

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

In the matter of Application Serial No. 76/575509
Published in the Official Gazette of March 29, 2005

TTAB

NEW BALANCE ATHLETIC SHOE, INC.,

Opposer,

Opposition No.

v.

S.A.S.C.O. TRADING, INC.

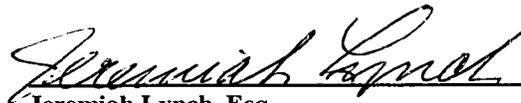
Attorney Docket No.: NBK-334-036

Applicant.

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P. O. Box 1451, Alexandria, Virginia 22313-1451, on the date set forth below.

May 27, 2005
Date of Signature
and of Mail Deposit


Jeremiah Lynch, Esq.
Registration No. 17,425

Commissioner for Trademarks
P. O. Box 1451
Alexandria, Virginia 22313-1451

Sir:

NOTICE OF OPPOSITION

New Balance Athletic Shoe, Inc., a corporation of the Commonwealth of Massachusetts having a principal place of business at 20 Guest Street, Boston, Massachusetts 02135 (hereinafter Opposer), believing that it will be damaged by the registration of the mark shown in application Serial No. 76/575509, published for opposition in the Official Gazette on March 29, 2005, hereby opposes the same and requests that registration be refused.

06-01-2005

In payment of the fee of \$300 and any additional fees which may be due, please charge our Deposit Account No. 501558. As grounds for opposition it is alleged that:

1. The Opposer is the owner by assignment of United States Trademark Registration No. 429,057 issued to The B. F. Goodrich Company on April 15, 1947, as shown by records in the United States Patent and Trademark Office. A copy of the certificate of said registration is appended hereto and made a part hereof as Exhibit A. On January 17, 1984, the said registration was amended to show the drawing of the mark in standard character form, and a copy of said amendment is appended hereto and made a part hereof as Exhibit B. As so amended, the said registration has been and is presently valid and subsisting, and is incontestable under the provisions of 15 U.S.C 1065.

2. The Opposer is the owner by assignment of United States Trademark Registration No. 1,236,457 issued on May 3, 1983 to Brookfield Athletic Shoe Company, Inc., successor in interest to The B. F. Goodrich Company, as shown by records in the United States Patent and Trademark Office. A copy of said registration is appended hereto and made a part hereof as Exhibit C. Registration No. 1,236,457 has been and is presently valid and subsisting, and incontestable under the provisions of 15 U.S.C. 1065.

3. On information and belief, the Opposer's predecessor The B. F. Goodrich Company commenced use of the mark PF on and in connection with footwear, specifically rubber-soled canvas footwear about May 15, 1941, the mark being applied or affixed to the packages containing the goods by printing the trademark thereon. On information and belief, the said mark was used by The B. F. Goodrich Company continuously until it was sold with the goodwill of the business to Brookfield Athletic Shoe Company, Inc.

On information and belief, upon acquisition of the said mark by Brookfield Athletic Shoe Company, Inc., it was used continuously by the latter company during its ownership of the mark for footwear and sporting articles, namely skates and athletic shoes as shown on Exhibit C.

4. On information and belief the mark PF, the goodwill of the business associated therewith and Registrations Nos. 429,057 and 1,236,457 were assigned from Brookfield Athletic Shoe Company, Inc. to Hyde Athletic Industries, Inc., then by the latter company to Leif J. Ostberg, Inc., and finally to the Opposer. On information and belief, use of the mark PF on or in connection with footwear throughout the United States has been substantially continuous by its respective owners recited above from May 15, 1941 to the present.

5. As a result of the use of the mark PF on footwear as alleged in paragraphs 3 and 4, said mark has been widely recognized for many years by the general public as identifying the owners of said mark and as the source having exclusive control over the nature and quality of said goods.

6. The Opposer and its above-recited predecessors in interest have expended large sums of money for over 60 years in the advertising and promotion of the mark PF, and by reason thereof the Opposer is presently the owner of a valuable reputation and goodwill on the part of the purchasing public in the general consumer goods field including footwear, whereby said mark is associated with and presently identifies the Opposer as the source controlling the nature and quality of said goods.

7. On information and belief, the Applicant seeks registration of the opposed mark for jackets, coats, pants, shirts, shorts, T-shirts, swimwear, underwear, sweat shirts, sweat pants, jogging suits and vests. On information and belief, the Applicant's said goods are closely related to goods of the Opposer, namely footwear. On information and belief, the Applicant's said goods are likely to be sold and will be sold to the same class of customers and through the same outlets including retail stores where the footwear of the Opposer is sold, and are likely to be offered for sale in side-by-side relationship with, or in the same store departments as, the Opposer's footwear.

8. The dominant feature of the opposed mark is the letters PF, and as such the opposed mark falls within the scope of the Opposer's Registrations Nos. 429,057 and 1,236,457 which display the marks in standard character form. The opposed mark creates the same commercial impression as the Opposer's registered marks, and use thereof on or in connection with the Applicant's said goods will be likely to cause confusion, deception or mistake on the part of the purchasing public with respect to the goods of the respective parties.

9. Under 15 U.S.C. 1057(b), if a certificate of registration were to issue to the Applicant it would be prima facie evidence inter alia, of the registrant's right to use the registered mark in commerce on or in connection with the Applicant's said goods, and such use would be likely to cause confusion, or to cause mistake, or to deceive purchasers by reason of the similarity thereof to the Opposer's mark PF.

10. By reason of the confusion, mistake or deception alleged in the preceding paragraph 9, the Opposer will suffer great damage to its commercial reputation and goodwill, as well as loss of sales and financial loss if a registration were to issue to the Applicant.

11. The issuance of a registration from the opposed application would falsely provide prima facie evidence of the validity thereof, of the registrant's ownership of the opposed mark, and of the registrant's exclusive right to use the said mark in commerce on or in connection with the goods specified in the certificate, in violation of the Opposer's prior rights in the mark PF and in the registrations in Exhibits A, B and C.

WHEREFORE, the Opposer prays that this opposition be sustained, and that the opposed application be refused.

NEW BALANCE ATHLETIC SHOE, INC.

May 27, 2005
(date)

By: 
Jeremiah Lynch, Esq.
Registration No. 17,425
Attorney for Opposer

LAHIVE & COCKFIELD, LLP
28 State Street
Boston, Massachusetts 02109
Telephone (617) 227-7400
Facsimile (617) 742-4214

Registered Apr. 15, 1947

Trade-Mark 429,057

UNITED STATES PATENT OFFICE

The B. F. Goodrich Company, New York, N. Y.,
Akron, Ohio, and Watertown, Mass.

Act of February 20, 1905

Application May 25, 1946, Serial No. 502,747

A stylized, bold, black logo consisting of the letters 'B' and 'F' intertwined. The 'B' is on the left and the 'F' is on the right, with a dot under the 'F'. The letters are thick and have a slightly irregular, hand-drawn appearance.

STATEMENT

To the Commissioner of Patents:

The B. F. Goodrich Company, a corporation duly organized under the laws of the State of New York and located at 230 Park Avenue, New York, N. Y., and doing business at 500 South Main Street, Akron, Ohio, and 98 Nichols Avenue, Watertown, Massachusetts, has adopted and used the trade-mark shown in the accompanying drawing, for FOOTWEAR, SPECIFICALLY RUBBER-SOLED CANVAS FOOTWEAR, in Class 39, Clothing, and presents herewith five specimens showing the trade-mark as actually used by appli-

cant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905. The trade-mark has been continuously used and applied to said goods in applicant's business since about May 15, 1941. The trade-mark is applied or affixed to the packages containing the goods by printing the trade-mark thereon.

THE B. F. GOODRICH COMPANY,
By W. F. AVERY,
Secretary.

EXHIBIT A

Amendment

Registered April 15, 1947

Registration No. 429,057

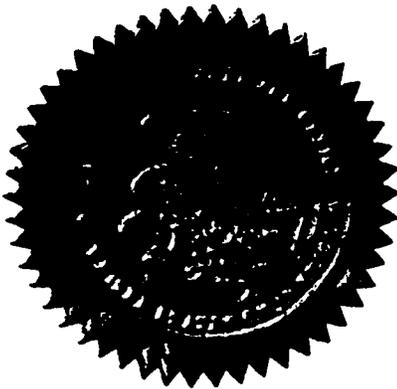
The B. F. Goodrich Company

Application to amend having been made by Brookfield Athletic Shoe Company, Inc., owner of the registration above identified, the drawing is amended to appear as follows:

P F

Such amendment has been entered upon the records of the Patent and Trademark Office and the said original registration should be read as so amended.

Signed and sealed this 17th day of January 1984.



Attest: *Michael J. Hynak*
MICHAEL J. HYNAK,
Attesting Officer.

Gerald J. Mossinghoff
GERALD J. MOSSINGHOFF,
Commissioner of Patents and Trademarks.

Int. Cls.: 25 and 28

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 1,236,457

Registered May 3, 1983

TRADEMARK
Principal Register

PF

Brookfield Athletic Shoe Company, Inc.
(Massachusetts corporation)
15 Mechanic St.
East Brookfield, Mass. 01515

(U.S. Cl. 22).

First use Feb. 11, 1982; in commerce Feb. 11,
1982.

For: FOOTWEAR, in CLASS 25 (U.S. Cl. 39).
First use Feb. 11, 1982; in commerce Feb. 11,
1982.

Ser. No. 359,706, filed Apr. 14, 1982.

For: SPORTING ARTICLES—NAMELY,
SKATES AND ATHLETIC SHOES, in CLASS 28

CRAIG K. MORRIS, Examiner

EXHIBIT C