

ESTTA Tracking number: **ESTTA104980**

Filing date: **10/18/2006**

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	H.W. Carter & Sons, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	11 Corbin Ave. Garden City Park, NY 11040 UNITED STATES		

Attorney information	Sheldon H. Klein Arent Fox PLLC 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES klein.sheldon@arentfox.com, tmdocket@arentfox.com, henry.eileen@arentfox.com Phone:202-857-6000
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Applicant Information

Application No	78799494	Publication date	09/19/2006
Opposition Filing Date	10/18/2006	Opposition Period Ends	10/19/2006
Applicant	The William Carter Company 1170 Peachtree Street, Suite 900 Atlanta, GA 30309 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Infants' and children's clothing, namely, underwear, undershirts, footwear, swimwear, pants, slacks, trousers, overalls, coveralls, two-piece shirt and pant sets, jeans, jumpers, jumpsuits, knit-tops, shirts, blouses, T-shirts, tank-tops, blazers, sweaters, cardigans, sweatshirts, sweatpants, skirts, dresses, shorts, shortalls, nightgowns, pajamas, robes, dressing gowns, bathrobes, socks, booties, leggings, bonnets, hats, caps, scarves, mittens, gloves, snow suits, coats, jackets, vests, baby bunting, cloth bibs, shoes, boots, slippers, bodysuits, creepers, rompers, sleepers, tops, bottoms, one-piece shirt and pant play sets, one-piece shirt and pant sleep sets, sleeping gowns; sleep and play clothing, namely, sleepwear, sleeping garments, play suits, nightgowns, pajamas, sleep shirts, sleep pants, footed pajamas, infant sleeping pajamas with enclosed foot area, play bottoms, play tops, sleep bottoms, sleep tops, one-piece bottoms and tops for play or sleeping, infant sleepers; sleeping suits and bloomers

Attachments	carter opposition.pdf (7 pages)(239046 bytes)
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Signature	/Sheldon H. Klein/
Name	Sheldon H. Klein

Date	10/18/2006
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No. 78/799,494, filed January 5, 2006, for the mark IF THEY COULD JUST STAY LITTLE 'TIL THEIR CARTER'S WEAR OUT; published September 19, 2006

H.W. CARTER & SONS, INC.,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
THE WILLIAM CARTER COMPANY,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer H.W. Carter & Sons, Inc., a Delaware corporation, having an address of 11 Corbin Ave., Garden City Park, New York, believes that it will be damaged by the registration of the above-identified mark and hereby opposes the same pursuant to the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063(a), as amended.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title, and interest in and to the mark CARTER'S WATCH THE WEAR for use on and in connection with apparel and related goods, including but not limited to the following:

Overalls, pants, coats, jackets, and aprons; ladies' workwear, namely overalls, jeans, dresses, jackets, shorts and skirts and ladies' and girls' T-shirts, blouses, sweaters and sweatshirts; caps, knitted hats, scarves, gloves and footwear, namely boots, sneakers, shoes, and slippers; men's' and ladies' pajamas, nightgowns, nightshirts, bathrobes, sleepwear, intimate apparel, namely, bed jackets, cover-ups, loungewear and underwear.

2. Since long prior to the filing of the above-referenced application, and prior to any first use date Applicant may claim, Opposer has continuously used its CARTER'S WATCH THE WEAR mark in interstate commerce on and in connection with the aforementioned goods.

3. Opposer's mark is inherently distinctive. Additionally, it has been used, promoted, and advertised extensively throughout the United States. As a result, Opposer's mark has become well known and famous as a distinctive indication of Opposer as the source of high quality goods and services, and the mark has generated valuable goodwill for Opposer.

4. Opposer's CARTER'S WATCH THE WEAR mark is registered on the Principal Register of the United States Patent and Trademark Office, as reflected in the following schedule:

Mark	Filing Date	Registration Number	Registration Date	Date of First Use
CARTER'S WATCH THE WEAR (Stylized)	03/01/1930	272,354	07/08/1930	02/01/1930
CARTER'S WATCH THE WEAR	09/02/1994	1,977,694	09/02/1994	11/1993
CARTER'S WATCH THE WEAR	02/22/1995	2,125,961	12/30/1997	08/1997
CARTER'S WATCH THE WEAR	09/21/1998	2,315,028	02/01/2000	08/12/1999

5. Opposer's registrations are valid, subsisting, and incontestable, and constitute conclusive evidence of Opposer's exclusive right to use its CARTER'S WATCH THE WEAR mark in commerce.

6. Notwithstanding Opposer's prior established rights in its well known and famous mark CARTER'S WATCH THE WEAR, Applicant filed an application with the United States Patent and Trademark Office, based on an alleged intent to use, to register the mark IF THEY

COULD JUST STAY LITTLE 'TIL THEIR CARTER'S WEAR OUT (Ser. No. 78/799,494) for

the following goods:

Infants' and children's clothing, namely, underwear, undershirts, footwear, swimwear, pants, slacks, trousers, overalls, coveralls, two-piece shirt and pant sets, jeans, jumpers, jumpsuits, knit-tops, shirts, blouses, T-shirts, tank-tops, blazers, sweaters, cardigans, sweatshirts, sweatpants, skirts, dresses, shorts, shortalls, nightgowns, pajamas, robes, dressing gowns, bathrobes, socks, booties, leggings, bonnets, hats, caps, scarves, mittens, gloves, snow suits, coats, jackets, vests, baby bunting, cloth bibs, shoes, boots, slippers, bodysuits, creepers, rompers, sleepers, tops, bottoms, one-piece shirt and pant play sets, one-piece shirt and pant sleep sets, sleeping gowns; sleep and play clothing, namely, sleepwear, sleeping garments, play suits, nightgowns, pajamas, sleep shirts, sleep pants, footed pajamas, infant sleeping pajamas with enclosed foot area, play bottoms, play tops, sleep bottoms, sleep tops, one-piece bottoms and tops for play or sleeping, infant sleepers; sleeping suits and bloomers.

7. On information and belief, Applicant made no use of its alleged mark prior to the date it filed its application, i.e., January 25, 2006.

8. On information and belief, Applicant made no use of its alleged mark prior to the date of first use of Opposer's CARTER'S WATCH THE WEAR mark.

9. On information and belief, Applicant made no use of its alleged mark prior to the filing dates of each of the applications for federal registration of Opposer's CARTER'S WATCH THE WEAR mark.

10. On information and belief, Applicant made no use of its alleged mark prior to the dates each of Opposer's CARTER'S WATCH THE WEAR registrations were issued by the United States Patent and Trademark Office.

Count I – Likelihood Of Confusion - § 2(d)

11. Opposer repeats and realleges the allegations of paragraphs 1 through 10 and incorporates each paragraph by reference as if set forth here.

12. The mark sought to be registered by Applicant so resembles Opposer's CARTER'S WATCH THE WEAR mark that its use and registration in connection with Applicant's goods is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's goods, or cause the public to assume erroneously that Applicant's goods are in some way connected with and/or sponsored by or affiliated with Opposer, or vice versa, all within the meaning of Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), as amended, and will injure and damage Opposer and the goodwill and reputation it has established in its well known CARTER'S WATCH THE WEAR mark.

13. Likelihood of confusion in this case is enhanced by the distinctiveness and fame of Opposer's CARTER'S WATCH THE WEAR mark and by the fact that consumers associate this mark with goods sold, approved, or endorsed by Opposer.

14. Likelihood of confusion is enhanced by the fact that purchasers of Applicant's goods are prospective purchasers of Opposer's goods, and vice versa.

Count II – Deception/False Suggestion Of Connection – § 2(a)

15. Opposer repeats and realleges the allegations of paragraphs 1 through 14 and incorporates each paragraph by reference as if set forth here.

16. The mark sought to be registered so closely resembles Opposer's CARTER'S WATCH THE WEAR mark that Applicant's mark is likely to cause deception in violation of Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a), as amended, in that the mark

misdescribes the nature or origin of the goods, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchasers' decisions to purchase Applicant's goods.

17. The mark sought to be registered so closely resembles Opposer's CARTER'S WATCH THE WEAR mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act of 1946, 15 U.S.C. § 1052(a), as amended, since the mark sought to be registered points uniquely to Opposer, and purchasers will assume that goods sold under the mark sought to be registered are connected with Opposer.

Count III – Dilution By Blurring – § 43(c)

18. Opposer repeats and realleges the allegations of paragraphs 1 through 17 and incorporates each paragraph by reference as if set forth here.

19. Opposer's CARTER'S WATCH THE WEAR mark has been extensively used and promoted throughout the United States for many years.

20. A substantial amount of goods have been sold under Opposer's CARTER'S WATCH THE WEAR mark throughout the United States.

21. Opposer's CARTER'S WATCH THE WEAR mark enjoys a high degree of recognition by the general consuming public of the United States.

22. Opposer's CARTER'S WATCH THE WEAR mark is registered on the Principal Register.

23. Accordingly, Opposer's CARTER'S WATCH THE WEAR mark is famous.

24. Applicant's unauthorized application for registration of its alleged mark was filed long after Opposer's CARTER'S WATCH THE WEAR mark became famous.

25. Any use that Applicant may allege of its alleged mark began long after Opposer's CARTER'S WATCH THE WEAR mark became famous.

26. Applicant's registration or use of its alleged mark is likely to cause an association arising from the similarity between Applicant's alleged mark and Opposer's CARTER'S WATCH THE WEAR mark that would impair the distinctiveness of Opposer's CARTER'S WATCH THE WEAR mark.

27. Applicant's alleged mark and Opposer's CARTER'S WATCH THE WEAR mark are highly similar.

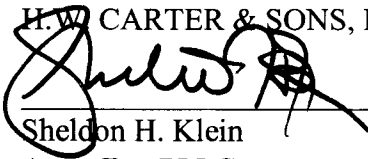
28. Opposer's CARTER'S WATCH THE WEAR mark is highly distinctive. Opposer is engaged in substantially exclusive use of its CARTER'S WATCH THE WEAR mark to a great extent.

29. On information and belief, Applicant intends to create an association between Applicant's mark and Opposer's CARTER'S WATCH THE WEAR mark.

30. Use or registration of Applicant's alleged mark is likely to cause dilution by blurring of Opposer's CARTER'S WATCH THE WEAR mark, in violation of the Trademark Dilution Revision Act of 2006, Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

31. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's alleged mark, and registration should be refused.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of the mark IF THEY COULD JUST STAY LITTLE 'TIL THEIR CARTER'S WEAR OUT by Applicant be denied.

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October 18, 2006

Attorneys for Opposer