

ESTTA Tracking number: **ESTTA568720**

Filing date: **11/04/2013**

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	Buckle Brands, Inc.
Granted to Date of previous extension	11/06/2013
Address	2407 W. 24th St. Kearney, NE 68845 UNITED STATES

Attorney information	Aryn M. Emert Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES ame@cll.com, jhe@cll.com, njh@cll.com, trademark@cll.com Phone:212-790-9200
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Applicant Information

Application No	85896578	Publication date	07/09/2013
Opposition Filing Date	11/04/2013	Opposition Period Ends	11/06/2013
Applicant	WD-40 Manufacturing Company 1061 Cudahy Place San Diego, CA 92110 CANADA		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bicycle clothing namely jerseys and bibs

Applicant Information

Application No	85896688	Publication date	07/30/2013
Opposition Filing Date	11/04/2013	Opposition Period Ends	
Applicant	WD-40 Manufacturing Company 1061 Cudahy Place San Diego, CA 92110 CANADA		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bicycle clothing, namely, jerseys and bibs

Grounds for Opposition

Other	Please see attached pleading.
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Attachments	Consolidated NOO - WD40 BKE - November 4 2013 .pdf(45306 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	/Aryn M. Emert/
Name	Aryn M. Emert
Date	11/04/2013

As grounds for opposition, it is alleged that:

1. Opposer is a wholly-owned subsidiary of The Buckle, Inc. (“Buckle”), one of the country’s foremost manufacturers and retailers of apparel, footwear and related fashion accessories. Buckle’s fashion products have been sold throughout the United States and have generated billions of dollars in sales over the years.

2. Buckle markets a wide selection of brand name apparel and fashion accessories and also sells apparel and fashion accessories under its own proprietary brands, including BKE. BKE is Buckle’s most successful proprietary brand, and since long prior to April 5, 2013, Applicant’s constructive first use date, Buckle has sold millions of dollars worth of BKE apparel and fashion accessories annually.

3. For many years and since long prior to April 5, 2013, Applicant’s constructive first use date, Opposer, through its affiliated companies, predecessors and authorized licensees has been in the business of designing, producing, selling and distributing a variety of goods, including, without limitation, sports and other apparel, footwear, headwear, bags, jewelry, eyewear and fragrances, under trademarks consisting of or containing the term BKE, either alone or in conjunction with other words and/or designs (collectively, “Opposer’s BKE Marks”).

4. Opposer owns U.S. federal applications and registrations for Opposer’s BKE Marks in International Classes 3, 9, 18 and 25, namely, Registration Nos. 2,447,957, 2,839,123, 3,752,278, 3,752,333, 4,082,735, 4,275,903, 4,317,982, and 4,319,009, and Application Nos. 85/478,036, 85/636,115, and 85/636,110. Registration Nos. 2,447,957 and 2,839,123, both in Class 25, are incontestable.

5. Since long prior to April 5, 2013, Applicant’s constructive first use date, Opposer, through its affiliated companies, predecessors and authorized licensees, has offered for sale,

promoted and advertised goods bearing one or more of Opposer's BKE Marks in U.S. commerce, including, without limitation, sports and other apparel, footwear, headwear, bags, jewelry, eyewear, and fragrance.

6. As a result of the sales and promotion of its goods bearing Opposer's BKE Marks, Opposer has built up valuable goodwill in Opposer's BKE Marks, and said goodwill has become closely and uniquely identified and associated with Opposer.

7. On April 5, 2013, Applicant filed the Applications for Applicant's Marks for "bicycle clothing, namely, jerseys and bibs" in International Class 25, both based on Applicant's intent to use such marks in U.S. commerce.

8. Upon information and belief, Applicant did not use either of Applicant's Marks in U.S. commerce for the goods covered by the Applications prior to Applicant's constructive first use date of April 5, 2013.

9. The goods covered by the Applications are closely related to the goods offered for sale and sold in U.S. commerce by Opposer under Opposer's BKE Marks.

10. Each of Applicant's Marks prominently displays the term:

The image shows the letters 'BKE' in a bold, outlined, sans-serif font. The letters are white with a black outline. The 'B' and 'K' are connected at the top, and the 'E' is separate. There is a small space between the 'K' and the 'E'.

11. The term BKE in each of Applicant's Marks is virtually identical to Opposer's mark, BKE, and to the term BKE in Opposer's BKE Marks.

12. Applicant has no connection with Opposer, nor has it been authorized by Opposer to use its mark, BKE, either alone or as part of another mark.

13. Applicant's Marks so resemble Opposer's BKE mark and Opposer's BKE Marks as to be likely, when used in connection with Applicant's goods, to cause confusion, to cause

mistake, and to deceive the trade and public, who are likely to believe that Applicant's goods have their origin with Opposer and/or that such goods are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of certificates of registration for Applicant's Marks.

14. Opposer would be further injured by the granting of certificates of registration to Applicant because Applicant's Marks, which are close approximations of Opposer's BKE mark and Opposer's BKE Marks, and which such marks point uniquely to Opposer, when used by Applicant in connection with the applied-for goods, would falsely suggest a connection between Applicant, which has no connection with or authorization from Opposer, and Opposer.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Marks and requests that the consolidated opposition be sustained and said registrations be denied.

Please recognize as attorneys for Opposer in this proceeding Jeffrey H. Epstein and Aryn M. Emert (members of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Jeffrey H. Epstein, Esq. at the address listed below.

Dated: New York, New York
November 4, 2013

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Aryn M. Emert/

Jeffrey H. Epstein
Aryn M. Emert
1133 Avenue of the Americas
New York, New York 10036
(212) 790-9200

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on November 4, 2013, I caused a true and correct copy of the foregoing Consolidated Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant's Attorney and Correspondent of Record, Kathleen A. Pasulka, Procopio Cory Hargreaves & Savitch LLP, 525 B St., Ste 2200, San Diego, California 92101-4474.

/Aryn M. Emert/
Aryn M. Emert