

ESTTA Tracking number: **ESTTA728619**

Filing date: **02/22/2016**

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	KDB Pty Ltd.
Granted to Date of previous extension	02/21/2016
Address	108-110 Church Street Hawthorn VIC, 3122 AUSTRALIA

Attorney information	Rebecca Gan WENDEROTH LLP 1030 15th Street, NW, Suite 400 East Washington, DC 20005 UNITED STATES wlp@wenderoth.com, rgan@wenderoth.com Phone:202-721-8227
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Applicant Information

Application No	86584742	Publication date	08/25/2015
Opposition Filing Date	02/22/2016	Opposition Period Ends	02/21/2016
Applicant	Kylie Jenner, Inc. c/o Boulevard Management, Inc. Woodland Hills, CA 91364 UNITED STATES		

Goods/Services Affected by Opposition


Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Advertising services, namely, promoting the brands, goods and services of others; endorsement services, namely, promoting the goods and services of others

Grounds for Opposition


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

Marks Cited by Opposer as Basis for Opposition


U.S. Application No.	86683460	Application Date	07/06/2015
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	KYLIE MINOGUE DARLING
Design Mark	
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2006/11/09 First Use In Commerce: 2006/12/01 Fragrance sprays for personal use, perfumes; essential oils for personal use; anti-perspirants and deodorants for personal use; cosmetics; non-medicated skin care preparations; hair care preparations; soaps for personal use

U.S. Application No.	79166727	Application Date	05/21/2015
Registration Date	NONE	Foreign Priority Date	NONE


Word Mark	KYLIE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Education and entertainment

U.S. Registration No.	4348562	Application Date	05/30/2012
Registration Date	06/11/2013	Foreign Priority Date	NONE


Word Mark	KYLIE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0

	Sound recordings, namely, music recordings; recording discs, namely, pre-recorded audio discs featuring music and pre-recorded optical discs featuring music video clips and concerts; compact discs, namely, audio and video compact discs featuring music video clips, and musical recordings; mobile telephone accessories, namely, wrist straps
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U.S. Registration No.	4319410	Application Date	02/24/2012
Registration Date	04/16/2013	Foreign Priority Date	02/22/2012
Word Mark	LUCKY - THE KYLIE MINOGUE MUSICAL		
Design Mark	Lucky - The Kylie Minogue Musical		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Entertainment in the nature of live musical performances: live entertainment in the nature of live music concerts; organization of exhibitions for musical entertainment; arranging of musical performances: entertainment, namely, live music concerts; musical entertainment services, namely, live performances by singers, dancers and musicians; presentation of musical performances; organization of musical exhibitions for entertainment purposes		

U.S. Registration No.	3547063	Application Date	06/27/2007
Registration Date	12/16/2008	Foreign Priority Date	06/27/2007
Word Mark	KYLIE MINOGUE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 0 First Use In Commerce: 0 Perfumes and fragrance sprays for personal use; [eodorants for personal use; body oil; bath oil; essential oils for aromatherapy; essential oils for use in the manufacture of scented products; cosmetics, namely, lipstick, nail polish, eye-shadow, eyeliner, mascara, foundation and concealer;] skin moisturizing products, namely, skin moisturizer; [eye creams; sunscreen lotions; self-tanning lotions; skin cleansers; skin toners; showergel;] body lotion [; hair care products, namely, shampoos, conditioners, hairgels, hair sprays and hair colors; bodycare products, namely, bubble bath, bath salts, hand soap, body soap and liquidsoap for personal use] Class 004. First use: First Use: 0 First Use In Commerce: 0 [Illuminants, namely, candles and perfumed candles and lamp wicks for lighting] Class 009. First use: First Use: 0 First Use In Commerce: 0 [Sound recordings, namely, music recordings; recording discs, namely, pre-recorded audio discs featuring music and pre-recorded optical discs featuring music video clips and concerts; compact discs featuring musical audio and video		

	<p>content; mobile telephone accessories, namely, straps]</p> <p>Class 011. First use: First Use: 0 First Use In Commerce: 0 [Apparatus for lighting, namely, flashlights]</p> <p>Class 014. First use: First Use: 0 First Use In Commerce: 0 Goods in precious metals or coated therewith, namely, jewellery; jewellery cases [; clocks and watches; digital and analog clocks and watches; alarm clocks; cases for clock and watch-making; watch chains; presentation cases for watches; chronographs for use of time pieces; electric clocks and watches; clock hands; clock and watch making dials; key rings and trinkets in the nature of rings]</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 [Paper and cardboard; printed matter, namely, stationery, photographs, gift card, gift wrap paper; note books, writing pads, diaries, address books, calendars and albums for photographs; pens and pencils; goods made of paper, namely, paper shopping bags]</p> <p>Class 018. First use: First Use: 0 First Use In Commerce: 0 [Leather and imitations of leather, and goods made of these materials, namely, wallets, purses, suitcases and luggage; hand bags, tote bags, canvas and cotton, shopping bags, travel bags, namely, canvas and cotton backpacks, suitcases and luggage; umbrellas]</p> <p>Class 025. First use: First Use: 0 First Use In Commerce: 0 [Clothing, namely, shirts, t-shirts, hooded sweatshirts, pants, shorts, skirts, dresses, lingerie, swimwear, wristbands, hosiery, footwear and headgear, namely, hats, caps, headbands and bandanas; belts]</p> <p>Class 026. First use: First Use: 0 First Use In Commerce: 0 [Ornamental novelty badges, buttons; belt clasps; shoelaces]</p>
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U.S. Registration No.	3131572	Application Date	11/21/2003
Registration Date	08/22/2006	Foreign Priority Date	NONE
Word Mark	KYLIE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 014. First use: First Use: 0 First Use In Commerce: 0 (Foreign Reg #868867) Jewelry, necklaces, [earrings,] bracelets, brooches, chains, [cuff links,] wristwatches, [precious stones; horological and chronometric instruments; costume jewelry;] imitation jewelry; [cases, boxes and caskets of precious metal for jewelry and watches;] chains, bands, bracelets and straps for watches; [parts and fittings for watches and clocks]</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 (Foreign Reg #971303) Printed matter in the nature of catalogs, magazines, printed programs and books featuring the subject matter of music, entertainment, clothing, fashion and lingerie; stationery; mounted and unmounted photographs; pictures; prints; [greeting cards; postcards; notepads; notebooks; writing pads;</p>		

	<p>address books; scrapbooks; folders; printed tickets; printed cartoons; comic strips;] calendars; [photograph albums; diaries; booklets;] stickers; [printed paper labels; pens; pencils; erasers; pencil sharpeners; pencil cases; drawing rulers; boxes for pens; book markers; wrapping and packaging paper; gift bags; paper bags; envelopes; napkins, tablecloths, placemats, coasters; flags of paper; pads of party invitations]</p> <p>Class 028. First use: First Use: 0 First Use In Commerce: 0 (Foreign Reg #971303) Dolls; [dolls' beds, clothes and houses; board games;] play figures; Children's multiple activity toys; toy figures; collectable toy figures; plastic character toys</p>
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Attachments	<p>86683460#TMSN.png(bytes) 79166727#TMSN.png(bytes) 79116176#TMSN.png(bytes) 79114488#TMSN.png(bytes) 79046332#TMSN.png(bytes) 76561587#TMSN.png(bytes) Notice of Opposition KYLIE-86584742.pdf(123213 bytes)</p>
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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	/rgan/
Name	Rebecca Gan
Date	02/22/2016

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

KDB PTY LTD.,

Opposer,

v.

KYLIE JENNER, INC.,

Applicant.

Opposition No. _____

Application Serial No. 86/584,742

Mark: **KYLIE**

NOTICE OF OPPOSITION

KDB Pty Ltd. (hereinafter referred to as the “Opposer”), is a proprietary limited company duly organized in Australia, with its principal place of business located at: 108-110 Church Street, Hawthorn VIC 3122, Australia.

Kylie Jenner, Inc. (hereinafter referred to as the “Applicant”), is a corporation duly organized in the State of California, with an address of: c/o Boulevard Management, Inc., 21731 Ventura Blvd., Suite 300, Woodland Hills, California 91364, United States.

Opposer believes that it will be damaged by the issuance of a registration for the mark “KYLIE”, in standard characters, for services in International Class 35, as identified in U.S. Trademark Application Serial No. 86/584,742 (hereinafter also referred to as “Applicant’s Mark”), filed on April 1, 2015 and published for public opposition in the *Official Gazette* on August 25, 2015; and, therefore, opposes the same.

As grounds for this opposition, Opposer, through counsel, alleges as follows:

FACTUAL BACKGROUND

1. Opposer is a corporate entity affiliated with internationally renowned performing artist, humanitarian, and breast cancer activist, Kylie Minogue, known worldwide simply as “Kylie.”
2. Kylie has been in the entertainment industry since 1979, and launched her first album titled “KYLIE” in 1988. Her eponymous album went gold in the United States, her global hit single “The Locomotion” reaching number three on the U.S. Billboard Hot 100 Chart.
3. Kylie’s 2002 hit album “Fever” also went gold in the United States, garnering her a Grammy Award for her highly successful single “Come Into My World.”
4. To date, Kylie has worldwide record sales of over 80 million records and tours regularly around the globe, including in the United States.
5. Opposer owns the website “www.kylie.com”. This domain was registered on August 21, 1996, and has been operational since 1998, promoting a variety of goods, services, and charitable endeavors.
6. Kylie is a breast cancer survivor, whose public health crisis and activism for increased research and public awareness has produced what has been called “The Kylie Effect,” in spurring early detection among young women worldwide.
7. Kylie has also been active both in the United States and around the world in a variety of high publicity humanitarian efforts, including American Foundation for Aids Research (Amfar) and Fashion Targets Breast Cancer, a charitable initiative of the Council of Fashion Designers of America.
8. Opposer is the owner of U.S. Trademark Application Serial No. 86/683,460 for “KYLIE MINOGUE DARLING”, in standard characters, for the following goods: “Fragrance

sprays for personal use, perfumes; essential oils for personal use; anti-perspirants and deodorants for personal use; cosmetics; non-medicated skin care preparations; hair care preparations; soaps for personal use,” in International Class 3. U.S. Trademark Application Serial No. 86/683,460 was filed on July 6, 2015 and was published for public opposition in the *Official Gazette* on December 15, 2015, and has a first use in commerce date of December 1, 2006.

9. Opposer is the owner of U.S. Trademark Application Serial No. 79/166,727 for “KYLIE”, for the following services: “Education and entertainment,” in International Class 41. U.S. Trademark Application Serial No. 79/166,727 was filed on May 21, 2015.

10. Opposer is the owner of U.S. Trademark Registration No. 4,348,562 for “KYLIE”, in standard characters, for the following goods: “Sound recordings, namely, music recordings; recording discs, namely, pre-recorded audio discs featuring music and pre-recorded optical discs featuring music video clips and concerts; compact discs, namely, audio and video compact discs featuring music video clips, and musical recordings; mobile telephone accessories, namely, wrist straps,” in International Class 9. U.S. Trademark Registration No. 4,348,562 registered on June 11, 2013.

11. Opposer is the owner of U.S. Trademark Registration No. 4,319,410 for “LUCKY - THE KYLIE MINOGUE MUSICAL”, in standard characters, for the following services: “Entertainment in the nature of live musical performances: live entertainment in the nature of live music concerts; organization of exhibitions for musical entertainment; arranging of musical performances: entertainment, namely, live music concerts; musical entertainment services, namely, live performances by singers, dancers and musicians; presentation of musical

performances; organization of musical exhibitions for entertainment purposes,” in International Class 41. U.S. Trademark Registration No. 4,319,410 registered on April 16, 2013.

12. Opposer is the owner of U.S. Trademark Registration No. 3,547,063 for “KYLIE MINOGUE & Design”, for the following goods: “Perfumes and fragrance sprays for personal use; skin moisturizing products, namely, skin moisturizer; body lotion,” in International Class 3; and “Goods in precious metals or coated therewith, namely, jewellery; jewellery cases,” in International Class 14. U.S. Trademark Registration No. 3,547,063 registered on December 16, 2008, and was acknowledged by the USPTO as incontestable on July 9, 2015.

13. Opposer is the owner of U.S. Trademark Registration No. 3,131,572 for “KYLIE”, in standard characters, for the following goods: “Jewelry, necklaces, bracelets, brooches, chains, wristwatches, imitation jewelry; chains, bands, bracelets and straps for watches;” in International Class 14; “Printed matter in the nature of catalogs, magazines, printed programs and books featuring the subject matter of music, entertainment, clothing, fashion and lingerie; stationery; mounted and unmounted photographs; pictures; prints; calendars; stickers;” in International Class 16; and “Dolls; play figures; Children's multiple activity toys; toy figures; collectable toy figures; plastic character toys,” in International Class 28. U.S. Trademark Registration No. 3,131,572 registered on August 22, 2006.

14. U.S. Trademark Application Serial Nos. 86/683,460 and 79/166,727; and U.S. Trademark Registration Nos. 4,348,562; 4,319,410; 3,547,063; and 3,131,572 are hereinafter also referred to as “Opposer’s Marks”.

15. Opposer has used Opposer's Marks, in association with the applied for and registered goods and services, in U.S. commerce, and Opposer's Marks are currently in use in U.S. commerce.

16. Applicant is a corporate entity affiliated with Kylie Jenner, a 2015 home-schooled graduate of Laurel Springs School in Ojai, California.

17. Ms. Jenner is a secondary reality television personality who appeared on the television series "Keeping Up With the Kardashians" as a supporting character, to Ms. Jenner's half-sisters, Kim, Khloe, and Kourtney Kardashian (*i.e.*, the Kardashians).

18. Ms. Jenner is active on social media where her photographic exhibitionism and controversial posts have drawn criticism from, *e.g.*, the Disability Rights and African-American communities.

19. On April 1, 2015, Applicant filed an application to register the "KYLIE" mark, in standard characters, for the following services: "Advertising services, namely, promoting the brands, goods and services of others; endorsement services, namely, promoting the goods and services of others," in International Class 35, with a Section 1(b) intent-to-use filing basis. Applicant's Mark was issued Serial Number 86/584,742, and was published for public opposition in the *Official Gazette* on August 25, 2015.¹

¹ Opposer filed a 90-Day Request for Extension of Time to Oppose, which was granted by the Board on September 21, 2015. Opposer subsequently filed a 60-Day Request for Extension of Time to Oppose with Consent, which was granted by the Board on December 10, 2015.

COUNT ONE: PRIORITY

20. Opposer re-alleges and incorporates herein by reference the allegations in paragraphs 1-19 above as if fully set forth herein.

21. Upon opinion and belief, Opposer's use and registration of Opposer's Marks, long pre-dates the filing date of Applicant's Mark.

22. Upon opinion and belief, Applicant's Mark has not been used in U.S. commerce and is not currently in use in commerce.

23. The granting of a trademark registration to Applicant for Applicant's Mark would violate and diminish the prior and superior rights of Opposer.

24. Opposer would be damaged within the meaning of 15 U.S.C. §1063(a), if Applicant's Mark is allowed to register, because Applicant would obtain statutory rights in Applicant's Mark in violation and derogation of the established prior rights of Opposer in Opposer's Marks.

COUNT TWO: LIKELIHOOD OF CONFUSION

25. Opposer re-alleges and incorporates herein by reference the allegations in paragraphs 1-24 above as if fully set forth herein.

26. Applicant's Mark is likely to be confused with and mistaken for Opposer's goods and services developed and marketed under Opposer's Marks, because Applicant's "KYLIE" mark is confusingly similar in sight and sound to Opposer's Marks.

27. Additionally, Applicant's Mark conveys a nearly identical commercial impression as Opposer's Marks.

28. Upon information and belief, Applicant's Mark is intended to be used on and in connection with services that are confusingly similar to those of Opposer.

29. Upon information and belief, Applicant's target customer and consumer base for its services overlaps with the customers and consumers of Opposer's goods and services.

30. Applicant's services description contains no restrictions or limitations as to Applicant's channels of trade; accordingly, Opposer may assume that Applicant's Mark, like Opposer's Marks, will be used in all accepted channels of trade.

31. Therefore, upon information and belief, Applicant's channels of trade for its services also overlaps with the channels of trade used by Opposer, or exist within the natural realm of expansion available to Opposer, for producing, providing, marketing, selling, and otherwise distributing its products and services.

32. If Applicant is permitted to register its "KYLIE" mark, confusion resulting in damage and injury to Opposer would likely occur. Persons familiar with Opposer's Marks, and Opposer's goods and services, would likely be confused, be mistaken, or be deceived into the belief that Applicant's services are associated with, affiliated with, or sponsored by Opposer. Such confusion would inevitably result in damage to Opposer.

33. Any defect, objection to, or fault found with Applicant's services marketed under Applicant's Mark, would necessarily reflect on and seriously injure the reputation that Opposer has established for its premium and famous goods and services.

34. Opposer's customers and the relevant public are likely to misperceive Applicant's Mark as one of Opposer's Marks, rather than as a mark of Kylie Jenner, Inc., and/or believe in error

that the services offered under Applicant's Mark are offered by, in association with, connected to, or under license from Opposer.

35. Applicant's filing of U.S. Trademark Application Serial No. 86/584,742 is without license, authorization, or permission from Opposer.

36. Registration of Applicant's Mark will further injure Opposer because such mark may disparage Opposer and Opposer's Marks, and/or bring them into contempt or disrepute.

37. Opposer has expanded its trademark use of "KYLIE" and "KYLIE"-formative marks to cover numerous additional products and services, including, but not limited to, advertising and endorsement services.

38. Opposer has invested substantial amounts of time, effort and money in protecting and policing its "KYLIE" trade name in the United States and throughout the world. As such, Opposer has extensive, non-registered statutory and common law rights in and to its "KYLIE" trade name, which Opposer uses in connection with its business activities.

39. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark, and of Applicant's exclusive right to use its "KYLIE" mark, all to the detriment of Opposer.

COUNT THREE: DILUTION

40. Opposer re-alleges and incorporates herein by reference the allegations in paragraphs 1-39 above as if fully set forth herein.

41. Prior to the application filing date for Applicant's Mark, Opposer's Marks had become famous for Opposer's goods and services, and the public has come to associate Opposer's goods and services with the "KYLIE" trademark and trade name.

42. Accordingly, Opposer's Marks have become distinctive and famous and, therefore, are subject to the protections and remedies of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

43. Registration of Applicant's Mark will also injure Opposer by causing a likelihood of dilution, through blurring and tarnishment, of the distinctive quality of Opposer's Marks.

44. In view of the foregoing reasons, the grant of a registration for Applicant's Mark, as sought in the application opposed herein, should be denied as registration would be contrary to the provisions of Section 2(d) and Section 43(c) of the Lanham Act, 15 U.S.C. §1052(d) and 15 U.S.C. §1125(c), respectively; and Opposer believes that it would be damaged thereby.

WHEREFORE, by the undersigned attorney, Opposer respectfully requests that this Notice of Opposition be sustained, and that registration of U.S. Trademark Application Serial Number 86/584,742 be refused.

Dated: February 22, 2016

Respectfully submitted,

/rgan/

Rebecca Gan, Esq.
Attorney for Opposer
WENDEROTH LLP
1030 15th Street, N.W.
Suite 400 East
Washington, D.C. 20005
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CERTIFICATE OF SERVICE

I, Christopher Emond, hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Applicant's attorneys of record, Jennifer Ko Craft, Esquire, John L. Krieger, Esquire, and Joanna M. Myers, Esquire, by mailing said copy on this 22nd day of February 2016, via First Class Mail, postage prepaid to:

Jennifer Ko Craft, Esquire
John L. Krieger, Esquire
Joanna M. Myers, Esquire
DICKINSON WRIGHT PLLC
8363 West Sunset Road, Ste. 200
Las Vegas, Nevada 89113
United States

 /cpe/
Christopher Emond