

ESTTA Tracking number: **ESTTA474241**

Filing date: **05/24/2012**

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         | Academy, Ltd.   |             |       |
| Entity       | Partnership   | Citizenship | Texas |
| Composed Of: | Academy Managing Co., L.L.C., a Texas limited liability company |             |       |
| Address      | 1800 North Mason Road<br>Katy, TX 77449<br>UNITED STATES        |             |       |

|                      |   |
|----------------------|---|
| Attorney information | Wendy C. Larson<br>Pirkey Barber LLP<br>600 Congress Ave., Suite 2120<br>Austin, TX 78701<br>UNITED STATES<br>wlarson@pirkeybarber.com, bbarber@pirkeybarber.com,<br>eolson@pirkeybarber.com, tmcentral@pirkeybarber.com Phone:512.322.5200 |
|----------------------|---|

### Applicant Information

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 85319771  | Publication date       | 05/01/2012 |
| Opposition Filing Date | 05/24/2012  | Opposition Period Ends | 05/31/2012 |
| Applicants             | Lumbang, Philip<br>407 S. Park View Street<br>Los Angeles, CA 90057<br>UNITED STATES<br><br>Domondon, Christopher Jay<br>8236 Gwinhurst Circle<br>Sacramento, CA 95828<br>UNITED STATES |                        |            |

### Goods/Services Affected by Opposition

|   |
|---|
| Class 025. First Use: 2011/05/01 First Use In Commerce: 2011/05/01<br>All goods and services in the class are opposed, namely: A-shirts; Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Baselayer tops; Body shirts; Button down shirts; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Collared shirts; Dress shirts; Fleece tops; Halter tops; Hooded sweat shirts; Knit shirts; Knit tops; Long-sleeved shirts; Muscle tops; Open-necked shirts; Pique shirts; Polo knit tops; Polo shirts; Rugby shirts; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sweat shirts; T-shirts; Tank tops; Tank-tops; Tee shirts; Tops; Tube tops; Woven tops |
|---|

### 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. Application/<br>Registration No. | NONE  | Application Date | NONE |
| Registration Date                     | NONE  |                  |      |
| Design Mark                           |                                      |                  |      |
| Goods/Services                        | retail store services featuring apparel and clothing, among other things, and apparel and clothing, among other things. |                  |      |
| U.S. Application/<br>Registration No. | NONE  | Application Date | NONE |
| Registration Date                     | NONE  |                  |      |

|                |  |
|----------------|--|
| Design Mark    |  <p>The logo features a stylized blue letter 'A' with a red swoosh above it. Below the 'A' is the word 'Academy' in a bold, blue, sans-serif font, followed by a registered trademark symbol (®). Underneath 'Academy' is the phrase 'SPORTS+OUTDOORS' in a smaller, red, all-caps, sans-serif font.</p> |
| Goods/Services | retail store services featuring apparel and clothing, among other things, and apparel and clothing, among other things.  |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1911968  | Application Date      | 04/07/1994 |
| Registration Date     | 08/15/1995   | Foreign Priority Date | NONE       |
| Word Mark             | ACADEMY  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 042. First use: First Use: 1951/00/00 First Use In Commerce: 1951/00/00 retail store services in the field of western wear; hunting, fishing and sporting equipment and outfitting; sporting and athletic equipment, gear and footwear; and outdoor and recreational equipment, outfitting and merchandise |                       |            |

|                       |             |                       |            |
|-----------------------|-------------|-----------------------|------------|
| U.S. Registration No. | 2834786     | Application Date      | 04/04/2000 |
| Registration Date     | 04/20/2004  | Foreign Priority Date | NONE       |
| Word Mark             | ACADEMY.COM |                       |            |

|                     |  |  |  |
|---------------------|--|--|--|
| Design Mark         | <b>ACADEMY.COM</b>   |  |  |
| Description of Mark | NONE   |  |  |
| Goods/Services      | <p>Class 035. First use: First Use: 2003/03/28 First Use In Commerce: 2003/03/28<br/> ONLINE RETAIL STORE SERVICES FEATURING SPORTING GOODS, ATHLETIC EQUIPMENT, APPAREL, AND FOOTWEAR; AND ISSUING GIFT CERTIFICATES WHICH MAY THEN BE REDEEMED FOR GOODS OR SERVICES; AND COMPUTER SERVICES, NAMELY, PROVIDING ONLINE COMPUTER DATABASES FEATURING CONSUMER PRODUCT REVIEWS AND COMPARISONS, AND MERCHANDISE DESCRIPTIONS AND INFORMATION BY MEANS OF A GLOBAL COMPUTER NETWORK</p> <p>Class 041. First use: First Use: 2003/03/28 First Use In Commerce: 2003/03/28<br/> COMPUTER SERVICES, NAMELY PROVIDING INFORMATION ON SPORTS AND OUTDOOR ACTIVITIES VIA A GLOBAL COMPUTER NETWORK</p> |  |  |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3338039   | Application Date      | 11/06/2006 |
| Registration Date     | 11/20/2007  | Foreign Priority Date | NONE       |
| Word Mark             | ACADEMY SPORTS + OUTDOORS   |                       |            |
| Design Mark           | <b>ACADEMY SPORTS + OUTDOORS</b>  |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | <p>Class 035. First use: First Use: 2003/02/06 First Use In Commerce: 2003/02/06<br/> Online retail store services featuring camping, fishing, hiking, hunting, outdoor, and recreational equipment, outfitting, and merchandise; sporting goods and athletic apparel, equipment, gear, and footwear; women's, men's, and youth apparel, footwear, swimwear, beachwear, and beach bags; baby strollers, jogging strollers, motorized scooters, and motorized scooter wheels; all purpose sports bags and luggage; manually operated exercise equipment, namely exercise machines, exercise benches, exercise tables, and weight lifting machines; and issuing gift certificates which may then be redeemed for goods or services; and computer services, namely, providing online computer databases featuring consumer product reviews and comparisons, and merchandise descriptions and information by means of a global computer network; retail store services in the field of camping, fishing, hiking, hunting, outdoor, and recreational equipment, outfitting, and merchandise; sporting goods and athletic apparel, equipment, gear, and footwear; women's, men's, and youth apparel, footwear, swimwear, beachwear, and beach bags; baby strollers, jogging strollers, motorized scooters, and motorized scooter wheels; all purpose sports</p> |                       |            |

|  |  |
|--|--|
|  | <p>bags and luggage; and manually operated exercise equipment, namely exercise machines, exercise benches, exercise tables, and weight lifting machines</p> <p>Class 041. First use: First Use: 2003/02/06 First Use In Commerce: 2003/02/06</p> <p>Computer services, namely providing information on sports and outdoor activities via a global computer network; entertainment in the nature of on-going television programs in the field of hunting and fishing distributed over television and the Internet</p> |
|--|--|

|             |  |
|-------------|--|
| Attachments | <p>Academy A Mark 1.JPG</p> <p>Academy A Mark - stacked 1.JPG</p> <p>76017934#TMSN.gif ( 1 page )( bytes )</p> <p>77037343#TMSN.jpeg ( 1 page )( bytes )</p> <p>Notice of Opposition A AWESOME ACADEMY.pdf ( 8 pages )(85602 bytes )</p> |
|-------------|--|

### 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.

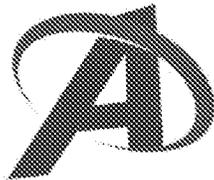
|           |                 |
|-----------|-----------------|
| Signature | /WCL/           |
| Name      | Wendy C. Larson |
| Date      | 05/24/2012      |



operating an extensive website and online retail store at [www.academy.com](http://www.academy.com). Opposer sells a wide array of products in its retail stores, including many types of clothing and apparel.

2. Opposer, through its predecessor in interest, commenced use of the mark ACADEMY for use in connection with the retail sale of sporting goods and apparel at least as early as 1951. Since that time, Opposer, or its predecessor in interest, has continually used the mark ACADEMY in commerce. Opposer has also used the marks ACADEMY.COM, ACADEMY SPORTS + OUTDOORS, as well as other marks that include “ACADEMY” for many years.

3. In connection with its sale of apparel and other sporting goods, Academy has also adopted and has long and continuously used a design mark incorporating the letter “A” encircled by a ring crossing in front of the top of the letter “A” and disappearing behind the bottom of the right side of the letter “A” and behind the middle of the left side of the letter “A,” as pictured directly below (the “Academy A Mark”).



The Academy A Mark is often used in conjunction with one of the other Academy Marks, as shown directly below.



4. Opposer's ACADEMY-formative marks, including ACADEMY, ACADEMY.COM, and ACADEMY SPORTS + OUTDOORS, as well as the Academy A Mark, are collectively referred to herein as the "ACADEMY Marks."

5. Opposer is the owner of U.S. Registration No. 1,911,968 for the mark ACADEMY for "retail store services in the field of western wear; hunting, fishing and sporting equipment and outfitting; sporting and athletic equipment, gear and footwear; and outdoor and recreational equipment, outfitting and merchandise," in International Class 42. This registration issued on August 15, 1995, is valid and subsisting, and is now incontestable.

6. Opposer is also the owner of U.S. Registration No. 2,834,786 for the mark ACADEMY.COM for "online retail store services featuring sporting goods, athletic equipment, apparel, and footwear; and issuing gift certificates which may then be redeemed for goods or services; and computer services, namely, providing online computer databases featuring consumer product reviews and comparisons, and merchandise descriptions and information by means of a global computer network" in International Class 35, and "computer services, namely providing information on sports and outdoor activities via a global computer network" in International Class 41. This registration issued on April 20, 2004, is valid and subsisting, and is now incontestable.

7. Opposer is also the owner of U.S. Registration No. 3,338,039 for the mark ACADEMY SPORTS + OUTDOORS for "Online retail store services featuring camping, fishing, hiking, hunting, outdoor, and recreational equipment, outfitting, and merchandise; sporting goods and athletic apparel, equipment, gear, and footwear; women's, men's, and youth apparel, footwear, swimwear, beachwear, and beach bags; baby strollers, jogging strollers, motorized scooters, and motorized scooter wheels; all purpose sports bags and luggage;

manually operated exercise equipment, namely exercise machines, exercise benches, exercise tables, and weight lifting machines; and issuing gift certificates which may then be redeemed for goods or services; and computer services, namely, providing online computer databases featuring consumer product reviews and comparisons, and merchandise descriptions and information by means of a global computer network; retail store services in the field of camping, fishing, hiking, hunting, outdoor, and recreational equipment, outfitting, and merchandise; sporting goods and athletic apparel, equipment, gear, and footwear; women's, men's, and youth apparel, footwear, swimwear, beachwear, and beach bags; baby strollers, jogging strollers, motorized scooters, and motorized scooter wheels; all purpose sports bags and luggage; and manually operated exercise equipment, namely exercise machines, exercise benches, exercise tables, and weight lifting machines” in International Class 35 and for “Computer services, namely providing information on sports and outdoor activities via a global computer network; entertainment in the nature of on-going television programs in the field of hunting and fishing distributed over television and the Internet” in International Class 41. This registration issued on November 20, 2007 and is valid and subsisting.

8. Opposer’s sales of apparel, including t-shirts, sweatshirts, polo shirts, footwear, hats and caps, pants, shorts, jackets, children’s apparel, and related products in connection with the ACADEMY Marks have been extensive. Moreover, Opposer uses the ACADEMY Marks on apparel. *See, e.g.*, Exhibit 1.

9. Opposer has expended vast resources to promote its ACADEMY Marks.

10. As a result of Opposer’s long usage and extensive promotion, Opposer has developed valuable goodwill and strong common law rights in its ACADEMY Marks.

Moreover, the ACADEMY Marks have become well-known, widely recognized, and famous to consumers.

11. On information and belief, Applicant Philip Lumbang is an individual with an address of 407 S. Park View Street, Los Angeles, California 90057, and Applicant Christopher Jay Domondon is an individual with an address of 8236 Gwinhurst Circle, Sacramento, California 95828 (together, “Applicants”). Applicants seek to register the mark A AWESOME ACADEMY (“Applicants’ Mark”) for “A-shirts; Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Baselayer tops; Body shirts; Button down shirts; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Collared shirts; Dress shirts; Fleece tops; Halter tops; Hooded sweat shirts; Knit shirts; Knit tops; Long-sleeved shirts; Muscle tops; Open-necked shirts; Pique shirts; Polo knit tops; Polo shirts; Rugby shirts; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sweat shirts; T-shirts; Tank tops; Tank-tops; Tee shirts; Tops; Tube tops; Woven tops” in International Class 25. Applicants filed this application on a use-in-commerce basis on May 12, 2011, and the application was assigned Serial No. 85/319,771 (the “Application”). The Application was published for opposition on May 1, 2012.

12. The goods covered by the Application are identical or closely related to those sold through Opposer’s retail outlets operated under Opposer’s ACADEMY Marks.

13. Opposer’s ACADEMY Marks became famous prior to any use by Applicants of Applicants’ Mark.

14. Opposer has priority based on its prior use and registrations of the ACADEMY Marks in the United States.

15. Opposer will be damaged if the Application matures to registration because Applicants' Mark is so similar to Opposer's ACADEMY Marks in sight, sound and meaning, and because Applicants' Mark identifies goods so highly related to those goods and services for which Opposer's ACADEMY Marks are used and/or registered, including many identical or related goods sold through Opposer's retail outlets, that contemporaneous use and registration will create a likelihood of consumer confusion and lead to deception as to source or sponsorship. Therefore, registration should be refused under 15 U.S.C. § 1052(d).

16. Opposer will be damaged if the Application matures to registration because it will cause dilution of the distinctive quality of Opposer's ACADEMY Marks. Therefore, registration should be refused under 15 U.S.C. §§ 1063(a) and 1125(c).

17. Opposer will be damaged if the Application matures to registration because such registration would purport to give Applicants prima facie evidence of the exclusive right to use Applicants' Mark in connection with the goods of the Application which would be inconsistent with Opposer's long use of and right to use its ACADEMY Marks in connection with apparel and the retail sale of the types of apparel for which Applicants seek registration of their mark.

Wherefore, Opposer prays that Application Serial No. 85/319,771 be rejected, and that registration of Applicants' Mark be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber LLP, Account No. 503924/ACAD:862/WGB, if there is any problem with the processing of the electronically submitted fee.

Date: May 24, 2012

/s/ Wendy C. Larson  
William G. Barber  
Wendy C. Larson  
Tyson D. Smith  
PIRKEY BARBER LLP  
600 Congress Avenue, Suite 2120  
Austin, Texas 78701  
(512) 322-5200  
  
Attorneys for Opposer

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing NOTICE OF OPPOSITION was served via First Class Mail, postage pre-paid, upon Applicants' attorney at the address below on May 24, 2012:

Andrew Wang  
2360 Birch Log Way  
Hacienda Heights, CA 91745-5605

/s/ Wendy C. Larson

# EXHIBIT 1

