

ESTTA Tracking number: **ESTTA169141**

Filing date: **10/17/2007**

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

Name	Schiesser AG
Granted to Date of previous extension	10/17/2007
Address	Schutzenstr 18 Radolfzell, 78315 GERMANY

Attorney information	Joan Kupersmith Larkin Seyfarth Shaw LLP 2029 Century Park East Suite 3300 Los Angeles, CA 90067 UNITED STATES jlarkin@seyfarth.com, clarkin@seyfarth.com, kelko@seyfarth.com Phone:310 277-7200
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Applicant Information

Application No	78857218	Publication date	06/19/2007
Opposition Filing Date	10/17/2007	Opposition Period Ends	10/17/2007
Applicant	SHAFIQ, MUHAMMAD 953 EAST 15TH STREET BROOKLYN, NY 11214 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Mobile phones; Power supply instruments, namely, electrical power extension cords; and power controls, namely, power access ports for use with electrical control panels for connecting multiple data and electrical devices
Class 011. All goods and services in the class are opposed, namely: Flashlights; and electric hair dryers
Class 028. All goods and services in the class are opposed, namely: Electric action toys

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application	79028444	Application Date	03/23/2005
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No.			
Registration Date	NONE	Foreign Priority Date	10/22/2004
Word Mark	SCHIESSER		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: INCONTINENCE UNDERWEAR, INCONTINENCE PANTS, INCONTINENCE NAPKINS; UNDERWEAR FOR PATIENTS WITH SKIN DISEASES, UNDERWEAR FOR PATIENTS SUFFERING FROM AN ALLERGY, UNDERWEAR FOR PATIENTS SUFFERING FROM NEURODERMITIS, ALL FOREGOING FOR MEDICAL PURPOSES</p> <p>Class 010. First use: Underwear for breastfeeding mothers, nursing bras, nursing vests; orthopedic products, namely, orthopedic trousers with pads for prevention and treatment of deformation and dysfunction of the musculoskeletal system, orthopedic braces and supports, orthopedic shoes, soles of shoes, insoles, shoe inserts and arch supports, arch supports, also in the form of blanks, surgical implants made of synthetic materials, orthopedic belts, medical compression stocking for orthopedic purposes, harnesses and bandage splints for orthopedic purposes; belts for medical purposes, orthopedic anatomical joint bandages, medical compression stockings, orthopedic knee bandages, girdles for medical purposes, trusses, clothing for operating rooms, namely, surgical scrub suits, surgical gowns; maternity support belts</p> <p>Class 025. First use: Clothing, namely, hats, gloves, mittens and scarves for women, men and children; custom-made-to-order underwear and fashionable underwear; outer clothing for women, men and children, namely, sweaters, hats and scarves all made of wool; suits, shirts, trousers, Bermuda shorts; frocks, blouses, jumpers, skirts; jackets, stuff jackets, waistcoats, coats, overalls, parkas, raincoats, wind jackets; hosiery, pullovers, sweaters, bandanas, jerseys, t-shirts, sweatshirts, terry clothing, namely, moisture or liquid absorbant and perspiration absorbant underwear; women's, men's and children's underwear, underwear, bras, women's underpants, breeches, women's vests, bustiers, corselets, bodices, teddies, bodysuits, lingerie; combinations of vests and slips; slips, petticoats, negligees; men's underpants, boxer shorts, men's vests; children's underpants, children's vests; women's, men's and children's sports underwear, sports bras, socks, stockings, mid-calf length socks, tights, sock suspenders, outer clothing for sports, namely, gloves, mittens, scarves, ski shell, namely, ski vests, ski hooded jackets, hiking jackets, hiking hooded jackets, hooded sweatshirts, running jackets, wind vests, hiking pants, parkas insulated vests, hats for outdoor pursuits and sports; clothing for gymnastics, namely, gym shorts, gym suits, leotards, tights; jogging suits, leggings, cyclists' clothing, namely, cyclists' jerseys; knit wear, namely, knitted underwear; singlets; bathing suits, bathing trunks; swimwear for women, men and children, swim suits, swim trunks, bathrobes, beach clothes, namely, beach coverups; beach wear; nightwear for women, men and children, pyjamas, nightgowns, dressing gowns; layettes; infantwear; baby pyjamas, baby underwear; babies' napkin-pants, namely, infant diaper covers of textile; babies' diapers of textile; gloves of textile, wrist bands, sweatbands, headbands, belts, suspenders, neckties, scarves, shawls, ear protectors, namely, ear muffs; aprons; shoes. bath sandals, bath slippers, sandals, sport shoes, esparto shoes, beach shoes; head wear; bathing caps, shower caps, hats, hoods, caps</p>		

Attachments	79028444#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (5 pages)(198968 bytes)
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Signature	/Christopher C. Larkin/
Name	Christopher C. Larkin
Date	10/17/2007

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

In the Matter of Application Serial No. 78/857,218
Published in the Official Gazette of June 19, 2007

SCHIESSER AG,

Opposer,

v.

MUHAMMAD SHAFIQ,

Applicant.

Opposition No.: _____

NOTICE OF OPPOSITION

Opposer Schiesser AG (“Opposer”) believes that it will be damaged by registration of the mark shown in Application Serial No. 78/857,218 and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:

1. Opposer is a corporation organized and existing under the laws of Germany, with offices in Radolfzell, Germany.
2. Upon information and belief, applicant Muhammad Shafiq (“Applicant”) is an individual who resides in Brooklyn, New York.
3. On April 8, 2006, Applicant filed Application Serial No. 78/857,218 (the “Opposed Application”) to register the claimed mark “SCHIESSER” and design on the Principal Register for goods originally identified as “1) ESD PRODUCTS (sic) (e.g. ionizing blowers, ionizing guns, ionizing bars and power supply instrumetns (sic) 2) electronics and electronic products 3) mobile phones and accessories” apparently on the basis of both Applicant’s alleged intention to use the mark in commerce and use in commerce. During prosecution of the Opposed Application, Applicant amended the identification of goods to read “mobile phones; power

supply instruments, namely, electrical power extension cords; and power controls, namely, power access ports for use with electrical control panels for connecting multiple data and electronic devices,” in Class 9; “flashlights and electric hair dryers,” in Class 11; and “electric action toys,” in Class 28, all based upon Applicant’s alleged intention to use the mark in commerce. Applicant also claimed the colors black, white, and red as features of the mark.

4. Opposer owns Application Serial No. 79/028,444, with a priority filing date of October 22, 2004, a date prior to the filing date of the Opposed Application, or any earlier date of actual use of the mark shown in the Opposed Application upon which Applicant can rely, to register the mark “SCHIESSER” for incontinence underwear, incontinence pants, incontinence napkins; underwear for patients with skin diseases, underwear for patients suffering from an allergy, underwear for patients suffering from neurodermitis, all foregoing for medical purposes, in Class 5; underwear for breastfeeding mothers, nursing bras, nursing vests; orthopedic products, namely, orthopedic trousers with pads for prevention and treatment of deformation and dysfunction of the musculoskeletal system, orthopedic braces and supports, orthopedic shoes, soles of shoes, insoles, shoe inserts and arch supports, arch supports, also in the form of blanks, surgical implants made of synthetic materials, orthopedic belts, medical compression stocking for orthopedic purposes, harnesses and bandage splints for orthopedic purposes; belts for medical purposes, orthopedic anatomical joint bandages, medical compression stockings, orthopedic knee bandages, girdles for medical purposes, trusses, clothing for operating rooms, namely, surgical scrub suits, surgical gowns; maternity support belts, in Class 10; and clothing, namely, hats, gloves, mittens and scarves for women, men and children; custom made-to-order underwear and fashionable underwear; outer clothing for women, men and children, namely, sweaters, hats and scarves all made of wool; suits, shirts, trousers, Bermuda shorts; frocks, blouses, jumpers, skirts; jackets; stuff jackets, waistcoats, coats, overalls, parkas, raincoats, wind jackets; hosiery,

pullovers, sweaters, bandanas, jerseys, t-shirts, sweatshirts, terry clothing, namely, moisture or liquid absorbent and perspiration absorbent underwear; women's, men's and children's underwear, underwear, bras, women's underpants, breeches, women's vests, bustiers, corselets, bodices, teddies, bodysuits, lingerie; combinations of vests and slips; slips, petticoats, negligees; men's underpants, boxer shorts, men's vests; children's underpants, children's vests; women's, men's and children's sports underwear, sports bras, socks, stockings, mid-calf length socks, tights, sock suspenders, outer clothing for sports, namely, gloves, mittens, scarves, ski shell, namely, ski vests, ski hooded jackets, hiking jackets, hiking hooded jackets, hooded sweatshirts, running jackets, wind vests, hiking pants, parkas insulated vests, hats for outdoor pursuits and sports; clothing for gymnastics, namely, gym shorts, gym suits, leotards, tights; jogging suits, leggings, cyclists' clothing, namely, cyclists' jerseys; knit wear, namely, knitted underwear; singlets; bathing suits, bathing trunks; swimwear for women, men and children, swim suits, swim trunks, bathrobes, beach clothes, namely, beach cover-ups; beach wear; nightwear for women, men and children, pyjamas, nightgowns, dressing gowns; layettes; infantwear; baby pyjamas, baby underwear; babies' napkin-pants, namely, infant diaper covers of textile; babies' diapers of textile; gloves of textile, wrist bands, sweatbands, headbands, belts, suspenders, neckties, scarves, shawls, ear protectors, namely, ear muffs; aprons; shoes, bath sandals, bath slippers, sandals, sport shoes, esparto shoes, beach shoes; head wear; bathing caps, shower caps, hats, hoods, and caps, in Class 25.

5. From a time prior to the filing date of the Opposed Application, or any earlier date of actual use of the mark shown in the Opposed Application upon which Applicant can rely, and continuously to the present, Opposer has used the mark "SCHIESSER" in the United States in connection with a wide variety of clothing items. Opposer has also used its "SCHIESSER" mark

in Germany and numerous other countries in Europe, and its mark is famous in Germany and well-known in other countries in Europe for various clothing items.

6. Upon information and belief, Applicant has never been named “Schiesser” and does not employ anyone named “Schiesser,” but instead was aware of Opposer’s use of the mark “SCHIESSER” when Applicant selected and adopted the mark “SCHIESSER” and did so with the intent to trade on the goodwill in Opposer’s mark.

FIRST CLAIM FOR RELIEF
(Likelihood of Confusion With Previously-Used Trademark)

7. Opposer repeats and realleges the allegations in paragraphs 1-6 as if fully set forth herein.

8. The mark shown in the Opposed Application so resembles the mark shown in Opposer’s Application Serial No. 79/028,444, and previously constructively used in the United States and not abandoned, as to be likely, when used on or in connection with the goods identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant’s mark is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

9. Opposer is or may be damaged by registration of the mark shown in the Opposed Application because such registration will give Applicant prima facie evidence of ownership of and the exclusive right to use a mark that is confusingly similar to Opposer’s mark previously constructively used and not abandoned, in derogation of Opposer’s rights in its mark.

SECOND CLAIM FOR RELIEF
(Likelihood of Confusion with Previously-Used Trademark)

13. Opposer repeats and realleges the allegations in paragraphs 1-6 as if fully set forth herein.

14. The mark shown in the Opposed Application so resembles Opposer's mark "SCHIESSER" previously used in the United States and not abandoned, as to be likely, when used on or in connection with the goods identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

15. Opposer is or may be damaged by registration of the mark shown in the Opposed Application because such registration will give Applicant prima facie evidence of ownership of and the exclusive right to use a mark that is confusingly similar to Opposer's mark previously used and not abandoned, in derogation of Opposer's rights in its mark.

WHEREFORE, Opposer Schiesser AG prays for judgment sustaining this opposition and refusing registration to the mark shown in the Opposed Application.

Please charge the filing fees for this opposition to Deposit Account No. 50-2291 and direct all correspondence and communication in this opposition to the undersigned.

Respectfully submitted,

SEYFARTH SHAW LLP

Dated: October 17, 2007

By: _____



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Joan Kupersmith Larkin
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SCHIESSER AG

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