

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

In the matter of Trademark Application Serial No. 77/770,613  
Filed on June 29, 2009  
For the mark "MISS EIGHTY EIGHT" and design  
Published: May 25, 2010

TTAB

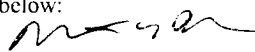
88 TEES HAWAII, INC. )  
 )  
 ) Opposer, )  
 )  
 ) Opposition No.: \_\_\_\_\_  
 )  
 ) v. )  
 )  
 ) MS. BUBBLES, INC., )  
 )  
 ) Applicant. )  
 )  
 \_\_\_\_\_ )

NOTICE OF OPPOSITION

Opposer 88 TEES HAWAII, INC., a Hawaii corporation ("**Opposer**"), whose mailing address is 725 Kapiolani Boulevard, Suite C-110, Honolulu, Hawaii 96813, believes it will be damaged by registration of the mark "MISS EIGHTY EIGHT" and design shown in U.S. Trademark Application Serial No. 77/770,613 (the "**Application**") filed by MS. BUBBLES, INC. ("**Applicant**") on June 29, 2009, and therefore opposes registration of said mark for "Sunglasses" in International Class 9, "Jewelry" in International Class 14, "Handbags" in International Class 18, and "Women's apparel, namely, shirts, shorts, pants, jackets, blazers, vests, blouses, skirts, camisoles, jeans, dresses, halters, socks, hats, swimwear, sweat shirts,

**CERTIFICATE OF MAILING**

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, Virginia 22313-1451 on the date shown below:



MARTIN E. HSIA 32,471

Date: \_\_\_\_\_

7/22/10



07-27-2010

U.S. Patent & Trademark Office

sweat pants, coats, boleros, pajamas, lingerie, scarves, shoes, belts” in International Class 25, and, hereby respectfully submits the following for its opposition to the Application:

1. Opposer is a retailer of various clothing and related goods, and has been engaged in that business for at least the last 14 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 or sold by others.

5. Opposer has extensively promoted and advertised Opposer’s Goods, at a cost of many thousands of dollars, and it has obtained substantial free promotional value from celebrities, as a result of which its sales of “T-shirts” and related 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 become recognized and relied upon as identifying Opposer’s Goods, and Opposer’s “88 TEES” mark has acquired a valuable business reputation and good will.

8. Opposer owns the following U.S. Trademark Registrations for marks containing “88” and “EIGHTY EIGHT” (collectively, “**Opposer’s Registrations**”):

(a) Registration No. 2,543,892 for the mark “88 TEES” (“TEES” is disclaimed) for “T-shirts” in International Class 25, which issued on March 5, 2002;

(b) Registration No. 3,652,933 for “88 TEES” for “Clothing, namely, t-shirts, polo shirts, shirts, tank tops, sweat shirts, headwear and footwear” in International Class 25, which issued on July 14, 2009;

(c) Registration No. 3,555,654 for “EIGHTY EIGHT TEES” for “Clothing, namely, T-shirts” in International Class 25, which issued on January 6, 2009;

(d) Registration No. 3,730,287 for “EIGHTY EIGHT” and design for “Clothing, namely, T-shirts” in International Class 25, which issued on February 15, 2005;

(e) Registration No. 3,730,286 for “EIGHTY EIGHT U.S.A.” for “Clothing, namely T-shirts” in International Class 25, which issued on May 9, 2006;

(f) Registration No. 3,652,932 for “88 TEES” for “Jewelry” in International Class 14, which issued on July 14, 2009;

(g) Registration No. 3,552,456 for “88 TEES” for “Bags, namely, tote bags, cosmetic bags and duffle bags” in International Class 18, which issued on December 30, 2008;

(h) Registration No. 3,552,457 for “88 TEES” for “Towels” in International Class 24, which issued on December 30, 2008; and

(i) Registration No. 3,649,136 for “88 TEES” for “Stickers” in International Class 16, which issued on July 7, 2009.

9. Opposer's U.S. Trademark Registration No. 2,543,892 for "88 TEES" for "T-shirts" in class 25 has become incontestable, pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and 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).

10. Opposer's Registrations are valid and subsisting and remain in full force and effect, as evidence of the validity and Opposer's exclusive ownership of, and right to use, the marks "88 TEES", "EIGHTY EIGHT TEES", "EIGHTY EIGHT" and design, and "EIGHTY EIGHT U.S.A.", and any mark confusingly similar thereto, or which causes the dilution thereof, for the goods and services listed in Opposer's Registrations and all goods and/or services related thereto.

11. Opposer's Registrations do not contain any restrictions as to channels of trade or purchasers.

12. On or about June 29, 2009, on information and belief, Applicant filed with the U.S. Patent and Trademark Office the Application to register the mark "MISS EIGHTY EIGHT" and design ("**Applicant's Mark**").

13. On the basis of a bona fide intention to use Applicant's Mark, pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), the Application seeks registration of the mark "MISS EIGHTY EIGHT" and design for "Cosmetics" in International Class 3, "Sunglasses" in International Class 9, "Jewelry" in International Class 14, "Handbags" in International Class 18, and "Women's apparel, namely, shirts, shorts, pants, jackets, blazers, vests, blouses, skirts, camisoles, jeans, dresses, halters, socks, hats, swimwear, sweat shirts,

sweat pants, coats, boleros, pajamas, lingerie, scarves, shoes, belts” in International Class 25 (collectively, “**Applicant’s Goods**”).

14. Opposer’s Goods include “jewelry”, “bags”, “shirts”, “sweat shirts” “headwear” and “footwear” as shown in Registrations Nos. 3,652,932; 3,552,456 and 3,652,933.

15. Cosmetics, sunglasses, jewelry, handbags and clothing are related products.

16. Applicant’s Goods are identical to some of Opposer’s Goods.

17. Applicant’s Goods are related to some or all of Opposer’s Goods.

18. On information and belief, J. Choo Limited is the holder of Registration No. 3,491,347 for “JIMMY CHOO” and design in connection with, among other things, “Cosmetics” in International Class 3, “Sunglasses” International Class 9, “Jewelry” in International Class 14, “Handbags” in International Class 18, and “Footwear, namely, boots, shoes, sandals, slippers, sneakers; clothing, namely, dresses, skirts, blouses, sweaters, t-shirts, polo shirts, long pants, short pants, Oxford shirts, gloves, jackets, suits, evening dresses; women's underwear, socks, stockings; headgear, namely, hats, scarves, baseball caps” in International Class 25.

19. On information and belief, Retail Brand Alliance, Inc. is the holder of Registration No. 3,029,206 for “BROOKS BROTHERS” in connection with, among other things, “Cosmetics” in International Class 3, “Sunglasses” in International Class 9, “Jewelry” in International Class 14, “Handbags” in International Class 18, and “Men's, women's, boy's and girl's shirts, tops, sweaters, jackets, pants, suits, bottoms, socks, hats and caps; shoes; shorts, coats, neckties, underwear, vests, robes, hosiery, skirts, dresses, loungewear, scarves, rainwear, trousers, ascots, ties, outer shirts including evening, dress, polo and sports shirts, collars,

pajamas, robes, smoking jackets, dressing gowns, mufflers, gloves, hose, belts, suspenders, garters, boots, slippers, shoes, overshoes, beach wear, swimwear, and formal wear, namely, jackets, pants, suits, shirts, shoes, cummerbunds, ties, suspenders and gowns” in International Class 25.

20. The Application is not restricted as to channels of trade or purchasers.

21. On information and belief, the goods covered by the Application are or will be offered to the same class of purchasers and users who purchase and use the goods in connection with which Opposer has used and is using its marks, “88 TEES”, “EIGHTY EIGHT TEES”, “EIGHTY EIGHT” and design, and “EIGHTY EIGHT U.S.A.”.

22. The dominant portion of Opposer’s “88 TEES” and “EIGHTY EIGHT TEES” marks are “88” and “EIGHTY EIGHT”, while “TEES” is disclaimed.

23. The dominant portion of Applicant’s Mark is “EIGHTY EIGHT”.

24. Applicant’s Mark is confusingly similar to Opposer’s marks, “88 TEES”, “EIGHTY EIGHT TEES”, “EIGHTY EIGHT” and design, and “EIGHTY EIGHT U.S.A.”.

25. A likelihood of confusion exists under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), between Opposer’s marks, “88 TEES”, “EIGHTY EIGHT TEES”, “EIGHTY EIGHT” and design, and “EIGHTY EIGHT U.S.A.”, and 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, approved, sponsored, or licensed by Opposer.

27. If Applicant is permitted to use and register Applicant’s Mark for Applicant’s Goods, confusion in trade, resulting in irreparable damage and injury to Opposer,

inevitably would result by reason of the confusing similarity between Applicant's and Opposer's marks and the goods and/or services to be sold and/or provided thereunder. Any defect, objection, or fault found with goods and services marketed under Applicant's Mark, would reflect on, and injure, the reputation Opposer has established for goods and services sold under its marks, "88 TEES", "EIGHTY EIGHT TEES", "EIGHTY EIGHT" and design, and "EIGHTY EIGHT U.S.A.".

28. 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 marks, and the diminution of Opposer's ability to control the quality of goods and/or services sold thereunder.

29. Moreover, such registration would run contrary to the requirement that all doubts as to the likelihood of confusion must be resolved in favor of Opposer as the senior user of the mark, and against Applicant, who has a legal duty to select a mark totally dissimilar to marks already in use.

30. Applicant's Mark, if used in connection with Applicant's Goods, would likely dilute, and/or would actually dilute, the distinctiveness of Opposer's marks, "88 TEES", "EIGHTY EIGHT TEES", "EIGHTY EIGHT" and design, and "EIGHTY EIGHT U.S.A.".

31. On information and belief, Applicant's Goods will be offered to the same class of purchasers and users who purchase and use the goods and/or services in connection with which Opposer has used and is using its marks, "88 TEES", "EIGHTY EIGHT TEES", "EIGHTY EIGHT" and design, and "EIGHTY EIGHT U.S.A.".

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

33. On March 19, 2007, Opposer filed a trademark infringement action against Applicant, captioned, 88 Tees Hawaii, Inc. v. Ms. Bubbles, Inc., Civil No. CV 07-00143 SPK/BMK, in the United States District Court for the District of Hawaii, pursuant to which Opposer and Applicant entered into a Settlement and Mutual Release Agreement (the "**Settlement Agreement**"), which incorporated the terms of a License Agreement ("**License Agreement**") by and between Opposer and Applicant.

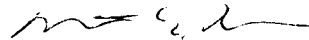
34. Applicant is prohibited from seeking registration of Applicant's Mark pursuant to the Settlement Agreement.

35. Opposer has not consented to Applicant's use or registration of Applicant's Mark.

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 pursuant to 37 C.F.R. § 2.6(a)(17) is enclosed herewith.

DATED: Honolulu, Hawaii, July 22, 2010.

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

Attorneys for Opposer  
88 TEES HAWAII, INC.



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

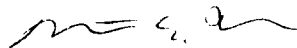
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		)	
MS. BUBBLES, INC.,		)	
		)	
	Applicant.	)	
_____			

**PROOF OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of OPPOSER'S NOTICE OF OPPOSITION was mailed by prepaid U.S. First Class Mail this 22<sup>nd</sup> day of July 2010, to:  
 Deborah H. Sirias, Esq., Lewis Brisbois Bisgaard & Smith LLP, 221 N. Figueroa Street,  
 Suite 1200, Los Angeles, California 90012-2663.

DATED: Honolulu, Hawaii, July 22, 2010.



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 CADES SCHUTTE LLP  
 1000 Bishop Street, Suite 1200  
 Honolulu, HI 96813  
 (808) 544-3835

Attorneys for Opposer  
 88 TEES HAWAII, INC.

**Transmittal Memorandum**

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

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

**DATE** : July 22, 2010

**RE** : Serial No.: 77/770,613  
Mark: "MISS EIGHTY EIGHT"  
Opposer: 88 Tees Hawaii, Inc.  
Applicant: Ms. Bubbles, Inc.

We are sending you the following:

ORIG.	COPIES	DATED	DESCRIPTION
1		07/22/10	Notice of Opposition; Proof of Service
1		07/22/10	Filing Fee (\$1200.00)
1		07/22/10	Postcard receipt of Notice of Opposition; Proof of Service and Filing Fee

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|---|--|
| <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

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