

ESTTA Tracking number: **ESTTA25983**

Filing date: **02/15/2005**

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

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Academy, Ltd.		
<b>Entity</b>	Partnership	<b>Citizenship</b>	Texas
<b>Composed Of:</b>	Academy Managing Co., L.L.C., a Texas limited liability company, as its sole general partner		
<b>Address</b>	1800 North Mason Road Katy, TX 77449 UNITED STATES		

<b>Correspondence information</b>	William G. Barber Attorney for Applicant Fulbright & Jaworski, LLP 600 Congress Ave., Suite 2400 Austin, TX 78701 UNITED STATES aotrademark@fulbright.com Phone:512.474.5201		
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#### Applicant Information

<b>Application No</b>	79004421	<b>Publication date</b>	01/18/2005
<b>Opposition Filing Date</b>	02/15/2005	<b>Opposition Period Ends</b>	02/17/2005
<b>Applicant</b>	FREDDY S.P.A. Via S. Rufino, 31		

	I-16043 Chiavari, ITALY
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### Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Sports and leisure wear, namely shorts, pants, t-shirts, jerseys, tights, socks, gloves, jackets, swimwear, sweaters, pullovers, warm-up suits, rain suits, boots, slippers, sandals, specific purpose athletic shoes and general purpose sports shoes
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Marks Cited by Opposer as Basis for Opposition

<b>U.S. Registration No.</b>	1911968	<b>Application Date</b>	04/07/1994
<b>Registration Date</b>	08/15/1995		
<b>Word Mark</b>	ACADEMY		
<b>Goods/Services</b>	Class 042. First use: First Use: 19510000First Use In Commerce: 19510000 retail store services in the field of western wear; hunting, fishing and sporting equipment and outfitting; sporting and athletic equipment, gear and footwear; and outdoor and recreational equipment, outfitting and merchandise		

<b>U.S. Registration No.</b>	2834786	<b>Application Date</b>	04/04/2000
<b>Registration Date</b>	04/20/2004		
<b>Word Mark</b>	ACADEMY.COM		
<b>Goods/Services</b>	Class 035 First use: First Use: 20030328First Use In Commerce:		

	<p>20030328</p> <p>ONLINE RETAIL STORE SERVICES FEATURING SPORTING GOODS, ATHLETIC EQUIPMENT, APPAREL, AND FOOTWEAR; AND ISSUING GIFT CERTIFICATES WHICH MAY THEN BE REDEEMED FOR GOODS OR SERVICES; AND COMPUTER SERVICES, NAMELY, PROVIDING ONLINE COMPUTER DATABASES FEATURING CONSUMER PRODUCT REVIEWS AND COMPARISONS, AND MERCHANDISE DESCRIPTIONS AND INFORMATION BY MEANS OF A GLOBAL COMPUTER NETWORK</p> <p>Class 041. First use: First Use: 20030328First Use In Commerce: 20030328</p> <p>COMPUTER SERVICES, NAMELY PROVIDING INFORMATION ON SPORTS AND OUTDOOR ACTIVITIES VIA A GLOBAL COMPUTER NETWORK</p>
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<b>Attachments</b>	Acad.pdf ( 3 pages )
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<b>Signature</b>	/L. Alison Davis/
<b>Name</b>	L. Alison Davis
<b>Date</b>	02/15/2005

Academy, Ltd., a limited partnership organized and existing under the laws of the State of Texas, having its principal place of business at 1800 North Mason Road, Katy, Texas 77449, believes that it will be damaged by registration of the mark DANCE ACADEMY & Design shown in Application Serial No. 79/004,421 and hereby opposes the same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer, through its predecessor in interest, commenced use of the mark ACADEMY (the “Mark”) for use in connection with the retail sale of sporting goods and apparel at least as early as 1951. Since that time, Opposer, or its predecessor in interest, has continually used the Mark in commerce.

2. Opposer is one of the largest sporting goods and apparel retailers in the United States, operating at least 80 stores under the Mark in eight states, and also operating an extensive web site at [www.academy.com](http://www.academy.com). Opposer sells a wide array of products, including all types of sports and leisure wear, in its retail stores.

3. Opposer is the owner of U.S. Registration No. 1,911,968 for the Mark for “retail store services in the field of western wear; hunting, fishing and sporting equipment and outfitting; sporting and athletic equipment, gear and footwear; and outdoor and recreational equipment, outfitting and merchandise,” in International Class 42. This registration issued on August 15, 1995 and is valid and subsisting and is now incontestable. Opposer is also the owner of U.S. Registration No. 2,834,786 for the mark ACADEMY.COM for “online retail store services featuring the sale of sporting goods, athletic equipment, apparel, and footwear; and issuing gift certificates which may then be redeemed for goods and services; and computer services, namely, providing online computer databases featuring consumer product reviews and

comparisons, and merchandise descriptions and information by means of a global computer network,” in Class 25 and “computer services, namely providing information on sports and outdoor activities via a global computer network,” in Class 41. The registration issued on April 20, 2004 and is valid and subsisting.

4. Opposer has expended vast resources to promote its Mark; moreover, Opposer’s sales of sports and leisure wear and related products have been extensive.

5. As a result of Opposer’s long usage and extensive promotion, Opposer has developed valuable goodwill and strong common law rights in its Mark. Moreover, the Mark has become well-known, widely recognized, and famous to consumers.

6. Applicant seeks to register the mark DANCE ACADEMY & Design (“Applicant’s Mark”) for “Sports and leisure wear, namely, shorts, pants, t-shirts, jerseys, tights, socks, gloves, jackets, swimwear, sweaters, pullovers, warm-up suits, rain suits, boots, slippers, sandals, specific purpose athletic shoes and general purpose sports shoes,” in International Class 25. Applicant filed its application under Section 66(a) on April 20, 2004 and the application was assigned Serial No. 79/004,421.

7. Opposer’s Mark became famous prior to any use by Applicant of its Mark.

8. Opposer has priority based on its prior use and registration of the Mark in the United States.

9. Opposer will be damaged if Applicant’s Mark matures to registration because Applicant’s Mark is so similar to Opposer’s Mark in sight, sound and meaning, and because Applicant’s Mark identifies goods so highly related to those goods and services for which Opposer’s Mark is used and registered, contemporaneous use and registration will create a

likelihood of consumer confusion and lead to deception as to source or sponsorship. Therefore, registration should be refused under 15 U.S.C. § 1052(d).

10. Opposer will be damaged if Applicant's Mark matures to registration because it will cause dilution of the distinctive quality of Opposer's Mark. Therefore, registration should be refused under 15 U.S.C. §§ 1063(a) and 1125(c).

11. Opposer will be damaged if Applicant's mark matures to registration because such registration would purport to give Applicant prima facie evidence of the exclusive right to use Applicant's Mark in connection with the goods of the application in question which would be inconsistent with Opposer's long use of, and right to use its Mark in connection with the retail sale of sports and leisure wear and related products.

Wherefore, Opposer prays that Application Serial No. 79/004,421 be rejected, and that registration of Applicant's Mark be refused.