

ESTTA Tracking number: **ESTTA355644**

Filing date: **06/30/2010**

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	K-Swiss Inc.
Granted to Date of previous extension	06/30/2010
Address	31248 Oak Crest Drive Westlake Village, CA 91361 UNITED STATES

Attorney information	Neil Greenstein TechMark 1917 Palomar Oaks Way Suite 300 Carlsbad, CA 92008 UNITED STATES ndg@techmark.com, cmp@techmark.com, dla@techmark.com Phone: 408-280-2228, X303
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Applicant Information

Application No	77843304	Publication date	03/02/2010
Opposition Filing Date	06/30/2010	Opposition Period Ends	06/30/2010
Applicants	Mastrandonas, Andrew Suite 200 16 East Main Street Rochester, NY 14614 UNITED STATES Gitlin, Preston A. Suite 200 16 East Main Street Rochester, NY 14614 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Bathing suits; Belts for clothing; Blouses; Dresses; Hats; Headbands; Neckties; Pants; Scarves; Shirts; Skirts; Sleepwear; Socks; Sweat pants; Sweaters; Undergarments; Wristbands

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. Registration	1477834	Application Date	06/29/1987
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No.			
Registration Date	02/23/1988	Foreign Priority Date	NONE
Word Mark	K-SWISS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1987/06/18 First Use In Commerce: 1987/06/18 SPORTSWEAR, NAMELY TOPS, T-SHIRTS, POLO SHIRTS, SHORTS, PANTS, WARM-UP SUITS, AND ATHLETIC SHOES, ACTIVE WALKING SHOES, AND CASUAL SHOES		

Attachments	73669167#TMSN.gif (1 page)(bytes) 2010-06-30-Notice of Opposition-FINAL.pdf (5 pages)(176558 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	/ndg-pto/
Name	Neil Greenstein
Date	06/30/2010

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

K-Swiss Inc.,

Opposer,

v.

Andrew Mastrandonas and Preston A.
Gitlin,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

In the matter of the application for registration of:

Applicant's Mark: S.W.I.S. brand

Serial No.: 77/843,304

International Classes: 25

Applicant's Goods: Bathing suits; Belts for clothing; Blouses; Dresses; Hats; Headbands;
Neckties; Pants; Scarves; Shirts; Skirts; Sleepwear; Socks; Sweat pants; Sweaters;
Undergarments; Wristbands

Extended Deadline for filing

Notice of Opposition: June 30, 2010

United States Patent and Trademark Office

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, VA 22313-1451

K-SWISS INC., a corporation organized and existing under the laws of the State of Delaware, with its principal place of business at 31248 Oak Crest Drive, Westlake Village, CA 91361, believes it will be damaged by registration on the Principal Register of the mark shown in Application Serial No. 77/843,304 and hereby opposes registration of the above-identified application on the following grounds:

Notice of Opposition

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SN 77/843,304

1. K-Swiss Inc. (herein sometimes "Opposer") is now and, through its predecessor, for well over 40 years has been engaged in the manufacture, promotion, advertising and sale of a variety of goods ("Opposer's Goods"), including, without limitation, footwear, shoes, clothing and related sports products, in association with its K-Swiss trade name and trademarks.

2. K-Swiss is, *inter alia*, the owner of U.S. Trademark Registration No. 1,477,834 registered on February 23, 1988, for a K•SWISS mark on sportswear and athletic shoes.

3. K-Swiss' registration identified above (the "K-Swiss Registration") is extant, has been registered for more than 5 years and has had declarations filed under Sections 8 and 15 of the Trademark Act. As such, the K-Swiss Registration is incontestible and is conclusive proof of the validity of the mark, of K-Swiss' ownership of the mark, and of K-Swiss' exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in such registration.

4. Opposer distributes goods which are identical to Applicant's goods, goods which are of the same type as Applicant's goods, goods which are related to Applicant's goods and/or goods which compete with Applicant's goods.

5. Applicant acquired no rights, inchoate or otherwise in Applicant's Mark for the goods specified in Application Serial Number 77/843,304 prior to October 7, 2009.

6. Applicant's Mark is confusingly similar to Opposer's mark and trade name.

7. Opposer uses its marks on catalogs, publications, labels and/or tags affixed to goods and/or packaging for goods, on the goods, and/or in other ways customary in the trade.

8. Opposer has continuously and extensively promoted its trademark and trade name in connection with Opposer's Goods. As a result, Opposer's mark and name have become well

known to and favorably received by the general consuming public as being associated with Opposer's Goods.

9. Opposer has used its marks continuously in the United States for over 40 years and long prior to any of Applicant's claimed rights. As such, Opposer's common law rights in its K-SWISS name and mark are superior to Applicant's rights.

10. Purchasers recognize K-Swiss as a supplier of Opposer's Goods in connection with Opposer's Mark and name. Such purchasers would likely assume that Applicant's Goods sold under Applicant's Mark originated with K-Swiss.

11. Opposer has built a valuable goodwill in its marks used in connection with Opposer's Goods. If Applicant is permitted to register and use Applicant's Mark in connection with Applicant's Goods, confusion in the trade would result. Purchasers familiar with Opposer's Goods would believe that Applicant's Goods sold under Applicant's Mark are, contrary to fact, associated with, endorsed by or in some way related to Opposer, or actually are the goods of Opposer. Any fault or defect in connection with Applicant's Goods would reflect upon and seriously injure the reputation which has been established for Opposer's Goods. Moreover, purchasers familiar with the Opposer's mark and name would confuse such mark and name with Applicant's Mark and might purchase or use Applicant's Goods in the belief that they are purchasing or using Opposer's Goods. This confusion would result in a loss of sales to K-Swiss and damage both its income and its reputation.

12. Applicant's Goods are related to and/or the same as Opposer's Goods and Applicant's Mark is confusingly similar to Opposer's mark and name. Applicant's Mark when used in association with Applicant's Goods is likely to cause confusion, mistake or deception

with Opposer's Goods. Thus, the registration of Applicant's Mark is precluded under Section 2(d) of the Trademark Act. Moreover, registration of Applicant's Mark would create rights inconsistent with K-Swiss' right to use its mark and name.

13. Applicant is not now and never was entitled to registration on the Principal Register of the alleged trademark depicted in Application Serial No. 77/843,304 for the goods specified therein ("Applicant's Goods").

14. If Applicant is granted the registration herein opposed, Applicant would have *prima facie* exclusive rights to Applicant's Mark and all confusingly similar marks, thus placing Applicant in a position to harass, annoy, damage and injure K-Swiss and K-Swiss' customers.

WHEREFORE, Opposer requests that registration of Applicant's alleged trademark, as show in Application Serial No. 77/843,304 be denied and that this Opposition be sustained.

Please recognize Neil D. Greenstein, (ndg@techmark.com) and Martin R. Greenstein with an address of TechMark, 1917 Palomar Oaks Way, Suite 300, Carlsbad, CA 92008, (408) 280-2228, members in good standing of the Bar of the State of California, as Opposer's attorneys in connection with this opposition proceeding. All correspondence from the Trademark Trial and Appeal Board should be directed to Neil D. Greenstein.

Dated: June 30, 2010

K-SWISS INC.

By: 
Attorney for Opposer

NEIL D. GREENSTEIN
TECHMARK
1917 Palomar Oaks Way, Suite 300
Carlsbad, CA 92008
Telephone: (408) 280-2228, X303
Facsimile: (408) 280-2250
Email: ndg@techmark.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **NOTICE OF OPPOSITION** has been served on Applicant's Attorney of Record, by mailing said copy on June 30, 2010 by First Class Mail, postage prepaid to the following:

Josh Gerben, Esq.
Gerben Law Firm, PLLC
1615 L Street NW, Suite 1350
Washington, DC 20036
Email: trademark@gerbenlaw.com

Dated: June 30, 2010


Neil D. Greenstein