

ESTTA Tracking number: **ESTTA75787**

Filing date: **04/12/2006**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	PUMA AG Rudolf Dassler Sport
Granted to Date of previous extension	04/12/2006
Address	Wuerzburger Str. 13 Herzogenaurach, D-91074 GERMANY
Domestic Representative	Lynn A. Sullivan Attorney for Opposer Leydig Voit & Mayer, Ltd. Two Prudential Plaza, 180 N. Stetson Suite 4900 Chicago, IL 60601-6780 UNITED STATES lsullivan@leydig.com Phone:312-616-5652

**Applicant Information**

Application No	78560115	Publication date	12/13/2005
Opposition Filing Date	04/12/2006	Opposition Period Ends	04/12/2006
Applicant	E.S. Originals, Inc. 450 West 33rd Street New York, NY 10001 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. All goods and sevicees in the class are opposed, namely: Footwear
---

Attachments	Notice of Opposition & Exhibits.pdf ( 9 pages )
-------------	---

Signature	/Lynn A. Sullivan/
Name	Lynn A. Sullivan
Date	04/12/2006

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

In re Opposition of:	)	
	)	
PUMA AG Rudolf Dassler Sport,	)	
Opposer,	)	Opposition No. _____
	)	Serial No. 78/560115
v.	)	
	)	
E. S. Originals, Inc.,	)	
Applicant.	)	
_____	)	

**NOTICE OF OPPOSITION**

In the matter of Application Serial No. 78/560115 for the design mark of a strip on an athletic shoe (herein "Shoe Strip Design") in International Class 25, filed February 3, 2005 by E. S. Originals, Inc., Corporation of New York, 450 West 33<sup>rd</sup> Street, New York, New York 10001 (hereinafter "Applicant"), Opposer, PUMA AG Rudolf Dassler Sport, a Joint Stock Company organized and existing under the laws of the Federal Republic of Germany, located and doing business at Wuerzburger Str. 13, D-91074 Herzogenaurach, Germany (hereinafter "Opposer"), believes that it will be damaged by registration of this Shoe Strip Design and having sought a timely extension to oppose, hereby opposes same. As grounds for the opposition, it is alleged that:

**COUNT 1 – LIKELIHOOD OF CONFUSION**

1. Opposer is and for many years prior to the filing date of the application at issue, has been engaged in the manufacture, distribution and sale of sport and leisure shoes that contain a Formstrip design which runs as a curved band from the upper heel portion of the footwear to the sole. The strip is positioned on the footwear upper in the area between the laces and the sole (hereinafter Formstrip).

2. Opposer has used its Formstrip design in the United States and many other countries for its athletic shoes continuously and exclusively for almost 50 years. - Opposer has also used the Formstrip design on other products such as clothing, particularly footwear, headwear, sport bags, sports wear and accessories. Accordingly, Opposer's Formstrip design has become well known not only in the United States but nearly worldwide.

3. Opposer is the owner of U. S. Trademark Registration No. 890,009, registered April 28, 1970, for a Formstrip design mark comprised of a curved band or strip adapted to be placed on sport shoes, which runs from the upper heel portion of the footwear to the sole as shown in Exhibit A attached hereto, for goods which include, *inter alia*,: Sport Shoes – namely, soccer shoes, lacrosse shoes, bowling shoes, boxing shoes, gymnastic shoes, jogging shoes, wrestling shoes, fencing shoes, track shoes, cross country shoes, and football shoes; sporting shoes - namely, basketball shoes, tennis shoes, and boating shoes, in International Class 25.

4. Opposer is the owner of U. S. Trademark Registration No. 1,256,945, registered November 8, 1983, for a Formstrip design mark comprised of a curved band or strip placed on shoes longitudinal subdivided into three subsections, that run from the upper heel portion of the footwear to the sole, as shown in Exhibit B attached hereto for goods which include, *inter alia*, shoes, especially sports and leisure shoes, in International Class 25. The stippling shown on this registration drawing is for the purpose of dividing the stitching part of the mark into three sections which has the appearance of 3 parallel bands, a design very similar to the appearance of applicant's 2 parallel bands. See comparison drawing attached as Exhibit D.

5. Opposer is the owner of U. S. Trademark Registration No. 1,135,790, registered May 20, 1980, for a Formstrip design mark comprised of a curved band or strip, as shown in Exhibit C attached hereto for goods which include, *inter alia*,: "Shoes, particularly sport and leisure shoes" in International Class 25.

6. As noted in paragraph 2, since long prior to the February 3, 2005, filing date of the intent to use application which is the subject of this opposition, Opposer adopted and commenced use of its Formstrip, a curved band or strip that likewise runs from the upper heel portion of the footwear to the sole, as a trademark in connection with the marketing, promoting, offering for sale and selling of various items of clothing, particularly footwear, headwear, sports bags, sports wear and accessories in the United States, continuously using combinations of coloring, texturing, and the like which give the Formstrip the appearance of a band or strip composed of more than one band. This look is clearly described in Registration No. 1,256,945, by stating that the stippling shown on the drawing is for the purpose of dividing the stitching part of the mark into three sections. The Formstrip, either alone or in combination with other words, has since been continuously used by Opposer in connection with the marketing, promoting, offering for sale and selling of athletic shoes in the United States and virtually worldwide.

7. As a result of the extensive use and advertising by Opposer of the trademarks referred to in Paragraphs 2-5 hereof, said marks have become extremely well known as symbolic of Opposer and Opposer has built up valuable goodwill in said marks such that the marks have come to identify Opposer's goods, including footwear, and distinguish Opposer's goods, including footwear, from the related goods of others.

8. The goods identified by Applicant in Serial No. 78/560115 are the same or substantially included within the goods on which Opposer has previously used and now uses the Formstrip trademarks referred to in Paragraphs 2-5 hereof and to the goods recited in Opposer's registrations referred to in Paragraphs 3-5 hereof.

9. The mark of Serial No. 78/560115 (hereinafter "Applicant's Mark"), is described in its application as consisting of "two parallel bands that are connected in the middle 1/3 that run from the upper heel portion of the footwear to the sole. The mark is applied to footwear and is positioned

on the footwear upper in the area between the laces and the sole.” Applicant’s Mark is substantially identical or equivalent to or creates the same or substantially the same commercial impression in the minds of prospective purchasers as the trademarks referred to above and as previously used by Opposer and is likely when applied to the goods of the Applicant to cause confusion, or to cause mistake, or to deceive, all to Opposer’s damage.

### **COUNT 2 – DILUTION**

10. Opposer’s Formstrip trademarks referred to above have had extensive national exposure for decades, being prominently apparent on clothing, particularly footwear, headwear, sports bags, sports wear and accessories sold to the general public and worn by numerous athletic stars, over the years. As a result of the extensive use and advertising of Opposer’s marks and the publicity associated with their use by well known athletes for many years, Opposer’s Formstrip marks have become famous. Registration and use by Applicant of Applicant’s Mark will dilute the distinctive quality of Opposer’s Formstrip marks, all to Opposer’s damage.

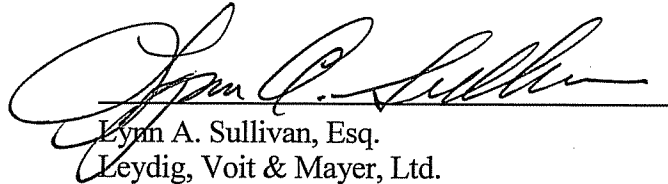
11. As a result of the extensive advertising, sales and national as well as worldwide exposure, the public has come to associate the Formstrip mark of the types shown in Exhibits A-C attached to this Opposition in various forms, patterns and manners of coloration, with Opposer. Registration and use of the Applicant’s Mark will affect Opposer’s right to continue to freely use its Formstrip marks and will dilute the public’s association of its Formstrip marks with Opposer.

WHEREFORE, Opposer prays that Application No. 78/560115 be rejected based on the fact that Applicant’s Shoe Strip Design mark is confusingly similar to Opposer’s Formstrip mark, and

that it will dilute the distinctive quality of Opposer's mark, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

Date: April 12, 2006



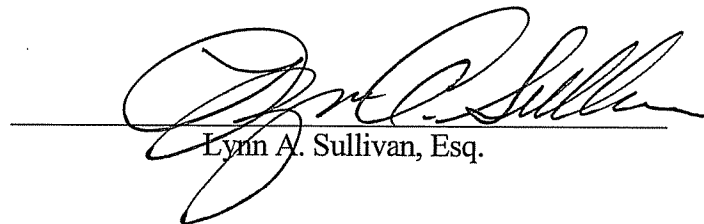
Lynn A. Sullivan, Esq.

Leydig, Voit & Mayer, Ltd.  
Two Prudential Plaza, Suite 4900  
180 North Stetson Avenue  
Chicago, IL 60601  
Telephone: (312) 616-5600

Attorneys for Opposer  
PUMA AG Rudolf Dassler Sport

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the above document was filed electronically with the Trademark Trial & Appeal Board on April 12, 2006.



Lynn A. Sullivan, Esq.

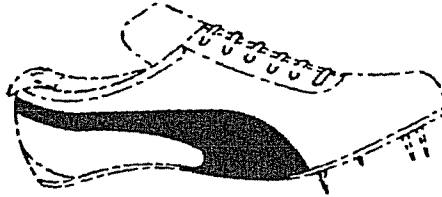
Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office  
10 Year Renewal

Reg. No. 890,009  
Registered Apr. 28, 1970  
Renewal Approved Mar. 29, 1990

TRADEMARK  
PRINCIPAL REGISTER



PUMA AG RUDOLF DASSLER SPORT  
(FED REP GERMANY CORPORATION)  
WURZBURGER STR. 13  
HERZOGENAURACH, FED REP GER-  
MANY, ASSIGNEE OF PUMA-SPORTS-  
CHUHFABRIKEN RUDOLF DASSLER  
KG. (FED REP GERMANY LIMITED  
PARTNERSHIP) 8522 HERZOGEN-  
AURACH, NURNBERG, FED REP  
GERMANY

FOR: SPORT SHOES—NAMELY,  
SOCCER SHOES, LACROSSE SHOES,  
BOWLING SHOES, BOXING SHOES.

GYMNASTIC SHOES, JOGGING SHOES,  
WRESTLING SHOES, FENCING SHOES,  
TRACK SHOES, CROSS COUNTRY  
SHOES, AND FOOTBALL SHOES, IN  
CLASS 22 (INT. CL. 25).

FIRST USE 0-0-1958; IN COMMERCE  
0-0-1958.

FOR: SPORTING SHOES—NAMELY,  
BASKETBALL SHOES, TENNIS SHOES,  
AND BOATING SHOES, IN CLASS 39  
(INT. CL. 25).

FIRST USE 0-0-1958; IN COMMERCE  
0-0-1958.

SER. NO. 72-288,345. FILED 1-8-1968.

*In testimony whereof I have hereunto set my hand  
and caused the seal of The Patent and Trademark  
Office to be affixed on May 8, 1990.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Exhibit A

Int. Cl.: 25

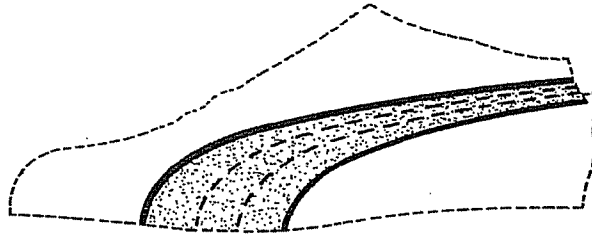
Prior U.S. Cls.: 22 and 39

**United States Patent and Trademark Office**

**Reg. No. 1,256,945**

Registered Nov. 8, 1983

**TRADEMARK**  
Principal Register



Puma-Sportschuhfabriken Rudolf Dassler KG (Fed.  
Rep. of Germany limited partnership)  
Herzogenaurach, Fed. Rep. of Germany

For: SHOES, ESPECIALLY SPORTS AND  
LEISURE SHOES, in CLASS 25 (U.S. Cls. 22 and  
39).

Owner of Fed. Rep. of Germany Reg. No.  
944,093, dated May 4, 1976, expires Nov. 4, 1985.

Owner of U.S. Reg. Nos. 890,009 and 1,135,790.

The stippling shown on the drawing is for the  
purpose of dividing the stitching part of the mark into  
three sections.

Sec. 2(f).

Ser. No. 279,936, filed Sep. 30, 1980.

J. H. WEBB, Examining Attorney

**Exhibit B**



Int. Cl.: 25

U.S. Cl.: 39

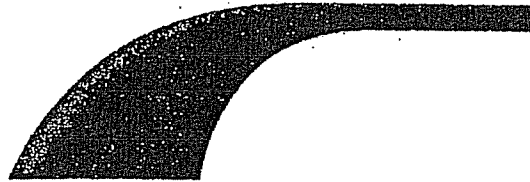
U.S. Patent and Trademark Office

Reg. No. 1,135,790

Registered May 20, 1980

**TRADEMARK**

**Principal Register**



Puma-Sportschuhfabriken Rudolf Dassler KG (Fed. Rep. of  
Germany limited partnership)  
P.O. Box 1420  
D-8522 Herzogenaurach, near Nurnberg, Fed. Rep. of Ger-  
many

For: SHOES, PARTICULARLY SPORT AND LEI-  
SURE SHOES, in CLASS 25 (U.S. CL. 39).  
First use 1958; in commerce 1958.

Ser. No. 144,331. Filed Oct. 11, 1977.

PAUL F. GAST, Primary Examiner

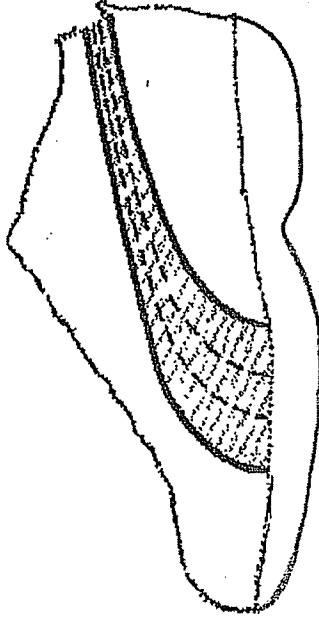
**Exhibit C**

**CONFRONTATION**

**E.S. Originals Inc.**



**PUMA AG Rudolf Dassler Sport**



**Exhibit D**