

ESTTA Tracking number: **ESTTA768243**

Filing date: **09/01/2016**

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	Kiss Catalog, Ltd.
Granted to Date of previous extension	09/07/2016
Address	c/o Joseph Young Associates, Ltd. 18 Hook Mountain Road, Suite 203 Pine Brook, NJ 07058 UNITED STATES

Attorney information	Peter J. Vranum Gordon, Herlands & Randolph LLP 355 Lexington Avenue New York, NY 10017 UNITED STATES pvranum@gordonherlands.com Phone:2129861200
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**Applicant Information**

Application No	86849320	Publication date	05/10/2016
Opposition Filing Date	09/01/2016	Opposition Period Ends	09/07/2016
Applicant	Legacy Sustainable Development, Inc. 21 Vista Valle Circle Lamy, NM 87540 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Arranging and conducting of concerts; Entertainment, namely, live music concerts
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration	1155932	Application Date	10/24/1979
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No.			
Registration Date	05/26/1981	Foreign Priority Date	NONE
Word Mark	KISS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1974/02/08 First Use In Commerce: 1974/02/08 Musical Entertainment Services Renderedby a Group		

U.S. Registration No.	4009074	Application Date	12/23/2010
Registration Date	08/09/2011	Foreign Priority Date	NONE
Word Mark	KISS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1974/02/18 First Use In Commerce: 1974/02/18 sound recordings featuring music; soundand video recordings featuring music and musical performances		

Attachments	85205034#TMSN.png( bytes ) kisstheearth.opp.320.pdf(369871 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	/peter j. vranum/
Name	Peter J. Vranum
Date	09/01/2016

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

-----X	)	
KISS CATALOG, LTD.,	)	
	)	
Opposer,	)	
	)	Opposition
v.	)	
-----X	)	No. _____
LEGACY SUSTAINABLE	)	
DEVELOPMENT, INC.,	)	
	)	
Applicant.	)	
-----X	)	

Re: Trademark Application:  
Applicant: Legacy Sustainable Development, Inc., a New Mexico corporation  
Mark: KISS THE EARTH  
Serial No. 86849320  
Filed: December 15, 2016  
For: Arranging and conducting of concerts; Entertainment, namely, live music concerts  
Class: 41  
Published: May 10, 2016

NOTICE OF OPPOSITION

In the matter of an application for registration of the mark "KISS THE EARTH" Serial No. 86849320 for "Arranging and conducting of concerts; Entertainment, namely, live music concerts " (International Class 41), filed under Section 1B of the Trademark Act on December 15, 2015 by Legacy Sustainable Development, Inc., a New Mexico corporation with an address at 21 Vista Valle Circle, Lamy, New Mexico 87540 (hereinafter called "Applicant"), published May 10, 2016, Kiss Catalog, Ltd., a corporation organized under the laws of the State

of New York, having an address c/o Joseph Young Associates, Ltd., 18 Hook Mountain Road, Suite 203, Pine Brook, New Jersey 07058 (hereinafter called "Opposer"), believes that it would be damaged by such registration and hereby opposes the same.

The grounds for opposition, on information and belief, are as follows:

1. Opposer, Kiss Catalog, Ltd., is the owner of the intellectual property rights, including federal and common law trademark rights, pertaining to the world famous musical group KISS, and as such has been engaged in the production of musical entertainment services and in merchandising the term KISS and variations thereof, on various goods, including jewelry, comic books, toys, sound and video recordings featuring musical performances, and clothing and apparel items.

Opposer has also used the mark KISS and variations thereof in connection with services, including online retail services.

2. Opposer has used and presently uses the marks "KISS" and variations thereof in connection with the design, sale and distribution of the goods and services identified in paragraph 1.

3. Opposer is the owner of the following registrations: "KISS" (Registration No. 1,155,932 dated May 26, 1981); and "KISS" (Registration No. 4,009,074 dated August 9, 2011), which registrations are valid, subsisting and unrevoked. Copies of printouts from the USPTO database (TARR) showing the current status and title of such registrations are annexed hereto as Exhibit A.

4. Since prior to the date of filing of Application Serial No. 86849320, and prior to any purported date of first use or other date upon which Applicant can

rely, Opposer did use and has continuously used in interstate commerce the mark "KISS" and variations thereof in connection with the various products and services described in paragraph 1 herein extensively throughout the United States. By reason of such extensive use and promotion, Opposer has attained an enviable reputation for high standards of quality, and the mark KISS and variations thereof have become distinctive of and associated in the minds of the trade and purchasing public with the Opposer.

5. Both Applicant's mark and Opposer's mark contain the term "KISS." Applicant's mark is different only by the inclusion of the terms "THE EARTH" which do not serve to distinguish Applicant's mark. Because the two marks are nearly identical, both have a similar commercial impression. Furthermore, the services of the Applicant are related and/or identical to the various products and services of Opposer as described in paragraph 1 herein, and are likely to move within the same channels of trade and be purchased by the same class of purchaser. As such, Applicant's mark is likely, when used in association with the services of Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the services of Applicant emanate from, are offered for sale, or are sold by Opposer or under Opposer's approval, sponsorship or control, all to the great damage of Opposer.

6. Opposer believes that Applicant's selection of the mark KISS THE EARTH may take advantage of the nationwide reputation of Opposer and its mark KISS, and combination marks featuring the term KISS, and may take advantage of the goodwill of Opposer gained by extensive and persistent advertising and

expenditures of large sums of money therefore, and if continued in commerce, will be likely to confuse, mislead or deceive the trade and members of the public in suggesting to them that Applicant's mark identifies goods and/or services sold, sponsored or approved by Opposer or to suggest falsely a trade connection between Opposer and Applicant.

7. If specified services of Applicant are inferior in quality, there will be irreparable injury to Opposer's valuable goodwill and its registered marks. Furthermore, the use and registration of the mark KISS THE EARTH will dilute the distinctive character of Opposer's valuable registered trademarks, and combination marks featuring the term KISS.

8. Applicant's mark, KISS THE EARTH, falsely suggests a connection with Opposer in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). By reason thereof Opposer is likely to be harmed by a registration of the instant application for KISS THE EARTH.

WHEREFORE, Opposer, by and through its counsel, respectfully requests that the mark sought to be registered by Applicant be refused and that a Notice of Opposition be sustained.

Please recognize William B. Randolph and Peter J. Vranum of the firm of Gordon, Herlands & Randolph LLP, all members of the Bar of the State of New York, 355 Lexington Avenue, New York, New York 10017, as attorneys for Opposer.

Respectfully submitted,

GORDON, HERLANDS  
& RANDOLPH, LLP



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Peter J. Vranum, Esq.  
Attorneys for Opposer  
355 Lexington Avenue  
New York, New York 10017  
(212) 986-1200

CERTIFICATE OF SERVICE

I hereby certify that I caused a true copy of the foregoing Opposer's Notice of Opposition to be served by First Class mail, postage prepaid, on September 1, 2016, on:

Mark A. Niede, Esq.  
Henderson, Franklin, Starnes & Holt PA  
1715 Monroe Street  
Fort Myers, FL 33901

And by email [trademarks@henlaw.com](mailto:trademarks@henlaw.com)



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Peter J. Vranum

# **EXHIBIT A**



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# Typed Drawing

**Word Mark** KISS

**Goods and Services** IC 041. US 107. G & S: Musical Entertainment Services Rendered by a Group. FIRST USE: 19740208. FIRST USE IN COMMERCE: 19740208

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 73236538

**Filing Date** October 24, 1979

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** March 3, 1981

**Registration Number** 1155932

**Registration Date** May 26, 1981

**Owner** (REGISTRANT) Aucoin Management Inc. CORPORATION NEW YORK 645 Madison Ave. New York NEW YORK 10022

(LAST LISTED OWNER) KISS CATALOG, LTD CORPORATION BY ASSIGNMENT, BY MERGER NEW YORK C/O JOSEPH YOUNG ASSOCIATES, LTD. 18 HOOK MOUNTAIN ROAD, SUITE 203 PINE BROOK NEW JERSEY 07058

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** WILLIAM H. COX

**Prior Registrations** 1055765

**Type of Mark** SERVICE MARK

**Register** PRINCIPAL

**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110124.

**Renewal** 2ND RENEWAL 20110124

**Live/Dead Indicator** LIVE

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# KISS

**Word Mark** KISS

**Goods and Services** IC 009, US 021 023 026 036 038. G & S: sound recordings featuring music; sound and video recordings featuring music and musical performances. FIRST USE: 19740218. FIRST USE IN COMMERCE: 19740218

**Standard Characters Claimed**

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

**Serial Number** 85205034

**Filing Date** December 23, 2010

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** May 24, 2011

**Registration Number** 4009074

**Registration Date** August 9, 2011

**Owner** (REGISTRANT) Kiss Catalog, Ltd. CORPORATION NEW YORK c/o Joseph Young Associates, Ltd. 18 Hook Mountain Road, Suite 203 Pine Brook NEW JERSEY 07058

**Attorney of Record** William H. Cox

**Prior Registrations** 1055765;1155932;1894876;AND OTHERS

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead  
Indicator**      LIVE

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