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

Proceeding	91198381
Party	Plaintiff Nautica Apparel, Inc.
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Date	01/31/2011
Attachments	Motion to Amend Notice and Amended notice 1-31-11.pdf (11 pages)(87888 bytes)

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

NAUTICA APPAREL, INC.,

Opposer,

v.

VICTOR BAUDURET

Applicant.

Opp. No. 91198381

Mark: NAUTICATHLON

Serial No. 79081811

Filed: May 13, 2010

**OPPOSER’S MOTION TO AMEND ITS NOTICE OF OPPOSITION
PURSUANT TO 15 U.S.C. § 1063**

Opposer, Nautica Apparel, (“Opposer”) Inc., by its attorneys Baker and Rannells, PA, (“Petitioner”), by its attorney, hereby moves, pursuant to Trademark Rule 2.115 to amend its notice of opposition to trademark application Ser. No. 79081811, to more fully plead its claims. Leave to amend should be freely granted unless one or more of specified grounds for denial exist. None of those grounds exist here and Opposers’s Motion should be granted. Applicant has not yet filed an Answer to Opposer’s first notice of opposition, and no prejudice would thereby ensue.

Dated: January 31, 2011

Respectfully submitted for
Opposer Nautica Apparel, Inc.

By: /Linda Kurth/
Linda Kurth
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Motion to Amend its Notice of Opposition was forwarded by first class postage prepaid mail by depositing the same with the U.S. Postal Service on this 31st of January, 2011 to the attorney for the Applicant at the following address:

Carl Oppedahl, Esq.
Oppedahl Patent Law Firm LLC
P O Box 5940
Dillon CO 80435-5940

/ Linda Kurth/
Linda Kurth

under 66(a) citing international registration number 1036586, as a trademark for “education services, namely, providing classes, seminars and workshops in the fields of sport and nutrition; training services in the field of sport and nutrition; organizing community sporting and cultural events; information on entertainment or education; leisure services, namely, amusement parks; book publishing; book lending; videotape film production; rental of cinematographic films; rental of sound recordings; rental of video cassette recorders or of radio and television sets; rental of show scenery; videotape editing; photography services; arranging of athletic and water-based competitions for educational or entertainment purposes; educational services, namely, arranging and conducting of educational colloquiums, conferences or congresses in the field of sport and nutrition; arranging of exhibitions for cultural or educational purposes; booking of seats for shows; providing games online on a computer network; gambling services; electronic publishing of books and periodicals online; desktop publishing for others” in International Class 41 (“Applicant’s Services”), which was published for opposition in the Official Gazette on January, 18, 2011.

5. Opposer is the owner of numerous trademarks in a variety and constantly expanding number of classes including the NAUTICA marks, marks that contain the word NAUTICA and variations thereof (“Opposer's Marks”) as trademarks, trade names, and as service marks, including Registration No. 3114379 for the mark NAUTICA for “Organizing and operating sporting events, tournaments, competitions and contests” in Class 41 and “Financial sponsorship of sporting events, tournaments, competitions and contests” in Class 36.

6. Including Registration Number 3114379, examples of Opposer's Marks are as follows:

Trademark	Serial No.	Application Date	Registration No.	Registration Date	Class	Status
NAUTICA	78764381	12-Dec-2005	3114379	11-Jul-2006	36, 41	Registered
NAUTICA	78885472	17-May-2006	3233030	24-Apr-2007	14	Registered
NAUTICA	78293501	28-Aug-2003	2865299	20-Jul-2004	20	Registered
NAUTICA	76/371274	16-Feb-2002	2731466	1-Jul-2003	24	Registered
NAUTICA	78292765	27-Aug-2003	3114862	11-Jul-2006	24	Registered
NAUTICA	78293506	28-Aug-2003	2865300	20-Jul-2004	24	Registered
NAUTICA	74462464	23-Nov-1993	1862585	15-Nov-1994	25	Registered
NAUTICA	78280401	29-Jul-2003	2865229	20-Jul-2004	28	Registered
NAUTICA	78825489	28-Feb-2006	3232846	24-Apr-2007	35	Registered
NAUTICA	74730271	18-Sep-1995	2304411	28-Dec-1999	11	Registered
NAUTICA BEACH	78258096	4-Jun-2003	3109967	27-Jun-2006	25	Registered
NAUTICA BEDWEAR	75/458277	27-Mar-1998	2639939	22-Oct-2002	20, 24	Registered
NAUTICA BERMUDA BLUE	78963691	30-Aug-2006	3447065	10-June-2008	3	Registered
NAUTICA BERMUDA TABLEWARES	75569530	12-Oct-1998	2476203	7-Aug-2001	8, 21, 24	Registered
NAUTICA BLUE	78647283	9-Jun-2005	3170055	7-Nov-2006	3	Registered
NAUTICA BLUE	78/114601	13-Mar-2002	2993023	6-Sep-2005	25	Registered
NAUTICA BLUE	78/114981	14-Mar-2002	2987139	23-Aug-2005	25	Registered
NAUTICA COMPETITION	78606800	12-Apr-2005	3076597	4-Apr-2006	3	Registered
NAUTICA COMPETITION	78613836	21-Apr-2005	3076794	4-Apr-2006	18	Registered

NAUTICA COMPETITION	78614003	21-Apr-2005	3076796	4-Apr-2006	25	Registered
NAUTICA EMBLEM	73652468	31-Mar-1987	1523565	7-Feb-1989	25	Registered
NAUTICA GOLF	78275303	17-Jul-2003	3272760	31-Jul-2007	25	Registered
NAUTICA ISLAND	78912365	20-Jun-2006	3888149	07-Dec- 2010	25	Registered
NAUTICA JEANS	75664161	19-Mar-1999	2474154	31-Jul-2001	25	Registered
NAUTICA JEANS COMPANY	75663915	19-Mar-1999	3170055	25-Dec-2001	25	Registered
NAUTICA PERFORMANCE TRAVEL GEAR	78814361	14-Feb-2006	3232827	24-Apr- 2007	18	Registered
NAUTICA	73745061	30-Jan-1990	1580007	30-Jan-1990	16 18 25	Registered
NAUTICA	74730051	18-Sep-1995	2246317	18-May- 1999	20	Registered
NAUTICA	74730052	18-Sep-1995	2306324	4-Jan-2000	21	Registered
NAUTICA	74/730054	18-Sep-1995	2247914	25-May- 1999	24	Registered
NAUTICA	73631447	20-Nov-1986	1464663	10-Nov- 1987	25	Registered
NAUTICA	74730053	18-Sep-1995	2242969	4-May-1999	27	Registered
NAUTICA	73745058	9-Aug-1988	1557528	26-Sep-1989	3	Registered
NAUTICA	73745057	9-Aug-1988	1557527	26-Sep-1989	3	Registered
NAUTICA	74355511	4-Feb-1993	1882757	7-Mar-1995	3	Registered
NAUTICA	74220315	12-Nov-1991	1873011	10-Jan-1995	6 14 18 26	Registered
NAUTICA	74730265	18-Sep-1995	2292976	16-Nov- 1999	8	Registered
NAUTICA	73737613	24-Jun-1988	1553539	29-Aug- 1989	9	Registered
NAUTICA VOYAGE	78668277	12-Jul-2005	3170094	7-Nov-2006	3	Registered
NAUTICAKIDS	78868779	25-Apr-2006	3165353	31-Oct-2006	11	Registered
NAUTICAKIDS	78868734	25-Apr-2006	3165351	31-Oct-2006	24	Registered

NAUTICAKIDS	78809150	7-Feb-2006	3168753	7-Nov-2006	25	Registered
NAUTICAKIDS	78869724	26-Apr-2006	3165354	31-Oct-2006	27	Registered
NAUTICAKIDS	78868759	25-Apr-2006	3165352	31-Oct-2006	28	Registered
NAUTICAKIDS	78858780	11-Apr-2006	3165348	31-Oct-2006	35	Registered
NAUTICARE	77081223	11-Jan-2007	3445949	10-June-2008	25	Registered
ISLAND BY NAUTICA	78912400	20-Jun-2006			25	Pending
NAUTICA	85013805	14-Apr-2010			19	Pending
NAUTICA	85013792	14-Apr-2010			21	Pending
NAUTICA	85013716	14-Apr-2010			20	Pending
NAUTICA	85013687	14-Apr-2010			11	Pending

Hereinafter the goods and services recited in Opposer's Marks are referred to as "Opposer's Goods and Services."

7. Opposer's Goods and Services have been widely advertised, offered for sale and sold throughout the United States under Opposer's Marks and Opposer's Marks are famous.

8. Since long prior to any date which may be claimed by Applicant, Opposer has been engaged in the offer for sale and sale of Opposer's Goods and Services under Opposer's Mark in interstate commerce.

9. Opposer's Goods and Services have been widely advertised, offered for sale and sold throughout the United States under Opposer's Mark and Opposer's Mark has become well known.

10. Opposer is now and has been for many years trading as and known by Opposer's Mark, identifying Opposer as the source of high quality goods and services.

11. Opposer is now and has been, for many years prior to any date which may be claimed by Applicant, engaged in the use of Opposer's Mark for Opposer's Goods and Services.

12. Opposer is now and has been, for many years prior to any date which may be claimed by Applicant, engaged in the sale of Opposer's Goods and Services under Opposer's Mark.

13. The use by Opposer of Opposer's Mark for Opposer's Goods and Services alleged herein is long prior to any date which may be lawfully claimed by Applicant, and Opposer has priority.

14. Opposer's Mark and Applicant's Mark are substantially identical and confusingly similar when applied to the goods and services of the parties.

15. Applicant intends to promote Applicant's Services through the same channels of trade as Opposer, and direct its respective goods to the same ultimate consumer as Opposer.

16. Applicant's intended use of Applicant's Mark in connection with Applicant's Goods is without the consent or permission of Opposer.

17. Since Opposer owns Opposer's Mark by virtue of prior use, confusion, mistake or deception as to the source of origin of the goods will arise and will injure and damage the Opposer and its goodwill.

18. The registration of Applicant's Mark to Applicant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant's Services are made by, licensed by, controlled by, sponsored by, or in some

way connected, related or associated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), all to Opposer's irreparable damage.

19. Issuance of registration for Applicant's Mark to Applicant would create a false and misleading connection to Opposer all to the irreparable damage of consumers and Opposer.

20. Issuance of registration for Applicant's Mark to Applicant would create a cloud on Opposer's rights to use Opposer's Mark for Opposer's Goods and Services.

21. As a result of Opposer's long use, extensive advertising and promotion, and successful sales for at least 20 years, Opposer's Marks have become distinctive and famous, long prior to any date which may be claimed by Applicant.

22. The registration of Applicant's Mark, will cause the dilution of the distinctive quality of Opposer's Marks, all to Opposer's irreparable damage

23. The association which would arise from the similarity between Applicant's Mark and Opposer's famous Marks will harm the reputation of Opposer and Opposer's famous Marks thereby resulting in dilution by tarnishment in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c). There is an overwhelming likelihood that this association will impugn Opposer's Goods and Services and injure its business reputation.

24. The association which would arise from the similarity between Applicant's Mark and Opposer's famous Marks will impair the distinctiveness of Opposer's famous Marks and thereby result in dilution by blurring in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c). There is an overwhelming likelihood that

this association will impugn Opposer's Goods and Services and injure its business reputation.

25. Applicant's Mark falsely suggests a connection with Opposer, and/or will bring Opposer into contempt or disrepute, in violation of §2(a) of the Lanham Act, 15 U.S.C. §1052(a), all to Opposer's irreparable damage.

26. Applicant's use of Applicant's Mark points uniquely and unmistakably to Opposer.

27. Consumers that encounter Applicant's Mark will recognize Applicant's Mark as pointing uniquely and unmistakably to Opposer.

28. The registration of Applicant's Mark to Applicant would create a false and misleading connection to Opposer all to the irreparable damage of consumers and Opposer.

WHEREFORE, Opposer prays that the application for registration of Applicant's Mark, Serial No. 79081811 be denied and that this Opposition be sustained.

Dated: January 31, 2011

Respectfully submitted for
Opposer Nautica Apparel, Inc.

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Amended Notice of Opposition was forwarded by first class postage prepaid mail by depositing the same with the U.S. Postal Service on this 31st day of January, 2011 to the attorney for the Applicant at the following address:

Carl Oppedahl, Esq.
Oppedahl Patent Law Firm LLC
P O Box 5940
Dillon CO 80435-5940

/ Linda Kurth/
Linda Kurth