

ESTTA Tracking number: **ESTTA780573**

Filing date: **11/02/2016**

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	The East India Company Holdings Pte Ltd.
Granted to Date of previous extension	11/02/2016
Address	150 Orchard Road Orchard Plaza, 238841 SINGAPORE

Attorney information	Douglas N. Masters Loeb & Loeb LLP 321 North Clark Street, Suite 2300 Chicago, IL 60654 UNITED STATES dmasters@loeb.com, mjobs@loeb.com, chdoCKET@loeb.com, skunzen-dorf@loeb.com Phone:312-464-3100
----------------------	---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

Applicant Information

Application No	86376047	Publication date	07/05/2016
Opposition Filing Date	11/02/2016	Opposition Period Ends	11/02/2016
International Registration No.	NONE	International Registration Date	NONE
Applicant	Captain William G. MacDonald The John Laird Centre, 4 Park Road North Birkenhead, CH414EZ UNITED KINGDOM		


Goods/Services Affected by Opposition

Class 006. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Steel
Class 033. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Alcoholic beverages except beers
Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Business development, consulting, management, administration, planning, advice, research, risk assessment, and supervision services provided to ship owners; import and export agency services
Class 039. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Warehousing services
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Cargo surveying; provision of technical advice by engineers and scientists relating to the engineering of marine vessels for use in arbitration

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Other	Trademark Act Section 44(e).

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85115746	Application Date	08/25/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	THE EAST INDIA COMPANY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 008. First use: First Use: 0 First Use In Commerce: 0 Cutlery</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 Precious metals and their alloys, namely, gold, silver, bronze, platinum, rhodium and palladium; goods in precious metals or coated therewith, not included in other classes, namely, brooches, badges, boxes, trinket boxes, jewellery boxes, jewellery cases, watch cases, chains, watch chains, charms, tie clips, tie pins, coins, commemorative coins, cufflinks, decorative pins, earrings, figurines, ingots, thread, key rings, lockets, medallions, medals, watch bands, watch straps, rings, stands for clocks, stopwatches, sundials, table clocks, thimbles, tiaras; jewellery, precious stones; horological and chronometric instruments</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 Stationery; printed matter, namely, magazines, books, brochures and periodicals, relating to The East India Company, its history and its products, cookery books, food and wine books, calendars; photographs; printed instructional and teaching material relating to The East India Company, its history and its products; packaging, namely, bags of paper or card, gift bags of paper or card; gift boxes of paper or card; gift wrapping paper; plastic goodie bags; plastic general purpose bags; blister cards</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 Leather and imitations of leather; leather bags, hand bags, purses, wallets, attaché cases, garment bags for travelling, canvas shopping bags and re-seable shopping bags, briefcases, furniture coverings of leather, cases and boxes of leather for packaging; trunks and travelling bags; luggage tags; umbrellas, parasols, walking sticks; saddlery</p> <p>Class 020. First use: First Use: 0 First Use In Commerce: 0 Furniture; mirrors, picture frames; curtain accessories, namely, hooks, rods, rails, tracks, poles, runners, tie-backs in the nature of non-textile curtain holders and rollers; goods not included in other classes of wood, cork, reed,</p>		

cane, wicker, horn, bone, ivory, shell, amber, mother of pearl or plastic, namely, beds, bed heads, bed fittings, mirrors, cabinets, tables, dining tables, centre tables, coffee tables, occasional tables, chairs, dining chairs, sofas of all materials, doors for furniture, sideboards, bookcases, dining cabinets, ornaments, bottle racks; cushions; plastic boxes for gift wrapping

Class 021. First use: First Use: 0 First Use In Commerce: 0

Household and kitchen utensils, namely, serving dishes, serving forks, serving spoons, serving tongs, spoons, spatulas, cups, mugs, saucers, plates, basins; baskets for domestic use not of metal; bowls; vegetable and fruit mashers, straining spoons, spaghetti spoons, ladles, whisks, utensil racks, garlic presses, graters, butter curlers, pastry brushes, corkscrews, sieves, zesters, non-electric juicers, ice cream scoops, and cutting boards; containers for household use; bakeware, namely, baking trays, oven trays, roasting pans; cookware, namely, saucepans, frying pans, milk pans, saute pans, skillets, stockpots; casseroles; thalis, namely, metal serving trays; meal trays; tea sets; tea strainers; tea infusers; bone china, glassware, porcelain and earthenware, namely, candle rings and candle sticks not of precious metal; ceramic bowls, plates, mugs, cups, saucers, vases, pots and tissue box covers for household purposes; chamber pots; china ornaments; figurines of porcelain, terracotta or glass; flower pots and flower pot covers; glass receptacles, bowls and jars; jugs and pitchers; knobs of porcelain; menu card holders; napkin holders and rings not of precious metal; pepper mills and pots; salt cellars and shakers; earthenware saucepans; stew-pans; tea caddies; tea services and tea pots; vases; dishes; works of art of porcelain, terracotta or glass; picnic baskets sold empty; pottery bowls, cups, mugs, saucers, vases and pots; glass cooking pots, cups and mugs not of precious metal; drinking vessels; decanters; dishes, butter dishes and dish covers; soap dishes; door handles of porcelain; decorative plates and bowls

Class 024. First use: First Use: 0 First Use In Commerce: 0

Textiles and textile goods not included in other classes, namely, bed covers, bed linen, bed spreads, bed blankets, woolen blankets, silk blankets, baby blankets, blanket throws, cashmere blankets, children's blankets, pet blankets and travelling blankets, throws, quilts, eiderdowns, mattress covers, table covers, table linen and napkins of textile, textile serviettes, table mats; table runners, bath linen, towels and face towels, handkerchiefs of textile; bath mats; cotton fabrics denim fabrics, knitted fabrics, upholstery fabrics, non-woven textile fabrics; crepe, damask and silk; silk fabrics for printing patterns; printed calico cloth; linen cloth; textile wall hangings; tapestry wall hangings; curtains; drapes; unfitted fabric covers for furniture; blinds of textile; cushion covers; textile pelmets; curtain tie-backs in the nature of textile curtain holders

Class 025. First use: First Use: 0 First Use In Commerce: 0

Clothing, namely, coats, raincoats, belts, waistcoats, blouses and pullovers, jackets, trousers, skirts, dresses, suits, shirts and chemises, t-shirts, sweaters, underwear; hosiery, socks and stockings, gloves, ties, scarves; headgear, namely, hats, caps and headscarves; footwear, namely, boots, shoes and slippers

Class 027. First use: First Use: 0 First Use In Commerce: 0

Carpets, rugs, mats and matting, linoleum for covering existing floors; floor runners; non-textile wall hangings

Class 029. First use: First Use: 0 First Use In Commerce: 0

Jellies, jams, marmalade, compotes; edible oils and fats; Bombay mix, namely, a variable mixture of spicy dried ingredients, which may include fried lentils, peanuts, chickpea flour noodles, corn, vegetable oil, chickpeas, flaked rice, fried onion and curry leaves; dried and cooked fruits and vegetables; vegetable pastes, fish pastes; meat, game and poultry pates; fruits in tins, jars and bottles, namely, cherries, pineapple, fruit salads, apricots, pears, peaches, grapefruit, prunes, plums; dried figs; mincemeat; soups; dairy products excluding ice cream, ice milk and yogurt; eggs; milk; milk products excluding ice cream, ice milk and

yogurt; fruit preserves, vegetable preserves; pickles; cheese; quark; cream; yoghurt; butter; flavoured butter; brandy butter; pickled onions; cranberry sauce; soup and preparations for making soup; unflavoured and unsweetened gelatin; prepared and prepackaged meals of meat and fish; gift food hampers containing meat, fish, poultry and game, meat extracts, conserves, compotes, fruit conserves, caviar, pate, partridge, grouse, pheasant, chicken, curried liver, curried mutton, curried chicken, fish pastes, hams, tongues, bacon, meat in tins, glasses and terrines, beef extracts, preserved, dried, cooked and frozen fruits, vegetables, meats and fish, dry and boiled fruit, fruits in tins and bottles, cherries, pineapple, fruit salads, apricots, pears, peaches, grapefruit, prunes, plums, figs, jellies, jams, marmalade, mincemeat, soups, dairy products, eggs, milk, milk-products, dairy products, edible oils and fats, preserves, fruit preserves, vegetable preserves, pickles, cheese, quark, cream, yoghurt, butter, flavoured butter, brandy butter, pickled onions, applesauce, cranberry sauce, soup and preparations for making soup, gelatine, ready cooked meals of meat and fish, sold as a unit

Class 030. First use: First Use: 0 First Use In Commerce: 0

Coffee, coffee substitutes; coffee essences and coffee extracts, mixture of coffee and chicory; chicory and chicory mixtures, all for use as substitutes for coffee; tea, tea bags, scented teas and flavoured teas; herbal teas; cocoa, hot chocolate; sugar, rice, tapioca, sago; flour, processed cereals made from wheat, oats, barley, rusk, durum and rice; breads; spiced bread, pastry; sweets (candy); vinegars, vinaigrettes, sauces, namely, hot sauces, ketchups; pepper; spices; mustard; honey mustard; honey; treacle; biscuits; cakes; pastry; puddings; chocolates; flavoured chocolates; petit fours; pancakes; fruits sauces excluding cranberry sauce and apple sauce; salad sauces and dressings; poppadoms; chutney; relish; salts, herb salts; curry powder; gift food hampers containing coffee, coffee substitutes, coffee essences and coffee extracts, mixture of coffee and chicory, chicory and chicory mixtures, all for use as substitutes for coffee, tea, tea bags, scented teas and flavoured teas, herbal teas; cocoa, hot chocolate, sugar, rice, tapioca, sago, flour, and preparations made from flour or cereals, breads, spiced bread, pastry and confectionery, vinegars, vinaigrettes, sauces, pepper, condiments, spices, mustard, honey mustard, honey, treacle, biscuits, cakes, pastry, puddings, chocolates, flavoured chocolates, petit fours, pancakes, fruit sauces, salad sauces and dressings, poppadoms, chutney, relish, salts, herb salts, curry powder, sold as a unit

Class 032. First use: First Use: 0 First Use In Commerce: 0

Beers, ales and porters; sweet cider; syrups and concentrates for making beverages; non-alcoholic fruit cordials; mineral and aerated waters; soft drinks; fruit and vegetable drinks and fruit and vegetable juices; gift drinks hampers containing beers, ales and porters, sweet cider, syrups and concentrates for making beverages, non-alcoholic fruit cordials, mineral and aerated waters, soft drinks, fruit and vegetable drinks and fruit and vegetable juices

Class 033. First use: First Use: 0 First Use In Commerce: 0

Alcoholic beverages except beers; wines, spirits and liqueurs; hard cider; sherry; port wine; champagne; gift drinks hampers containing alcoholic beverages except beers, wines, spirits and liqueurs, hard cider, sherry, port wine, champagne, sold as a unit

Class 036. First use: First Use: 0 First Use In Commerce: 0

Financial affairs, namely, financial management, hire purchase financing, credit and loan services, department store payment protection services, all relating to store account card purchases made on-line, by mail order or in a retail store, banking services, financial investment brokerage services, commodity brokerages services, charge card and credit card services, money exchange services, debt factoring services, housing agency services, arrangement of installment loans, insurance brokerage, insurance underwriting, issuing of travelers cheques, lease purchase financing, lending against security, financing of loans,

providing finance for credit sales, savings bank services, financial valuation of personal property, safe deposit services, cheque encashment services, provision of cash dispensing facilities, saving scheme services, leasing of real estate, building leasing, mortgage banking, mortgage lending, securities brokerage, securities deposit services, management of securities portfolio, safe deposit box services, insurance brokerage services, insurance agencies, financial and investment consultancy and analysis services, money transmission services, cheque clearing services, payment of administration services, debit card services, cheque book services, recording, counting and billing services for financial transactions, real estate agencies, electronic funds transfer, issuing of travelers cheques; real estate consultation; real estate agency services; real estate management; real estate appraisal; real estate brokerage; renting of apartments and of flats

Class 037. First use: First Use: 0 First Use In Commerce: 0

Construction of buildings; repair and maintenance of buildings; repair, maintenance and installation of electrical appliances, furniture, heating and kitchen apparatus and of office machines and apparatus; repair of furs, clothing, clocks and watches, electrical appliances, film projectors, heating apparatus, furniture, shoes, upholstery and of office machines and apparatus; restoration of furniture; renovation of clothes; cabinet making; painting and wallpapering

Class 039. First use: First Use: 0 First Use In Commerce: 0

Travel arrangement; travel agency services, namely, making reservations and bookings for transportation; coach tour services; rental of coaches; escorting of travelers; delivery of goods and of furniture by road; temperature controlled garment storage; delivery of parcels; arranging for the delivery of goods overseas; transportation and delivery by road; warehousing of goods and parcels; junk, trash and debris removal services; transportation of persons and goods by air; transportation of persons and goods by land vehicles, including railway and by sea and inland waterways; information services relating to air travel, air transport, timetables, fares, schedules, connecting transport and tourist information; provision and arrangement of holidays and tours; travel agency services; agency services for arranging travel; services for the arranging of the transportation of travelers and for the warehousing of goods relating thereto; services for the booking of travel; agency services for the arranging of transportation of goods; packaging and storage of goods; consultancy and advisory services relating to the aforesaid

Class 041. First use: First Use: 0 First Use In Commerce: 0

Education and entertainment, namely, conducting classes, seminars, exhibitions and lectures in the field of the history, including history of The East India Company, food and drink, fashion, health and wellbeing; Organization of exhibitions for cultural or educational purposes; arranging exhibitions relating to history, including history of The East India Company, food and drink, fashion, health and wellbeing, all of the foregoing for educational or cultural purposes; publication of texts, books, magazines and other printed matter; book rental; lending library services; writing of articles for periodicals other than for advertising or publicity; gaming services in the nature of casino gaming; sporting and cultural activities, namely, organizing sporting and cultural community events; organization of competitions covering entertainment, lifestyle, music, sports, news, current affairs, business, finance, trade, technology, science, nature, industry, transport, art, history, travel, culture, film, games and gaming and navigation; arranging for ticket reservations for shows and other entertainment events; providing a website featuring entertainment information; conducting informal on-line programs in the fields of history, including history of The East India Company, food and drink, fashion, health and wellbeing, and printable materials distributed therewith; night clubs

Class 043. First use: First Use: 0 First Use In Commerce: 0

Services for providing food and drink; restaurant services; bar services; catering

	services; tea room services; providing temporary accommodation
--	----------------------------------------------------------------

Attachments	85115746#TMSN.png(bytes) British East India Notice of Opposition.pdf(46164 bytes) EXHIBIT A - UK reg.pdf(142324 bytes)
-------------	----------------------------------------------------------------------------------------------------------------------------------

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	/Douglas N. Masters/
Name	Douglas N. Masters
Date	11/02/2016

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

**In the Matter of App. Ser. No. 86/376,047: THE BRITISH EAST INDIA COMPANY
Published in the *Official Gazette* of July 5, 2016**

THE EAST INDIA COMPANY)	
HOLDINGS PTE. LTD,)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	
CAPTAIN WILLIAM G. MACDONALD,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

The East India Company Holdings Pte. Limited (“Opposer”), a Singapore limited company, located and doing business at 150 Orchard Road, Orchard Plaza, Singapore 238841, believes it will be damaged by registration on the Principal Register of the mark THE BRITISH EAST INDIA COMPANY, Application Serial No. 86/376,047, filed by Captain William G. MacDonald (“Applicant”), an individual, with an address at The John Laird Centre, 4 Park Road North, c/o The British East India Company Ltd., Birkenhead, United Kingdom CH414EZ, and hereby opposes the same.

As grounds for this opposition, Opposer alleges:

1. Opposer is an international seller of luxury items including gourmet teas, coffee, chocolate, and gifts. Opposer is the revitalized entity of the historic The East India Company.
2. Opposer is the owner of Application Serial No. 85/115,746 for THE EAST INDIA COMPANY (“Opposer’s Mark”) for numerous goods and services, including among others: “Alcoholic beverages except beers; wines, spirits and liqueurs; hard cider; sherry; port

wine; champagne; gift drinks hampers containing alcoholic beverages except beers, wines, spirits and liqueurs, hard cider, sherry, port wine, champagne, sold as a unit” in Class 33.

3. The application for Opposer’s Mark was filed on August 25, 2010, on an intent-to-use basis and on the basis of a foreign registration under Section 44(e) of the Trademark Act.

4. By virtue of at least the use in commerce and well-known and historical significance of Opposer’s THE EAST INDIA COMPANY mark in connection with a variety of goods, Opposer owns an extremely valuable goodwill which is symbolized by Opposer’s Mark.

5. By its Application Serial No. 86/376,047, Applicant seeks to register THE BRITISH EAST INDIA COMPANY mark (“Applicant’s Mark”) for: “Steel” in Class 6; “Alcoholic beverages except beers” in Class 33; “Business development, consulting, management, administration, planning, advice, research, risk assessment, and supervision services provided to ship owners; import and export agency services” in Class 35; “Warehousing services” in class 39, and “Cargo surveying; provision of technical advice by engineers and scientists relating to the engineering of marine vessels for use in arbitration” in Class 42 (“Applicant’s Goods & Services”). During examination of Applicant’s Mark, the terms BRITISH and COMPANY were disclaimed.

6. The application for THE BRITISH EAST INDIA COMPANY was filed on August 25, 2014 on the basis of intent-to-use and foreign registration under Section 44(e) of the Trademark Act, well after Opposer’s application for THE EAST INDIA COMPANY mark.

7. Upon information and belief, neither Applicant nor any predecessor or related company of Applicant made actual use of THE BRITISH EAST INDIA COMPANY mark prior to the filing date of the application for Applicant’s Mark.

8. Applicant's proposed use and registration of THE BRITISH EAST INDIA COMPANY mark for Applicant's Goods & Services is without Opposer's consent or permission.

9. Applicant's proposed use and registration of THE BRITISH EAST INDIA COMPANY mark is and will be damaging to Opposer.

Count I – Likelihood of Confusion under 15 U.S.C. §1052(d)

10. Opposer realleges the allegations of Paragraphs 1 through 9.

11. Applicant's THE BRITISH EAST INDIA COMPANY mark is likely to cause confusion, mistake, or deception, in relation to the goods in Class 33, in that consumers are likely to believe Applicant's Class 33 goods are Opposer's products or the products of a person or company that is sponsored, authorized or licensed by, or in some other way legitimately connected with Opposer.

Count II – Applicant Did Not Have a *Bona Fide Intent to*

Use THE BRITISH EAST INDIA COMPANY mark in Commerce

12. Opposer realleges the allegations of Paragraph 1 through 9.

13. Applicant's counsel, on behalf of Applicant, signed Application Serial No. 86/376,047 stating that Applicant "has a bona fide intention to use ... the mark in commerce on or in connection with the identified goods and/or services."

14. Upon information and belief, Applicant did not have a bona fide intent to use THE BRITISH EAST INDIA COMPANY mark in commerce with Applicant's Goods & Services on August 25, 2014, the date he filed an application for Applicant's Mark.

15. Applicant's Mark is *void ab initio*.

Count III – Foreign Registration Filing Basis Under Section 44(e) Is Invalid

16. Opposer realleges the allegations of Paragraphs 1 through 9.

17. Applicant filed its application for THE BRITISH EAST INDIA COMPANY mark as a standard character mark.

18. The foreign registration upon which Applicant relies for the Section 44(e) filing basis is UK Trade Mark No. UK0002404311B, which was registered on July 21, 2006 for the mark shown below (see Exhibit A):

The British East India Company Limited
(International Trading, Shipping & Transport)

(“UK Mark”).

19. Applicant’s THE BRITISH EAST INDIA COMPANY mark is not a substantially exact representation of the UK Mark as Applicant’s Mark only includes the first portion of the UK Mark and does not include the same font style as the UK Mark.

20. Because Applicant’s Mark is not a substantially exact representation of the mark shown in UK Trade Mark No. UK0002404311B, Applicant’s Mark is not “[a] mark duly registered in the country of origin of the foreign applicant ...” as required by Section 44(e) of the Trademark Act, and therefore Applicant cannot rely upon Section 44(e) as a basis for registration.

21. Applicant’s Mark is not registrable based upon Section 44(e) for any of Applicant’s Goods & Services.

WHEREFORE, the registration of THE BRITISH EAST INDIA COMPANY, Application Serial No. 86/376,047, for Applicant’s Goods & Services will be damaging to Opposer.

Please debit our Deposit Account No. 502876 for the filing fee and for any additional necessary fees.

Please address all correspondence to Douglas N. Masters, Esq., Loeb & Loeb LLP, 321 N. Clark Street, Suite 2300, Chicago, Illinois 60654.

Date: November 2, 2016

LOEB & LOEB LLP

By: /s/ Douglas N. Masters
Douglas N. Masters
Melaina D. Jobs
321 North Clark St., Suite 2300
Chicago, Illinois 60654
Telephone: (312) 464-3100
Facsimile: (312) 464-3111

Attorneys for Opposer

CERTIFICATE OF SERVICE

I, Sarah C. Kunzendorf, hereby certify that a copy of this **NOTICE OF OPPOSITION**

has been served upon:

THOMAS W. COLE
ROBERTS MLOTKOWSKI SAFRAN & COLE P.C.
7918 JONES BRANCH DR STE 500
MC LEAN, VIRGINIA UNITED STATES 22102-3366

first class mail, postage prepaid, on this 2nd day of November, 2016.

/s/ Sarah C. Kunzendorf

EXHIBIT A



Intellectual Property Office

Current case details for UK Trade Mark Number: UK0002404311B

Printed On: 26 October 2016

Trade mark

The British East India Company Limited
(International Trading, Shipping & Transport)

Status: Registered

Relevant dates

Filing date: 28 September 2005

Date of entry in register: 21 July 2006

Renewal date: 28 September 2025

List of goods and services

Class 6: Steel.

Class 33: Alcoholic drinks.

Class 35: Business services provided to shipowners;
import-export agency services.

Class 39: Warehousing services.

Class 42: Cargo surveying; provision of technical
advice relating to marine arbitration.

Name and Address details

Owner(s) name: Captain William G MacDonald

c/o The British East India Company
Limited, The John Laird Centre, 4 Park
Road North, Birkenhead, United

Kingdom, CH41 4EZ

[View owner's other trade marks](#)**IPO representative name:**

Murgitroyd & Company

Scotland House,, 165-169 Scotland
Street, Glasgow, United Kingdom, G5
8PL**Publication details****First advert:**Journal : 6628 Date of publication : 07
April 2006

© Crown Copyright 2016

Intellectual Property Office is an operating name of the Patent Office