

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

In the matter of Trademark Application Serial No. 78/830,746  
Filed on March 7, 2006  
For the mark "88"  
Published: January 1, 2008

88 TEES HAWAII, INC., )  
 )  
 ) Opposer, )  
 )  
 ) v. )  
 )  
 )  
 )  
 ) EIGHTY-EIGHT, LLC, )  
 )  
 )  
 ) Applicant. )  
 )  
 )  
 )

Opposition No.: \_\_\_\_\_

NOTICE OF OPPOSITION

Opposer 88 TEES HAWAII, INC., a Hawaii corporation ("**Opposer**"), whose mailing address is 1441 Kapiolani Boulevard, Suite 1114, Honolulu, Hawaii 96814, believes it will be damaged by the registration of the mark "88" shown in Application Serial No. 78/830,746 (the "**Application**") originally filed by Jr. Motorsports, L.L.C. and subsequently allegedly assigned to EIGHTY-EIGHT, LLC ("**Applicant**"), for "Clothing marketed as goods associated with a stock car racing team, namely, sweatshirts, sweat pants, sweat suits, warm-up suits, shirts, sport shirts, golf shirts, T-shirts, tank tops, sweaters, dresses, skirts, jerseys, long pants, sport shorts, shorts, bathing suits, pants, jackets, coats, hats, caps, bandanas, visors, belts, suspenders, head bands, wrist bands, socks, hosiery, footwear, gloves, scarves, neckties,

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as U.S. first class mail in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on April 11, 2008.

04/22/2008 HPHAM1 00000155 78830746  
01 FC:6402 300.00 OP

  
MARTIN E. HSIA 32,471

DATED 4/11/08



04-18-2008

**Transmittal Memorandum**

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

**FROM** : Martin E. Hsia, Esq.

**DATE** : April 11, 2008

**RE** : Serial No.: 78/830,746  
 Mark: "88"  
 Opposer: 88 Tees Hawaii, Inc.  
Applicant: Eighty-Eight, LLC

We are sending you the following:

ORIG.	COPIES	DATED	DESCRIPTION
1		04/11/08	Notice of Opposition; Exhibit "A"; Proof of Service
1		04/11/08	Filing Fee (\$300.00)
1		04/11/08	Postcard receipt of Notice of Opposition; Exhibit "A"; Proof of Service and Filing Fee

- |   |  |
|---|--|
| <input type="checkbox"/> For your information                   | <input type="checkbox"/> For signature and return                              |
| <input type="checkbox"/> For your files                         | <input type="checkbox"/> For signature, forwarding,<br>as noted below & return |
| <input type="checkbox"/> Per your request                       | <input type="checkbox"/> For review & approval                                 |
| <input type="checkbox"/> Per our conversation                   | <input type="checkbox"/> For distribution                                      |
| <input checked="" type="checkbox"/> <b>For necessary action</b> | <input checked="" type="checkbox"/> <b>For recording/filing</b>                |
| <input type="checkbox"/> Are returned herewith                  |  |

REMARKS:

C S

Cades Schutte Building  
 1000 Bishop Street, Suite 1200  
 Honolulu, Hawaii 96813  
 Tel: 808.521-9200  
 Fax: 808.521-9210  
 www.cades.com

Kona Office  
 75-170 Hualalai Road, Suite 303  
 Kailua Kona, Hawaii 96740  
 Tel: 808.329-5811  
 Fax: 808.326-1175

raincoats, ponchos, pajamas, night shirts, night gowns and robes; masquerade costumes, namely, replica driver suits, replica driver helmets and baseball uniforms; infant wear; and cloth baby bibs not of paper” in International Class 25, and hereby respectfully submits the following for its opposition to the Application with respect to Class 25:

1. Opposer is a manufacturer, distributor, and retailer of various clothing and related goods, including but not limited to T-shirts, and has been engaged in that business for at least the last 13 years.

2. Since at least as early as 1995, Opposer has been engaged in the selling, marketing, and distribution of T-shirts and various other clothing and related goods (collectively, **“Opposer’s Goods”**).

3. Opposer adopted and began using in commerce its distinctive “88 TEES” mark in connection with Opposer’s Goods.

4. Opposer has continuously used its “88 TEES” mark in connection with the sale, marketing, and distribution of Opposer’s Goods, including the affixation of labels and hang-tags showing the “88 TEES” mark, thereby distinguishing its goods from similar or related goods marketed and sold by others.

5. Opposer has extensively promoted and advertised Opposer’s Goods, at a cost of many thousands of dollars, and it has also obtained substantial free promotional value from celebrities, as a result of which sales of 88 Tees’ T-shirts and other clothing goods bearing the “88 TEES” mark have been substantial.

6. As a further result of Opposer’s vigorous marketing efforts over many years, there is a great demand for Opposer’s Goods bearing the “88 TEES” mark.

7. As a result of Opposer's extensive marketing, promotional, and sales efforts in connection with Opposer's Goods bearing the "88 TEES" mark, Opposer's "88 TEES" mark has acquired a valuable business reputation and good will.

8. Opposer is the assignee of U.S. Trademark Registration No. 2,543,892 for the mark, "88 TEES" ("TEES" is disclaimed) ("**Opposer's Mark**"), in connection with "T-shirts", which registration issued on or about March 5, 2002.

9. Attached hereto as Exhibit "A" is a copy of a certified status and title copy of Opposer's Registration No. 2,543,892.

10. As shown by the attached Exhibit "A", Opposer's U.S. Trademark Registration No. 2,543,892 for its "88 TEES" Mark is incontestable, and it therefore constitutes "conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce." 15 U.S.C. 1115(b).

11. Opposer's U.S. Trademark Registration No. 2,543,892 for its "88 TEES" Mark does not contain any restrictions as to channels of trade or purchasers.

12. Opposer has continuously used its "88 TEES" Mark in connection with Opposer's Goods, in U.S. commerce, since at least as early as September 8, 1995.

13. On or about March 7, 2006, on information and belief, Jr. Motorsports, L.L.C., a North Carolina limited liability company, filed with the U.S. Patent and Trademark Office (the "**Trademark Office**") the Application to register the mark "88" ("**Applicant's Mark**").

14. On the basis of an intent to use Applicant's Mark, pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), the Application sought registration of the mark "88"

for “Clothing marketed as goods associated with a stock car racing team, namely, sweatshirts, sweat pants, sweat suits, warm-up suits, shirts, sport shirts, golf shirts, T-shirts, tank tops, sweaters, dresses, skirts, jerseys, long pants, sport shorts, shorts, bathing suits, pants, jackets, coats, hats, caps, bandanas, visors, belts, suspenders, head bands, wrist bands, socks, hosiery, footwear, gloves, scarves, neckties, raincoats, ponchos, pajamas, night shirts, night gowns and robes; masquerade costumes, namely, replica driver suits, replica driver helmets and baseball uniforms; infant wear; and cloth baby bibs not of paper” in International Class 25 (collectively, “**Applicant’s Goods**”), among other goods and services.

15. The Application is not restricted as to purchasers.

16. On information and belief, on or about September 13, 2007, Jr. Motorsports, L.L.C. changed its name to DEJ Holdings, LLC, a North Carolina limited liability company.

17. On information and belief, on or about January 31, 2008, Eighty-Eight, LLC, a North Carolina limited liability company having a principal place of business at 4400 Papa Joe Hendrick Boulevard, Charlotte, North Carolina 28262, was formed.

18. On information and belief, on or about February 12, 2008, DEJ Holdings, LLC purportedly assigned the Application to Eighty-Eight, LLC.

19. At the time of the alleged assignment, no statement of use had been filed and Eighty-Eight, LLC did not have a then ongoing and existing business with regard to the manufacturing, sale, or distribution of Applicant’s Goods, in violation of Section 6 of the Lanham Act, 15 U.S.C. § 1060, which provides in pertinent part, that “no application to register a mark under § 1051(b) of this title shall be assignable prior to the filing of the verified statement

of use under section 1051(d) of this title, except to a successor to the business of the applicant, or portion thereof, to which that mark pertains, if that business is ongoing and existing.”

20. The Application is invalid because it was improperly assigned to Eighty-Eight, LLC. 15 U.S.C. § 1060.

21. Applicant’s Goods and Opposer’s Goods are related.

22. The dominant portion of Applicant’s Mark is “88”, which is identical to the dominant portion of Opposer’s Mark.

23. Applicant’s Mark is confusingly similar to Opposer’s Mark.

24. Persons who are not associated with a stock car racing team may view Applicant’s Goods bearing Applicant’s Mark after such goods have been purchased.

25. Members of the general public may purchase Applicant’s Goods bearing Applicant’s Mark.

26. The use and registration of Applicant’s Mark, as indicated above, would result in confusion, mistake, and/or deception as to the source or origin of Applicant’s Goods, leading consumers to believe that they are somehow affiliated with, or approved, sponsored, or licensed by Opposer.

27. A likelihood of confusion exists under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), between Opposer’s “88 TEES” Mark and Applicant’s “88” Mark.

28. If Applicant is permitted to use and register Applicant’s “88” Mark for Applicant’s Goods, confusion in trade, resulting in irreparable damage and injury to Opposer, inevitably would result by reason of the similarity between Applicant’s and Opposer’s marks and the goods and/or services to be sold thereunder. Any defect, objection, or fault found with goods

and services marketed under Applicant's "88" Mark, would reflect on, and injure, the reputation Opposer will establish for goods sold under its "88 TEES" Mark.

29. If Applicant is granted the registration herein opposed, Applicant would obtain a *prima facie* exclusive right to use the mark set forth in the Application. Such registration would become a source of damage and injury to Opposer through the generation of confusion, mistake, and/or deception, the dilution of Opposer's registered and incontestable "88 TEES" Mark, and the diminution of Opposer's ability to control the quality of goods and/or services sold thereunder.

30. Applicant's Mark, if used on Applicant's Goods, would likely dilute, and/or would actually dilute, the distinctiveness of Opposer's "88 TEES" Mark.

31. On information and belief, Applicant's Goods are or will be offered to purchasers and users who purchase and use the goods and/or services in connection with which Opposer has used and is using Opposer's "88 TEES" Mark.

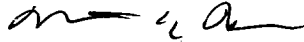
32. There is no issue as to priority. As evidenced by Opposer's registration identified above, Opposer has been using Opposer's "88 TEES" Mark since at least as early as September 8, 1995.

33. On information and belief, and as indicated in the Application, Applicant has not yet commenced use of Applicant's Mark in commerce, in connection with Applicant's Goods.

WHEREFORE, Opposer prays that this Opposition be sustained, that the Application be refused, and that the mark applied for therein be refused registration. The fee required in 37 C.F.R. § 2.6(a)(17) is enclosed herewith.

DATED: Honolulu, Hawaii, April 11, 2008.

Respectfully submitted,



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Martin E. Hsia, Reg. No. 32,471  
CADES SCHUTTE LLP  
A Limited Liability Law Partnership  
1000 Bishop Street, Suite 1200  
Honolulu, HI 96813  
Tel: (808) 521-9200

Attorney for Opposer  
88 TEES HAWAII, INC.



**EXHIBIT "A"**

7066754



# THE UNITED STATES OF AMERICA

**TO ALL TO WHOM THESE PRESENTS SHALL COME;**

**UNITED STATES DEPARTMENT OF COMMERCE**

**United States Patent and Trademark Office**

**May 09, 2007**

**THE ATTACHED U.S. TRADEMARK REGISTRATION 2,543,892 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.**

**REGISTERED FOR A TERM OF 10 YEARS FROM *March 05, 2002*  
SECTION 8 & 15**

**SAID RECORDS SHOW TITLE TO BE IN:**

***88 TEES HAWAII, INC.  
A HAWAII CORPORATION***

**By Authority of the  
Under Secretary of Commerce for Intellectual Property  
and Director of the United States Patent and Trademark Office**

**P. SWAIN  
Certifying Officer**



**EXHIBIT A**

**Int. Cl.: 25**

**Prior U.S. Cls.: 22 and 39**

**United States Patent and Trademark Office**

**Reg. No. 2,543,892**

**Registered Mar. 5, 2002**

**TRADEMARK  
PRINCIPAL REGISTER**

**88 TEES**

**WONG, LOU KIE (UNITED STATES CITIZEN),  
DBA 88 TEES  
2310 KUHIO AVENUE  
HONOLULU, HI 96815**

**NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "TEES", APART FROM THE MARK  
AS SHOWN.**

**FOR: T-SHIRTS, IN CLASS 25 (U.S. CLS. 22 AND  
39).**

**SER. NO. 75-867,111, FILED 12-7-1999.**

**FIRST USE 9-8-1995; IN COMMERCE 9-8-1995.**

**ALICE SUE CARRUTHERS, EXAMINING ATTOR-  
NEY**

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

In the matter of Trademark Application Serial No. 78/830,746  
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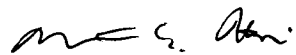
88 TEES HAWAII, INC.,	)	
	)	
Opposer,	)	
	)	Opposition No.: _____
v.	)	
	)	
EIGHTY-EIGHT, LLC,	)	
	)	
Applicant.	)	
_____	)	

**PROOF OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of OPPOSER'S NOTICE OF OPPOSITION was mailed by U.S. First Class mail this 11 day of April 2008 to: Nichelle Nicholes Levy, Esq., Robinson Bradshaw & Hinson, Suite 1900, 101 North Tryon Street, Charlotte, NC 28246.

DATED: Honolulu, Hawaii, April 11, 2008.

Respectfully submitted,



\_\_\_\_\_  
Martin E. Hsia, Reg. No. 32,471  
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88 TEES HAWAII, INC.