

TTAB

TRADEMARK

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

In the matter of Trademark Application
Serial No. 78/119,979
Filed: April 6, 2002
Trademark: 13
Published: November 16, 2004

-----X)	
Reebok International Ltd.,)	
)	
Opposer)	
)	Opposition No. _____
v.)	
)	
Mark J. Mormar,)	
)	
Applicant.)	
-----X)	

NOTICE OF OPPOSITION

Reebok International Ltd., a Massachusetts corporation having a principal place of business at 1895 J.W. Foster Boulevard, Canton, Massachusetts 02021 ("Opposer" or "Reebok"), believes that it will be damaged by the registration of the mark shown in Application Serial No. 78/119,979, filed April 6, 2002 by Mark J. Mormar, an individual having a mailing address of 167 Route 301, Cold Spring, New York 10516 ("Applicant"), and hereby opposes the registration of said mark.

As grounds of opposition, it is alleged that:

1. Reebok is a leading manufacturer and marketer in this country of footwear and apparel products, including, without limitation, footwear and apparel goods having the commercial endorsements of selected professional basketball players and other athletes.

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2. One such athlete is Allen Iverson ("Iverson"), a famous professional basketball player. In playing for his Philadelphia team in the National Basketball Association, Iverson wears the number "3" on his jersey.

3. As part of his commercial relationship with Reebok, Iverson's name, persona and image are used to promote particular shoe models and apparel. In conjunction with some of those shoes and apparel goods, Reebok has adopted and used the designation "I3" as a trademark.

4. Moreover, since at least as early as November 1997, and, in any event, since prior to either April 6, 2002, the date on which the subject application was filed by Applicant, or July 13, 2001, the claimed date of first use of the "I3" mark by Applicant, Reebok has continuously used the designation "I3" as a trademark in offering, selling, advertising, promoting and transporting footwear and apparel goods in commerce.

5. The availability of such products under the "I3" trademark has been advertised to the public at considerable expense.

6. By reason of the adoption and continuous use of the "I3" trademark, that designation has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying Reebok and its footwear and apparel products.

7. Consequently, through such usage and recognition, Reebok has acquired common-law rights in the designation "I3" as a proprietary trademark, which rights extend, without limitation, to the exclusive right to use such designation nationwide.

8. Reebok is also the owner of a federal registration of its "I3" trademark in International Class 25, U.S. Trademark Registration No. 2,512,630, which registration issued

November 27, 2001 from an application filed March 15, 2001.

9. Through Trademark Application Serial No. 78/119,979, Applicant seeks to register the designation "13" in International Class 25 as a trademark, for use in conjunction with the following goods: "Men's, women's and children's clothing, namely leather coats, leather jackets, leather pants, leather vests, boots, gloves, chaps, denim jackets, denim pants, denim vests, shirts, blouses, T-shirts, baseball-style caps, hats, bandanas, sweatshirts, sweaters, belts, socks, undergarments."

10. Visually, Applicant's "13" mark is almost identical to Reebok's senior "I3" mark, thus contributing to a likelihood of confusion. Further, Applicant's listed goods are substantially related to the goods on which Reebok's "I3" mark has been used. Thus, Applicant's mark, when used in conjunction with the goods listed in Applicant's application, is likely to deceive or cause confusion or mistake among members of the public as to the source or sponsorship of Applicant's goods in relation to Opposer. Applicant's application for registration should be refused on the basis that it consists of or comprises, according to 15 U.S.C. § 1052(d):

a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion or to cause mistake, or to deceive.

11. Further, in the course of applying for registration of the subject mark, Applicant represented under oath that the designation "13" has been used by Applicant in commerce as a trademark with respect to all of the several types of goods listed in said application.

12. Upon information and belief, at the time Applicant made said representation, Applicant had not used in commerce the designation "13" as a trademark for some or all of the

types of goods listed in the subject application.

13. Upon information and belief, at the time Applicant made said representation, Applicant knew that he had not used in commerce the designation "13" as a trademark for some or all of the types of goods listed in the subject application.

14. The PTO accepted Applicant's representation regarding his alleged use of the designation "13" on all of the listed goods as being sufficient, such that the application proceeded toward a registration on the Principal Register.

15. Applicant's representation that he had used in commerce the designation "13" as a trademark for all of the types of goods listed in the subject application is material since, *inter alia*, the application would not have been accepted and published for opposition but for Applicant's representation.

16. Upon information and belief, at the time Applicant made his representation regarding his alleged actual use of the "13" designation on all of the goods listed in the subject application, he made a false representation that he knew or should have known was false.

17. A proper ground for refusal of an application for a trademark registration is fraud upon the PTO.

18. Upon information and belief, the actions of Applicant in conjunction with the subject application constitute fraud upon the PTO.

19. In any event, upon information and belief, Applicant has not used the "13" designation as a trademark for all of the goods listed in the subject application.

20. Accordingly, Opposer Reebok asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for the "13" mark to Applicant as sought in

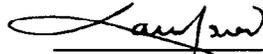
Trademark Application Serial No. 78/119,979.

WHEREFORE, Opposer, Reebok International Ltd., prays that the application for registration of Applicant's mark be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

A duplicate copy of this Notice of Opposition and a fee of \$300 are enclosed herewith. Please charge any additional fees incurred by Opposer in conjunction with this proceeding to the firm's Deposit Account No. 16-0605.

Date: December 16, 2004

Respectfully submitted,



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CERTIFICATE OF MAILING

"Express Mail" mailing label number EV 550556421 US
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I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to BOX TTAB/FEE, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on December 16, 2004.



Larry C. Jones
Date of Signature: December 16, 2004

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