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Filing date:

05/19/2008

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

Proceeding	91183309
Party	Plaintiff Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien
Correspondence Address	Thilo C. Agthe Wuersch & Gering LLP 100 Wall Street, 21st Floor New York, NY 10005 UNITED STATES thilo.agthe@wg-law.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Thilo C. Agthe
Filer's e-mail	thilo.agthe@wg-law.com
Signature	/Thilo C. Agthe/
Date	05/19/2008
Attachments	Motion_Amend Notice of Opposition.pdf (3 pages)(20103 bytes) Motion_Exhibit A_Amended Notice of Opposition.pdf (7 pages)(362611 bytes)

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

WILLY BOGNER GMBH & CO.,)	
KOMMANDITGESELLSCHAFT)	
AUF AKTIEN)	
)	
Opposer and Counterclaim-Respondent)	
)	
v.)	Opposition No. 91183309
)	
PACIFIC SUNWEAR)	
OF CALIFORNIA INC.)	
)	
Applicant and Counterclaim-Petitioner)	

OPPOSER WILLY BOGNER GMBH & CO., KOMMANDITGESELLSCHAFT AUF
AKTIEN'S MOTION FOR LEAVE TO FILE A FIRST AMENDED NOTICE OF
OPPOSITION

PLEASE TAKE NOTICE that pursuant to TBMP §503.03, Willy Bogner GmbH & Co., Kommanditgesellschaft auf Aktien (“Opposer”), by and through its attorneys, hereby moves the Trademark Trial and Appeal Board (“Board”) for an order granting Opposer leave to file a First Amended Notice of Opposition, in the form attached hereto as Exhibit A, to change and amend the grounds for opposition, as previously filed, as follows: (i) paragraph 6 be struck in its entirety, and (ii) old paragraph 15 (upon the Board’s requested order new paragraph 14) be amended to read: “The mark shown in application serial no. 77/279,917 so resembles Opposer's marks 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.”

On Friday, May 16, 2008, Pacific Sunwear of California Inc., the Applicant and Counterclaim-Petitioner, by and through its attorneys, gave its written consent to this Opposer’s

Motion For Leave To File A First Amended Notice Of Opposition by and through an email sent by Mr. Eric Jaegers, Esq to the undersigned.

In addition, Opposer, on the one side, and Applicant and Counterclaim-Petitioner, on the other side, agreed upon email as their agreed upon and exclusive means of service.

WHEREFORE, the Opposer prays that this Board enter an order:

- (1) granting the relief requested in the motion; and
- (2) granting such other and further relief as the Board deems just and proper.

DATED: New York, NY
May 19, 2008

Respectfully submitted by:

WUERSCH & GERING LLP

By: /Thilo C. Agthe/
Thilo C. Agthe, Esq.
Martin F. Gusy, Esq.

Attorneys for Opposer
Willy Bogner GmbH & Co.,
Kommanditgesellschaft auf Aktien

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Certificate of Electronic Filing

I hereby certify that the above document was filed electronically with the Trademark Trial and Appeal Board on this 19th day of May, 2008.

/Thilo C. Agthe/
Thilo C. Agthe

Certificate of Service

I hereby certify that a true and correct copy of the above and foregoing has been served on counsel for the Applicant, Pacific Sunwear of California, Inc. via e-mail on this, the 19th day of May, 2008.

Matthew D. Murphy
Eric M. Jaegers
Elizabeth K. Stanley
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Attorneys for Applicant

/Thilo C. Agthe/
Thilo C. Agthe

ESTTA Tracking number: **ESTTA202194**

Filing date: **04/02/2008**

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	Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien		
Entity	Association limited by shares	Citizenship	Germany
Address	Sankt-Veit-Strasse 4 Muenchen, 81673 GERMANY		

Attorney information	Thilo C. Agthe Wuersch & Gering LLP 100 Wall Street, 21st Floor New York, NY 10005 UNITED STATES thilo.agthe@wg-law.com		
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Applicant Information

Application No	77279917	Publication date	03/04/2008
Opposition Filing Date	04/02/2008	Opposition Period Ends	04/03/2008
Applicant	Pacific Sunwear of California, Inc. 3450 East Miraloma Avenue Anaheim, CA 928062101 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2004/06/01 First Use In Commerce: 2004/06/01 All goods and services in the class are opposed, namely: Jeans; Cargo pants; Denims; Pants; Shorts
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Grounds for Opposition

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

U.S. Registration No.	2264266	Application Date	11/12/1997
Registration Date	07/27/1999	Foreign Priority Date	05/14/1997
Word Mark	B BOGNER		
Design Mark			
Description of Mark	NONE		

Goods/Services	<p>Class 003. First use: [products for body and beauty care, namely, skin soap, toilet soap, bath soap, deodorant soap, perfumes, essential oils for personal use, hand cream, cold cream, night cream, skin cleansing cream, moisturizing lotions, body lotions, hand lotions, face lotions, bubble bath, shower gels, skin cleansing gels, hair shampoos, hair removing creams, sun blocking preparations, suntan preparations, face cleansing masks in the form of gels, creams and lotions, face moisturizing masks in the form of gels, creams and lotions, shaving cream, shaving foam, shaving lotions, personal deodorants, antiperspirants, body powder, face powder, rouge, eyebrow pencils, eye shadow, mascara, lipsticks, nail polish, nail polish remover, hair conditioners, non-medicated hair care preparations, and dentifrices]</p> <p>Class 009. First use: [EYE GLASSES, EYE GLASS FRAMES, EYE GLASS CASES]</p> <p>Class 018. First use: ARTICLES MADE FROM LEATHER AND IMITATION LEATHER, NAMELY, HANDBAGS; SMALL LEATHER GOODS, NAMELY, PURSES, WALLETS, AND KEY CASES; TRUNKS FOR TRAVELING AND SUITCASES; UMBRELLAS, PARASOLS AND CANES</p> <p>Class 025. First use: WEARING APPAREL, NAMELY, PANTS, TROUSERS, RIDING PANTS, GOLF PANTS, SPORTS JACKETS, JACKETS, DRESSES, COATS, SUITS, SKIRTS, BLOUSES, SHIRTS, PARKAS, SKI PANTS, SKI SUITS, PULLOVERS, CAPS, HATS, STOCKINGS AND GLOVES, SHAWLS, SCARVES, HEADBANDS, SUSPENDERS, SHOES, BELTS MADE FROM LEATHER AND IMITATION LEATHER, FOOTWEAR AND HEADWEAR</p>
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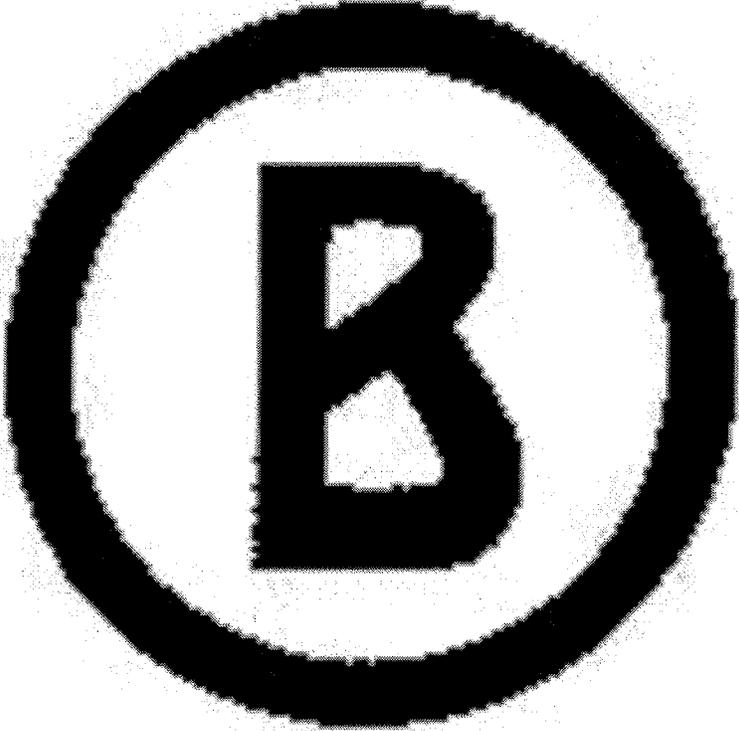
U.S. Registration No.	3076868	Application Date	09/27/2004
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	B		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: Winter clothes, namely, ski suits and anoraks; sport suits		

U.S. Registration No.	3233645	Application Date	10/31/2005
Registration Date	04/24/2007	Foreign Priority Date	NONE
Word Mark	B		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: Eyewear, namely protective eyewear, eyeglasses, goggles for skiing and snowboarding, spectacle frames, spectacle cases, sunglasses, ski-glasses, protective helmets for sports, in particular for skiing and snowboarding; mobile phones; apparatus for recording, transmission or reproduction of sound and images; blank magnetic recording media, namely, computer discs, sound recording discs, sound recording tapes, video tapes, floppy discs; prerecorded		

	<p>audio tapes featuring music; prerecorded video tapes featuring motion pictures about sports, leisure, recreational activities and music; prerecorded compact discs featuring music, prerecorded tapes and video tapes other than for music featuring motion picture films and documentaries in the field of sports, leisure and recreational activities; exposed cinematographic films, exposed camera and slide films, video disks, CDs, CD-ROMs and video tapes with recorded animated cartoons; dictating machines; blank recording discs, electronic automatic vending machines, mechanisms for coin-operated machines, namely, coin dispensers, coin changers, coin counting and sorting mechanisms; cash registers, calculating machines, data processors and computer hardware; fire extinguishers</p> <p>Class 018. First use: Leather and imitation of leather as well as goods made thereof, namely backpacks, boston bags, handbags, purses, wallets, key cases; animal skins and hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips and saddlery</p> <p>Class 025. First use: Clothing, namely, cycling shorts, cycling shirts and cycling jackets, pants, trousers, riding pants, golf pants, ski pants, ski suits, sports shirts, sports jackets, anoraks, gymnastic clothing, namely, leotards, bodysuits, tank shirts, exercise shorts, sweat socks and sports bras; raincoats, shorts, blousons, jackets, dresses, coats, suits, skirts, shirts, parkas, pullovers, stockings, evening dresses, ponchos, chasubles, blue jeans, capes, girdles, blouses, swimming caps, swimsuits, chemisettes, chemises, sweaters, sweatshirts, sweat pants, cardigans, underwear, polo shirts, pullovers, t-shirts, bandanas, ear muffs, gloves, mittens, shawls, shoulder wraps, scarves, socks, water proof clothing, namely, raincoats and trousers; overalls, overcoats; footwear and headwear</p>
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U.S. Registration No.	3275447	Application Date	01/10/2006
Registration Date	08/07/2007	Foreign Priority Date	10/27/2005
Word Mark	B		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Protective helmets for sports, including for the skiing and snowboarding; sports; goggles for sports, namely goggles for skiing and snowboarding; spectacles, spectacle glasses, spectacle frames, sunglasses and spectacle cases; magnetic cards with or without chip, namely, credit cards; cinematographic films; blank video cassettes; recorded video cassettes featuring motion picture films and documentaries in the field of sports, leisure and recreational activities; exposed slide films; mechanic, magnetic, optical and opto-electronic recording and data carriers, namely, blank floppy disks, CDs and DVDs; mechanic, magnetic, optical and opto-electronic recording and data carriers namely, floppy disks, CDs and DVDs cassettes featuring music, voice recordings, pictures, movies about sports, leisure and recreational activities and animated cartoons; data processing equipment, namely central processing units for processing information, data, sound or images; computers; computer programs, namely computer operating system programs; projection apparatus and equipment, namely video projectors, data projectors, LCD panels, projection screens made of cloth, projection screens, touch screens with interactive projection areas; telecommunications apparatus for connecting and controlling interactive television, pay TV and video; mobile phones; and dictating machines</p> <p>Class 018. First use:</p>		

	<p>Leather; imitations of leather; goods made of these materials leather and imitation leather, namely handbags and leather briefcases, trunks and suitcases, rucksacks, sport bags, bags for sports shoes for travel, traveling bags, all-purpose carrying bags and shoulder bags, belt bags; umbrellas, parasols and walking sticks; whips, harness and saddlery</p> <p>Class 025. First use:</p> <p>Clothing, namely, pants, trousers, riding pants, golf pants, denim pants, sports jackets, jackets, dresses, coats, suits, skirts, blouses, shirts, parkas, ski pants, ski suits, overalls, pullovers, t-shirts, stockings and gloves, shawls, scarves, headbands, suspenders, belts, headwear, shoes, boots, footwear, ski boots and snowboard boots; parts of footwear, namely, heels; soles of shoes; ski gloves and snowboard gloves</p>
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U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Design Mark			
Goods/Services	pants, trousers, jackets, shirts, ski pants, ski suits, pullovers, caps, hats		

Attachments	<p>7538870#TMSN.gif (1 page)(bytes)</p> <p>79005647#TMSN.jpeg (1 page)(bytes)</p> <p>79021062#TMSN.jpeg (1 page)(bytes)</p> <p>79025019#TMSN.jpeg (1 page)(bytes)</p> <p>BinCirc.jpg</p> <p>GROUNDS FOR OPPOSITION.pdf (3 pages)(12172 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Thilo C. Agthe/
Name	Thilo C. Agthe
Date	04/02/2008

The grounds for opposition are as follows:

1. Willi Bogner GmbH & Co. Kommanditgesellschaft auf Aktien (hereinafter "Opposer") is a German manufacturer and distributor in interstate commerce of clothing articles and related goods.

2. Opposer has adopted and is using the trademark B in various forms, including "B in Circle" for various goods, including clothing, and has used and is currently using such mark in interstate commerce in the United States.

3. For more than two decades and long before June 1, 2004, the date of first use in commerce claimed on the application opposed herein, Opposer has continuously used the design mark "B in Circle" for clothing and related goods and has used such mark in interstate commerce in the United States.

4. Opposer's design mark "B in Circle" has a high degree of distinctiveness due to the duration and extent of Opposer's use, advertising and publicity of the "B in Circle" mark.

5. Opposer is the owner of U.S. trademark registration no. 2,264,266 for the mark B BOGNER (stylized) for, *inter alia*, "wearing apparel, namely, pants, trousers, riding pants, golf pants, sports jackets, jackets, dresses, coats, suits, skirts, blouses, shirts, parkas, ski pants, ski suits, pullovers, caps, hats, stockings and gloves, shawls, scarves, headbands, suspenders, shoes, belts made from leather and imitation leather, footwear and headwear" in International Class 25, registered in the United States on July 27, 1999.

6. Opposer is the owner of U.S. trademark registration no. 3,076,868 for the mark B (stylized) for, *inter alia*, "winter clothes, namely, ski suits and anoraks; sport suits" in International Class 25, registered in the United States on April 4, 2006.

7. Opposer is the owner of U.S. trademark registration no. 3,233,645 for the mark B (in circle) for, *inter alia*, "clothing, namely, cycling shorts, cycling shirts and cycling jackets, pants, trousers, riding pants, golf pants, ski pants, ski suits, sports shirts, sports jackets, anoraks, gymnastic clothing, namely, leotards, bodysuits, tank shirts, exercise shorts, sweat socks and sports bras; raincoats, shorts, blousons, jackets, dresses, coats, suits, skirts, shirts, parkas,

pullovers, stockings, evening dresses, ponchos, chasubles, blue jeans, capes, girdles, blouses, swimming caps, swimsuits, chemisettes, chemises, sweaters, sweatshirts, sweat pants, cardigans, underwear, polo shirts, pullovers, t-shirts, bandanas, ear muffs, gloves, mittens, shawls, shoulder wraps, scarves, socks, water proof clothing, namely, raincoats and trousers; overalls, overcoats; footwear and headwear” in International Class 25, registered in the United States on April 24, 2007.

8. Opposer is the owner of U.S. trademark registration no. 3,275,447 for the mark B (stylized) for, *inter alia*, “clothing, namely, pants, trousers, riding pants, golf pants, denim pants, sports jackets, jackets, dresses, coats, suits, skirts, blouses, shirts, parkas, ski pants, ski suits, overalls, pullovers, t-shirts, stockings and gloves, shawls, scarves, headbands, suspenders, belts, headwear, shoes, boots, footwear, ski boots and snowboard boots; parts of footwear, namely, heels; soles of shoes; ski gloves and snowboard gloves” in International Class 25, registered in the United States on April 24, 2007.

9. Opposer has expended significant amounts of resources and money to advertise and promote its trademarks in the United States.

10. On information and belief, no other entity other than Opposer has adopted and used the mark “B in Circle” until its adoption by Opposer.

11. Applicant’s application Serial No. 77/279,917 lists “Jeans; Cargo pants; Denims; Pants; Shorts” in international class 25 and claims a date of first use in commerce in the United States of June 1, 2004.

12. Applicant’s goods and Opposer’s goods are practically identical or at least closely related and are sold in the same channels of trade and to the same customers.

13. Opposer will be damaged by the sale and offering of Applicant's goods bearing the mark shown in application serial no. 77/279,917 since this mark, when used on Applicant's goods, falsely suggests a connection with Opposer, or falsely suggests that Applicant is associated with, or sponsored by, Opposer.

14. The mark shown in application serial no. 77/279,917 so resembles Opposer's marks 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.

WHEREFORE, Opposer demands that this opposition be sustained and that the trademark identified in Application Serial No. 77/279,917 be refused registration.