

ESTTA Tracking number: **ESTTA873038**

Filing date: **01/24/2018**

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	Tumi, Inc.
Granted to Date of previous extension	02/14/2018
Address	1001 Durham Avenue South Plainfield, NJ 07080 UNITED STATES
Attorney information	Ben Natter Haug Partners, LLP 745 Fifth Avenue New York, NY 10151 UNITED STATES Email: bnatter@haugpartners.com, docket@haugpartners.com, csamay@haugpartners.com

**Applicant Information**

Application No	87247204	Publication date	10/17/2017
Opposition Filing Date	01/24/2018	Opposition Period Ends	02/14/2018
Applicant	On Five Corp. Suite 701 250 W. 39th St. New York, NY 10018 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: Water proof jackets, jackets, coats, wind resistant jackets, vest, anoraks, parkas, leather coats, leather jackets, coats, jackets, over coats, rain-coats, sport coats, trench coats, wind coats, bed jackets, blazers, boleros, dusters in thenature of coats, hats, headwear, shawls, belts, caps, footwear, neckwear, t-shirts, denims, slacks, jeans, sleepwear, underwear, dress shirts, sport shirts, knit shirts, sweaters, pullovers, turtlenecks, cardigans, hosiery, socks, ties, suspenders, capes, cassocks, dresses, slippers, shoes, shorts, skirts, robes, blouses, ascots, scarves, gloves, mittens, baby bodysuits
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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)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2805311	Application Date	02/06/2001
Registration Date	01/13/2004	Foreign Priority Date	NONE
Word Mark	T-TECH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2000/11/30 First Use In Commerce: 2000/11/30 Purses, women handbags, clutches, shoulder bags, toiletry cases sold empty, make-up bags sold empty, leather shopping bags, suitcases, carry on luggage, travelkits sold empty, shoulder bags, back packs, book bags, waist packs, key cases, pocket wallets, school bags, all purposesports bags, tote bags, attache cases, briefcase-type portfolios and briefcases		

U.S. Registration No.	3595760	Application Date	09/13/2007
Registration Date	03/24/2009	Foreign Priority Date	NONE
Word Mark	T		
Design Mark			

Description of Mark	The mark consists of the letter "T" in a circle.
Goods/Services	Class 018. First use: First Use: 2008/02/01 First Use In Commerce: 2008/02/01 Purses; Handbags; Clutches; Shoulder bags; Toiletry cases sold empty; Make-up bags sold empty; Leather shopping bags; Suitcases; Luggage; Travel bags; Backpacks; Book bags; Waist packs; Key cases; Pocket wallets; School bags; All purpose sport bags; Tote bags; Attache cases; Briefcase-type portfolios; Briefcases Class 025. First use: First Use: 2008/02/01 First Use In Commerce: 2008/02/01 Coats; Jackets; Vests; Overcoats; Sportcoats; Raincoats; Trench coats; Leathercoats; Coats for men and women; Anoraks; Parkas; Blazers; Wind resistant jackets; [ Bed jackets; Boleros; Dusters; Shawls; Capes; Cassocks; Dress shirts; Dresssuits; Dresses; Knit shirts; Sweaters; Cardigans; Turtlenecks; Denims; Underwear; Sleep wear; Robes; Slacks; Blouses; ]T-shirts; [ Shorts; Skirts; Socks; Hosiery; Ties; Suspenders; Shoes; Slippers; Belts; Footwear; Neckwear; Ascots; Scarves; Gloves; Mittens; Body suits; ] Head wear; Hats; Caps

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark			
Goods/Services	Goods in classes 9, 18 and 25.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	T-TECH		
Goods/Services	Goods in classes 9 and 25.		

Attachments	76205532#TMSN.png( bytes ) 77278576#TMSN.png( bytes ) T Tech.JPG Opposition 012418.pdf(134835 bytes ) Exhibit A 0124.pdf(64635 bytes )
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Signature	//Ben Natter//
Name	Ben Natter
Date	01/24/2018

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

Tumi Inc.,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.
	:	
On-Five Corporation.,	:	
	:	
Applicant.	:	
	:	

**NOTICE OF OPPOSITION**

Tumi Inc. (“Opposer”), a corporation organized under the laws of New Jersey with offices at 1001 Durham Avenue, South Plainfield, NJ, 07080, will be damaged by registration of the mark T-TECH (plus design), which is the subject of Application Ser. No. 87/247,204, and hereby opposes registration of the same under the provisions of Section 13 of the Trademark Act of 1946, as amended, 15 U.S.C. § 1063 and Trademark Rule 2.101.


As grounds for opposition, Opposer alleges as follows:

1. Upon information and belief, Applicant On Five Corporation (“Applicant”), a corporation organized and existing under the laws of the State of New York, and having its principal place of business located at 250 W. 39th St. New York, New York 10018, is the owner of United States Trademark Application Ser. No. 87/247,204 seeking to register the mark T-TECH plus design for “Water proof jackets, jackets, coats, wind resistant jackets, vest, anoraks, parkas, leather coats, leather jackets, coats, jackets, over coats, raincoats, sport coats, trench coats, wind coats, bed jackets, blazers, boleros, dusters in the nature of coats, hats, headwear, shawls, belts, caps, footwear, neckwear, t-shirts, denims, slacks, jeans, sleepwear, underwear, dress shirts, sport

shirts, knit shirts, sweaters, pullovers, turtlenecks, cardigans, hosiery, socks, ties, suspenders, capes, cassocks, dresses, slippers, shoes, shorts, skirts, robes, blouses, ascots, scarves, gloves, mittens, baby bodysuits” in International Class 25, on an intent to use basis. Upon information and belief, Applicant is not currently using the mark in connection with such goods.

2. Opposer is the owner of the famous Tumi brand. Since at least as early as 2000, Opposer has offered for sale, in the United States and around the world, goods in class 18 bearing the mark T-TECH. Since at least as early as 2008, Opposer has offered for sale in the United States and around the world goods in class 25 bearing the T-TECH and T-TECH plus design mark, which is identical to the mark of Application Serial No. 87/247,204.

3. In addition to common law rights to the T-TECH word and design marks in classes 18 and 25, Opposer is the owner of the following related trademark registrations in the United States:

Mark	Registration No.	Registration Date	International Class & Goods/Services
T-TECH	2,805,311	January 13, 2004	IC 018
	3,595,760	March 24, 2009	IC 018 and 025

Printouts of the USPTO TSDR information showing the current status and title for each of the foregoing registrations are attached as Exhibit A pursuant to Trademark Rule 2.122(d)(1).

4. Opposer’s rights in the T-TECH plus design mark are prior and superior to any rights of Applicant in the Mark.

5. Upon information and belief, a principal or principals of Applicant are related to Level 8 Apparel, LLC, (“Level 8”) a past defaulting and now bankrupt licensee of Opposer for the T-TECH and T-TECH plus design mark in connection with goods in class 25. According to database records, Applicant and defaulting licensee Level 8 share the same company President, Frances (Frank) Spadaro. According to database records, contemporaneous with the demise of Level 8, Spadaro created the entity On Five Corporation and launched a website that is identical in all relevant respects to the website of defaulting licensee Level 8, where it presumably intends to market products bearing the mark the is the subject of this opposition proceeding. Shortly thereafter, on November 23, 2016, Applicant filed the instant application for registration of the identical mark to which former defaulting licensee Level 8 had earlier been licensed by Opposer to use. Upon information and belief, Applicant’s foregoing actions, including its attempted registration of the opposed mark, were performed with knowledge of Opposer’s prior and superior rights in the T-TECH plus design mark.

6. Responsive to an office action received on March 5, 2017, on September 5, 2017, Applicant submitted a sworn declaration to the USPTO in which it stated it was entitled to use the subject mark in commerce. The declaration was executed on August 29, 2017 and warned of the following: “The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.”

7. Upon information and belief on August 29, 2017, Bokyoung Kim, CEO of Applicant, was aware of Opposer’s prior use of the mark and the existence of a prior license

agreement through a related company for identical goods yet, nevertheless, executed a declaration which states that “no other persons, except, if applicable, concurrent users, have 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 persons, to cause confusion or mistake, or to deceive”, knowing such statement was false.

8. Upon information and belief, Applicant submitted the declaration to the USPTO knowing that it contained fraudulent statements and that it was not entitled to use the mark in commerce.

9. Upon information and belief, Applicant misrepresented the nature of its rights to the mark at the time it submitted the declaration and continued to prosecute the trademark application that is the subject of this opposition.

10. Upon information and belief, said false statements were made with the intent to induce the USPTO to grant said registration, and reasonably relying upon the truth of said false statements, the application later published for opposition.

11. Opposer has made substantial investments in advertising, promoting, marketing and developing public awareness for Opposer’s goods offered under Opposer’s T-TECH marks in the United States. Indeed, Opposer has established substantial goodwill in its marks through such activities, and by virtue of having made substantial sales of goods in the United States in connection with the T-TECH marks.

12. Applicant’s mark is identical to Opposer’s T-TECH plus design mark and confusingly similar to the marks of the registrations listed above.



13. Opposer will be damaged by the registration of the Application as the mark is identical to Applicant's and is likely to cause confusion, mistake and deception, with consequent irreparable damage to Opposer's business and goodwill in violation of Section 2(d) of the United States Trademark Act of 1946, as amended, 15 U.S.C. § 1052(d), and otherwise will improperly give the appearance of exclusive statutory ownership rights in the T-TECH plus design mark to Applicant in derogation of Opposer's superior and prior rights.

14. Consumer confusion is very likely as between Applicant's mark and Opposer's marks because the marks are identical and used in an identical manner.

15. Applicant's registration and use of the mark for the applied goods will allow Applicant to trade on the goodwill established by Opposer.

16. Registration of the Application should be refused for the reasons set forth above.

WHEREFORE, Opposer requests that this opposition be sustained and that Application Serial No. 87/247,204 be refused.

Dated: New York, NY

January 24, 2018

Respectfully submitted,  
HAUG PARTNERS LLP

By:           /Ben Natter/          

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Attorneys for Petitioner

**CERTIFICATE OF SERVICE**

On this January 24, 2018, a true and correct copy of the foregoing document, was served by e-mailing a copy to Applicant's Attorney of Record John O'Malley at jomalley@vklaw.com.

/s/Ben Natter/

Ben Natter

# EXHIBIT A

**Int. Cl.: 18**

**Prior U.S. Cls.: 1, 2, 3, 22, and 41**

**Reg. No. 2,805,311**

**United States Patent and Trademark Office**

**Registered Jan. 13, 2004**

## **TRADEMARK PRINCIPAL REGISTER**

### **T-TECH**

TUMI, INC. (NEW JERSEY CORPORATION)  
1001 DURHAM AVENUE  
SOUTH PLAINFIELD, NJ 07080

FOR: PURSES, WOMEN HANDBAGS, CLUTCHES, SHOULDER BAGS, TOILETRY CASES SOLD EMPTY, MAKE-UP BAGS SOLD EMPTY, LEATHER SHOPPING BAGS, SUITCASES, CARRY ON LUGGAGE, TRAVEL KITS SOLD EMPTY, SHOULDER BAGS, BACK PACKS, BOOK BAGS, WAIST PACKS, KEY CASES, POCKET WALLETS, SCHOOL BAGS,

ALL PURPOSE SPORTS BAGS, TOTE BAGS, ATTACHE CASES, BRIEFCASE-TYPE PORTFOLIOS AND BRIEFCASES, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 11-30-2000; IN COMMERCE 11-30-2000.

SN 76-205,532, FILED 2-6-2001.

ANGELA M. MICHELI, EXAMINING ATTORNEY

**Int. Cls.: 18 and 25**

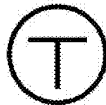
**Prior U.S. Cls.: 1, 2, 3, 22, 39, and 41**

**Reg. No. 3,595,760**

**United States Patent and Trademark Office**

**Registered Mar. 24, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**



TUMI, INC. (NEW JERSEY CORPORATION)  
1001 DURHAM AVENUE  
SOUTH PLAINFIELD, NJ 07080

FOR: PURSES; HANDBAGS; CLUTCHES; SHOULDER BAGS; TOILETRY CASES SOLD EMPTY; MAKE-UP BAGS SOLD EMPTY; LEATHER SHOPPING BAGS; SUITCASES; LUGGAGE; TRAVEL BAGS; BACKPACKS; BOOK BAGS; WAIST PACKS; KEY CASES; POCKET WALLETS; SCHOOL BAGS; ALL PURPOSE SPORT BAGS; TOTE BAGS; ATTACHE CASES; BRIEFCASE-TYPE PORTFOLIOS; BRIEFCASES, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 2-1-2008; IN COMMERCE 2-1-2008.

FOR: COATS; JACKETS; VESTS; OVERCOATS; SPORT COATS; RAINCOATS; TRENCH COATS; LEATHER COATS; COATS FOR MEN AND WOMEN; ANORAKS; PARKAS; BLAZERS; WIND RESISTANT JACKETS; BED JACKETS; BOLEROS;

DUSTERS; SHAWLS; CAPES; CASSOCKS; DRESS SHIRTS; DRESS SUITS; DRESSES; KNIT SHIRTS; SWEATERS; CARDIGANS; TURTLENECKS; DENIMS; UNDERWEAR; SLEEP WEAR; ROBES; SLACKS; BLOUSES; T-SHIRTS; SHORTS; SKIRTS; SOCKS; HOSIERY; TIES; SUSPENDERS; SHOES; SLIPPERS; BELTS; FOOTWEAR; NECKWEAR; ASCOTS; SCARVES; GLOVES; MITTENS; BODY SUITS; HEAD WEAR; HATS; CAPS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 2-1-2008; IN COMMERCE 2-1-2008.

OWNER OF U.S. REG. NO. 2,805,311.

THE MARK CONSISTS OF THE LETTER "T" IN A CIRCLE.

SN 77-278,576, FILED 9-13-2007.

DAVID C. REIHNER, EXAMINING ATTORNEY