

ESTTA Tracking number: **ESTTA863776**

Filing date: **12/11/2017**

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	DKH Retail Limited
Granted to Date of previous extension	12/10/2017
Address	Unit 60 The Runnings Cheltenham Gloucestershire, GL519NW UNITED KINGDOM

Domestic Representative	Ricardo Fischer Arent Fox LLP 1717 K Street NW Washington, DC 20006 UNITED STATES Email: diana.bae@arentfox.com, TMDocket@ARENTFOX.COM Phone: 2023503695
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Applicant Information

Application No	87097430	Publication date	06/13/2017
Opposition Filing Date	12/11/2017	Opposition Period Ends	12/10/2017
Applicant	Aviator Nation, Inc. 1224 Abbot Kinney Blvd. Venice, CA 90291 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2016/06/29 First Use In Commerce: 2016/06/29
All goods and services in the class are opposed, namely: Head wear; Pants; Shirts; Shorts; Sweat-jackets; Sweat shirts; Sweat suits; T-shirts; Sweat shirts; T-shirts

Grounds for Opposition

The mark comprises matter that, as a whole, is functional	Trademark Act Section 2(e)(5)
Failure to function as a mark	Trademark Act Sections 1, 2 and 45
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)

Attachments	DKH Retail Notice of Opposition Aviator Nation Stripes Design.pdf(92280 bytes)
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Signature	/diana s. bae/
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Name	Diana Bae
Date	12/11/2017

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

In re Application No. 87/097430 for a multi-colored stripe design mark filed on July 8, 2016, and published on June 13, 2017.

DKH RETAIL LIMITED,	:	
	:	
Opposer	:	
	:	Opp. No. _____
v.	:	
	:	
AVIATOR NATION, INC.	:	
	:	
Applicant.	:	

NOTICE OF OPPOSITION

DKH Retail Limited (“Opposer”), a limited liability company duly organized and existing under the laws of the United Kingdom and having a principal business address of Unit 60, The Runnings, Cheltenham Gloucestershire, GL519NW, United Kingdom, believes that it will be damaged by the registration of the multi-colored stripe design mark found in U.S. Application No. 87/097430 by Aviator Nation, Inc. (“Applicant”). Opposer hereby opposes this application under the provisions of Lanham Act §13, 15 U.S.C. §1063.

As grounds for the opposition, Opposer alleges as follows:

1. Opposer, along with its affiliates and related companies, is a globally recognized clothing and apparel company that operates in nearly 150 countries worldwide.

2. Opposer sells clothing in the United States and internationally, and is the owner of various U.S. trademark registrations and applications for marks in International Class 25, including but not limited to U.S. Registration Nos. 5337798, 5248524, and 5243667.

3. Through its family of affiliates and related companies, Opposer has operated in the apparel and retail business since 2003.

4. On July 8, 2016, Applicant filed Application No. 87/097430 for a multi-colored stripe design that “consists of a rectangle consisting of horizontal stripes arranged from top to bottom in the colors dark red-orange, light red-orange, orange and yellow,” for use in connection with “Head wear; Pants; Shirts; Shorts; Sweat jackets; Sweat shirts; Sweat suits; T-shirts; Sweat shirts; T-shirts” in Class 25, which Application is the subject of this opposition.

5. Applicant also owns Application No. 87/097509 for a multi-colored stripe design, which has been refused as non-distinctive trade dress, and Registration No. 5076084, which, as originally applied for, was a multi-colored stripe design, and was initially refused as a color mark lacking inherent distinctiveness.

6. Applicant’s alleged mark found in Application No. 87/097430, consists only of colored stripes and thus, lacks inherent distinctiveness and Applicant was never required to prove acquired distinctiveness during examination in a manner consistent with the treatment of its other applications.

7. Opposer has a bona fide intent to use designs that incorporate a multi-colored stripe design on clothing and accessories in the United States, and believes it will be damaged by the registration of Applicant’s alleged mark.

8. Since prior to the filing date of Application No. 87/097430, parties other than Applicant have used non-distinctive, ornamental, multi-colored stripe designs that are identical or similar to Applicant's alleged mark on and in connection with Class 25 goods.

9. Such multi-colored stripe designs have become associated in the minds of the purchasing public as non-distinctive, ornamental designs that convey the idea or impression of a rainbow, sunrise, or sunset. Such designs are particularly popular on clothing and accessories targeted to the California surfing industry.

10. Such multi-colored stripe designs, like the one featured in Applicant's alleged mark, have become recognized as non-distinctive, ornamental designs, such that they are incapable of functioning as a trademark when displayed on the face of clothing and accessories, because they neither identify nor distinguish the source of the goods.

11. Upon information and belief, Applicant knew at the time it filed Application No. 87/097430 that the multi-colored stripe design was used by parties other than Applicant in connection with clothing and accessories, and therefore it had no right to exclusively appropriate the design.

12. Applicant's alleged mark is incapable of functioning as a trademark or a source indicator because it is mere ornamentation and is aesthetically functional.

13. Applicant has used a number of variations of multi-colored stripe designs on its products that either feature different colors than those in Application No. 87/097430, or that feature the same colors in different orders, such that the purchasing public will perceive Applicant's multi-colored stripe designs as ornamental features of Applicant's Class 25 products, rather than source-identifying marks.

14. The multi-colored striped design mark that Applicant seeks to register is commonly and frequently used within the fashion and clothing industry as a decorative feature on clothing and accessories, particularly within the surfing industry and community.

15. Multi-colored stripes serve merely as ornamentation on clothing and accessories and marks consisting of solely color are generally incapable of identifying source.

16. Applicant's alleged mark, consisting of a particular color combination applied to its goods, is ornamental and has not become distinctive as an indication of source of the Applicant's goods.

17. The purchasing public would perceive Applicant's alleged mark as a merely ornamental design, rather than an indication of source.

18. Additionally, the color combination identified in Applicant's alleged mark serves an aesthetically functional purpose in connection with clothing and apparel, given that this is the color combination often used to depict the sun, sunrises, sunsets, and various rainbow designs, among other designs. Accordingly, Applicant's alleged mark comprises matter that, as a whole, is functional.

19. Opposer, as well as other retailers and the public, would be damaged if a registration were granted to Applicant for the alleged mark, which would provide Applicant with exclusive rights over a commonly used and aesthetically functional design, and consequently inhibit competition.

20. Granting the registration would provide Applicant with a non-reputation related competitive advantage over third parties.

21. Applicant's alleged mark lacks distinctiveness and has not acquired distinctiveness; does not function as a trademark; and comprises matter that, as a whole, is functional, under Trademark Act §§ 1, 2, and 45. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's alleged mark, and registration should be refused.

WHEREFORE, based on the foregoing, Opposer prays that this opposition be sustained and that registration be denied.

Respectfully submitted,

DKH RETAIL LIMITED

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Date: December 11, 2017