

ESTTA Tracking number: **ESTTA835755**

Filing date: **07/26/2017**

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	Asco Group Limited
Granted to Date of previous extension	07/26/2017
Address	CHANCERY COURT THE MALL FREEPORT, 0 BAHAMAS
Attorney information	Craig S. Mende Fross Zelnick Lehrman & Zissu, P.C. 4 Times Square, 17th Floor New York, NY 10036 UNITED STATES Email: cmende@fzlz.com, aricketts@fzlz.com, rbecker@fzlz.com Phone: 212-813-5900

**Applicant Information**

Application No	87232930	Publication date	03/28/2017
Opposition Filing Date	07/26/2017	Opposition Period Ends	07/26/2017
Applicants	Dickson, Jayne 2039 Evergreen Street Burbank, CA 91505 UNITED STATES  Dickson, Jeremy 2039 Evergreen Street Burbank, CA 91505 UNITED STATES		


**Goods/Services Affected by Opposition**


Class 025. First Use: 2016/09/08 First Use In Commerce: 2016/09/08 All goods and services in the class are opposed, namely: Dresses; Hats; Jackets; Nursing apparel, namely, sweaters, hoodies, jackets, sweatshirts, tops; Pajamas; Pants; Shirts; Shoes; Shorts; Sweaters; Sweatshirts; Underwear; Children's and infants' cloth bibs
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

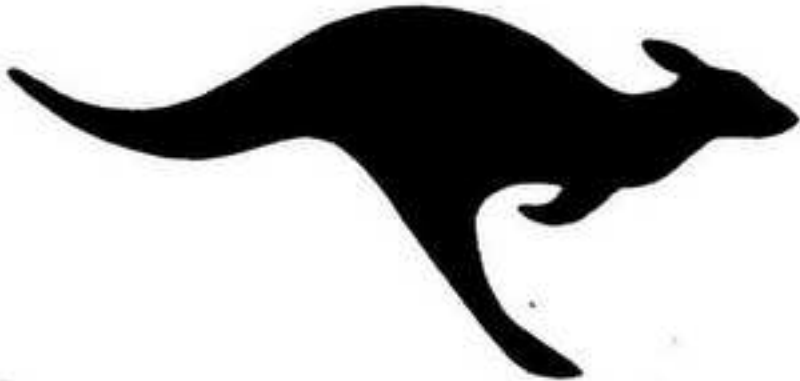
## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1384447	Application Date	08/15/1985
Registration Date	02/25/1986	Foreign Priority Date	NONE
Word Mark	KANGAROOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1980/02/00 First Use In Commerce: 1980/02/00 FOOTWEAR		

U.S. Registration No.	3050911	Application Date	06/04/2003
Registration Date	01/24/2006	Foreign Priority Date	12/06/2002
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 [ bags; namely, all purpose athletic bags, tote bags, rucksacks, and backpacks ] Class 025. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 footwear [ and clothing, namely, headwear, shirts, and t-shirts, not in the nature of underwear ]		

U.S. Registration No.	5061693	Application Date	09/28/2012
Registration Date	10/18/2016	Foreign Priority Date	NONE
Word Mark	KANGAROOS		

Design Mark	
Description of Mark	The mark consists of the word "KANGAROOS" with a kangaroo design.
Goods/Services	Class 018. First use: First Use: 0 First Use In Commerce: 0 Bags, namely, all purpose sports bags, handbags, purses, rucksacks, satchels, travelling bags, duffel bags, garment bags for travel, backpacks, briefcase type portfolios, attaché cases, wallets, briefcases, trunks for travelling, suitcases; umbrellas and parasols Class 025. First use: First Use: 0 First Use In Commerce: 0 Footwear, shoes, sports boots, sports shoes; clothing, namely, headwear, hosiery, hats, headbands, jackets, jerseys, jumpers, leggings, shirts, shorts, singlets, skirts, socks, sports jerseys, sweaters, sweat shirts, t-shirts not in the nature of underwear, trousers; and water-proof clothing, namely waterproof jackets and coats; athletic wear, namely, warm up suits, sweat shirts and sweat pants

U.S. Registration No.	5003592	Application Date	09/28/2012
Registration Date	07/19/2016	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a kangaroo design.		
Goods/Services	Class 025. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 Footwear		

Attachments	73553613#TMSN.png( bytes ) 78975501#TMSN.png( bytes )
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Signature	/csm/
Name	Craig S. Mende
Date	07/26/2017

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

Asco Group Limited,	X	
	:	
Opposer,	:	Opposition No.
	:	
- against -	:	<b>NOTICE OF OPPOSITION</b>
	:	
Jeremy Dickson and Jayne Dickson,	:	
	:	
Applicants.	:	
	X	

Opposer, Asco Group Limited (“Asco” or “Opposer”), a corporation organized under the laws of the Bahamas with a principal place of business at Chancery Court, The Mall, Freeport, BAHAMAS, believes that it would be damaged by the issuance of a registration for the kangaroo design mark shown in Application Serial No. 87232930 (the “Application”) filed on November 10, 2016 by Jeremy Dickson and Jayne Dickson (“Applicants”) for goods in Class 25, and therefore opposes the same. As grounds for this opposition, Opposer, by its counsel, Fross Zelnick Lehrman & Zissu, P.C., states as follows:

FACTS

A. Opposer and its Famous KANGAROOS Marks




1. Opposer has long used the famous marks KANGAROOS and a fanciful kangaroo design shown below (together, the “Kangaroo Marks”) on and in connection with its goods for many years.



2. Through extensive promotion and use, and the success of Opposer's offerings under these marks, the Kangaroo Marks have come to represent substantial goodwill.

3. Dating to long before any date upon which Applicants can rely, Opposer's Kangaroo Marks have become uniquely identified with Opposer and its goods and have come to identify the goods of Opposer exclusively. The Kangaroo Marks have become famous marks of Opposer.

4. Opposer owns numerous federal registrations for the Kangaroo Marks, including the following (among others):

Mark	Reg'n No.	Class 25 Goods (other classes omitted here)
<b>KangaROOS</b>	1384447	Footwear
	3050911	Footwear
 <b>KangaROOS</b>	5061693	Footwear, shoes, sports boots, sports shoes; clothing, namely, headwear, hosiery, hats, headbands, jackets, jerseys, jumpers, leggings, shirts, shorts, singlets, skirts, socks, sports jerseys, sweaters, sweat shirts, t-shirts not in the nature of underwear, trousers; and water-proof clothing, namely waterproof jackets and coats; athletic wear, namely, warm up suits, sweat shirts and sweat pants
	5003592	Footwear

5. Opposer's foregoing registrations are valid, subsisting, and in full force and effect. These registrations constitute evidence of the validity of the registered marks and of the

registrations thereof, and of Opposer's ownership of the marks and exclusive right to use the marks in commerce in connection with the identified goods.

B. Applicants and their Application

6. Upon information and belief, Applicants are individuals both residing at 2039 Evergreen Street, Burbank, California 91505.

7. On November 10, 2016, Applicants filed the Application to register the kangaroo design mark below ("Applicants' Mark"), which covers the following goods in Class 25: "Dresses; Hats; Jackets; Nursing apparel, namely, sweaters, hoodies, jackets, sweatshirts, tops; Pajamas; Pants; Shirts; Shoes; Shorts; Sweaters; Sweatshirts; Underwear; Children's and infants' cloth bibs," based on alleged first use in commerce on September 8, 2016.



8. Prior to Applicants' adoption of and application to register Applicants' Mark, Applicants were on constructive notice of Opposer's prior rights in the Kangaroo Marks by virtue of, *inter alia*, Opposer's above-referenced registrations.

9. Upon information and belief, prior to Applicants' adoption of and application to register Applicants' Mark, Applicants were on actual notice of Opposer's prior rights in the Kangaroo Marks by virtue of Opposer's extensive use thereof.

**FIRST CLAIM FOR RELIEF:  
LIKELIHOOD OF CONFUSION**

10. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 9.

11. The filing date of Applicants' Application, and the first use in commerce date alleged therein, are significantly later than Opposer's first use of the Kangaroo Marks and significantly after Opposer acquired rights in and federal registrations for the Kangaroo Marks. As such, Opposer's rights in the Kangaroo Marks are prior and superior to any rights Applicants may claim in Applicants' Mark.

12. Applicants' Mark is highly similar to Opposer's Kangaroo Marks in appearance and commercial impression.

13. The goods identified in the Application are identical and/or closely related to goods that Opposer has long offered under its Kangaroo Marks.

14. In view of the similarity of the marks and goods, use by Applicants of Applicants' Mark for the goods identified in the Application is likely to confuse consumers into believing, falsely, that Applicants' goods originate with, are sponsored or approved by, or are otherwise connected with Opposer or the goods Opposer offers under its Kangaroo Marks. Any use of Applicants' Mark by Applicants is, therefore, likely to cause confusion, cause mistake or to deceive the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

15. As a result of the foregoing, registration to Applicants of Applicants' Mark in would be inconsistent with Opposer's prior exclusive rights in Opposer's Kangaroo Marks and would threaten the investment and goodwill of Opposer in its Kangaroo Marks. Opposer therefore would be injured by registration of Applicants' Mark.

#### SECOND CLAIM FOR RELIEF: NON-USE

16. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 15.

17. Upon information and belief, Applicants' Mark was not being used in commerce for most of the goods identified in the Application at the time Applicants filed their Application.



18. Upon information and belief, Applicants' Mark is not presently being used in commerce for most of the goods identified in their Application.

19. Upon information and belief, Applicants have never used Applicants' Mark in commerce for most of the goods identified in their Application.

20. Upon information and belief, Applicants' Mark has only been used for one product in the identification of goods in the Application, namely, a top for mothers carrying and nursing children ("Tops").

21. Because Applicant's Mark was not in use in commerce on or prior to the filing date of the Application in connection with most of the goods listed in the Application, the Application is void *ab initio* under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a). By reason of the foregoing, Opposer would be damaged by the registration of Applicant's Mark.

THIRD CLAIM FOR RELIEF: FRAUD ON THE PTO

22. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 21.

23. In connection with the Application, Applicants submitted a Declaration that, *inter alia*, "the applicant is using the mark in commerce on or in connection with the goods/services in the application ...."

24. When the Application was filed, Applicants knew that Applicant's Mark was not in use for any goods identified in the application other than Tops.

25. When the Application was filed, Applicants knew that Applicants' Mark was not in use for: Dresses; Hats; Jackets; Nursing apparel, namely, sweaters, hoodies, jackets, sweatshirts; Pajamas; Pants; Shirts; Shoes; Shorts; Sweaters; Sweatshirts; Underwear; Children's and infants' cloth bibs.

26. Applicants therefore knew that the Declaration submitted in support of their Application was false.

27. The false representation that Applicants' Mark was in use for the goods listed in the Application is material. Applicants filed the Application based on alleged use in commerce for all of the goods identified in the Application. By making their false representations as to use to the PTO, Applicant intended to and did deceive the PTO, and thereby sought to secure registered trademark rights well beyond any rights to which it could be entitled.

28. As a result of Applicants' willful and material false statement in connection with the Application, Applicants have committed fraud against the PTO, which invalidates their Application. By reason of the foregoing, Opposer would be damaged by the registration of Applicants' Mark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that registration of Applicants' Mark be denied in its entirety.

Dated: New York, New York  
July 26, 2017

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 

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*Attorneys for Opposer*