

ESTTA Tracking number: **ESTTA884313**

Filing date: **03/19/2018**

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	The Arsenal Football Club plc
Granted to Date of previous extension	03/18/2018
Address	75 Drayton Park London, N5 1BU UNITED KINGDOM
Attorney information	Laura Popp-Rosenberg Fross Zelnick Lerhman & Zissu, P.C. 4 Times Square, 17th Floor New York, NY 10036 UNITED STATES Email: lpopp-rosenberg@fzlj.com Phone: (212) 813-5900

**Applicant Information**

Application No	87420915	Publication date	09/19/2017
Opposition Filing Date	03/19/2018	Opposition Period Ends	03/18/2018
Applicant	UBM IP Luxembourg Sarl 17 Boulevard Prince Henri Luxembourg, L-1724 LUXEMBOURG		

**Goods/Services Affected by Opposition**

<p>Class 035. First Use: 2011/08/03 First Use In Commerce: 2011/08/03 All goods and services in the class are opposed, namely: Arranging and conducting trade shows in the fields of information security, computer and network security, data and telephony network security, Internet security, computer and network technology, computer and network hardware and computer and network software, none of the foregoing pertaining to the arranging or conducting of sporting events or athletic competitions</p>
<p>Class 041. First Use: 2011/08/03 First Use In Commerce: 2011/08/03 All goods and services in the class are opposed, namely: Educational conferences, workshops and seminars for others in the fields of information security, computer and network security, data and telephony network security, Internet security, computer and network technology, computer and network hardware and computer and network software, none of the foregoing pertaining to the arranging or conducting sporting events or athletic competitions</p>

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
--------------------------------------	----------------------------


Dilution by blurring	Trademark Act Sections 2 and 43(c)
----------------------	------------------------------------

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2653016	Application Date	09/24/1997
Registration Date	11/26/2002	Foreign Priority Date	NONE
Word Mark	ARSENAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 video games software and hardware; computer games software and hardware; video game machines for use with televisions; computer programs for playing games; [ camera cases; ] but not including any such goods relating to weapons, ammunition or other military apparatus</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 medals and medallions; jewelry and imitation jewelry; clocks and watches [ ; jewelry cases of precious metal ]</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 stationery; folders; binders; diaries and personal organizers; writing instruments; posters; photographs; albums, namely, photograph and collector card albums; philatelic stamps; stickers; decalomanias; calendars; [ maps; ] writing paper; drawing paper; note books; [ address books; ] ordinary playing cards; [ coasters of paper; table mats of paper; flags and pennants of paper; ] but not including any such goods relating to weapons, ammunition or other military equipment</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 cases, namely, attache cases, business card cases, credit card cases, calling card cases, document cases, [ key cases, ] overnight cases, passport cases, cosmetic cases sold empty, toiletry cases sold empty, vanity cases sold empty; [ suitcases; articles of luggage; ] umbrellas; bags, namely, school book bags, barrel bags, beach bags, book bags, carry-on bags, clutch bags, diaper bags, duffel bags, gym bags, leather shopping bags, overnight bags, school bags, shoulder bags, tote bags, travel bags, garment bags, shoe bags, bags for merchandise packaging consisting of envelopes and pouches; holdalls; wallets; purses; key cases; leather or imitation leather key fobs</p> <p>Class 020. First use: First Use: 0 First Use In Commerce: 0 cushions</p> <p>Class 024. First use: First Use: 0 First Use In Commerce: 0 cloth flags and pennants; bed covers; sheets and pillow cases; household cloths for drying glasses and dishes; towels; bar cloths; textile articles, namely, curtains, duvet covers, table mats and coasters; [ table linen; ] table mats and coasters not of paper</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 articles of outer clothing, namely, sweatshirts, shorts, rain jackets, polo shirts, hooded tops, T-shirts, jackets, swim suits, [ bikinis, ] swim shorts, bath robes, boxer shorts, overshirts, sweaters, pullovers, jumpers, [ jeans, ] ties, hats, footwear, headwear [ and belts; leather or imitation leather belts ]</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0 board games; card games; bath toys; infant toys; mechanical toys and parts and fittings therefor; [ toy model hobby craft kits and parts and fittings therefore; ] but not including any such goods being toy weapons or goods relating to toy</p>		

	<p>weapons  Class 041. First use: First Use: 0 First Use In Commerce: 0  [ providing facilities for seminar presentations ]  Class 042. First use: First Use: 0 First Use In Commerce: 0  [ rental of rooms; providing convention facilities; providing facilities for exhibitions; provision of restaurant, bar and catering facilities; provision of wedding, party and banqueting facilities ]</p>
--	---

U.S. Registration No.	2987168	Application Date	02/26/2003
Registration Date	08/23/2005	Foreign Priority Date	NONE
Word Mark	ARSENAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 ((Organization of sporting events;, namely, arranging and conducting athletic, soccer, [and football ]competitions; providing facilities for [gymnastic and] recreation activities; providing facilities for soccer matches;[ providing facilities for athletic tournaments;]) provision of sports information services; ((butnot including any such services relating to weapons, ammunition or military apparatus))		

U.S. Registration No.	4441792	Application Date	09/29/2011
Registration Date	12/03/2013	Foreign Priority Date	03/31/2011
Word Mark	ARSENAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Dentifrices Class 006. First use: First Use: 0 First Use In Commerce: 0 Metal name badges; buckles of metal; metal keys for locks, metal key rings, metal key chains and trophies of metal; metal money boxes; non-luminous and non-mechanical metal signs, statues and statuettes; none being of precious metal or coated therewith Class 014. First use: First Use: 0 First Use In Commerce: 0 Medals and medallions; jewellery and imitation jewellery; boxes of precious metal; charms in precious metal; wall plaques made of precious metal; clocks and watches; key fobs of precious metal; tie pins, cufflinks clips Class 021. First use: First Use: 0 First Use In Commerce: 0 Household utensils, namely, pot and panscrapers, chopping blocks, wire baskets, rolling pins, spatulas, turners, whisks, graters, sieves, strainers; containers for household or kitchen use; combs, hair brushes; sponges for household use, cosmetic brushes, and bath sponges; brush-making materials; steelwool; un-worked or semi-worked glass except glass used in building; beverage glass-		

	<p>ware, porcelain and earthenware mugs, and sculptures of earthenware, glass and porcelain</p> <p>Class 026. First use: First Use: 0 First Use In Commerce: 0 Ornamental novelty badges; belt buckles; hair ornaments; clasps for clothing; buttons, fabric appliques; ribbons, braids and rosettes of textile materials; cloth patches for clothing</p> <p>Class 027. First use: First Use: 0 First Use In Commerce: 0 Carpets, rugs, mats and matting; linoleum for covering existing floors; coverings for existing floors; non-textile wallhangings</p> <p>Class 032. First use: First Use: 0 First Use In Commerce: 0 Mineral and aerated waters and other non-alcoholic drinks, namely, cider, soft drinks; syrups and other preparations for making beverages, namely soft drinks, fruit drinks, isotonic sports beverages, and sports beverages</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Advertising; business management; business administration; office functions; arranging commercial transactions over electronic communication networks and the Internet; promotional events relating to sport, sporting activities and/or football matches</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0 Insurance brokerages; insurance information; insurance underwriting services for all types of insurance; financial affairs and monetary affairs, namely, financial information, management and analysis services; real estate financing services; vacation real estate time-sharing</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Telecommunications, in particular, telephone, radio and television communication services; radio and/or television broadcasting; data transmission</p> <p>Class 039. First use: First Use: 0 First Use In Commerce: 0 Transport by ferry, boat, rail, air and bus; packaging and storage of goods; travel arrangement</p> <p>Class 043. First use: First Use: 0 First Use In Commerce: 0 Café, canteen restaurant and catering services, services for providing facilities for exhibition; rental of rooms as temporary living accommodations; rental of rooms for social functions; rental of room for conferences, exhibitions and seminars</p>
--	---

U.S. Registration No.	4843392	Application Date	06/26/2014
Registration Date	11/03/2015	Foreign Priority Date	NONE
Word Mark	ARSENAL		
Design Mark	<b>ARSENAL</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 0 First Use In Commerce: 0 Sporting kit comprised of shirts, shorts, and socks; football base layers; jackets; rain jackets, casual jackets, softshell jackets; pitchside jackets; tops; shirts; t-shirts; polo shirts; sweatshirts; hooded sweatshirts; turtlenecks; fleece pullovers, fleece shorts, fleece tops, fleece tracksuits, fleece jogging bottoms, fleece dressing gowns, fleece sleepsuits, fleece gloves, fleece slippers; shorts; trousers;</p>		

	<p>knitwear, namely, shirts, jackets, bottoms, cardigans, and jumpers; jumpers and cardigans; sweatbands, headbands; gloves; swimwear; sweatpants;belts; rugby shirts; gillets; shawls; scarves; jogging suits; baby and infant body suits; baby coveralls; cloth bibs; pyjamas; bathrobes; boxer shorts; slippers; aprons; socks; football boots; wellington boots; sandals; flip flops; slippers; trainers; sports shoes; booties; baseball caps; sunhats; woollen hats, acrylic hats; beanies; bobble hats; military caps</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0</p> <p>Shin guards for athletic use; footballs; mini footballs; beach balls; snow globes; flying discs; golf balls; golf tees;gift sets comprising golf tees, golf club head covers, golf balls and golf clips; head covers for golf clubs; dummies for baby dolls, namely, pacifiers; bath ducks; toys designed to be attached to prams; baby rattles; plush toys; goalkeepers' gloves</p>
--	---

Attachments	<p>79118323#TMSN.png( bytes )  79157505#TMSN.png( bytes )  F2550006.pdf(16727 bytes )</p>
-------------	---

Signature	/Laura Popp-Rosenberg/
Name	Laura Popp-Rosenberg
Date	03/19/2018

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

THE ARSENAL FOOTBALL CLUB PLC,

Opposer,

v.

UBM IP LUXEMBOURG SARL,

Applicant.

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

The Arsenal Football Club plc (“Opposer”) believes that it would be damaged by the issuance of a registration for the trademark ARSENAL as applied for in Application Serial No. 87420915 and therefore opposes the same. As grounds for its opposition, Opposer, by its attorneys, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer is a public limited company organized under the laws of the United Kingdom, with an address at Highbury House, 75 Drayton Park, London, N5 1BU, United Kingdom.
2. Opposer is the owner of all rights in and to the name and trademark ARSENAL as used in connection with the world-famous professional soccer team of that name.
3. Founded in 1886, the ARSENAL soccer team is one of the most successful teams in the United Kingdom and has one of the largest fan bases in the world. The ARSENAL soccer team has long had a following and a reputation in the United States.
4. Opposer has used the ARSENAL mark not only in connection with the soccer team, but also in connection with a wide variety of associated and ancillary goods and services.

5. In addition, for many years, Opposer has entered into sponsorship agreements with a number of companies representing a wide variety of industries, including, by way of example only, Emirates (airlines), Puma (clothing and sports gear), Cooper Tire (tires), Vitality (health and wellness), Gatorade (sports drinks) and WorldRemit (online money transfer), among others. Arsenal's sponsorship partners are permitted to use the ARSENAL mark within the limits of the sponsorship.

6. Opposer – itself and through its licensees and its authorized partners – has extensively used and promoted the ARSENAL mark. Though this extensive promotion and use, and the success of Opposer's offerings, the ARSENAL mark has come to represent enormous goodwill for Opposer.

7. Dating to long before any date upon which the applicant can rely, Opposer's ARSENAL mark had become uniquely associated with Opposer and had come to represent the goods and services of Opposer exclusively.

8. In addition to its common law trademark rights in the ARSENAL mark developed through many years of use and promotion, Opposer owns several U.S. trademark registrations for the mark, including:

<i>Mark</i>	<i>Reg'n No.</i>	<i>International Classes</i>
ARSENAL	2653016	9, 14, 16, 18, 20, 24, 25, 28
ARSENAL	2987168	41
ARSENAL	4441792	3, 6, 14, 21, 26, 27, 32, 35, 36, 38, 39, 43
ARSENAL	4843392	25, 28

The foregoing registrations are valid, subsisting and in full force and effect.

5. Upon information and belief, the owner of the application at issue is UBM IP Luxembourg Sarl (“Applicant”), a Luxembourg société à responsabilité limitée with an address of 17 Boulevard Prince Henri, Luxembourg L-1724, Luxembourg.

6. Upon information and belief, on or about April 21, 2017, Applicant filed Application Serial No. 87420915 (the “Application”) to register the mark ARSENAL for “Arranging and conducting trade shows in the fields of information security, computer and network security, data and telephony network security, Internet security, computer and network technology, computer and network hardware and computer and network software, none of the foregoing pertaining to the arranging or conducting of sporting events or athletic competitions” in International Class 35 and “Educational conferences, workshops and seminars for others in the fields of information security, computer and network security, data and telephony network security, Internet security, computer and network technology, computer and network hardware and computer and network software, none of the foregoing pertaining to the arranging or conducting sporting events or athletic competitions” in International Class 41.

7. The Application was filed under Section 1(a) of the Lanham Act, and in connection with the Application Applicant claimed first use and first use in commerce of the applied-for mark as of August 3, 2011 for both covered International Classes.

8. Applicant is not connected to Opposer in any way and has not been authorized by Opposer to use or register Opposer’s ARSENAL mark.

COUNT 1:  
PRIORITY AND LIKELIHOOD OF CONFUSION

9. Opposer incorporates by reference paragraphs 1 through 8 above as if fully set forth herein.



10. Upon information and belief, Opposer's rights in its own ARSENAL mark are prior to any rights Applicant can establish in the applied-for ARSENAL mark.

11. Applicant's applied-for ARSENAL mark is identical to Opposer's ARSENAL mark.

12. Based on the identity of the applied-for mark to Opposer's ARSENAL mark, the strength of Opposer's ARSENAL mark, and the breadth of the goods and services on and in connection with which Opposer's ARSENAL mark has been used and with which it has been associated, among other factors likely to contribute to consumer confusion, consumers are likely mistakenly to associate the services offered by Applicant under the applied-for ARSENAL mark with Opposer or with the ARSENAL soccer club, or to believe that Applicant's services are sponsored, endorsed, or licensed by Opposer or the ARSENAL soccer club, or that there is some other relationship between Applicant and Opposer or the ARSENAL soccer club.

13. For the above reasons, any use of the ARSENAL mark by Applicant in connection with the services set forth in the Application is likely to cause confusion, to cause mistake, or to deceive the public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. By reason of the foregoing, Opposer will be damaged by the registration of the ARSENAL mark to Applicant.

**COUNT 2:  
DILUTION**

15. Opposer incorporates by reference paragraphs 1 through 14 above as if fully set forth herein.

16. Opposer's ARSENAL mark is distinctive and famous, has been used in commerce and widely advertised throughout the United States, and is widely recognized by consumers as a symbol of Opposer and its goods and services.

17. Opposer's ARSENAL mark is famous and has been so long prior to any date upon which Applicant can rely.

18. Owing to the fame of Opposer's ARSENAL mark and the identity of the applied-for ARSENAL mark to Opposer's ARSENAL mark, registration of the applied-for ARSENAL mark is likely to dilute the distinctive quality of Opposer's ARSENAL mark by lessening the capacity of that mark to identify and distinguish exclusively the goods and services of Opposer, in violation of Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registrations sought by the Applicant through Application Serial No. 87420915 be denied.

Dated: New York, New York  
March 19, 2017

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: /Laura Popp-Rosenberg/  
Laura Popp-Rosenberg  
4 Times Square, 17<sup>th</sup> Floor  
New York, New York 10036  
Tel: (212) 813-5900  
Email: lpopp-rosenberg@fzlv.com

*Attorneys for Opposer*  
*The Arsenal Football Club plc*