

LAHIVE  
&  
COCKFIELD  
L L P

COUNSELLORS AT LAW  
28 STATE STREET  
BOSTON, MASSACHUSETTS 02109-1784  
TELEPHONE (617) 227-7400  
FAX (617) 742-4214  
[www.lahive.com](http://www.lahive.com)  
[lc@lahive.com](mailto:lc@lahive.com)

JOHN A. LAHIVE, JR. (1928-1997)  
JAMES E. COCKFIELD (1930-2005)  
THOMAS V. SMURZYNSKI  
GIULIO A. DeCONTI, JR.  
ELIZABETH A. HANLEY  
AMY BAKER MANDRAGOURAS  
ANTHONY A. LAURENTANO  
KEVIN J. CANNING  
JANE E. REMILLARD  
DEBRA J. MILASINCIC, Ph.D.  
MEGAN E. WILLIAMS, Ph.D.  
WILLIAM A. SCOFIELD, JR.  
SIBLEY P. REPERT  
DAVID R. BURNS  
JOHN S. CURRAN  
SEAN D. DETWEILER  
HATHAWAY P. RUSSELL \*  
MARIA LACCOTRIPE ZACHARAKIS, Ph.D.  
DANIELLE L. HERRITT

EUIHOON LEE \*\*  
MANEESH GULATI  
CYNTHIA M. SOROOS  
PETER W. DINI, Ph.D.  
MICHAEL J. BASTIAN, Ph.D.  
JAMES M. MCKENZIE  
JILL R. GORNY  
SAPNA MEHTANI, Ph.D.  
JACOB G. WEINTRAUB  
LAURA C. DILORENZO

OF COUNSEL  
JEREMIAH LYNCH  
JEANNE M. DIGIORGIO  
CYNTHIA L. KANIK, Ph.D.  
BENEDICT A. MONACHINO

PATENT AGENTS  
CATHERINE J. KARA, Ph.D.  
CRISTIN HOWLEY COWLES, Ph.D.  
JILL ANN MELLO, Ph.D.  
JAMES H. VELEMA  
BRIAN C. TRINQUE, Ph.D.

TECHNICAL SPECIALISTS  
CATHERINE M. BISHOP  
DEBORAH L. NAGLE, Ph.D.  
ANNE JACQUELINE WIZEMAN, Ph.D.  
CHRISTOPHER R. COWLES, Ph.D.  
W. ELANA WANG  
MEAGHAN L. RICHMOND, Ph.D.  
SHARON M. WALKER, Ph.D.  
ALISSA H. FARIS  
SEAN R. MacDAVITT  
ANITA M. BOWLES, Ph.D.  
MARCIE B. CLARKE, Ph.D.

\* Admitted in TX only  
\*\* Admitted in CT only

July 7, 2006

TTAB

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

Re: U.S. Trademark Opposition  
New Balance Athletic Shoe, Inc.  
v.  
PF Pillows L.L.C.  
Application No. 76/633251  
(Our Ref: NBK-334-049)


Dear Sir:

We enclose herewith a Notice of Opposition, in duplicate.

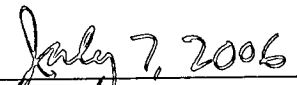
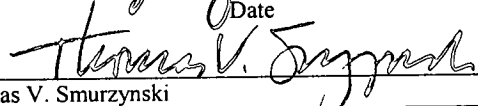
Please charge the \$600.00 filing fee or any additional charges to our Deposit Order Account No. 501558. A duplicate of this letter is enclosed.

Respectfully submitted,


LAHIVE & COCKFIELD, LLP

By   
Thomas V. Smurzynski  
Reg. No. 24,798  
28 State Street  
Boston, MA 02109  
617-227-7400  
Telecopier 617-742-4214

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

  
Date  
  
Thomas V. Smurzynski

TVS/pr  
Enclosures

  
07-10-2006  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

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

In the matter of Application Serial No. 76/633251  
Published in the Official Gazette of June 13, 2006

New Balance Athletic Shoe, Inc.,

Opposer,

v.

PF Pillows L.L.C.

Applicant.

Opposition No.

Attorney Docket No.: NBK-334-049

Certificate of First Class Mailing (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, VA 22313-1451, on the date set forth below.

July 7, 2006  
Date of Signature and of Mail Deposit

By: Thomas V. Smurzynski  
Thomas V. Smurzynski  
Reg. No. 24,798  
Attorney for Opposer

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

07/13/2006 GTRK032 00000055 501550 76633251  
01 FC:6402 600.00 DA

Sir:

**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. 76/633251, published for opposition in the Official Gazette on June 13, 2006, hereby opposes the same and requests that registration be refused.

1. The Opposer is the owner by assignment of United States Trademark Registration No. 429,057 issued to The B. F. Goodrich Company on April 15, 1947, as shown by records in the United States Patent and Trademark Office. A copy of the certificate of said registration is appended hereto and made a part hereof as Exhibit A. On January 17, 1984, the said registration was amended to show the drawing of the mark in standard character form, and a copy of said amendment is appended hereto and made a part hereof as Exhibit B. As so amended, the said registration has been and is presently valid and subsisting, and is incontestable under the provisions of 15 U.S.C 1065.

2. The Opposer is the owner by assignment of United States Trademark Registration No. 1,236,457 issued on May 3, 1983 to Brookfield Athletic Shoe Company, Inc., successor in interest to The B. F. Goodrich Company, as shown by records in the United States Patent and Trademark Office. A copy of said registration is appended hereto and made a part hereof as Exhibit C. Registration No. 1,236,457 has been and is presently valid and subsisting, and incontestable under the provisions of 15 U.S.C. 1065.

3. On information and belief, the Opposer's predecessor The B. F. Goodrich Company commenced use of the mark PF on and in connection with footwear, specifically rubber-soled canvas footwear about May 15, 1941, the mark being applied or affixed to the packages containing the goods by printing the trademark thereon. On information and belief, the said mark was used by The B. F. Goodrich Company continuously until it was sold with the goodwill of the business to Brookfield Athletic Shoe Company, Inc. On information and belief, upon acquisition of the said mark by Brookfield Athletic Shoe Company, Inc., it was used continuously by the latter company during its ownership of the mark for footwear and sporting articles, namely skates and athletic shoes as shown on Exhibit C.

4. On information and belief the mark PF, the goodwill of the business associated therewith and Registrations Nos. 429,057 and 1,236,457 were assigned from Brookfield Athletic Shoe Company, Inc. to Hyde Athletic Industries, Inc., then by the latter company to Leif J. Ostberg, Inc., and finally to the Opposer. On information and belief, use of the mark PF on or in connection with footwear throughout the United States has been substantially continuous by its respective owners recited above from May 15, 1941 to the present.

5. As a result of the use of the mark PF on footwear as alleged in paragraphs 3 and 4, said mark has been widely recognized for many years by the general public as identifying the owners of said mark and as the source having exclusive control over the nature and quality of said goods.

6. The Opposer and its above-recited predecessors in interest have expended large sums of money for over 60 years in the advertising and promotion of the mark PF, and by reason thereof the Opposer is presently the owner of a valuable reputation and goodwill on the part of the purchasing public in the general consumer goods field including footwear, whereby said mark is associated with and presently identifies the Opposer as the source controlling the nature and quality of said goods.

7. On information and belief, the Applicant seeks registration of the opposed mark for general bedding, namely pillows for medical use, in class 10, and pillows, in class 24. On information and belief, the Applicant's said goods are closely related to goods of the Opposer.

8. The dominant feature of the opposed mark is the letters PF, and as such the opposed mark falls within the scope of the Opposer's Registrations Nos. 429,057 and 1,236,457 which display the marks in standard character form. The opposed mark creates the same commercial impression as the Opposer's registered marks, and use thereof on or in connection

with the Applicant's said goods will be likely to cause confusion, deception or mistake on the part of the purchasing public with respect to the goods of the respective parties.

9. Under 15 U.S.C. 1057(b), if a certificate of registration were to issue to the Applicant it would be prima facie evidence inter alia, of the registrant's right to use the registered mark in commerce on or in connection with the Applicant's said 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 the Opposer's mark PF.

10. By reason of the confusion, mistake or deception alleged in the preceding paragraph 9, 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.

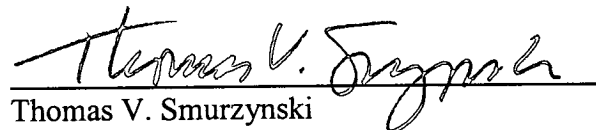
11. The issuance of a registration from the opposed application would falsely provide prima facie evidence of the validity thereof, of the registrant's ownership of the opposed mark, and of the registrant's exclusive right to use the said mark in commerce on or in connection with the goods specified in the certificate, in violation of the Opposer's prior rights in the mark PF and in the registrations in Exhibits A, B and C.

WHEREFORE, the Opposer prays that this opposition be sustained, and that the opposed application be refused.

Respectfully submitted,  
NEW BALANCE ATHLETIC SHOE, INC.  
By its attorneys,

Date:

July 7, 2006



Thomas V. Smurzynski  
Jeremiah Lynch  
LAHIVE & COCKFIELD, LLP  
28 State Street  
Boston, MA 02109  
(617) 227-7400

Registered Apr. 15, 1947

Trade-Mark 429,057

## UNITED STATES PATENT OFFICE

The B. F. Goodrich Company, New York, N. Y.,  
Akron, Ohio, and Watertown, Mass.

Act of February 20, 1905

Application May 25, 1946, Serial No. 502,747

### STATEMENT

*To the Commissioner of Patents:*

The B. F. Goodrich Company, a corporation duly organized under the laws of the State of New York and located at 230 Park Avenue, New York, N. Y., and doing business at 500 South Main Street, Akron, Ohio, and 98 Nichols Avenue, Watertown, Massachusetts, has adopted and used the trade-mark shown in the accompanying drawing, for FOOTWEAR, SPECIFICALLY RUBBER-SOLED CANVAS FOOTWEAR, in Class 39, Clothing, and presents herewith five specimens showing the trade-mark as actually used by appli-

cant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905. The trade-mark has been continuously used and applied to said goods in applicant's business since about May 15, 1941. The trade-mark is applied or affixed to the packages containing the goods by printing the trade-mark thereon.

THE B. F. GOODRICH COMPANY,  
By W. F. AVERY,  
*Secretary.*

EXHIBIT A

**Amendment**

Registered April 15, 1947

Registration No. 429,057

The B. F. Goodrich Company

Application to amend having been made by Brookfield Athletic Shoe Company, Inc., owner of the registration above identified, the drawing is amended to appear as follows:

P F

Such amendment has been entered upon the records of the Patent and Trademark Office and the said original registration should be read as so amended.

Signed and sealed this 17th day of January 1984.



Attest: *Michael J. Hynak*  
MICHAEL J. HYNAK,  
Attesting Officer.

*Gerald J. Mossinghoff*  
GERALD J. MOSSINGHOFF,  
Commissioner of Patents and Trademarks.

Int. Cls.: 25 and 28

Prior U.S. Cls.: 22 and 39

**United States Patent and Trademark Office**

**Reg. No. 1,236,457**

Registered May 3, 1983

**TRADEMARK**  
Principal Register

**PF**

Brookfield Athletic Shoe Company, Inc. (U.S. Cl. 22).  
(Massachusetts corporation)  
15 Mechanic St.  
East Brookfield, Mass. 01515

First use Feb. 11, 1982; in commerce Feb. 11,  
1982.

For: FOOTWEAR, in CLASS 25 (U.S. Cl. 39).  
First use Feb. 11, 1982; in commerce Feb. 11,  
1982.

Ser. No. 359,706, filed Apr. 14, 1982.

For: SPORTING ARTICLES—NAMELY,  
SKATES AND ATHLETIC SHOES, in CLASS 28

CRAIG K. MORRIS, Examiner

EXHIBIT C