

ESTTA Tracking number: **ESTTA735420**

Filing date: **03/23/2016**

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	Lotto Sport Italia S.p.A.
Granted to Date of previous extension	03/23/2016
Address	Via Montebelluna 5/7 Trevignano (TV), 31040 ITALY
Attorney information	James J. Bitetto Tutunjian & Bitetto, P.C. 425 Broadhollow Road, Suite 302 Melville, NY 11747 UNITED STATES trademarks@tb-iplaw.com Phone:631 844 0080

Applicant Information

Application No	86493215	Publication date	11/24/2015
Opposition Filing Date	03/23/2016	Opposition Period Ends	03/23/2016
International Registration No.	NONE	International Registration Date	NONE
Applicant	SPORTS CORNER COMPANY Al Qassar Tower - 20th Fl. Steet No: 920 West Bay, Doha, QATAR		

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: Assistance with business management; commercial or industrial management assistance
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2D 1938 (Fed. Cir. 2009)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4148339	Application Date	02/16/2011
Registration Date	05/29/2012	Foreign Priority	08/17/2010

		Date	
Word Mark	LOTTO		
Design Mark			
Description of Mark	<p>The mark consists of the stylized word "LOTTO" surrounded by a rectangle appearing to the right of two vertically connected chevrons surrounded by a square. Inbetween the vertically connected chevrons is the shape of a diamond.</p>		
Goods/Services	<p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Leather and imitation leather; goods made of leather and imitation leather not included in other classes, namely, bags, handbags, carry - all bags, sport bags, shoulder bags, backpacks, travel bags, duffel bags, trunks, suit bags, carriers for suits, shirts and dresses, souvenir bags, clutch bags, key cases, book bags, cosmetic bags sold empty, rucksacks, briefcases and attaché cases, wheeled bags, wallets, pocket wallets, card wallets, document cases, business card cases, calling card cases, credit card cases, name card cases, purses, coin purses; animal skins and hides; trunks and traveling bags; umbrellas, parasols and walking stick handles; whips, harnesses and saddlery</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Clothing, namely, shirts, body shirts, tank shirts, camp shirts, dress shirts, sweatshirts, t-shirts, knit shirts, long-sleeved shirts, short-sleeved shirts, moisture-wicking sports shirts, polo shirts, shirts for suits, sports shirts, wind shirts, pants, padded pants, gym pants, jogging pants, lounge pants, sports pants, moisture-wicking sports pants, petti-pants, stretch pants, sweat pants, tappants, track pants, wind pants, Bermudashorts, jackets, men's and women's jackets, outer jackets, padded jackets, sleeved or sleeveless jackets, sports jackets, sweat jackets, waterproof jackets, wind-jackets, athletic uniforms, coats, trousers, vests, skirts, dresses, jumpers, socks, stockings, tights, ties, underwear, pajamas, bathing suits, swim trunks, gloves, footwear, headgear, namely, hats, caps, caps with visors, bandannas, head scarves, sun visors, berets</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0 Games and playthings, namely, marionettes, dolls, toy model trains, toy mobiles, playing cards, dominoes, rocking horses, musical toys; Gymnastic and sporting articles not included in other classes, namely, gymnastic apparatus, shin guards for athletic use, soccer shin guards; sports balls, namely, footballs, paddleballs, lacrosse balls, racket balls, squash balls, soccer balls, basket balls, volley balls, tennis balls, golf balls, rugby balls, cricket balls, rubber balls, table tennis balls, tennis rackets, table tennis bats; tennis racket covers, squash, tennis and table tennis racket paddles, table tennis paddles, knee guards for athletic use, football gloves, golf gloves, baseball gloves; Bowling gloves, Handball gloves; Hockey gloves; chest protectors for sports; football or soccer goals, soccer goal nets, soccer ball kneepads; skis; water skis, golf clubs; decorations for Christmas trees not including confectionery and illumination articles</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Retail and wholesale store services featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports; Online wholesale and retail store services featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, per-</p>		

	<p>fumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports; On-line ordering services featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports; Mail order services featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports; Catalog ordering service featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports</p>
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Attachments	<p>79096741#TMSN.png(bytes) 374-319 - Notice of Opposition.pdf(272621 bytes)</p>
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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	/JJB/
Name	James J. Bitetto
Date	03/23/2016

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

Lotto Sport Italia, S.p.A.,

Opposer,
v.

Opposition No.: [TBD]
Serial No.: 86/493,215
Mark: **SPORTS CORNER** (Design mark)
Published: November 24, 2015

Sports Corner Company,

Applicant.

Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

Notice of Opposition

Lotto Sport Italia, S.p.A. (“Opposer”), a Joint Stock Company organized and existing under the laws of Italy, and having a principal place of business at **Via Montebelluna 5/7, Trevignano (TV) 31040 ITALY**, believes that it will be damaged by, and hereby opposes, the grant of the application of **Sports Corner Company** (“Applicant”), a Company of Qatar at **Al Qassar Tower – 20th Floor, Street No. 920, PO Box 5508, West Bay, Doha QATAR**, to register the mark “SPORTS CORNER” (Design mark) shown in the application Serial Number 86/493,215 filed December 31, 2014 for “Assistance with business management; commercial or industrial management assistance” in International Class 035. Pursuant to 15 U.S.C. Section 1052, by and through its attorneys, Opposer hereby opposes the same.

1. By the application Serial No. 86/493,215 herein opposed, Applicant is seeking to obtain registration on the Principal Register of “SPORTS CORNER” (Design mark) (hereinafter “Applicant’s ‘215 mark”) for services in class 035, and particularly, for “Assistance with business management; commercial or industrial management assistance” in International Class 035. The Applicant’s ‘215 mark is a Design Mark and appears below:



2. Applicant's application Serial No. 86/493,215 for "SPORT CORNER" (Design mark) is a 44(d) basis application filed on December 31, 2014 and such mark was published for opposition on November 24, 2015. Opposer timely filed a request for a 90 day extension of time to file an opposition with the Trademark Trial and Appeal Board on December 10, 2015, which was duly granted by the Board on December 10, 2015. This Notice of Opposition is timely filed.

3. Opposer is the owner of at least the following federal trademark registration:

- a. No. 4,148,339 (hereinafter "Lotto '339 Registration"), registered on the Principal Register on May 29, 2012 for the trademark "LOTTO" (Design mark) for:
 - i. "Leather and imitation leather; goods made of leather and imitation leather not included in other classes, namely, bags, handbags, carry - all bags, sport bags, shoulder bags, backpacks, travel bags, duffel bags, trunks, suit bags, carriers for suits, shirts and dresses, souvenir bags, clutch bags, key cases, book bags, cosmetic bags sold empty, rucksacks, briefcases and attaché cases, wheeled bags, wallets, pocket wallets, card wallets, document cases, business card cases, calling card cases, credit card cases, name card cases, purses, coin purses; animal skins and hides; trunks and traveling bags; umbrellas, parasols and walking stick handles; whips, harnesses and saddlery" in **International Class 018**;
 - ii. "Clothing, namely, shirts, body shirts, tank shirts, camp shirts, dress shirts, sweatshirts, t-shirts, knit shirts, long-sleeved shirts, short-sleeved shirts, moisture-wicking sports shirts, polo shirts, shirts for suits, sports shirts, wind shirts, pants, padded pants, gym pants, jogging pants, lounge pants, sports pants, moisture-wicking sports pants, petti-pants, stretch pants, sweat pants, tap pants, track pants, wind pants, Bermuda shorts, jackets, men's and women's jackets, outer jackets, padded jackets, sleeved or sleeveless jackets, sports jackets, sweat jackets, waterproof jackets, wind-jackets, athletic uniforms, coats,

trousers, vests, skirts, dresses, jumpers, socks, stockings, tights, ties, underwear, pajamas, bathing suits, swim trunks, gloves, footwear, headgear, namely, hats, caps, caps with visors, bandannas, head scarves, sun visors, berets” in International Class 025;

- iii. “Games and playthings, namely, marionettes, dolls, toy model trains, toy mobiles, playing cards, dominoes, rocking horses, musical toys; Gymnastic and sporting articles not included in other classes, namely, gymnastic apparatus, shin guards for athletic use, soccer shin guards; sports balls, namely, footballs, paddleballs, lacrosse balls, racket balls, squash balls, soccer balls, basket balls, volley balls, tennis balls, golf balls, rugby balls, cricket balls, rubber balls, table tennis balls, tennis rackets, table tennis bats; tennis racket covers, squash, tennis and table tennis racket paddles, table tennis paddles, knee guards for athletic use, football gloves, golf gloves, baseball gloves; Bowling gloves, Handball gloves; Hockey gloves; chest protectors for sports; football or soccer goals, soccer goal nets, soccer ball knee pads; skis; water skis, golf clubs; decorations for Christmas trees not including confectionery and illumination articles “ in International Class 028; and
- iv. “Retail and wholesale store services featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports; Online wholesale and retail store services featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports; On-line ordering services featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves

for the practice of sports; Mail order services featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports; Catalog ordering service featuring clothing, sport clothing, footwear, sport footwear, headgear, belts, perfumes, cosmetics, soaps, wristwatches and pocket watches, glasses, sunglasses and reading glasses, sports glasses, frames, spectacle cases, life-saving and protective clothing and footwear, protective helmets for the practice of sports, luggage, rucksacks, bags and traveling bags for sports, bags for sports articles, articles of paper, stationary, gymnastic and sports equipment, ball for playing sports, shin guards, knee guards and gloves for the practice of sports” in International Class 035.

- b. The Opposer’s Lotto ‘339 Registration is a Design mark and appears below:



4. Opposer’s LOTTO ‘339 Registration listed above has not been cancelled, is valid, and is currently in full force and effect.

5. The Opposer has been continuously and prominently using its “LOTTO” (Design Mark) trademark in connection with the goods and services listed in its registration and has been actively promoting and expanding its use of the mark.

6. As a result of the prior prominent and widespread use in commerce by the Opposer of the aforesaid “LOTTO” (Design Mark) trademark in connection with its respective goods and services, the mark has acquired extensive goodwill, has developed a high degree of distinctiveness, is an asset of the Opposer, and is well known and recognized as identifying at

least the listed goods and services which have their origin with or have been authorized by the Opposer. In addition, Opposer's "LOTTO" (Design mark) trademark has reached the good reputation it enjoys, prior to the filing date of Applicant's '215 mark.

7. Opposer has priority with respect to the mark at issue in this Opposition. Opposer adopted and commenced use of its "LOTTO" (Design mark) as a trademark before Applicant filed its application for its '215 mark.

8. Applicant's mark "SPORTS CORNER" (Design mark) is confusingly and deceptively similar to Opposer's previously used and duly registered mark "LOTTO" (Design mark) at least in sight and/or commercial impression.

9. In particular, Applicant's mark includes the design logo: "" which is highly similar to the Opposer's design logo: "" in appearance.

10. Moreover, Applicant's mark consists of a rectangular box with multi-tone shading containing such design logo together with a literal element, which is highly similar to the Opposer's mark, which also consists of a rectangular box with multi-tone shading containing a design logo:

"SPORTS CORNER" (Design Mark):



“LOTTO” (Design Mark):

11. Applicant’s services are in Class 035 and encompass and/or are related to at least the services in Class 035 provided in connection with Opposer’s “LOTTO” (Design Mark) trademark, and such services would travel and/or be promoted through the same channels of trade, marketing and/or advertising to be provided to and/or used by, the same class of purchasers/clients.

12. Due to the similarity between Applicant’s mark and Opposer’s previously used and duly registered “LOTTO” (Design mark) trademark, and in view of their identical Class 035 designation, Applicant’s mark “SPORT CORNER” (Design Mark) is likely to cause confusion, mistake or deception as to the source of origin of Applicant’s services in that the public, the trade and others are likely to believe that Applicant’s services are: (a) the same services as Opposer’s and/or (b) endorsed, provided, sponsored, approved, licensed by, affiliated with or in some other way legitimately connected to Opposer and/or its goods, licensed products and/or services.

13. Thus, the use and registration of the Applicant’s ‘215 mark for “SPORT CORNER” (Design Mark) for services in Class 035 is likely to cause confusion or to cause mistake or deception in the trade and among purchasers/users and potential purchasers/users with Opposer’s previously used and duly registered “LOTTO” (Design Mark) trademark, causing damage to Opposer.

14. The use and registration of the Applicant’s ‘215 mark for the “SPORT CORNER” (Design Mark) mark is likely to dilute the distinctive quality of Opposer’s “LOTTO” (Design Mark) trademark, again causing damage to Opposer.

15. Opposer asserts the Applicant committed fraud in the procurement of its registration or during the prosecution of its application for registration. Applicant's '215 application contained the sworn statement, *inter alia*, that: "[T]he signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive." However, the Opposer states:

a. The Applicant is the Opposer's authorized and long-time distributor in Qatar, and thus is well familiar with the Opposer's protected trademarks and design logos.

b. The Applicant previously entered into a written Distribution Agreement with the Opposer, in which the Applicant agreed not to file any trademarks similar to the Opposer's marks.

c. As Opposer asserts that the "SPORTS CORNER" (Design Mark) is confusingly similar to the "LOTTO" (Design Mark), the Opposer hereby asserts that in filing its '215 application, the Applicant knowingly made false, material representations of fact in connection with the application with an intent to deceive the USPTO.

16. Registration of the mark shown in the Application Serial No. 86/493,215 will result in damage to Opposer under at least the provisions of Section 2(d) of United States Trademark Act, 15 U.S.C. 1052(d), pursuant to the allegations stated above.

WHEREFORE, Opposer respectfully requests that the Opposition be sustained and Application Serial Number 86/493,215 be refused registration.

Accompanying this Notice of Opposition is the required fee of \$300.00.

Dated: March 23, 2016

Respectfully submitted,
LOTTO SPORT ITALIA, S.p.A.

By its attorneys,

/Susan Paik/

Susan Paik, Esq.
James J. Bitetto, Esq.
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ATTORNEY(S) FOR OPPOSER

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on the Applicant's attorney (as listed in their 86/493,215 application) by mailing said copy on March 23, 2016 via First Class mail to:

ATTN: Kevin G. Smith
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue NW
Washington, DC 20037-3202

/Susan Paik/

Susan Paik