

ESTTA Tracking number: **ESTTA471628**

Filing date: **05/09/2012**

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 | Zumiez Inc. | | |
| Entity | Corporation | Citizenship | WA |
| Address | 6300 Merrill Creek Parkway, Suite B Everett, WA 98203-5862 UNITED STATES | | |

| | | | |
|----------------------|---|--|--|
| Attorney information | Pam K. Jacobson Christensen O'Connor Johnson Kindness PLLC 1420 Fifth Avenue, Suite 2800 Seattle, WA 98101 UNITED STATES pam.jacobson@cojk.com, kathi.milner@cojk.com, litdoc@cojk.com Phone:206.682.8100 | | |
|----------------------|---|--|--|

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 85457457 | Publication date | 04/10/2012 |
| Opposition Filing Date | 05/09/2012 | Opposition Period Ends | 05/10/2012 |
| Applicant | Jeremie Bitton 18 chemin Baronscourt Hampstead, H3X1H1 CANADA | | |

Goods/Services Affected by Opposition

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|---|
| Class 025. All goods and services in the class are opposed, namely: Clothing, namely pants, shorts, skirts, dresses, t-shirts, sweatshirts, jackets, coats, hats, caps |
|---|

Grounds for Opposition

| | |
|--------------------------------------|----------------------------|
| False suggestion of a connection | Trademark Act section 2(a) |
| Priority and likelihood of confusion | Trademark Act section 2(d) |

Mark Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3418244 | Application Date | 05/25/2005 |
| Registration Date | 04/29/2008 | Foreign Priority Date | NONE |
| Word Mark | EMPYRE | | |

| | |
|---------------------|--|
| Design Mark | <h1>EMPYRE</h1> |
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 1999/05/22 First Use In Commerce: 1999/05/22 clothing, namely, T-shirts, shorts, pants, shirts, hats, jackets and socks Class 028. First use: First Use: 1999/05/06 First Use In Commerce: 1999/05/06 sporting goods, namely, skateboard decks and parts |

| | |
|-------------|---|
| Attachments | 78636888#TMSN.jpeg (1 page)(bytes) 3532 Notice of Opposition.pdf (14 pages)(584578 bytes) |
|-------------|---|

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 | /Pam K. Jacobson/ |
| Name | Pam K. Jacobson |
| Date | 05/09/2012 |

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

4 Applicant: Jeremie Bitton International Class: 25
5 Serial No.: 85/457,457 Published for Opposition: April 10, 2012
6 Filed: October 27, 2011
7 Mark: M P I R E (Stylized/Design) Attorney Docket No.: ZUMI-6-3532
8 Goods: Clothing, namely pants, shorts, skirts, dresses, t-shirts, sweatshirts, jackets, coats,
9 hats, caps.

10 Zumiez Inc.,

11 Opposer,

12 v.

13 Jeremie Bitton,

14 Applicant.

No.

NOTICE OF OPPOSITION

15 TO THE COMMISSIONER FOR TRADEMARKS
16 TRADEMARK TRIAL AND APPEAL BOARD:

17 Zumiez, Inc. (hereinafter "Opposer"), a Washington corporation with a principal place
18 of business at 6300 Merrill Creek Parkway, Suite B, Everett, Washington, United States,
19 98203-5862, believes that it will be damaged by registration of the mark M P I R E
20 (Stylized/Design) shown in Application Serial No. 85/457,457, and hereby opposes the
21 aforementioned application and requests that registration to Applicant be refused. As grounds
22 for the opposition, Opposer alleges as follows.

23 1. On information and belief, Jeremie Bitton (hereinafter "Applicant") is an
24 individual, having an address of 18 chemin Baronscourt, Hampstead, Canada H3X1H1.

25 2. On information and belief, Applicant is the record owner of U.S. Trademark
26 Application Serial No. 85/457,457, filed October 27, 2011, for the mark M P I R E
27 (Stylized/Design) for "clothing, namely pants, shorts, skirts, dresses, t-shirts, sweatshirts,

1 jackets, coats, hats, caps," in International Class 25. U.S. Trademark Application Serial
2 No. 85/457,457 is attached as Exhibit A.

3 3. Based on the information in U.S. Trademark Application Serial
4 No. 85/457,457, Applicant has not yet started using the mark.

5 4. Since at least as early as May 6, 1999, Opposer has adopted, used, and
6 continues to use the mark EMPYRE in commerce in the United States in association with
7 clothing, including T-shirts, shorts, pants, shirts, hats, jackets and socks.

8 5. Opposer is the owner of U.S. Trademark Registration No. 3,418,244 for the
9 mark EMPYRE, for "clothing, namely, T-shirts, shorts, pants, shirts, hats, jackets and socks"
10 in International Class 25 and "sporting goods, namely, skateboard decks and parts" in
11 International Class 28 in the United States. Said registration issued April 29, 2008 and is
12 attached as Exhibit B.

13 6. On information and belief, Applicant's likely customers and channels of trade
14 overlap with those of Opposer.

15 7. On information and belief, Applicant uses or will use channels of trade highly
16 similar, if not identical, to Opposer's channels of trade, to sell its M P I R E (Stylized/Design)
17 product.

18 8. The mark M P I R E (Stylized/Design), shown in Application Serial
19 No. 85/457,457, so resembles Opposer's mark, shown in U.S. Trademark Registration
20 No. 3,418,244, in sight, sound, and commercial impression, as to be likely, when used in
21 association with the goods claimed by Application Serial No. 85/457,457, to cause confusion,
22 or to cause mistake, or to deceive within the meaning and in violation of Section 2(d) of the
23 Lanham Act, 15 U.S.C. § 1052(d).

24 9. The mark M P I R E (Stylized/Design), shown in Application Serial
25 No. 85/457,457, so resembles Opposer's mark, shown in U.S. Trademark Registration
26 No. 3,418,244, as to falsely suggest a connection with Opposer, when applied to the goods of
27

1 Applicant, within the meaning and in violation of Section 2(a) of the Lanham Act,
2 15 U.S.C. § 1052(a).

3 10. Opposer will be damaged by the registration sought by Applicant insofar as the
4 registration will be *prima facie* evidence of the validity of the registration, Applicant's
5 ownership of the mark M P I R E (Stylized/Design), for the goods claimed by Application
6 Serial No. 85/457,457, and Applicant's exclusive right to use the mark M P I R E
7 (Stylized/Design), in association with the goods claimed by Application Serial
8 No. 85/457,457 when, in fact, Applicant is not entitled to the full scope of such rights by
9 virtue of Opposer's prior and continuous use of the EMPYRE mark shown in U.S. Trademark
10 Registration No. 3,418,244.

11 11. Based upon the foregoing, registration of the mark M P I R E (Stylized/Design)
12 shown by Application Serial No. 85/457,457, filed October 27, 2011, is likely to cause injury
13 and damage to Opposer.

14 WHEREFORE, Opposer respectfully requests that registration of the mark M P I R E
15 (Stylized/Design) as shown by Application Serial No. 85/457,457 be denied under
16 Sections 2(a) and 2(d) of the Lanham Act, 15 U.S.C. §§ 1052(a) and 1052(d), and that this
17 Opposition be sustained.

18 Please charge the filing fee of US \$300.00 to Deposit Account No. 03-1740 of
19 Opposer's counsel noted below.

20 Please direct all correspondence to Pam K. Jacobson of Christensen O'Connor Johnson
21 Kindness PLLC at the following address:

22 Pam K. Jacobson, Esq.
23 Christensen O'Connor Johnson Kindness^{PLLC}
24 1420 5th Avenue, Suite 2800
25 Seattle, Washington 98101

26 Please direct all telephone calls to Pam K. Jacobson at 206-682-8100.
27

1 Dated this 9th day of May, 2012.
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4 CHRISTENSEN O'CONNOR
5 JOHNSON KINDNESS^{PLLC}
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Pam K. Jacobson
Attorney for Opposer Zumiez Inc.

CERTIFICATE OF FILING

I hereby certify that on May 9, 2012, the foregoing NOTICE OF OPPOSITION is being electronically filed with the Trademark Trial and Appeal Board using the ESTTA filing system of the U.S. Patent and Trademark Office.

May 9, 2012 Kath E. Milner

CERTIFICATE OF SERVICE

I hereby certify that on May 9, 2012, I served a true and correct copy of the foregoing NOTICE OF OPPOSITION via Air Mail, to the Applicant at:

Jeremie Bitton
18 chemin Baronscourt
Hampstead H3X1H1
Canada

May 9, 2012 Kath E. Milner

EXHIBIT A

Trademark/Service Mark Application, Principal Register

Serial Number: 85457457

Filing Date: 10/27/2011

The table below presents the data as entered.

| Input Field | Entered |
|---|--|
| SERIAL NUMBER | 85457457 |
| MARK INFORMATION | |
| *MARK | <u>\\TICRS\EXPORT11\IMAGEOUT 11\854\574\85457457\xml1\ APP0002.JPG</u> |
| SPECIAL FORM | YES |
| USPTO-GENERATED IMAGE | NO |
| LITERAL ELEMENT | M-PIRE |
| COLOR MARK | NO |
| *DESCRIPTION OF THE MARK (and Color Location, if applicable) | The mark consists of the term M-PIRE with a stylized letter 'M'. |
| PIXEL COUNT ACCEPTABLE | YES |
| PIXEL COUNT | 570 x 447 |
| REGISTER | Principal |
| APPLICANT INFORMATION | |
| *OWNER OF MARK | Jeremie Bitton |
| *STREET | 18 chemin Baronscourt |
| *CITY | Hampstead |
| *COUNTRY | Canada |
| *ZIP/POSTAL CODE (Required for U.S. applicants only) | H3X1H1 |
| PHONE | 514-388-3551 |
| EMAIL ADDRESS | akotras@buffalojeans.com |
| AUTHORIZED TO COMMUNICATE VIA EMAIL | Yes |
| LEGAL ENTITY INFORMATION | |

| | |
|--|--|
| TYPE | individual |
| COUNTRY OF CITIZENSHIP | Canada |
| GOODS AND/OR SERVICES AND BASIS INFORMATION | |
| INTERNATIONAL CLASS | 025 |
| *IDENTIFICATION | Clothing, namely pants, shorts, skirts, dresses, t-shirts, sweatshirts, jackets, coats, hats, caps |
| FILING BASIS | SECTION 1(b) |
| CORRESPONDENCE INFORMATION | |
| NAME | Jeremie Bitton |
| STREET | 18 chemin Baronscourt |
| CITY | Hampstead |
| COUNTRY | Canada |
| ZIP/POSTAL CODE | H3X1H1 |
| PHONE | 514-388-3551 |
| EMAIL ADDRESS | akotras@buffalojeans.com |
| AUTHORIZED TO COMMUNICATE VIA EMAIL | Yes |
| FEE INFORMATION | |
| NUMBER OF CLASSES | 1 |
| FEE PER CLASS | 325 |
| *TOTAL FEE DUE | 325 |
| *TOTAL FEE PAID | 325 |
| SIGNATURE INFORMATION | |
| SIGNATURE | /Jeremie Bitton/ |
| SIGNATORY'S NAME | Jeremie Bitton |
| SIGNATORY'S POSITION | Owner |
| DATE SIGNED | 10/27/2011 |

Trademark/Service Mark Application, Principal Register

Serial Number: 85457457

Filing Date: 10/27/2011

To the Commissioner for Trademarks:

MARK: M-PIRE (stylized and/or with design, see mark)

The literal element of the mark consists of M-PIRE.

The applicant is not claiming color as a feature of the mark. The mark consists of the term M-PIRE with a stylized letter 'M'.

The applicant, Jeremie Bitton, a citizen of Canada, having an address of

18 chemin Baronscourt
Hampstead H3X1H1
Canada

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 025: Clothing, namely pants, shorts, skirts, dresses, t-shirts, sweatshirts, jackets, coats, hats, caps

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant's current Correspondence Information:

Jeremie Bitton
18 chemin Baronscourt
Hampstead H3X1H1, Canada
514-388-3551(phone)
akotras@buffalojeans.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to

be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Jeremie Bitton/ Date Signed: 10/27/2011

Signatory's Name: Jeremie Bitton

Signatory's Position: Owner

RAM Sale Number: 8821

RAM Accounting Date: 10/27/2011

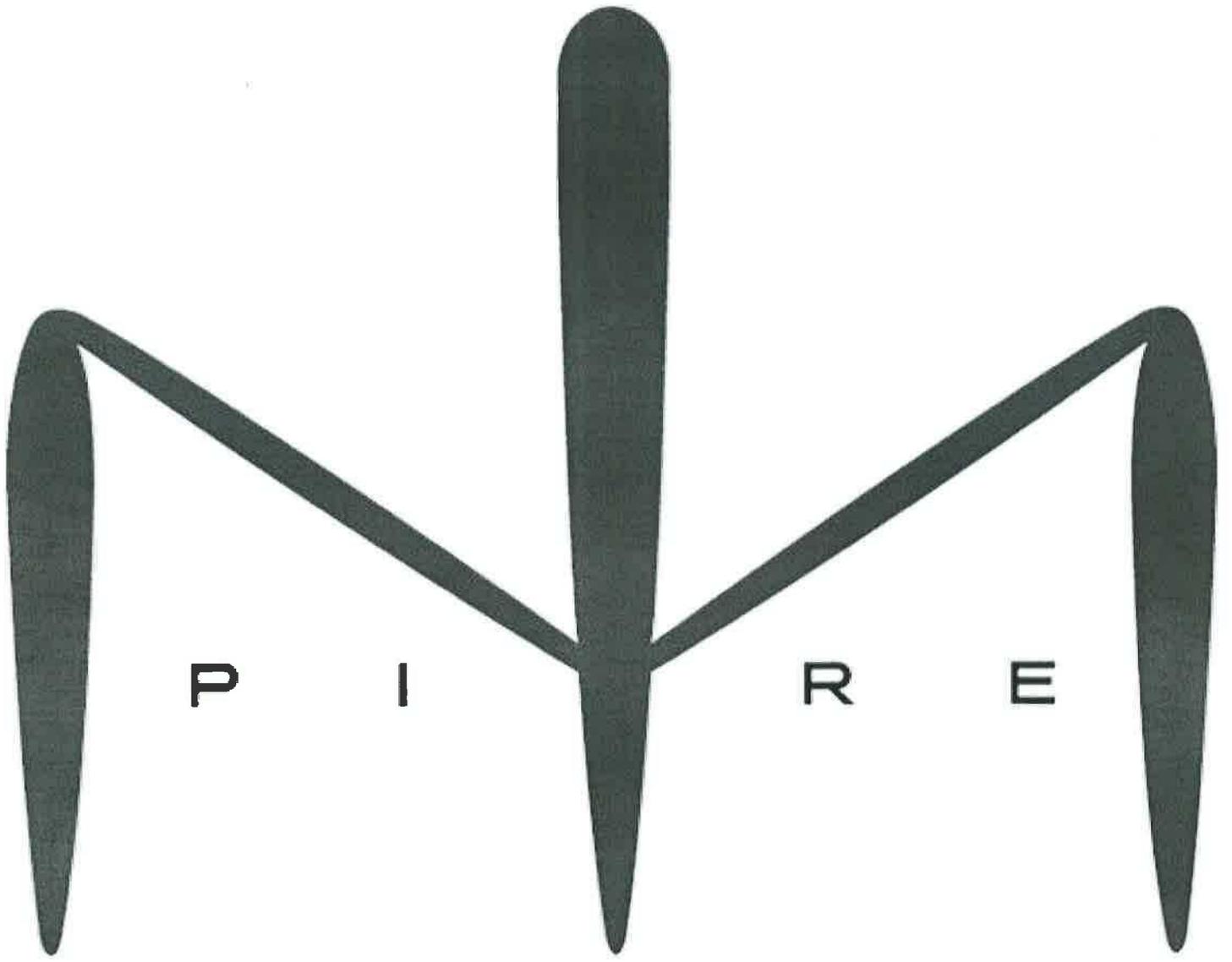
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Internet Transmission Date: Thu Oct 27 10:09:38 EDT 2011

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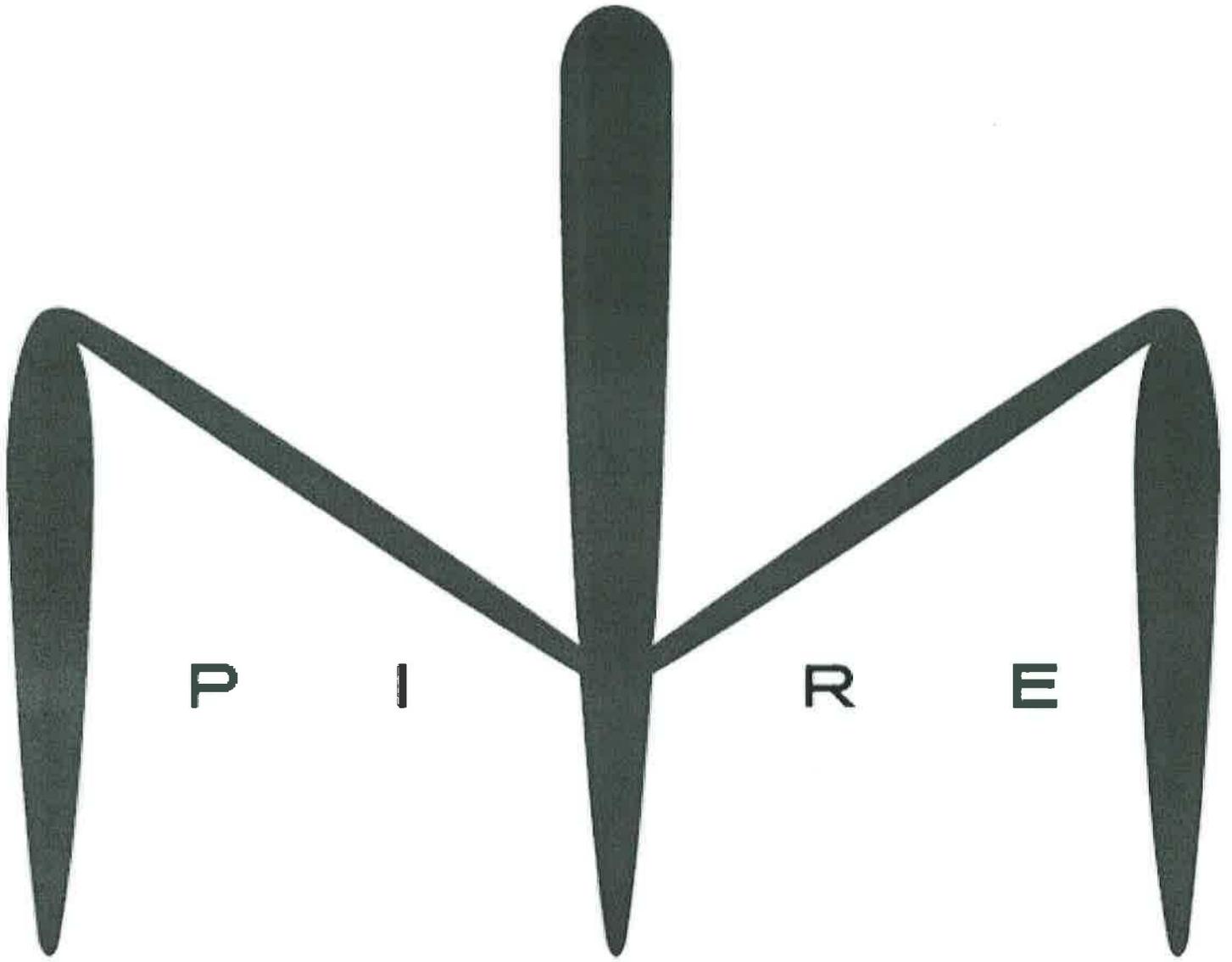


EXHIBIT B

Int. Cls.: 25 and 28

Prior U.S. Cls.: 22, 23, 38, 39 and 50

Reg. No. 3,418,244

United States Patent and Trademark Office

Registered Apr. 29, 2008

TRADEMARK
PRINCIPAL REGISTER

EMPYRE

ZUMIEZ INC. (WASHINGTON CORPORATION)
6300 MERRILL CREEK PARKWAY, SUITE B
EVERETT, WA 982035862

FIRST USE 5-6-1999; IN COMMERCE 5-6-1999.

FOR: CLOTHING, NAMELY, T-SHIRTS, SHORTS,
PANTS, SHIRTS, HATS, JACKETS AND SOCKS, IN
CLASS 25 (U.S. CLS. 22 AND 39).

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

FIRST USE 5-22-1999; IN COMMERCE 5-22-1999.

SER. NO. 78-636,888, FILED 5-25-2005.

FOR: SPORTING GOODS, NAMELY, SKATE-
BOARD DECKS AND PARTS, IN CLASS 28 (U.S.
CLS. 22, 23, 38 AND 50).

ESTHER A. BORSUK, EXAMINING ATTORNEY