

ESTTA Tracking number: **ESTTA777745**

Filing date: **10/19/2016**

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	NSCO LLC DBA Need Supply Co.
Granted to Date of previous extension	10/19/2016
Address	3100 West Cary Street Richmond, VA 23219 UNITED STATES

Attorney information	Edward T. White LeClairRyan 919 East Main StreetTwenty-Fourth Floor Richmond, VA 23219 UNITED STATES trademarksri@leclairryan.com Phone:804.916.7160
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Applicant Information

Application No	86897841	Publication date	06/21/2016
Opposition Filing Date	10/19/2016	Opposition Period Ends	10/19/2016
Applicant	COLBY_EXON LLC 5832 E. 2nd Street Long Beach, CA 90803 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Retail apparel and sporting goods stores; On-line retail store services featuring apparel and sporting goods; Wholesaleand retail store services featuring apparel and sporting goods
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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.	4882167	Application Date	02/24/2014
Registration Date	01/05/2016	Foreign Priority Date	NONE
Word Mark	NEED		

Design Mark	<h1>NEED</h1>		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2015/02/26 First Use In Commerce: 2015/02/26 clothing, namely, men's and women's pants, shorts, shirts, t-shirts, dresses, skirts, sweaters, jackets, coats, and hats		

U.S. Application No.	86835551	Application Date	12/01/2015
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	NEED		
Design Mark	<h1>NEED</h1>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 0 First Use In Commerce: 0 Computerized on-line ordering featuring men's and women's clothing, jewelry and beauty products, retail clothing store services		

U.S. Registration No.	4616942	Application Date	02/24/2014
Registration Date	10/07/2014	Foreign Priority Date	NONE
Word Mark	NEED SUPPLY CO.		

Design Mark	NEED SUPPLY CO.		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2008/11/30 First Use In Commerce: 2008/11/30 Computerized on-line ordering featuring men's and women's clothing, jewelry, and beauty products		

U.S. Registration No.	2322498	Application Date	10/07/1998
Registration Date	02/22/2000	Foreign Priority Date	NONE
Word Mark	NEED SUPPLY CO.		
Design Mark	NEED SUPPLY CO.		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/03/04 First Use In Commerce: 1999/03/04 RETAIL CLOTHING STORE SERVICES		

U.S. Application No.	86836938	Application Date	12/02/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NEED SUPPLY CO.		
Design Mark	NEED SUPPLY CO.		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Men's and women's shoes		

U.S. Application No.	86739653	Application Date	08/27/2015
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NEED SUPPLY CO.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 clothing, namely, men's and women's pants, shorts, shirts, t-shirts, dresses, skirts, sweaters, jackets, coats and hats		

U.S. Application No.	86835511	Application Date	12/01/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NEED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Men's and women's shoes		

Attachments	86201930#TMSN.png(bytes) 86835551#TMSN.png(bytes) 86201968#TMSN.png(bytes) 75567058#TMSN.png(bytes) 86836938#TMSN.png(bytes) 86739653#TMSN.png(bytes) 86835511#TMSN.png(bytes) NEED ESSENTIALS 86897841 Notice of Opposition 19-Oct-2016.pdf(268451 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	/Edward T. White/
Name	Edward T. White
Date	10/19/2016

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

In the Matter of Application Serial No. 86/897,841
For the Mark: NEED ESSENTIALS
Filing Date: February 4, 2016

NSCO LLC d/b/a Need Supply Co.,)
)
Petitioner,)
)
v.)
)
Colby_Exon LLC,)
)
Applicant.)
_____)

Opposition No. _____

NOTICE OF OPPOSITION

NSCO LLC d/b/a Need Supply Co., a limited liability company organized and existing under the laws of Virginia, with an address at 3100 West Cary Street, Richmond, Virginia 23221 (“Opposer” or “NEED”), believes it will be damaged by registration of the mark NEED ESSENTIALS as shown in Application Serial No. 86/897,841 and hereby opposes its registration pursuant to 15 U.S.C. §§ 1051 *et seq.*, including specifically 15 U.S.C. §1063.

This Notice of Opposition has been timely filed. As grounds for its opposition, Opposer alleges as follows:

1. Upon information and belief, applicant Colby_Exon LLC is a limited liability company organized in Delaware with an address at 5832 E. 2nd Street, Long Beach, California 90803 (“Applicant”).
2. As evidenced in Application Serial No. 86/897,841, Applicant seeks to register the mark NEED ESSENTIALS for “Retail apparel and sporting goods stores; On-line retail store

services featuring apparel and sporting goods; Wholesale and retail store services featuring apparel and sporting goods,” in International Class 35.

3. NEED has used the mark NEED SUPPLY CO. since at least as early as 1999 to promote the retail sale of clothing and accessories.

4. NEED has used the mark NEED SUPPLY CO. since at least as early as 2008 to promote the online sale of clothing and accessories.

5. NEED has used the mark “NEED” since at least as early as February 2015 to promote clothing.

6. Consumers have come to refer to Opposer as “Need.”

7. NEED owns the following trademark applications and registrations incorporating “Need” as shown at Exhibit A attached:

Mark	Application or Registration No.	Filing Date / Registration Date	Goods or Services
NEED	4,882,167	January 5, 2016	IC 25: Clothing, namely, men's and women's pants, shorts, shirts, t-shirts, dresses, skirts, sweaters, jackets, coats, and hats
NEED	86/835,551	December 1, 2015	IC 35: Computerized on-line ordering featuring men's and women's clothing, jewelry and beauty products, retail clothing store services
NEED SUPPLY CO.	4,616,942	October 7, 2014	IC 35: Computerized on-line ordering featuring men's and women's clothing, jewelry, and beauty products
NEED SUPPLY CO.	2,322,498	February 22, 2000	IC 35: Retail clothing store services
NEED SUPPLY CO.	86/836,938	December 2, 2015	IC 25: Men's and women's shoes
NEED SUPPLY CO.	86/739,653	August 27, 2015	IC 25: Clothing, namely, men's and women's pants, shorts, shirts, t-shirts, dresses, skirts, sweaters, jackets, coats

Mark	Application or Registration No.	Filing Date / Registration Date	Goods or Services
			and hats
NEED	86/835,511	December 1, 2015	IC 25: Men's and women's shoes

8. Applicant's mark NEED ESSENTIALS is confusingly similar to, and shares a similar commercial impression with, Opposer's marks NEED and NEED SUPPLY CO. ("the Marks").

9. Opposer is the senior user of the Marks and Opposer's registrations and pending applications for the Marks have priority over Applicant's Intent-To-Use application.

10. The distinctiveness of the Marks is reinforced by the widespread secondary meaning associated with the Marks in the minds of consumers. Opposer has expended and continues to expend substantial time, money, and effort in advertising and promoting the Marks to identify itself as the source of its goods and services, such as in print and electronic advertising across numerous mediums.

11. As a result of Opposer's efforts, the Marks have become assets of substantial value, symbolizing Opposer's goodwill. Consequently, the Marks are some of the most recognizable brands in the clothing and accessories industry. Furthermore, due to the national recognition of the Marks by consumers, the public has come to associate "Need" as also symbolizing the goodwill inherent in the Marks, and further, link the "Need" element solely with Opposer and its high-quality products and services.

12. Applicant's proposed mark is confusingly similar to the Marks because it appropriates the positive emotive qualities conveyed by "Need" in the Marks. Specifically, Applicant's "NEED ESSENTIALS" mark shares the dominant and distinctive element with the

Marks and merely adds the non-distinctive term “Essentials” to the “Need” formative. Accordingly, Applicant’s mark conveys the same commercial impression as the Marks.

13. The likelihood of confusion between Applicant’s mark and the Marks is exacerbated because the products and services proposed to be sold under Applicant’s mark, namely clothing and accessories, are highly similar to the products and services sold under the Marks. Thus, consumers will likely believe—incorrectly—that NEED ESSENTIALS is an extension of the Marks.

14. As a result of the goodwill and public recognition arising from the association of the Marks with Opposer, consumers are likely to believe that Opposer has licensed, approved, or otherwise authorized Applicant’s use of the NEED ESSENTIALS mark, when it has not.

15. The maturation of Applicant’s application into registration will cause a likelihood of confusion, mistake, or deception with respect to the source or origin of Applicant’s services. Consumers will erroneously believe that Applicant’s services are produced or associated with, Opposer.

16. In summary, registration of Applicant’s mark would be incorrect and improper in view of the requirements of the Trademark Act of 1946, as amended, including specifically but not limited to, the provisions of 15 U.S.C. §§ 1051, *et seq.*

WHEREFORE, Opposer prays that this opposition be sustained, and that registration to Applicant for the proposed mark NEED ESSENTIALS as shown in Application Serial No. 86/897,841 for the services identified in International Class 35 be denied.

Opposer submits this Notice of Opposition via the e-filing procedure of the Trademark Trial and Appeal Board (“TTAB”) and hereby advises the Board that it may debit the Deposit Account No. 501563 of LeClairRyan for the appropriate filing fee.

Respectfully submitted,

LECLAIRRYAN

Dated: October 19, 2016

By: 
Edward T. White
Janet W. Cho
Attorneys for Respondent
LeClairRyan
919 East Main Street
24th Floor
Richmond, Virginia 23219
Phone: (804) 916-7160
Fax: (804) 916-7270
Email: trademarksri@leclairryan.com

*Attorneys for Petitioner
NSCO LLC d/b/a Need Supply Co.*

EXHIBIT A

United States of America
United States Patent and Trademark Office

NEED

Reg. No. 4,882,167

Registered Jan. 5, 2016

Int. Cl.: 25

TRADEMARK

PRINCIPAL REGISTER

NSCO LLC DBA/ NEED SUPPLY CO. (VIRGINIA LIMITED LIABILITY COMPANY)
3100 WEST CARY STREET
RICHMOND, VA 23221

FOR: CLOTHING, NAMELY, MEN'S AND WOMEN'S PANTS, SHORTS, SHIRTS, T-SHIRTS, DRESSES, SKIRTS, SWEATERS, JACKETS, COATS, AND HATS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 2-26-2015; IN COMMERCE 2-26-2015.

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

OWNER OF U.S. REG. NO. 2,322,498.

SN 86-201,930, FILED 2-24-2014.

ALLISON HOLTZ, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office



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NEED

Word Mark	NEED
Goods and Services	IC 035. US 100 101 102. G & S: Computerized on-line ordering featuring men's and women's clothing, jewelry and beauty products, retail clothing store services
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86835551
Filing Date	December 1, 2015
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	February 2, 2016
Owner	(APPLICANT) NSCO LLC d/b/a/ NEED SUPPLY CO. LIMITED LIABILITY COMPANY VIRGINIA 3100 West Cary Street Richmond VIRGINIA 23219
Attorney of Record	Janet W. Cho
Prior Registrations	2322498;4616942
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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United States of America

United States Patent and Trademark Office

NEED SUPPLY CO.

Reg. No. 4,616,942

Registered Oct. 7, 2014

Int. Cl.: 35

SERVICE MARK

PRINCIPAL REGISTER

NSCO LLC DBA/ NEED SUPPLY CO. (VIRGINIA LIMITED LIABILITY COMPANY)
3100 WEST CARY STREET
RICHMOND, VA 23221

FOR: COMPUTERIZED ON-LINE ORDERING FEATURING MEN'S AND WOMEN'S CLOTHING, JEWELRY, AND BEAUTY PRODUCTS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 11-30-2008, IN COMMERCE 11-30-2008.

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

OWNER OF U.S. REG. NO. 2,322,498.

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

SER. NO. 86-201,968, FILED 2-24-2014.

ALLISON HOLTZ, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

Int. Cl.: 35

Prior U.S. Cls.: 100, 101, and 102

Reg. No. 2,322,498

United States Patent and Trademark Office

Registered Feb. 22, 2000

**SERVICE MARK
PRINCIPAL REGISTER**

NEED SUPPLY COMPANY

NEED SUPPLY COMPANY, LLC (VIRGINIA
LIMITED LIABILITY COMPANY)
3010 WEST CARY STREET
RICHMOND, VA 23221 BY CHANGE OF NAME
NEED SUPPLY COMPANY, L.L.C. (VIRGINIA
CORPORATION) RICHMOND, VA 23221

FOR: RETAIL CLOTHING STORE SERV-
ICES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 3-4-1999; IN COMMERCE
3-4-1999.

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

SN 75-567,058, FILED 10-7-1998.

MITCHELL FRONT, EXAMINING ATTORNEY



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NEED SUPPLY CO.

Word Mark	NEED SUPPLY CO.
Goods and Services	IC 025. US 022 039. G & S: Men's and women's shoes
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86836938
Filing Date	December 2, 2015
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	March 8, 2016
Owner	(APPLICANT) NSCO LLC d/b/a/ NEED SUPPLY CO. LIMITED LIABILITY COMPANY VIRGINIA 3100 West Cary Street Richmond VIRGINIA 23219
Attorney of Record	Janet W. Cho
Prior Registrations	2322498;4616942
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SUPPLY CO." APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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NEED SUPPLY CO.

Word Mark	NEED SUPPLY CO.
Goods and Services	IC 025. US 022 039. G & S: clothing, namely, men's and women's pants, shorts, shirts, t-shirts, dresses, skirts, sweaters, jackets, coats and hats
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86739653
Filing Date	August 27, 2015
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	March 1, 2016
International Registration Number	1292579
Owner	(APPLICANT) NSCO LLC d/b/a/ NEED SUPPLY CO. LIMITED LIABILITY COMPANY VIRGINIA 3100 West Cary Street Richmond VIRGINIA 23219
Attorney of Record	Janet W. Cho
Prior Registrations	2322498;4616942
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SUPPLY CO." APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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NEED

Word Mark	NEED
Goods and Services	IC 025. US 022 039. G & S: Men's and women's shoes
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86835511
Filing Date	December 1, 2015
Current Basis	1B
Original Filing Basis	1B
Published for Opposition	February 2, 2016
Owner	(APPLICANT) NSCO LLC d/b/a/ NEED SUPPLY CO. LIMITED LIABILITY COMPANY VIRGINIA 3100 West Cary Street Richmond VIRGINIA 23219
Attorney of Record	Janet W. Cho
Prior Registrations	2322498;4616942
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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CERTIFICATE OF SERVICE

I hereby certify that that pursuant to CFR 2.101(b), a true and correct copy of the foregoing NOTICE OF OPPOSITION has been properly served via first class mail on Opposer's Attorney of Record, this 19th day of October, 2016, at the following address:

MITCH MILSTEIN
AUCTUS LAW PARTNERS
425 30TH STREET
SUITE 14
NEWPORT BEACH, CALIFORNIA 92663
mmilstein@auctuslaw.com



Yvonne D. D'Erasmus