

ESTTA Tracking number: **ESTTA211664**

Filing date: **05/15/2008**

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	Varsity Spirit Corporation
Granted to Date of previous extension	05/18/2008
Address	6745 Lennox Center Court Suite 300 Memphis, TN 38115 UNITED STATES

Attorney information	Arlana S. Cohen Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036 UNITED STATES trademark@cll.com Phone:212-790-9200
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Applicant Information

Application No	78972608	Publication date	11/20/2007
Opposition Filing Date	05/15/2008	Opposition Period Ends	05/18/2008
Applicant	A & N ENTERPRISES, L.L.C. 350 Fifth Avenue Room 2204 New York, NY 10118 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: clothing, namely, pants, jeans, sweatpants, shirts, polo shirts, dress shirts, sweatshirts, t-shirts, underwear, jumpers, blouses, skirts, shorts, swimwear, and bathing suits; shoes; slippers; sneakers; boots; socks; hosiery; belts; outerwear, namely, jackets, leather jackets, ski jackets, and vests; suits; ties; school uniforms; dresses; gloves; hats; scarves; pajamas; robes; nightshirts; overalls; coveralls; creepers; leggings; sweaters; snowsuits; layettes; gowns; shortalls; blanket sleepers, knit tops; knit bottoms; sweat suits; warm-up suits; cloth bibs

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.	1575830	Application Date	05/15/1989
Registration Date	01/02/1990	Foreign Priority	NONE

		Date	
Word Mark	JUNIOR VARSITY SPIRIT FASHIONS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1989/04/01 First Use In Commerce: 1989/04/01 MAIL ORDER CATALOG SERVICES IN THE FIELD OF CHEERLEADER UNIFORMS FOR YOUNGER AGE GROUPS		

U.S. Registration No.	1680452	Application Date	04/02/1990
Registration Date	03/24/1992	Foreign Priority Date	NONE
Word Mark	VARSITY SPIRIT FASHIONS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1978/04/10 First Use In Commerce: 1978/04/10 men's and women's cheerleader and dance team clothing; namely, skirts, sweats, sweaters, tops, pants, shoes		

U.S. Registration No.	1796645	Application Date	12/13/1991
Registration Date	10/05/1993	Foreign Priority Date	NONE
Word Mark	VARSITY SPIRIT CORPORATION		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 1993/03/09 First Use In Commerce: 1993/03/09 clothing; namely, cheerleader and dance team uniforms with pom-pons, gloves, vests, tops, shirts, skirts, jumpers, warm-up suits, pants, sweaters, shoes, socks, sweatshirts, T-shirts, shorts, sweat pants, tights, leotards, unitards, dresses and jackets</p> <p>Class 041. First use: First Use: 1992/03/00 First Use In Commerce: 1992/03/00 conducting cheerleading, dance team and gymnastics training camps, clinics, seminars, workshops, competitions, championships and tournaments; performing cheerleading at bowl games; private gymnastics, cheerleader and dance team coaching</p>		

U.S. Registration No.	2293083	Application Date	12/20/1996
Registration Date	11/16/1999	Foreign Priority Date	NONE
Word Mark	VARSITY SPORT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1997/10/30 First Use In Commerce: 1997/10/30 athletic wear, namely, sports shirts, sports shorts, gloves, vests, tops, skirts,		

	jumpers, warm-up suits, pants, sweaters, athletic shoes, sweatshirts, T-shirts, athletic shorts, sweatpants, tights, leotards, unitards, dresses and jackets
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U.S. Registration No.	2357303	Application Date	05/13/1999
Registration Date	06/13/2000	Foreign Priority Date	NONE
Word Mark	V VARSITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1988/11/01 First Use In Commerce: 1988/11/01 cheerleader uniforms, drill team uniforms and pom pon squad uniforms		

U.S. Registration No.	2526564	Application Date	09/14/1999
Registration Date	01/08/2002	Foreign Priority Date	NONE
Word Mark	VARSITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1978/12/00 First Use In Commerce: 1978/12/00 Athletic shirts, athletic shorts, athletic tops, body suits, dresses, hats, jackets, jerseys, jumpers, leotards, pants, skirts, sweaters, sweat pants, sweat shirts, T-shirts, unitards, and warm-up suits sold to colleges, high schools and school-affiliated teams, clubs, groups and individuals by direct sales through sales representatives or employees of applicant, through mail order catalog services or through campus book stores or other retail outlets located at colleges and high schools; uniforms for cheerleaders, drill teams, pom pon squads, pep squads, mascots, bands and booster clubs		

U.S. Registration No.	3418764	Application Date	09/01/1999
Registration Date	04/29/2008	Foreign Priority Date	NONE
Word Mark	VARSITY.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Online retail store services featuring pre-recorded videotapes and compact discs, school supplies, jewelry and home furnishings; providing a website which features advertisements for the goods and services of others on topics of interest to teenage boys and girls on a global computer network Class 039. First use: First Use: 2005/12/31 First Use In Commerce: 2005/12/31 Travel agency services, namely, making reservations Class 045. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Providing an online database in the field of topics of interest to teenage boys and girls, namely, fashion		

U.S. Application No.	75791750	Application Date	09/01/1999
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	VARSITY.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: Cosmetics, namely, lipstick, lip liner, face powder, blush, mascara, eyeliner, eyebrow pencil, and eye shadow</p> <p>Class 009. First use: Pre-recorded videotapes and compact discs containing music and/or movies and video game cassettes</p> <p>Class 020. First use: Home furnishings, namely, sofas, chairs, bedroom furniture</p> <p>Class 041. First use: Camps, namely, children's recreational camps, cheerleading camps, and soccer camps</p>		

U.S. Application No.	75791751	Application Date	09/01/1999
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	VARSITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: Cosmetics, namely, lipstick, lip liner, face powder, blush, mascara, eyeliner, eyebrow pencil, and eye shadow</p> <p>Class 009. First use: Pre-recorded videotapes and compact discs containing music and/or movies and video game cassettes</p> <p>Class 020. First use: Home furnishings, namely, sofas, chairs, bedroom furniture</p> <p>Class 041. First use: Camps, namely, children's recreational camps, cheerleading camps, and soccer camps</p>		

U.S. Application No.	75983628	Application Date	09/01/1999
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	VARSITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Online retail store services featuring pre-recorded videotapes and compact</p>		

	<p>discs, school supplies, jewelry and home furnishings; providing a website which features advertisements for the goods and services of others on topics of interest to teenage boys and girls on a global computer network</p> <p>Class 039. First use: First Use: 2005/12/31 First Use In Commerce: 2005/12/31 Travel agency services, namely, making reservations</p> <p>Class 045. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Providing an online database in the field of topics of interest to teenage boys and girls, namely, fashion</p>
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Attachments	<p>74231166#TMSN.gif (1 page)(bytes) 75216343#TMSN.gif (1 page)(bytes) 75704039#TMSN.gif (1 page)(bytes) 75798082#TMSN.gif (1 page)(bytes) 75984008#TMSN.gif (1 page)(bytes) 75791750#TMSN.gif (1 page)(bytes) 75791751#TMSN.gif (1 page)(bytes) 75983628#TMSN.gif (1 page)(bytes) VARSITYJOE - NOA.pdf (6 pages)(226203 bytes)</p>
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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	/Mark J. Speciner/
Name	Mark J. Speciner
Date	05/15/2008

sweaters; snowsuits; layettes; gowns; shortalls; blanket sleepers, knit tops; knit bottoms; sweat suits; warm-up suits; cloth bibs” in Class 25 (hereinafter referred to as the “A&N VARSITY Mark”). This application was based on Applicant’s intent to use the A&N VARSITY Mark in commerce.

2. Opposer, together with its sister company, Varsity Spirit Fashions & Supplies, Inc. (Varsity Spirit Corporation and Varsity Spirit Fashion & Supplies, Inc. will heretofore be referred to collectively as the “Varsity Companies”), are, and have for many years been engaged in the business of offering goods and services directed to students at all levels and all ages.

3. Opposer, through the Varsity Companies, has used, since at least as early as April 10, 1978, and continues to use in commerce, the mark “VARSITY” for, *inter alia*, products, particularly clothing products and accessories. Opposer has long sold its VARSITY clothing products online at “www.varsity.com” and through catalogs (“Opposer’s Common Law Rights”).

4. Opposer, through the Varsity Companies, is the owner of the following trademark registrations in the United States:

MARK	REG. NO.	DATE	GOODS/SERVICES
JUNIOR VARSITY SPIRIT FASHIONS	1,575,830	01/02/90	Mail order catalog services in the field of cheerleader uniforms for younger age groups
VARSITY SPIRIT FASHIONS	1,680,452	03/24/92	Men’s and women’s cheerleader and dance team clothing; namely, skirts, sweaters, tops, pants, shoes
V VARSITY DANCE	1,752,630	02/16/93	Pompon squad, dance team, and drill team uniforms
VARSITY SPIRIT CORPORATION	1,796,645	10/05/93	Conducting cheerleading, dance teams and gymnastics training camps, clinics, seminars, workshops, competitions, championships and tournaments; performing cheerleading at bowl games; private gymnastics, cheerleader and dance team coaching; clothing; namely,

			cheerleader and dance team uniforms with pom-poms, gloves, vests, tops, shirts, skirts, jumpers, warm-up suits, pants, sweaters, shoes, socks, sweatshirts, T-shirts, shorts, sweat pants, tights, leotards, unitards, dresses and jackets
VARSITY SPORT	2,293,083	11/16/99	Athletic wear, namely, sports shirts, sports shorts, gloves, vests, tops, skirts, jumpers, warm-up suits, pants, sweaters, athletic shoes, sweatshirts, T-shirts, athletic shorts, sweat-pants, tights, leotards, unitards, dresses, and jackets
V VARSITY	2,357,303	06/13/00	Cheerleader uniforms, drill team uniforms and pompon squad uniforms
VARSITY	2,526,564	01/08/02	Athletic shirts, athletic shorts, athletic tops, body suits, dresses, hats, jackets, jerseys, jumpers, leotards, pants, skirts, sweaters, sweat pants, sweat shirts, T-shirts, unitards, and warm-up suits sold to colleges, high schools and school-affiliated teams, clubs, groups and individuals by direct sales through sales representatives or employees of applicant, through mail order catalog services or through campus book stores or other retail outlets located at colleges and high schools; uniforms for cheerleaders, drill teams, pompon squads, pep squads, mascots, bands and booster clubs
VARSITY.COM	3,418,764	04/29/08	Online retail store services featuring pre-recorded videotapes and compact discs, school supplies, jewelry and home furnishings; providing a website which features advertisements for the goods and services of others on topics of interest to teenage boys and girls on a global computer network; travel agency services, namely, making reservations; and providing an online database in the field of topics of interest to teenage boys and girls, namely, fashion.

5. Opposer, through the Varsity Companies, is also the owners of the following allowed trademark applications in the United States:

MARK	Ser. No.	FILED	GOODS/SERVICES
VARSIY.COM	75/791,750	09/01/99	Cosmetics, namely, lipstick, lip liner, face powder, blush, mascara, eyeliner, eyebrow pencil, and eye shadow; Pre-recorded videotapes and compact discs containing music and/or movies and video game cassettes; home furnishings, namely, sofas, chairs, bedroom furniture; camps, namely, children's recreational camps, cheerleading camps, and soccer camps
VARSIY	75/791,751	09/01/99	Cosmetics, namely, lipstick, lip liner, face powder, blush, mascara, eyeliner, eyebrow pencil, and eye shadow; pre-recorded videotapes and compact discs containing music and/or movies and video game cassettes; home furnishings, namely, sofas, chairs, bedroom furniture; camps, namely, children's recreational camps, cheerleading camps, and soccer camps.
VARSIY	75/983,628	09/01/99	Online retail store services featuring, pre-recorded videotapes and compact discs, school supplies, jewelry, home furnishing; providing a website which features advertisements for the goods and services of others on topics of interest to teenage boys and girls on a global computer network; travel agency services, namely, making reservations; providing an online database in the field of topics of interest to teenage boys and girls, namely fashion.

Opposer's Common Law Rights, trademark applications and trademark registrations are referred to hereinafter as the "VARSIY Family of Marks."

6. By virtue of extensive use in commerce of the mark VARSITY in the United States, the relevant trade and public have come to associate goods and services bearing its VARSITY Family of Marks with Opposer.

7. Opposer's first use and registration of its VARSITY Family of Marks in connection with goods and services directed to students long predates Applicant's filing date for its application to register the A&N VARSITY Mark herein opposed.

8. The proposed goods of Applicant and the goods of Opposer are identical and/or substantially similar and related.

9. The A&N VARSITY Mark, as applied to the goods set forth in the application herein opposed, so resembles Opposer's VARSITY Family of Marks as applied to its goods that it is likely to cause confusion, mistake and/or deception.

10. If Applicant is permitted to register the A&N VARSITY Mark for the goods set forth in the application, confusion of the trade and public is likely to result, such confusion resulting in damage and injury to Opposer.

11. Purchasers and potential purchasers, on seeing the Applicant's A&N VARSITY Mark used in connection with its goods are likely to believe, in error, that such goods are offered in association or affiliation with or under license from Opposer.

12. If Applicant is permitted to register its mark for the goods set forth in the application herein opposed, confusion of the relevant trade and public resulting in damage and injury to Opposer would be likely to result. Any persons familiar with the goods of Opposer would be likely to assume that Applicant's goods are sponsored by or produced under license from or otherwise affiliated with Opposer. Furthermore, any objection to or fault found with Applicant's goods provided under its mark would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods sold and services offered under its VARSITY Family of Marks.

13. If Applicant were granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer prays that registration of the mark of application No. 78/972,608 be refused and that this opposition be sustained.