

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

In the matter of Application Serial No. 76/550,187
Published in the Official Gazette of September 21, 2004

NEW BALANCE ATHLETIC SHOE, INC.,

Opposer,

v.

JAMES E. MANN and JAMEY STORVICK

Applicant.

Opposition No.

Attorney Docket No.: NBK-334-033

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, P. O. Box 1451, Alexandria, Virginia 22313-1451, on the date set forth below.

November 10, 2004

Date of Signature
and of Mail Deposit

Jeremiah Lynch

Jeremiah Lynch, Esq.
Registration No. 17,425

Commissioner for Trademarks
P. O. Box 1451
Alexandria, Virginia 22313-1451

Sir:



11-12-2004
U.S. Patent & TMOtc/TM Mail Rept Dt. #77

NOTICE OF OPPOSITION

New Balance Athletic Shoe, Inc., a corporation of the Commonwealth of Massachusetts having a principal place of business at 20 Guest Street, Boston, Massachusetts 02135 (hereinafter Opposer), believing that it will be damaged by the registration of the mark shown in application Serial No. 76/550,187, published for opposition in the Official Gazette on September 21, 2004,

hereby opposes the same for the goods in classes 25 and 28 and requests that registration be refused for the goods in classes 25 and 28. In payment of the fee of \$600 and any additional fees which may be due, please charge our deposit account No. 12-0080. As grounds for opposition it is alleged that:

1. From a date before 1951 and continuously thereafter to the present date, Opposer has manufactured, licensed and sold athletic shoes, sport shoes and leisure shoes throughout the United States and in commerce between the United States and foreign countries. On or about 1974 Opposer included T-shirts in its product line. On or about 1977 hats and tote bags were also included, followed in 1979 by singlets, running shorts, all-weather suits, and recreational tops and shorts. By 1982 the product line was further extended to include sport shirts, visors, socks, walking shoes, boat shoes, aerobic dancing shoes and hiking boots. Thus, by the last-mentioned date Opposer was offering an extended range of footwear and apparel products primarily directed to the athletic, sports, exercise, recreational and fitness market. From the last-mentioned date continuously to the present date, Opposer has manufactured, licensed and sold all of the above-stated products to a worldwide market comprising all of the United States and numerous foreign countries throughout the world.

2. On or about January 2, 1977, Opposer adopted and began using a block letter "N" as a trademark for its products, and ever since that date Opposer has continuously displayed the said trademark on the side and other parts of athletic shoes, sport shoes and leisure shoes. In December, 1995, Opposer began using a stylized letter "N" as a trademark for footwear.

By December, 1999, Opposer had begun using the stylized letter "N" as a trademark for athletic, exercise and sports apparel, namely, hats, T-shirts, sport shirts, singlets, shorts, pants, tights, jackets, running suits, all-weather suits, recreational tops and shorts and socks. Opposer obtained and is presently the owner of United States trademark registrations Nos. 1097551, 1308133, 1344589 and 2345832, copies of which are appended hereto and made a part hereof as Exhibits A, B, C and D, respectively. Each of the registrations in Exhibits A, B and C is presently incontestable under the provisions of section 15 of the Lanham Act, 15 U.S.C. §1065.

3. Opposer has expended large sums of money in the advertising and promotion of the marks referred to in paragraph 2 including the marks shown in Exhibits A, B, C and D, and by reason thereof Opposer has created a valuable reputation and goodwill on the part of the purchasing public in the field of athletic, sports, exercise, recreational and fitness footwear, bags and apparel, whereby the said marks are associated with and identify the Opposer as the source controlling the nature and quality of the footwear, bags and apparel goods identified above in paragraphs 1 and 2.

4. On information and belief, the Applicant seeks registration of the opposed mark for goods in classes 25 and 28 which are the same as or closely related to the goods of the Opposer. On information and belief, the said goods of Applicant in classes 25 and 28 are likely to be sold and will be sold to the same class of customers and through the same outlets including retail stores and the Internet where the above-recited goods of Opposer are sold, and are likely to be offered for sale in side-by-side relationship or in the same store departments as Opposer's goods.

5. The mark shown in the opposed application, as applied to the goods recited therein, so nearly resembles the Opposer's marks referred to in paragraph 2 including the marks shown in Exhibits A, B, C and D as to be likely to cause confusion, or to cause mistake, or to deceive purchasers and potential purchasers of said goods as to the source controlling, or the sponsorship of, the nature and quality of Applicant's goods and the goods of Opposer.

6. Under Section 7(b) of the Lanham Act, 15 USC 1057(b), if a certificate of registration were to issue to the Applicant it would be prima facie evidence inter alia, of the Applicant's right to use the registered mark in commerce on the Applicant's goods, and such use would be likely to cause confusion, or to cause mistake, or to deceive purchasers by reason of the similarity thereof to Opposer's marks referred to in paragraph 2.


7. By reason of the confusion, mistake or deception alleged in the preceding paragraphs 5 and 6, the Opposer will suffer great damage to its commercial reputation and goodwill, as well as loss of sales and financial loss if a registration were to issue to the Applicant.

8. The issuance of a registration in classes 25 and 28 from the opposed application would falsely provide prima facie evidence of the validity thereof, of the Applicant's ownership of the opposed mark, and of the Applicant's exclusive right to use the said mark in commerce on or in connection with the goods specified in the certificate, in violation of the Opposer's prior rights in the marks referred to in paragraph 2 including the marks shown in Exhibits A, B, C and D.

WHEREFORE, the Opposer prays that this opposition be sustained, and that the opposed application be refused for the goods in classes 25 and 28.

NEW BALANCE ATHLETIC SHOE, INC.

November 10, 2004
Date

By: 
Jeremiah Lynch, Esq.
Registration No. 17,425
Attorney for Opposer

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Int. Cl.: 25

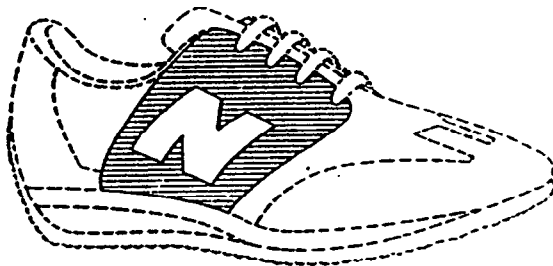
Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,097,551
Registered July 25, 1978

TRADEMARK

Principal Register



New Balance Athletic Shoe, Inc. (Massachusetts corporation), doing business as New Balance Athletic Shoes USA
38 Everett St.
Boston, Mass. 02134

For: ATHLETIC SHOES, in CLASS 25 (U.S. CL. 39).

First use Jan. 2, 1977; in commerce Jan. 2, 1977.

The drawing is lined for the color blue, but color is not claimed.

The mark consists of the pattern outlined in solid lines applied to the shoes. The shoe outline shown in broken lines forms no part of the mark, but is furnished to show the location of the mark in use.

Owner of Reg. No. 1,065,726.

Ser. No. 122,822, filed Apr. 14, 1977.

JOHN C. DEMOS, Supervisory Examiner

JOAN KUPERSMITH, Examiner

EXHIBIT A

Int. Cl.: 25

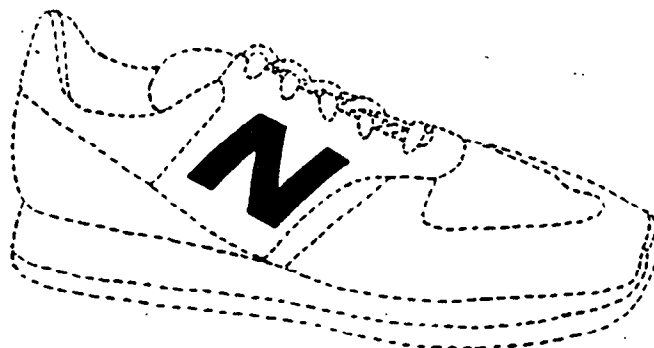
Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 1,308,133

Registered Dec. 4, 1984

TRADEMARK
Principal Register



New Balance Athletic Shoe, Inc. (Massachusetts
corporation)
38 Everett St.
Boston, Mass. 02134

For: ATHLETIC FOOTWEAR, in CLASS 25
(U.S. Cls. 22 and 39).

First use Jan. 2, 1977; in commerce Jan. 2, 1977.

Owner of U.S. Reg. Nos. 1,065,726 and 1,097,551.

The shoe outline shown in broken lines in the
drawing forms no part of the mark, but is furnished to
show the location of the mark in use.

Ser. No. 447,937, filed Oct. 13, 1983.

LUCY A. MARINO, Examining Attorney

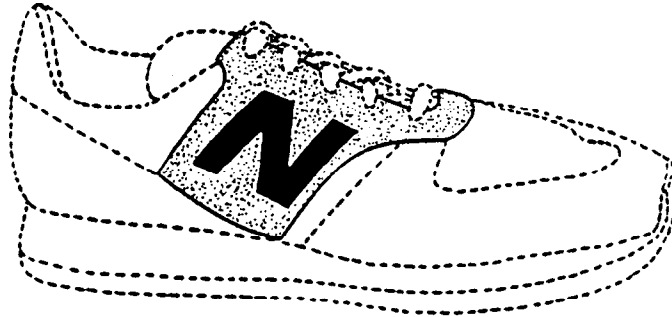
EXHIBIT B

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office Reg. No. 1,344,589
Registered June 25, 1985

**TRADEMARK
PRINCIPAL REGISTER**



NEW BALANCE ATHLETIC SHOE, INC. (MAS-
SACHUSETTS CORPORATION)
38 EVERETT ST.
BOSTON, MA 02134

FOR: ATHLETIC FOOTWEAR, IN CLASS 25
(U.S. CL. 39).

FIRST USE 2-1-1979; IN COMMERCE
2-1-1979.

OWNER OF U.S. REG. NOS. 1,065,726 AND
1,097,551.

THE STIPPLING DOES NOT INDICATE
COLOR, BUT DEFINES THE EXTENDED
SADDLE DEVICE.

THE SHOE OUTLINE SHOWN IN BROKEN
LINES IN THE DRAWING FORMS NO PART
OF THE MARK, BUT IS FURNISHED TO
SHOW THE LOCATION OF THE MARK IN
USE.

SER. NO. 447,946, FILED 10-13-1983.

LUCY A. MARINO, EXAMINING ATTORNEY

Int. Cls.: 18 and 25

Prior U.S. Cls.: 1, 2, 3, 22, 39, and 41

Reg. No. 2,345,832

United States Patent and Trademark Office

Registered Apr. 25, 2000

**TRADEMARK
PRINCIPAL REGISTER**



**NEW BALANCE ATHLETIC SHOE, INC. (MAS-
SACHUSETTS CORPORATION)
61 NORTH BEACON STREET
BOSTON, MA 02134**

**FOR: BAGS FOR CARRYING SPORTING AR-
TICLES, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND
41).**

**FIRST USE 9-2-1999; IN COMMERCE
9-2-1999.**

**FOR: ATHLETIC, EXERCISE AND SPORTS
APPAREL, NAMELY, HATS, T-SHIRTS, SPORT
SHIRTS, SINGLET, SHORTS, PANTS, TIGHTS,**

**JACKETS, RUNNING SUITS, ALL-WEATHER
SUITS, RECREATIONAL TOPS AND SHORTS,
SOCKS, AND FOOTWEAR, IN CLASS 25 (U.S.
CLS. 22 AND 39).**

**FIRST USE 12-0-1995; IN COMMERCE
12-0-1995.**

**OWNER OF U.S. REG. NOS. 1,097,551,
1,308,133, AND 1,344,589.**

SN 74-734,332, FILED 9-26-1995.

DAN VAVONESE, EXAMINING ATTORNEY

EXHIBIT D

