )







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 trademark in commerce for over 75 years.
5. Opposer is the owner of and relies upon its valid Reg. No. 4103589 for the mark under section 66A, dated February 28, 2012, which covers the following goods and services, and in particular the goods covered by class 25:

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.

A current printout showing status and title of such registration from the USPTO's TESS is attached hereto as Exhibit A.

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 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 and other items of apparel. As a result of such long term and widespread use and promotion, such

mark has developed valuable goodwill, and substantial recognition by the relevant public as an indication of origin of the goods so identified in Opposer, prior to the filing date of the application herein opposed.

8. Opposer has priority based on its issued registration 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 mark it may have made of such mark, 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 mark 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 23, 2014

By:           /sbf/            
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**EXHIBIT A**

**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Thu Oct 23 03:20:54 EDT 2014

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# LYLE & SCOTT

**Word Mark** LYLE & SCOTT**Goods and Services**

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

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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

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 79086417

**Filing Date** April 15, 2010

**Current Basis** 66A

**Original Filing Basis** 66A

**Published for Opposition** December 13, 2011

**Registration Number** 4103589

**International Registration Number** 1048570

**Registration Date** February 28, 2012

**Owner** (REGISTRANT) LYLE & SCOTT LIMITED LIMITED COMPANY UNITED KINGDOM Unit 3, 1st Fl, Ashted Lock, Dartmouth Middleway, Aston Science Park Birmingham UNITED KINGDOM B7 4AZ

**Attorney of Record** Jennifer Fraser

**Priority Date** October 19, 2009

**Prior Registrations** 1202089;1765979

**Type of Mark** TRADEMARK. SERVICE MARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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