

ESTTA Tracking number: **ESTTA661784**

Filing date: **03/18/2015**

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	Genesco Brands, LLC
Granted to Date of previous extension	03/18/2015
Address	300 Delaware Avenue9th Floor Wilmington, DE 19801 UNITED STATES
Attorney information	Nichole Davis Chollet Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, N.E.Suite 2800 Atlanta, GA 30309 UNITED STATES nchollet@kilpatricktownsend.com, tlord@ktslaw.com, ccao@ktslaw.com, tmadmin@ktslaw.com, lcrumbley@ktslaw.com Phone:404-815-6500

**Applicant Information**

Application No	86316685	Publication date	11/18/2014
Opposition Filing Date	03/18/2015	Opposition Period Ends	03/18/2015
Applicant	Marcus McClarn 5225 S. Hermitage Ave. Chicago, IL 606095724 UNITED STATES		

**Goods/Services Affected by Opposition**

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

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3232063	Application Date	04/10/2001
Registration Date	04/24/2007	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1987/12/31 First Use In Commerce: 1987/12/31 retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories

U.S. Registration No.	2054259	Application Date	10/24/1995
Registration Date	04/22/1997	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	

Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1987/12/31 First Use In Commerce: 1987/12/31 shoes and clothing, namely, shirts, T-shirts, sweatshirts, jackets, [ pants, shorts, ] socks and hats

Attachments	76238378#TMSN.png( bytes ) 75009503#TMSN.png( bytes ) NOO_ Notice of Opposition against Marcus McClarn Mark D.pdf(180312 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	/Nichole Davis Chollet/
Name	Nichole Davis Chollet
Date	03/18/2015

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

GENESCO BRANDS, LLC	)	
	)	
	)	Serial No.: 86/316,685
Opposer,	)	Mark:
	)	
v.	)	
	)	
MARCUS MCCLARN	)	
	)	Opposition No. _____
	)	
Applicant.	)	

NOTICE OF OPPOSITION

Opposer Genesco Brands Inc. will be damaged by registration in International Class 25 of the mark underlying intent-to-use application Serial No. 86/316,685 and states the following grounds under 15 U.S.C. § 1063 and 37 C.F.R. §§ 2.101 and 2.104 for its opposition to that application:

1. Opposer Genesco Brands, Inc. is the owner and licensor of the trademark JOURNEYS, alone and in conjunction with other words and designs, used in connection with a well-known chain of over seven hundred JOURNEYS and JOURNEYS KIDZ retail stores located in major shopping malls throughout the United States, which are owned and operated by Opposer Genesco Brands, Inc.’s predecessor and exclusive licensee, Genesco Inc. (Opposer Genesco Brand Inc. and Genesco Inc. are collectively referred to as “Genesco”). The stores operating under the JOURNEYS trademarks sell a wide range of footwear, clothing, fashion accessories, novelties, bags, backpacks, and other goods in connection with the JOURNEYS marks.

2. The JOURNEYS stores and virtually all advertising for JOURNEYS stores prominently feature the design mark depicted below (the “Handprint Design Mark”), which is

owned by Genesco Brands Inc. By virtue of its use of the Handprint Design Mark, Genesco owns common law rights in the design.



3. Genesco’s Handprint Design Mark is used in connection with JOURNEYS retail stores and on point of purchase materials in connection with clothing, footwear, accessories, bags, novelties, and other products sold in those stores.

4. Genesco also owns federal Registration No. 3,232,063 of its Handprint Design Mark for “*retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories*” in International Class 35. Genesco has complied with all requirements necessary to maintain its federal registration for the Handprint Design Mark (Reg. No. 3,232,063), which is now incontestable under 15 U.S.C. § 1065. In addition, Genesco owns federal Registration No. 2,054,259 of its Handprint Design Mark for “*shoes and clothing, namely, shirts, T-shirts, sweatshirts, jackets, socks, and hats*” in International Class 25.

5. Genesco has used its Handprint Design Mark in commerce in connection with the advertising, promotion, distribution, and sale of footwear and clothing and other goods, as well as retail store services, since at least as early as December 31, 1987.

6. By virtue of continuous and extensive advertising of the Handprint Design Mark in connection with Genesco’s retail stores and the products sold therein, and of the extensive sales under the mark for over 20 years, Genesco’s Handprint Design Mark is widely and favorably known by the public throughout the United States.

7. Genesco's Handprint Design Mark is symbolic of the substantial goodwill and consumer recognition established by Genesco as a result of the outstanding quality and extensive sales of products through its retail stores throughout the United States for many years. Genesco has expended large amounts of money, time, and effort in advertising and promoting such goods and services under the Handprint Design Mark. By reason of Genesco's extensive use and advertising of the Handprint Design Mark and resulting favorable public recognition, the Handprint Design Mark uniquely identifies Genesco and its retail stores and related products and services to the public. As such, Genesco has acquired extensive common law rights in the Handprint Design Mark in connection with its retail store services and with footwear, clothing and other goods.

8. Applicant Marcus McClarn ("Applicant") filed intent-to-use application Serial No. 86/316,685 on June 21, 2014 to register the D & Handprint Design mark ("Applicant's Mark"), which is reproduced below:



Applicant's Mark, which was published for opposition in the Official Gazette on November 18, 2014, is for use in connection with "*athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms*" in International Class 25. Genesco timely filed extensions of time to oppose this application.

9. Genesco continuously has used its Handprint Design Mark since long prior to the Applicant's actual or constructive first use date.

10. Applicant's Mark prominently incorporates a handprint design that is virtually identical in appearance and commercial impression to Genesco's Handprint Design Mark.

11. Applicant's Mark is proposed to be used with goods in International Class 25 that are identical and/or high related to the goods Genesco offers under its Handprint Design Mark.

12. Genesco will be damaged by the registration of Applicant's Mark in International Class 25 because the mark so resembles Genesco's previously used Handprint Design Mark as to be likely to cause consumer confusion, mistake and deception. Consumers familiar with Genesco's Handprint Design Mark would be likely, erroneously, to believe that Applicant's goods are those of Genesco or are endorsed, sponsored, or licensed by Genesco. Thus, registration of Applicant's Mark with respect to International Class 25 on the Principal Register would be inconsistent with Genesco's rights in its Handprint Design Mark.

13. The required opposition fee is being electronically processed in connection with this Notice of Opposition. The Director is authorized to debit KILPATRICK TOWNSEND & STOCKTON LLP's Trademark Deposit Account No. 20-1430 for any deficiency in the required fee.

Opposer Genesco Brands, Inc. therefore requests that application Serial No. 86/316,685 be refused registration.

Date: March 18, 2015

Respectfully Submitted:

/Nichole Davis Chollet/  
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Nichole Davis Chollet  
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*Attorneys for Opposer*

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being filed electronically through the U.S. Patent and Trademark Office's ESTTA system on March 18, 2015.

BY: /Louie Crumbley/  
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Opposer,	)	Mark:
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v.	)	
	)	
MARCUS MCCLARN	)	
	)	Opposition No. _____
	)	
Applicant.	)	

**CERTIFICATE OF SERVICE**

This is to certify that the foregoing NOTICE OF OPPOSITION was served on counsel for Applicant by depositing a true and correct copy in the first class mail, postage pre-paid, addressed as follows:

Manotti Jenkins  
Law Offices of Manotti L. Jenkins, LTD.  
5111 S. University Ave, Apt. 305  
Chicago, Illinois 60615-3954

This 18th day of March, 2015.

/Louie Crumbley/

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