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

Proceeding	91223512
Party	Defendant ATMOS NATION L.L.C.
Correspondence Address	DIVYA KHULLAR USAPATENTS.COM/ KHULLAR P.A. 4786 W COMMERCIAL BLVD TAMARAC, FL 33319-2878  dkhullar@usapatents.com;notices@khullar
Submission	Answer
Filer's Name	Divya Khullar
Filer's e-mail	dkhullar@usapatents.com, notices@khullarlaw.com, assistant@usapatents.com
Signature	s/Divya Khullar/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

**ABG COLLECTIVE LLC,**  
**Opposer,**

**Vs.**

**ATMOS NATION LLC,**  
**Applicant**

Opposition No. 91223512  
In re Serial No. 86/459,048  
Mark: AIRWALK  
Published: April 28, 2015

**APPLICANT’S ANSWER AND AFFIRMATIVE DEFENSES TO OPPOSER’S NOTICE**  
**OF OPPOSITION**

To,  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

Applicant, ATMOS NATION LLC, (hereinafter “ATMOS”) by and through the undersigned counsel files answers and arguments, to the Notice of Opposition filed by ABG COLLECTIVE, LLC (hereinafter “ABG”) against application for AIRWALK, Serial No. 86/459,048 filed November 19, 2014, and published in the Official Gazette of the United States Patent and Trademark Office on April 28, 2015, and states the following:

1. As to the allegations in paragraph 1 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.
2. As to the allegations in paragraph 2 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.
3. As to the allegations in paragraph 3 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

4. As to the allegations in paragraph 4 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

5. As to the allegations in paragraph 5 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

6. As to the allegations in paragraph 6 of the Notice of Opposition, Applicant admits the allegations thereof.

7. As to the allegations in paragraph 7 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

8. As to the allegations in paragraph 8 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

9. As to the allegations in paragraph 9 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

**COUNT I**  
**“THERE IS A LIKELIHOOD OF CONFUSION WITH OPPOSER’S MARK”**

10. As per paragraph 10 of the Notice of Opposition, Applicant reasserts paragraphs 1-9 of this Answer.

11. As to the allegations in paragraph 11 of the Notice of Opposition, Applicant admits the allegations thereof.

12. As to the allegations in paragraph 12 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

13. As to the allegations in paragraph 13 of the Notice of Opposition, Applicant denies each and every allegation herein and demands that Opposer provide strict proof in support of the allegations.

14. As to the allegations in paragraph 14 of the Notice of Opposition, Applicant denies each and every allegation herein and demands that Opposer provide strict proof in support of the allegations.

**COUNT II**  
**“THE APPLICATION DILUTES BY BLURRING OPPOSER’S MARK”**

15. As per paragraph 15 of the Notice of Opposition, Applicant reasserts paragraphs 1-14 of this Answer.

16. As to the allegations in paragraph 16 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

17. As to the allegations in paragraph 17 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

18. As to the allegations in paragraph 18 of the Notice of Opposition, Applicant denies each and every allegation herein and demands that Opposer provide strict proof in support of the allegations.

19. As to the allegations in paragraph 19 of the Notice of Opposition, Applicant denies each and every allegation herein and demands that Opposer provide strict proof supporting their allegations.

20. As to the allegations in paragraph 20 of the Notice of Opposition, Applicant denies each and every allegation herein and demands that Opposer provide strict proof supporting their allegations.

**COUNT III**  
**“THE APPLICATION DILUTES BY TARNISHMENT OPPOSER’S MARK”**

21. As per paragraph 21 of the Notice of Opposition, Applicant reasserts paragraphs 1-20 of this Answer.

22. As to the allegations in paragraph 22 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

23. As to the allegations in paragraph 23 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

24. As to the allegations in paragraph 24 of the Notice of Opposition, Applicant denies each and every allegation herein and demands that the Opposer provide strict proof supporting their allegations.

25. As to the allegations in paragraph 25 of the Notice of Opposition, Applicant does not have sufficient information or knowledge to either admit or deny.

26. As to the allegations in paragraph 26 of the Notice of Opposition, Applicant denies each and every allegation herein and demands that the Opposer provide strict proof supporting their allegations.

27. As to the allegations in paragraph 27 of the Notice of Opposition, Applicant denies each and every allegation herein and demands that the Opposer provide strict proof supporting their allegations.

## **AFFIRMATIVE DEFENSES**

### **I. INTRODUCTION**

1. The applicant, ATMOS, is a well-known provider of vaporizers and related accessories (herein after "Vaporizer Products").

2. ATMOS is in the business of designing, marketing, and selling portable vaporizers, e-cigarettes, and their accessories throughout the United States and the World under the brand name ATMOS RX®.

3. Vaporizers provide their users with a healthier way to inhale tobacco, eucalyptus, hops, chamomile, lavender, lemon, balm, sage, thyme, aromatherapy, dry herbs, and aromatic oils with a reduced negative impact on their health. Vaporizers break down substances into a vapor. Vaporization releases the essential, active elements of a substance, and virtually eliminates second hand smoke.

4. ATMOS is among the most prominent, best-selling, and innovative vaporizer companies in the United States and throughout the World. ATMOS have over forty registered Trademarks in US and some of these trademarks have been extended to other prominent economies around the world. ATMOS' intellectual property portfolio extends beyond just trademark to over thirty patents/applications and numerous copyrights.

5. ATMOS filed the mark AIR WALK (Application Serial No. 86/459,048) (the "Mark"), on November 19, 2014. The Mark was published in the Official Gazette of the United States Patent and Trademark Office on April 28, 2015.

6. The Application for the mark "AIR WALK" for "Electronic cigarettes; Electronic cigars; Electronic hookahs; Electronic smoking pipes; Mechanical electronic cigarettes;

Smokeless cigarette vaporizer pipe" in CLASS 34 based on an intent to use the mark in the United States.

7. ABG (the "Opposer") engage in the business of skater, bmx, and boards with expansion into, *inter alia*, footwear, sporting apparels.

## **II. ATMOS AND ABG ENGAGE IN UNRELATED COMMERCE.**

8. Applicant realleges paragraph 1-7 of applicant's arguments against the notice of opposition as paragraph 8 of this section.

9. Noncompetitive trademark infringements occur if the goods are so kindred that the maker of one might naturally be assumed to be the maker of the other. *Wells Fargo & Co. v. Wells Fargo Express Co.*, 358 F. Supp. 1065, 1088 (D. Nev. 1973). *Wells Fargo*, explaining the above further states that the kindred goods mean that the industrial or commercial picture would reasonably suggests the possible future expansion of the opposer's business to include the article in question, as such confusion of businesses. *Id.*

10. The Application for the mark "AIR WALK" for is in **CLASS 34**, while ABG holds no trademark in international Class 34 or any class that may be considered the natural scope of expansion. Hence, the applicant's goods are **UNRELATED** to and/or are **OUTSIDE** the natural zone of expansion of the Opposer's Goods.

11. The Applicant's Goods are advertised and sold worldwide via the Applicant's own on-line store and Third Party Websites. The Applicant's prospective products are substantially different to those provided by the ABG.

12. Additionally, the ABG clearly has no intention of expanding into the electronic vaporizer market, evident from their argument in the Notice of Opposition in which they specify their market aims towards those with an interest in extreme sports.

13. Moreover, ABG has clearly stated its intention to abandon any future interest in class 34 as shown in the opposer's argument in the Notice of Opposition. See Paragraph 26 "Applicant's proposed use and registration of AIRWALK in connection with electronic cigarettes, tobacco and nicotine products, and other paraphernalia such as vaporizers, electronic hookahs, and electronic pipes ... promotes goods that are inherently harmful and unhealthy, and as a result would contradict [opposer's business model]"

14. Thus, the opposer has no possibility of future expansion of the opposer's business to include the article in question.

15. In conclusion it is clear that ATMOS and ABG engage in unrelated commerce and ABG's lack of intention to expand in the business of vaporizers.

### **III. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE APPLICANT'S MARK AND THE OPPOSER'S MARK.**

16. Applicant realleges paragraph 1-15 of applicant's arguments against the notice of opposition as paragraph 16 of this section.

17. ABG has failed to present any evidence of confusion or any legible arguments that the mark may cause confusion to a consumer viewing the mark. Simply stating likelihood of confusion is NOT a legal basis for opposition.

18. Nevertheless, the Applicants presents the following arguments that support Applicant's right to the mark and that no confusion exists.

19. "To prove likelihood of confusion, [opposer] must show that consumers viewing the mark would probably assume the product or service it represents is associated with the source of a different product or service identified by a similar mark." *Checkpoint Sys. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 276 (3d Cir. 2001).

**A. THE APPLICANT'S GOODS IS NOT RELATED TO OPPOSER'S GOODS, THUS NO PASSING OFF.**

20. “A factor to consider in assessing the likelihood of confusion is the relatedness of the parties’ goods.” *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1423 (S.D. Ohio 1990).

21. “The [opposer’s] rights may extend ... to “related” products if the owner mark is reasonably be thought by the buying public to come from the same source.”(emphasis added). *Carnival Brand Seafood Co. v. Carnival Brands, Inc.*, 187 F.3d 1307 (11th Cir. 1999).

22. “[Passing] off occurs when a defendant attempts to bring about consumer confusion by causing consumers to purchase its products under the mistaken belief that they are in fact purchasing the plaintiff’s goods.” *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1423 (S.D. Ohio 1990). “Passing off involves directly competing goods.” *Worthington Foods, Inc. v. Kellogg Co.*, 732 F. Supp. 1417, 1423 (S.D. Ohio 1990).

23. ATMOS is in the business of selling portable vaporizer pens for the purposes of using tobacco products and other dry herbs. (Class 034- “Smoking” per the United States Patent and Trademark Office).

24. ABG, through their brand AIRWALK, sells clothing, footwear, and other sports apparel. (Class 025- “Clothing” per the United States Patent and Trademark Office).

25. Moreover, ABG has no intention to enter the market of electronic vaporizers. ABG is currently in the market of selling sports apparel. Applicant’s products involve electronic vaporizers, have absolutely no connection to footwear.

26. Courts have held that even if two products fall within the same general classification but serve different purpose, the trademark of one may not be confused by the other.

27. “Although both gasoline and motor oil are petroleum products and fall within the same general classification under the United States Patent Office regulations, the fact remains that they are different products having different uses and serving different purposes.” *Crown Cent. Petroleum Corp. v. Standard Oil Co.*, 135 So. 2d 26, 36-37 (Fla. 1st DCA 1961) (dissenting that while both Plaintiff and Defendant shared the same trademark name of “Crown”, one company produced gasoline and another produced motor oil—these both have different uses and different purposes.”)

28. A reasonable consumer engaged in the commerce of buying footwear will not confuse the mark with a vaporizer. Thus for the reasons above, there is no likelihood or prospect of confusion between ATMOS’s brand AIRWALK and ABG’s brand AIRWALK and the two may co-exist without confusion.

#### **IV. ABG’S MARK CANNOT BE DILUTED BECAUSE ABG IS NOT A FAMOUS MARK AND ‘AIRWALK’ IS A DESCRIPTIVE TERM.**

29. Applicant realleges paragraph 1-28 of applicant’s arguments against the notice of opposition as paragraph 29 of this section.

30. Dilution by blurring is association arising from the similarity between a mark and a famous mark that impairs the distinctiveness of the famous mark. *See* Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730. Dilution by blurring occurs when consumers mistakenly associate a famous mark with goods and services of a junior mark, thereby diluting the power of the senior mark to identify and distinguish associated goods .... *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 955 F. Supp. 605, 616 (E.D. Va. 1997) (citing *Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989).

31. According to the amended statute determining whether a mark is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

- (i) “The degree of similarity between the mark ... and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.”

32. See Trademark Dilution Revision Act of 2006, Pub. L. No. 109-312, 120 Stat. 1730.

33. But, before the Appeal board proceeds on these factors, the appeal board shall determine if ABG’s AIR WALK mark qualifies as a **famous mark**.

**A. THE ABG’S MARK IS NOT FAMOUS BECAUSE SIMILAR MARK IS IN USE BY A THIRD PARTY.**

34. Applicant realleges paragraph 1-33 of applicant’s arguments against the notice of opposition as paragraph 34 of this section.

35. Courts have held that a third-party’s use of [a] mark seriously undermines any acquired distinctiveness. *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117.

36. A third-party’s use of a mark is relevant in determining fame and distinctiveness; the mark must be in substantially exclusive use. If a mark is in widespread use, it is not famous

for the goods and services of a business. *Times Mirror Magazines Inc. v. Las Vegas Sports News*, 212 F.3d 157.

37. This is especially so when an applicant can show that the third-party marks are in actual use, well-promoted, and recognized by consumers. *Hasbro, Inc. v. Clue Computing, Inc.*, 66 F. Supp. 2d 117. *See, e.g., Carnival Corp. v. SeaEscape Casino Cruises, Inc.*, 74 F. Supp. 2d 1261, 1271 (S.D. Fla. 1999)(“the word fun is used by many other businesses in the travel, gaming, and entertainment industries . . . cutting against Carnival's dilution claim”)

38. The following similar marks have been in use for decades in stream of commerce

A. The Word Mark-“AIRWALKERS”, Serial Number 73746711, has been in use since August 23, 1987.

B. The Word Mark “AIR WALKER”, Serial Number 74330625, has been in use since January 18, 1993.

C. The Word Mark “AIR WALKER”, Serial Number 77627865, has been in use since November 1, 1994.

39. Widespread use of the mark similar to “AIRWALK” by third-party companies seriously undermines fame of ABG’s mark. *See Sports Authority v. Abercrombie & Fitch, Inc.*, 965 F. Supp. 925, 941 (E.D. Mich. 1997)(third-party use of “authority,” whether or not in the relevant market, diminishes any distinctive or famous aspects of mark rendering it “not so famous as to deserve protection” under the FTDA). *See also Star Mkts., Ltd. v. Texaco, Inc.*, 950 F. Supp. 1030 (D. Haw. 1996) (noting multiple uses of “Star” and “Star Markets” in food industry and unrelated industries)

40. Thus, ABG fails the test of a Famous marks thus, lacks the protection under the Federal Dilution Statute.

**B. THE ABG'S MARK IS NOT FAMOUS BECAUSE THE MARK LAST LOST IT'S RECOGNITION.**

41. Applicant realleges paragraph 1-40 of applicant's arguments against the notice of opposition as paragraph 41 of this section.

42. There is published literature that documents the rise and "fall" of ABG's Airwalk mark. *See, e.g.,* Malcolm Gladwell, *The Tipping Point*, ch. 6 (2000). Malcolm Gladwell is a national, best-selling author and a writer for *The New Yorker*.

43. Specifically in chapter 6 of the book, Gladwell discusses the decline of Airwalk shoes. Gladwell specifically state that the cost-cutting measures by ABG caused the decline of AIRWALK. Additionally, ABG provided their distributors with only a single line of shoes.

44. In light of the lost luster, ABG's AIRWALK mark cannot claim consumer recognition.

**C. THE ABG'S MARK IS NOT FAMOUS BECAUSE IT LACKS DISTINCTIVENESS**

45. Applicant realleges paragraph 1-44 of applicant's arguments against the notice of opposition as paragraph 45 of this section.

46. In *Visa Int'l Serv. Ass'n v. JSL Corp.*, 610 F.3d 1088, 1091, it was held that "[w]hen a trademark is also a word with a dictionary definition, it is "difficult to show that the trademark holder's use of the word is sufficiently distinctive to deserve anti-dilution protection because such a word is likely to be descriptive or suggestive of an essential attribute of the trademarked good."

47. "In making a determination of whether a mark is generic, courts consider such evidence as dictionary definitions" *Gaylord Entm't Co. v. Gilmore Entm't Grp.*, 187 F. Supp. 2d 926, 930 (M.D. Tenn. 2001).

48. Performing a search on <http://www.dictionary.com>, the word Air Walk has a definition as “a passageway connecting two structures well above the ground, usually made of transparent material.”

49. In *Visa*, the court rejected a dilution claim by Trek Bicycle Corporation for its "Trek" mark in part because it played heavily off the dictionary meaning of "trek," suggesting that the bicycles were designed for long or arduous journeys.”

50. The dictionary definition above defines the word “Air Walk” as a passageway connecting two structures, well above the ground, implying that the purpose is to walk over it (while you are technically in the air). Normally, when people walk they use shoes. Under the reasoning of *Visa*, ABG’s AIRWALK brand plays heavily off “walking in the air” which is what the definition of “air walk” essentially is on <http://www.dictionary.com>.

51. The use of generic terms does not identify and distinguish the product of only one seller. *Gaylord Entm't Co. v. Gilmore Entm't Grp.*, 187 F. Supp. 2d 926, 930 (M.D. Tenn. 2001)

52. The words “Air” and “Walk” are two terms of generic nature—“Walk” is what the public would associate with footwear. Therefore, the word “Walk” relates to the object to which AIRWALK applies—sneakers.

53. The original creator of a product or the first user of the term cannot acquire exclusivity to use the term. *Id.*

54. “Air” has been used by a large number of world-wide famous companies. For example, “Air Jordan”, “Nike Air”. A consumer associates AIR with light weight. The Apple MacBook “Air” is so-called due to its light weight. Nike Air Max shoes are so-called because of their light weight and proficiency for sports.

55. Therefore, the word “AIRWALK” or “AIR WALK” can be assumed to mean shoes that are light as air, and is not sufficiently distinct nor can the word acquire a secondary meaning as ABG argues.

56. Generic names are regarded by the laws of the United States as “free for all to use.” Generic words are in the public domain. *Id.*

57. Generic words are words that name the species or object to which the mark applies. Generic words are totally without distinctiveness. “They are ineligible for protection as marks because to give them protection would be to deprive competitors of the right to refer to their products by name.” *Id.*

58. Accordingly, ABG’s argument that ATMOS’s AIRWALK brand for electronic vaporizers dilutes by blurring ABG’s brand is meritless.

#### **V. ABG FAILS TO ESTABLISH DILUTION BY TARNISHMENT**

59. Applicant realleges paragraph 1-58 of applicant’s arguments against the notice of opposition as paragraph 59 of this section.

60. Dilution by tarnishment is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark. 15 U.S.C. § 125.

61. ABG, in their Notice of Opposition, claims “the target customers for the AIRWALK brand are children, young adults, and youthful people who support board culture and value an active, healthy lifestyle.”

62. ABG also notes “Opposer’s AIRWALK mark is closely associated with board sports, active lifestyles, and peak athletic performance, as evidence by its sponsorship of many professional skaters over the years, including world-renowned athlete Tony Hawk.”

63. ATMOS'S products are aimed solely at persons over the age of 18 who engage in the activity of smoking and ATMOS is NOT associate with athletic footwear, apparel, accessories, and sporting goods and equipment as well as sporting events.

64. ABG's claim that ATMOS products are associated with illegal drugs is wholly unfounded.

65. For the reasons listed above, there is no likelihood of confusion between ATMOS and ABG's use of the AIRWALK mark. Therefore, there can be no dilution by tarnishment, or degradation of ABG's AIRWALK mark. The two marks promote completely different products. Thus, the trademarks can co-exist in the same class with no confusion.

**WHEREFORE,** Applicant requests that ABG's Notice of Opposition be dismissed and that ATMOS'S Application for AIRWALK, Serial No. 86/459,048, be considered for allowance for grant.

Respectfully Yours,



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Divya Khullar, Esq.  
Florida Bar No. 0101116  
**USAPatents.com**  
4786 W. Commercial Blvd.  
Tamarac, Florida 33319  
Phone: (954) 642-2308  
Fax: (754) 999-7057  
assistant@usapatents.com