

ESTTA Tracking number: **ESTTA527873**

Filing date: **03/20/2013**

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	C. & J. Clark International Limited
Granted to Date of previous extension	03/20/2013
Address	40 High Street Street, Somerset, England BA16 0EQ UNITED KINGDOM

Attorney information	Stephen P. McNamara St. Onge Steward Johnston & Reens LLC 986 Bedford Street Stamford, CT 06905-5619 UNITED STATES litigation@ssjr.com, smcnamara@ssjr.com Phone:203-324-6155
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**Applicant Information**

Application No	85648047	Publication date	11/20/2012
Opposition Filing Date	03/20/2013	Opposition Period Ends	03/20/2013
Applicants	Oji-Bertrand, Louis 98-908 Yamashitacho Nakaku Yokohamashi Yokohama, JAPAN  Maeji , Kenjo 98-908 Yamashitacho Nakaku Yokohamashi Yokohama, JAPAN		

**Goods/Services Affected by Opposition**

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, footwear, shoes, headwear, tops, bottoms, shirts, t-shirts, pants, jackets, jeans, neckties, and clothing accessories in the nature of mufflers, wristbands, and suspenders
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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. Registration No.	2942979	Application Date	04/08/2003
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Registration Date	04/19/2005	Foreign Priority Date	NONE
Word Mark	PR!VO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/08/01 First Use In Commerce: 2003/11/01 FOOTWEAR, NAMELY SHOES AND BOOTS; HOSIERY; BELTS		

Attachments	78235013#TMSN.gif ( 1 page )( bytes ) 0032 Notice of Opposition.pdf ( 12 pages )(1197843 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	/spmcmamara/
Name	Stephen P. McNamara
Date	03/20/2013

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

C. & J. Clark International Limited	:		
	:		
Opposer,	:		
v.	:	Opposition No.	
	:	[not yet assigned]	
Kenjo Maeji and Louis Oji-Bertrand,	:		
	:		
Applicants.	:		

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Re U.S. Trademark Application Serial No. 85-648047  
For: PREVO QUANTUM and Design  
By: Kenjo Maeji and Louis Oji-Bertrand  
Filed on: 06/11/2012  
Published: 11/20/2012  
Extension of time to file opposition until 3/20/2013

**NOTICE OF OPPOSITION**

Opposer, C. & J. Clark International Limited, a United Kingdom corporation with a principal place of business at 40 High Street, Street, Somerset, England BA16 0EQ, United Kingdom ("Opposer"), believes it will be damaged by registration of PREVO QUANTUM and Design, U.S. Trademark Application Serial No. 85-648047 in International Class 25 filed by Kenjo Maeji and Louis Oji-Bertrand, both at 98-908 Yamashitacho Nakaku Yokohamashi, Yokohama, Japan ("Applicants") for use on the following goods and services:

(Int'l Class: 25) Clothing, namely, footwear, shoes, headwear, tops, bottoms, shirts, t-shirts, pants, jackets, jeans, neckties, and clothing accessories in the nature of mufflers, wristbands, and suspenders

and hereby opposes registration thereof pursuant to Section 13 of the 1946 Trademark Act (15 U.S.C. §1063), alleging as grounds for opposing the registration of PREVO QUANTUM and Design that:

1. Opposer currently uses the trademark PR!VO in connection with footwear, (hereinafter “Opposer’s Mark”). Opposer’s trademark PR!VO is pronounced “PRIVO” or “PREE-VO.”

2. Opposer is the owner of U.S. Registration No. 2,942,979 for the mark PR!VO (“Opposer’s Registration”) for use in connection with “footwear, namely shoes and boots; hosiery; belts.” A copy of the registration from the USPTO database is attached as Exhibit A and made of record in this proceeding pursuant to Trademark Rule 2.122(d).

3. On June 11, 2012, Applicants filed an application to register the trademark PREVO QUANTUM and Design, which was assigned Application Serial No. 85-648047 by the U.S. Patent and Trademark Office (hereinafter “Applicants’ Mark”).

4. Applicants’ Application Serial No. 85-648047 identifies the following goods: Clothing, namely, footwear, shoes, headwear, tops, bottoms, shirts, t-shirts, pants, jackets, jeans, accessories, and neckties.

5. Opposer’s rights in Opposer’s Mark and Opposer’s Registration are prior in time to any alleged first use or intent to use application by Applicants for Applicants’ Mark.

6. Opposer’s Mark was registered prior to the date of alleged first use or intent to use application by Applicants for Applicants’ Mark.

7. Opposer’s Mark is inherently distinctive, has been used for more than 7 years, and has become famous with respect to goods in International Class 25.

8. In view of the similarities between Opposer’s Mark and Applicants’ Mark and the fact the goods are identical, there is a likelihood that Applicants’ products are likely to be seen as being sponsored by Opposer.

9. Applicants' Mark so resembles Opposer's PR!VO Mark as to be likely to cause confusion, or to cause mistake, or to deceive as to the source of the identified goods within the meaning of Section 2(d) of the Lanham Act.

10. The use and registration of Applicants' Mark will damage Opposer in the selling of its goods and by causing a likelihood of confusion.

WHEREFORE, Opposer prays that the Trademark Trial and Appeal Board deny registration to U.S. Trademark Application Serial No. 85-648047 for the mark PREVO QUANTUM and Design and otherwise sustain this opposition.

Payment in the amount of \$300 is submitted herewith.

**C. & J. CLARK INTERNATIONAL LIMITED,**



March 20, 2013

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Stephen P. McNamara  
ST.ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, CT 06905  
Tel. (203) 324-6155  
Facsimile (203) 327-1096  
Email: [smcnamara@ssjr.com](mailto:smcnamara@ssjr.com); [litigation@ssjr.com](mailto:litigation@ssjr.com)

ATTORNEYS FOR OPPOSER

## EXHIBIT A

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

**United States Patent and Trademark Office**

Reg. No. 2,942,979

Registered Apr. 19, 2005

**TRADEMARK  
PRINCIPAL REGISTER**

**p r ! v o**

C. & J. CLARK INTERNATIONAL LIMITED  
(UNITED KINGDOM CORPORATION)  
40 HIGH STREET  
STREET, SOMERSET, UNITED KINGDOM BA16  
0YA

FIRST USE 8-1-2003; IN COMMERCE 11-1-2003.

SN 78-235,013, FILED 4-8-2003.

FOR: FOOTWEAR, NAMELY SHOES AND  
BOOTS; HOSIERY; BELTS, IN CLASS 25 (U.S. CLS.  
22 AND 39).

BARNEY CHARLON, EXAMINING ATTORNEY



**United States Patent and Trademark Office**

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**p r ! v o**

<b>Word Mark</b>	PRIVO
<b>Goods and Services</b>	IC 025. US 022 039. G & S: FOOTWEAR, NAMELY SHOES AND BOOTS; HOSIERY; BELTS. FIRST USE: 20030801. FIRST USE IN COMMERCE: 20031101
<b>Mark Drawing Code</b>	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
<b>Serial Number</b>	78235013
<b>Filing Date</b>	April 8, 2003
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	May 25, 2004
<b>Registration Number</b>	2942979
<b>Registration Date</b>	April 19, 2005
<b>Owner</b>	(REGISTRANT) C. & J. CLARK INTERNATIONAL LIMITED CORPORATION UNITED KINGDOM 40 HIGH STREET STREET, SOMERSET UNITED KINGDOM BA16 0YA
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Stephen P. McNamara
<b>Type of Mark</b>	TRADEMARK

Register PRINCIPAL  
Affidavit Text SECT 15. SECT 8 (6-YR).  
Live/Dead Indicator LIVE

- 
- TESS HOME
  - NEW USER
  - STRUCTURED
  - FREE FORM
  - BROWSE DICT
  - SEARCH OG
  - TOP
  - HELP
  - PREV LIST
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STATUS DOCUMENTS

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Mark: PRIVO

The logo for the trademark 'pr!vo' is displayed in a large, bold, lowercase font. The letter 'i' is replaced by an exclamation point '!', and the 'o' is a standard lowercase letter.

US Serial Number: 78235013

Application Filing Date: Apr. 08, 2003

Date:

US Registration Number: 2942979

Registration Date: Apr. 19, 2005

Register: Principal

Mark Type: Trademark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: May 07, 2010

Publication Date: May 25, 2004

Notice of Allowance Date: Aug. 17, 2004

Date:

## Mark Information

Mark Literal Elements: PR!VO

Standard Character Claim: No

Claim:

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

## Goods and Services

### Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks \*.\* identify additional (new) wording in the goods/services.

For: FOOTWEAR, NAMELY SHOES AND BOOTS; HOSIERY; BELTS

International Class: 025 - Primary Class

U.S Class: 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 01, 2003

Use in Commerce: Nov. 01, 2003

**Basis Information (Case Level)**

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

**Current Owner(s) Information**

Owner Name: C. & J. CLARK INTERNATIONAL LIMITED

Owner Address: 40 HIGH STREET  
STREET, SOMERSET BA16 0YA  
UNITED KINGDOM

Legal Entity Type: CORPORATION

State or Country UNITED KINGDOM  
Where Organized:

**Attorney/Correspondence Information**

**Attorney of Record**

Attorney Name: Stephen P. McNamara

Docket Number: 00032-T0511A

Attorney Primary [tm-pto@ssjr.com](mailto:tm-pto@ssjr.com)  
Email Address:

Attorney Email Yes  
Authorized:

**Correspondent**

Correspondent Stephen P. McNamara  
Name/Address: ST. ONGE STEWARD JOHNSTON & REENS LLC  
986 BEDFORD STREET  
STAMFORD, CONNECTICUT 06905-5619  
UNITED STATES

Phone: 203-324-6155

Fax: 203-327-1096

Correspondent e-mail: [tm-pto@ssjr.com](mailto:tm-pto@ssjr.com)

Correspondent e-mail Yes  
Authorized:

Domestic Representative - Not Found

**Prosecution History**

Date	Description	Proceeding Number
May 07, 2010	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70619

May 07, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70619
Apr. 26, 2010	TEAS SECTION 8 & 15 RECEIVED	
Apr. 19, 2005	REGISTERED-PRINCIPAL REGISTER	
Jan. 07, 2005	LAW OFFICE REGISTRATION REVIEW COMPLETED	67215
Oct. 22, 2004	ASSIGNED TO LIE	67215
Oct. 18, 2004	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Sep. 28, 2004	ASSIGNED TO EXAMINER	71994
Sep. 27, 2004	STATEMENT OF USE PROCESSING COMPLETE	
Sep. 15, 2004	USE AMENDMENT FILED	
Sep. 15, 2004	TEAS STATEMENT OF USE RECEIVED	
Aug. 17, 2004	NOA MAILED - SOU REQUIRED FROM APPLICANT	
May 25, 2004	PUBLISHED FOR OPPOSITION	
May 05, 2004	NOTICE OF PUBLICATION	
Jun. 04, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Oct. 20, 2003	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 06, 2003	ASSIGNED TO EXAMINER	71994
Jun. 04, 2003	TEAS VOLUNTARY AMENDMENT RECEIVED	

### Maintenance Filings or Post Registration Information

Affidavit of Continued Section 8 - Accepted

Use:

Affidavit of Section 15 - Accepted

Incontestability:

### TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMEG LAW OFFICE 105

Date in Location: May 07, 2010

**Assignment Abstract Of Title Information - Click to Load**

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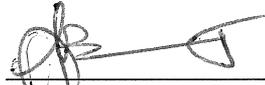
**CERTIFICATE OF SERVICE**

This is to certify that a true copy of the foregoing **NOTICE OF OPPOSITION** is being served by first class mail, postage prepaid on the Correspondent for the Applicants as follows:

Christopher Ditico  
Raj Abhyanker, P.C.  
1580 W El Camino Real STE 8  
Mountain View, CA 94040-2462

March 20, 2013

Date



\_\_\_\_\_  
John M. Burnett