

ESTTA Tracking number: **ESTTA1359533**
Filing date: **05/17/2024**

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): bowen@rqn.com, arichards@rqn.com, admin@bakerip.com, docket@rqn.com, kpickering@rqn.com (801) 618-3359		
Docket no.	44140-92		

Applicant information

Application no.	98039616	Publication date	04/23/2024
Opposition filing date	05/17/2024	Opposition period ends	05/23/2024
Applicant	KOOL WAR LLC 161 S. HILLSIDE AVE SUCCASUNNA, NJ 07876 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: Athletic shoes; Bandanas; Beanies; Bomber jackets; Clothing jackets; Denim jackets; Footwear; Footwear, namely, flip-flops; Gloves; Hats; Hoodies; Leggings; Neck gaiters; Shoes; Short-sleeved or long-sleeved t-shirts; Ski gloves; Sneakers; Snowboard gloves; Socks; Sports jerseys; Sweat pants; Tee shirts; Vests; Wind-jackets
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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.	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	<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.	3916866	Application date	06/23/2010
Register	Principal		
Registration date	02/08/2011	Foreign priority date	NONE
Word mark	KÄ#HL		
Design mark			
Description of mark	NONE		
Goods/services	<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</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	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
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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		

Related proceedings	None
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Attachments	85705526#TMSN.png(bytes) 85069309#TMSN.png(bytes) 85705696#TMSN.png(bytes) 74561353#TMSN.png(bytes) Notice of Opposition.pdf(184264 bytes)
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Signature	/s Trent H. Baker /
Name	Trent H. Baker
Date	05/17/2024

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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.

KOOL WAR LLC,

Applicant.

Opposition No. _____

Mark: KOOL WAR

Serial No. 98-039,616

Filed: June 13, 2023

Published: April 23, 2024

NOTICE OF OPPOSITION

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

As grounds of opposition, it is alleged that:

1. As is evidenced by the publication of said mark on April 23, 2024, in the Trademark Official Gazette, Applicant seeks to register KOOL WAR (words only) as a trademark for the following goods in International Class 025: “Athletic shoes; Bandanas; Beanies; Bomber jackets; Clothing jackets; Denim jackets; Footwear; Footwear, namely, flip-flops; Gloves; Hats; Hoodies; Leggings; Neck gaiters; Shoes; Short-sleeved or long-sleeved t-shirts; Ski gloves; Sneakers; Snowboard gloves; Socks; Sports jerseys; Sweat pants; Tee shirts; Vests; Wind-jackets.”

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 intent-to-use application for KOOL WAR (the “Application”) on June 13, 2023.

3. 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 United States commerce at least by February 1, 1994.

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. This registration issued on February 8, 2011. Opposer began using the KÜHL mark on or in connection with clothing items sold or transported in United States commerce at least by February 1, 1994.

5. 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.

6. Opposer is the owner and relies on U.S. Trademark Registration No. 1,990,375 for the mark **kühl** (word and design) for, in part, “rugged outdoor clothing, namely jackets, shirts, pants, shorts, T-shirts, and hats” in International Class 025. This registration issued on July 30, 1996. Opposer began using the **kühl** mark on or in connection with clothing items sold or transported in United States commerce at least by February 1, 1994.

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). Opposer filed applications for the cited registrations 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, KUUL, and **kühl** and derivatives thereof.

8. 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.

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

CONFUSION IS LIKELY

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

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

13. Opposer's marks KÜHL, KUHL, KUUL, and **kühl** were well established and famous long before the filing date of the Application.

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

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

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

17. Upon information and belief, the goods identified in the Application for KOOL WAR, the goods identified in each of Opposer's pleaded registrations, and the products on and in connection with which Opposer uses each of its KÜHL portfolio of marks, including clothing, are products that are offered for sale and sold to a similar class of purchasers.

18. Applicant has no license, consent, or permission from Opposer to use or register the KOOL WAR 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/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.

21. If Applicant is permitted to use and register its KOOL WAR mark as specified in the Application, confusion is likely to result. The first word of the KOOL WAR mark contains four letters, begins with the letter "K," and ends with the letter "L." Each of Opposer's KÜHL portfolio of marks similarly contains four letters, begins with the letter "K," and ends with the letter "L." Applicant's Application identifies goods identical to or related to the goods identified in the registrations for Opposer's KÜHL portfolio of marks and the goods are in the same class as Opposer's KÜHL portfolio of marks (International Class 025). Applicant's mark is phonetically similar to each of the KÜHL portfolio of marks because they all include the pronounced word COOL. Likewise, the word WAR in Applicant's mark may be descriptively pronounced as the word WEAR. Therefore, a person familiar with any of 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 KOOL WAR, the resulting confusion and assumed affiliation will be damaging to Opposer's established goodwill under the KÜHL portfolio of marks.

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

25. Applicant filed the Application for KOOL WAR after Opposer's KÜHL and KUHL marks became famous.

26. 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. 98-039,616 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 17th day of May, 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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