

ESTTA Tracking number: **ESTTA777508**

Filing date: **10/18/2016**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Varsity Brands, LLC
Granted to Date of previous extension	10/19/2016
Address	6745 Lenox Center Court, Suite 300 Memphis, TN 38115 UNITED STATES

Name	Varsity Spirit Fashions & Supplies, LLC
Granted to Date of previous extension	10/19/2016
Address	6745 Lenox Center Court, Suite 300 Memphis, TN 38115 UNITED STATES

Name	Varsity Spirit, LLC
Granted to Date of previous extension	10/19/2016
Address	6745 Lenox Center Court, Suite 300 Memphis, TN 38115 UNITED STATES

Attorney information	Deborah K. Squiers / Ryan A. Ghiselli Cowan, Liebowitz & Latman, P.C. 114 West 47th Street New York, NY 10036 UNITED STATES dks@cll.com, ryg@cll.com, las@cll.com, trademark@cll.com Phone:2127909200
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Applicant Information

Application No	86845562	Publication date	06/21/2016
Opposition Filing Date	10/18/2016	Opposition Period Ends	10/19/2016
Applicant	HB Northway Limited Partnership Suite 200 Edgewater, MD 20814 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2013/12/00 First Use In Commerce: 2013/12/00
All goods and services in the class are opposed, namely: Housing services, namely, rental of student housing

Applicant Information

Application No	86845586	Publication date	06/21/2016
Opposition Filing Date	10/18/2016	Opposition Period Ends	
Applicant	HB Northway Limited Partnership Suite 200 Edgewater, MD 20814 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2013/12/00 First Use In Commerce: 2013/12/00
All goods and services in the class are opposed, namely: Housing services, namely, rental of student housing

Grounds for Opposition

Other	See attached pleading
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Attachments	Consolidated Notice of Opposition.pdf(82848 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	/Ryan A. Ghiselli/
Name	Ryan A. Ghiselli
Date	10/18/2016

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

In re Application Serial Nos. 86845562 and 86845586

Filed: December 10, 2015

For Marks: VARSITY ON CHARLES and V VARSITY ON CHARLES (Design)

Published in the Official Gazette: June 21, 2016

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 VARSITY SPIRIT, LLC, VARSITY)
 SPIRIT FASHIONS & SUPPLIES, LLC,)
 and VARSITY BRANDS, LLC)
)
 Opposers,)
)
 v.) Opposition No. _____
)
 HB NORTHWAY LIMITED)
 PARTNERSHIP)
)
 Applicant.)
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CONSOLIDATED NOTICE OF OPPOSITION

Opposers, Varsity Spirit, LLC, a Tennessee limited liability company, Varsity Spirit Fashions & Supplies, LLC, a Minnesota limited liability company, and Varsity Brands, LLC, a Delaware limited liability company, all having a business address at 6745 Lenox Center Court, Memphis, TN 38115 (“Opposers”), believe they will be damaged by and hereby oppose the registration of the mark VARSITY ON CHARLES (“Applicant’s VARSITY ON CHARLES Mark”) for “Housing services, namely, rental of student housing” in International Class 36 as shown in Application Serial No. 86845562 and of the mark V VARSITY ON CHARLES and



Design, as depicted here: (“Applicant’s V VARSITY ON CHARLES Mark”)

for “Housing services, namely, rental of student housing” in International Class 36 as shown in

Application Serial No. 86845586 (the “Applications”). The grounds for opposition are as follows:

1. Upon information and belief, Applicant HB Northway Limited Partnership is a Maryland limited partnership located at Suite 200, 2824 Solomons Island Road, Edgewater, Maryland 20814.

2. Opposers and other related companies, all of whom are in direct privity with one another (hereinafter referred to individually and collectively as the “Varsity Companies”), are engaged in the business of manufacturing and selling a wide variety of apparel, footwear and headwear, conducting sports competitions, games and training, offering online services including multiple interactive websites and social media platforms featuring entertainment, photos, videos and sports information, offering housing in connection with camps and competitions, and other related goods and services (“Opposers’ Goods and Services”), all of which bear the mark and/or trade name VARSITY, alone and /or with other words, designs or stylization (“Opposers’ VARSITY Marks”) and/or the mark “V,” alone or with other word, letter and/or design

elements, including, without limitation, in the following distinctive stylization:



(“Opposers’ V Marks”).

3. Prior to the filing date of the Applications and any claimed first use date, the Varsity Companies have used, and continue to use in commerce Opposers’ VARSITY and V Marks on or in connection with Opposers’ Goods and Services.

4. Prior to the filing date of the Applications and any claimed first use date, the Varsity Companies have promoted and advertised the sale and distribution of goods and services bearing

or offered in connection with Opposers' VARSITY and V Marks, including but not limited to Opposers' Goods and Services.

5. The Varsity Companies own the following trademark and service mark registrations and applications in the United States without limitation: U.S. Reg. Nos. 1575830; 4546436; 2357303; 4110341; 2526564; 3696209; 4403734; 3436493; 3842122; 3928856; 3782739; 3782740; 4607865; 4258636; 4451703; 4743867; 4526644; 4593424; 4203121; 4203122; 4314148; 4625161; 1796645; 1680452; 2293083; 4615138; 3920302; 3858342; 3797635; 3689696; 3418764; 4464123; 2082554; 1812198; 879543; 4438199; 4823834; 2155823; and 5008375; and U.S. Ser. Nos. 86012461; 86315936; 86316142; and 86824500.

6. By virtue of extensive use in commerce of Opposers' VARSITY and V Marks in the United States, the relevant trade and public have come to associate goods and services bearing such marks with the Varsity Companies.

7. On December 10, 2015, Applicant filed the Applications, claiming a date of first use of December 2013 for Applicant's VARSITY ON CHARLES and V VARSITY ON CHARLES Marks on or in connection with the services listed in the Applications.

8. The services of Applicant and the goods and services of Opposers are substantially similar and/or related.

9. Applicant's VARSITY ON CHARLES Mark, which includes "VARSITY", is identical and/or similar to Opposers' VARSITY Marks.

10. Applicant's V VARSITY ON CHARLES Mark, which includes "VARSITY" and a stylized "V," is identical and/or similar to Opposers' VARSITY and V Marks.

11. Upon information and belief, Applicant often uses the “V” element in Applicant’s V VARSITY ON CHARLES Mark in the colors blue and black, which are the same as the colors in which the Opposers’ V Marks often appear, as shown below:



12. Applicant’s VARSITY ON CHARLES and V VARSITY ON CHARLES Marks, as applied to the services set forth in the Applications herein objected to, so resemble Opposers’ VARSITY and V Marks as applied to their goods and services that they are likely to cause confusion, mistake and/or deception.

13. If Applicant is permitted to register Applicant’s VARSITY ON CHARLES Mark and/or Applicant’s V VARSITY ON CHARLES Mark for the services set forth in the Applications herein objected to, confusion of the relevant trade and public resulting in damage and injury to the Varsity Companies would be likely to result. Any persons familiar with the goods and services of the Varsity Companies would be likely to assume that Applicant’s services are sponsored by or produced under license from or otherwise affiliated with the Varsity Companies. Furthermore, any objection to or fault found with Applicant’s services provided under its marks would necessarily reflect on and seriously injure the reputation that the Varsity Companies have established for goods sold and services rendered under Opposers’ VARSITY and V Marks.

14. If Applicant were granted registrations for Applicant’s VARSITY ON CHARLES Mark and/or Applicant’s V VARSITY ON CHARLES Mark, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registrations would be a source of damage and injury to the Varsity Companies.

WHEREFORE, Opposers pray that the opposition and cancellation be sustained and that the Applications be refused.

Please recognize Deborah K. Squiers as the principal attorney for Opposers in this proceeding and as the named correspondent.

Dated: October 18, 2016
New York, New York

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.

By: /Deborah K. Squiers/
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Attorneys for Opposers

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on October 18, 2016 a true and correct copy of the Consolidated Notice of Opposition was served by United States Mail, First Class, by depositing it, postage prepaid, in a depository under the exclusive custody and control of the United States Postal Service, addressed to Applicant's Attorney of Record:

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/Ryan A. Ghiselli/
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