

ESTTA Tracking number: **ESTTA1191360**

Filing date: **02/16/2022**

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	BBC ICE CREAM, LLC
Granted to date of previous extension	02/16/2022
Address	3850 BIRD ROAD SUITE 801 MIAMI, FL 33146 UNITED STATES
Attorney information	MICHAEL B. CHESAL PERETZ CHESAL & HERRMANN, P.L. 1 S.E. 3RD AVENUE SUITE 1820 MIAMI, FL 33131 UNITED STATES Primary email: mchesal@pch-iplaw.com Secondary email(s): trademarks@pch-iplaw.com, mshafer@pch-iplaw.com (305)341-3000
Docket no.	

Applicant information

Application no.	88770513	Publication date	10/19/2021
Opposition filing date	02/16/2022	Opposition period ends	02/16/2022
Applicant	ZURICH LLOYDS CORPORATION 851 BROKEN SOUND PKWY SUITE 207 BOCA RATON, FL 33487 UNITED STATES		

Goods/services affected by opposition

Class 003. First Use: None First Use In Commerce: None
All goods and services in the class are opposed, namely: Fragrances; Cologne; Perfume


Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks cited by opposer as basis for opposition

U.S. registration no.	3216201	Application date	02/14/2003
Register	Principal		

Registration date	03/06/2007	Foreign priority date	NONE
Word mark	BILLIONAIRE BOYS CLUB		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Jun 2005 First Use In Commerce: Jun 2005 Clothing, namely, jackets, coats, raincoats, [blazers,] shirts, t-shirts, [skirts, dresses,] trousers, jeans, shorts, sweaters, cardigans [, scarves and belts] ; footwear; headwear		


U.S. registration no.	5086483	Application date	04/15/2016
Register	Principal		
Registration date	11/22/2016	Foreign priority date	NONE
Word mark	BILLIONAIRE BOYS CLUB		
Design mark			
Description of mark	The mark consists of the word "BILLIONAIRE" above the words "BOYS CLUB", with the design of a man's head inside a spacehelmet appearing to the left of "BOYS CLUB".		
Goods/services	Class 025. First use: First Use: Jun 30, 2005 First Use In Commerce: Jun 30, 2005 Clothing, namely, tops, bottoms, jackets, hooded pullovers, sweaters, foot-wear, headwear, socks and undergarments		


U.S. registration no.	5242580	Application date	04/15/2016
Register	Principal		
Registration date	07/11/2017	Foreign priority date	NONE
Word mark	BILLIONAIRE BOYS CLUB		

Design mark	
Description of mark	The mark consists of the word "BILLIONAIRE" above the words "BOYS CLUB", with the design of a man's head inside a spacehelmet appearing to the left of "BOYS CLUB".
Goods/services	Class 016. First use: First Use: Dec 31, 2007 First Use In Commerce: Dec 31, 2007 Stickers Class 020. First use: First Use: Dec 31, 2011 First Use In Commerce: Dec 31, 2011 Rubber key chains Class 024. First use: First Use: Dec 31, 2007 First Use In Commerce: Dec 31, 2007 Towels Class 028. First use: First Use: Dec 31, 2010 First Use In Commerce: Dec 31, 2010 Skateboard decks

U.S. registration no.	5723816	Application date	12/28/2017
Register	Principal		
Registration date	04/09/2019	Foreign priority date	NONE
Word mark	BILLIONAIRE BOYS CLUB		
Design mark			
Description of mark	NONE		

Goods/services	Class 018. First use: First Use: Dec 31, 2006 First Use In Commerce: Dec 31, 2006 All-purpose sports and athletic bags; beach, book, carry-on, duffel, gym, shoulder, tote and travel bags; fanny packs and waist packs; backpacks; knapsacks; luggage; luggage tags; business cases; business card cases; calling and credit card cases; wallets; banknote holders; billfolds; umbrellas
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U.S. registration no.	3778773	Application date	05/29/2008
Register	Principal		
Registration date	04/20/2010	Foreign priority date	NONE
Word mark	BILLIONAIRE BOYS CLUB		
Design mark			
Description of mark	NONE		
Goods/services	Class 014. First use: First Use: Sep 2009 First Use In Commerce: Sep 2009 [Jewelry;] ornamental lapel pins [; pins being jewelry; jewelry chains]		

U.S. registration no.	4846345	Application date	08/15/2012
Register	Principal		
Registration date	11/03/2015	Foreign priority date	NONE
Word mark	BGC BILLIONAIRE GIRLS CLUB		
Design mark			
Description of mark	The mark consists of the stylized letters "B" "G" "C" to the left of a stylized depiction of a female's head inside a space helmet, above the words "BILLIONAIRE GIRLS CLUB".		
Goods/services	Class 025. First use: First Use: Jun 5, 2015 First Use In Commerce: Jun 5, 2015 Clothing, namely, shirts, hooded sweatshirts		

Attachments	87002346#TMSN.png(bytes) 87002345#TMSN.png(bytes) 87979907#TMSN.png(bytes) 77486341#TMSN.png(bytes) 85704212#TMSN.png(bytes) 00158082.PDF(163112 bytes)
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Signature	/Michael B. Chesal/
Name	MICHAEL B. CHESAL
Date	02/16/2022

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

BBC Ice Cream, LLC,

Opposer,

v.

Zurich Lloyds Corporation,

Applicant.

Opposition No.:

In re App. Serial No.: 88/770,513

Mark: BILLIONAIRE POLO CLUB

NOTICE OF OPPOSITION

BBC Ice Cream, LLC (“**Opposer**”), a Delaware Limited Liability Company located at 3850 Bird Road, Suite 801, Miami, Florida 33146, believes it will be damaged by registration of the mark claimed in Application Serial No. 88/770,513 (the “**Contested Application**”) and accordingly hereby opposes the Contested Application pursuant to Trademark Act Section 13, 15 U.S.C. §1063, and alleges:

INTRODUCTION

1. Because of Opposer’s prior rights in the mark ICECREAM, the Contested Application should be refused.

THE CONTESTED APPLICATION

2. Upon information and belief, Applicant, Zurich Lloyds Corporation (“**Applicant**”) is an inactive Florida Corporation, having been administratively dissolved on September 24, 2021, with its principal place of business located at 851 Broken Sound Pkwy, Suite 207, Boca Raton, Florida.

3. Through the Contested Application, Applicant is seeking registration of the mark BILLIONAIRE POLO CLUB (the “**Contested Mark**”) for “Fragrances; Cologne; Perfume” in Class 3 (filed on an intent-to-use basis).

4. The Contested Application was filed on January 23, 2021 under Section 1(b) and was published for opposition on October 19, 2021.

5. Opposer timely filed a Request to Extend Time to Oppose on November 18, 2021, which was granted by the Board the same day. Opposer then requested a second extension on December 17, 2021, which was also granted by the Board the same day.

OPPOSER'S PRIOR RIGHTS

6. In or about June 2005, Opposer began using the mark BILLIONAIRE BOYS CLUB (the "**BILLIONAIRE BOYS CLUB Mark**") to identify clothing, headwear and footwear, and subsequently expanded its product line to a variety of other products including, but not limited to, bags, rugs, towels, and related items.

7. Opposer's line of BILLIONAIRE BOYS CLUB products was launched by the iconic singer, rapper, and record producer Pharrell Williams, and has received a substantial amount of media coverage.

8. As a result of the foregoing use of the BILLIONAIRE BOYS CLUB Mark, Opposer has established significant goodwill in the mark, and it has come to be exclusively associated with Opposer.


OPPOSER'S FEDERAL TRADEMARK REGISTRATIONS FOR ITS BILLIONAIRE BOYS CLUB MARK

9. Applicant's rights are inferior to those of Opposer due to Opposer's actual prior use of the BILLIONAIRE BOYS CLUB Mark for clothing and related goods.


10. Opposer also has priority over Applicant based upon constructive use dating back as far as February 2003 in connection with the following registrations (collectively, "**Opposer's BILLIONAIRE BOYS CLUB Registrations**"):

U.S. Reg. No. 3,216,201 for the mark BILLIONAIRE BOYS CLUB covering "Clothing, namely, jackets, coats, raincoats, [blazers,] shirts, t-shirts, [skirts, dresses,] trousers, jeans, shorts, sweaters, cardigans [, scarves and belts] ; footwear; headwear" in Class 25 (Filed February 14, 2003).



U.S. Reg. No. 5,086,483 for the mark  covering "Clothing, namely, tops, bottoms, jackets, hooded pullovers, sweaters, footwear, headwear, socks and undergarments" in Class 25 (Filed April 15, 2016).



U.S. Reg. No. 5,242,580 for the mark  covering "Stickers" in Class 16; "Rubber key chains" in Class 20; "Towels" in Class 24; and "Skateboard decks" in Class 28 (Filed April 15, 2016).

U.S. Reg. No. 5,723,816 for the mark BILLIONAIRE BOYS CLUB covering "All-purpose sports and athletic bags; beach, book, carry-on, duffel, gym, shoulder, tote and travel bags; fanny packs and waist packs; backpacks; knapsacks; luggage; luggage tags; business cases; business card cases; calling and credit card cases; wallets; banknote holders; billfolds; umbrellas" in Class 18 (Filed December 28, 2017).

U.S. Reg. No. 3,778,773 for the mark BILLIONAIRE BOYS CLUB covering "[Jewelry;] ornamental lapel pins [; pins being jewelry; jewelry chains]" in Class 14 (Filed May 29, 2008).



U.S. Reg. No. 4,846,345 for the mark  covering "Clothing, namely, shirts, hooded sweatshirts" in Class 25 (Filed August 15, 2012)

OPPOSITION BASED ON OPPOSER'S PRIOR RIGHTS

11. The Contested Mark is virtually identical and therefore confusingly similar to Opposer's BILLIONAIRE BOYS CLUB Mark and is likely to cause confusion, mistake, or to deceive as to the source, sponsorship, or affiliation between Opposer and Applicant and their respective goods.

12. The Contested Mark only substitutes the term BOYS in Opposer's BILLIONAIRE BOYS CLUB Mark for the term POLO. Thus, the marks share distinct similarities in sight, sound, meaning, and overall commercial impression. The use of the Opposer's BILLIONAIRE _____

CLUB construction bookending the term POLO will no doubt confuse consumers as to the source, origin, sponsorship, or affiliation of Applicant's fragrance products.

13. The first term BILLIONAIRE is the dominant portion of both parties' marks.

14. The Contested Mark also covers highly related goods, including, for example, perfumes and cologne. Fragrance products such as these commonly emanate from the same source goods such as Opposer's apparel, accessory, and home goods products.

15. These products are squarely within Opposer's zone of probable or natural expansion. Apparel companies such as Opposer frequently launch fragrance lines and consumers seeking such products expect this.

16. When used on or in connection with the goods of the Applicant, the Contested Mark is likely to cause confusion, or to cause mistake, or to deceive.

17. Applicant filed the Contested Application on a 1(b) (intent-to-use) basis and, on information and belief, has not begun use of the Contested Mark in U.S. commerce.

18. Opposer has priority over Applicant based upon (1) Opposer's use of its BILLIONAIRE BOYS CLUB Mark in commerce dating back to 2005; and (2) the constructive use priority dates of Opposer's BILLIONAIRE BOYS CLUB Registrations—dating back to 2003.

19. Opposer thus has prior and superior rights in the BILLIONAIRE BOYS CLUB Mark.

20. Since Opposer's rights are superior to those of Applicant, the Contested Applications should not have been approved for publication.

21. If Applicant is granted registration for BILLIONAIRE POLO CLUB, Applicant would thereby obtain a prima facie exclusive right to use the BILLIONAIRE POLO CLUB Mark, which would be a source of damage to Opposer's trademark rights as a result of the potential likelihood of confusion between the respective marks.

WHEREFORE, Opposer, BBC Ice Cream, LLC, respectfully requests that registration of the mark in the Contested Application (Serial No. 88/770,513) be refused and that this Opposition be sustained in favor of Opposer.

Dated: February 16, 2022

Respectfully submitted,

PERETZ CHESAL & HERRMANN, P.L.

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By: /s/ Michael B. Chesal
Michael B. Chesal