

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

In the Matter of Application Serial No. 78-115,894
Published in the Official Gazette on April 22, 2003

Port Authority, Inc. d/b/a Jocko, Inc.

Opposer,

v.

KL Fenix (A California Corporation),

Applicant.

05-27-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #39

Opposition No.: _____

BOX TTAB FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

Port Authority, Inc. d/b/a Jocko, Inc., a corporation organized and existing under the laws of the State of California, believes that it will be damaged by registration of the mark shown in Serial No. 78-115,894 in Classes 25 and 35 and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. The Applicant seeks to register JOKO as a trademark for the following:

"men's, women's, boy's, girls and children's and infant underwear, footwear, swimwear, caps, headwear, rain wear, aprons, robes, pajamas, hosiery, gloves, suspenders, belts, neckties, women's panties, bras, tank tops, crop tops, bustiers, camisoles, tap pants, teddies, men's briefs, boxer shorts, under shirts, socks, shirts, tee shirts, sweat pants, sweatshirts, knit tops, skirts, pants, trousers, shorts, sweaters, jeans, vests, coats, jackets, overalls, blazers, dresses, scarves, blouses, cardigans, gowns, golf shirts, jogging suits, turtlenecks, suits and polo shirts" in International Class 25; and

"retail store services in the field of apparel, apparel accessories, and home furnishings, providing pricing and descriptive information relating to apparel, accessories and home furnishing products over a global computer network, and providing a photographic gallery over a global computer network featuring photographs of retail apparel, accessories and home furnishings" in International Class 35,

as evidenced by the publication of said mark in the Official Gazette on page TM 106 of the April 22, 2003 issue.

2. The Opposer and its predecessors in title have used the JOCKO house mark since as early as 1993 on a variety of clothing items and currently use it in retail store services. Opposer is submitting herewith as a part hereof and marked Exhibits A, B, C, and D respectively, Registration No. 1,995,176 issued on August 20, 1996; Registration No. 2,445,584 issued April 24, 2001; Registration No. 2,536,790 issued February 5, 2002; and Registration No. 2,625,500 issued September 24, 2002, covering these marks.

3. There is no issue as to priority. The Applicant has yet to use the mark and therefore is subsequent to the issuance date of Opposer's Registrations Nos. 2,445,584, 2,625,500, 2,536,790 and 1,995,176.

4. Opposer has sold its goods and services listed in the aforesaid registrations under the aforesaid marks as hereinbefore referred to throughout the United States. Opposer has developed an exceedingly valuable goodwill in respect to the marks covered by the aforesaid registrations.

5. By virtue of its efforts, and the expenditure of considerable sums for promotional activities, and by virtue of the excellence of its products, the Opposer has gained for its above-identified marks a most valuable reputation.

6. The trademark proposed for registration by the Applicant, namely, JOKO, is substantially incorporated in its entirety in Opposer's marks JOCKO, JOCKO GYM and JOCKO WATCHDOG FOR THE MILLENNIUM AND DESIGN, and is intended to be applied to the identical goods and services as those sold by Opposer and so nearly resemble the Opposer's marks as to be likely to be confused therewith and mistaken therefor. The Applicant's mark is deceptively similar to Opposer's marks so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing the Applicant's mark.

7. If the Applicant is permitted to use and register its mark for its goods and services, as specified in the application herein opposed, confusion in trade resulting in damage and injury to the Opposer would be caused and would result by reason of the similarity between the Applicant's mark and the Opposer's marks. Persons familiar with Opposer's marks would be likely to buy Applicant's goods as and for a product made and sold or services provided by the Opposer. Any such confusion in trade inevitably would result in loss of sales to the Opposer. Furthermore, any defect, objection or fault found with Applicant's products or services marketed

under its mark would necessarily reflect upon and seriously injure the reputation which the Opposer has established for its products merchandised under its marks.

8. If the Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

WHEREFORE, the Opposer prays that the application Serial No 78-115,894 be rejected, and that the mark therein sought for the goods and services herein specified in International Classes 25 and 35 be denied and refused.

Opposer hereby gives notice under Rule 2 122(d) of the Rules of Practice that after hearing and in any appeal on this opposition proceeding, it will rely on its registrations which are annexed as exhibits to this Notice of Opposition as evidence in support of this Notice of Opposition.

A duplicate copy of this Notice of Opposition and the fee required in § 2.6(a)(17) are enclosed herewith.

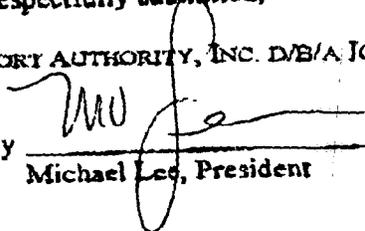
The undersigned Opposer hereby consents and appoints Charles F. Reidelbach, Jr., and Michael J. Hoisington, each a member of the Bar of the State of California, whose address is Higgs, Fletcher & Mack LLP, 401 West "A" Street, Suite 2600, San Diego, California 92101-7910, as its duly authorized agents and attorneys in the matter of the opposition above-identified to prosecute said opposition, to transact all business in the Patent and Trademark Office and in the United States courts in connection with this opposition, to sign their name to all papers which may hereinafter be filed in connection therewith, and to receive all communications relating to the same.

Date: May 21 2003

Respectfully submitted,

PORT AUTHORITY, INC. D/B/A JOCKO, INC

By


Michael Lee, President

533127.2
05/20/03

-3-

Exhibit A:

Registration No. 1,995,176 issued on August 20, 1996



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Tue May 20 04:26:15 EDT 2003

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP

Logout Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status (TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark	JOCKO WATCHDOG FOR THE MILLENNIUM
Goods and Services	IC 025. US 022 039. G & S: clothing, namely shirts, pants, hats, belts, and jackets. FIRST USE: 19931100. FIRST USE IN COMMERCE: 19931100
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	030108 260102 260107 260113 260121 260303 261102 261107
Serial Number	74697753
Filing Date	July 6, 1995
Published for Opposition	May 28, 1996
Registration Number	1995176
Registration Date	August 20, 1996
Owner	(REGISTRANT) LEE, MICHAEL INDIVIDUAL UNITED STATES 5410 WILSHIRE BLVD SUITE 800 LOS ANGELES CALIFORNIA 90036
Attorney of Record	MICHAEL J. HOISINGTON
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-05-20 14:16:19 ET

Serial Number: 74697753

Registration Number: 1995176

Mark



(words only): JOCKO WATCHDOG FOR THE MILLENNIUM

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2002-08-15

Filing Date: 1995-07-06

Registration Date: 1996-08-20

Law Office Assigned: TMEG Law Office 103

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -Warehouse (Newington)

Date In Location: 2002-08-20

CURRENT APPLICANT(S)/OWNER(S)

1. LEE, MICHAEL

Address:

LEE, MICHAEL
5410 WILSHIRE BLVD SUITE 800
LOS ANGELES, CA 90036
United States

Country of Citizenship: United States

Legal Entity Type: Individual

GOODS AND/OR SERVICES

clothing, namely shirts, pants, hats, belts, and jackets

International Class: 025

First Use Date: 1993-11-00

First Use in Commerce Date: 1993-11-00

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-08-15 - Section 8 (6-year) accepted & Section 15 acknowledged

2002-07-31 - Section 8 (6-year) and Section 15 Filed

2002-07-31 - TEAS Section 8 & 15 Received

1996-08-20 - Registered - Principal Register

1996-05-28 - Published for opposition

1996-04-26 - Notice of publication

1996-03-06 - Approved for Pub - Principal Register (Initial exam)

1996-03-04 - Examiner's amendment mailed

1995-12-04 - Communication received from applicant

1995-11-16 - Non-final action mailed

1995-11-13 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

MICHAEL J. HOISINGTON (Attorney of record)

MICHAEL J. HOISINGTON
HIGGS, FLETCHER & MACK LLP
401 W. "A" STREET, STE. 2600
SAN DIEGO CA 92101
United States

Exhibit B:

Registration No. 2,445,584 issued on April 24, 2001

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,445,584

Registered Apr. 24, 2001

**TRADEMARK
PRINCIPAL REGISTER**

JOCKO

PORT AUTHORITY, INC. (CALIFORNIA CORPORATION), DBA JOCKO
5410 WILSHIRE BLVD., SUITE 227
LOS ANGELES, CA 90036

FOR: CLOTHING, NAMELY PANTS, SKIRTS, JACKETS, SHORTS, AND JUMPERS, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 9-11-1993; IN COMMERCE 9-11-1993.

SEC. 2(F).

SER. NO. 75-648,288, FILED 2-25-1999.

ESTHER BELENKER, EXAMINING ATTORNEY

Exhibit C:

Registration No. 2,536,790 issued on February 5, 2002

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,536,790

Registered Feb. 5, 2002

**TRADEMARK
PRINCIPAL REGISTER**

JOCKO GYM

PORT AUTHORITY, INC. (CALIFORNIA COR-
PORATION), DBA JOCKO, INC
5410 WILSHIRE BLVD.
SUITE 227
LOS ANGELES, CA 90036

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "GYM", APART FROM THE MARK
AS SHOWN.

FOR: CLOTHING, NAMELY SHIRTS AND
PANTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

SER. NO. 78-014,387, FILED 6-26-2000.

FIRST USE 2-1-1997; IN COMMERCE 2-1-1997.

TONJA GASKINS, EXAMINING ATTORNEY

Exhibit D:

Registration No. 2,625,500 issued on September 24, 2002

Int. Cl.: 35

Prior U.S. Cls.: 100, 101, and 102

United States Patent and Trademark Office

Reg. No. 2,625,500

Registered Sep. 24, 2002

**SERVICE MARK
PRINCIPAL REGISTER**

JOCKO

PORT AUTHORITY, INC. (CALIFORNIA CORPORATION), DBA JOCKO,
5410 WILSHIRE BLVD., SUITE 227
LOS ANGELES, CA 90036

FIRST USE 10-1-2000; IN COMMERCE 10-1-2000.

SN 75-679,951, FILED 4-12-1999.

FOR: RETAIL CLOTHING STORES; COMPUTERIZED ON-LINE RETAIL SERVICES IN THE FIELD OF CLOTHING, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

ESTHER BELENKER, EXAMINING ATTORNEY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BOX TTAB FEE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

05-27-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #39

TRADEMARK / SERVICE MARK TRANSMITTAL LETTER

Transmitted herewith for consideration by the Commissioner on behalf of:

Opposer: Port Authority, Inc. d/b/a Jocko, Inc.

In opposition of:

S/N: 78/115,894
For: JOKO
In Classes: 025 (Int'l), and 035 (Int'l)

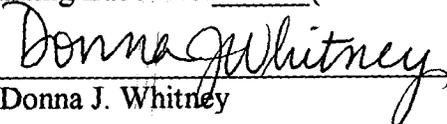
SUBMITTED HEREWITH:

- Trademark / Service Mark Application (PTO Form 1478)
- Power of Attorney (PTO-FB-TM 150)
- Drawing Page
- Amendment Under 37 C.F.R. § 2.62
- Declaration Under 37 C.F.R. § 2.20
- Statement of Use (PTO Form 1580)
- Request for Extension of Time to File Statement of Use (PTO Form 1581)
- Affidavit of a Mark Under Section 8 (PTO Form 1583)

CERTIFICATION OF MAILING UNDER 37 CFR §§1.8(a) and 1.10

I hereby certify that, on the date shown, this correspondence is being:

- deposited with the United States Postal Service, 21 May 2003, in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514.
- with sufficient postage as first class mail. (37 CFR §1.8(a))
- as "Express Mail Post Office to Addressee" Mailing Label No. _____ (37 CFR §1.10)


Donna J. Whitney

Trademark/Service Mark Transmittal Letter

Page 2

- Application for Renewal of a Mark (PTO-FB-TM 201)
- Affidavit for Publication under Section 12(c) (PTO Form 4.14a)
- Affidavit of Incontestability under Section 15 (PTO-FB-207)
- Combined Affidavit for Publication and Incontestability (PT-FB-TM 209)
- Opposition to the Registration of a Mark (PTO-FB-TM 300)
- Petition to Cancel Registration of a Mark (PTO-FB-TM 301)
- Petition to Revive Abandoned Application
- Ex Parte Appeal from Examiner of Trademarks to Trademark (PTO-FB-TM 302)
- Cover Sheet, Recordation of Trademark Assignment (PTO Form 1594)
- Other: Specimen (1 page)
- Payment of Filing Fees
 - Please charge our deposit order account no. 501760 in the amount of \$600.00 for opposition to the registration of a mark. A duplicate copy of this letter is attached.
 - A check in the amount of \$ ___ is enclosed
 - A firm check, no. ____, in the amount of \$ ___ is enclosed
 - A cashiers check/money order in the amount of \$ ___ is enclosed. Issuing Institution: _____

This transmittal letter ends with this page.

Date: 21 MAY 2003

Respectfully submitted,



CHARLES F. REIDELBACH, JR.
Attorney for Applicant

HIGGS FLETCHER & MACK LLP
2600 First National Bank Building
401 West "A" Street
San Diego, CA 92191-7910
Telephone: (619) 236-1551
Facsimile: (619) 696-7312
E-mail: reidelbachc@higgslaw.com