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

-----X
GTFM, INC.,)
)
Petitioner,)
)
v.)
)
THE NORTH FACE)
APPAREL CORP,)
)
Applicant.)
-----X



09-08-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #66

Opposition

No. _____

Re: Trademark Application:
Applicant: The North Face Apparel Corp., a Delaware corporation
Mark: A5
Serial No. 76/340,802
Filed: November 21, 2001
For: Sunglasses, safety glasses, optical frames and goggles, eyeglass lanyards, and clothing
Class: 9, 22 and 25
Published: August 19, 2003

NOTICE OF OPPOSITION

In the matter of an application for registration of the mark "A5", Serial No. 76/340802 for "men's, women's and children's footwear; men's, women's and children's headgear, namely, hats, caps and headbands; men's, women's and children's apparel, namely, t-shirts, sweatshirts, shirts, skirts, dresses, shorts, pants, swimsuits, swim trunks, parkas, vests, jackets, anoraks, ski bibs, ski suits, sweaters, gloves, mittens, underwear, belts and socks; sunglasses, safety glasses and protective eyewear, and replacement lenses for all of the foregoing; optical frames for men, women and children, and eyeglass cases, goggles for use in swimming, snow skiing, snow boarding, hiking,

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climbing, golfing, kayaking, tennis, motorcycling, boating, skateboarding, in-line skating, racquet ball and bicycling, eyeglass and sunglass chains; eyeglass and sunglass lanyards (International Classes 9, 22 and 25), filed under Section 1(b) of the Trademark Act on November 21, 2001 by The North Face Corp. of 3411 Silverside Road, 201 Baynard Building, Wilmington, Delaware 19810 (hereinafter called "Applicant"), published August 19, 2003, GTFM, Inc., a corporation organized under the laws of the State of New York, domiciled and doing business at 350 Fifth Avenue, Suite 6617, New York, New York 10118 (hereinafter called "Opposer"), believes that it would be damaged by such registration and hereby opposes the same.

The grounds for opposition, on information and belief, are as follows:

1. Opposer, GTFM, Inc., is now and has been engaged in the design, sale and distribution of clothing, footwear and headwear products, including, but not limited to, clothing, namely, athletic uniforms, headbands, neckbands, sweatbands, wristbands, bermuda shorts, blouses, cardigans, fur coats, lab coats, leather coats, overcoats, raincoats, sport coats, suit coats, top coats, dresses, dungarees, hats, headwear, gym shorts, bed jackets, fur jackets, leather jackets, wind resistant jackets, jeans jogging suits, jumpsuits, overalls, robes, shirts, skirts, suits, gym suits, play suits, ski suits, snow suits, sweat suits, vested suits, sweaters; footwear, namely, shoes, sneakers, athletic footwear, booties, boots sandals, slippers; undergarments, namely, boxer shorts, briefs, underwear, hosiery, knee highs, socks; belts, earmuffs, gloves, mittens and scarves.

2. Petitioner has used and presently uses the marks "05", and "FUBU 05" in connection with the design, sale and distribution of the products identified in paragraph 1.

3. Petitioner is the owner of registrations for "05" (Registration No. 2,415,190 dated December 26, 2000), and "FUBU 05" (Registration No. 2,415,191 dated December 26, 2000) which registrations are valid, subsisting and unrevoked. Copies of the PTO database printouts pertaining to these registrations are attached as Exhibit A and certified title and status copies will be provided at a later date.

4. Since prior to the filing date of Applicant's Intent To Use Application Serial No. 75/058,122 Opposer did use and has continuously used in interstate commerce the marks "05" and "FUBU 05" in connection with the various products described in paragraph 1 herein extensively throughout the United States. By reason of such extensive use and promotion, Opposer has attained an enviable reputation for high standards of quality, and the marks 05 and FUBU 05 and variations thereof have become distinctive of and associated in the minds of the trade and purchasing public with the Opposer.

5. Both Applicant's mark and Opposer's mark, 05, contain the number "5". Both marks consist of two syllables and are similar in sound and appearance. The only difference between the marks is that the Applicant's mark includes a letter "A" whereas the Opposer's mark includes the number "0." Because a significant portion of the two marks are almost identical, both and have a similar commercial impression. Furthermore, the goods of the Applicant are related and/or identical to the various products of Opposer as described in paragraph 1 herein, and are likely to move within

the same channels of trade and be purchased by the same class of purchaser so that Applicant's mark is likely, when used in association with the goods of Applicant, to cause confusion or to deceive purchasers in the mistaken belief that the goods of Applicant emanate from, are offered for sale, or are sold by Opposer or under Opposer's approval, sponsorship or control, all to the great damage of Opposer.

8. Opposer believes that Applicant's selection of the mark A5 may take advantage of the nationwide reputation of Opposer and its marks 05 and FUBU 05, and combination marks featuring the term 05, and may take advantage of the goodwill of Opposer gained by extensive and persistent advertising and expenditures of large sums of money therefore, and if continued in commerce, will be likely to confuse, mislead or deceive the trade and members of the public in suggesting to them that Applicant's mark identifies goods sold, sponsored or approved by Opposer or to suggest falsely a trade connection between Opposer and Applicant.

9. If specified goods of Applicant are inferior in quality, there will be irreparable injury to Opposer's valuable goodwill and its registered marks. Furthermore, the use and registration of the mark A5 will dilute the distinctive character of Opposer's valuable registered trademarks, and combination marks featuring the term 05.

WHEREFORE, Opposer, by and through its counsel, respectfully requests that the mark sought to be registered by Applicant be refused and that a Notice of Opposition be sustained.

Please recognize William H. Cox, William B. Randolph and Peter J. Vranum of the firm of Janvey, Gordon, Herlands, Randolph & Cox, LLP, all members of the Bar of

the State of New York, 355 Lexington Avenue, New York, New York 10017, as attorneys for Opposer.

A check for \$900.00 for the opposition fee is attached hereto, together with two copies of the Notice of Opposition.

Respectfully submitted,

JANVEY, GORDON, HERLANDS,
RANDOLPH & COX, LLP



William H. Cox, Esq.
Attorneys for Opposer
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New York, New York 10017
(212) 986-1200

Certificate of Mailing

I hereby certify that this Notice of Opposition - Serial No. 76/340802, is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

on September 4, 2003.



Peter J. Vranum



UNITED STATES PATENT AND TRADEMARK OFFICE

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TESS was last updated on Tue Sep 2 04:27:33 EDT 2003

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List At: OR to record: **Record 70 out of 81**

(*TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS*)

Typed Drawing

Word Mark 05

Goods and Services IC 025. US 022 039. G & S: CLOTHING, NAMELY, ATHLETIC UNIFORMS, HEADBANDS, [NECKBANDS,] SWEATBANDS, [WRISTBANDS,] BERMUDA SHORTS, BLOUSES, [CARDIGANS, FUR COATS, LAB COATS,] LEATHER COATS, OVERCOATS, RAINCOATS, SPORT COATS, [SUIT COATS, TOP COATS,] DRESSES, [DUNGAREES,] HATS, HEADWEAR, GYM SHORTS, [BED JACKETS, FUR JACKETS,] LEATHER JACKETS, WIND RESISTANT JACKETS, JEANS, JOGGING SUITS, [JUMPSUITS,] OVERALLS, ROBES, SHIRTS, SKIRTS, SUITS, [GYM SUITS, PLAY SUITS, SKI SUITS,] SNOW SUITS, SWEAT SUITS, VESTED SUITS, SWEATERS; FOOTWEAR, NAMELY, SHOES, SNEAKERS, ATHLETIC FOOTWEAR, [BOOTIES,] BOOTS, SANDALS, SLIPPERS; UNDERGARMENTS, NAMELY, BOXER SHORTS BRIEFS, UNDERWEAR, HOSIERY, KNEE HIGHS, SOCKS, BELTS, EARMUFFS, GLOVES, MITTENS, SCARVES. FIRST USE: 19961100. FIRST USE IN COMMERCE: 19961100

Mark

Drawing Code (1) TYPED DRAWING

Serial Number 75665400

Filing Date March 22, 1999

Published for Opposition October 3, 2000

Change In Registration CHANGE IN REGISTRATION HAS OCCURRED

Registration Number 2415190

Registration Date December 26, 2000

Owner (REGISTRANT) GTFM, Inc. CORPORATION NEW YORK 350 Fifth Avenue, Suite 6617 New York NEW YORK 10118

Attorney of Record MARY L. GREICO

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE LIST	TOP	HELP	PREV LIST
CURR LIST	NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC				



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Trademark Electronic Search System (TESS)

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List At: OR to record: **Record 69 out of 81**

(*TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS*)

Typed Drawing

Word Mark FUBU 05

Goods and Services IC 025. US 022 039. G & S: CLOTHING, NAMELY, ATHLETIC UNIFORMS, HEADBANDS, [NECKBANDS,] SWEATBANDS, [WRISTBANDS,] BERMUDA SHORTS, BLOUSES, [CARDIGANS, FUR COATS, LAB COATS,] LEATHER COATS, OVERCOATS, RAINCOATS, SPORT COATS, [SUIT COATS, TOP COATS,] DRESSES, [DUNGAREES,] HATS, HEADWEAR, GYM SHORTS, [BED JACKETS, FUR JACKETS,] LEATHER JACKETS, WIND RESISTANT JACKETS, JEANS, JOGGING SUITS, [JUMPSUITS,] OVERALLS, ROBES, SHIRTS, SKIRTS, SUITS, [GYM SUITS,] PLAY SUITS, [SKI SUITS,] SNOW SUITS, SWEAT SUITS, VESTED SUITS, SWEATERS; FOOTWEAR, NAMELY, SHOES, SNEAKERS, ATHLETIC FOOTWEAR, [BOOTIES,] BOOTS, SANDALS, SLIPPERS; UNDERGARMENTS, NAMELY, BOXER SHORTS, BRIEFS, UNDERWEAR, HOSIERY, KNEE HIGHS, SOCKS; BELTS, EARMUFFS, GLOVES, MITTENS, SCARVES. FIRST USE: 19961100. FIRST USE IN COMMERCE: 19961100

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75665548

Filing Date March 22, 1999

Published for Opposition May 23, 2000

Change In Registration CHANGE IN REGISTRATION HAS OCCURRED

Registration Number 2415191
Registration Date December 26, 2000
Owner (REGISTRANT) GTFM, Inc. CORPORATION NEW YORK 350 Fifth Avenue Suite 6617 New York NEW YORK 10118
Attorney of Record STEVEN R GURSKY
Prior Registrations 1910169;2068058;AND OTHERS
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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