

ESTTA Tracking number: **ESTTA461708**

Filing date: **03/14/2012**

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	Beacon Footwear, Inc.
Granted to Date of previous extension	03/14/2012
Address	2208 Edge Wood Manor Lane Wildwood, MO 63011 UNITED STATES

Attorney information	SCOTT A. SMITH POLSTER LIEDER WOODRUFF & LUCCHESI LC 12412 POWERSOURT DRIVE SUITE 200 ST LOUIS, MO 63131 UNITED STATES trademarks@patpro.com Phone:314-238-2400
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### Applicant Information

Application No	85357153	Publication date	11/15/2011
Opposition Filing Date	03/14/2012	Opposition Period Ends	03/14/2012
Applicant	NICOLA, LLC PO Box 16254 Savannah, GA 31416 UNITED STATES		

### Goods/Services Affected by Opposition

Class 035. All goods and services in the class are opposed, namely: Retail store and on-line retail store services featuring shoes, comfort shoes, footwear, and footwear accessories
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### 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. Application No.	85375920	Application Date	07/20/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SENSIBLE SOLES		

Design Mark	<b>SENSIBLE SOLES</b>
Description of Mark	NONE
Goods/Services	Class 025. First use: Shoes

Attachments	85375920#TMSN.jpeg ( 1 page )( bytes ) BSCI_Not_opp.pdf ( 4 pages )(17227 bytes ) Sensible Soles 1.pdf ( 1 page )(5051622 bytes ) Sensible Soles 2.pdf ( 1 page )(2446672 bytes ) Sensible Soles 3.pdf ( 1 page )(955194 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	/scott a. smith/
Name	SCOTT A. SMITH
Date	03/14/2012

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

**Trademark: SENSIBLE SHOES**  
**Serial No.: 85/357153**  
**Publication Date: November 15, 2011**

**BEACON FOOTWEAR, INC.**

**Opposer,**

**vs.**

**NICOLA, LLC**

**Applicant.**

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**Notice of Opposition**

**Opposition No.** \_\_\_\_\_

Commissioner of Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
Attn: Trademark Trial & Appeal Board

**NOTICE OF OPPOSITION**

Beacon Footwear, Inc., (“Opposer”) a Missouri corporation located and doing business at 2208 Edgewood Manor Lane, Wildwood, Missouri 63011, believes that it will be damaged by registration of the trademark SENSIBLE SOLES shown in Serial No. 85/357153, filed June 27, 2011, by, Nicola, LLC (“Applicant”) a Georgia limited liability company, and hereby opposes the same.

As ground of opposition, it is alleged that:

1. Applicant’s proposed mark was published for opposition on November 15, 2011. Opposer filed, and the Board approved extensions of time to oppose Applicant’s mark until March 14, 2012. This Notice of Opposition is timely filed.

2. Opposer is now and has been for a number of years last past engaged in the manufacture and sale of shoes for women and is the owner of at least nine federal trademark registrations for shoes in Class 25.

3. Opposer adopted and used the trademark "SENSIBLE SOLES" in said business prior to June 27, 2011, the claimed filing date for applicant's mark and Opposer is now using said trademark.

4. Opposer adopted and used, and continues to use its trademark, SENSIBLE SOLES, to identify its diverse products including those especially directed at the ladies footwear market as exemplified in the annexed Exhibits 1, 2 and 3.

5. Opposer has established common law trademark rights in its distinctive trademark SENSIBLE SOLES through Opposer's long and uninterrupted use of the trademark in connection with the marketing, manufacturing and/or sale of Opposer's products, namely ladies footwear.

6. Applicant, filed Application Serial No. 85/357153 on June 27, 2011 for Retail store and on-line retail store services featuring shoes, comfort shoes, footwear, and footwear accessories and said application was published in the Official Gazette of November 15, 2011, on page TM 549.

7. It is opposer's understanding that applicant, Nicola, LLC, claims no actual use for the mark SENSIBLE SOLES.

8. The goods recited in applicant's said application and the goods upon which Opposer uses its trademark are substantially identical in use and are goods of the same class and will be sold side by side in retail establishments and will be advertised in the same channels of trade.

9. The goods marketed by Opposer in association with its trademark SENSIBLE SOLES will be sold through the same channels of commerce and to the same purchasers as the goods of applicant bearing the alleged trademark SENSIBLE SOLES.

10. The SENSIBLE SOLES trademark of Applicant, as applied to the goods of Applicant set forth in its application, is identical with the trademark SENSIBLE SOLES of Opposer, as applied to goods of Opposer, as to cause confusion or cause mistake, or to deceive.

11. An application for the trademark SENSIBLE SOLES was filed by Opposer, Beacon Footwear, Inc. on July 20, 2011.

12. Prior to filing its application, Beacon Footwear conducted a search which was reported to Opposer's President, Robert Tucker on June 7, 2011. No application or registration was found which would have presented an obstacle to registration of SENSIBLE SOLE by Beacon Footwear, Inc.

13. Prior to authorizing the search, Beacon Footwear, Inc. had taken the following steps to use the mark SENSIBLE SOLE.

14. Contacted a customer in the state of Georgia to ascertain whether there was any interest in a program featuring the trademark SENSIBLE SOLE.

15. In view of the positive response from the customer, Beacon Footwear, Inc. authorized its trademark attorney, Ronald W. Hind, to file an application to register the trademark SENSIBLE SOLE and a trademark application was duly filed on July 20, 2011.

16. A request to a manufacturer to produce three specimen shoes bearing the trademark SENSIBLE SOLES was duly made and three photographs were taken on or about November 21, 2011 and copies thereof bearing the trademark SENSIBLE SOLES are enclosed as Exhibits 1, 2, and 3.

17. Based upon the foregoing, the registration of the mark depicted in Application Serial No. 85/357153 filed June 27, 2011 on the Principal Register of the United States Patent and Trademark Office, will cause injury and damage to Opposer.

**WHEREFORE**, Opposer requests that registration of Applicant's mark SENSIBLE SOLES, Application No. 85/357153 be denied and this opposition be sustained.

Opposer hereby appoints Scott A. Smith (U.S. Pat. Off. Reg. No. 46,067) of St. Louis, Missouri, its attorneys in the matter of the above-identified opposition, to prosecute said opposition, to transact all business with the Patent and Trademark Office and the United States courts connected with this opposition and to sign its name to all papers which may hereafter be filed in connection with the said opposition, and to receive the official communications relating to same.

Beacon Footwear Corporation

Date: March 14, 2012

By  /Scott A. Smith/  
Scott A. Smith

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