

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

In the Matter of Trademark Application
Serial No. 76/498,101
for the mark
PHATMUSCLE

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PHAT FASHIONS LLC, :
:
Opposer, :
:
-against- :
:
Lopez, Gabriel R. :
:
Applicant. :
-----X



06-30-2004

U.S. Patent & TMO/TM Mail Rcpt. Dt. #40

Opposition No.

In the matter of the Application of Lopez, Gabriel R. (“Applicant”) for registration of the trademark PHATMUSCLE, Application Serial No. 76/498,101 which was published in the *Official Gazette* on March 2, 2004, Phat Fashions LLC (“Opposer” or “Phat Fashions”), a limited liability company organized under the laws of the State of New York with its principal place of business at 512 Seventh Avenue, 43rd Floor, New York, New York 10018, respectfully avers that it will be substantially and irreparably damaged by the registration of the mark PHATMUSCLE as shown in Application Serial No. 76/498,101. Accordingly, Phat Fashions hereby opposes the filing and registration of the PHATMUSCLE mark. As grounds for opposition, it is alleged that:

1. Opposer is and for several years has been an internationally renowned manufacturer and retailer of men’s, women’s and children’s clothing, including headwear, and fashion accessories.

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2. In addition to the common law rights that Opposer owns in the mark “PHAT”, Opposer is also the owner of the following Federal trademark registrations, hereinafter referred to as the “family of PHAT marks”:

(a) PHAT, Reg. No. 2,372,748, in Class 25 for clothing for men, women and children, including, inter alia, caps, headbands, hats, footwear, socks, stockings, pantyhose, pants, denim jeans, overalls, shorts, shirts, t-shirts, sweatshirts, blouses, skirts, dresses, sweaters, vests, sweatpants, sweatshorts, swimwear, belts, underwear, sleepwear, scarves, suspenders, neckties; cloth, denim, leather and suede jackets, and rainwear;

(b) PHAT FARM, Reg. No. 1,809,325 in Class 25 for clothing, including, inter alia, denim jeans, denim jackets, shirts, sweatshirts, t-shirts, dress shirts, sweat shorts and army jackets;

(c) PHAT FARM, Reg. No. 2,260,888 in Class 35 for retail store services featuring clothing and fashion accessories;

(d) PHAT FARM, Reg. No. 2,415,455 in Classes 18 and 25 for clothing for men, women and children, including, inter alia, caps, headbands, hats, footwear, socks, stockings, pantyhose, pants, overalls, shorts, blouses, skirts, dresses, sweaters, vests, sweatpants, swimwear, belts, underwear, sleepwear, scarves, suspenders, neckties; cloth, leather and suede jackets, and rainwear (Class 25) and backpacks, messenger bags, athletic bags, tote bags, umbrellas, wallets, purses, coin purses, key cases and credit card cases (Class 18);

(e) PHAT THREADS, Reg. No. 1,819,997 in Class 25 for clothing, including, inter alia, shorts, sweatshirts, t-shirts, dress shirts, army jackets, anoraks and leather jackets;

(f) PHAT FARM (Stylized), Reg. No. 2,552,152 in Class 25 for clothing namely, pants, denim jeans, overalls, shorts, shirts, sweaters, jackets in all fabrications and weights, vests, t-shirts, sweatshirts, sweatpants, suspenders, neckties, caps, hats, headbands, belts, underwear, sleepwear, scarves and workout gear; outerwear in all fabrications, namely, cloth, denim, leather and suede jackets; footwear, socks and rainwear;

(g) PHAT FARM and Design, Reg. No. 2,272,181 in Class 25 for clothing for men, women and children, including, inter alia, caps, headbands, hats, pants, denim jeans, overalls, shorts, shirts, blouses, skirts, dresses, sweaters, jackets in all fabrications and weights, vests, t-shirts, sweatshirts, sweatpants, swimwear, belts, underwear, socks, sleepwear, scarves and outerwear in all fabrications, and rainwear;

(h) P PHAT FARM and Design, Reg. No. 2551,715 in Class 25 for clothing for men and children, namely, pants, overall, shorts, sweaters, vests, sweatpants, caps, headbands, scarves, hats, belts, socks, sleepwear, suspenders and footwear; cloth, leather and suede jackets, rainwear and men's and boys swimwear, underwear and neckties;

(i) PHAT FARM and Design, Reg. No. 2,487,474 in Class 25 for clothing, namely, shirts, both knit and woven, T-shirts and sweatshirts;

(j) PHAT P FARM and Design, Reg. No. 2,485,552 in Classes 18 and 25 for backpacks, and messenger bags (Class 18) and men's and women's apparel, namely, pants, shirts both knit and woven, sweaters, coordinated jackets in all fabrications and weights, vests, T-shirts, sweatshirts, sweatpants, caps, hats, belts, and underwear; outerwear in all fabrications, namely, cloth jackets, denim jackets, leather jackets and suede jackets (Class 25);

(k) BABY PHAT, Reg. No. 2,240,881 in Class 25 for women's and girls' apparel, including, inter alia, pants, denim jeans, overalls, shorts, shirts, blouses, skirts, dresses, sweaters, jackets in all fabrications and weights, vests, t-shirts, sweatshirts, sweatpants, swimwear, caps, headbands, hats, belts, underwear, socks, sleepwear, scarves and outerwear in all fabrications, and rainwear;

(l) BABY PHAT (Stylized), Reg. No. 2,303,780 in Class 25 for women's and girls' apparel, including, inter alia, pants, denim jeans, overalls, shorts, shirts, t-shirts, blouses, skirts, dresses, sweaters, jackets in all fabrications and weights, vests, sweatshirts, sweatpants, swimwear, caps, headbands, underwear, socks, sleepwear, hats, belts and scarves; outerwear in all fabrications and weights, and rainwear;

(m) BABY PHAT and Design, Reg. No. 2,429,559 in Class 25 for clothing for women and girls, including, inter alia, pants, denim jeans, shorts, shirts, skirts, dresses, sweatshirts, swimwear, caps, sleepwear, outerwear in all fabrications, jackets in all fabrications and weights, sweaters, blouses, overalls, vests, underwear, belts, caps, hats, headbands, socks, scarves, sweatpants, t-shirts and rainwear;

(n) BABY PHAT and Design, Reg. No. 2,541,251 in Class 18 for backpacks, shoulder bags, handbags, purses, luggage, athletic bags, tote bags, toiletry cases sold empty, briefcases, umbrellas, key cases and wallets;

(o) BABY PHAT GIRLZ, Reg. No., 2,557,269 in Class 25 for clothing, namely, pants, denim jeans, overalls, shorts, shirts, blouses, skirts, dresses, sweaters, jackets in all fabrications and weights, vests, t-shirts, sweatshirts, sweatpants, swimwear, caps, headbands, hats, belts, underwear, socks, sleepwear and scarves; outerwear in all fabrications, namely, cloth, denim, leather and suede jackets; footwear, rainwear;

(p) PHAT FARM and Design, Reg. No. 2,256,348 in Class 18 for backpacks, messenger bags; leather goods, namely, wallets;

(q) PHAT FARM (Stylized), Reg. No. 2,492,511 in Class 18 for backpacks, messenger bags, athletic bags and tote bags;

(r) BABY PHAT, Reg. No. 2,538,494 in Class 18 for backpacks, messenger bags; handbags, purses, luggage, athletic bags, tote bags, toilet cases sold empty, briefcases, umbrellas, key cases and wallets;

(s) PHAT CATZ, Reg. No. 1,544,526 in Class 25 for athletic shoes.

3. Opposer has continuously and substantially used the marks PHAT® in interstate commerce since at least as early as December 31, 1992 in connection with clothing in Class 25, PHAT FARM® in interstate commerce in Class 35 since at least as early as June 1992 in connection with its retail stores services featuring its fashion accessories, and has continuously and substantially used the marks PHAT FARM® and BABY PHAT® in interstate commerce since at least as early as 1993 on clothing and fashion accessories. In addition, Opposer has continuously and substantially used the marks PHAT THREADS® in interstate commerce since at least as early as 1993 on clothing and PHAT FARM® and PHAT FARM and Design® in interstate commerce since at least as early as 1994 in connection with, inter alia, clothing and fashion accessories.

4. Opposer's family of PHAT marks have each been in valid and continuous use since the date of first use cited in each registration and have not been abandoned.

5. Opposer has expended substantial sums and significant resources over the years advertising and promoting its family of PHAT marks. The PHAT®, PHAT FARM®, BABY PHAT® and PHAT THREADS® products, as well as the PHAT FARM® retail stores, have

received widespread media attention, including features in The New York Times, The New York Post, The New York Daily News, People Magazine, Forbes, Harper's Bazaar, Elle Magazine, and/or The New Yorker. Further, PHAT FARM® and BABY PHAT® products have been prominently worn by numerous sports personalities, popular recording artists and high-profile celebrities, including Russell Simmons, Kobe Bryant, Patrick Ewing, Madonna, Eve, Adam Sandler, Chris Rock, Queen Latifah, Kimora Lee Simmons, Alicia Keys, Pink, Britney Spears, Eminem and Mary J. Blige, to name a few.

6. Opposer's products, including its line of clothing, footwear, apparel and accessory products, are widely distributed throughout the United States, on the Internet via its web sites www.phatfarm.com and www.babyphat.com and in numerous foreign countries including Canada, the United Kingdom, Ireland, Germany, France, Denmark, Sweden, Japan and several others, and Opposer is currently planning the further expansion of its PHAT FARM® retail stores.

7. Opposer's merchandise offered under the family of PHAT marks have come to symbolize quality in the eyes of the consuming public as a result of Opposer's exacting standards, its vigorous promotion of the PHAT marks and the publicity generated for the family of PHAT marks by the celebrities who prominently wear and/or use Opposer's products and services. The family of PHAT marks has become well known to the general public and to the trade, and has become distinctively and exclusively associated with Opposer and, as such, identify and distinguish the source and origin of Opposer's goods and services.

8. As a result of the substantial amount of time and money Opposer has expended in advertising and promoting its merchandise and retail store services under the family of PHAT marks, Opposer has built up significant goodwill in the family of PHAT marks. Further, the

family of PHAT marks has become famous to the trade and the consuming public from the use of each such mark on clothing and fashion accessories including hats, footwear, shirts, jeans, jackets, bags, belts, umbrellas, wallets and toiletry cases, throughout the United States and in numerous foreign countries and from the widespread media and celebrity attention it has received over the past decade.

9. Opposer vigorously polices its family of PHAT marks and, as a result of its efforts, is the only lawful entity using a PHAT® mark with clothing.

10. Applicant filed its Intent-To-Use Application to register the subject mark on February 19, 2003, more than ten years after Opposer began using its family of PHAT marks in commerce.

11. Applicant's mark PHATMUSCLE encompasses Opposer's federally registered trademark PHAT®, - the dominant portion of Applicant's mark.

12. Applicant's mark is confusingly similar to Opposer's family of PHAT marks and has been applied for in Class 25 for "hats, shirts, shorts, pants" – the same goods offered by Opposer under its famous family of PHAT marks.

13. Because the family of PHAT trademarks and the goods and services offered by Opposer under those trademarks are exclusively associated with Opposer, Applicant's registration and use of the mark PHATMUSCLE for "hats, shirts, shorts, pants" will inevitably cause confusion in the minds of the public, misleading the public to believe that Applicant's clothing products emanate from Opposer or that Applicant is in some way associated with or connected to Opposer, when, in fact, no such relationship exists.

14. In sum, registration of Applicant's mark would likely cause considerable dilution, confusion, mistake and/or deception in view of the facts that:

- (i) Opposer's registered word marks have been in continuous use since at least as early as 1992;
- (ii) Opposer's family of PHAT marks is famous and distinctive;
- (iii) the goods in connection with which Applicant intends to use its mark (clothing) will overlap and/or suggest an association with the clothing products offered by Opposer under its family of PHAT marks;
- (iv) Applicant's mark encompasses Opposer's PHAT® trademark;
- (vi) Applicant's mark is deceptively and confusingly similar to Opposer's family of PHAT marks;

WHEREFORE, Opposer prays that the Application, Serial No. 76/498,101, be rejected and that the mark therein sought for the goods therein specified in International Class 25 be denied and refused.

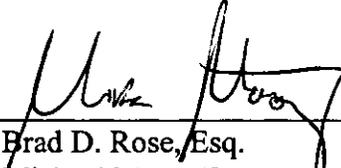
A duplicate copy of this Notice of Opposition and the fee of \$300.00 for opposition in International Class 25 are enclosed herewith.

POWER OF ATTORNEY

Opposer hereby appoints Brad D. Rose, Nicole E. Kaplan, Teresa A. Lee and Michael Maoz, members of the Bar of the State of New York, whose address is Pryor Cashman Sherman & Flynn LLP, 410 Park Avenue, New York, New York 10022, (212) 421-4100, as its duly authorized agents and attorneys in this matter to prosecute this Opposition, to transact all business in the Patent and Trademark Office and in the United States Courts in connection with the Opposition, to sign their names to all papers which may be hereinafter filed in connection therewith and to receive all communications relating to same.

Dated: June 30, 2004

Respectfully submitted,

By: 
Brad D. Rose, Esq.
Michael Maoz, Esq.

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Attorneys for Opposer,
Phat Fashions LLC

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I, Regina Tenore, hereby certify that this correspondence is being deposited as "Express Mail" with the United States Postal Service addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 BOX TTAB FEE on the date indicated below.

Date of Deposit: 6/30/04

Signed: Regina Tenore

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U.S. Patent & TMO/TM Mail Rcpt. Dt. #40

June 30, 2004

VIA EXPRESS MAIL

Commissioner
for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
Box: TTAB FEE

RE: NOTICE OF OPPOSITION TO
PHATMUSCLE, Appln. Ser. No. 76/498,101

Dear Sir or Madam:

I am enclosing for filing on behalf of our client, Phat Fashions, LLC:

1. An original and one copy of a Notice of Opposition to the filing and registration of the mark PHATMUSCLE, Serial No. 76/498,101.
2. A return post card for the Opposition, which the Patent and Trademark Office is requested to stamp as "RECEIVED".
3. A check in the amount of \$300.00 to cover the Notice Of Opposition filing fee.

Yours truly,


Michael Maoz

Encls.