

ESTTA Tracking number: **ESTTA712888**

Filing date: **12/07/2015**

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	12/13/2015
Address	300 Delaware Avenue 9th Floor Wilmington, DE 19801 UNITED STATES

Attorney information	Tywanda H. Lord KILPATRICK TOWNSEND & STOCKTON LLP 1100 PEACHTREE Street Suite 2800 ATLANTA, GA 30309 UNITED STATES tlord@ktslaw.com, nchollet@ktslaw.com, ccao@ktslaw.com, jburns@ktslaw.com, tadmin@ktslaw.com Phone:404-815-6500
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Applicant Information

Application No	86561218	Publication date	06/16/2015
Opposition Filing Date	12/07/2015	Opposition Period Ends	12/13/2015
Applicant	PECHANGA BAND OF LUISENO MISSION INDIANS OF THE PECHANGA RESERVATION, CALIFORNIA 12705 Pechanga Road Temecula, CA 92593 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2009/01/27 First Use In Commerce: 2009/01/27 All goods and services in the class are opposed, namely: head gear, namely, fitted caps, visors, and beanies; clothing, namely, collared shirts, sweatshirts, and sweaters; outerwear, namely, vests, and jackets; bath robes; bath slippers
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Applicant Information

Application No	86561195	Publication date	06/09/2015
Opposition Filing Date	12/07/2015	Opposition Period Ends	
Applicant	PECHANGA BAND OF LUISENO MISSION INDIANS OF THE PECHANGA RESERVATION, CALIFORNIA 12705 Pechanga Road Temecula, CA 92593 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 025. First Use: 2009/01/27 First Use In Commerce: 2009/01/27 All goods and services in the class are opposed, namely: head gear, namely, fitted caps, visors, and beanies; clothing, namely, collared shirts, sweatshirts, and sweaters; outerwear, namely, vests, and jackets; bath robes; bath slippers</p>

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.	1475093	Application Date	06/15/1987
Registration Date	02/02/1988	Foreign Priority Date	NONE
Word Mark	JOURNEYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1987/02/09 First Use In Commerce: 1987/02/09 SHOES		

U.S. Registration No.	1458854	Application Date	02/17/1987
Registration Date	09/22/1987	Foreign Priority Date	NONE
Word Mark	JOURNEYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1986/12/17 First Use In Commerce: 1986/12/17 RETAIL SHOE STORE SERVICES		

U.S. Registration No.	3099876	Application Date	08/11/2005
Registration Date	06/06/2006	Foreign Priority Date	NONE
Word Mark	JOURNEYS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1987/02/09 First Use In Commerce: 1987/02/09 footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweat-shirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts Class 035. First use: First Use: 1987/02/09 First Use In Commerce: 1987/02/09 retail store services in the fields of footwear, apparel, luggage, handbags, sports bags, backpacks, jewelry and fashion accessories

U.S. Registration No.	2501052	Application Date	04/04/2000
Registration Date	10/23/2001	Foreign Priority Date	NONE

Word Mark	JOURNEYS ZAPCARD
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2001/06/21 First Use In Commerce: 2001/06/21 Providing prepaid payment cards redeemable for purchases in applicant's retail stores

U.S. Registration No.	2620681	Application Date	06/13/2001
Registration Date	09/17/2002	Foreign Priority Date	NONE

Word Mark	JOURNEYS ZAP CARD
Design Mark	JOURNEYS ZAP CARD
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2000/11/00 First Use In Commerce: 2000/11/00 financial services in connection with the issuance of stored value cards

U.S. Registration No.	1558147	Application Date	01/23/1989
Registration Date	09/26/1989	Foreign Priority Date	NONE
Word Mark	JOURNEYS AN ATTITUDE YOU CAN WEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1988/07/15 First Use In Commerce: 1988/07/15 SHOES Class 042. First use: First Use: 1988/07/15 First Use In Commerce: 1988/07/15 RETAIL SHOE STORE SERVICES		

U.S. Registration No.	2957414	Application Date	12/06/2000
Registration Date	05/31/2005	Foreign Priority Date	NONE
Word Mark	JOURNEYS KIDZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweat-shirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts Class 035. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00		

	Retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories
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U.S. Registration No.	2952068	Application Date	12/06/2000
Registration Date	05/17/2005	Foreign Priority Date	NONE
Word Mark	JOURNEYS KIDZ		
Design Mark	<p style="text-align: center;">JOURNEYS KIDZ</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweat-shirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts</p> <p>Class 035. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories</p>		

U.S. Registration No.	3406723	Application Date	06/16/2005
Registration Date	04/01/2008	Foreign Priority Date	NONE
Word Mark	SHI BY JOURNEYS		
Design Mark	<p style="text-align: center;">SHI BY JOURNEYS</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 2007/05/08 First Use In Commerce: 2007/05/08 FOOTWEAR AND APPAREL, NAMELY, SHOES, BOOTS, HOSIERY, COATS, SCARVES</p> <p>Class 035. First use: First Use: 2005/11/22 First Use In Commerce: 2005/11/22 RETAIL STORE SERVICES IN THE FILEDS OF FOOTWEAR, APPAREL, HANDBAGS, JEWELRY AND FASHION ACCESSORIES</p>		

Attachments	76644691#TMSN.png(bytes) 76017122#TMSN.png(bytes) 76270806#TMSN.png(bytes) 76176492#TMSN.png(bytes) 76176773#TMSN.png(bytes) 78652161#TMSN.png(bytes) Consolidated Notice of Opposition (JOURNEY AT PECHANGA).pdf(43396 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	/Carrie W. Cao/
Name	Carrie W. Cao/
Date	12/07/2015

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

GENESCO BRANDS, LLC,)	
)	
Opposer,)	Serial Nos.
)	86561218 (JOURNEY AT PECHANGA)
v.)	86561195 (JOURNEY AT PECHANGA
)	& Design)
PECHANGA BAND OF LUISENO)	
MISSION INDIANS OF THE PECHANGA)	
RESERVATION, CALIFORNIA,)	Consolidated Opposition No. _____
)	
Applicant.)	

CONSOLIDATED NOTICE OF OPPOSITION

Opposer Genesco Brands, LLC believes it will be damaged by registration to Applicant Pechanga Band of Luiseno Mission Indians of The Pechanga Reservation, California (“Applicant”) of the marks JOURNEY AT PECHANGA and JOURNEY AT PECHANGA & Design (together, “Applicant’s Marks”) that are the subjects of use-based application Serial Nos. 86561218 and 86561195, respectively (together, the “Applications”), and opposes the same pursuant to 15 U.S.C. § 1063 and 37 C.F.R. §§ 2.101 and 2.104. Application Serial Nos. 86561218 and 86561195 were filed on March 11, 2015 and first published for opposition in the *Official Gazette* on June 16, 2015 and June 9, 2015, respectively. Opposer timely filed extensions of time to oppose Application Serial Nos. 86561218 and 86561195 and has until December 13, 2015 and December 6, 2015, respectively, to oppose the Applications.

The grounds for this consolidated opposition are as follows:

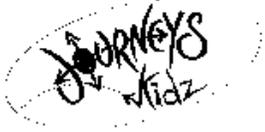
1. Opposer Genesco Brands, LLC is the owner and licensor of the trademark JOURNEYS, alone and in conjunction with other words and designs, used in connection with a well-known chain of over seven hundred JOURNEYS and JOURNEYS KIDZ retail stores located in major shopping malls throughout the United States, which are owned and operated by

Opposer Genesco Brands, LLC’s predecessor and exclusive licensee, Genesco Inc. (Opposer Genesco Brands, LLC, Genesco Inc., and their predecessors 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. Genesco has validly and continuously used the JOURNEYS mark and other marks incorporating the element JOURNEYS in connection with a variety of goods and services since at least as early as December 17, 1986.

3. Genesco owns the following federal registrations for marks comprised of or incorporating the JOURNEYS mark (collectively the “JOURNEYS Marks”), including numerous design marks:

Name of Mark	Registration No.	Goods/Services	First Use Date
JOURNEYS	1,475,093	“shoes” in International Class 025.	02/09/87
JOURNEYS	1,458,854	“retail shoe store services” in International Class 042.	12/17/86
JOURNEYS and Design 	3,099,876	“footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts” in International Class 025; ”retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories” in International Class 035.	02/9/1987
JOURNEYS ZAPCARD and Design	2,501,052	“providing prepaid payment cards redeemable for purchases in Applicant’s retail stores” in	06/21/01

		International Class 036.	
JOURNEYS ZAP CARD	2,620,681	“financial services in connection with the issuance of stored value cards” in International Class 036.	11/00/00
JOURNEYS AN ATTITUDE YOU CAN WEAR	1,558,147	“shoes” in International Class 025; and “retail shoe store services” in International Class 042.	07/15/88
JOURNEYS KIDZ and Design 	2,957,414	“footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts” in International Class 025; ”retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories” in International Class 035.	08/00/00
JOURNEYS KIDZ	2,952,068	“footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts” in International Class 025; ”retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories” in International Class 035.	08/00/00
SHI BY JOURNEYS	3,406,723	“footwear and apparel, namely, shoes, boots, hosiery, coats, scarves” in International Class 025;	11/22/05

		“retail stores services in the fields of footwear, apparel, handbags, jewelry and fashion accessories” in International Class 035.	
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The above-listed registrations of the JOURNEYS Marks are valid and subsisting, and affidavits have been filed and accepted pursuant to Sections 8 and 15 of the Lanham Act for the nine (9) registrations listed above (Reg. Nos. 1,458,854, 1,475,093, 1,558,147, 2,501,052, 2,620,681, 2,952,068, 2,957,414, 3,099,876, and 3,406,723), rendering such registrations incontestable.

4. By virtue of continuous and extensive sales and advertising of the JOURNEYS Marks in connection with Genesco’s retail stores and the products sold therein, and the extensive sales of such goods for over 25 years, Genesco’s JOURNEYS Marks are widely and favorably known by the public throughout the United States.

5. Genesco has expended large amounts of money, time, and effort in advertising and promoting its goods and services under the JOURNEYS Marks. By reason of Genesco’s extensive use and advertising of the JOURNEYS Marks and resulting favorable public recognition, Genesco’s JOURNEYS Marks uniquely identify Genesco and its products and services to the public. As such, Genesco has established extensive common-law rights in the JOURNEYS Marks in connection with footwear, clothing, bags and other goods, as well as for retail store services.

6. On March 11, 2015, Applicant filed application Serial Nos. 86561218 and 86561195 of the JOURNEY AT PECHANGA mark and the JOURNEY AT PECHANGA & Design mark, respectively, for use in connection with, *inter alia*¹, “head gear, namely, fitted

¹ The Applications also identify “Golf equipment, namely, golf bags, golf accessory pouches, golf balls, golf ball markers, golf bag tags, head covers for golf clubs, golf clubs, golf pin flags, golf gloves, golf towel clips for attachment to golf bags, and clips specially adapted for attachment of golf accessories to golf bags” in International Class 28. Genesco does not oppose the registration of Applicant’s Marks in connection with the goods identified in International Class 28 and limits this consolidated opposition only to the goods identified in International Class 25.

caps, visors, and beanies; clothing, namely, collared shirts, sweatshirts, and sweaters; outerwear, namely, vests, and jackets; bath robes; bath slippers” in International Class 25, claiming a date of first use of January 27, 2009.

7. Genesco continuously has used its JOURNEYS Marks since long prior to the Applications’ filing date and any claimed date of first use, actual or constructive.

8. Applicant’s Marks are closely similar in sight, sound and commercial impression to Genesco’s JOURNEYS Marks.

9. Applicant’s Marks are to be used with goods in International Class 25 that are identical or closely related to the goods and services Genesco offers with its JOURNEYS Marks.

10. Genesco will be damaged by the registration of Applicant’s Marks in International Class 25 because the marks so resemble Genesco’s JOURNEYS Marks 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 JOURNEYS Marks would be likely, erroneously, to believe the goods in International Class 25 of the Applications are goods of Genesco’s or are endorsed, sponsored, or licensed by Genesco. Thus, registration of Applicant’s Marks on the Principal Register would be inconsistent with Genesco’s rights in its JOURNEYS Marks.

Opposer Genesco Brands, LLC therefore requests that application Serial Nos. 86561218 and 86561195 be refused registration.

The required opposition fee for opposing Applicant’s Marks in connection with International Class 25 is being electronically processed in connection with this Consolidated Notice of Opposition. The Director is authorized to debit Kilpatrick Townsend & Stockton’s Trademark Deposit Account No. 20-1430 for any deficiency in the required fee.

Date: December 7, 2015

Respectfully Submitted:

/Carrie W. Cao/

Tywanda H. Lord

Nichole Davis Chollet

Carrie Weiting Cao

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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 December 7, 2015.

BY: /Joseph V. Burns/
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)	& Design)
PECHANGA BAND OF LUISENO)	
MISSION INDIANS OF THE PECHANGA)	
RESERVATION, CALIFORNIA,)	Consolidated Opposition No. _____
)	
Applicant.)	

CERTIFICATE OF SERVICE

This is to certify that the foregoing CONSOLIDATED 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:

Sanford E. Warren, Jr., Esq.
Warren Rhoades LLP
1212 Corporate Dr. Suite 250
Irving, Texas 75038-2705

This 7th day of December, 2015.

/Joseph V. Burns/
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