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

In the Matter of Application Serial No. 76/080,809  
Filed: November 2, 1999  
By: Frederic Remington Trust 1861  
For The Mark: FREDERIC REMINGTON  
Published in the Official Gazette: November 25, 2003



03-29-2004

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

Remington Products Company, )  
L.L.C., )  
Opposer, )  
)  
vs )  
)  
Frederic Remington Trust 1861, )  
Applicant )

Opposition No.:

Box TTAB, Fee  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**NOTICE OF OPPOSITION**

Opposer, Remington Products Company, L.L.C. ("Opposer" or "Remington Products Company") a limited liability company organized and existing under the laws of the State of Delaware, located and doing business in Bridgeport, Connecticut, believes that it will be damaged by the issuance of a registration for the mark FREDERIC REMINGTON that is the subject of application Serial No. 76/080,809, filed on November 2, 1999 by Frederic Remington Trust 1861, and hereby opposes the application.

03/31/2004 EPINA1 00000023 76080809

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As grounds for this Opposition, Remington Products Company alleges that:

1. Application Serial Number 76/080,809 was filed by Applicant Frederic Remington Trust 1861 to register the mark FREDERIC REMINGTON on the Principal Register for goods and services in class 12.

2. In the subject application, Applicant alleges that its FREDERIC REMINGTON mark was first used in 1968 and first used in interstate commerce in 1985.

3. Opposer, Remington Products Company, has been and continues to be engaged in the business of manufacturing, promoting, marketing and selling a wide variety of goods and services under its family of REMINGTON trademarks. These goods and services include, inter alia, the promotion and sale of consumer products to a broad spectrum of men and women. Opposer and its predecessors in interest have been using its various REMINGTON marks on and in connection with consumer products and related services since at least as early as 1900.

4. Opposer's REMINGTON mark has become well known to consumers, and is a recognized indicator of quality and of the source of origin of said goods and services. As a result of Opposer's long term and exclusive use of its REMINGTON mark on and in connection with its various consumer goods and related services, the mark has become synonymous with Opposer Remington Products Company in the minds of the public, and identifies such goods and services as originating from Opposer.

5. In recognition of the widespread consumer awareness of the REMINGTON brand of goods and services that originate from Opposer, the REMINGTON mark has been registered by Opposer in the United States. Opposer is

the owner of many trademark registrations for the mark REMINGTON, whether alone or in conjunction with other terms, including the following United States Registration Nos.:

372,566	1,009,949	1,546,845
416,818	1,091,858	1,551,381
761,721	1,156,146	1,734,704
830,996	1,341,385	1,967,474
977,729	1,394,122	2,495,134
986,980	1,472,924	2,570,249
988,280	1,478,550	2,561,659
989,674	1,480,838	2,647,545
999,410	1,532,739	2,699,029

6. Opposer has continuously promoted, marketed and sold consumer products under its various REMINGTON marks, and has established common law trademark rights associated with its long term and exclusive use of the REMINGTON mark.

7. Opposer's products are advertised and promoted extensively, including in print, radio and television.

8. Through use and promotion in interstate commerce of the REMINGTON marks, Remington Products Company has acquired valuable goodwill in the REMINGTON marks. As a result, the REMINGTON marks have come to indicate to the trade and purchasing public a source of origin in Remington Products Company. Accordingly, said REMINGTON marks are an asset of considerable value to Opposer.

#### **APPLICANT'S VARIOUS APPLICATIONS**

9. The present application is but one of many applications filed by Applicant to register trademarks which include the term REMINGTON. These applications, some of which have been abandoned or are no longer pending because an Opposition proceeding has previously been sustained, all recite use of Applicant's mark,

FREDERIC REMINGTON, in commerce, covering such diverse goods and services such as financial services (Application Serial No. 76/080,800); backpacks (Application Serial No. 76/080,801); tequila (Application Serial No. 76/080,802); horse drawn sleighs (Application Serial No. 76/080,803); variety television programs (Application Serial No. 76/080,804); (ribbons and embroidery (Application Serial No. 76/080,805); business cards and materials (Application Serial No. 76/080,806); furniture (Application Serial No. 76/080,807); glass bottles sold empty and porcelain figurines (Application Serial No. 76/080,808); muzzle loading rifles and accessories therefore (Application Serial No. 76/080,810); statues and lamps (Application Serial No. 76/080,811); production of motion pictures and television shows (Application Serial No. 76/080,812) and; advertising services (Application Serial No. 76/080,813).

10. Upon information and belief, Applicant filed this and its other applications, for a myriad listing of goods and services, despite the fact that Applicant never made bona fide use of its FREDERIC REMINGTON mark or, if said mark was ever used, despite that fact that such use has long ceased. Upon information and belief, these applications were filed with the intent and purpose of "flooding" the register with these illicit applications, as a way to eventually seek payment from Opposer or, at the very least, to cause Opposer the bother and expense of opposing these applications in the Patent and Trademark Office.

#### **LIKELIHOOD OF CONFUSION**

11. Opposer's various registered and unregistered REMINGTON trademarks and Applicant's FREDERIC REMINGTON mark are confusingly similar in appearance, sound, spelling and overall commercial impression.

12. Consumers are likely to believe that the Applicant's goods and services recited in Applicant's application at issue herein, are somehow associated with Opposer, and/or that Applicant is associated with Opposer or Opposer's REMINGTON goods and services.

13. The registration of Applicant's mark is likely to result in consumer confusion as to the source of origin of any goods sold under Applicant's mark.

14. The grant of a Registration for Applicant's FREDERIC REMINGTON mark would be a source of damage and injury to Opposer, as such grant would provide Applicant with a prima facie exclusive right to use its mark, to the detriment of Opposer and consumers who are likely to be confused as to the source of origin of such goods, as well as to any implied affiliation or association between Opposer's various registered trademarks, its common law trademarks and Opposer's well known trade name.

**ABANDONMENT THROUGH NON-USE**

15. Applicant's application at issue herein claims a date of first use of 1968 and a date of first use in commerce of 1985.

16. Upon information and belief, Applicant made no bona fide use of its FREDERIC REMINGTON mark in the United States or abroad in 1968, and Applicant made no bona fide use of that mark in interstate commerce in 1985.

17. Further, upon information and belief, Applicant has not used the mark FREDERIC REMINGTON for a period of at least three (3) or more consecutive years.

18. Upon information and belief, Applicant's non-use of the mark continues to date.

19. Upon information and belief, during the above stated period of non-use, Applicant had no intent to resume use the FREDERIC REMINGTON mark that is the subject of Application Serial No. 76/080,809.

20. Based on the foregoing, the FREDERIC REMINGTON mark, which is the subject of the application at issue herein, has been abandoned by Applicant and thus Applicant is not entitled to a federal registration of the FREDERIC REMINGTON mark.

**ABANDONMENT THROUGH APPLICANT'S UNCONTROLLED LICENSING**

21. Upon information and belief, in addition to Applicant's abandonment of the FREDERIC REMINGTON mark through non-use, Applicant has abandoned the FREDERIC REMINGTON mark by virtue of its uncontrolled licensing activities.

22. As set forth previously, Opposer believes that Applicant never made a bona fide use of its FREDERIC REMINGTON mark and, if there ever were such use, then such use has long ceased resulting in abandonment of said mark for the goods and/or services recited in said application. Nonetheless, to the extent that there ever was use of the FREDERIC REMINGTON mark, upon information and belief, said use was by license to third parties for use in connection with goods and/or services identified in Application Serial No. 76/080,809.

23. Upon information and belief, during the term of the license(s) granted to third parties, and to the extent that there was ever use of the FREDERIC REMINGTON mark, Applicant made no attempt to exercise control of the use of the FREDERIC REMINGTON mark. Rather, any alleged licensing was a "naked license" resulting in invalidity of the mark.

24. As a result of the foregoing, Applicant effectively abandoned the FREDERIC REMINGTON mark for the goods and/or services in the present application.

**APPLICANT'S FRAUD ON THE TRADEMARK OFFICE**

**Fraud In Connection With The Use Of The Mark**

25. On November 2, 1999, Applicant filed the present application for the registration of the mark FREDERIC REMINGTON. The application stated that the mark was first used in 1968 and was first used in commerce in 1985. The application further stated that "Applicant is using the mark in commerce on or in connection with the below-identified goods and/or services." These dates of use and statement that the mark was currently in use were verified by a declaration signed by Sang Yoo, the Trustee of Applicant, on July 22, 1999, with the declaration noting that it was signed under penalty of perjury and that wilful false statements would jeopardize the validity of the application.

26. Upon information and belief, notwithstanding Applicant's statement in its application to the contrary and its Trustee's sworn declaration to the veracity of such statement, Applicant was not using the FREDERIC REMINGTON mark in interstate commerce as of the filing date of the application.

27. Upon information and belief, notwithstanding Applicant's statement in its application to the contrary and its Trustee's sworn declaration to the veracity of such statement, Applicant was not using the FREDERIC REMINGTON mark in the United States or abroad in 1968, and Applicant made no bona fide use of that mark in interstate commerce in 1985.

28. Upon information and belief, notwithstanding Applicant's statement in its application to the contrary and its Trustee's sworn declaration to the veracity of such statement, Applicant was not using the FREDERIC REMINGTON mark in interstate commerce in connection with the goods and services originally stated in the application and the goods and services later identified by its Amendment submitted by its attorneys.

29. On or about October 21, 1999, Sang Yoo, the Trustee of Applicant, submitted another declaration stating:

"2. the mark is now a registered mark, 1941902 upon the Principal Register and either now in use in commerce in this classification or intended use in commerce;

3. and the specimens were/are/intended; in use, in commerce at least as early as the dates declared on face of application."

30. The declaration by the Trustee of Applicant further stated:

"All of the above statements made on my own knowledge are true. I understand that wilful false statements and the like are punishable by fine or imprisonment or both under section 1001 of Title 18 of United States Code, and may jeopardise [sic] the validity of the application or any registration resulting from the application."

31. Upon information and belief, this subsequent declaration also included numerous false and/or fraudulent statements. First, although Applicant has a prior registration for the mark FREDRIC REMINGTON, Registration No. 1,941,902, the mark FREDRIC REMINGTON is not identical to nor is the subject of Application Serial No. 76/080,809. Second, the subsequent declaration also indicated that the mark was "now in use in commerce" (although it also stated that the mark was "intended" to be used in commerce) and it stated that specimens were "in use, in commerce at least as early as dates declared on face of application" (although it also stated that the specimens "were/are/intended" to be used).



32. Upon information and belief, Applicant knew, or should have known, that the statements made in the declaration of October 21, 1999 were false.

**Fraud In Connection With The Petition To Make Special**

33. In a letter to the PTO, requesting "expedited application processing" or that the application be "made special," the Trustee of Applicant further stated that Applicant was in "large-scale monetary negotiations with a fortune 250 U.S. concern," and that it was "gearing up for enforcement and litigation of all infringement, via U.S. Customs Service, as well as, litigating domestic theft of goodwill, unfair competition, infringement, freeriding, and dilution tactics...."

34. Upon information and belief, Applicant has never been in large-scale monetary negotiations with a fortune 250 U.S. concern and has never been involved in any litigation concerning its own enforcement of the FREDERIC REMINGTON mark by others.

35. Upon information and belief, Applicant's statements to the PTO in its application for registration were false and material and were either made knowingly of the falsity thereof, or were made with reckless disregard for the truth thereof.

36. Upon information and belief, Applicant's statements to the PTO in its application for registration were false and fraudulent and said statements were made with the intent to induce authorized agents of the PTO to publish Application Serial No. 76/080,809 for opposition, for purposes of subsequently issuing a registration for the mark FREDERIC REMINGTON.

37. Upon information and belief, the PTO reasonably relied to the truth of Applicant's false statements in connection with Applicant's application for the mark FREDERIC REMINGTON in publishing said application.

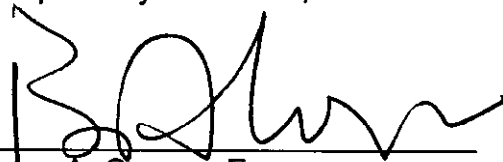
38. Based on the foregoing, the application was filed under fraudulent and false pretences and should be held invalid.

**WHEREFORE**, it is respectfully requested that this Opposition be sustained and that the registration sought by Application Serial No. 76/080,809 be denied in its entirety.

A check in the amount of \$300 and two (2) copies of this Notice of Opposition are included herewith. The Patent and Trademark Office is also authorized to charge any deficiencies in fees to Deposit Account No. 07-1730.

Dated: New York, New York  
March 24, 2004

Respectfully submitted,



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**CERTIFICATE OF MAILING**

I hereby certify that on this 24<sup>th</sup> day of March, 2004, two (2) copies of the NOTICE OF OPPOSITION were deposited with the United States Postal Service as first class mail in an envelope addressed to:

BOX TTAB FEE  
Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202

  
Marisol Lopez-DaRosso  
Marisol Lopez-DaRosso