

ESTTA Tracking number: **ESTTA721422**

Filing date: **01/19/2016**

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 | Specialty Retailers, Inc. | | |
| Entity | Corporation | Citizenship | Texas |
| Address | 10201 Main Street Houston, TX 77025 UNITED STATES | | |

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| Attorney information | Jessica L. John Bowman McAfee & Taft 1717 S. Boulder Suite 900 Tulsa, OK 74119 UNITED STATES jessica.johnbowman@mcafeetaft.com, anthony.rahhal@mcafeetaft.com, di- ane.goswick@mcafeetaft.com Phone:9185743046 |
|----------------------|--|

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 86665765 | Publication date | 01/19/2016 |
| Opposition Filing Date | 01/19/2016 | Opposition Period Ends | 02/18/2016 |
| Applicants | Gordon, Dan J 2033 Colquitt Street Houston, TX 77098 UNITED STATES Gordon, Andrew J 2033 Colquitt Street Houston, TX 77098 UNITED STATES | | |

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: Clothing, footwear, and headwear for male and female infants, children, young adults, parents, families, and educators, namely, shirts, sweat-shirts, tank tops, t-shirts, pants, jackets, shorts, vests, socks, leggings, sleepwear, uniforms, infants' sleepers, pajamas, nightgowns, robes, dresses, jumpers, skirts, sweaters, underwear, beachwear, swimwear, bathing suits, flip flops, sun visors, gym shorts, warm-up suits, playsuits, baby bibs not made of paper, scarves, belts, ties, bandannas, suspenders, hats, ballet shoes, neckwear, shoes, boots, rain boots, mittens, gloves, coats, rainwear, ponchos, dancewear, theater costumes, and Halloween and Masquerade costumes; play costumes for infants, children, parents, families, and educators for use in arts-related role-playing games |
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Grounds for Opposition

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

| | | | |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1525762 | Application Date | 05/14/1987 |
| Registration Date | 02/21/1989 | Foreign Priority Date | NONE |
| Word Mark | STAGE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1969/01/15 First Use In Commerce: 1969/02/17 [WOMEN'S READY TO WEAR APPAREL, NAMELY, SHIRTS, DRESSES, COATS, BELTS AND SHOES] Class 042. First use: First Use: 1969/01/15 First Use In Commerce: 1969/02/17 RETAIL STORE SERVICES IN THE FIELD OF CLOTHING, SHOES AND ACCESSORIES | | |

| | |
|-------------|--|
| Attachments | NoticeOfOpposition.86665765.TakeTheStage.pdf(4087045 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 | /Jessica L. John Bowman/ |
| Name | Jessica L. John Bowman |
| Date | 01/19/2016 |

3. Applicant seeks to register the word mark TAKE THE STAGE (“Applicant’s Mark”) on the Principal Register for: “Clothing, footwear, and headwear for male and female infants, children, young adults, parents, families, and educators, namely, shirts, sweatshirts, tank tops, t-shirts, pants, jackets, shorts, vests, socks, leggings, sleepwear, uniforms, infants' sleepers, pajamas, nightgowns, robes, dresses, jumpers, skirts, sweaters, underwear, beachwear, swimwear, bathing suits, flip flops, sun visors, gym shorts, warm-up suits, playsuits, baby bibs not made of paper, scarves, belts, ties, bandannas, suspenders, hats, ballet shoes, neckwear, shoes, boots, rain boots, mittens, gloves, coats, rainwear, ponchos, dancewear, theater costumes, and Halloween and Masquerade costumes; play costumes for infants, children, parents, families, and educators for use in arts-related role-playing games” in International Class 25.

4. The Opposed Application was filed on June 17, 2015 under Section 1(b), based upon a bona fide intent to use Applicant’s Mark in commerce, or to use Applicant’s Mark in commerce through a related company or licensee.

5. The Opposed Application was published for opposition on January 19, 2016.

6. SRI offers retail store services in the field of clothing, shoes and accessories throughout the United States.

7. At least as early as 1969, SRI and/or its predecessor-in-interest began using the distinctive trademark STAGE in connection with retail store services in the field of clothing, shoes and accessories.

8. SRI and/or its predecessor-in-interest, Fashion Bar, Inc., filed with the U.S. Patent and Trademark Office (“USPTO”) Application Serial No. 73/660,706 to register the mark STAGE for use in connection with retail store services in the field of clothing, shoes and accessories in International Class 42.

9. On February 21, 1989, the USPTO issued United States Registration No. 1,525,762 (the “STAGE Mark”). The Registration was assigned to SRI by an agreement executed on January 21, 1994. A copy of the assignment is recorded at <http://tsdr.uspto.gov/documentviewer?caseId=sn73660706&docId=IPC20080721123358#docIndex=8&page=1>, and is attached hereto as Exhibit A, and is incorporated herein. A copy of the Registration, now incontestable, is attached hereto as Exhibit B, and is incorporated herein.

10. SRI has expended a great deal of effort and money to market and promote its retail store services in the field of clothing, shoes and accessories associated with its STAGE Mark. By carefully controlling the quality of the services, SRI has built up an excellent reputation and valuable goodwill in association with the STAGE Mark.

11. The Opposed Application is for the mark TAKE THE STAGE on the Principal Register for: “Clothing, footwear, and headwear for male and female infants, children, young adults, parents, families, and educators, namely, shirts, sweatshirts, tank tops, t-shirts, pants, jackets, shorts, vests, socks, leggings, sleepwear, uniforms, infants' sleepers, pajamas, nightgowns, robes, dresses, jumpers, skirts, sweaters, underwear, beachwear, swimwear, bathing suits, flip flops, sun visors, gym shorts, warm-up suits, playsuits, baby bibs not made of paper, scarves, belts, ties, bandannas, suspenders, hats, ballet shoes, neckwear, shoes, boots, rain boots, mittens, gloves, coats, rainwear, ponchos, dancewear, theater costumes, and Halloween and Masquerade costumes; play costumes for infants, children, parents, families, and educators for use in arts-related role-playing games” in International Class 25.

12. The Opposed Application concerns goods closely related to the services offered by SRI under the STAGE Mark and listed in the valid and incontestable registration for the STAGE Mark.

13. The Opposed Application concerns goods that are encountered by the same customers as those who utilize services offered by SRI under SRI's incontestable and valid STAGE Mark.

14. The retail services offered by SRI under SRI's incontestable and valid STAGE Mark feature products similar to, if not identical to, the products listed in the Opposed Application.

15. The Opposed Application concerns goods that travel through channels of trade that are similar to, if not identical to, the trade channels through which the services offered by SRI under SRI's valid and incontestable STAGE Mark travel.

16. Applicant's Mark contains SRI's valid and incontestable STAGE Mark in its entirety.

17. Applicant's Mark and SRI's valid and incontestable STAGE Mark are virtually identical in appearance, sound and commercial impression.

18. The similarities between Applicant's Mark and SRI's valid and incontestable STAGE Mark are such that the average purchaser, viewing the marks in their entireties, would be confused as to the source of goods or services associated with the marks.

19. SRI's rights to the valid and incontestable STAGE Mark date back to at least as early as 1969. USPTO records indicate that the Applicant's earliest possible constructive use of Applicant's mark is over forty-five years later, on June 17, 2015, the filing date of the 1(b) application. SRI thus has priority of use.

20. If Applicant is allowed to register the Opposed Application, it will obtain statutory rights to the mark that will conflict with and substantially degrade SRI's rights in the

above-mentioned and attached registration, as well as SRI's superior common-law rights to the STAGE Mark.

21. SRI's goodwill and reputation will be jeopardized by Applicant's registration of the Opposed Application due to SRI's lack of control over the quality of Applicant's goods and services.

22. Concurrent use and/or registration of Applicant's Mark and the STAGE Mark is likely to cause confusion and lead to deception as to the origin of the goods that are associated with the Opposed Application. Concurrent use and/or registration of the Applicant's Mark and the STAGE Mark would allow Applicant to be unjustly enriched by, and reap the benefit of, the goodwill and reputation that SRI has developed in association with its STAGE Mark. Accordingly, registration of the Opposed Application will be a source of damage and injury to SRI.

WHEREFORE, SRI respectfully requests that this Opposition be sustained, that registration of the mark TAKE THE STAGE in International Class 25 as evidenced by United States Application Serial No. 86/665,765 be refused, and that SRI be awarded any other and further relief as is deemed just and proper.

Dated: January 19, 2015.

Respectfully submitted,



Anthony L. Rahhal

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Attorneys for Opposer

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the above and foregoing NOTICE OF OPPOSITION was mailed, postage prepaid thereon, on this 19th day of January, 2016 to:

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Attorneys for Opposer

1099/0115

MARCH 1, 1994



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

N07A

TO: GREGORY W. CARR
GARDERE & WYNNE, L.L.P.
1601 ELM ST., STE. 300
DALLAS, TEXAS 75201

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT BRANCH OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE U.S. PATENT AND TRADEMARK OFFICE ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE TRADEMARK ASSIGNMENT PROCESSING SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U. S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT BRANCH, NORTH TOWER BUILDING, SUITE 10C35, WASHINGTON, D.C. 20231.

ASSIGNOR:
FASHION BAR, INC.

DOC DATE : 01/21/1994
CITIZENSHIP : COLORADO

ENTITY : CORPORATION

ASSIGNOR:
3 BEALL BROTHERS 3, INC.

DOC DATE : 01/21/1994
CITIZENSHIP : TEXAS

ENTITY : CORPORATION

ASSIGNOR:
PALAIS ROYAL, INC.

DOC DATE : 01/24/1994
CITIZENSHIP : TEXAS

ENTITY : CORPORATION

ASSIGNEE:
SPECIALTY RETAILERS, INC.
10201 S. MAIN
HOUSTON, TX 77025
ENTITY : CORPORATION

CITIZENSHIP : DELAWARE

BRIEF:

GARDERE & WYNNE
MAR 2 1 1994

ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

NO. OF PAGES : 012
REEL/FRAME : 1099/0115 *87535-51* DATE RECORDED : 02/03/1994

APPLICATION NUMBER : 73-660672 FILING DATE : 05/14/1987
REGISTRATION NUMBER: 1475067 REGISTRATION DATE: 02/02/1988

MARK: HANNAH
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

APPLICATION NUMBER : 73-660673 *87535-52* FILING DATE : 05/14/1987
REGISTRATION NUMBER: 1475068 REGISTRATION DATE: 02/02/1988

MARK: FB CAREERS
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

APPLICATION NUMBER : 73-660674 *87535-53* FILING DATE : 05/14/1987
REGISTRATION NUMBER: 1475069 REGISTRATION DATE: 02/02/1988

MARK: FASHION BAR
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

APPLICATION NUMBER : 73-660675 *87535-54* FILING DATE : 05/14/1987
REGISTRATION NUMBER: 1475070 REGISTRATION DATE: 02/02/1988

MARK: FB PETITE
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

APPLICATION NUMBER : 73-660706 *87535-46* FILING DATE : 05/14/1987
REGISTRATION NUMBER: 1525762 REGISTRATION DATE: 02/21/1989

MARK: STAGE
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

APPLICATION NUMBER : 73-670295 *87535-55* FILING DATE : 07/06/1987
REGISTRATION NUMBER: 1543605 REGISTRATION DATE: 06/13/1989

MARK: FB
DRAWING TYPE: STYLIZED WORDS, LETTERS, OR NUMBERS

APPLICATION NUMBER : 73-560559 *87535-9* FILING DATE : 09/27/1985
REGISTRATION NUMBER: 1563887 REGISTRATION DATE: 10/31/1989

MARK: BEALLS
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS IN TYPED FORM

APPLICATION NUMBER : 73-691051 *87535-35* FILING DATE : 10/22/1987
REGISTRATION NUMBER: 1568465 REGISTRATION DATE: 11/28/1989

MARK: WYNWOOD COLLECTION
DRAWING TYPE: WORDS, LETTERS, OR NUMBERS AND DESIGN

Anne Harrell

EXAMINER/PARALEGAL
ASSIGNMENT BRANCH
ASSIGNMENT/CERTIFICATION SERVICES DIVISION

RECORDATION FORM COVER SHEET

TRADEMARKS ONLY

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Tab settings: □ □ □

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

Record 3-03-94

1. Name of conveying party(ies):

Fashion Bar, Inc.

- Individual(s)
- General Partnership
- Corporation-State
- Other
- Association
- Limited Partnership

Additional name(s) of conveying party(ies) attached? Yes No

3. Nature of conveyance:

- Assignment
- Security Agreement
- Other
- Merger
- Change of Name

Execution Date: January 21, 1994

2. Name and address of receiving party(ies)

Name: Specialty Retailers, Inc.

Internal Address: _____

Street Address: 10201 S. Main

City: Houston State: TX ZIP: 77025

- Individual(s) citizenship
- Association
- General Partnership
- Limited Partnership
- Corporation-State Delaware
- Other

If assignee is not domiciled in the United States, a domestic representative designation is attached: Yes No

(Designations must be a separate document from assignment)
Additional name(s) & address(es) attached? Yes No

4. Application number(s) or patent number(s):

A. Trademark Application No.(s)

B. Trademark Registration No.(s)

- 1,475,067
- 1,475,068
- 1,475,069
- 1,475,070
- 1,525,762
- 1,543,605
- 1,563,887
- 1,568,465

Additional numbers attached? Yes No

TRADEMARK
FEB 10 9 9 AM '94

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Gregory W. Carr

Internal Address: Gardere & Wynne, L.L.P.

Street Address: 1601 Elm St., Suite 3000

City: Dallas State: TX ZIP: 75201

6. Total number of applications and registrations involved: 8

7. Total fee (37 CFR 3.41).....\$ 215.00

- Enclosed
- Authorized to be charged to deposit account

8. Deposit account number:

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

050 MS 02/11/94 1475067

0 481 40.00 CK

89150239

050 MS 02/11/94 1475067

0 482 175.00 CK

9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Gregory W. Carr
Name of Person Signing

Gregory W. Carr
Signature

January 25, 1994
Date

Total number of pages including cover sheet, attachments, and document: 12

Int. Cls.: 25 and 42

Prior U.S. Cls.: 39 and 101

United States Patent and Trademark Office **Reg. No. 1,525,762**
Registered Feb. 21, 1989

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

STAGE

FASHION BAR, INC. (COLORADO CORPORATION)
401 BUCKLEY ROAD
AURORA, CO 80017

FOR: WOMEN'S READY TO WEAR APPAREL, NAMELY; SHIRTS, DRESSES, COATS, BELTS AND SHOES, IN CLASS 25 (U.S. CL. 39).
FIRST USE 1-15-1969; IN COMMERCE 2-17-1969.

FOR: RETAIL STORE SERVICES IN THE FIELD OF CLOTHING, SHOES AND ACCESSORIES, IN CLASS 42 (U.S. CL. 101).

FIRST USE 1-15-1969; IN COMMERCE 2-17-1969.

SER. NO. 660,706, FILED 5-14-1987.

DEBORAH S. COHN, EXAMINING ATTORNEY