

This Opinion is not a
Precedent of the TTAB

Oral Hearing: January 22, 2020

Mailed: September 30, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Barclays Capital Inc.
and Barclays PLC

v.

Tiger Lily Ventures Ltd.

Opposition Nos. 91219477¹ (parent) and 91219478

Tiger Lily Ventures Ltd.

v.

Barclays Capital Inc.
and Barclays PLC

Opposition No. 91219549

Eric J. Shimanoff of Cowan, Liebowitz & Latman, P.C. for Opposers/Counterclaim-Defendants, Barclays Capital Inc. and Barclays PLC.

Robert Garson of Garson, Ségal, Steinmetz, Fladgate LLP for Applicant/Counter-Opposer, Tiger Lily Ventures Ltd.²

¹ The record in these consolidated proceedings is maintained in Opposition No. 91219477 and all citations are to that proceeding unless otherwise noted.

² Trial briefs and other documents filed on behalf of Applicant/Counter-Opposer Tiger Lily Ventures Ltd. identify its counsel as “Attorneys for Defendant/Counter Opposer Tiger Lily, Ltd.” while the ESTTA sheet identifies Defendant as “Tiger Lily Ventures Ltd.” Additionally, the Applicant for Application Serial No. 85868892 is identified as “Tiger Lily Venture Ltd.” while the Applicant for Application Serial No. 86298069 is identified as “Tiger Lily Ventures Ltd.” Accordingly, this decision applies to the Applicant(s) of Serial Nos. 85868892 and 86298069, regardless of which legal name identifies the Applicant(s).

Before Taylor, Mermelstein and Kuczma,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

In 2008, Lehman Brothers was the fourth largest investment bank in the United States, with hundreds of billions of dollars of assets under management and over 25,000 employees in offices worldwide when it filed for protection under the U.S. bankruptcy laws, the largest bankruptcy in United States history.³ A day later, Lehman Brothers sold several of its businesses and other assets, including its LEHMAN BROTHERS trademarks and the accompanying goodwill, to Opposer, Barclays Capital Inc. (Barclays), “one of the world’s oldest and leading providers of financial services” for approximately \$1.3 billion. Lehman Brothers assigned to Barclays all of Lehman Brothers’ rights in the LEHMAN names and trademarks, including LEHMAN BROTHERS, and the goodwill associated therewith.⁴

Shortly thereafter, pursuant to amendments to their agreement, Barclays granted Lehman Brothers a worldwide, non-exclusive license to use the LEHMAN tradenames and trademarks in connection with Lehman Brothers’ retained and continuing businesses and operations. The term of the trademark license was limited

³ Barclays’ Trial Testimony Declaration of Alexander L. Greenberg, Esq., Director, Legal (formerly, Vice-President, Legal) for Barclays Capital Inc., ¶¶ 3, 6 (86 TTABVUE 6-7).

All cites to the record are to the record in Opposition No. 91219477 unless otherwise noted. Record citations are to TTABVUE, the Board’s publically available electronic docket history system. The number preceding TTABVUE corresponds to the docket entry number(s), and any number(s) following TTABVUE refer to the page number(s) of the docket entry where the cited materials appear. For material or testimony that has been designated confidential, the TTABVUE docket entry number where such material or testimony is located is referenced.

⁴ The term “trademarks” in this decision includes service marks.

to “two years for use in connection with certain Lehman businesses, namely, Lehman Brothers’ investment banking and capital markets businesses. . . . the amendment does not alter the perpetual license granted to Lehman Brothers for its other businesses or continuing operations.”⁵

Several years later, on March 6, 2013, Tiger Lily Ventures Ltd. (Tiger Lily) filed an application to register LEHMAN BROTHERS (standard characters) for beer and spirits in International Classes 32 and 33, and filed a second application to register the same mark for bar services and restaurant services in International Class 43, on June 2, 2014, Application Nos. 85868892 and 86298069, respectively.⁶

Meanwhile, after allowing all of the U.S. trademark registrations for the LEHMAN and LEHMAN BROTHERS marks it acquired to expire, Barclays filed trademark application, Application Serial No. 86081143, on October 2, 2013 for the mark LEHMAN BROTHERS (standard characters)⁷ for:

Securities brokerage services; investment consulting services; investment banking services; merchant banking services; financial and investment management services; financial planning and investment advisory services; financial research services; administration and valuation of financial investments; financial sponsorship of sporting, charitable and educational events; providing consultancy,

⁵ Greenberg Testimony Declaration ¶¶ 7-9 (86 TTABVUE 7-9) and Exhibits 3-5 thereto titled Intellectual Property Assignment Agreement (86 TTABVUE 159-226); Confidential (88 TTABVUE 6-79).

⁶ Tiger Lily’s Trial Testimony Declaration of Chaim Aaron James Green, founder and director of Tiger Lily Ventures, Ltd., ¶¶ 8, 11, 17 (124 TTABVUE 4-6); Barclays’ First Notice of Reliance Exhibits 1-2 (77 TTABVUE 6-12, 13-17).

⁷ Greenberg Testimony Declaration ¶ 45 (86 TTABVUE 16).

information and advisory services relating to all the foregoing, in International Class 36.⁸

A year later, on November 24, 2014, Barclays filed Notices of Opposition, Opposition Nos. 91219477 and 91219478, against Tiger Lily's LEHMAN BROTHERS applications Serial Nos. 86298069 and 85868892.⁹ The Board subsequently consolidated those two Oppositions, designating Opposition No. 91219477 as the "parent case."¹⁰ A day later, Opposition No. 91219549, filed by Tiger Lily, opposing Barclays' Application Serial No. 86081143 for the mark LEHMAN BROTHERS was added to the consolidated proceeding.¹¹

Thus, this consolidated proceeding involves Opposition Nos. 91219477 and 91219478 filed by Barclays against Tiger Lily's applications, and Opposition No. 91219549 filed by Tiger Lily against Barclays' application, each involving the identical LEHMAN BROTHERS mark.

⁸ Application Serial No. 86081143 was filed on October 2, 2013 for the mark LEHMAN BROTHERS based on Barclays' allegation of a bona fide intention to use the mark in commerce under § 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Acquired distinctiveness is claimed as to the entire mark.

⁹ Application Serial No. 85868892 for beer in International Class 32 and spirits in International Class 33 was filed on March 6, 2013 and Application Serial No. 86298069 for bar services, restaurant services in International Class 43 was filed on June 2, 2014; both applications are for the mark LEHMAN BROTHERS and are based on Tiger Lily's allegation of a bona fide intention to use the mark in commerce under § 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). "BROTHERS" is disclaimed in both applications.

¹⁰ 4 TTABVUE.

¹¹ 5 TTABVUE.

I. Opposition Nos. 91219477-78 filed by Barclays

A. Barclays' Grounds of Opposition

Barclays' Notices of Opposition assert: (1) it is the owner by assignment of the LEHMAN and LEHMAN BROTHERS common law marks; (2) that such marks are famous; (3) that it has priority of use and there is a likelihood of confusion under § 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), between Barclays' previously used marks and Tiger Lily's mark; (4) that registration of Tiger Lily's mark dilutes the distinctive quality of Barclays' marks long associated with the Lehman Brothers financial institution and allegedly owned and used by Barclays and used by Lehman Brothers and third parties pursuant to license, in violation of § 43(c) of the Trademark Act, 15 U.S.C. § 1125(c)¹²; (5) that Tiger Lily's mark falsely suggests a connection between Tiger Lily and Barclays (or Lehman Brothers, the predecessor-in-interest of Barclays) in violation of § 2(a) of the Trademark Act, 15 U.S.C. § 1052(a); and (6) that at the time Tiger Lily filed its applications, it did not have a *bona fide* intent to use the mark in commerce.¹³

¹² Barclays' Notice of Opposition plead dilution under § 13(a) of the Trademark Act, 15 U.S.C. § 1063(a).

¹³ Opposition No. 91219477, 1 TTABVUE; Opposition No. 91219478, 1 TTABVUE.

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