

ESTTA Tracking number: **ESTTA580590**

Filing date: **01/08/2014**

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

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|---------------------------------------|---|
| Name | Fox Head, Inc. |
| Granted to Date of previous extension | 01/08/2014 |
| Address | 18400 SUTTER BLVD Morgan Hill, CA 95037 UNITED STATES |

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| Attorney information | Jason Zedeck Law Office of Jason Zedeck P.O. Box 35210 LOS ANGELES, CA 90035 UNITED STATES jason@zedecklaw.com |
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Applicant Information

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|------------------------|---|------------------------|------------|
| Application No | 85902199 | Publication date | 09/10/2013 |
| Opposition Filing Date | 01/08/2014 | Opposition Period Ends | 01/08/2014 |
| Applicant | dunbar, trevor sr. P.O. Box 885361 San Francisco, CA 94188 GERMANY | | |

Goods/Services Affected by Opposition

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| Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

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| U.S. Application No. | 85911889 | Application Date | 04/23/2013 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | SHIFT S | | |

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| Design Mark |  |
| Description of Mark | The mark consists of the word "SHIFT" in stylized lettering over a larger stylized "S" letter. |
| Goods/Services | Class 016. First use: First Use: 2011/09/01 First Use In Commerce: 2011/09/01 Paper, cardboard and goods made from these materials, not included in other classes; printed matter; printed advertising materials; decals; stickers (decalcomanias); brochures; catalogues; pamphlets; leaflets; periodical magazines; newsletters; stationery; photographs; instructional and teaching material (except apparatus); all relating to clothing, apparel, protective gear, footwear, casualwear accessories, and moto-cross, motorcycle, bicycle and action sports activities, goods and services Class 025. First use: First Use: 2011/09/01 First Use In Commerce: 2011/09/01 Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, tights, shorts, hats, caps, sweatbands, headbands, gloves, belts, shoes, boots, socks and swimwear |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2711103 | Application Date | 05/06/2002 |
| Registration Date | 04/29/2003 | Foreign Priority Date | NONE |
| Word Mark | SHIFT | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1996/09/00 First Use In Commerce: 1996/09/00 Clothing, namely jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, hats, caps, sweatbands, gloves, belts, shoes, socks, and polo shirts | | |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3021302 | Application Date | 06/21/2001 |
| Registration Date | 11/29/2005 | Foreign Priority Date | NONE |

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| Word Mark | SHIFTMX |
| Design Mark | SHIFTMX |
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 1999/01/01 First Use In Commerce: 1999/01/01 CLOTHING, NAMELY, JACKETS, RAINCOATS, SWEATSHIRTS, JERSEYS, SHIRTS, BLOUSES, PANTS, TIGHTS, SHORTS, HATS, CAPS, SWEATBANDS, HEADBANDS, GLOVES, BELTS, SHOES, BOOTS, SOCKS, APRONS |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3261387 | Application Date | 10/29/2001 |
| Registration Date | 07/10/2007 | Foreign Priority Date | NONE |

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| Word Mark | SHIFT RACING |
| Design Mark | SHIFT RACING |
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 2001/06/01 First Use In Commerce: 2001/06/01 Clothing, namely, jackets, raincoats, sweatshirts, jerseys, shirts, blouses, pants, unitards, tights, hats, caps, sweatbands, gloves, belts, shoes, socks, aprons, polo shirts, outrider jackets |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2747574 | Application Date | 06/04/1999 |
| Registration Date | 08/05/2003 | Foreign Priority Date | NONE |

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| Word Mark | SHIFT |
| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | Class 018. First use: First Use: 1997/02/01 First Use In Commerce: 1997/02/01 Gear bags for carrying motorcycling andbicycling equipment, saddle bags, tool |

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| | packs sold empty and umbrellas | | |
| U.S. Registration No. | 2847631 | Application Date | 06/04/1999 |
| Registration Date | 06/01/2004 | Foreign Priority Date | NONE |
| Word Mark | SHIFT | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 1998/02/28 First Use In Commerce: 1998/02/28 Motorcycle and safety helmets, and protective clothing for motorcyclists and cyclists; pre-recorded videos in the fieldof motorcycle and bicycle racing | | |

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| U.S. Registration No. | 2747575 | Application Date | 06/04/1999 |
| Registration Date | 08/05/2003 | Foreign Priority Date | NONE |
| Word Mark | SHIFT | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 016. First use: First Use: 1997/02/01 First Use In Commerce: 1997/02/01 Decals, stickers, calendars and catalogs relating to motocross and bicycling sports clothing, protective gear, footwearand accessories | | |

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| Attachments | 85911889#TMSN.jpeg(bytes) 76404291#TMSN.gif(bytes) 76275802#TMSN.gif(bytes) 76331561#TMSN.gif(bytes) SHIFT TEAM - App. No. 85902199 - Notice of Opposition.pdf(28836 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.

| | |
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| Signature | /jasonpzedeck/ |
| Name | Jason Zedeck |
| Date | 01/08/2014 |

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

In the Matter of Application Serial No. 85902199
Filed April 12, 2013
For the mark **SHIFT TEAM**
PUBLISHED IN THE *OFFICIAL GAZETTE* ON September 10, 2013

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| _____ |) | |
| Fox Head, Inc. |) | |
| |) | |
| Opposer, |) | |
| v. |) | Opposition No. _____ |
| |) | |
| Trevor Dunbar, Sr. DBA Shift Team, |) | |
| |) | |
| Applicant. |) | |
| _____ |) | |

NOTICE OF OPPOSITION

Opposer FOX HEAD, INC., a corporation organized and existing under the laws of the State of Delaware, with a principal place of business located at 18400 Sutter Blvd. Morgan Hill California 95037 (hereinafter "Opposer") believes that it has or will be damaged by the registration of the trademark SHIFT TEAM, Application Serial No. 85902199 referenced above, and therefore hereby opposes Trevor Dunbar, Sr. DBA Shift Team's (hereinafter "Applicant") application for registration of the SHIFT TEAM trademark in accordance with the provisions of Section 13 of the Trademark Act (15 U.S.C. §1063).

As grounds for opposition, Opposer alleges as follows:

1. According to the records of the United States Patent and Trademark Office, Applicant, a Limited Liability Company organized and existing under the laws of the State of Delaware, with a principal place of business located at P.O. Box 885361, San Francisco, California 94188 filed an Intent-to-Use application on or about April 12, 2013 to register the SHIFT TEAM trademark in connection with the following goods:

"Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms"

in International Class 25.

The Application was published in the September 10, 2013 edition of the *Official Gazette*.

2. On or about October 9, 2013, Opposer requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

3. On or about November 8, 2013, Opposer requested a sixty (60) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

4. Opposer is a well-known worldwide clothing and accessory company that has manufactured, licensed and distributed merchandise bearing trademarks incorporating the term "SHIFT" since at least as early as 1996.

5. Opposer is the owner of several trademarks which consist of or incorporate the term "SHIFT" and which are registered with the United States Patent and Trademark Office for a variety of goods in International Class 25 including a registration for the SHIFT trademark, Registration No. 2711103, the SHIFTMX trademark, Registration No. 3021302 and the SHIFT RACING trademark, Registration No. 3261387 (hereinafter, collectively, the "SHIFT Marks"). These registrations are valid, in full force and effect and conclusive evidence of Opposer's rights to use the trademarks.

6. Opposer has adopted and used the SHIFT Marks throughout the world, including the United States, on or in connection with a variety of products and services since at least as early as September 1996, more than 15 years before Applicant filed Application Serial No. 85902199. By reason of such extensive use of the SHIFT Marks, consumers have come to recognize Opposer's marks as signifying Opposer and as identifying Opposer as the source of goods and services bearing the SHIFT Marks.

7. Applicant's proposed mark, SHIFT TEAM, is similar to Opposer's SHIFT Marks and is likely to be confused therewith. Applicant's proposed SHIFT TEAM mark is deceptively similar to Opposer's SHIFT Marks so as to cause confusion, mistake or deception as to the origin of Applicant's goods and it is likely to cause irreparable harm to Opposer and to consumers.

8. The goods identified in Application Serial No. 85902199 and goods offered by Applicant are identical or similar to the goods associated with Opposer's SHIFT Marks and are of the type which are available in the same channels of trade and to the same prospective customers.

9. If Application Serial No. 85902199 is registered, the public will reasonably believe that Applicant's goods are provided by Opposer, all to the detriment of the consumers and Opposer.

10. The registration and/or use by Applicant of its SHIFT TEAM mark will dilute the distinctiveness of the SHIFT Marks and otherwise injure Opposer's reputation and unique identity in the mind of consumers.

11. In addition to any rights arising from the registration of Opposer's trademarks, Opposer has, with respect to its products and services, valid common law rights in and to its SHIFT trademarks as set forth above. Applicant's proposed SHIFT TEAM mark is in violation and degrogation of those common law rights and is likely to cause confusion, mistake and deception among purchasers and users as to the source or origin of the goods, thereby causing loss, damage and injury to Opposer and the consuming public.

12. If Application Serial No. 85902199 proceeds to registration, Applicant would thereby obtain *prima facie* rights to use its SHIFT TEAM trademark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE Opposer requests that Serial No. 85902199 be rejected and registration thereof be denied, and that this Opposition be sustained in favor of Opposer.

Respectfully submitted,

Dated: January 8, 2014

FOX HEAD, INC.

by: /jasonpzedeck/

Jason Zedeck
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P.O. Box 35210
Los Angeles, CA 90035-0210
310-849-0336
jason@zedecklaw.com

Attorney for Opposer FOX HEAD, INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing NOTICE OF OPPOSITION has been duly served on the Applicant by mailing a copy of same via First Class Mail, postage prepaid, on this 8th day of January, 2014 to:

Trevor Dunbar, Sr.
P.O. Box 885361
San Francisco, California 94188

by: /jasonpzedeck/

Jason Zedeck