

ESTTA Tracking number: **ESTTA732910**

Filing date: **03/11/2016**

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
Granted to Date of previous extension	03/16/2016
Address	200 Domain Drive Stratham, NH 03885 UNITED STATES
Attorney information	Larry C. Jones Alston & Bird LLP 101 S. Tryon Street Suite 4000 Charlotte, NC 28280-4000 UNITED STATES Larry.Jones@Alston.com Phone:704.444.1019

Applicant Information

Application No	86675780	Publication date	11/17/2015
Opposition Filing Date	03/11/2016	Opposition Period Ends	03/16/2016
Applicant	Helwig, David P.O Box 14554 San Luis Obispo, CA 93406 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 1990/01/01 First Use In Commerce: 2010/01/01 All goods and services in the class are opposed, namely: On-line retail store services featuring t-shirts, CD's, tote bags, necklaces, bracelets, hats, coffee mugs and stickers
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by blurring	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	NONE

		Date	
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
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Registration Date	08/28/1990	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
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	NONE

		Date	
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
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Design Mark	
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Description of Mark	NONE
Goods/Services	<p>Class 006. First use: First Use: 2004/08/31 First Use In Commerce: 2004/08/31 [Metal fuel bottles, sold empty; metalkey fobs]</p> <p>Class 018. First use: First Use: 1987/09/30 First Use In Commerce: 1987/09/30 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>

Attachments	<p>73701653#TMSN.png(bytes) 73721905#TMSN.png(bytes) 73824199#TMSN.png(bytes) 73778475#TMSN.png(bytes) 73831211#TMSN.png(bytes) 74083463#TMSN.png(bytes) 75504014#TMSN.png(bytes) 76381869#TMSN.png(bytes) 78667488#TMSN.png(bytes) TBL Helwig NoO.PDF(210990 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	03/11/2016

“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 clothing, jewelry, bags, and retail clothing, footwear and outerwear store services, which retail store services are classified in International Class 35. The availability of such goods and services 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, retail store services.

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	Leather goods, namely, credit

U.S. Registration No.	Int'l Class	Original Goods/Services	Current Goods/Services
		fobs, luggage tags, credit card cases, wallets, portfolio type briefcases, duffle bags, backpacks and briefcases	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 repellant for shoes	Shoe care products, namely water repellant 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 Timberland'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. On June 26, 2015, Applicant filed the application at issue to register the mark shown below (the "Circumscribed Tree Mark").



7. More particularly by the opposed application, Applicant seeks to register the Circumscribed Tree Mark for use in conjunction with, inter alia, the following services in International Class 35: On-line retail store services featuring t-shirts, CD's, tote bags, necklaces, bracelets, hats, coffee mugs and stickers.

8. The Timberland Tree Mark and the Circumscribed Tree Mark are shown below:



9. Each party's mark is generally circular in shape and includes a single tree as its most prominent element.

10. Thus, the Circumscribed Tree Mark is quite similar visually to the Timberland Tree Mark. This characteristic contributes significantly to a likelihood of confusion. Moreover, the on-line retail services listed in the subject application and the particular goods to be sold via those retail services are the same as, or are closely related to, the retail services and goods in conjunction with 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 Circumscribed Tree Mark, when used on or in connection with the retail services listed in the opposed application, is likely to deceive or cause confusion or mistake as to the source or sponsorship of Applicant's services in relation to Timberland.

11. 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 Circumscribed Tree Mark as an on-line retail service mark (if any such usage has been made) or the filing date of the opposed application.

12. Hence, the application to register the Circumscribed Tree Mark in International Class 35 should be refused on the basis that the usage of that mark in conjunction with the services listed in the subject application: (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

13. Application No. 86/675,780 for registration of the Circumscribed Tree Mark should be refused under either or both 15 U.S.C. § 1052(d) and 15 U.S.C. § 1063(a).

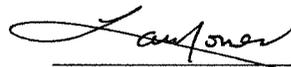
14. Accordingly, Timberland asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for the Circumscribed Tree Mark to Applicant in International Class 35 as sought in Service Mark Application Serial No. 86/675,780.

WHEREFORE, Timberland prays that said application for registration of the Circumscribed Tree Mark in International Class 35 be rejected, that no registration in International Class 35 be issued thereon to Applicant, and that this opposition 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: March 11, 2016

Respectfully submitted,

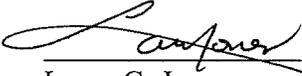


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CERTIFICATE OF SERVICE

I hereby certify that the foregoing "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 11th day of March, 2016, addressed to Applicant as follows:

Mr. David Helwig
P.O. Box 14554
San Luis Obispo, CA 93406



Larry C. Jones