

ESTTA Tracking number: **ESTTA528691**

Filing date: **03/25/2013**

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 parties oppose registration of the indicated application.

**Opposers Information**

Name	Jules Shapiro
Granted to Date of previous extension	03/24/2013
Address	619 Gallier St. New Orleans, LA 70117 UNITED STATES

Name	Juliette Tworsey
Granted to Date of previous extension	03/24/2013
Address	619 Gallier St. New Orleans, LA 70117 UNITED STATES

Attorney information	JOHN E RUSSELL ALLMARK TRADEMARK 2089 AVY AVENUE MENLO PARK, CA 94025 UNITED STATES john@allmarktrademark.com, allmarktrademark@gmail.com, tom@allmarktrademark.com Phone:(650)233-2789
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**Applicant Information**

Application No	85608089	Publication date	09/25/2012
Opposition Filing Date	03/25/2013	Opposition Period Ends	03/24/2013
Applicant	SHOES BY FIREBUG, LLC 14100 Southwest Freeway Suite 360 Sugar Land, TX 77478 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. First Use: 2011/09/27 First Use In Commerce: 2011/09/27  
All goods and services in the class are opposed, namely: Flip flops; Footwear; Shoes

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Prior common law use of the FIREBUG mark for class 25 goods that are related to teh goods

	sought to be registered by Applicant
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2389198	Application Date	11/02/1998
Registration Date	09/26/2000	Foreign Priority Date	NONE
Word Mark	FIRE BUG		
Design Mark	<b>FIRE BUG</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1997/05/01 First Use In Commerce: 1997/07/07 series of musical recordings on [ phonograph records, ] compact discs, [ audio cassettes, digital audio cassettes, video cassettes, CD roms, audio mini-discs and laser discs ] all containing musical entertainment</p> <p>Class 041. First use: First Use: 1997/05/01 First Use In Commerce: 1997/06/11 Entertainment Services, namely live musical performances</p>		

U.S. Application No.	85633416	Application Date	05/23/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FIREBUG		
Design Mark			
Description of Mark	The mark consists of the word 'FIREBUG' in a decorative font, with the letter "F" and "B" in capital letters, and the remaining letters in lower case lettering.		
Goods/Services	Class 025. First use: First Use: 1997/05/01 First Use In Commerce: 1997/05/01 Clothing, namely, t-shirts, shirts, sweatshirts, and hats		

Related Proceedings	TTAB Opposition No. 91209941
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Attachments	75575780#TMSN.gif ( 1 page )( bytes ) 85633416#TMSN.jpeg ( 1 page )( bytes ) notice of opposition against 85608089 FIREBUG tm.pdf ( 5 pages )(660454 bytes )
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	certificate of service for 85608089 notice of opposition.pdf ( 1 page )(88216 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	/Thomas P. Philbrick/
Name	Thomas P. Philbrick
Date	03/25/2013

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

In re Application No. 85608089

Published in the Official Gazette on September 25, 2012

Jules Shapiro and Juliette Tworsey	)
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Opposers,	)
	)
v.	)
	)
Shoes By Firebug, LLC	)
	)
Applicant.	)
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Opposition No. \_\_\_\_\_

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

**NOTICE OF OPPOSITION**

Jules Shapiro and Juliette Tworsey, both individual joint owners and citizens of the United States, with a principal place of business of 619 Gallier St., New Orleans, LA 70117, (“Opposers”) having filed timely extensions of time to oppose, hereby believe that they will be damaged by registration of the mark FIREBUG (stylized words mark) in International Class 25 shown in Application Serial No. 85608089 and hereby oppose the same.

As grounds for opposition, it is alleged that:

1. Shoes by Firebug, LLC (an LLC of the state of Texas) (“Applicant”) is seeking to register the mark FIREBUG(stylized words mark) based on Section 1(a) “in use in commerce”

for “Flip flops; Footwear; Shoes” in International Class 25. (Serial Number 85608089) Said application contains a first use date and use in commerce date allegation of 09/27/2011.

2. Opposers have used the mark FIREBUG in interstate commerce since at least as early as summer 1997 (well before the application filing date of Applicant’s “in use” serial number 85608089) in connection with a musical band services, recorded musical media (since at least as early as summer 1997) and for a variety of clothing items since at least as early as May 1997. Opposers are the owner of U.S. Registration No. 2389198 for the mark FIRE BUG, used in connection with “series of musical recordings on compact discs, all containing musical entertainment,” in International Class 9 and “Entertainment Services, namely live musical performances,” in International Class 41. Said registration is active and in good standing at the USPTO since September 26, 2000, over ten years prior to Applicant’s filing date and pleaded first usage dates in the application that is the subject of this opposition.

3. Opposers are also the owners of U.S. serial number 85633416 for the mark FIREBUG (stylized) filed on May 23, 2012 and used in connection with “Clothing, namely, t-shirts, shirts, sweatshirts, and hats,” in International Class 25. Said application has a pleaded first use and first use in commerce date of May 1, 1997, also over a decade prior to Applicant’s application filing date and pleaded first usage date upon which it might be able to rely.

4. Based on Opposers’ substantial prior interstate use of its FIREBUG family of marks in commerce and resulting goodwill, Opposers believe that they will be damaged by the registration of Serial No. 85608089 as it creates a confusingly similar overall commercial impression, contains confusingly similar stylized wording and is used in connection with closely related, if not identical goods in International Class 25. (footwear items being a type of clothing item that consumers generally expect to travel in related channels to other clothing items) In

addition, Opposers have priority of use over Applicant based on substantial interstate usage many years prior to Applicant's adoption (and alleged use in commerce) of identical and/or confusingly similar FIREBUG related marks.

5. Opposers allege that the USPTO inadvertently approved Applicant's application serial number 85608089 for publication despite the presence of their existing registration in classes 9 and 41 for the same mark. The USPTO routinely cites prior filed musical band and music media marks as Section 2(d) conflicts against clothing applications in class 25 because it is so commonplace for bands and recorded music providers to sell related clothing items promoting their music group. Based on this, the USPTO erred in approving application 85608047 for publication and Applicant knew or should have known that it was pursuing a brand that had already been registered for related goods that travel in similar if not identical channels of trade. Said actions of Applicant have lead to considerable damage to Opposers.

6. On the basis of similarities in appearance and field of usage in International Class 25, Opposers have had Applicant's prior filed class 25 applications cited as potential Section 2(d) "likelihood of confusion" conflicts against Opposer's FIREBUG class 25 application upon examination by the USPTO. In addition to the prior use and registration of their class 41 & 9 registration for related goods, Opposers also have standing to file this opposition as the registration of their FIREBUG mark in Class 25 (as identified in Serial Number 85633416) will be refused (causing irreparable damage and injury to Opposers) if serial number 85608089 is not successfully opposed and ultimately refused registration.

7. If Applicant's application is not successfully opposed, Applicant will own the *prima facie* exclusive right to use the FIREBUG mark in Class 25 in connection with goods that the Examining Attorney has deemed "confusingly similar" to Opposer's FIREBUG class 25

goods. Such a registration would be a source of damage and injury to Opposers as it would prevent the USPTO from issuing a registration to Opposer based on its serial number 85633416.

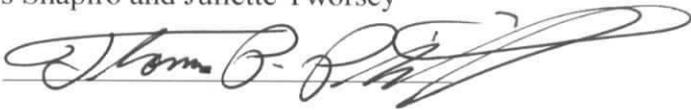
8. In view of the substantial similarity between the respective marks (serial numbers 85633416 [Opposer's mark] and 85608089 [Applicant's mark], Opposers' longstanding prior use in commerce for class 9, 41, and 25 goods/services, and the commercial relationship between the goods in International Class 25, registration of the FIREBUG mark herein opposed to Applicant in class 25 is likely to cause confusion, mistake or deception with consumers as to the source of Opposer's goods/services, and therefore it is requested that registration to Applicant be refused under Section 2(d) of the Trademark Act.

WHEREFORE, Opposers pray that this Opposition be sustained in favor of Opposers, that Application Serial No. 85608089, be rejected entirely in International Class 25, and that the registration of the mark therein sought in International Class 25 be denied and refused.

DATED this 25<sup>th</sup> day of March, 2013.

Respectfully submitted,

Jules Shapiro and Juliette Tworsey

By: 

John E. Russell, Esq.  
Thomas P. Philbrick, Esq.  
Attorneys for Opposers

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Notice of Opposition to Ser. No. 85608089

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and john@allmarktrademark.com

## CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **NOTICE OF OPPOSITION (against serial number 85608089)** has been served on J M (MARK) GILBRETH of GILBRETH & ASSOCIATES PC (counsel for Applicant) by mailing said copy on March 25, 2013 via First Class Mail, postage prepaid to:

Gilbreth & Associates PC  
Attn: J M (MARK) GILBRETH, Esq.  
P.O. Box 2428  
Bellaire, TX 77402

By: 

Thomas P. Philbrick

Dated: March 25, 2013