

ESTTA Tracking number: **ESTTA169280**

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	Rocky Brands Wholesale LLC		
Entity	Corporation	Citizenship	Delaware
Address	39 E. Canal St. Nelsonville, OH 45764 UNITED STATES		

Attorney information	Karen Hammond Porter, Wright, Morris & Arthur LLP 41 S. High St. Columbus, OH 43215 UNITED STATES khammond@porterwright.com, ipdocket@porterwright.com Phone:614-227-2000
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Applicant Information

Application No	76663912	Publication date	09/18/2007
Opposition Filing Date	10/17/2007	Opposition Period Ends	10/18/2007
International Registration No.	NONE	International Registration Date	NONE
Applicant	Rebelde Boots, S.A. de C.V. Av. Industriales # 401-B Fracc. Ind. Julian de Obregon Leon, GTO 37290, MEXICO		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Footwear, shirts, pants, suits, jackets, and hats
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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

U.S. Registration No.	790751	Application Date	07/27/1964
Registration Date	06/08/1965	Foreign Priority Date	NONE
Word Mark	DURANGO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U039 (International Class 025). First use: First Use: 1964/06/24 First Use In Commerce: 1964/06/24 WESTERN BOOTS

U.S. Registration No.	2562205	Application Date	05/24/1999
Registration Date	04/16/2002	Foreign Priority Date	NONE
Word Mark	DURANGO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1999/08/00 First Use In Commerce: 1999/08/00 Jeans, pants, shirts, jackets and socks		

Attachments	elalacrandedurango.pdf (2 pages)(26770 bytes)
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Signature	/Karen Hammond/
Name	Karen Hammond
Date	10/17/2007

NOTICE OF OPPOSITION

Rocky Brands Wholesale LLC (“Rocky Brands” or “Opposer”), a company organized under the laws of the state of Delaware, believes it will be damaged by the registration of the mark shown in U.S. application Serial No. 76/663912, applied for on July 28, 2006, and published for opposition on September 18, 2007, and hereby opposes said application.

As grounds for the notice of opposition, it is alleged that:

1. Applicant has applied for the mark EL ALACRAN DE DURANGO WESTERN WEAR and Design to identify footwear, shirts, pants, suits, jackets and hats, in International Class 25, as evidenced by the publication of said mark in the September 18, 2007 issue of the *Official Gazette*.

2. Opposer is the owner of the mark DURANGO, which is the subject of (among others) U.S. Registration Nos. 0790751, registered June 8, 1965, and 2562205, registered April 16, 2002, both in International Class 25. Opposer’s registrations in International Class 25 cover footwear, including western boots, and clothing, including jeans, pants, shirts, jackets, and socks.

3. Opposer’s DURANGO mark uniquely serves to identify the source and origin of goods that bear the mark and serves to distinguish Opposer’s DURANGO products from those promoted, manufactured, and sold by others.

4. Priority is not an issue in this case. Applicant’s application is based on an intent-to-use the subject mark. Applicant’s application was filed more than 40 years after Opposer’s first registration of DURANGO, and more than 3 years after Opposer’s most recent registration of DURANGO.

5. Upon seeing the applied-for mark, the public is likely to think that Applicant’s goods are sponsored by or affiliated with Opposer, or that Opposer has licensed Applicant to use the mark.

6. Opposer’s mark and the applied-for mark contain the identical and dominant “DURANGO” component. The parties’ related goods are identical. As a result, there is, or could be, overlap in the parties’ marketing and trade channels since the parties’ goods are identical with respect to the goods. Applicant’s disclaimer of “DURANGO” does not dispel the likelihood of confusion.

7. Use of, and registration by, Applicant of EL ALACRAN DE DURANGO WESTERN WEAR for the goods identified in the application will, or is likely to, cause confusion or mistake, or will deceive consumers erroneously into the belief that Applicant’s goods are authorized or sponsored by Opposer, or otherwise connected with the business of Opposer. Applicant’s registration of a mark containing DURANGO for competing products would allow Applicant to reap the financial reputation-related reward associated with Opposer’s goods and retail activities and misappropriate goodwill to Applicant that Opposer has established. Opposer would be injured in the provision, sale, and distribution of its goods, and in the conduct of its business.

8. Accordingly, in view of the fact that Opposer’s DURANGO mark and the applied-for mark are confusingly similar, the substantial overlap in the parties’ goods, and other relevant considerations, Opposer will be damaged by the registration of the mark shown in U.S. application Serial No. 76/663912 because:

- a. The applied-for mark is likely to cause confusion, or to cause mistake or to deceive when used in connection with the goods and business of Applicant; and
- b. The applied-for mark is confusingly similar to Opposer's DURANGO mark. As a result, registration of the applied-for mark may disparage and falsely suggest a connection with Opposer and injure Opposer's reputation; and
- c. Registration of the applied-for mark by Applicant would tend to restrict and interfere with Opposer in the conduct of Opposer's business; and
- d. Registration of the applied-for mark causes, or will cause, dilution of Opposer's rights in Opposer's mark and of the distinctive qualities of such mark, causing Opposer to suffer loss of goodwill in the mark.

WHEREFORE, Opposer prays that this Opposition be sustained, that application Serial No. 76/663912 hereby opposed be refused and no registration be issued to Applicant thereon, and for such other and further relief as may be deemed appropriate.