

ESTTA Tracking number: **ESTTA201215**

Filing date: **03/27/2008**

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	Ocean Minded, Inc.		
Entity	Corporation	Citizenship	Colorado
Address	6328 Monarch Park Place Niwot, CO 80503 UNITED STATES		

Attorney information	Jennifer Daniel Collins Faegre & Benson LLP 1700 Lincoln Street 3200 Wells Fargo Center Denver, CO 80203-4532 UNITED STATES trademarkdnvr@faegre.com, jcollins@faegre.com, jsmith@faegre.com Phone:303-607-3500
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Applicant Information

Application No	78910705	Publication date	02/26/2008
Opposition Filing Date	03/27/2008	Opposition Period Ends	03/27/2008
Applicant	Aguirre, Rene 9627 Borson St. Downey, CA 90242 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: hats, pants, shirts, shorts
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2282012	Application Date	07/11/1997
Registration Date	09/28/1999	Foreign Priority Date	NONE
Word Mark	OCEAN MINDED		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 025. First use: First Use: 1997/01/01 First Use In Commerce: 1997/01/01 footwear and clothing, namely, sandals, T-shirts, sweatshirts, shorts and hats
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U.S. Application No.	78499677	Application Date	10/14/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	OCEAN MINDED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: PRINTED MATTER, NAMELY, NEWSLETTERS IN THE FIELD OF OCEAN AWARENESS Class 035. First use: RETAIL STORE SERVICES OF WEARING APPAREL		

U.S. Registration No.	3349385	Application Date	10/14/2004
Registration Date	12/04/2007	Foreign Priority Date	NONE
Word Mark	OM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1997/01/01 First Use In Commerce: 1997/01/01 WEARING APPAREL, NAMELY, T-SHIRTS, SANDALS AND SHOES Class 028. First use: First Use: 1997/01/01 First Use In Commerce: 1997/01/01 SPORTING GOODS, NAMELY, SURFBOARDS AND SURFBOARD LEASHES		

Attachments	75322835#TMSN.gif (1 page)(bytes) 78499677#TMSN.jpeg (1 page)(bytes) 78499717#TMSN.jpeg (1 page)(bytes) 78910705 OCEAN MOTION and Design.pdf (15 pages)(305976 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jennifer Daniel Collins/
Name	Jennifer Daniel Collins
Date	03/27/2008

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

OCEAN MINDED, INC.

Opposer,

v.

RENE AGUIRRE

Applicant.

Opposition No. _____

Mark: **OM OCEAN MOTION**

Serial No.: 78/910,705

Filing Date: June 17, 2006

Publication Date: February 26, 2008

NOTICE OF OPPOSITION

Ocean Minded, Inc. ("Ocean Minded"), a corporation organized under the laws of the State of Colorado, having its principal place of business at 6328 Monarch Park Place, Niwot, Colorado 80503, believes that it will be damaged by the registration of the mark **OM OCEAN MOTION**, as depicted in Application Serial No. 78/910,705 ("Applicant's Mark"), and hereby opposes the registration of said application under the provisions of 15 U.S.C. § 1063.

As grounds for its opposition to the registration of Applicant's Mark, Opposer alleges:

1. Applicant Rene Aguirre ("Applicant") applied for Applicant's Mark on June 17, 2006, and said application was assigned serial number 78/910,705.
2. Application serial number 78/910,705 seeks the registration of Applicant's Mark, depicted as follows:



3. Application serial number 78/910,705 seeks the registration of Applicant's Mark in connection with the following goods:

"hats, pants, shirts, shorts" in International Class 25.

4. Applicant's Mark was published for Opposition in the *Official Gazette* on February 26, 2008.

5. Accordingly, this Notice of Opposition is timely filed.

6. Opposer is the owner of the following United States Trademark Registration: 2,282,012 for the mark OCEAN MINDED for "footwear and clothing, namely, sandals, t-shirts, sweat-shirts, shorts and hats" in International Class 25. A copy of the registration certificate is attached hereto as Exhibit A. In addition, Opposer is the owner of the following valid and subsisting U.S. Trademark Application No.: 78/499,677 for the mark OCEAN MINDED for "printed matter, namely newsletters in the field of ocean awareness" in International Class 16 and "retail store service of wearing apparel" in International Class 35. A printout from the USPTO TARR database evidencing the status of this application is attached hereto as Exhibit B. Finally, Opposer is the owner of the following United States Trademark Registration: 3,349,385 for the mark OM and Design for "wearing apparel, namely, t-shirts, sandals and shoes" in International Class 25 and "sporting goods, namely, surfboards and surfboard leashes" in International Class 28. A copy of the registration certificate is attached hereto as Exhibit C.

7. Since at least 1997, the mark OCEAN MINDED has been used in interstate commerce in conjunction with footwear, clothing and hats, which is prior to the June 17, 2006 filing date of Applicant's application.

8. Opposer has promoted the OCEAN MINDED Marks through a wide variety of channels. Products bearing the OCEAN MINDED Marks were sold in 1600 retail outlets in 2007. Opposer has also promoted the OCEAN MINDED Marks through electronic media, including Ocean Minded's website located at <http://www.oceanminded.com>. In 2007, approximately 215,400 pairs of shoes were sold under the OCEAN MINDED Marks, amounting to nearly \$3.25 million in sales worldwide. Last year, Opposer spent nearly \$90,000 advertising the OCEAN MINDED Marks. Through such promotion and use by Opposer, the OCEAN MINDED Marks are widely recognized as an indicator of source for Opposer's products and represents valuable and substantial goodwill of Opposer in its business.

9. Opposer is not connected in any way with Applicant's use of Applicant's Mark.

10. The OCEAN MINDED Marks are distinctive in connection with Opposer's footwear, clothing and hat products.

11. Applicant's use of or intended use of Applicant's Mark is without Opposer's consent or permission.

12. Applicant's Mark is confusingly similar to the OCEAN MINDED Marks.

13. The goods identified in application serial number 78/910,705 are related to the footwear, clothing and hat goods offered by Opposer Ocean Minded under the OCEAN MINDED Marks. Such related goods are offered and will be offered in the same channels of trade.

14. Because of the similarity of Applicant's Mark to the OCEAN MINDED Marks, and the overlapping and related goods offered in connection with Applicant's Mark through similar channels of trade, persons familiar with Opposer and its goods are likely to be misled into believing that Applicant's goods, if offered under Applicant's Mark, are sponsored by or otherwise affiliated with Opposer in some way, thereby damaging Opposer.

15. Applicant's use or intended use of Applicant's Mark in connection with Applicant's goods is likely to cause confusion, mistake, or deception as to the source, origin, or sponsorship or approval of Applicant's goods, in that consumers are likely to believe that Applicant's goods are Opposer's goods, or are in some way legitimately connected with, licensed, or approved by Opposer.

16. Opposer believes that the registration of Applicant's Mark on the Principal Register in connection with the opposed services would be inconsistent with Opposer's rights under the common law and the Trademark Act, and Opposer believes that such registration would be damaging to Opposer.

WHEREFORE, Opposer believes that it would be damaged by registration of Applicant's Mark in connection with the opposed services and respectfully pray that Application serial number 78/910,705 be rejected, that no registration be issued thereon, and that this opposition be sustained in favor of Opposer.

The required opposition fee of \$300.00 accompanies this Notice. If the filing fee is deficient or excessive in any way, the Commissioner is granted authority to credit or debit Deposit Account Number 06-0029.

Dated: March 27, 2008

Respectfully submitted,

By: /Jennifer Daniel Collins/
Natalie Hanlon-Leh
Jennifer Daniel Collins
Faegre & Benson LLP
3200 Wells Fargo Center
1700 Lincoln Street
Denver, Colorado 80203-4532

Attorneys for Opposer
Ocean Minded, Inc.

Filed Electronically via ESSTA.

fb.us.2726765.02

Exhibit A

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 2,282,012

Registered Sep. 28, 1999

**TRADEMARK
PRINCIPAL REGISTER**

OCEAN MINDED

OCEAN MINDED SANDALS, INC. (CALIFORNIA CORPORATION)
2011 S. EL CAMINO REAL, SUITE C
SAN CLEMENTE, CA 92672

FOR: FOOTWEAR AND CLOTHING,
NAMELY, SANDALS, T-SHIRTS, SWEAT-
SHIRTS, SHORTS AND HATS, IN CLASS 25
(U.S. CLS. 22 AND 39).

FIRST USE 1-1-1997; IN COMMERCE
1-1-1997.

SN 75-322,835, FILED 7-11-1997.

KATHERINE STOIDES, EXAMINING ATTOR-
NEY



Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 2

Serial #: 75322835

Filing Dt: 07/11/1997

Reg #: 2282012

Reg. Dt: 09/28/1999

Registrant: Ocean Minded Sandals, Inc.

Mark: OCEAN MINDED

Assignment: 1

Reel/Frame: 3202/0321

Received: 09/22/2005

Recorded: 09/22/2005

Pages: 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: OCEAN MINDED SANDALS, INC.

Exec Dt: 09/14/2005

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Entity Type: LTD. LIABILITY CO.

Citizenship: CALIFORNIA

Assignee: OCEAN MINDED, LLC

5 JENNER STREET, SUITE 100
IRVINE, CALIFORNIA

Correspondent: KIT M. STETINA, ESQ.

STETINA BRUNDA ET AL.
75 ENTERPRISE, SUITE 250
ALISO VIEJO, CA 92656

Assignment: 2

Reel/Frame: 3488/0483

Received: 02/26/2007

Recorded: 02/26/2007

Pages: 5

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: OCEAN MINDED, LLC

Exec Dt: 02/01/2007

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: CALIFORNIA

Entity Type: CORPORATION

Citizenship: COLORADO

Assignee: OCEAN MINDED, INC.

6328 MONARCH PARK PLACE
NIWOT, COLORADO 80503

Correspondent: NATALIE HANLON-LEH

1700 LINCOLN STREET
3200 WELLS FARGO CENTER
DENVER, CO 80203-4532

Search Results as of: 03/27/2008 06:06 PM
If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350, v.2.0.1
Web interface last modified: April 20, 2007 v.2.0.1

Exhibit B

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-03-27 18:04:50 ET

Serial Number: 78499677 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

OCEAN MINDED

(words only): OCEAN MINDED

Standard Character claim: Yes

Current Status: A request for the third extension of time to file a statement of use has been granted.

Date of Status: 2008-02-05

Filing Date: 2004-10-14

The Notice of Allowance Date is: 2006-06-06

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 115

Attorney Assigned:
KIM YONG OH

Current Location: 700 -Intent To Use Section

Date In Location: 2008-02-01

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. OCEAN MINDED, INC.

Address:
OCEAN MINDED, INC.
6328 MONARCH PARK PLACE
NIWOT, CO 80503

United States

Legal Entity Type: Corporation

State or Country of Incorporation: Colorado

GOODS AND/OR SERVICES

International Class: 016

Class Status: Active

PRINTED MATTER, NAMELY, NEWSLETTERS IN THE FIELD OF OCEAN AWARENESS

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 035

Class Status: Active

RETAIL STORE SERVICES OF WEARING APPAREL

Basis: 1(b)

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-02-05 - Extension 3 granted

2007-12-06 - Extension 3 filed

2008-01-31 - Extension Received With TEAS Petition

2008-01-31 - Petition To Revive-Granted

2008-01-31 - TEAS Petition To Revive Received

2008-01-30 - Abandonment Notice Mailed - No Use Statement Filed

2008-01-30 - Abandonment - No use statement filed

2007-12-06 - Extension 2 granted

2007-06-06 - Extension 2 filed

2007-06-06 - FAX RECEIVED

2007-04-26 - Attorney Revoked And/Or Appointed

2007-04-26 - TEAS Revoke/Appoint Attorney Received

2007-04-26 - Attorney Revoked And/Or Appointed

2007-04-26 - TEAS Revoke/Appoint Attorney Received

2007-04-13 - Notice Of Reinstatement Mailed

2007-04-06 - Extension 1 granted

2006-11-13 - Extension 1 filed

2006-11-13 - Reinstated

2007-04-04 - Abandonment Notice Mailed - No Use Statement Filed

2007-04-04 - Abandonment - No use statement filed

2007-02-28 - Automatic Update Of Assignment Of Ownership

2006-11-13 - PAPER RECEIVED

2006-06-06 - Notice of allowance - mailed

2006-03-17 - Changes/Corrections After Pub Approval Entered

2006-03-14 - Published for opposition

2006-03-10 - TEAS Change Of Owner Address Received

2006-02-22 - Notice of publication

2006-01-31 - Law Office Publication Review Completed

2006-01-27 - Assigned To LIE

2006-01-21 - Approved for Pub - Principal Register (Initial exam)

2005-11-04 - Amendment From Applicant Entered

2005-10-27 - Communication received from applicant

2005-10-27 - PAPER RECEIVED

2005-05-25 - Non-final action mailed

2005-05-25 - Non-Final Action Written

2005-05-18 - Assigned To Examiner

2004-10-21 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Jennifer Daniel Collins

Correspondent

Jennifer Daniel Collins

Faegre & Benson LLP

3200 Wells Fargo Center

1700 Lincoln Street

Denver CO 80203-4532

Phone Number: (303) 607-3500

Fax Number: (303) 607-3600

Exhibit C

Int. Cls.: 25 and 28

Prior U.S. Cls.: 22, 23, 38, 39, and 50

United States Patent and Trademark Office

Reg. No. 3,349,385

Registered Dec. 4, 2007

TRADEMARK
PRINCIPAL REGISTER



OCEAN MINDED, INC. (COLORADO CORPORATION)
6328 MONARCH PARK PLACE
NIWOT, CO 80503

FOR: WEARING APPAREL, NAMELY, T-SHIRTS,
SANDALS AND SHOES, IN CLASS 25 (U.S. CLS. 22
AND 39).

FIRST USE 1-1-1997; IN COMMERCE 1-1-1997.

FOR: SPORTING GOODS, NAMELY, SURF-
BOARDS AND SURFBOARD LEASHES, IN CLASS
28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE 1-1-1997; IN COMMERCE 1-1-1997.

SN 78-499,717, FILED 10-14-2004.

BRIAN PINO, EXAMINING ATTORNEY