

ESTTA Tracking number: **ESTTA413124**

Filing date: **06/07/2011**

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	L.A. Gear, Inc.		
Entity	Corporation	Citizenship	California
Address	844 Moraga Drive Los Angeles, CA 90049 UNITED STATES		

Attorney information	Susan L. Heller Greenberg Traurig, LLP 2450 Colorado Ave., Suite 400E Santa Monica, CA 90404 UNITED STATES latm2@gtlaw.com Phone:3105867700		
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Applicant Information

Application No	85188855	Publication date	05/10/2011
Opposition Filing Date	06/07/2011	Opposition Period Ends	06/09/2011
Applicant	D.Rose Store Inc. 1018 Wall St Los Angeles, CA 90015 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, capri pants, capri, coats of denim, denim jackets, denims, jackets, pants, shirts, shorts, vests, jogging suits, warm up suits, caps, belts, socks, shoes, t-shirts
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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.	3844628	Application Date	02/01/2010
Registration Date	09/07/2010	Foreign Priority Date	NONE
Word Mark	LA		

Design Mark	
Description of Mark	The mark consists of "L" with a stylized "A".
Goods/Services	Class 025. First use: First Use: 1992/02/03 First Use In Commerce: 1992/02/03 Footwear

U.S. Registration No.	2160298	Application Date	03/31/1997
Registration Date	05/26/1998	Foreign Priority Date	NONE
Word Mark	LA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 footwear[and apparel products for men, women and children] , namely, shoes [, boots, pants, shorts, shirts, blouses, skirts, jackets, overalls, warm-up suits, sweatshirts, socks, hats, leotards, and tights]		

Attachments	77925036#TMSN.jpeg (1 page)(bytes) 75266551#TMSN.gif (1 page)(bytes) notice of opp.pdf (9 pages)(132589 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	/slh/
Name	Susan L. Heller

Date	06/07/2011
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 85/188,855

For the mark 
Published in the *Official Gazette* on May 10, 2011

L.A. Gear, Inc., a California corporation,

Opposer,

vs.

D.Rose Store Inc., a California corporation,

Applicant.

Opposition No. _____

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

1. Opposer L.A. Gear, Inc. (“Opposer”) is a California corporation located at 844 Moraga Drive, Los Angeles, California 90049.

2. Opposer believes that it will be damaged if the above-referenced mark is registered, and hereby opposes the registration.

3. Upon information and belief, Applicant D.Rose Store Inc. (“Applicant”) is a California corporation located at 1018 Wall Street, Los Angeles, California 90015.

4. Opposer owns a number of marks, including, without limitation, the well known

and famous marks  and  (“LA Marks”). Opposer has used the LA Marks in commerce in the United States on or in connection with footwear and clothing since at least as early as February 3, 1992.

5. In addition to the LA Marks, Opposer owns a family of marks that incorporate “L.A.” and “LA” with other words and/or symbols (“LA Family Marks”), which are used on or in connection with footwear and clothing. For example, Opposer owns the well known and famous mark L.A. GEAR, which Opponent has used in commerce since at least as early as 1982.

6. In addition to its common law rights, Opposer owns U.S. Federal registrations for the LA Marks, Registration No. 3844628 for “footwear” in International Class 25 and Registration No. 2160298 for “footwear, namely, shoes” in International Class 25. Opposer’s Registration No. 2160298 has attained incontestable status.

7. Opposer also owns numerous registrations for the LA Family Marks. Attached hereto is Exhibit A, which identifies Opposer’s registrations for the LA Marks and the LA Family Marks, including L.A. GEAR, L.A. GEAR SPORT, LAGEAR.COM, L.A. LIGHTS, L.A. BRAT, L.A. BRAT 442, LA CHEER, L.A. GIRL, L.A. LADY, L.A. RUNNER, L.A.

TECH, L.A. WALKER, SO...L.A., JELLYZ BY L.A. GEAR, 

 and 

8. The U.S. Patent & Trademark Office (“PTO”) has recognized that Opposer’s use of “LA” has acquired distinctiveness and has registered Opposer’s LA Marks under Section 2(f) on the Principal Register without any disclaimers. Further, the PTO has also registered the

“L.A.” and “LA” portion of many of Opposer’s LA Family Marks under Section 2(f) on the Principal Register.

9. Opposer has made significant sales of products under its LA Marks and LA Family Marks in the United States and in many countries throughout the world for many years. Moreover, the products sold under Opposer’s LA Marks and LA Family Marks are and have been extensively advertised and promoted by or on behalf of Opposer.

10. Based on this extensive and prominent use, Opposer’s products and LA Marks and LA Family Marks have achieved fame and represent enormous value and goodwill. Opposer’s LA Marks and LA Family Marks are recognized in the United States and throughout the world in connection with products exclusively associated with Opposer and regarded as an indication that those products originate with or are endorsed, sponsored and/or licensed by Opposer. The imitation and/or unauthorized use of such marks or similar marks will lead to confusion.

11. Based on Opposer’s extensive use, promotion, and advertising of its products and its LA Marks and LA Family Marks, and the substantial sales of the products offered in connection with these marks, the marks are and have become strong, distinctive, and famous in the United States within the meaning of the Lanham Act.

12. Applicant filed for registration of the mark  (“LA and heart design Mark”) on December 2, 2010 for clothing and footwear, identifying “Clothing, namely, capri pants, capri, coats of denim, denim jackets, denims, jackets, pants, shirts, shorts, vests, jogging suits, warm up suits, caps, belts, socks, shoes, t-shirts” in International Class 25. The intent to use application was published for opposition on May 10, 2011, and the time to oppose

expires June 9, 2011. Accordingly, Opposer has timely filed and served this Notice of Opposition before the expiration of the opposition period.

13. Applicant's application for its LA and heart design Mark was filed without Opposer's authorization, consent, or prior knowledge.

14. Opposer's first use of its LA Marks and LA Family Marks predate the first use of, and filing date of, Applicant's application for the LA and heart design Mark.

15. The goods identified in Applicant's application are identical to the goods that Opposer offers in connection with its LA Marks and LA Family Marks, namely clothing and footwear. Furthermore, the parties are both in the apparel and footwear industries and utilize overlapping retail channels of trade.

16. Applicant's LA and hearts design Mark is confusingly similar to Opposer's LA Marks. "LA" is the only word in both Applicant's mark and Opposer's LA Marks. As the only verbal element of the respective marks, it is the only way in which potential customers may refer to these marks. "LA" is clearly the most dominant portion of Applicant's LA and hearts design Mark and Opposer's LA Marks, and when a mark comprises both a word and a design the word is typically accorded greater weight because it is what purchasers use to request the goods. Moreover, Applicant's mark imitates Opposer's well-known LA Marks and merely adds a few faint heart designs. Furthermore, Applicant's mark clearly plays off the fame of Opposer's distinctive LA Marks by similarly using fanciful letters to achieve a similar commercial impression. Given the similarities, as well as the fame of Opposer's LA Marks, consumers viewing Applicant's LA and hearts design Mark are likely to be confused as to source and to perceive an association with Opposer.

17. Opposer has built up strong brand recognition in its LA Marks and LA Family Marks and the PTO has recognized this brand strength by acknowledging that the terms "L.A."

and “LA” have acquired secondary meaning as a source identifier of Opposer’s clothing and footwear. Given Opposer’s well-known image and recognition in the apparel and footwear industries, it is likely that consumers will view Applicant’s mark as a mere extension of Opposer’s famous brand. As such, it is likely that consumers will mistakenly believe that Applicant’s mark is connected to or associated with Opposer, or that Opposer has, to some degree, sponsored or endorsed Applicant’s goods. Accordingly, Applicant’s mark is likely to cause confusion, mistake and/or deception among the consuming public regarding the source, affiliation and/or sponsorship of Applicant’s goods.

18. In addition, because of the fame acquired by Opposer’s LA Marks and LA Family Marks, registration of Applicant’s mark will dilute the value and distinctive quality of Opposer’s marks.

19. The registration of Applicant’s mark for the goods identified in the instant application would be inconsistent with Opposer’s rights in its LA Marks and LA Family Marks, and will cause damage to Opposer and its rights in the same.

20. By virtue of the foregoing, Applicant's application should be rejected, and registration of  as a trademark in Applicant's name should be denied and refused.

Submitted herewith is the amount of \$300.00 representing the required filing fee paid by deposit account. Authorization is hereby provided to charge any deficiency to Deposit Account 50-2638.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Dated: June 7, 2011

By:  _____

Susan L. Heller
2450 Colorado Avenue, Suite 400E
Santa Monica, CA 90404
Tel: (310) 586-6568
Fax: (310) 586-0568
hellers@gtlaw.com

Attorneys for L.A. Gear, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant by depositing one copy thereof in the United States Mail, first-class postage prepaid, on June 7, 2011, addressed as follows:

Christopher Ditico
Raj Abhyanker, P.C.
Suite 8
1580, W. El Camino Real
Mountain View CA 94040



Grace Linker
Sr. Trademark Paralegal

EXHIBIT A

MARK	CLASS: GOODS	APP. NO. FILING DATE	REG. NO. REG. DATE
	25: Footwear.	77925036 01-Feb-2010	3844628 07-Sep-2010
	25: Footwear, namely shoes	75/266,551 31-Mar-1997	2160298 26-May-1998
	25: Footwear and apparel products for men, women and children; namely, shoes, pants, shorts, shirts, blouses, jackets, overalls, warm-up suits, socks, hats, leotards and tights	74/270,774 30-Apr-1992	1815958 11-Jan-1994
	25: Footwear; apparel; namely, pants, dresses, shorts, skirts, shirts, blouses, jackets, socks, hats, leotards and tights.	74/103,547 05-Oct-1990	1856290 27-Sep-1994
L.A. GEAR	9: Eyewear, namely eyeglasses, sunglasses, and reading glasses	78/326,235 11-Nov-2003	3163405 24-Oct-2006
L.A. GEAR	16: Stationery portfolios, note books, memo pads, writing pads, stationery	74/270,767 30-Apr-1992	1748439 26-Jan-1993
L.A. GEAR	18: Bags; namely, gym bags, backpacks, duffle bags, tote bags, and overnight bags	74/218,966 04-Nov-1991	1813728 28-Dec-1993
L.A. GEAR	25: Shoes, shirts, skirts, shorts, pants, dresses, jackets and jumpsuits	73/408,426 07-Jan-1983	1325941 19-Mar-1985
L.A. GEAR SPORT	25: Footwear.	75/739,493 29-Jun-1999	2769442 30-Sep-2003
LAGEAR.COM	25: Footwear 35: On-line retail store services featuring footwear	76/670,303 13-Dec-2006	3315339 23-Oct-2007
L.A. BRAT	25: Footwear.	76/457,538 10-Oct-2002	2831405 13-Apr-2004

MARK	CLASS: GOODS	APP. NO. FILING DATE	REG. NO. REG. DATE
LA BRAT 442	25: Footwear.	76/446,257 03-Sep-2002	2820760 09-Mar-2004
LA CHEER	25: Footwear.	77/334,617 20-Nov-2007	3609673 21-Apr-2009
L.A. GIRL	25: Footwear.	76/514,815 16-May-2003	3418787 29-Apr-2008
L.A. LADY	25: Footwear.	78/291,025 22-Aug-2003	2962622 14-Jun-2005
L.A. RUNNER	25: Footwear.	77/459,943 28-Apr-2008	3620645 12-May-2009
L.A. TECH	25: Footwear.	77/505,901 23-Jun-2008	3818995 13-Jul-2010
L.A. TECH	25: Footwear and apparel products for men, women and children; namely, shoes, pants, shorts, shirts, blouses, jackets, socks, hats, leotards and tights	74221235 12-Nov-1991	1779716 29-Jun-1993
L.A. WALKER	25: Footwear.	78/804,251 01-Feb-2006	3593134 17-Mar-2009
SO...L.A.	25: Shoes.	74/802,343 16-Nov-1992	1909357 01-Aug-1995
JELLYZ BY L.A. GEAR	25: Footwear.	77/138,944 23-Mar-2007	3387901 26-Feb-2008
	25: Clothing, namely pants, shorts, shirts, jackets, socks, legwarmers, tights, leotards, skirts, blouses, overalls, jumpsuits, caps, visors and headbands.	73/826,956 22-Sep-1989	1614968 25-Sep-1990
L.A. LIGHTS	25: Footwear products for men, women and children; namely, shoes.	74/393,748 24-May-1993	1822900 22-Feb-1994