

ESTTA Tracking number: **ESTTA381442**

Filing date: **12/01/2010**

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	Panama Jack International, Inc.
Granted to Date of previous extension	12/01/2010
Address	230 Ernestine Street Orlando, FL 32801 UNITED STATES

Attorney information	Bridget H. Labutta Allen, Dyer, Doppelt, Milbrath & Gilchrist, P.A. 255 S. Orange Avenue, Suite 1401 Orlando, FL 32801 UNITED STATES blabutta@addmg.com, spayne@addmg.com Phone:4078412330
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Applicant Information

Application No	77959640	Publication date	08/03/2010
Opposition Filing Date	12/01/2010	Opposition Period Ends	12/01/2010
Applicant	The Vermont Teddy Bear Company, Inc. 6655 Shelburne Road, P.O. Box 965 Shelburne, VT 05482 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Caps; Denim jackets; Denims; Footwear; Hats; Jackets; Lounge pants; Loungewear; Pajama bottoms; Pajamas; Pants; Shirts; Sleep pants; Sleep shirts; Sleepwear; Sport shirts; Sports pants; T-shirts; Visors; Yoga pants


Grounds for Opposition


Deceptiveness	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	1784193	Application Date	02/10/1992
Registration Date	07/27/1993	Foreign Priority Date	NONE
Word Mark	PANAMA JACK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1987/01/01 First Use In Commerce: 1987/01/01 footwear

U.S. Registration No.	1667691	Application Date	01/25/1991
Registration Date	12/10/1991	Foreign Priority Date	NONE
Word Mark	PANAMA JACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1974/07/00 First Use In Commerce: 1975/00/00 clothing; namely, T-shirts, jerseys, baseball shirts and sweatshirts		

U.S. Registration No.	1690257	Application Date	01/25/1991
Registration Date	06/02/1992	Foreign Priority Date	NONE
Word Mark	PANAMA JACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1975/00/00 First Use In Commerce: 1975/00/00 clothing; namely, T-shirts, jerseys, baseball shirts and sweatshirts		

U.S. Registration No.	1354252	Application Date	07/23/1984
Registration Date	08/13/1985	Foreign Priority Date	NONE
Word Mark	PANAMA JACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1981/04/09 First Use In Commerce: 1981/05/12		

	CLOTHING, NAMELY JEANS, PANTS, SHORTS, DRESSES SWIMWEAR, JOGGING OUTFITS, SWEAT PANTS, BANDANNAS, NIGHTSHIRTS, VISORS, HATS AND JACKETS		
U.S. Registration No.	1354251	Application Date	07/23/1984
Registration Date	08/13/1985	Foreign Priority Date	NONE
Word Mark	PANAMA JACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1981/04/09 First Use In Commerce: 1981/05/12 CLOTHING, NAMELY JEANS, PANTS, SHORTS, DRESSES, HATS, SWIMWEAR, JOGGING OUTFITS, SWEAT PANTS, NIGHT SHIRTS, VISORS, BANDANNAS AND JACKETS		

Attachments	74134312#TMSN.gif (1 page)(bytes) 74134311#TMSN.gif (1 page)(bytes) 73491104#TMSN.gif (1 page)(bytes) Notice of Opposition.pdf (5 pages)(18961 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	/Bridget H. Labutta/
Name	Bridget H. Labutta
Date	12/01/2010

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

In the matter of Trademark Application Serial No. 77/959,640
For the Mark **PAJAMA JACK**
Published in the Official Gazette on August 3, 2010

Panama Jack International, Inc.,

Opposer,

Opposition No. _____

vs.

The Vermont Teddy Bear Company, Inc.,

Applicant.

_____ /

NOTICE OF OPPOSITION

Panama Jack International, Inc. ("Panama Jack"), a Florida corporation located at 230 Ernestine Street, Orlando, Florida 32801, believes that it will be damaged by the registration of the mark **PAJAMA JACK**, as shown in Application Serial No. 77/959,640 and intended for use in connection with "Caps; Denim jackets; Denims; Footwear; Hats; Jackets; Lounge pants; Loungewear; Pajama bottoms; Pajamas; Pants; Shirts; Sleep pants; Sleep shirts; Sleepwear; Sport shirts; Sports pants; T-shirts; Visors; Yoga pants" in International Class 25, as published in the Official Gazette on August 3, 2010, and hereby opposes the same pursuant to an extension of time granted on August 30, 2010.

The grounds for the opposition are as follows:

1. Since at least as early as July of 1974, Panama Jack has been engaged in the manufacture, promotion, advertising, distribution, sale and offering for sale of a variety of goods and services employing the mark **PANAMA JACK**, used alone or in combination with other names and designs (hereinafter the "Panama Jack Marks").

2. The Panama Jack Marks are used and federally registered for use on or in connection with "active lifestyle" products and services including but not limited to clothing,

footwear, sunblock and sunscreen preparations, lip balm, sunglasses, sunglass cases, hand bags, tote bags, luggage, liquor, towels, jewelry, hair care products, and retail sales of the foregoing.

3. Relevant to this proceeding, Panama Jack owns U.S. Trademark Registration Nos. 1,784,193; 1,667,691; 1,690,257; 1,354,252 and 1,354,251, all for the mark **PANAMA JACK** and all for goods in International Class 25, namely footwear (based on use since at least as early as 1987) and clothing including jeans, pants, shorts, dresses, hats, swimwear, jogging outfits, sweatpants, nightshirts, visors, bandannas and jackets (based on use since at least as early as 1975). All of these federal trademark registrations remain in full force and effect, having neither been revoked nor cancelled, and are *prima facie* evidence of Panama Jack's exclusive right to use these marks in commerce on these goods or related goods.

4. All of the Panama Jack Marks are distinctive and are valuable assets as symbols of Panama Jack.

5. Panama Jack has developed considerable and valuable goodwill with respect to the Panama Jack Marks. For over thirty years, Panama Jack and its authorized licensees have continuously and exclusively sold and distributed substantial quantities of goods in association with the Panama Jack Marks, and have spent substantial sums in advertising and promoting goods and services bearing the Panama Jack Marks, resulting in widespread and favorable public acceptance and recognition.

6. Applicant filed its intent-to-use application on March 16, 2010, seeking to register the mark **PAJAMA JACK** in connection with "Caps; Denim jackets; Denims; Footwear; Hats; Jackets; Lounge pants; Loungewear; Pajama bottoms; Pajamas; Pants; Shirts; Sleep pants; Sleep shirts; Sleepwear; Sport shirts; Sports pants; T-shirts; Visors; Yoga pants" in International Class 25. To date, Applicant has not filed an Amendment to Allege Use.

7. The application for the mark **PAJAMA JACK** identifies a mark that is very similar in sight, sound, connotation, and commercial impression to the mark **PANAMA JACK**.

8. The application for the mark **PAJAMA JACK** identifies goods that are similar, if not identical, to those goods identified in Panama Jack's registrations noted in Paragraph 3, above.

9. Upon information and belief, Applicant intends to offer for sale and sell goods under the mark **PAJAMA JACK** through the same channels of trade and to the same classes of purchasers that are utilized by Panama Jack in connection with Panama Jack's registrations noted in Paragraph 3, above.

10. Each of the Panama Jack Marks listed in Paragraph 3, above, was used in commerce before the application for **PAJAMA JACK** was filed. Moreover, each of the Panama Jack registrations noted in Paragraph 3, above, was issued before the application for **PAJAMA JACK** was filed.

11. The subject application should be denied registration because Applicant's mark is deceptively similar to each of the previously used and registered Panama Jack Marks noted in Paragraph 3, above, and Applicant's mark is likely to cause confusion with the Panama Jack Marks noted in Paragraph 3, above, as to the source of the goods.

12. If Applicant is granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to use the mark **PAJAMA JACK**, thereby causing damage and injury to Panama Jack. Any defect, objection or fault found with Applicant's goods promoted under the mark **PAJAMA JACK** is likely to reflect upon Panama Jack, and expose Panama Jack to liability, and seriously injure the goodwill and superior reputation that Panama Jack has established for its goods and the Panama Jack Marks.

13. WHEREFORE, Panama Jack respectfully requests that this opposition be sustained, and the subject mark **PAJAMA JACK** be denied registration.

Respectfully submitted,

Dated: December 1, 2010

/Bridget Heffernan Labutta/
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**Attorneys for Opposer
Panama Jack International, Inc.**

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing was served by U. S. Mail on this 1st day of December 2010 to:

H. JAY SPIEGEL & ASSOCIATES
PO BOX 11
MOUNT VERNON, VA 22121-0011

/Bridget Heffernan Labutta/