

02/27/2003 08:00:00 AM
00/02/2003 08:00:00 AM

3. Upon information and belief, Profoot made no use of the mark THE NEUTRALIZER at least prior to August 14, 2002.

4. Brown Shoe believes that it will be damaged by registration of the THE NEUTRALIZER mark shown in Application Ser. No. 76/282,252 in International Class 25.

5. Applicant Profoot's mark was published for opposition on March 25, 2003, and Brown Shoe requested extensions of time to August 22, 2003, to file its Notice of Opposition.

6. Brown Shoe, and its predecessors, over the past one hundred twenty-five years have been engaged in the footwear business, and over the years this has included manufacture, distribution, marketing, promotion and wholesale and retail sale of a number of lines of footwear, including a footwear line known as "NATURALIZER."

7. Brown Shoe is the holder of the following federal trademark registrations:

a. Registration No. 236,545 issued December 13, 1927, for NATURALIZERS, for shoes made of leather, cloth, canvas, or combinations thereof, in Class 39. (A copy of the certificate of registration is attached hereto as Exhibit 1 and incorporated by reference herein).

b. Registration No. 780,404 issued November 17, 1964, for NATURALIZER, for shoes, in Class 39. (A copy of the certificate of registration is attached hereto as Exhibit 2 and incorporated by reference herein).

c. Registration No. 1,987,055 issued July 16, 1996, for NATURALIZER, for retail shoe store services, in Class 42. (A copy of the certificate of registration is attached hereto as Exhibit 3 and incorporated by reference herein).

00722720001100
00722720001100
00722720001100

8. While the records of the Trademark Office indicate that title to the registrations resides in Brown Group, Inc., Brown Shoe is actually Brown Group, Inc., by virtue of a change of corporate name.

9. Brown Shoe is the owner of the goodwill and the beneficiary of the good reputation associated with the NATURALIZER mark.

10. U.S. Registration No. 236,545 was last renewed for twenty (20) years on December 13, 1987.

11. U.S. Registration No. 780,404 was renewed for twenty (20) years on November 17, 1984, and the Section 15 Affidavit for the registration was accepted on January 6, 1970, making the registration incontestable.

12. Brown Shoe adopted the NATURALIZER trademark at least as early as 1927, and the NATURALIZER mark has been continuously used by Brown Shoe in interstate commerce on shoes since that time.

13. Brown Shoe continues to use its NATURALIZER trademark on or in connection with said goods, and thereby owns valuable common law rights as to said mark.

14. Brown Shoe adopted the mark NATURALIZER for retail shoe services at least as early as 1954, and said mark has been continuously used by Brown Shoe in interstate commerce for retail shoe services since that time.

15. Brown Shoe continues to use its NATURALIZER service mark in connection with said services, and thereby owns valuable common law rights in said mark.

16. Brown Shoe also has, well prior to the filing date of applicant's application for THE NEUTRALIZER, has used, and in some cases, presently uses its NATURALIZER trademark on or in connection with goods other than those listed in the registration goods

statements, including, but not limited to: activewear (ie. sweat suits); hats; belts; gloves; tee-shirts; umbrellas; tote bags; slippers; hosiery and legwear; boots; sandals; massaging foot cushions; handbags; socks; watches; earrings; music CD's; photo albums; fanny packs (ie. waist bags); shoe sprays; shoe polishes; and scented candles; and Brown Shoe thereby owns further valuable common law rights in said marks.

17. Brown Shoe also has, well prior to the filing date of applicant's said application for THE NEUTRALIZER, has used, and in some cases, presently uses its NATURALIZER service mark on or in connection with the distribution and/or sale of goods other than those listed in the registration goods statement, including, but not limited to activewear (ie. sweat suits); hats; belts; gloves; tee-shirts; umbrellas; tote bags; slippers; hosiery and legwear; boots; sandals; massaging foot cushions; handbags; socks; watches; earrings; music CD's; photo albums; fanny packs (ie. waist bags); shoe sprays; shoe polishes; and scented candles; and Brown Shoe thereby owns further valuable common law rights in said mark.

18. There is no issue of priority. Brown Shoe's use of the NATURALIZER mark significantly predates the filing date of Profoot's Application Ser. No. 76/441,636, and any date of first use that may be alleged by or available to Profoot.

19. THE NEUTRALIZER is virtually identical to Brown Shoe's federally registered NATURALIZER trademark. The word "THE" is widely recognized to have virtually no distinctive qualities, and therefore provides no distinction to Profoot's THE NEUTRALIZER mark against Brown Shoe's NATURALIZER mark.

20. The goods for both marks are closely related and commercially intertwined since Brown Shoe's NATURALIZER mark is used on shoes and on retail shoe services and upon information and belief Profoot's THE NEUTRALIZER mark is intended to be used on inserts

and insoles for placement footwear such as shoes. Moreover, since it is shoe owners who will purchase inserts and insoles, the customer base for both sets of goods is identical.

21. Brown Shoe has expended substantial amounts of money, time and effort in advertising, promoting and popularizing its NATURALIZER mark so that the trade in general and the purchasing public in particular have come to know and recognize NATURALIZER goods and services, and to know that the same originate with and belong to a single source which is Brown Shoe.

22. Brown Shoe's NATURALIZER mark is distinctive and famous.

Basis I
Likelihood of Confusion, Mistake or Deception

23. THE NEUTRALIZER so resembles Brown Shoe's mark as set forth in its aforesaid United States Trademark Registrations, and so resembles Brown Shoe's mark used in the United States, as to be likely, when used on or in connection with shoes as set forth in Profoot's application to cause confusion, or to cause mistake, or to deceive, all to the detriment of Brown Shoe.

24. Unless Brown Shoe's opposition is upheld, Profoot will be allowed to federally register THE NEUTRALIZER, thereby giving Profoot *prima facie* exclusive right to use the mark throughout the United States, which use will infringe Brown Shoe's NATURALIZER trademark and service mark through said likelihood of confusion, mistake and/or deception, to the harm of Brown Shoe.

25. Thus a registration should not issue for THE NEUTRALIZER for those goods in view of 15 USC §1052(d).

Basis II
Dilution Under 15 USC §1052

26. Brown Shoe's NATURALIZER mark is distinctive and famous within the meaning of 15 USC §1125(c)(1).

27. Brown Shoe is favorably known in the United States and has built up exceedingly valuable goodwill and good reputation in connection with its NATURALIZER mark.

28. Profoot's use of THE NEUTRALIZER will dilute the distinctive quality of Brown Shoe's federally registered NATURALIZER mark, and thereby dilute, jeopardize and damage Brown Shoe's goodwill and good reputation in those marks, in violation of 15 USC §1125(c)(1).

29. Profoot's use of THE NEUTRALIZER will dilute the distinctive quality of Brown Shoe's NATURALIZER common law mark, and thereby dilute, jeopardize and damage Brown Shoe's goodwill and good reputation in those marks, in violation of 15 USC §1125(c)(1).

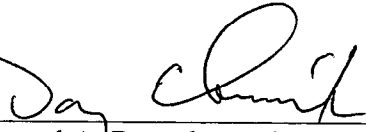
30. Thus a registration should not issue for THE NEUTRALIZER for those goods in view of 15 USC §1052.

WHEREFORE, Profoot is not entitled to register THE NEUTRALIZER and Opposer Brown Shoe Company, Inc., respectfully requests that this opposition be sustained and registration of THE NEUTRALIZER under Application Ser. No. 76/441,636 be denied.

Opposer submits this Opposition in duplicate along with a check in the sum of \$300 to cover the fees prescribed by 37 CFR 2.101(d)(1) and 37 CFR 2.6(a)(17). If there is an additional amount due, please charge deposit account 162201.

09/29/2008TTAB
09/29/2008TTAB
09/29/2008TTAB

Respectfully submitted,

By:  _____

Edward A. Boeschstein, Esq.
McPherson D. Moore, Esq.
Douglas D. Churovich, Esq.
Polster, Lieder, Woodruff & Lucchesi, L.C.
763 South New Ballas Road
St. Louis, MO 63141
Telephone 314.872.8118
Facsimile 314.991.2178

Attorneys for Opposer
Brown Shoe Company, Inc.

00722/2002TTAP
00722/2002TTAP

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Renewal

Reg. No. 236,545

Registered Dec. 13, 1927

OG Date Aug. 2, 1988

TRADEMARK
PRINCIPAL REGISTER

NATURALIZERS

BROWN GROUP, INC. (NEW YORK
CORPORATION)
3300 MARYLAND AVE.
ST. LOUIS, MO 63105, BY CHANGE OF
NAME FROM BROWN SHOE COMPA-
NY, INC. (NEW YORK CORPORA-
TION) ST. LOUIS, MO

FOR: SHOES MADE OF LEATHER,
CLOTH, CANVAS, OR COMBINATIONS
THEREOF, IN CLASS 39 (INT. CL. 25).

FIRST USE 7-14-1927; IN COMMERCE
7-14-1927.

SER. NO. 232,940, FILED 8-1-1927.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Aug. 2, 1988.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Opposer's Exhibit No. 1
Brown Shoe Company, Inc. (Opposer)

v.
Profoot, Inc. (Applicant)

United States Patent Office

780,404

Registered Nov. 17, 1964

PRINCIPAL REGISTER
Trademark

Ser. No. 137,006, filed Feb. 19, 1964

NATURALIZER

Brown Shoe Company, Inc. (New York corporation)
8300 Maryland Ave.
St. Louis, Mo.

For: SHOES, in CLASS 39.
First use on or about July 14, 1927; in commerce on
or about July 14, 1927.
Owner of Reg. No. 236,545.

Opposer's Exhibit No. 2
Brown Shoe Company, Inc. (Opposer)
v.
Profoot, Inc. (Applicant)

00/2 2/2 0000TTAB
00/2 2/2 0000TTAB



Int. Cl.: 42

Prior U.S. Cls.: 100 and 101

United States Patent and Trademark Office

Reg. No. 1,987,055

Registered July 16, 1996

SERVICE MARK
PRINCIPAL REGISTER

NATURALIZER

BROWN GROUP, INC. (NEW YORK CORPORATION)
8300 MARYLAND AVENUE
ST. LOUIS, MO 63105

OWNER OF U.S. REG. NOS. 236,545, 415,871,
AND 780,404.

FOR: RETAIL SHOE STORE SERVICES, IN
CLASS 42 (U.S. CLS. 100 AND 101).
FIRST USE 0-0-1954; IN COMMERCE
0-0-1954.

SER. NO. 74-694,949, FILED 6-29-1995.

EVERETT FRUEHLING, EXAMINING ATTORNEY