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

In the matter of Application Serial No. 76/024,587

NEW BALANCE ATHLETIC SHOE, INC.,
Opposer,

v.

H. JOHN CAMPAIGN,
Applicant.

02-24-2003

U.S. Patent & TMOrc/TM Mail Rcpt Dt. #01

Opposition No. 91122837

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: BOX TTAB NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on the date set forth below.

Feb. 19, 2003

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By:

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OPPOSER'S BRIEF

Table of Contents

Index of Cases and Authorities	ii
Introduction	1
Applicant’s Counterclaim For Cancellation Should be Dismissed For Failure To Present Evidence	1
Applicant’s Application Should Be Refused Because Of Opposer’s Registrations	1
Applicant’s Application Should Be Refused Because It Was Not “Bona Fide”	3
Conclusion.....	4
Appendix A	File History of Serial No. 76/024,587
Appendix B	Registration No. 664,453
Appendix C	Amendment of Registration No. 664,453
Appendix D	Registration No. 1,251,718
Appendix E	Applicant’s Response to Opposer’s First Set of Interrogatories to Applicant

Index of Cases and Authorities

Cases

In re E.I. duPont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973)..... 2

Statutes

The Lanham Act, 15 U.S.C. §1052(d) 2

The Lanham Act, 15 U.S.C. §1051(b) 3

Legislative History

House Cong. Rec. H10419 (October 19, 1988) 3

Introduction

New Balance Athletic Shoe, Inc. brought this opposition against an application by H. John Campaign to register FLEXIBLE FLYERS for "footwear," based on its ownership of trademark registrations of P F FLYERS for "footwear - namely, rubber-soled canvas footwear" and for "footwear, athletic shoes."

The Notice of Opposition also included an allegation that the Applicant did not have a bona fide intention to use the mark on footwear when his application was filed.

Applicant, in his answer, denied the allegations, and counterclaimed for cancellation of Opposer's registrations on the ground of abandonment.

Applicant has submitted no evidence whatsoever. Opposer submitted a Notice of Reliance with certified copies of its registrations, and a copy of Applicant's responses to interrogatories.

Attached as an appendix to this brief are copies of all the evidence present in the proceeding: Applicant's file history, Opposer's two registrations, and Applicant's response to interrogatories.

Applicant's Counterclaim For Cancellation Should Be Dismissed For Failure To Present Evidence

Since Applicant has submitted no evidence whatsoever, the Trademark Trial and Appeal Board should dismiss his cancellation counterclaim since it has absolutely no support.

Applicant's Application Should Be Refused Because Of Opposer's Registrations

One of the bases for opposition by Opposer is that Applicant's application should be refused registration because, in the words of Section 2(d) of the Lanham Act, it

“Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office ..., as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d)

The determination as to whether such a “likelihood of confusion” exists is based on weighing factors like those enumerated in In re E.I. duPont de Nemours & Co., 177 U.S.P.Q. 563 (C.C.P.A. 1973).

Applicant’s application is to register FLEXIBLE FLYERS for “footwear.” Opposer’s registrations are for P F FLYERS for “footwear - namely, rubber-soled canvas footwear” (Registration No. 664,453) and for “footwear, athletic shoes” (Registration No. 1,251,718).

The goods of the application and the registrations are identical, in that they all are “footwear.” Accordingly, all the duPont factors dealing with goods, such as the nature of the goods themselves, their trade channels, and their marketing channels, weigh heavily in favor of a finding of likelihood of confusion.

The marks that are involved are tested as to similarity in appearance, sound, connotation and commercial impression. In this case, the marks are dominated by the identical word “FLYERS” so that this important part of both marks is precisely identical in appearance, sound, connotation and commercial impression. “FLYERS” is a strong, arbitrary, part of Opposer’s registered mark.

The marks of Applicant and Opposer, to be sure, have different prefixes, “FLEXIBLE,” on one hand, and “P F,” on the other. Since “flexible” has descriptive connotations for footwear, and “P F” is essentially meaningless, these prefixes do not provide strong contrasts that would help distinguish the otherwise identical suffix portions of the marks.

Accordingly, the presence of greatly similar marks, applied to identical goods, in the Applicant's application and Opposer's registrations, provides the necessary basis for refusing registration to Applicant.

**Applicant's Application Should Be Refused
Because It Was Not "Bona Fide"**

The Trademark Law requires that a person applying to register a trademark based on intent to use it have "a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" (15 U.S.C. §1051(b)).

The legislative history of this intent-to-use portion of the Lanham Act includes the Congressional Record of October 19, 1988, setting forth the compromise version of the Trademark Law Revision Act of 1988, which became Public Law 100-667, with remarks by Representative Kastenmeier. About the nature of adjustments in the language of the bill agreed to between the Senate and the House of Representatives, Mr. Kastenmeier said,

"S. 1883 adds to subsection (b) the language 'under circumstances showing the good faith of such person.' This addition strengthens the congressional intention that the circumstances surrounding the application show that the applicant's intention to use the mark ultimately, and within the specified time limits, is in fact bona fide. Courts should consider these circumstances, or the lack of them, when issues surrounding the validity of the application are raised."
House Cong. Rec. H10419 (October 19, 1988).

In contrast to this requirement, Applicant, a trademark attorney (as can be determined from the letterhead on the letter forwarding the application to the Patent and Trademark Office), has no past or present experience in the manufacture or sale of footwear, the subject of the application (Response to Interrogatory No. 3). There are no parties that are, or were, a "related company" of Applicant (Response to Interrogatory No. 4). The Applicant's only basis for asserting a bona fide intent to use the mark is his "long lasting love affair with the name 'FLEXIBLE FLYERS' and a belief that it will be a most appropriate trademark for footwear, particularly basketball shoes" (Response to Interrogatory No. 1). The Applicant's only basis for

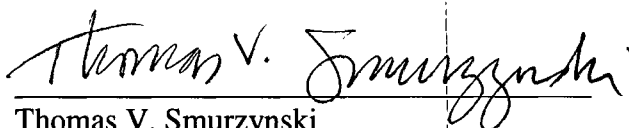
asserting an intention to license the mark is to say that, "Provided that registration of 'FLEXIBLE FLYERS' could be obtained for such goods, applicant had every intention in the world of contacting a manufacturer of footwear for the purpose of manufacturing the goods and/or using the trademark "FLEXIBLE FLYERS' thereon" (Response to Interrogatory No. 2). These are not circumstances showing the good faith of the Applicant.

What these facts and stated intentions show is that Applicant filed a speculative application to register a mark that he hoped would survive examination and the opposition period, whereupon he would shop the mark around (using the euphemism, "offering to license it"). This activity is precisely the kind of activity that the framers of the intent-to-use provisions of the trademark law wanted to prohibit by requiring a "bona fide" intent to use the mark, rather than an intent to stockpile the mark and traffic in it, as Applicant proposes to do.

Conclusion

Applicant's Counterclaim for Cancellation has no supporting evidence. It should be dismissed. Applicant's application should be refused registration because (a) Opposer owns two registrations for a very similar mark for the identical goods, and (b) Applicant did not have a bona fide intent to use the mark when he filed the application.

Respectfully submitted,

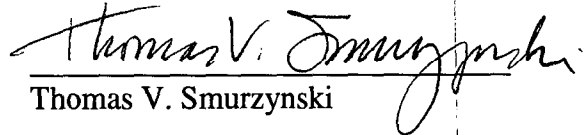


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Dated: February 19, 2003

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing OPPOSER'S BRIEF was served by first-class mail, postage prepaid, on Applicant, H. John Campaign, Esq., The Bar Building, 36 West 44th Street, New York, NY, 10036, on this 19th day of February, 2003.


Thomas V. Smurzynski