

ESTTA Tracking number: **ESTTA681961**

Filing date: **07/06/2015**

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	CDC Distributors, Inc.
Granted to Date of previous extension	07/08/2015
Address	10511 Medallion Drive Cincinnati, OH 45241 UNITED STATES
Attorney information	Kathryn E. Smith Wood Herron & Evans LLP 441 Vine Street 2700 Carew Tower Cincinnati, OH 45202 UNITED STATES ksmith@whe-law.com Phone:(513) 241-2324

Applicant Information

Application No	86274596	Publication date	03/10/2015
Opposition Filing Date	07/06/2015	Opposition Period Ends	07/08/2015
Applicant	AWI Licensing Company 1105 North Market Street, Suite 1300 Wilmington, DE 19801 UNITED STATES		

Goods/Services Affected by Opposition

Class 019. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Laminate flooring
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3945960	Application Date	06/03/2009
Registration Date	04/12/2011	Foreign Priority Date	NONE
Word Mark	TIMELESS DESIGNS		

Design Mark	TIMELESS DESIGNS
Description of Mark	NONE
Goods/Services	Class 019. First use: First Use: 2009/10/01 First Use In Commerce: 2009/10/01 Flooring products, namely, laminate flooring, hardwood flooring, solid and engineered hardwood flooring, tile flooring, namely, luxury vinyl tile; sustainable flooring, namely, bamboo flooring Class 027. First use: First Use: 2010/11/01 First Use In Commerce: 2010/11/01 Carpeting

U.S. Registration No.	4215506	Application Date	12/16/2011
Registration Date	09/25/2012	Foreign Priority Date	NONE

Word Mark	TIMELESS DESIGNS
Design Mark	TIMELESS DESIGNS
Description of Mark	NONE
Goods/Services	Class 019. First use: First Use: 2012/04/01 First Use In Commerce: 2012/04/01 Underlay for laminate flooring Class 027. First use: First Use: 2012/04/01 First Use In Commerce: 2012/04/01 Underlay for carpets

Attachments	77981135#TMSN.png(bytes) 85497441#TMSN.png(bytes) Notice of Opposition_TIMELESS NATURALS.pdf(228895 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	/Kathryn E. Smith/
Name	Kathryn E. Smith
Date	07/06/2015

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

<u>In re Application Serial No. 86/274,596</u>)	Opposition No. _____
CDC Distributors, Inc.)	
)	Mark: TIMELESS NATURALS
Opposer,)	
)	
v.)	Published for Opposition:
)	March 10, 2015
AWI Licensing Company)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer, CDC Distributors, Inc. (hereinafter “CDC”), is an Ohio corporation, located and doing business at 10511 Medallion Drive, Cincinnati, Ohio 45241.

Opposer believes that it will be damaged by registration of the mark **TIMELESS NATURALS** shown in Application Serial No. 86/274,596, and hereby opposes the same, and opposes registration for the goods set forth therein, namely:

Class 19: Laminate flooring.

The subject application (“Application”) was filed by AWI Licensing Company (“Applicant”) on May 7, 2014 under Section 1(b) of the Trademark Act, and published in the Official Gazette of March 10, 2015.

As grounds for the opposition, it is alleged that:

1. CDC is the owner of the following U.S. Trademark Registrations:
 - **TIMELESS DESIGNS**, U.S. Registration No. 3,945,960 covering: “Flooring products, namely, laminate flooring, hardwood flooring, solid and engineered hardwood flooring, tile flooring, namely, luxury vinyl tile; sustainable flooring, namely, bamboo flooring,” in Class 19; and “Carpeting,” in Class 27; and
 - **TIMELESS DESIGNS**, U.S. Registration No. 4,215,506 covering: “Underlay for laminate flooring,” in Class 19; and “Underlay for carpets,” in Class 27.

(hereinafter “CDC’s Marks” or the “CDC Marks”). A copy of each of the registrations is attached as

Exhibit A.

2. CDC’s Marks are distinctive and serve as valid source indicators with respect to the goods offered by CDC under the marks.

3. CDC began using the **TIMELESS DESIGNS** mark as early as 2009, and since then has made a continuous, substantial, and ongoing investment in marketing and promoting the CDC Marks to the public in a variety of media.

4. CDC has used, advertised, promoted, and offered for sale goods in association with its CDC Marks, with the result that CDC’s consumers and the general public have come to know and recognize the CDC Marks owned by CDC and to associate the **TIMELESS DESIGNS** mark with CDC and its goods.

5. Upon information and belief, Applicant is the owner of U.S. Trademark Application Serial No. 86/274,596 for the mark **TIMELESS NATURALS** for goods described in the application as:

Class 19: Laminate flooring

6. Upon information and belief, Applicant is a Delaware Corporation with an address of 1105 North Market Street, Suite 1300, Wilmington, Delaware 19801.

7. Applicant filed Application Serial No. 86/274,596 under Section 1(b) of the Trademark Act.

8. Applicant is not entitled to use or register as a trademark the mark **TIMELESS NATURALS** for which it seeks registration in Application Serial No. 86/274,596, either on May 7, 2014, the date of filing of said application, or on March 10, 2015, the date of publication thereof in the Official Gazette.

9. Applicant's goods, as described in the subject Application, are identical to and/or closely related to the goods offered by CDC under its mark **TIMELESS DESIGNS** and are likely to be promoted to the same class of consumers, and will be available through the same or similar channels of trade.

10. Applicant's mark **TIMELESS NATURALS** is confusingly similar to CDC's Marks in appearance, sound, meaning, connotation, and commercial impression.

11. Applicant's mark **TIMELESS NATURALS** is intended to be used in connection with goods that are either the same as or directly competitive with the goods covered by CDC's Marks.

12. The mark Applicant seeks to register, **TIMELESS NATURALS**, so resembles CDC's Marks, as to be likely, when applied to the goods of Applicant, to cause confusion or mistake or to deceive persons by creating the erroneous impression that Applicant's goods originate with or come from Opposer, or are authorized, licensed, endorsed, sponsored by, or are connected in some way with Opposer, and therefore, the registration thereof by Applicant would be injurious to Opposer, and should be barred under 15 U.S.C. §1052(d).

13. If Applicant is permitted to register the **TIMELESS NATURALS** mark for the goods specified in the Application herein opposed, such registration would result in confusion in the trade by reason of the similarity between Applicant's **TIMELESS NATURALS** mark and the **TIMELESS**

DESIGNS mark of Opposer, thereby damaging and injuring Opposer and damaging the reputation which Opposer has established for the goods sold in association with its CDC Marks.

14. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a *prima facie* right to the use of the mark. Such registration would be a further source of damage to Opposer.

15. Applicant's adoption and use of the mark **TIMELESS NATURALS** is without the license or permission of Opposer.

16. For all of the above reasons, use of the mark **TIMELESS NATURALS** by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the goods offered under the mark **TIMELESS NATURALS** emanate from or are otherwise sponsored or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

17. By reason of the foregoing, Opposer will be damaged by registration of the **TIMELESS NATURALS** mark to Applicant.

18. The opposition fee in the amount of \$300.00 is filed herewith. The Commissioner is authorized to charge any underpayment to Deposit Account No. 23-3000 in case of any deficiency.

WHEREFORE, Opposer prays that said Application Serial No. 86/274,596 be rejected; that registration of the mark **TIMELESS NATURALS** as a trademark to Applicant be refused and denied; and that this opposition be sustained in Opposer's favor.

* * * * *

Opposer requests such other and further relief as the Board may deem just and proper.

Date: July 6, 2015

Respectfully submitted,
WOOD HERRON & EVANS LLP



Kathryn E. Smith
Attorney for Opposer, CDC Distributors, Inc.

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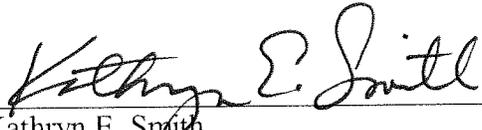
CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Notice of Opposition has been served upon the following by regular U.S. mail this 6th day of July, 2015:

AWI Licensing Company
1105 North Market Street
Suite 1300
Wilmington, Delaware 19801

and

Amy M. Fernandez, Esq.
2500 Columbia Ave
Lancaster, Pennsylvania 17603-4117



Kathryn E. Smith
Attorney for Opposer, CDC Distributors, Inc.
Email: ksmith@whe-law.com

United States of America

United States Patent and Trademark Office

TIMELESS DESIGNS

Reg. No. 3,945,960

Registered Apr. 12, 2011

Int. Cls.: 19 and 27

TRADEMARK

PRINCIPAL REGISTER

CDC DISTRIBUTORS, INC. (OHIO CORPORATION)
10511 MEDALLION DRIVE
CINCINNATI, OH 45241

FOR: FLOORING PRODUCTS, NAMELY, LAMINATE FLOORING, HARDWOOD FLOORING, SOLID AND ENGINEERED HARDWOOD FLOORING, TILE FLOORING, NAMELY, LUXURY VINYL TILE, SUSTAINABLE FLOORING, NAMELY, BAMBOO FLOORING, IN CLASS 19 (U.S. CLS. 1, 12, 33 AND 50).

FIRST USE 10-1-2009; IN COMMERCE 10-1-2009.

FOR: CARPETING, IN CLASS 27 (U.S. CLS. 19, 20, 37, 42 AND 50).

FIRST USE 11-1-2010; IN COMMERCE 11-1-2010.

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

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "DESIGNS", APART FROM THE MARK AS SHOWN.

SN 77-981,135, FILED 6-3-2009.

BRIAN NEVILLE, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

United States of America
United States Patent and Trademark Office

TIMELESS DESIGNS

Reg. No. 4,215,506

Registered Sep. 25, 2012

Int. Cls.: 19 and 27

TRADEMARK

PRINCIPAL REGISTER

CDC DISTRIBUTORS, INC. (OHIO CORPORATION)
10511 MEDALLION DRIVE
CINCINNATI, OH 45241

FOR: UNDERLAY FOR LAMINATE FLOORING, IN CLASS 19 (U.S. CLS. 1, 12, 53 AND 50)
FIRST USE 4-1-2012; IN COMMERCE 4-1-2012.

FOR: UNDERLAY FOR CARPETS, IN CLASS 27 (U.S. CLS. 19, 20, 37, 42 AND 50).
FIRST USE 4-1-2012; IN COMMERCE 4-1-2012.

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

OWNER OF U.S. REG. NO. 3,945,960.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "DESIGNS", APART FROM THE MARK AS SHOWN.

SN 85-497,441, FILED 12-16-2011.

RENEE MCCRAY, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office