

ESTTA Tracking number: **ESTTA302753**

Filing date: **08/26/2009**

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	Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien
Granted to Date of previous extension	08/26/2009
Address	Sankt-Veit-Strasse 4 München, 81673 GERMANY

Correspondence information	John L. Welch Lando & Anastasi, LLP One Main Street Eleventh Floor Cambridge, MA 02142 UNITED STATES jwelch@ll-a.com Phone:617-395-7072
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Applicant Information

Application No	77646025	Publication date	04/28/2009
Opposition Filing Date	08/26/2009	Opposition Period Ends	08/26/2009
Applicant	Pacific Sunwear of California, Inc. 3450 East Miraloma Avenue Anaheim, CA 928062101 UNITED STATES		

Goods/Services Affected by Opposition


Class 025. All goods and services in the class are opposed, namely: Jeans; Cargo pants; Denims; Pants; Skirts; Shorts; Belts

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.	2264266	Application Date	11/12/1997
Registration Date	07/27/1999	Foreign Priority Date	05/14/1997
Word Mark	B BOGNER		

Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 003. First use: [products for body and beauty care, namely, skin soap, toilet soap, bath soap, deodorant soap, perfumes, essential oils for personal use, hand cream, cold cream, night cream, skin cleansing cream, moisturizing lotions, body lotions, hand lotions, face lotions, bubble bath, shower gels, skin cleansing gels, hair shampoos, hair removing creams, sun blocking preparations, suntan preparations, face cleansing masks in the form of gels, creams and lotions, face moisturizing masks in the form of gels, creams and lotions, shaving cream, shaving foam, shaving lotions, personal deodorants, antiperspirants, body powder, face powder, rouge, eyebrow pencils, eye shadow, mascara, lipsticks, nail polish, nail polish remover, hair conditioners, non-medicated hair care preparations, and dentifrices]</p> <p>Class 009. First use: [EYE GLASSES, EYE GLASS FRAMES, EYE GLASS CASES]</p> <p>Class 018. First use: ARTICLES MADE FROM LEATHER AND IMITATION LEATHER, NAMELY, HANDBAGS; SMALL LEATHER GOODS, NAMELY, PURSES, WALLETS, AND KEY CASES; [TRUNKS FOR TRAVELING] AND SUITCASES; UMBRELLAS, [PARASOLS AND CANES]</p> <p>Class 025. First use: WEARING APPAREL, NAMELY, PANTS, TROUSERS, [RIDING PANTS,] GOLF PANTS, SPORTS JACKETS, JACKETS, DRESSES, COATS, SUITS, SKIRTS, BLOUSES, SHIRTS, PARKAS, SKI PANTS, SKI SUITS, PULLOVERS, CAPS, HATS, [STOCKINGS] AND GLOVES, SHAWLS, SCARVES, HEADBANDS, [SUSPENDERS,] SHOES, BELTS MADE FROM LEATHER AND IMITATION LEATHER, FOOTWEAR AND HEADWEAR</p>
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U.S. Registration No.	3233645	Application Date	10/31/2005
Registration Date	04/24/2007	Foreign Priority Date	NONE
Word Mark	B		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: Eyewear, namely protective eyewear, eyeglasses, goggles for skiing and snowboarding, spectacle frames, spectacle cases, sunglasses, ski-glasses, protective helmets for sports, in particular for skiing and snowboarding; mobile phones; apparatus for recording, transmission or reproduction of sound and images; blank magnetic recording media, namely, computer discs, sound recording discs, sound recording tapes, video tapes, floppy discs; prerecorded audio tapes featuring music; prerecorded video tapes featuring motion pictures about sports, leisure, recreational activities and music; prerecorded compact discs featuring music, prerecorded tapes and video tapes other than for music featuring motion picture films and documentaries in the field of sports, leisure and recreational activities; exposed cinematographic films, exposed camera and slide films, video disks, CDs, CD-ROMs and video tapes with recorded animated cartoons; dictating machines; blank recording discs, electronic automatic vending machines, mechanisms for coin-operated machines, namely, coin dispensers, coin changers, coin counting and sorting mechanisms; cash registers, calculating machines, data processors and computer hardware; fire extinguishers</p> <p>Class 018. First use: Leather and imitation of leather as well as goods made thereof, namely backpacks, boston bags, handbags, purses, wallets, key cases; animal skins and hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips and saddlery</p> <p>Class 025. First use: Clothing, namely, cycling shorts, cycling shirts and cycling jackets, pants, trousers, riding pants, golf pants, ski pants, ski suits, sports shirts, sports jackets, anoraks, gymnastic clothing, namely, leotards, bodysuits, tank shirts, exercise shorts, sweat socks and sports bras; raincoats, shorts, blousons, jackets, dresses, coats, suits, skirts, shirts, parkas, pullovers, stockings, evening dresses, ponchos, chasubles, blue jeans, capes, girdles, blouses, swimming caps, swimsuits, chemisettes, chemises, sweaters, sweatshirts, sweat pants, cardigans, underwear, polo shirts, pullovers, t-shirts, bandanas, ear muffs, gloves, mittens, shawls, shoulder wraps, scarves, socks, water proof clothing, namely, raincoats and trousers; overalls, overcoats; footwear and headwear</p>

Attachments	75388870#TMSN.gif (1 page)(bytes) 79021062#TMSN.jpeg (1 page)(bytes) Notice of Opposition 77646025.pdf (5 pages)(106278 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	/johnlwelch/
Name	John L. Welch
Date	08/26/2009

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

_____)	
Willy Bogner GmbH & Co.)	
Kommanditgesellschaft auf Aktien,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
Pacific Sunwear of California, Inc.,)	
)	Application
)	S.N. 77/646,025
Applicant.)	
_____)	

OPPOSITION

Willy Bogner GmbH & Co. Kommanditgesellschaft auf Aktien, an association limited by shares, organized under the laws of Germany and having a place of business at Sankt-Veit-Strasse 4, München, 81673, Germany, believes that it will be damaged by registration of the trademark that is the subject of Application Serial No., 77/646,025, filed by Pacific Sunwear of California, Inc, and which mark was published for opposition in the *Official Gazette* of April 28, 2009/.



The grounds for the opposition are as follows:

1. Applicant seeks to register the trademark shown immediately below, for “jeans; cargo pants; denims; pants; skirts; shorts; belts” in International Class 25.



2. The opposed application was filed on January 8, 2009, alleging a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

3. Since at least 2005, and long prior to Applicant’s filing date, Opposer has used its B-in-a-circle design mark shown immediately below in commerce in connection with wearing apparel, namely, pants, trousers, golf pants, sports jackets, jackets, dresses, coats, suits, skirts, blouses, shirts, parkas, ski pants, ski suits, pullovers, caps, hats, and gloves, shawls, scarves, headbands, shoes, belts made from leather and imitation leather, footwear and headwear. Opposer is the owner of, *inter alia*, the following United States Trademark Registrations for goods in Class 25:

Reg. No.	Mark	Issued	Goods/Services
2,264,266		July 27, 1999	Wearing apparel, namely, pants, trousers, golf pants, sports jackets, jackets, dresses, coats, suits, skirts, blouses, shirts, parkas, ski pants, ski suits, pullovers, caps, hats, and gloves, shawls, scarves, headbands, shoes, belts made from leather and imitation leather, footwear and headwear
3,233,645		April 24, 2007	Clothing, namely, cycling shorts, cycling shirts and cycling jackets, pants, trousers, riding pants, golf pants, ski pants, ski suits, sports shirts, sports jackets, anoraks, gymnastic clothing, namely, leotards, bodysuits, tank shirts, exercise shorts, sweat socks and sports bras; raincoats, shorts, blousons, jackets, dresses, coats, suits, skirts, shirts, parkas, pullovers, stockings, evening dresses, ponchos, chasubles, blue jeans, capes, girdles, blouses, swimming caps, swimsuits, chemisettes, chemises, sweaters, sweatshirts, sweat pants, cardigans, underwear, polo shirts, pullovers, t-shirts, bandanas, ear muffs, gloves, mittens, shawls, shoulder wraps, scarves, socks, water proof

			clothing, namely, raincoats and trousers; overalls, overcoats; footwear and headwear
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Registration No. 2,264,266 has been made incontestable under 15 U.S.C. § 1065.

5. Opposer's goods as identified in its above-listed trademark registrations are identical or closely related to the goods identified in Application Serial No. 77/646,025. On information and belief, Opposer's goods and Applicant's goods are or will be offered to the same classes of customers through the same channels of trade.

6. Applicant's applied-for mark is substantially and confusingly similar to Opposer's trademarks identified above..

7. If Applicant uses the applied-for mark for the goods identified in Application 77/646,025, such use would be likely to cause confusion, mistake, and/or deception of the relevant trade and public. Customers and potential customers are likely to believe that Applicant's goods offered under the applied-for mark emanate from, or are licensed or approved by, Opposer, when that is not the case. Such confusion, mistake, and/or deception would be a source of damage to Opposer.

8. If Applicant is granted the registration herein opposed, it would thereby obtain a *prima facie* right to exclusive use of the applied-for mark, which would be a further source of damage to Opposer.

9. Because Applicant's applied-for mark is likely to cause confusion with Opposer's above-identified trademarks, Applicant's mark should be refused registration under Section 2(d) of the Trademark Act.

WHEREFORE, Opposer believes that it will be damaged by registration of said mark, and prays that this Opposition be sustained, that Application Serial No. 77/646,025 be rejected, and that the mark applied for therein be refused registration.

Willy Bogner GmbH & Co.
Kommanditgesellschaft auf Aktien

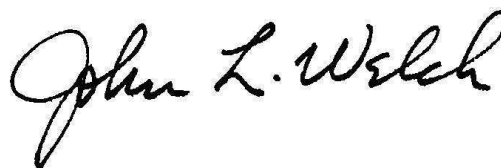
A handwritten signature in black ink that reads "John L. Welch". The signature is written in a cursive, flowing style.

John L. Welch, Esq.
Lando & Anastasi, LLP
One Main Street, Eleventh Floor
Cambridge, MA 02142
617/395-7000

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 25th day of August 2009, a true copy of the foregoing NOTICE OF OPPOSITION was served by first-class mail, postage pre-paid on:

Matthew D. Murphey
Gordon & Rees LLP
4675 Macarthur Ct., Ste. 800
Newport Beach, CA 92660-1844

A handwritten signature in black ink that reads "John L. Welch". The signature is written in a cursive style with a large, prominent "J" and "W".

John L. Welch
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