

ESTTA Tracking number: **ESTTA1351515**
Filing date: **04/10/2024**

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	Incorporated or registered in	Utah
Address	1635 SOUTH 5070 WEST, SUITE C SALT LAKE CITY, UT 84104 UNITED STATES		
Attorney information	TRENT H. BAKER BAKER IP PLLC 921 SOUTH MAIN STREET #3147 CEDAR CITY, UT 84720 UNITED STATES Primary email: trent@bakerip.com Secondary email(s): admin@bakerip.com, bowen@rqn.com, arichards@rqn.com, kpickering@rqn.com, docket@rqn.com (801) 618-3359		
Docket no.	44140-91		

Applicant information

Application no.	97738678	Publication date	03/12/2024
Opposition filing date	04/10/2024	Opposition period ends	04/11/2024
Applicant	Kul Products LLC 2738 WINNETKA AVE N STE 200C NEW HOPE, MN 55427 UNITED STATES		

Goods/services affected by opposition

Class 021. First Use: Dec 1, 2022 First Use In Commerce: Dec 1, 2022
All goods and services in the class are opposed, namely: Portable coolers, non-electric


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.	5931177	Application date	05/21/2019
Register	Principal		

Registration date	12/10/2019	Foreign priority date	NONE
Word mark	KÄ#HL		
Design mark			
Description of mark	NONE		
Goods/services	Class 021. First use: First Use: Apr 30, 2019 First Use In Commerce: Apr 30, 2019 Water bottles sold empty; Empty water bottles for bicycles; Plastic water bottles sold empty; Reusable plastic water bottles sold empty		

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			
Description of mark	NONE		
Goods/services	Class 003. First use: First Use: Jan 28, 2013 First Use In Commerce: Jan 28, 2013 Lip balm 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 Class 032. First use: First Use: Aug 17, 2004 First Use In Commerce: Aug 17, 2004 Bottled water		

U.S. registration no.	3916866	Application date	06/23/2010
Register	Principal		
Registration date	02/08/2011	Foreign priority	NONE

		date	
Word mark	KÄ#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.	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	Class 024. First use: First Use: Oct 3, 2014 First Use In Commerce: Oct 3, 2014 Textile fabrics for the manufacture of clothing Class 025. First use: First Use: May 21, 2015 First Use In Commerce: May 21, 2015 Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Tops		

U.S. application no.	88825380	Application date	03/07/2020
Registration date	NONE	Foreign priority date	NONE
Word mark	KÄ#HL		

Design mark	KÜHL
Description of mark	NONE
Goods/services	Class 021. First use: First Use: None First Use In Commerce: None Non-electric portable coolers; Portable coolers, non-electric

Attachments	88439507#TMSN.png(bytes) 85705526#TMSN.png(bytes) 85069309#TMSN.png(bytes) 85705696#TMSN.png(bytes) 88825380#TMSN.png(bytes) Notice of Opposition.pdf(137729 bytes)
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Signature	/s Trent H. Baker /
Name	Trent H. Baker
Date	04/10/2024

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Attorneys for Opposer Alfwear, Inc. dba KÜHL

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

ALFWEAR INC. dba KÜHL,

Opposer,

v.

KUL PRODUCTS LLC dba KUL STOOL,

Applicant.

Opposition No. _____

Mark: KUL STOOL

Serial No. 97-738,678

Filed: January 1, 2023

Published: March 12, 2024

NOTICE OF OPPOSITION

ALFWEAR INC. dba KÜHL (hereinafter “Opposer”) believes that it will be damaged by the above-referenced application by KUL PRODUCTS LLC dba KUL STOOL (hereinafter “Applicant”) of the above-identified mark (KUL STOOL) and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. As is evidenced by the publication of said mark on March 12, 2024, in the Trademark Official Gazette, Applicant seeks to register KUL STOOL (words and design) as a trademark for the following goods in International Class 021: “Portable coolers, non-electric.”

2. Opposer has 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. Opposer began use of the mark KÜHL in interstate commerce well before Applicant filed its application for KUL STOOL (the “Application”) on January 1, 2023, and well before Applicant’s asserted date of first use of December 1, 2022.

3. Opposer is the owner and relies on U.S. Trademark Registration No. 5,931,177 for the mark KÜHL (words only) for “Water bottles sold empty; Empty water bottles for bicycles; Plastic water bottles sold empty; Reusable plastic water bottles sold empty” in International Class 021. This registration issued on December 10, 2019. Opposer has been selling water bottles under or in connection with the KÜHL mark since at least May 21, 2019.

4. Opposer is the owner and relies on U.S. Trademark Registration No. 4,441,177 for the mark KUHL (words only) for, in part, “Belts; Bottoms; Hats; Jackets; Pants; Shirts; Shorts; Tops” in International Class 025. This registration issued on November 26, 2013. Opposer began using the KUHL mark on or in connection with clothing items sold or transported in commerce at least by February 1, 1994.

5. 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. This registration issued on February 8, 2011.

6. Opposer is the owner and relies on 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. This registration issued on July 21, 2015.

7. Opposer is the owner and relies on U.S. Trademark Application number 88-825,380 for the mark KÜHL (words only) for “Non-electric portable coolers; Portable coolers, non-electric” in International Class 021, which was filed on March 07, 2020.

8. There is no issue of priority with respect to the registered KÜHL portfolio of marks (*see* paragraphs 3–7; the term “KÜHL portfolio of marks” is used to designate the marks identified in paragraphs 3–7 alone or in combination). Opposer filed applications for the cited registrations and filed the cited application 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 that Opposer has acquired in the words KÜHL, KUHL, and KUUL and derivatives thereof.

9. As a result of Opposer’s valid, continuous, extensive, and diverse use of the KÜHL portfolio of marks, Opposer has developed exceedingly valuable goodwill and recognition with respect to the KÜHL portfolio of marks.

10. 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.

11. 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 and prior to Applicant's alleged date of first use.

CONFUSION IS LIKELY

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

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

14. Opposer's marks KÜHL, KUHL, and/or KUUL were well established and famous long before the filing date of the Application.

15. Upon information and belief, Applicant's mark KUL STOOL is confusingly similar to each of Opposer's KÜHL portfolio of marks as used and registered by Opposer. Applicant's KUL STOOL mark is similar in sight, sound, appearance, and commercial impression to each of Opposer's KÜHL portfolio of marks.

16. Upon information and belief, the goods identified in the Application are related to the goods identified in Opposer's pleaded registrations and the products on or in connection with which Opposer has used, and is using, the KÜHL portfolio of marks, including water bottles and clothing. *See Alfwear Inc. v. Rivers Promo, Inc.*, Opposition No. 91256052, 2022 WL 1026675,

at *8 (TTAB Apr. 4, 2022) (non-precedential) (holding that non-electric portable coolers are related to water bottles and clothing).

17. Upon information and belief, the goods identified in the Application, the goods identified in Opposer's pleaded registrations, and the products on and in connection with which Opposer uses its KÜHL portfolio of marks, including water bottles and clothing, are products that are offered for sale and sold in related channels of trade. *See id.* (holding that non-electric portable coolers, water bottles, and clothing are sold through the same channels of trade).

18. Upon information and belief, the goods identified in the Application for KUL STOOL, the goods identified in Opposer's pleaded registrations, 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 a similar class of purchasers. *See id.* (holding that non-electric portable coolers, water bottles, and clothing are sold to the same classes of customers).

19. Applicant has no license, consent, or permission from Opposer to use or register the KUL STOOL mark.

COUNT 1
LIKELIHOOD OF CONFUSION

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

21. In view of the fame and/or commercial strength of Opposer's KÜHL portfolio of marks, the similarity of the parties' marks, the similarity of the channels of trade, the identical and related nature of the goods, and the ongoing use of Opposer's KÜHL portfolio of 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.

22. If Applicant is permitted to use and register its KUL STOOL mark as specified in the Application, confusion is likely to result. Applicant's KUL STOOL mark and each of Opposer's KÜHL portfolio of marks begin with the letters "KU." Those letters are then followed either directly or closely by the letter "L." Applicant's Application identifies goods related to the goods identified in the registrations for Opposer's KÜHL portfolio of marks and the goods are in the same class as some of Opposer's KÜHL portfolio of marks (International Class 021). Applicant's mark is phonetically similar to each of the KÜHL portfolio of marks because they all include the pronounced word COOL. 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 Opposer. 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 KUL STOOL, the resulting confusion and assumed affiliation will be damaging to Opposer's established goodwill under the KÜHL portfolio of marks.

23. 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

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

25. Opposer's KÜHL and KUHL marks have become famous in accordance with the standard set forth in 15 U.S.C. § 1125(c).

26. Applicant filed the Application for KUL STOOL after Opposer's KÜHL and KUHL marks became famous. On information and belief, Applicant began using the KUL STOOL mark after Opposer's KÜHL and KUHL marks became famous.

27. Applicant's mark is likely to cause the dilution of distinctiveness of Opposer's famous KÜHL and KUHL marks.

WHEREFORE, Opposer prays that the application Serial No. 97-738,678 be rejected, and that registration of the mark therein sought be denied and refused.

Opposer has hereby appointed Trent Baker of BAKER IP PLLC of 921 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. Opposer further requests that its correspondence email addresses be as follows: trent@bakerip.com, admin@bakerip.com, bowen@rqn.com, arichards@rqn.com, kpickering@rqn.com, docket@rqn.com.

DATED this 10th day of April, 2024.

BAKER IP PLLC

/s Trent Baker/

Trent Baker

RAY QUINNEY & NEBEKER P.C.

/s S. Brandon Owen/

S. Brandon Owen

Attorneys for Opposer Alfwear, Inc. dba KÜHL

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