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Vasuki Selvan
Vasuki Selvan

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

In the Matter of Trademark Application
for "504 GEAR")

Applicant: The Chad Knox & Alonzo
Smalley Partnership)

Serial No.: 76/280,869)

Filed: July 2, 2001)

International
Class No: 25)

Published in the Official Gazette:
June 25, 2002)
Page TM 641)

09/19/2002 JHARLEY 00000067 76280869)

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U.S. Patent & TMO/TM Mail Rcpt. Dt. #57



09-13-2002

TTAB FEE

NOTICE OF OPPOSITION

Levi Strauss & Co. (hereinafter "Opposer") believes it will be damaged by the registration of "504 GEAR" illustrated in and covered by Application Serial No. 76/280,869, filed on July 2, 2001, by The Chad Knox & Alonzo Smalley Partnership (hereinafter "Applicant"), and hereby opposes such registration.

Opposer is a Delaware corporation having its headquarters and its principal place of business at 1155 Battery Street, San Francisco, California 94111.

Applicant is, upon information and belief, a Michigan partnership with its place of business located at 5581 Ivanhoe, Detroit, Michigan 48204.

This Notice of Opposition has been timely filed.

As grounds of opposition, Opposer alleges as follows:

1. As illustrated in the Official Gazette dated June 25, 2002, at Page TM 641, Applicant seeks to register "504 GEAR" as illustrated in and covered by Application Serial No. 76/280,869 in International Class 25.
2. Opposer is the owner of the distinctive 501® Trademark, as reflected in the representative Registration No. 1,552,985, which issued on the Principal Register on August 22, 1989, is presently in full force and effect, and which is incontestable under 15 U.S.C. § 1065. A true and correct copy of this Registration is attached as Exhibit A. Since at least as early as December 31, 1969, Opposer continuously has used its 501® Trademark on a variety of goods, including but not limited to jeans.
3. No issue of priority exists with respect to Opposer's trademark as set out in Exhibit A and "504 GEAR" illustrated in and covered by Application Serial No. 76/280,869. Opposer's dates of adoption and first use of its trademark long precede the date of Applicant's intent to use application for "504 GEAR."¹
4. Since adoption and first use of Opposer's trademark, Opposer continuously has marketed and presently is marketing its goods nationwide. Opposer's goods are identified as originating from Opposer through the display of Opposer's 501® Trademark.
5. Since adoption and first use of Opposer's 501® Trademark, Opposer has expended and continues to expend substantial time, money, and effort in promoting its 501® Trademark to identify Opposer as the source of the goods displaying that trademark. As a result, Opposer believes and alleges that the public has come to recognize Opposer as the source of a variety of goods, including but not limited to jeans, which display Opposer's 501® Trademark.
6. By virtue of its efforts and expenditure of considerable sums for promotional

¹Upon information and belief, Application Serial Number 76/280,869 was originally filed as a use based application, but was subsequently amended to assert an intent to use basis for filing. To the extent that Applicant has made any use of "504 GEAR", Opposer's dates of adoption and first use of its 501® Trademark long precede the date of Applicant's first use.

activities and by virtue of the excellence of its goods, Opposer has gained a valuable reputation for its 501® Trademark and has developed exceedingly valuable goodwill with respect to that trademark.

7. Registration of “504 GEAR” illustrated in and covered by Application Serial No. 76/280,869 will lead the public to conclude, incorrectly, that Applicant is or has been, and that Applicant’s goods displaying said trademark are or have been, authorized, sponsored, or licensed by Opposer. Accordingly, issuance of any registration to Applicant for “504 GEAR” is contrary to the provisions of 15 U.S.C. § 1052(a) and will result in damage to Opposer and the public.

8. “504 GEAR” illustrated in and covered by Application Serial No. 76/280,869 and any use thereof by Applicant is and will be deceptively similar to Opposer’s 501® Trademark so as to cause confusion, or to cause mistake or to deceive the public as to the origin of Applicant’s goods bearing that trademark. Therefore, registration of said trademark is prohibited by 15 U.S.C. § 1052(d).

9. “504 GEAR” illustrated in and covered by Application Serial No. 76/280,869 creates the same, or essentially the same, commercial impression as Opposer’s 501® Trademark. Accordingly, registration by Applicant of that trademark is likely to cause confusion, or to cause mistake or to deceive the public as to the source of Applicant’s goods, all to the harm and damage of Opposer and the public. Therefore, registration of said trademark is prohibited by 15 U.S.C. § 1052(d).

10. Registration of “504 GEAR” illustrated in and covered by Application Serial No. 76/280,869 would constitute prima facie evidence of the validity of such Registration, of Applicant’s ownership of that trademark, and of Applicant’s exclusive right to use said trademark pursuant to the provisions of 15 U.S.C. § 1057(b). Such registration would be a source of damage and injury to Opposer and the public and would be contrary to the principles of registration set out in 15 U.S.C. §§ 1051 et seq.

11. Opposer’s 501® Trademark is distinctive and famous within the meaning of 15

U.S.C. § 1125(c), the Federal Trademark Dilution Act of 1995. The “504 GEAR” mark illustrated in and covered by Application Serial No. 76/280,869, when used, causes or is likely to cause dilution of the distinctive quality of Opposer’s 501® Trademark, in violation of the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c), all to the harm and damage of Opposer and the public. Therefore, registration of said trademark should be refused under 15 U.S.C. §§ 1052 and 1063(a) (as amended by the Trademark Amendments Act of 1999.)

12. In summary, registration of “504 GEAR” illustrated in and covered by Application Serial No. 76/280,869 should be refused in view of the requirements of the Trademark Act of 1946, as amended, including specifically but not limited to the provisions of 15 U.S.C. §§ 1051, 1052, 1063, and 1127.

WHEREFORE, Opposer prays that this Opposition be sustained, and that registration to Applicant for “504 GEAR” illustrated in and covered by Application Serial No. 76/280,869 in International Class No. 25 be denied.

Opposer hereby files this Notice of Opposition in triplicate; the statutory filing fee of \$300.00 is submitted herewith.

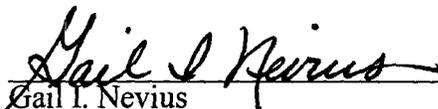
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Opposer hereby appoints the firm of Legal Strategies Group and Gail I. Nevius, a member of the Bar of the State of California, 5095 Christie Avenue, Emeryville, California 95608, telephone (510) 450-9600, its attorneys with full power of substitution and revocation, to prosecute this Opposition and to transact all business in the United States Patent and Trademark Office in connection therewith. All future communications in this Opposition should be directed to Opposer's attorney identified above.

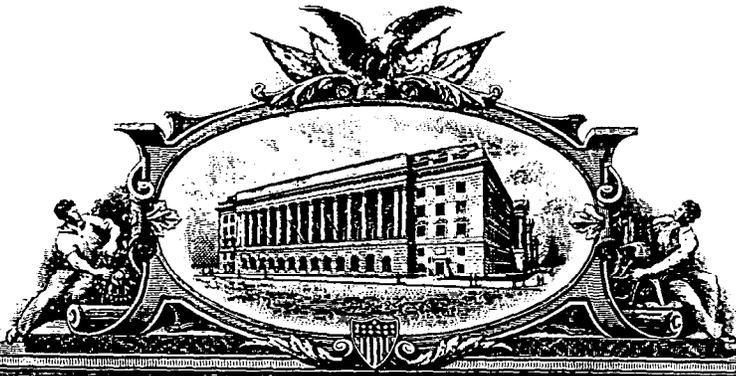
DATED: September 13, 2002

Respectfully submitted,

LEGAL STRATEGIES GROUP

By: 
Gail I. Nevius
LEGAL STRATEGIES GROUP
5905 Christie Avenue
Emeryville, California 94608
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Attorneys for Opposer
LEVI STRAUSS & CO.



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

December 18, 1995

THE ATTACHED U.S. TRADEMARK REGISTRATION 1,552,985 IS CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION ISSUED BY THE UNITED STATES PATENT AND TRADEMARK OFFICE WHICH REGISTRATION IS IN FULL FORCE AND EFFECT.

REGISTERED FOR A TERM OF 20 YEARS FROM *August 22, 1989*
SAID RECORDS SHOW TITLE TO BE IN: *Registrant*



By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS

T. Wallace
T. WALLACE
Certifying Officer

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office Reg. No. 1,552,985
Registered Aug. 22, 1989

**TRADEMARK
PRINCIPAL REGISTER**

501

LEVI STRAUSS & CO. (DELAWARE CORPO-
RATION)
1155 BATTERY STREET
SAN FRANCISCO, CA 94111

FIRST USE 12-31-1969; IN COMMERCE
12-31-1969.

SER. NO. 768,165, FILED 10-24-1988.

FOR: JEANS, IN CLASS 25 (U.S. CL. 39).

CHRIS A. F. PEDERSEN, EXAMINING ATTOR-
NEY



September 13, 2002

U.S. Patent & TMO/c/TM Mail Rcpt. Dt. #57
09-13-2002

VIA EXPRESS MAIL

Box TTAB FEE
The Assistant Commissioner for Trademarks
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Application Serial No. 76/280,869
Applicant: Chad Knox & Alonzo Smalley Partnership
Mark: 504 GEAR
Opposer: Levi Strauss & Co.

02 SEP 20 PM 12: 29
TRADEMARK TRIAL AND APPEAL BOARD

Dear Sir or Madam:

Enclosed please find the original and two copies of the Notice of Opposition in the above-referenced matter, as well as a filing fee check in the amount of \$300.00, and a post card confirming receipt. Please date stamp and return the post card to our offices.

Thank you for your assistance in this matter. If you should have any questions, please do not hesitate to contact me.

Very truly yours,

Vasuki Selvan
Vasuki Selvan
Trademark Specialist
(510) 450-9608

Enclosures