

ESTTA Tracking number: **ESTTA1380353**
Filing date: **08/28/2024**

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	Lacoste Alligator SA		
Entity	Corporation	Incorporated or registered in	Switzerland
Address	6, RUE CORNAVIN GENEVA, 1201 SWITZERLAND		
Attorney information	RICHARD LEHV FROSS ZELNICK LEHRMAN & ZISSU, P.C. 151 WEST 42ND STREET 17TH FLOOR NEW YORK, NY 10036 UNITED STATES Primary email: rlehv@fzlz.com Secondary email(s): ysharp@fzlz.com, ttabfiling@fzlz.com, cmende@fzlz.com 2128135928		
Docket no.	LCA 9606823		

Applicant information

Application no.	98278194	Publication date	07/30/2024
Opposition filing date	08/28/2024	Opposition period ends	08/29/2024
Applicant	Zhangjiakou Zeling Technology Co., Ltd 5TH FLOOR, OFFICE BUILDING, NO.1 SOUHO ZHANGJIAKOU CITY, 075000 CHINA		


Goods/services affected by opposition


Class 025. First Use: Oct 8, 2023 First Use In Commerce: Oct 8, 2023
All goods and services in the class are opposed, namely: Bonnets; Cassocks; Raincoats; Shoes; Skooters; Tutus; Camouflage gloves; Clothing jerseys; Fascinator hats; Footwear for men and women; Foul weather gear; Foundation garment girdles; Insoles for footwear; Women's hats and hoods; Women's suits


Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application, amendment to allege use, or statement of use was due	Trademark Act Section 1(a) and (c)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks cited by opposer as basis for opposition

U.S. registration no.	0879171	Application date	03/17/1969
Register	Principal		
Registration date	10/21/1969	Foreign priority date	NONE
Word mark	LACOSTE		
Design mark			
Description of mark	NONE		
Goods/services	Class 039. First use: First Use: Jul 19, 1935 First Use In Commerce: Sep 5, 1950 SHIRTS FOR MEN, WOMEN AND CHILDREN, SWEATERS, TENNIS SHORTS, WALKING SHORTS, SOCKS, BEACH JACKETS, DRESSES FOR WOMEN AND CHILDREN, SWIM TRUNKS, CAPS, HATS, AND SKIRTS		

U.S. registration no.	1035615	Application date	01/16/1975
Register	Principal		
Registration date	03/16/1976	Foreign priority date	NONE
Word mark	LACOSTE		
Design mark			
Description of mark	NONE		
Goods/services	Class 003. First use: First Use: Mar 1969 First Use In Commerce: Sep 1969 PERFUMERY, TOILET WATERS, SKIN CREAMS AND LOTIONS, AND TOILET [AND SHAVING] SOAPS		

U.S. registration no.	1187445	Application date	01/28/1980
Register	Principal		
Registration date	01/26/1982	Foreign priority date	NONE
Word mark	LACOSTE		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: Mar 25, 1979 First Use In Commerce: Mar 25, 1979 Eyeglasses; Sunglasses; Eyeglasses and Eyeglass Case Sold as Unit, and Sunglasses and Sunglass Case as Unit		

U.S. registration no.	1262783	Application date	01/06/1982
Register	Principal		
Registration date	01/03/1984	Foreign priority date	NONE
Word mark	LACOSTE		
Design mark	LACOSTE		
Description of mark	NONE		
Goods/services	<p>Class 003. First use: First Use: Mar 1969 First Use In Commerce: Sep 1969 [PERFUME,] COLOGNE, AFTER SHAVE LOTION, AND PERSONAL DEODORANT</p> <p>Class 018. First use: First Use: Oct 1, 1978 First Use In Commerce: Oct 1, 1978 [Luggage-Namely, Garment Bags for Travel, Duffle Bags, Travel Cases, Key Fobs, wallets and Key Cases]</p> <p>Class 022. First use: First Use: Aug 1975 First Use In Commerce: Sep 1975 Plastic Shopping Bags</p> <p>Class 025. First use: First Use: Jul 19, 1935 First Use In Commerce: Dec 31, 1978 SPORT SHIRTS, [BATHROBES,] WARMUP SUITS, [DIAPER COVERS,] WOMEN'S AND CHILDREN'S SOCKS, SWEATBANDS AND WRISTBANDS AND VISORS</p> <p>Class 028. First use: First Use: Oct 1, 1978 First Use In Commerce: Oct 1, 1978 [Racquetball Bags and Golf Bag Covers]</p>		

U.S. registration no.	1873327	Application date	08/30/1990
Register	Principal		
Registration date	01/10/1995	Foreign priority date	NONE
Word mark	LACOSTE		
Design mark	LACOSTE		
Description of mark	NONE		
Goods/services	Class 028. First use: First Use: Jun 1963 First Use In Commerce: Apr 28, 1994 [tennis rackets, tennis balls, grips, strings for tennis rackets,] tennis bags, [racket covers]		

U.S. registration no.	1947111	Application date	01/16/1992
Register	Principal		
Registration date	01/09/1996	Foreign priority date	NONE
Word mark	LACOSTE		

Design mark	LACOSTE		
Description of mark	NONE		
Goods/services	Class 014. First use: First Use: 1983 First Use In Commerce: 1983 watches		

U.S. registration no.	1985923	Application date	05/20/1992
Register	Principal		
Registration date	07/09/1996	Foreign priority date	NONE
Word mark	LACOSTE		
Design mark	LACOSTE		
Description of mark	NONE		
Goods/services	Class 041. First use: First Use: Oct 1995 First Use In Commerce: Oct 1995 [entertainment in the nature of golf tournaments] Class 042. First use: First Use: Dec 12, 1994 First Use In Commerce: Dec 12, 1995 retail shops featuring clothing, footwear, toiletries, personal accessories and sporting goods		

U.S. registration no.	3023973	Application date	11/02/2000
Register	Principal		
Registration date	12/06/2005	Foreign priority date	NONE
Word mark	LACOSTE		
Design mark	LACOSTE		
Description of mark	NONE		
Goods/services	Class 018. First use: First Use: Mar 2002 First Use In Commerce: Oct 2004 [luggage;] rucksacks; fanny packs; waist packs; [belt bags; belt pouches;] toiletry cases sold empty; [cosmetic cases sold empty;] tote bags; all purpose sport bags; gym bags; hand bags; shoulder bags; [briefcases;] cases for portable telephones; wallets; credit card cases; business card cases; key cases		

U.S. registration no.	3132846	Application date	09/15/2005
Register	Principal		
Registration date	08/22/2006	Foreign priority date	NONE
Word mark	LACOSTE		

Design mark	LACOSTE
Description of mark	NONE
Goods/services	Class 025. First use: First Use: 1935 First Use In Commerce: 1950 Sweaters, blazers, shirts, polo shirts, dress shirts, turtle neck shirts, tee-shirts, sweatshirts, knit shirts, jackets, parkas, trousers, shorts, bermuda shorts, track suit trousers, track suits, skirts, dresses, beachwear, socks, wrist bands, head bands, scarves, headwear, neckwear, gloves, underwear, footwear

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Signature	/Richard Lehv/
Name	Richard Lehv
Date	08/28/2024

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

LACOSTE ALLIGATOR S.A.,

Opposer,

- against -

ZHANGJIAKOU ZELING TECHNOLOGY CO.,
LTD.,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

Opposer, Lacoste Alligator S.A., a corporation organized and existing under the laws of Switzerland, believes that it will be damaged by registration of the mark LOCASTA shown in Application Serial No. 98278194 (the “Application”), and hereby opposes the same. As grounds for this opposition, Opposer, by its counsel, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

FACTS

A. Opposer and its Famous Mark

1. Opposer is the owner of the mark LACOSTE, which it and its licensees have used for a wide variety of clothing and other items, including but not limited to polo shirts, outerwear, hats, caps, shoes, athletic shoes, socks, bags, luggage, and small leather goods, as well as perfumery, sunglasses jewelry, and retail store services offering these goods.

2. Opposer, though licensees, has used the mark LACOSTE in the U.S. for the above goods for many decades. Through extensive promotion and use and the success of Opposer’s offerings bearing the LACOSTE mark, the LACOSTE mark has become famous and

is uniquely and exclusively identified with Opposer and its goods and retail services. The LACOSTE mark became famous long before any priority date upon which Applicant may rely with respect to the mark in the Application.

3. In addition to its strong common law rights in the LACOSTE mark arising from extensive use and consumer recognition, Opposer owns numerous federal registrations for its LACOSTE mark, including:

- No. 0879171, issued in 1969 for “SHIRTS FOR MEN, WOMEN AND CHILDREN, SWEATERS, TENNIS SHORTS, WALKING SHORTS, SOCKS, BEACH JACKETS, DRESSES FOR WOMEN AND CHILDREN, SWIM TRUNKS, CAPS, HATS, AND SKIRTS” in Class 25.
- No. 1035615, issued in 1976 for “PERFUMERY, TOILET WATERS, SKIN CREAMS AND LOTIONS, AND TOILET SOAPS” in Class 3.
- No. 1187445, issued in 1982 for “Eyeglasses; Sunglasses; Eyeglasses and Eyeglass Case Sold as Unit, and Sunglasses and Sunglass Case as Unit” in Class 9.
- No. 1262783, issued in 1984 for “COLOGNE, AFTER SHAVE LOTION, AND PERSONAL DEODORANT” in Class 3 and “SPORT SHIRTS, WARMUP SUITS, DIAPER COVERS, WOMEN'S AND CHILDREN'S SOCKS, SWEATBANDS AND WRISTBANDS AND VISORS” in Class 25.
- No. 1873327, issued in 1995 for “tennis bags” in Class 28.
- No. 1947111, issued in 1996 for “watches” in Class 14.
- No. 1985923, issued in 1996 for “retail shops featuring clothing, footwear, toiletries, personal accessories and sporting goods” in Class 42.

- No. 3023973, issued in 2005 for “rucksacks; fanny packs; waist packs; toiletry cases sold empty; tote bags; all purpose sport bags; gym bags; hand bags; shoulder bags; cases for portable telephones; wallets; credit card cases; business card cases; key cases” in Class 18.
- No. 3132846, issued in 2006 for “Sweaters, blazers, shirts, polo shirts, dress shirts, turtle neck shirts, tee-shirts, sweatshirts, knit shirts, jackets, parkas, trousers, shorts, bermuda shorts, track suit trousers, track suits, skirts, dresses, beachwear, socks, wrist bands, head bands, scarves, headwear, neckwear, gloves, underwear, footwear” in Class 25.

4. The foregoing registrations are valid, subsisting and in full force and effect.

Moreover, most of the above registrations are incontestable and therefore constitute conclusive evidence of Opposer’s exclusive right to use the LACOSTE mark for the goods identified therein.

B. Applicant and its Mark

5. On November 20, 2023, Applicant filed the Application to register the mark LOCASTA (“Applicant’s Mark”) for “Bonnets; Cassocks; Raincoats; Shoes; Skooters; Tutus; Camouflage gloves; Clothing jerseys; Fascinator hats; Footwear for men and women; Foul weather gear; Foundation garment girdles; Insoles for footwear; Women's hats and hoods; Women's suits” in Class 25, alleging first use on October 8, 2023.

6. Prior to any adoption or use of Applicant’s Mark by Applicant, Applicant was on constructive notice of Opposer’s prior rights in the LACOSTE mark by virtue of Opposer’s above-referenced registrations.

7. Upon information and belief, prior to any adoption and use of Applicant's Mark by Applicant, Applicant was on actual notice of Opposer's prior rights in the LACOSTE mark by virtue of Opposer's extensive use thereof.

FIRST CLAIM FOR RELIEF: LIKELIHOOD OF CONFUSION

8. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 7.

9. Opposer's first use of the LACOSTE mark, Opposer's acquisition of exclusive rights in the LACOSTE mark, and Opposer's registration of the LACOSTE mark all took place long prior to any priority date upon which Applicant can rely. Therefore, Opposer's rights in the LACOSTE mark are prior and superior to any rights Applicant may claim in Applicant's Mark.

10. Applicant's Mark is confusingly similar to the LACOSTE mark.

11. The goods identified in the Application are identical or closely related to the goods that Opposer has long offered in connection with its LACOSTE mark, and for which the LACOSTE mark is registered.

12. In view of the similarity of the marks and goods, use by Applicant of Applicant's Mark for the goods identified in the Application is likely to confuse consumers into believing, falsely, that Applicant's goods originate with, are sponsored, or approved by, or are otherwise connected with Opposer or with the goods Opposer offers in connection with its LACOSTE mark. Any use of Applicant's Mark by Applicant is, therefore, likely to cause confusion, to cause mistake or to deceive the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

13. As a result of the foregoing, registration to Applicant of Applicant's Mark would be inconsistent with Opposer's prior exclusive rights in the LACOSTE mark and would threaten

Opposer's investment and goodwill in its LACOSTE mark. Opposer therefore would be injured by registration of Applicant's Mark.

SECOND CLAIM FOR RELIEF: DILUTION BY BLURRING

14. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 13.

15. Opposer's LACOSTE mark is a famous mark and became famous long before the earliest priority date upon which Applicant can rely.

16. Opposer's LACOSTE mark is registered and was registered long before the earliest priority date upon which Applicant can rely.

17. Applicant's Mark is similar to Opposer's LACOSTE mark, and Applicant's Mark creates an association with Opposer's LACOSTE mark.

18. Applicant's use of Applicant's Mark in connection with Applicant's goods will damage Opposer by impairing the distinctiveness of Opposer's famous LACOSTE mark, constituting dilution by blurring, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

THIRD CLAIM FOR RELIEF: NO USE IN COMMERCE

19. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 18.

20. Applicant claimed in the Application that it was using the mark LOCATA in commerce on or in connection with *all* the goods identified in the Application.

21. On information and belief, as of the date of filing the Application, Applicant had not used the mark in commerce on or in connection with all the goods in the Application.

22. Accordingly, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), Applicant is not entitled to a Registration based on use in commerce.

