

ESTTA Tracking number: **ESTTA679359**

Filing date: **06/22/2015**

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	06/21/2015
Address	300 Delaware Avenue9th Floor Wilmington, DE 19801 UNITED STATES
Attorney information	NICHOLE DAVIS CHOLLET KILPATRICK TOWNSEND & STOCKTON LLP 1100 PEACHTREE NE, SUITE 2800 ATLANTA, GA 30309 UNITED STATES nchollet@kilpatricktownsend.com, tlord@ktslaw.com, lcrumbley@ktslaw.com, ccao@ktslaw.com, tadmin@ktslaw.com Phone:404-815-6500

Applicant Information

Application No	79131343	Publication date	12/23/2014
Opposition Filing Date	06/22/2015	Opposition Period Ends	06/21/2015
International Registration No.	1163398	International Registration Date	08/30/2012
Applicant	Cristalica GmbH Ringstraße 16 GERMANY		

Goods/Services Affected by Opposition

<p>Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Suits; baby clothes, namely, body-suits,t-shirts, tops, hats, shirts, sweatshirts; baby pants; bathing suits; bathing trunks; bathrobes; bathing caps; bath sandals; slippers; bandanas; basque hats; leg warmers; clothing made of imitation leather, namely, boots, coats, headwear, jackets, pants, shoes, slippers, vests, trousers; clothing for motorists, namely, boots, coats, headwear, jackets, pants, shirts, shoes, slippers, vests, t-shirts, trousers; boas; bodysuits, namely, teddies; bras; chasubles; dresses; showercaps; carnival costumes; gloves; fishing vests; soccer shoes; gabardine clothing, namely, coats, suits, trousers; galoshes; boots; money belts; belts; gymnastic clothing, namely, bodysuits, t-shirts,tops, headwear, shirts, shoes, sweatbands; gym shoes; ankle boots; scarves; slippers; shirt pants combinations; shirt inserts, namely, dickies; shirts; shirt collars; shirt plastrons; wooden shoes; pants; trouser straps; suspenders; garterbelts; hats; jackets; jerseys; jackets;camisoles; caps; hoods; gowns; ready-made linings for clothing; headgear, namely, hats and caps; corset bodices; corsets; collars; ties; tie scarves; short sleeve shirts; bibs not of paper; leather clothing, namely, boots, coats, headwear,jackets, pants, shoes, slippers, vests,trousers; leggings; underwear; liveries; coats; fur-lined coats; mantillas;</p>
--

sleeves worn separate and apart from blouses, shirts and other tops; caps; visors; outer jackets; ear muffs; overalls; slippers; paper hats for use as clothing items; parkas; capes; fur coats; petticoats; ponchos; sweaters; pajamas; cyclists' clothing, namely, headwear, jackets, pants, shirts, shoes, sweatbands, t-shirts, vests; raincoats; skirts; sandals; saris; sarongs; scarves; shawls; sleep masks; knickers; lace boots; shoes fittings of metal; shoe soles; footwear uppers; aprons; sweat bands; ski gloves; ski boots; skorts; briefs; socks; sock suspenders; sport shoes; boots; boot tops; headbands; canvas shoes; stoles; beachwear; beach shoes; stockings; tights; sweaters; T-shirts; togas; strappy dresses; turbans; overcoat undergarments; anti-perspiration undergarments; knee stockings; lingerie; water ski suits; knitwear, namely, headwear, jackets, socks, vests, gloves, scarves; top hats; hat frames; cuffs; pockets for clothing

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

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		

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

Attachments	75009503#TMSN.png(bytes) 76238378#TMSN.png(bytes) 79131343_Notice of Opposition.pdf(47693 bytes)
-------------	---

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	06/22/2015

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

GENESCO BRANDS INC.)
)
)
Opposer,) Serial No.: 79131343
) Mark: FAN UNIKATE CRISTALICA &
) Handprint Design
)
)
)
)
v.)
)
)
CRISTALICA GMBH)
)
)
)
Applicant.) Opposition No. _____



NOTICE OF OPPOSITION

Opposer Genesco Brands Inc. will be damaged by registration in International Class 25 of the mark underlying application Serial No. 79131343 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 Brands 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. 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. 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. In addition, Genesco 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. Registration Nos. 2,054,259 and 3,232,063 of the Handprint Design are valid and subsisting, and affidavits have been filed and accepted pursuant to Sections 8 and 15 of the Lanham Act for Registration No. 3,232,063, rendering such registration incontestable.

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 the 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 25 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 Cristalica GmbH ("Applicant") filed application Serial No. 79131343 on August 30, 2012 to register the mark FAN UNIKATE CRISTALICA & Handprint Design ("Applicant's Mark"), which is reproduced below:



Applicant's Mark was published for opposition in the Official Gazette on December 23, 2014 for use in connection with, *inter alia*, "suits; baby clothes, namely, bodysuits, t-shirts, tops, hats, shirts, sweatshirts; baby pants; bathing suits; bathing trunks; bathrobes; bathing caps; bath sandals; slippers; bandanas; basque hats; leg warmers; clothing made of imitation leather,

namely, boots, coats, headwear, jackets, pants, shoes, slippers, vests, trousers; clothing for motorists, namely, boots, coats, headwear, jackets, pants, shirts, shoes, slippers, vests, t-shirts, trousers; boas; bodysuits, namely, teddies; bras; chasubles; dresses; shower caps; carnival costumes; gloves; fishing vests; soccer shoes; gabardine clothing, namely, coats, suits, trousers; galoshes; boots; money belts; belts; gymnastic clothing, namely, bodysuits, t-shirts, tops, headwear, shirts, shoes, sweatbands; gym shoes; ankle boots; scarves; slippers; shirt pants combinations; shirt inserts, namely, dickies; shirts; shirt collars; shirt plastrons; wooden shoes; pants; trouser straps; suspenders; garter belts; hats; jackets; jerseys; jackets; camisoles; caps; hoods; gowns; ready-made linings for clothing; headgear, namely, hats and caps; corset bodices; corsets; collars; ties; tie scarves; short sleeve shirts; bibs not of paper; leather clothing, namely, boots, coats, headwear, jackets, pants, shoes, slippers, vests, trousers; leggings; underwear; liveries; coats; fur-lined coats; mantillas; sleeves worn separate and apart from blouses, shirts and other tops; caps; visors; outer jackets; ear muffs; overalls; slippers; paper hats for use as clothing items; parkas; capes; fur coats; petticoats; ponchos; sweaters; pajamas; cyclists' clothing, namely, headwear, jackets, pants, shirts, shoes, sweatbands, t-shirts, vests; raincoats; skirts; sandals; saris; sarongs; scarves; shawls; sleep masks; knickers; lace boots; shoes fittings of metal; shoe soles; footwear uppers; aprons; sweat bands; ski gloves; ski boots; skorts; briefs; socks; sock suspenders. sport shoes; boots; boot tops; headbands; canvas shoes; stoles; beachwear; beach shoes; stockings; tights; sweaters; T-shirts; togas; strappy dresses; turbans; overcoat undergarments; anti-perspiration undergarments; knee stockings; lingerie; water ski suits; knitwear, namely, headwear, jackets, socks, vests, gloves, scarves; top hats; hat frames; cuffs; pockets for

clothing” in International Class 25.¹ Genesco timely filed extensions of time to oppose this application.

9. Genesco continuously has used its Handprint Design Mark long before the August 30, 2012 filing date of Applicant’s application and/or any claimed date of first use in commerce of Applicant’s Mark in connection with Applicant’s goods.

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 in connection with goods in International Class 25 that are identical and/or highly 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 in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). 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 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 for International Class 25 only. The Director is authorized to debit Kilpatrick Townsend & Stockton LLP’s Trademark Deposit Account No. 20-1430 for any deficiency in the required fee.

¹ Applicant’s application Serial No. 79131343 also covers goods and services in International Classes 9, 14, 16, 21, 26, 28, 34, 35, and 39. Genesco limits its opposition only to the goods identified in International Class 25.

Opposer Genesco Brands Inc. therefore requests that application Serial No. 79131343 be refused registration in International Class 25.

Date: June 22, 2015

Respectfully Submitted:

/Nichole Davis Chollet/
Tywanda H. Lord
Nichole Davis Chollet
Carrie Weiting Cao
KILPATRICK TOWNSEND & STOCKTON LLP
1100 Peachtree Street NE, Suite 2800
Atlanta, GA 30309-4530
(404) 815-6500

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 June 22, 2015.

BY: /Louie Crumbley/
KILPATRICK TOWNSEND & STOCKTON LLP
1100 Peachtree Street Suite 2800
Atlanta, Georgia 30309-4530
(404) 815-6500

