

ESTTA Tracking number: **ESTTA219715**

Filing date: **06/23/2008**

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	Converse Inc.
Granted to Date of previous extension	06/25/2008
Address	One High Street North Andover, MA 01845-2601 UNITED STATES
Attorney information	Kenneth Solomon Gallop, Johnson & Neuman, L.C. 101 South Hanley Road, Suite 1700 Clayton, MO 63105 UNITED STATES ip@gjn.com Phone:(314) 615-6000

Applicant Information

Application No	79038026	Publication date	02/26/2008
Opposition Filing Date	06/23/2008	Opposition Period Ends	06/25/2008
International Registration No.	0922848	International Registration Date	02/08/2007
Applicant	UNIT ENTERPRISES PTY LTD 2/12 Distribution Avenue MOLENDINAR QLD 4214, AUSTRALIA		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Motocross, freestyle motocross, bmx, mountain bike, and casual clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, unitards, tights, shorts, hats, caps, gloves, belts, shoes, boots, socks, sweatbands, headbands, aprons, bandanas, beanies
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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.	741662	Application Date	01/26/1962
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Registration Date	12/04/1962	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1916/10/24 First Use In Commerce: 1916/10/24 Canvas-Topped, Rubber-Soled Athletic Shoes		

U.S. Registration No.	924169	Application Date	10/06/1970
Registration Date	11/23/1971	Foreign Priority Date	NONE
Word Mark	CONVERSE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U022 (International Class 016, 018, 020, 022, 025, 028). First use: First Use: 1967/01/01 First Use In Commerce: 1967/01/01 [GOLF SHOES, TRACK SHOES, WRESTLING SHOES, BASEBALL SHOES, FOOTBALL SHOES, SKATE SCABARDS, ANKLE SUPPORTS, TEETH GUARDS, HOCKEY PUCKS, AIR FLOATS AND AIR MATTRESSES] Class U039 (International Class 010, 025, 026). First use: First Use: 1967/01/01 First Use In Commerce: 1967/01/01 [HUNTING BOOTS, FISHING BOOTS, INDUSTRIAL BOOTS, RUBBER BOOTS, TENNIS SHOES,] BASKETBALL SHOES, [BOAT SHOES,] GENERAL PURPOSE ATHLETIC SNEAKERS, [CASUAL SHOES, WADING SANDALS, JACKETS, TROUSERS, PARKAS, SHIRTS, OVERALLS, HATS, RAINCOATS, AND SUSPENDERS]		

U.S. Registration No.	1053338	Application Date	02/24/1975
Registration Date	11/23/1976	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1974/10/00 First Use In Commerce: 1975/01/00 CANVAS AND IMITATION LEATHER TOPPED SOFT SOLED ATHLETIC SHOES AND CASUAL SHOES		

U.S. Registration No.	1078480	Application Date	03/11/1977
Registration Date	11/29/1977	Foreign Priority Date	NONE
Word Mark	CONVERSE		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 025. First use: First Use: 1976/12/00 First Use In Commerce: 1976/12/00 FOOTWEAR		
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U.S. Registration No.	1138468	Application Date	08/23/1979
Registration Date	08/05/1980	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1977/02/01 First Use In Commerce: 1977/02/01 FOOTWEAR		

U.S. Registration No.	1138469	Application Date	08/23/1979
Registration Date	08/05/1980	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR CHUCK TAYLOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1946/00/00 First Use In Commerce: 1946/00/00 FOOTWEAR		

U.S. Registration No.	1146876	Application Date	08/23/1979
Registration Date	02/10/1981	Foreign Priority Date	NONE
Word Mark	ALL STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1974/01/01 First Use In Commerce: 1974/01/01 Footwear		

U.S. Registration No.	1215935	Application Date	01/19/1981
Registration Date	11/09/1982	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1979/11/00 First Use In Commerce: 1980/01/00 Shirts		

U.S. Registration No.	1490262	Application Date	08/14/1987
Registration Date	05/31/1988	Foreign Priority	NONE

		Date	
Word Mark	CONVERSE CHUCK TAYLOR ALL STAR		
Design Mark			
Description of Mark	THE DRAWING IS A SHOE DESIGN SHOWN IN DOTTED LINES DEMONSTRATING THE PLACEMENT OF A CIRCULAR ANKLE PATCH ON THE SIDE OF THE SHOE.		
Goods/Services	Class 025. First use: First Use: 1922/00/00 First Use In Commerce: 1922/00/00 ATHLETIC FOOTWEAR		

U.S. Registration No.	1525779	Application Date	11/02/1987
Registration Date	02/21/1989	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1978/02/01 First Use In Commerce: 1978/02/01 SOCKS		

U.S. Registration No.	1632413	Application Date	07/28/1989
Registration Date	01/22/1991	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1976/12/00 First Use In Commerce: 1976/12/00 FOOTWEAR, [SOCKS AND WARM-UP SUITS]		

U.S. Registration No.	1654951	Application Date	04/02/1990
Registration Date	08/27/1991	Foreign Priority Date	NONE
Word Mark	CONVERSE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1986/12/15 First Use In Commerce: 1986/12/15 clothing; namely, footwear		

U.S. Registration No.	1738330	Application Date	09/26/1991
Registration Date	12/08/1992	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR CHUCK TAYLOR		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 018. First use: First Use: 1987/01/00 First Use In Commerce: 1987/01/00 all purpose sports bags

U.S. Registration No.	1789476	Application Date	11/06/1992
Registration Date	08/24/1993	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1946/00/00 First Use In Commerce: 1946/00/00 footwear		

U.S. Registration No.	1804563	Application Date	12/21/1992
Registration Date	11/16/1993	Foreign Priority Date	NONE
Word Mark	CONVERSE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1984/01/00 First Use In Commerce: 1984/01/00 clothing; namely, knit T-shirts, collar placket shirts, [woven shirts, swimwear,] knit and woven shorts, [knit and] woven pants, tank tops, fleece tops and bottoms, wind resistant suits and jackets sports caps [and knit caps]		

U.S. Registration No.	1868414	Application Date	11/26/1993
Registration Date	12/20/1994	Foreign Priority Date	NONE
Word Mark	ONE STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1993/06/00 First Use In Commerce: 1993/06/00 footwear		

U.S. Registration No.	1877671	Application Date	08/10/1992
Registration Date	02/07/1995	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR CHUCK TAYLOR		
Design Mark			
Description of Mark	The broken lines are a feature of the mark and do not indicate the position of the mark on the goods.		
Goods/Services	Class 025. First use: First Use: 1972/00/00 First Use In Commerce: 1972/00/00 clothing; namely, T-shirts, shorts, tank tops, sweatsuits, vests, pants, jackets, swimwear, sweaters, jeans and outerwear; namely, lined jackets, insulated snow		

	mobile suits and nylon jackets		
U.S. Registration No.	1981319	Application Date	08/10/1992
Registration Date	06/18/1996	Foreign Priority Date	NONE
Word Mark	ALL STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1992/12/07 First Use In Commerce: 1992/12/07 clothing; namely, T-shirts, shorts, tank tops, sweatsuits, vests, pants, jackets, swimwear, sweaters, jeans and outerwear; namely, lined jackets, insulated snow mobile suits and nylon jackets		
U.S. Registration No.	2063154	Application Date	05/28/1996
Registration Date	05/20/1997	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR CHUCK TAYLOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1993/02/15 First Use In Commerce: 1993/02/15 headwear, namely, sport and knit hats and caps		
U.S. Registration No.	2098296	Application Date	03/20/1996
Registration Date	09/16/1997	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1996/09/11 First Use In Commerce: 1996/09/11 athletic footwear, and clothing, namely, T-shirts, shorts, hats, jackets, tank tops, sweatpants and sweatshirts		
U.S. Registration No.	2435788	Application Date	03/17/1999
Registration Date	03/13/2001	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR CHUCK TAYLOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1999/11/30 First Use In Commerce: 1999/11/30 [MEN'S BRIEFS, BOXERS, BOXER BRIEFS, PANTS, KNIT SHIRTS, AND SCREEN-PRINTED UNDERWEAR AND LOUNGE WEAR, AND] T-SHIRTS		

U.S. Registration No.	2435789	Application Date	03/17/1999
Registration Date	03/13/2001	Foreign Priority Date	NONE
Word Mark	ALL STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1999/11/30 First Use In Commerce: 1999/11/30 CLOTHING NAMELY, [MEN'S BRIEFS, BOXERS, BOXER BRIEFS, PANTS, KNIT SHIRTS, AND SCREEN-PRINTED UNDERWEAR, LOUNGE WEAR AND] T-SHIRTS		

U.S. Registration No.	2466301	Application Date	03/05/1999
Registration Date	07/03/2001	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR CHUCK TAYLOR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1999/06/30 First Use In Commerce: 1999/06/30 [exercise books, wirebound books, wirebound hardback books, ballpoint pens, cartridge pens, elasticated binders, erasers, filled pencil cases, pencils, pencil packs, pencil sets] Class 018. First use: First Use: 1999/06/30 First Use In Commerce: 1999/06/30 book bags and briefcases-style portfolios		

U.S. Registration No.	2525636	Application Date	03/17/1999
Registration Date	01/01/2002	Foreign Priority Date	NONE
Word Mark	ALL STAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1999/06/30 First Use In Commerce: 1999/06/30 EXERCISE BOOKS, WIREBOUND BOOKS, WIREBOUND HARDBACK BOOKS, BALLPOINT PENS, CARTRIDGE PENS, ELASTICATED BINDERS, ERASERS, FILLED PENCIL CASES, PENCILS, PENCIL PACKS, PENCIL SETS Class 018. First use: First Use: 1999/06/30 First Use In Commerce: 1999/06/30 BOOK BAGS, BRIEFCASE-STYLE PORTFOLIOS		

U.S. Registration No.	2529040	Application Date	12/27/1999
Registration Date	01/15/2002	Foreign Priority Date	NONE
Word Mark	CONVERSE ALL STAR CHUCK TAYLOR		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1989/07/31 First Use In Commerce: 1989/07/31 Eyewear

U.S. Registration No.	2973804	Application Date	09/22/2003
Registration Date	07/19/2005	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a star and chevron design.		
Goods/Services	Class 025. First use: First Use: 2003/10/00 First Use In Commerce: 2003/10/00 footwear		

Attachments	72136634#TMSN.gif (1 page)(bytes) 72372578#TMSN.gif (1 page)(bytes) 73044904#TMSN.gif (1 page)(bytes) 73118741#TMSN.gif (1 page)(bytes) 73228707#TMSN.gif (1 page)(bytes) 73228708#TMSN.gif (1 page)(bytes) 73228706#TMSN.gif (1 page)(bytes) 73293693#TMSN.gif (1 page)(bytes) 73678527#TMSN.gif (1 page)(bytes) 73693236#TMSN.gif (1 page)(bytes) 73815375#TMSN.gif (1 page)(bytes) 74044591#TMSN.gif (1 page)(bytes) 74207058#TMSN.gif (1 page)(bytes) 74328801#TMSN.gif (1 page)(bytes) 74341917#TMSN.gif (1 page)(bytes) 74463082#TMSN.gif (1 page)(bytes) 74302298#TMSN.gif (1 page)(bytes) 74302907#TMSN.gif (1 page)(bytes) 75110027#TMSN.gif (1 page)(bytes) 75075527#TMSN.gif (1 page)(bytes) 75662554#TMSN.gif (1 page)(bytes) 75662559#TMSN.gif (1 page)(bytes) 75654970#TMSN.gif (1 page)(bytes) 75662556#TMSN.gif (1 page)(bytes) 75881244#TMSN.gif (1 page)(bytes) 78303567#TMSN.jpeg (1 page)(bytes) Notice of Opp 79-038026.pdf (5 pages)(35245 bytes)
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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 First Class Mail on this date.

Signature	/Kenneth Solomon/
Name	Kenneth Solomon
Date	06/23/2008

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

Converse Inc.	:	
	:	
Opposer,	:	Opposition No. _____
	:	
v.	:	
	:	
Unit Enterprises Pty. Ltd.	:	Directed to App. No. 79/038,026
	:	
Applicant.	:	

NOTICE OF OPPOSITION

COMES NOW Opposer, Converse Inc., and pursuant to 15 U.S.C. §§1063 and 1068, and 37 CFR §2.101, and hereby files its Notice of Opposition to U.S. Trademark Application Serial No. 79/038,026 owned by Unit Enterprises Pty. Ltd. In support thereof, Opposer states as follows:

PARTIES

1. Opposer, Converse Inc., is a corporation organized and existing under the laws of the state of Delaware, with offices at One High Street, North Andover, Massachusetts 01845.
2. On information and belief, Applicant is a company organized under the laws of Australia with an address at 2/12 Distribution Avenue, Molendinar, QLD 4214, Australia.
3. On information and belief, Applicant is the owner of trademark application serial no. 79/038,026 for Five-Pointed Star in Circle Design for "*Motocross, freestyle motocross, bmx, mountain bike, and casual clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, unitards, tights, shorts, hats, caps, gloves, belts, shoes, boots, socks, sweatbands, headbands, aprons, bandanas, beanies*" in International Class 25 ("the Application"). The Application was published in the United States Patent and Trademark Office Official Gazette on February 26, 2008.

BACKGROUND

4. Since at least 1916, Opposer has continuously used in interstate commerce marks consisting solely or in part of a prominent five-pointed star design and marks consisting solely or in part of a five-pointed star design within a circle (both types of mark identified collectively herein as "Star Marks"), as trademarks in its business of manufacturing, marketing and selling footwear, clothing, and related articles ("Opposer's goods").

5. Opposer is owner of the following United States trademark registrations on its Star

Marks:

<u>Registration Number</u>	<u>Registration Date</u>	<u>International Class</u>	<u>Exhibit No.</u>
741,662	Dec. 4, 1962	39	A
924,169	Nov. 23, 1971	25, 28	B
1,053,338	Nov. 23, 1976	25	C
1,078,480	Nov. 29, 1977	25	D
1,138,468	Aug. 5, 1980	25	E
1,138,469	Aug. 5, 1980	25	F
1,146,876	Feb. 10, 1981	25	G
1,215,935	Nov. 9, 1982	25	H
1,490,262	May 31, 1988	25	I
1,525,779	Feb. 21, 1989	25	J
1,632,413	Jan. 22, 1991	25	K
1,654,951	Aug. 27, 1991	25	L
1,738,330	Dec. 8, 1992	18	M
1,789,476	Aug. 24, 1993	25	N
1,804,563	Nov. 16, 1993	25	O
1,868,414	Dec. 20, 1994	25	P
1,877,671	Feb. 7, 1995	25	Q
1,981,319	June 18, 1996	25	R
2,063,154	May 20, 1997	25	S
2,098,296	Sep. 16, 1997	25	T
2,435,788	Mar. 13, 2001	25	U
2,435,789	Mar. 13, 2001	25	V
2,466,301	July 3, 2001	16, 18	W
2,525,636	Jan. 1, 2002	16, 18	X
2,529,040	Jan. 15, 2002	9	Y
2,973,804	July 19, 2005	25	Z

Said registrations are valid and in good standing. Exhibits A-Z are attached hereto.

6. Opposer has promoted and sold its goods in interstate and intrastate commerce under its Star Marks since long prior to any alleged use by Applicant of the mark shown in the Application.

7. As a result of the use, promotion, and advertising of Opposer's Star Marks, said marks have become well known to the trade and to the public, and have accordingly acquired significant

goodwill. Opposer's trademarks identify and distinguish Opposer's goods from the goods of others, and identify the source and origin thereof to both the trade and the public.

8. Prior to Applicant's adoption of its mark, if any, Opposer's Star Marks have been used and promoted in such a way as to create a public perception of the prominent five-pointed star design and of the five-pointed star design within a circle as family characteristics and as indications of source, each of which characteristic is distinctive. Opposer's Star Marks continue to be used and promoted in such a way. Thus, Opposer's Star Marks constitute a family of marks, with Applicant's mark appearing to be a member thereof.

9. Opposer's family of Star Marks is famous as that term is defined under 15 U.S.C. §1125.

COUNT I
(Likelihood of Confusion)

10. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 through 9 as if fully set forth herein.

11. Upon information and belief, Applicant has made no use of the mark shown in the Application, nor of any word, letter or design confusingly similar thereto, as a trademark or service mark, prior to the date of first use of the Star Marks of Opposer.

12. Applicant's registration and use of the mark shown in the Application is likely to cause confusion in the minds of the trade and of the public that Applicant's goods emanate from or are licensed, sponsored or otherwise authorized by Opposer, whereas in fact they are not.

13. The mark shown in the Application so resembles Opposer's Star Marks previously used in the United States by Opposer and not abandoned, as to be likely, when applied to Applicant's goods, to cause confusion or to cause mistake or to deceive, and is an attempt to deceive the public and to benefit from the reputation and goodwill developed by Opposer.

14. Opposer will be injured and damaged by the registration of the mark shown in the Application, because such mark, when applied to the goods of Applicant:

- a) is likely to cause confusion, or to cause mistake, or to deceive;
- b) falsely suggests a connection with Opposer; and
- c) will damage Opposer's valuable goodwill in its Star Marks trademarks.

15. By reason of the foregoing, Applicant is not entitled to the registration of the mark shown in the Application.

COUNT II
(Dilution)

16. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 through 15 as if fully set forth herein.

17. Upon information and belief, Applicant has made no use of the mark shown in the Application, nor of any word, letter or design confusingly similar thereto, as a trademark or service mark, prior to the date of first use of the Star Marks of Opposer.

18. Opposer's Star Marks became famous as that term is defined in 15 U.S.C. §1125 prior to the date of first use of the mark shown in the Application by Applicant.

19. Applicant's commercial use of the mark shown in the Application will cause dilution of the distinctive quality of Opposer's famous Star Marks.

20. By reason of the foregoing, Applicant is not entitled to the registration of the mark shown in the Application.

PRAYER FOR RELIEF

WHEREFORE, Opposer prays that the Opposition be sustained and that registration of the mark shown in the Application be refused.

Opposer authorizes the Commissioner for Trademarks to charge the fee of \$300 to Deposit Account 501846 for filing this Notice of Opposition. Opposer believes that no additional fees are due; however, the Commissioner for Trademarks is authorized to debit our Account 501846 for any additional fees.

Respectfully submitted,

By: /Kenneth Solomon/
Kenneth Solomon
GALLOP, JOHNSON & NEUMAN, L.C.
101 South Hanley, Suite 1700
St. Louis, Missouri 63105
(314) 615-6000
(314) 615-6001 (Facsimile)

Attorney for Opposer Converse, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of this Notice of Opposition and the attached exhibits were sent, via First Class Mail, postage prepaid, this 23rd day of June, 2008, to the following attorney of record for applicant:

Charlotte K. Corwin, Esq.
Unit Enterprises Pty. Ltd.
2/12 Distribution Avenue
Molendinar, QLD 4214
AUSTRALIA

Attorney for Applicant: Unit Enterprises Pty. Ltd.

/s/ Kenneth Solomon