

ESTTA Tracking number: **ESTTA904126**

Filing date: **06/19/2018**

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 parties oppose registration of the indicated application.

Opposers Information

Name	AT&T Intellectual Property II, L.P.
Granted to Date of previous extension	06/20/2018
Address	645 East Plumb Lane Reno, NV 89502 UNITED STATES

Name	AT&T Mobility LLC
Granted to Date of previous extension	06/20/2018
Address	1025 Lenox Park Blvd NE Atlanta, GA 30319 UNITED STATES

Name	New Cingular Wireless PCS, LLC
Granted to Date of previous extension	06/20/2018
Address	1025 Lenox Park Blvd NE Atlanta, GA 30319 UNITED STATES

Attorney information	Jeffrey M. Becker Haynes and Boone, LLP 2323 Victory Avenue, Suite 700 Dallas, TX 75219 UNITED STATES Email: jeff.becker@haynesboone.com, ipdocketing@haynesboone.com Phone: 214-651-5066
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Applicant Information

Application No	87400204	Publication date	02/20/2018
Opposition Filing Date	06/19/2018	Opposition Period Ends	06/20/2018
International Registration No.	NONE	International Registration Date	NONE
Applicant	CKL Holdings N.V. Leeuwenstraat 4 Antwerpen, 2000 BELGIUM		


Goods/Services Affected by Opposition

Class 014. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Precious metals; jewellery; precious stones; chronometric instruments
Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing, namely, shirts, pants, coats, dresses, tops and bottoms; footwear; headwear; swimwear; sportswear, namely, athletic shorts, athletic pants, athletic shirts, athletic uniforms; leisurewear, namely, robes, night gowns, leisure suits, leisure shoes, loungewear
Class 026. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Lace; Embroidery; ribbons; braids; buttons; hooks and eyes; pins, namely, sewing pins, hat pins, curling pins, safety pins, bobby pins, marking pins, ornamental novelty pins; needles; artificial flowers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
Other	No bona fide intent to use mark in commerce for identified goods or services pursuant to Trademark Act Section 44(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	86481025	Application Date	12/15/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CINGULAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Telephones, smartphones, telephone accessories and equipment, namely, batteries, cables, cases and chargers; magnetically encoded calling cards; wireless handheld communication devices to transmit, receive or otherwise access communications networks; tablet computers; mobile hotspot devices; low power wide area network (LPWAN) equipment and devices, namely, gateways, routers, transceivers, repeaters, converters and optimizers, wave division multiplexers, free-space optics transmission systems, switches including Ethernet switches and routers, fiber-to-the-home and Ethernet-over-VDSL access aggregators, ter-		

	<p>minators and repeaters, and remote presence management products, namely, switches, and console, alarm, sensor and power management devices</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0</p> <p>Telecommunications services, namely, the transmission of voice, data and text via telephone, personal communications services, electronic mail services, voice messaging services; communications services, namely, providing low power wide area network (LPWAN) services</p>
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U.S. Application No.	86481044	Application Date	12/15/2014
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Registration Date	NONE	Foreign Priority Date	NONE
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Word Mark	CINGULAR
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Description of Mark	The mark consists of the word "CINGULAR" and a design representing a person shaped like a toy jack with a round ball for a head.
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Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0</p> <p>Telephones, smartphones, telephone accessories and equipment, namely, batteries, cables, cases and chargers; magnetically encoded calling cards; wireless handheld communication devices to transmit, receive or otherwise access communications networks; tablet computers; mobile hotspot devices; low power wide area network (LPWAN) equipment and devices, namely, gateways, routers, transceivers, repeaters, converters and optimizers, wave division multiplexers, free-space optics transmission systems, switches including Ethernet switches and routers, fiber-to-the-home and Ethernet-over-VDSL access aggregators, terminators and repeaters, and remote presence management products, namely, switches, and console, alarm, sensor and power management devices</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0</p> <p>Telecommunications services, namely, the transmission of voice, data and text via telephone, personal communications services, electronic mail services, voice messaging services; communications services, namely, providing low power wide area network (LPWAN) services</p>
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U.S. Application No.	86877203	Application Date	01/15/2016
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Registration Date	NONE	Foreign Priority Date	NONE
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Word Mark	AT&T CINGULAR
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Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Mobile phones; smartphones

U.S. Application No.	86903169	Application Date	02/10/2016
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	AT&T CINGULAR FLIP
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Mobile phones; Smartphones

Attachments	86481025#TMSN.png(bytes) 86481044#TMSN.png(bytes) 86877203#TMSN.png(bytes) 86903169#TMSN.png(bytes) CKL Holdings Notice of Opposition - CINGULAR.pdf(524289 bytes)
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Signature	/Jeffrey M. Becker/
Name	Jeffrey M. Becker
Date	06/19/2018

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

**AT&T Mobility LLC,
New Cingular Wireless PCS, LLC, and
AT&T Intellectual Property II, L.P.**
Opposers,

v.

CKL Holdings N.V.
Applicant.

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Mark: **CINGULAR**

Serial No.: 87/400,204

NOTICE OF OPPOSITION

Opposer AT&T Mobility LLC, formerly named Cingular Wireless LLC (“Opposer AT&T Mobility”), Opposer New Cingular Wireless PCS, LLC (“Opposer New Cingular”), and Opposer AT&T Intellectual Property II, L.P. (“Opposer AT&T IP”) (Opposer AT&T Mobility, Opposer New Cingular, and Opposer AT&T IP, collectively, “Opposers”), believe that they will be damaged by registration of the above-captioned trademark application (the “Opposed Application”) filed by CKL Holdings N.V. (“Applicant”), published for purposes of opposition in the Official Gazette of February 20, 2018, and hereby oppose same.

As grounds for opposition, Opposers allege as follows:

1. Opposer AT&T Mobility is a Delaware limited liability company having an address at 1025 Lenox Park Blvd. NE, Atlanta, Georgia 30319.
2. Opposer New Cingular Wireless PCS, LLC is a Delaware limited liability company having an address at 1025 Lenox Park Blvd. NE, Atlanta, Georgia 30319.
3. Opposer AT&T IP is a Nevada limited partnership having an address at 645 East Plumb Lane, Reno, Nevada 89502.
4. Upon information and belief, Applicant CKL Holdings N.V. is a Belgium naamloze vennootschap having an address at Leeuwenstraat 4, Antwerp, Belgium 2000.

5. Opposers are wholly-owned subsidiaries of AT&T Inc., the public company known generally as “AT&T,” and are all under common control of AT&T Inc.

6. AT&T Inc., through its subsidiaries, operates several businesses, including a wireless voice and data communications business having over 100 million subscribers throughout the United States. AT&T Inc. provides its wireless goods and services through Opposer AT&T Mobility and AT&T Mobility’s subsidiaries, including Opposer New Cingular.

7. Opposer AT&T IP is an intellectual property holding company which, among other things, licenses the right to use trademarks owned by Opposer AT&T IP to other subsidiaries of AT&T Inc., including rights in the mark CINGULAR for use by Opposer AT&T Mobility and Opposer New Cingular.

8. Opposer AT&T IP is the owner of trademark rights in the mark CINGULAR, including the following U.S. Trademark Applications (collectively, “Opposers’ Applications”):

- Serial No. 86/481,025 for the mark CINGULAR, filed December 15, 2014,
- Serial No. 86/481,044 for the mark CINGULAR & Design, filed December 15, 2014,
- Serial No. 86/877,203 for the mark AT&T CINGULAR, filed January 15, 2016, and
- Serial No. 86/903,169 for the mark AT&T CINGULAR FLIP, filed February 10, 2016.

9. Opposer AT&T Mobility was initially formed in 2000 as Cingular Wireless LLC and became one of the largest wireless telecommunications companies in the country offering wireless telecommunications goods and services under the name and trademark CINGULAR.

10. By virtue of its efforts, and the expenditure of billions of dollars on advertising the CINGULAR name and mark, Opposer AT&T Mobility caused CINGULAR to become a household name, gaining substantial goodwill, which consumers have come to recognize as pointing uniquely and unmistakably to Opposer AT&T Mobility and its subsidiaries.

11. In 2004, Opposer AT&T Mobility grew significantly, becoming the country’s largest wireless communications company when it merged with AT&T Wireless Services, Inc. Opposer New Cingular,

which at the time was named AT&T Wireless PCS, LLC, was a subsidiary of AT&T Wireless Services, Inc., and as part of that merger, Opposer New Cingular became a controlled indirect subsidiary of Opposer AT&T Mobility, and has continued to be such through to today.

12. In 2006, Opposer AT&T Mobility and its subsidiary Opposer New Cingular became wholly-owned subsidiaries of AT&T Inc., and continue to be such through to today.

13. In 2007, Opposer AT&T Mobility started a co-branding campaign that displayed both the CINGULAR and AT&T marks, some of which ads headlined that “Cingular Is Now the New AT&T.”

14. As part of the 2007 rebranding campaign, Opposer AT&T Mobility legally changed its name from Cingular Wireless LLC to its current name of AT&T Mobility LLC. However, Opposer New Cingular did not change its name, nor has it since, and still operates today as New Cingular Wireless PCS, LLC, thus maintaining continuous use of CINGULAR.

15. Opposer New Cingular is the principal operating entity of AT&T’s wireless telecommunications business.

16. Even though Opposer AT&T Mobility now markets itself under the AT&T name and logo, and has changed its legal name to AT&T Mobility LLC, the fame and reputation of the CINGULAR name, combined with the co-branding of the CINGULAR and AT&T marks, as well as the continued use of the CINGULAR name by Opposer New Cingular, has resulted in the consuming public still associating CINGULAR with Opposer AT&T Mobility and its subsidiaries.

17. Prior to November 16, 2016, the priority date of the Opposed Application, Opposer New Cingular started selling CINGULAR branded telephones nationwide, which sales have been continuous through to today.

18. Prior to November 16, 2016, the priority date of the Opposed Application, Opposer AT&T IP filed all four (4) of Opposers’ Applications.

19. On April 5, 2017, Applicant filed the Opposed Application, Application No. 87/400,204 for the mark CINGULAR (the “Opposed Mark”), under Section 44(d) of the Lanham Act, 15 U.S.C. § 1126(d),

asserting its bona fide intention to use the Opposed Mark in U.S. commerce, and claiming priority back to a Benelux application having a November 16, 2016 filing date.

20. The Opposed Mark is identical to Opposers' CINGULAR mark and name.

21. Opposers' have priority over the Opposed Application since, well before the November 16, 2016, priority date of the Opposed Application, CINGULAR had become uniquely and unmistakably associated with Opposer AT&T Mobility and its subsidiaries, Opposer New Cingular was using the name CINGULAR in its name and was selling CINGULAR-branded telephones, and Opposer AT&T IP had filed the Opposers' Applications.

22. The Opposed Mark will be recognized by consumers of Applicant's products as Opposer AT&T Mobility since the Opposed Mark points uniquely and unmistakably to Opposer AT&T Mobility and its subsidiaries.

23. Opposers are not connected with the activities to be performed by Applicant under the Opposed Mark.

24. The fame or reputation of Opposer AT&T Mobility is such that, when the Opposed Mark is used with the Applicant's goods, a connection with Opposer AT&T Mobility will be presumed.

25. Opposer AT&T Mobility will be irreparably injured and damaged if Applicant is permitted to use and register the Opposed Mark, because the purchasing public will presume that Applicant is connected to Opposer AT&T Mobility within the meaning of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

26. Opposer New Cingular will be irreparably injured and damaged if Applicant is permitted to use and register the Opposed Mark, because the Opposed Mark so resembles Opposer New Cingular's CINGULAR trademark and trade name as to be likely, when applied to the goods in the Opposed Application, to cause confusion, mistake or deception among the purchasing public within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

27. Opposer AT&T IP will be irreparably injured and damaged if Applicant is permitted to use and register the Opposed Mark, because the Opposed Mark so resembles Opposer AT&T IP's CINGULAR

trademark, including Opposers' Applications, as to be likely, when applied to the goods in the Opposed Application, to cause confusion, mistake or deception among the purchasing public within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

28. On information and belief, Applicant has not used in U.S. commerce, and did not have the requisite bona fide intent as required by Section 44(d) of the Lanham Act, 15 U.S.C. § 1126(d), to use in U.S. commerce as of its filing date of the Opposed Application, the Opposed Mark for any of the goods listed in the Opposed Application.

29. From late 2016 through summer 2017, Applicant filed over 280 U.S. trademark applications and has not filed with the U.S. Trademark Office evidence of the actual use of any of the filed for trademarks.

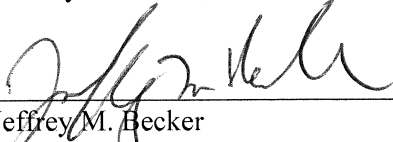
30. On information and belief, Applicant has not commenced use in U.S. commerce of any trademark.

31. Due to Applicant's lack of bona fide intent to use the Opposed Mark in U.S. commerce in connection with the goods identified in the Opposed Application, the registration of the Opposed Application should be refused under Section 44(d) of the Lanham Act, 15 U.S.C. § 1126(d).

WHEREFORE, for the reasons set forth above, Opposers pray that Applicant's U.S. Trademark Application Serial No. 87/400,204, be rejected, that no registration be issued thereon to Applicant and that this Notice of Opposition be sustained in favor of Opposers.

Respectfully submitted,

Date: June 19, 2018

By: 
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