

ESTTA Tracking number: **ESTTA684729**

Filing date: **07/20/2015**

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	OluKai, LLC
Granted to Date of previous extension	07/19/2015
Address	8955 Research Drive Irvine, CA 92618 UNITED STATES

Attorney information	B. Anna McCoy Alleman Hall McCoy Russell & Tuttle LLP 806 SW Broadway, Suite 600 Portland, OR 97205 UNITED STATES harnett@ahmrt.com, mccoey@ahmrt.com, mercer@ahmrt.com, gladwin@ahmrt.com, saing@ahmrt.com Phone:503-459-4141
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**Applicant Information**

Application No	86381166	Publication date	01/20/2015
Opposition Filing Date	07/20/2015	Opposition Period Ends	07/19/2015
Applicant	NT Partners LLC 4521 PGA Blvd #136 Palm Beach Gardens, FL 33418 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. First Use: 2010/05/31 First Use In Commerce: 2010/05/31 All goods and services in the class are opposed, namely: Clothing and headgear, namely, t-shirts, shirts, polos, shorts, bathing trunks,swimsuits, jackets, hoodies, hats, visors, and skull caps
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	common-law basis for opposition

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3163969	Application Date	03/23/2005
Registration Date	10/24/2006	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2005/12/15 First Use In Commerce: 2005/12/15 Footwear; clothing, namely, surfwear, t-shirts, shirts, [ sweatshirts, jackets, rain coats, rain trousers, rain suits, wind resistant jackets, parkas, vests, anoraks, ski bibs, gloves, mittens, underwear, socks,] hats, headbands, caps, [ ski suits, gaiters, belts, skirts, shorts, pants, trousers, wetsuits, drysuits, wet suits for water-skiing,] rash guards [, swim trunks, swim caps, swim wear, and water socks ]		
U.S. Registration No.	3422573	Application Date	08/27/2007
Registration Date	05/06/2008	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a hook.
Goods/Services	Class 025. First use: First Use: 2005/12/15 First Use In Commerce: 2005/12/15 Clothing, namely, t-shirts, shirts; footwear; headgear, namely, headwear

U.S. Registration No.	3426168	Application Date	08/27/2007
Registration Date	05/13/2008	Foreign Priority Date	NONE
Word Mark	OLUKAI		
Design Mark			
Description of Mark	The mark consists of a hook and the word "OLUKAI."		
Goods/Services	Class 025. First use: First Use: 2005/12/15 First Use In Commerce: 2005/12/15 Clothing, namely t-shirts, shirts; footwear; headgear, namely, headwear		

U.S. Registration No.	3441978	Application Date	06/05/2007
Registration Date	06/03/2008	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 2006/06/15 First Use In Commerce: 2006/06/15 garment bags for travel; leather key chains; sports bags

U.S. Registration No.	3544582	Application Date	08/28/2007
Registration Date	12/09/2008	Foreign Priority Date	NONE

Word Mark	NONE		
Design Mark			
Description of	The mark consists of a hook.		

Mark	
Goods/Services	Class 016. First use: First Use: 2006/01/01 First Use In Commerce: 2006/01/01 catalogs featuring clothing, footwear and headwear; cardboard shipping boxes; decals; paper and cardboard banners; mounted photographs; unmounted photographs; posters; printed signs made of paper and cardboard; stationery; stickers

U.S. Registration No.	3626900	Application Date	10/29/2008
Registration Date	05/26/2009	Foreign Priority Date	NONE

Word Mark	NONE
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Design Mark	
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Description of Mark	The mark consists of a hook.
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Goods/Services	Class 018. First use: First Use: 2006/06/15 First Use In Commerce: 2006/06/15 All purpose sport bags; All-purpose carrying bags; Carry-all bags; Duffel bags for travel; Garment bags for travel; Leather key chains; Overnight bags; Roll bags; Sports bags; Travel bags; Wheeled bags
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U.S. Registration No.	4002659	Application Date	08/28/2007
Registration Date	07/26/2011	Foreign Priority Date	NONE

Word Mark	NONE
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Design Mark	
Description of Mark	The mark consists of a hook.
Goods/Services	Class 009. First use: First Use: 2011/05/14 First Use In Commerce: 2011/05/14 Cellphone cases; prerecorded compact discs featuring music; prerecorded video discs featuring information on fashion, lifestyle, music, sports and travel; protective gear, namely, protective clothing; sunglasses

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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	/B. Anna McCoy/
Name	B. Anna McCoy
Date	07/20/2015



3. Since at least as early as December 15, 2005, Opposer has used and continues to

use in interstate commerce the mark  (the “Hook Mark”), solely and in combination with the word OLUKAI, in connection with the sales and promotion of Opposer’s goods and services. Opposer owns and uses the Hook Mark to identify footwear, apparel, surfwear, headgear, bags, eyewear, accessories, and other related goods and services originating from the Opposer in commerce.

4. Opposer owns several United States trademark registrations for the Hook Mark. A list of Opposer’s United States trademark registrations for the Hook Mark, alone or in combination with the mark OLUKAI, is below.

Registration Number	Registration Date	Class	Goods
3,163,969	October 24, 2006	25	Footwear; clothing, namely, surfwear, t-shirts, shirts, hats, headbands, caps, rash guards
3,422,573	May 6, 2008	25	Clothing, namely, t-shirts, shirts; footwear; headgear, namely, headwear
3,426,168	May 13, 2008	25	Clothing, namely t-shirts, shirts; footwear; headgear, namely, headwear
3,441,978	June 3, 2008	18	Garment bags for travel; leather key chains; sports bags
3,544,582	December 9, 2008	16	Catalogs featuring clothing, footwear and headwear; cardboard shipping boxes; decals; paper and cardboard banners; mounted photographs; unmounted photographs; posters; printed signs made of paper and cardboard; stationery; stickers
3,626,900	May 26, 2009	18	All purpose sport bags; All-purpose carrying bags; Carry-all bags; Duffel bags for travel; Garment bags for travel; Leather key chains; Overnight bags; Roll bags; Sports bags; Travel bags; Wheeled bags
4,002,659	July 26, 2011	9	Cellphone cases; prerecorded compact discs featuring music; prerecorded video discs featuring information on fashion, lifestyle, music, sports and travel; protective gear, namely, protective clothing; sunglasses

5. Opposer also has common law rights in the Hook Mark for use in connection with footwear, apparel, surfwear, headgear, bags, eyewear, accessories, and related goods and services.

6. Opposer has used and continues to use the Hook Mark and the goods in connection therewith have been popular and the subject of significant advertising and promotional activities.

7. Opposer's use of the Hook Mark has been valid and continuous since the dates of first use and Opposer has not abandoned the Hook Mark. The Hook Mark is symbolic of extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion. The Hook Mark identifies and distinguishes Opposer's goods and services from the goods and services of others, and identifies the source and origin thereof to both the trade and the public.

8. Prior to Applicant's adoption of its mark, Opposer's Hook Mark has been used and promoted in such a way as to create a public perception of the Hook Mark as an indication of source.

9. Notwithstanding Opposer's rights in and to its Hook Mark, Applicant, on August 29, 2014, filed a use-based application for registration of the mark  ("Applicant's Mark"). Applicant's application was given Serial No. 86/381,166 and was published for opposition in the Official Gazette on January 20, 2015.

10. The published application for Applicant's Mark includes the following goods: "Clothing and headgear, namely, t-shirts, shirts, polos, shorts, bathing trunks, swimsuits, jackets, hoodies, hats, visors, and skull caps" in International Class 025.

11. Applicant claims a date of first use in commerce of May 31, 2010.

12. Opposer's first use of the Hook Mark is earlier than Applicant's date of first use and date of first use in interstate commerce of Applicant's Mark.

13. Applicant's filing date is subsequent to Opposer's filing date for the Hook Mark.

14. Applicant's applied-for goods are the same as and closely related to the goods identified in Opposer's registrations for the Hook Mark. Further, Applicant's recited goods are closely associated with, and are likely to be encountered in the same channels of trade, as the goods offered by Opposer in connection with the Hook Mark.

15. Applicant's Mark  and Opposer's Hook Mark  both consist of a single, stylized fishing hook. Similarities in the composition of the two marks, including the standalone nature of the single hook and features such as the pointed barbs and exaggerated, stylized curvature, predominate and create a confusingly similar overall impression.

16. If Applicant registers and uses its mark for the applied-for goods in the U.S., it is likely to cause confusion, mistake and deception among consumers regarding the source of Applicant's goods. Registration of Applicant's Mark may damage the goodwill and consumer recognition that Opposer has built up in its Hook Mark.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Mark, and prays that registration be denied.

Opposer authorizes the Commissioner for Trademarks to charge the fee for filing this Notice of Opposition, or any other additional fees that may be due, to Deposit Account 503397.

DATED this 20<sup>th</sup> day of July, 2015.

Respectfully submitted,  
Alleman Hall McCoy Russell & Tuttle LLP



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