

ESTTA Tracking number: **ESTTA825014**

Filing date: **06/05/2017**

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	Ashley L Dickinson		
Entity	Individual	Citizenship	UNITED STATES
Address	1011 N. LaSalle St. Chicago, IL 60610 UNITED STATES		

Attorney information	Monika R. Oyama 203 N. LaSalle St. Suite 2500 Chicago, IL 60601 UNITED STATES trademark@masudafunai.com Phone:312-245-7500		
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Applicant Information

Application No	87123822	Publication date	05/23/2017
Opposition Filing Date	06/05/2017	Opposition Period Ends	06/22/2017
Applicant	Finkel, Tracy 133 Demarest Ave. Bloomfield, NJ 07003 UNITED STATES		

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: T-shirts; Short sleeved t-shirts; hoodies; Tank-shirts; Long-sleeved t-shirts; Sweatshirts; Caps; hats; skull caps; headwear; baseball caps; knitted caps; gift packages sold as a unit consisting primarily of a sweatshirt and also including a photo frame, coffee mug and tote bag

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	87149132	Application Date	08/24/2016
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	KINDNESS IS BADASS		

Design Mark	KINDNESS IS BADASS
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2015/07/13 First Use In Commerce: 2015/07/13 Clothing, namely, t-shirts, tank tops, hoodies, sweaters, sweatpants, shorts, socks, and hats Class 041. First use: First Use: 2015/07/13 First Use In Commerce: 2015/07/13 Providing information, news, and commentary in the field of current events via the Internet; Interactive online web journals featuring news, politics, media, social media, entertainment, and topics of general interest; Publication of electronic magazines; Providing a website featuring non-downloadable videos on inspirational or motivational topics

Related Proceedings	Opposer is applying for KINDNESS IS BADASS (Serial No. 87149132) under the filing basis 1(a)
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Attachments	87149132#TMSN.png(bytes) Notice of Opposition.pdf(188621 bytes)
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Signature	/Monika R. Oyama/
Name	Monika R. Oyama
Date	06/05/2017

Notice of Opposition

Opposer: Ashley L. Dickinson
Application Appealed: 87123822
Mark: KINDNESS IS BADASS
Attorney Docket No.: 15799-10001

KINDNESS IS BADASS (U.S. Serial No. 87123822), which has been applied-for by Tracy Finkel (hereinafter referred to as the “Finkel Mark”) has been published on the Trademark Official Gazette on May 23, 2017. For the reasons set forth below, Ashley L. Dickinson (the “Opposer”) respectfully opposes the registration of the Finkel Mark as Opposer believes, in good faith, that it will sustain substantial, continuous and ongoing damages as a result of the registration of the Finkel Mark.

The Finkel Mark should not be granted registration on the Principal Register of the United States Patent and Trademark Office based on priority of the Opposer’s mark and likelihood of confusion with such mark under Section 2(d) of the U.S. Trademark Act. As further set forth below, (i) the Finkel Mark is an exact duplication of Opposer mark (U.S. Serial No. 87149132, hereinafter referred to as the “Opposer Mark”) which Opposer has used continuously and without interruption in U.S. commerce since as early as July 13, 2015, and (ii) the Finkel Mark would cause confusion relative to the Opposer Mark when used in connection with the respective goods covered by the Finkel Mark.

Priority: The Opposer Mark has priority over the Finkel Mark because the Opposer has been using the Opposer Mark in U.S. commerce at least as early as July 13, 2015. The Finkel Mark was filed as a Section 1(b) Intent to Use application on August 2, 2016, which assumes no previous use of the mark in U.S. commerce.

Likelihood of Confusion: The Office Action issued against the Opposer Mark on December 5, 2016, provides that there is a likelihood of confusion between the Finkel Mark and Opposer Mark. Opposer agrees with the Examining Attorney that there is a likelihood of confusion between the two marks because the appearance, sound, and connotation of the marks are identical, and as such, the commercial impression of the respective marks are substantially similar, if not identical. The connotation is identical because the phrase, “Kindness is Badass” conveys a message that gestures of kindness are “cool” or commendable. Additionally, the goods covered by the Finkel Mark and Opposer Mark substantially overlap, the distribution channel of the goods is the same (i.e., via e-commerce), the conditions in which consumers encounter the marks are substantially similar, and the nature of the consumers are substantially similar. With regards to the goods covered by each mark, (i) the Finkel Mark covers “T-shirts; Short sleeved t-shirts; hoodies; Tank-shops; Long-sleeved t-shirts; Sweatshirts; Caps; hats; skull caps; headwear; baseball caps; knitted caps; gift packages sold as a unit consisting primarily of a sweatshirt and also including a photo frame, coffee mug and tote bag,” whereas (ii) the Opposer Mark covers “Clothing, namely, t-shirts, tank tops, hoodies, sweaters, sweatpants, shorts, socks, and hats.” Clearly, the goods covered by the two marks substantially overlap and are directly related to one another. The distribution channels are the same because both Finkel and the Opposer sell their goods via e-commerce on their respective websites (Opposer: <http://kindakind.com/>; Finkel: <https://kindnessisbadass.com/>).

Additionally, the conditions in which the consumers encounter the marks are substantially similar because both parties use the marks on their goods as well as their respective blogs and social media accounts, such as Facebook and Instagram. Finally, the nature of the consumers is similar because they are most likely those individuals who are internet and social media users, looking for motivational and inspirational guidance.