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

06-24-2002

U.S. Patent & TMO/TM Mail Ropt Dt. #71

GAP (APPAREL), INC.

Opposer,

v.

American Fast Freight, Inc.,

Applicant.

NOTICE OF OPPOSITION

Opposition No. \_\_\_\_\_

Published in the Official Gazette on April 23, 2002

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TRADEMARK TRIAL AND APPEAL BOARD

Opposer, Gap (Apparel) Inc., a California corporation, with an address at 900 Cherry Avenue, San Bruno, California 94066 ("Opposer") believes that it will be damaged by the registration of the mark EGAP shown in Serial No. 76/040590 in International Classes 35 and 36, and hereby oppose the same.

This Notice of Opposition has been timely filed, Opposer having been granted a thirty (30) day extension of time in which to oppose until June 22, 2002.

As grounds for opposition, Opposer allege the following:

- By application serial no. 76/040590 herein opposed, applicant American Fast Freight, Inc. ("Applicant") seeks to register the mark EGAP for "International e-commerce services provided online via a global computer network, namely online cost/price analysis, namely calculating and displaying costs of a product or service that includes freight, duty, tax and transportation charges converted to the currency and language of the customer, computerized tracking and tracing of packages in transit, namely electronic tracking and confirmation of product orders and coordinating delivery of products for others; import and export agency services namely calculating and handling import and export logistics, taxes and duties, billing documents, and shipping documents" in International Class 35, and for "Insurance services, namely insuring products against loss or damage during shipment by courier, underwriting compliance and foreign accounts receivable insurance" in International Class 36. Applicant filed its application on May 4, 2000, based on an intent-to-use basis. The EGAP mark was published for opposition in the Official Gazette on April 23, 2002.

2. Opposer owns the various GAP, GAP and Design, and other GAP marks identified and described herein (collectively, "GAP MARKS"), and has licensed each of these marks to The Gap, Inc. and its related companies (collectively, "Gap, Inc.") for use in interstate commerce throughout the United States and in connection with a variety of goods and services.

3. Opposer and its predecessors in title or their licensees have used the GAP MARKS in commerce as indicated on the chart below, in connection with retail store services including online services, clothing, clothing accessories, and a wide variety of other products and services (including products and services in International Classes 35 & 36), long prior to Applicant's intent-to-use filing of the above-referenced application.

4. Opposer has the authority to prosecute this opposition proceeding.

5. Opposer is the owner of the U.S. trademark registrations shown in the chart below, all of which are valid and subsisting and constitute prima facie evidence of Opposer's exclusive right to use its marks in commerce in connection with the goods and services identified in the registrations. These goods and services include, clothing, clothing accessories, retail stores services as well as on-line services, food, jewelry, charitable services, credit card services, personal care products, toys, bags and backpacks, paper products, bed and bath linens. The dates of registration and/or first use of Opposer's marks identified herein precede that of Applicant's application intent-to-use filing and/or future use of Applicant's mark by many years:

Mark	Reg. No.	Reg. Date	First Use	Class
THE GAP	944,941	10/10/72	8/23/69	42
THE GAP (Stylized)	944,942	10/10/72	8/23/69	42
THE GAP and Design	1,097,038	7/18/78	8/23/69	42
THE GAP (Stylized)	1,055,151	12/28/76	6/25/74	25
GAP	1,129,294	1/15/80	6/25/74	25
GAP	1,406,870	8/26/86	6/25/74	25
GAP	1752562	2/16/93	8/1/88	18
GAP	2,003,751	9/24/96	11/1/94	3, 4, 21
GAP	2,020,312	12/3/96	7/23/88	42
GAP	2,049,950	4/1/97	2/96	30
GAP	2,070,168	6/10/97	4/15/95	3, 21
GAP	2,138,241	4/14/98	10/10/96	16
GAP	2,146,558	3/24/98	11/25/96	14
GAP	2,527,652	1/8/02	8/1/88	18
GAP	2,341,527	4/11/00	12/2/96	24
GAP	2,482,507	8/28/01	10/1/96	3
GAP	2,532,258	1/22/02	4/15/95	3
GAP	2,512,889	11/27/01	11/4/97	35
GAP	2,528,640	1/8/02	8/29/00	36
GAP	1,912,356	8/15/95	2/27/94	9
GAP (Stylized)	1,576,510	1/9/90	7/23/88	25
GAP and Design	1,745,875	1/12/93	12/88 6/87	25 42
GAP (Stylized)	1,808,207	11/30/93	7/23/88	42
GAP and Design	2,431,833	2/27/01	12/1/88	25
GAP and Design	2,481,998	8/28/01	10/1/97	3
GAP and Design	2,431,835	2/27/01	10/1/98	4
GAP and Design	2,481,997	8/28/01	10/1/97	3
GAP and Design	2,431,834	2/27/01	10/1/98	4
GAP (Stylized)	2,500,467	10/23/01	8/1/88	18
GAP (Stylized)	2,496,373	10/09/01	6/1/87	35
GAP (Stylized)	2,482,506	8/28/01	10/1/94	4
GAP (Stylized)	1,129,295	1/15/80	6/25/74	25
GAP.COM	2,221,076	2/2/99	12/16/97	42
GAP.COM	2,540,610	2/19/02	11/4/97	35
GAP BODY	2,498,434	10/16/01	8/6/98	35
GAP BODY (and Design)	2,356,121	6/6/00	8/6/98	35
GAP KIDS	1,416,059	11/4/86	3/24/86	25, 42
GAP KIDS	1,587,827	3/20/90	8/1/86	18
GAP KIDS	2,498,432	10/16/01	8/1/88	18
GAP KIDS	1,912,355	8/15/95	4/1/94	9
GAP KIDS (and Design)	1,744,610	1/5/93	1/3/92	25, 42
GAP KIDS (Stylized)	1,750,214	2/2/93	1/3/92 8/91	25 42
GAP KIDS (and Design)	2,481,933	8/28/01	8/1/91	35, 42
GAP KIDS (and Design)	2,500,468	10/23/01	8/1/91	35
GAP KIDS (and Design)	2,501,641	10/30/01	8/1/91	35, 42
GAP KIDS (Stylized)	2,496,372	10/09/01	1/3/92	25
GAP KIDS (Stylized)	2,481,934	8/28/01	8/1/91	35, 42
GAP KIDS (and Design)	1,416,058	11/4/86	3/27/86	25, 42

GAPKIDS.COM	2,176,659	7/28/98	3/28/97	42
GAPKIDS.COM	2,498,433	2/19/02	10/27/98	35
GAP SCENTS	2,006,270	10/8/96	11/1/94	3, 4
BABY GAP	1,671,790	1/14/92	1/29/90	24
BABYGAP	1,675,154	2/11/92	1/29/90	25
BABY GAP	2,526,898	1/8/02	2/6/90	25
BABY GAP	2,481,935	8/28/01	1/29/90	35, 42
BABYGAP	1,906,665	7/18/95	1/1/93	28
BABYGAP	2,176,915	7/28/98	2/6/90	35
BABYGAP.COM	2,410,999	12/5/00	11/2/98	42
BABY GAP (Stylized)	1,829,759	4/5/94	6/92	25, 42
BABY GAP and Design	1,856,136	9/27/94	11/92	25, 42
BABY GAP and Design	1,749,044	1/26/93	8/1/91	42
BABY GAP and Design	2,481,996	8/28/01	11/1/92	25
BABY GAP and Design	2,481,936	8/28/01	8/1/91	35, 42
BABY GAP and Design	2,497,963	10/16/01	11/1/92	25
BABY GAP and Design	2,501,642	10/30/01	8/1/91	35, 42
BABY GAP (Stylized)	1,746,201	1/12/93	8/1/91	42
BABY GAP (Stylized)	2,481,995	8/28/01	6/1/92	25
BABY GAP (Stylized)	2,481,937	8/28/01	8/1/91	35, 42
GAP OUTLET	2,020,323	12/3/96	4/3/95	42
GAP ATHLETIC	1,950,476	1/23/96	3/16/94	25
GAP SCENTS	2,006,270	10/8/96	11/1/94	3, 4
GAPSHARE	1,708,644	8/18/92	6/10/91	36
GAP FOUNDATION	1,861,981	11/8/94	4/18/84	36, 42

6. Opposer has superior rights in and to the GAP MARKS because their use of the marks predates Applicant's intent-to-use filing date.

7. Opposer has sold goods and offered services bearing the GAP MARKS throughout the United States and abroad. The above-identified family of GAP MARKS owned by Opposer and used in interstate commerce by its licensees, are symbolic of the extremely valuable goodwill and substantial consumer recognition that Opposer has created in the GAP MARKS by virtue of extensive sales, prominent advertising and promotion, and the excellent quality of GAP products and services. The above-identified GAP MARKS, alone or as a family, are thus entitled to a wide range of protection, including protection against Applicant's use of the confusingly similar EGAP mark.

8. Applicant's mark, namely EGAP, is nearly identical in sight, sound, and connotation to Opposer's registered GAP MARKS and, as such, is likely to be confused therewith and mistaken therefor. Applicant's mark is deceptively similar to Opposer's marks so as to cause confusion and lead to deception as to the origin of Applicant's services bearing the mark.

9. Applicant is using the mark EGAP in connection with "international e-commerce services provided online via a global computer network, namely online cost/price analysis, namely calculating and displaying costs of a product or service that includes freight, duty, tax and transportation charges converted to the currency and language of the customer, computerized tracking and tracing of packages in transit, namely electronic tracking and confirmation of product orders and coordinating delivery of products for others; import and export agency services namely calculating and handling import and export logistics, taxes and duties, billing documents, and shipping documents" in International Class 35, and for "insurance services, namely insuring products against loss or damage during shipment by courier, underwriting compliance and foreign accounts receivable insurance" in International Class 36. If Applicant is permitted to register its mark for the aforementioned services as specified in its application, confusion in trade resulting in damage and injury to the Opposer would be caused and would result by reason of similarity between the Applicant's mark and Opposer's marks. Consumers familiar with Opposer's marks would be likely to associate Applicant's services as a service offered and sold by the Opposer. Furthermore, Applicant's use of its EGAP mark likely would cause consumers to believe incorrectly that Applicant's services originate from, are associated with, are connected to, or are sponsored by, Opposer. This is particularly likely here as both Opposer's goods and services, and Applicants proposed services are consumer services sold to the general public.

10. Moreover, any defect, objection or fault found with Applicant's services marketed under its EGAP mark would necessarily reflect upon and seriously injure the excellent reputation which the Opposer has established for its products and services.

11. If Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

12. Opposer's family of GAP MARKS, described above are used nationwide, and constitute as "famous" marks under Section 43(c) of the Lanham Act. The GAP MARKS have acquired considerable fame through extensive sales, advertising and promotion throughout the United States over the last 33 years.

13. Opposer through its licensees, have been using the GAP MARKS on a wide variety of goods and services since 1969.

14. In the years since 1969, Opposer and its licensees, have extensively advertised and promoted the products and services sold under the GAP MARKS in newspapers, magazines, billboards and on the radio, television and the internet.

15. The GAP MARKS and the goods and services sold thereunder have received extensive press coverage over the past 33 years.

16. Applicant's commercial use of its EGAP mark in connection with "international e-commerce services provided online via a global computer network, namely online cost/price analysis, namely calculating and displaying costs of a product or service that includes freight, duty, tax and transportation charges converted to the currency and language of the customer, computerized tracking and tracing of packages in transit, namely electronic tracking and confirmation of product orders and coordinating delivery of products for others; import and export agency services namely calculating and handling import and export logistics, taxes and duties, billing documents, and shipping documents" in International Class 35, and for "insurance services, namely insuring products against loss or damage during shipment by courier, underwriting compliance and foreign accounts receivable insurance" in International Class 36 is likely to dilute the distinctive quality of Opposer's family of famous GAP MARKS by blurring the distinctiveness of the famous GAP MARKS.

17. The use or addition of the letter "E" in connection with other words has come to mean "*electronic*" or otherwise internet related. The internet and web-based internet environment have become an importance means of communication and commerce. The letter "E" in Applicant's mark is not distinctive or material to identify Opposer's well-known marks from Applicant's pending mark. In conducting research on the internet, over 5,000,000 words appeared incorporating the letter "E" in connection with services relating to internet use. Such words that appeared in the search are "*e-commerce, e-mail, e-pages, e-online, e-vision, e-media, e-cell, e-studio, e-businessexpress, e-speak, e-line, e-times, e-consultancy, e-street and e-quill*". As such, it is likely that the letter "E" may be ignored or glossed over by consumers and possibly should be disclaimed from Applicant's pending mark having the material part of Applicant's mark, "GAP", remaining. In sight, sound and meaning, the distinguishable and recognizable portion of the proposed mark is clearly identical and confusingly similar to Opposer's GAP MARKS. Therefore, Applicant's use of its mark for e-commerce services and for similar services will dilute, damage and tarnish the Opposer's GAP MARKS.

18. The possibility of confusion and/or dilution is heightened because Opposer owns registrations for numerous goods and services, including on-line services, and its licensees use the GAP MARKS in connection with a variety e-commerce services, including its commerce web sites www.gap.com, www.gapkids.com, www.gapbody.com, and www.babygap.com and its information web site www.gapinc.com. These sites not only offer for sale and sell clothing, but also provide shipping for such products. In addition, Opposer or its licensees conduct promotions and advertising via e-mail and over the internet.

WHEREFORE, Opposer prays that application Serial No. 76/040590 be rejected, that no registration be issued thereon to Applicant, that this opposition be sustained in favor of Opposer, and that such other and further relief as is deemed just and proper be awarded.

Opposer hereby gives notice under Rule 2.122(d) of the Rules of Practice that after hearing and in any appeal on this opposition proceeding, they will rely on their registrations as evidence in support of this Notice of Opposition.

Opposer hereby appoints Julie Gruber to act as attorney for Opposer, with full power to prosecute this opposition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts, and to receive all official communications in connection with this opposition.

This notice of opposition is submitted in duplicate in accordance with Trademark Rule 2.104(a).

Please charge deposit account number 500237 to cover the requisite filing fee.

Respectfully submitted,  
GAP (APPAREL) INC.

By: 

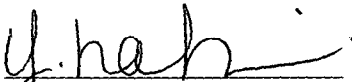
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Dated: 6/20/02 

**CERTIFICATE OF MAILING**

The undersigned hereby certifies that the foregoing documents with respect to Serial No. 76/040590 are being deposited, with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to:

ASSISTANT COMMISSIONER FOR TRADEMARKS  
BOX TTAB – FEE  
2900 CRYSTAL DRIVE  
ARLINGTON, VIRGINIA 22202-3513



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