

ESTTA Tracking number: **ESTTA1227205**

Filing date: **08/06/2022**

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	Alfwear Inc.		
Entity	Corporation	Citizenship	Utah
Address	1635 SOUTH 5070 WEST, SUITE C SALT LAKE CITY, UT 84104 UNITED STATES		

Attorney information	TRENT BAKER BAKER IP PLLC 124 SOUTH MAIN STREET #3147 CEDAR CITY, UT 84720 UNITED STATES Primary email: trent@bakerip.com Secondary email(s): admin@bakerip.com 801-618-3359		
Docket no.			

Applicant information

Application no.	90816274	Publication date	07/12/2022
Opposition filing date	08/06/2022	Opposition period ends	08/11/2022
Applicant	IBKUL UBHOT Ltd. 510 JERICHO TURNPIKE SYOSSET, NY 11791 UNITED STATES		

Goods/services affected by opposition

Class 025. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Clothing and activewear, namely, vests,jackets, shirts, tops, bottoms, hats, headbands

Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Marks cited by opposer as basis for opposition

U.S. registration no.	1990375	Application date	08/15/1994
Register	Principal		

Registration date	07/30/1996	Foreign priority date	NONE
Word mark	KUHL		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Feb 1, 1994 First Use In Commerce: Aug 17, 1994 rugged outdoor clothing, namely jackets, shirts, pants, shorts, T-shirts, and hats Class 032. First use: First Use: Aug 17, 1994 First Use In Commerce: Jan 29, 1995 bottled spring water		

U.S. registration no.	3916866	Application date	06/23/2010
Register	Principal		
Registration date	02/08/2011	Foreign priority date	NONE
Word mark	K?HL		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Feb 1, 1994 First Use In Commerce: Feb 1, 1994 Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Tops		

U.S. registration no.	4441177	Application date	08/16/2012
Register	Principal		
Registration date	11/26/2013	Foreign priority date	NONE
Word mark	KUHL		

Design mark	<h1>KUHL</h1>
Description of mark	NONE
Goods/services	<p>Class 003. First use: First Use: Jan 28, 2013 First Use In Commerce: Jan 28, 2013 Lip balm</p> <p>Class 025. First use: First Use: Feb 1, 1994 First Use In Commerce: Feb 1, 1994 Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Tops; Fabric sold as an integral component of finished clothing, namely, Belts, Bottoms, Hats, Jackets, Pants, Shirts, Shorts and Tops</p> <p>Class 032. First use: First Use: Aug 17, 2004 First Use In Commerce: Aug 17, 2004 Bottled water</p>

U.S. registration no.	4777532	Application date	08/16/2012
Register	Principal		
Registration date	07/21/2015	Foreign priority date	NONE
Word mark	KUUL		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 024. First use: First Use: Oct 3, 2014 First Use In Commerce: Oct 3, 2014 Textile fabrics for the manufacture of clothing</p> <p>Class 025. First use: First Use: May 21, 2015 First Use In Commerce: May 21, 2015 Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Tops</p>		

Related proceedings	91233985; 91270271; 91270271; Case 2:21-cv-00698-DBB- JCB Alfwear v Ib-kul Ubhot
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Attachments	<p>85069309#TMSN.png(bytes)</p> <p>85705526#TMSN.png(bytes)</p> <p>080622IBKOMFORTABLE_opposition.pdf(1183399 bytes)</p>
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Signature	/trentbaker/
Name	Trent Baker
Date	08/06/2022

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	ALFWEAR INC.
Address	1635 South 5070 West, Suite C, Salt Lake City, Utah 84104, UNITED STATES

Attorney Information	Trent Baker BAKER IP PLLC 124 South Main Street #3147 Cedar City, UT 84720 UNITED STATES trent@bakerip.com 801-618-3359
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Applicant Information

Application No	90816274	Publication date	07/12/2021
Opposition Filing Date	08/06/22	Opposition Period Ends	08/12/2021
Applicant	IBKUL UBHOT Ltd. 510 Jericho Turnpike Syosset, NEW YORK UNITED STATES 11791		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing and activewear, namely, vests, jackets, shirts, tops, bottoms, hats, headbands.
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act § 2(d)
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Marks Cited by Opposer as Basis for Opposition

Int. Cls.: 25 and 32

Prior U.S. Cls.: 22, 39, 45, 46, and 48

Reg. No. 1,990,375

United States Patent and Trademark Office Registered July 30, 1996

TRADEMARK
PRINCIPAL REGISTER

ALFWEAR INC. (UTAH CORPORATION)
P.O. BOX 2972
PARK CITY, UT 84060FOR: RUGGED OUTDOOR CLOTHING,
NAMESLY JACKETS, SHIRTS, PANTS, SHORTS,
T-SHIRTS, AND HATS, IN CLASS 25 (U.S. CLS.
22 AND 39).FIRST USE 2-1-1994; IN COMMERCE
8-17-1994.FOR: BOTTLED SPRING WATER, IN CLASS
32 (U.S. CLS. 45, 46 AND 48).FIRST USE 8-17-1994; IN COMMERCE
1-29-1995.THE ENGLISH TRANSLATION OF THE
MARK IS "COOL".

SN 74-561,353, FILED 8-15-1994.

ODETTE BONNET, EXAMINING ATTORNEY

Reg. No. 3,916,866

Registered Feb. 8, 2011

Int. Cl.: 25

TRADEMARK

PRINCIPAL REGISTER

ALFWEAR INC. (UTAH CORPORATION)
4884 SOUTH 300 WEST
MURRAY, UT 84107FOR: BELTS; BOTTOMS; HATS; JACKETS; PANTS; SHIRTS; SHORTS; TOPS, IN CLASS
25 (U.S. CLS. 22 AND 39).

FIRST USE 2-1-1994; IN COMMERCE 2-1-1994.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-
TICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 1,990,375.

THE ENGLISH TRANSLATION OF "KÜHL" IN THE MARK IS "COOL".

SER. NO. 85-069,309, FILED 6-23-2010.

KHANH LE, EXAMINING ATTORNEY

KUHL

Reg. No. 4,441,177
Registered Nov. 26, 2013
Int. Cls.: 3, 25, and 32

ALFWEAR INC. (UTAH CORPORATION)
4884 SOUTH 300 WEST
MURRAY, UT 84107
FOR: LIP BALM, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).
FIRST USE 1-28-2013; IN COMMERCE 1-28-2013.

TRADEMARK
PRINCIPAL REGISTER

FOR: BELTS; BOTTOMS; HATS; JACKETS; PANTS; SHIRTS; SHORTS; TOPS; FABRIC SOLD AS AN INTEGRAL COMPONENT OF FINISHED CLOTHING, NAMELY, BELTS, BOTTOMS, HATS, JACKETS, PANTS, SHIRTS, SHORTS AND TOPS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 2-1-1994; IN COMMERCE 2-1-1994.

FOR: BOTTLED WATER, IN CLASS 32 (U.S. CLS. 45, 46 AND 48).

FIRST USE 8-17-2004; IN COMMERCE 8-17-2004.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,990,375 AND 3,916,866.

THE ENGLISH TRANSLATION OF "KÜHL" IN THE MARK IS "COOL".

SN 85-705,526, FILED 8-16-2012.

CAITLIN WATTS-FITZGERALD, EXAMINING ATTORNEY



KUUL

Reg. No. 4,777,532
Registered July 21, 2015
Int. Cls.: 24 and 25

ALFWEAR INC. (UTAH CORPORATION)
4884 SOUTH 300 WEST
MURRAY, UT 84107
FOR: TEXTILE FABRICS FOR THE MANUFACTURE OF CLOTHING, IN CLASS 24 (U.S. CLS. 42 AND 50).

TRADEMARK
PRINCIPAL REGISTER

FIRST USE 10-3-2014; IN COMMERCE 10-3-2014.

FOR: BELTS; BOTTOMS; HATS; JACKETS; PANTS; SHIRTS; SHORTS; TOPS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 5-21-2015; IN COMMERCE 5-21-2015.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 1,990,375 AND 3,916,866.

SN 85-705,696, FILED 8-16-2012.

CAITLIN WATTS-FITZGERALD, EXAMINING ATTORNEY

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature /trentbaker46534/
Name Trent Baker
Date 8/6/2022

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

In the matter of trademark application Serial No. 90816274
Published in the Official Gazette (Trademarks) on July 12, 2022
Mark: "IBKOMFORTABLE BY IBKUL"

ALFWEAR INC. Opposer, vs. IBKUL UBHOT LTD. Applicant.	Opposition No. _____
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

ALFWEAR INC. (hereinafter "the Opposer") believes that it will be damaged by the above-referenced application by IBKUL UBHOT LTD. (hereinafter "the Applicant") of the above-identified mark (IBKOMFORTABLE BY IBKUL) and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. As is evidenced by the publication of said mark on July 12, 2022 in the Trademark Official Gazette. Applicant seeks to register IBKOMFORTABLE BY IBKUL (words and design) as a trademark for the following goods in International class: Class 025: "Clothing and activewear, namely, vests, jackets, shirts, tops, bottoms, hats, headbands."

2. Opposer used the mark KÜHL in interstate commerce since at least as early as February 1, 1994 on or in connection with a wide variety of goods and services, including clothing, well before Applicant filed its application for IBKOMFORTABLE BY IBKUL on July 07, 2021.

3. Opposer is the owner and relies on U.S. Trademark Registration No. 1,990,375 for the mark KÜHL (words plus design) for "rugged outdoor clothing, namely jackets, shirts, pants, shorts, T-shirts, and hats in class 25" and "bottled spring water in class 032" which was registered as a trademark with the U. S. Patent and Trademark Office on July 30, 1996. This registration has achieved incontestable status under 15 U.S.C. § 1065.

4. Opposer is the owner and relies on U.S. Trademark Registration No. 3,916,866 for the mark KÜHL (words only) for " Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Tops" in International Class 025 which was registered on February 8, 2011.

5. Opposer is the owner and relies on use-based U.S. Trademark Registration No. 4,441,177 for the mark KUHL (words only) for "Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Tops" in International Class 025, "Lip balm" in International Class 003, and "Bottled water" in international class 032 which was registered on November 26, 2013. This registration has achieved incontestable status under 15 U.S.C. § 1065. Opposer began using the KUHL mark on or in connection with clothing items sold or transported in commerce at least by August 16, 2012.

6. Opposer is the owner and relies on use-based U.S. Trademark Registration No. 4,777,532 for the mark KUUL (words only) for "Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Tops" in

International Class 025 and “Textile fabrics for the manufacture of clothing” in international class 024 which was registered on July 21, 2015.

7. There is no issue of priority with respect to the registered KÜHL portfolio of marks (See paragraphs 3-6; the term “KÜHL portfolio of marks” is used to designate the marks identified in paragraphs 3-6 alone or in combination). The cited registrations were filed before Applicant filed its application. Opposer's date of first use is at least as early as February 1, 1994, and Opposer's date of first use in interstate commerce is at least as early as February 1, 1994. Opposer's use of the KÜHL portfolio of marks has been consistent, not been abandoned, and therefore the Registrations cited in Paragraphs 3, 4, 5 and 6 are valid and subsisting. The KÜHL portfolio of marks also refers to the common law rights acquired in the words KÜHL, KUHL, KUL, and derivatives thereof.

8. Opposer's valid, continuous, extensive, and diverse use of the KÜHL portfolio of marks has developed exceedingly valuable goodwill and recognition in respect to the KÜHL portfolio of marks.

9. By virtue of its efforts and the expenditure of considerable sums for promotional materials and advertisements and the quality of its goods and services, Opposer has gained a valuable reputation for the KÜHL portfolio of marks and these marks have acquired great value as an identification of Opposer's goods and services and the marks distinguish such goods and services from the goods and services of others.

10. Upon information and belief, through extensive use and advertising of Opposer's KÜHL portfolio of marks, the marks have become a unique and famous identifier of Opposer's goods since a date prior to the filing date of Applicant's application.

DILUTION AND CONFUSION ARE LIKELY

11. Opposer's use in commerce of the marks KÜHL, KUHL, and KUUL predates the filing date of the Application.

12. Opposer's use of the marks KÜHL, KUHL, and KUUL predates the filing date of the Application.

13. Opposers marks KÜHL, KUHL, and/or KUUL were well established and famous long before the filing date of the Application.

14. Upon information and belief, Applicant's mark IBKOMFORTABLE BY IBKUL is confusingly similar to each of Opposer's KÜHL portfolio of marks as used and registered by Opposer.

15. Upon information and belief, the products identified in the Application are related to, or identical to, the products identified in Opposer's pleaded registrations, including clothing products, and the products on or in connection with which Opposer have used, and is using, the KÜHL portfolio of marks including clothing.

16. Upon information and belief, the goods identified in the Application, and the products identified in Opposer's pleaded registrations, including clothing products, and the products on and in connection with which Opposer uses its KÜHL portfolio of marks, including clothing, are products that are offered for sale and sold in identical channels of trade.

17. Upon information and belief, the goods to which Applicant's Mark IBKOMFORTABLE BY IBKUL will be applied, and the products identified in Opposer's pleaded registrations, including clothing products, and the products on and in connection with which Opposer uses its KÜHL portfolio of marks, including clothing, are products that are offered for sale and sold to the same class of purchasers.

18. Applicant has no license, consent or permission from Opposer to use or register Applicant's mark.

COUNT 1

LIKELIHOOD OF CONFUSION

19. Opposer incorporates each and every allegation of Paragraphs 1-18 of this Notice as through fully set forth herein.

20. In view of the fame and commercial strength of one or more of Opposer's KÜHL portfolio of marks, the similarity of the respective marks, similarity of the channels of trade, related nature of the goods, and the ongoing use of Opposer's marks, the mark shown in the Application so resembles each of Opposer's KÜHL portfolio of marks so as to be likely to cause confusion, or to cause mistake, or to deceive as to source by suggesting that Applicant's goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Opposer.

21. If Applicant is permitted to use and register its mark as specified in the application herein opposed, confusion is likely to result because the identical K-U-L letters in Applicant's mark and each of Opposer's KÜHL portfolio of marks. Applicant's mark is in the same class of goods as Opposer's KÜHL portfolio of marks (Clothing class 025). The Applicants mark includes the letters

I-B which will be pronounced and interpreted as “I be”. Therefore, a user would read and pronounce the mark as “I be comfortable by I be cool” by wearing the associated clothing. It is obvious that the pronunciation of the Applicant’s mark would instantly be confused with the Opposer’s portfolio of marks since the phrase “I be” does not affect the distinctiveness of the Applicant’s mark and the word “comfortable” is clearly descriptive of clothing. The literal effective phrase “I be KUL” is therefore substantially identical in both appearance and sound to Opposer’s marks KÜHL, KUHL, and KUUL. Therefore, a person familiar with Opposer's KÜHL portfolio of marks would assume that Applicant was associated with Opposer and any such confusion would inevitably result in damage to the Opposer (ie. “I be NIKE” or “IBNIKE” would cause confusion with the famous brand NIKE). Furthermore, any objection or fault found with Applicant's goods would necessarily reflect upon and seriously injure the reputation that Opposer has established under its marks. Thus, if Applicant is allowed to use and register IBKOMFORTABLE BY IBKUL the resulting confusion and assumed affiliation will be damaging to the Opposer's established goodwill under the KÜHL portfolio of marks. The Trademark Trial and Appeal Board (TTAB) ruled on a similar application in proceeding 91233985 sustaining the opposition on the grounds of likelihood of confusion.

22. Further, if Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark thereby casting a cloud over Opposer's KÜHL portfolio of marks. Applicant would also appropriate the considerable goodwill and recognition that Opposer has established through years of exclusive use and marketing. Such registration would be a source of damage and injury to Opposer.

COUNT 2

DILUTION

23. Opposer incorporates each and every allegation of Paragraphs 1-22 of this Notice as through fully set forth herein.

24. KÜHL, KUHL, and/or KUUL have become famous in accordance with the standard set forth in 15 USC 1125(c).

25. Applicant filed the Application for IBKOMFORTABLE BY IBKUL after one or more of Opposer's KÜHL portfolio of marks became famous.

26. Applicant's mark is likely to cause the dilution of distinctiveness of the Opposer's famous marks.

WHEREFORE, Opposer prays that the application Serial No. 90816274 be rejected, and that registration of the mark therein sought be denied and refused.

Opposer has hereby appointed Trent Baker of BAKER IP PLLC 124 South Main Street #3147 Cedar City, UT 84720, member of the bar of the State of Utah, as attorney in the matter of the opposition above-identified, to prosecute said opposition, to transact all business in the United States Patent & Trademark Office and in the United States courts in connection with this opposition, to sign his name to all papers which may hereinafter be filed in connection therewith, and to receive all communications relating to the same.

Respectfully submitted,

/trentbaker46534/

Trent Baker
BAKER IP PLLC
124 South Main Street #3147

Cedar City, UT 84720
Direct 801-618-3359
trent@bakerip.com
Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition has been served by first class mail, postage pre-paid, upon the Applicant at the following address:

IBKUL UBHOT Ltd.
510 Jericho Turnpike
Syosset, NEW YORK UNITED STATES 11791
Dated: August 6, 2022

/trentbaker46534/
Trent Baker