

ESTTA Tracking number: **ESTTA392204**

Filing date: **02/08/2011**

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	Theory, LLC
Granted to Date of previous extension	02/23/2011
Address	38 Gansevoort Street New York, NY 10014 UNITED STATES

Attorney information	Amy B. Goldsmith Gottlieb, Rackman & Reisman, PC 270 Madison Avenue New York, NY 10016 UNITED STATES efiling@grr.com, agoldsmith@grr.com Phone:212-684-3900
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### Applicant Information

Application No	85045928	Publication date	10/26/2010
Opposition Filing Date	02/08/2011	Opposition Period Ends	02/23/2011
Applicant	Barney, Joshua Clifton 33781 Harvest Way East Wildomar, CA 92595 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms
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### 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.	2067427	Application Date	10/08/1993
Registration Date	06/03/1997	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 025. First use: First Use: 1996/08/17 First Use In Commerce: 1996/08/17 sweaters

U.S. Registration No.	2338012	Application Date	02/03/1999
Registration Date	04/04/2000	Foreign Priority Date	NONE

Word Mark	THEORY
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Design Mark	<b>THEORY</b>
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Description of Mark	NONE
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Goods/Services	Class 025. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 WEARING APPAREL, NAMELY T-SHIRTS, TOPS, SHORTS, PANTS, SKIRTS, BLOUSES, DRESSES, EVENING GOWNS, JACKETS, COATS, SUITS, VESTS, SOCKS, SCARVES AND CAPS
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U.S. Registration No.	2802700	Application Date	01/18/1999
Registration Date	01/06/2004	Foreign Priority Date	NONE

Word Mark	THEORY
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Design Mark	<b>THEORY</b>
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Description of Mark	NONE
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Goods/Services	Class 018. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 LEATHER GOODS, namely, BELTS, HANDBAGS, [ KEY CASES, WALLETS, ] TOTE BAGS, [ COSMETIC BAGS SOLD EMPTY, ] BACKPACKS, [ FANNY PACKS, DIARY AND ADDRESS BOOK COVERS, AND LUGGAGE; AND UMBRELLAS ] Class 025. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 WEARING APPAREL, namely, BELTS, SLEEPWEAR, [ BATHING SUITS, ] STOCKINGS, LINGERIE, UNDERWEAR, WRAPS, HATS, GLOVES AND FOOTWEAR
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	Class 035. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 RETAIL STORE SERVICES IN THE FIELDS OF APPAREL, FOOTWEAR, BAGS AND LUGGAGE AND WATCHES AND JEWELRY		
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U.S. Registration No.	3004691	Application Date	06/06/2002
Registration Date	10/04/2005	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark	<b>THEORY</b>		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2003/06/23 First Use In Commerce: 2003/06/23 JEWELRY, CLOCKS AND WATCHES		

U.S. Registration No.	3388829	Application Date	06/24/2005
Registration Date	02/26/2008	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark	<b>THEORY</b>		
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2005/01/31 First Use In Commerce: 2005/01/31 lip balm		

U.S. Registration No.	3490184	Application Date	12/29/2004
Registration Date	08/19/2008	Foreign Priority Date	NONE
Word Mark	THEORY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2008/04/24 First Use In Commerce: 2008/04/24 EYEGLASSES, EYEGLOSS FRAMES and SUNGLASSES

U.S. Registration No.	3672075	Application Date	10/29/2008
Registration Date	08/25/2009	Foreign Priority Date	NONE
Word Mark	THEORY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1999/01/01 First Use In Commerce: 1999/01/01 MEN'S WEAR, NAMELY, TAILORED SUITS, TAILORED SPORTS COATS, TAILORED TROUSERS, TAILORED VESTS, TAILORED TOP COATS, TIES AND BOW TIES; MEN'S WEAR, NAMELY, TUXEDOS; MEN'S WEAR, NAMELY, T-SHIRTS, LONG-SLEEVED SHIRTS, SWEATERS, PANTS, VESTS, COATS, BLAZERS, SCARVES AND LEATHER JACKETS		

Attachments	75631960#TMSN.gif ( 1 page )( bytes ) 75980638#TMSN.gif ( 1 page )( bytes ) 76417051#TMSN.gif ( 1 page )( bytes ) 78658069#TMSN.jpeg ( 1 page )( bytes ) 78539450#TMSN.jpeg ( 1 page )( bytes ) 77603433#TMSN.jpeg ( 1 page )( bytes ) DecayTheory- Opposition.pdf ( 11 pages )(213363 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	/abg/
Name	Amy B. Goldsmith
Date	02/08/2011

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

In the Matter of Trademark Application  
Serial No.: 85045928  
Applicant: Joshua Clifton Barney  
Trademark: DTD DECAY THEORY and design  
Published: October 26, 2010  
Class: International Class 25

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Theory LLC,

Opposer,

vs.

Joshua Clifton Barney,

Applicant.  
-----X

Opposition No.

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451  
Attn: Trademark Trial and Appeal Board

**NOTICE OF OPPOSITION**

Theory LLC ("Opposer"), through its attorneys, believing that it would be damaged by the registration of the mark DTD DECAY THEORY and design in Application Serial No. 85045928, published in the Official Gazette on October 26, 2010, does allege, on knowledge as to Opposer and otherwise on information and belief, as follows:

1. Theory, LLC is a limited liability company of the State of New York, located and doing business at 38 Gansevoort Street, New York, New York 10014. Theory, LLC is the owner of numerous United States trademark registrations and applications comprising or incorporating the mark THEORY in classes 3, 14, 18, 25 and 35 under U.S. Trademark Registration Nos. 2,067,427; 2,338,012; 2,802,700; 3,004,691; 3,388,829; 3,490,184; 3,672,075, and others (the "THEORY Trademarks").

Enclosed, as Exhibit A, is a print-out of these registration from the Trademark Office TARR database.

2. It is believed that the foregoing is relevant to Applicant's application to register athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps and athletic uniforms. (International Class 25), pursuant to 2(d) of the Trademark Act.

3. Theory, LLC has expended considerable amounts of time, effort and money in promoting the above-identified THEORY Trademarks which have become assets of substantial value and symbols of Theory, LLC's high quality products and reliability and goodwill.

4. As a result of Theory, LLC's long, continuous and highly publicized use of its THEORY Trademarks, the public has come to associate the THEORY Trademarks with Theory, LLC.

5. Applicant filed its Application Serial No. 85045928 for the mark DTD DECAY THEORY and design for athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps and athletic uniforms in International Class 25, on May 24, 2010, based on intent to use in commerce.

6. Theory, LLC's date of first use of the THEORY Trademarks, including Registration No. 2,067,427 for clothing is prior to the filing date of Application Serial No. 85045928.

7. The goods identified in Theory, LLC's THEORY Trademarks and Applicant's purported trademark in Serial No. 85045928 travel in the same channels of trade.

8. The goods represented by the THEORY Trademarks and Applicant's purported mark in Serial No. No. 85045928 is identical or similar.

9. Applicant's purported trademark DTD DECAY THEORY and design represented in Serial No. 85045928 sounds, appears and has the same connotations as the THEORY Trademarks and is confusingly similar to the THEORY Trademarks. Moreover, the association of the brand name and trade name THEORY with the pejorative word DEVIL is likely to damage Theory, LLC's reputation.

10. Applicant's purported mark DTD DECAY THEORY and design in Serial No. 85045928 so resembles the THEORY Trademarks as to be likely when used on or in connection with the goods recited in Application Serial No. 85045928 to cause confusion, or to cause mistake, or to deceive.

For the above reasons, Theory, LLC would be severely damaged by the registration of the purported trademark DTD DECAY THEORY and design in Serial No. 85045928.

Thus, Theory, LLC respectfully requests that the Director of the Trademark Examining Operations grant this Opposition.

The Commissioner is authorized to charge any fees which may be required to our Deposit Account No. 07-1730.

Respectfully submitted,

GOTTLIEB, RACKMAN & REISMAN, P.C.  
Attorneys for Theory, LLC  
270 Madison Avenue, 8<sup>th</sup> Floor  
New York, New York 10016  
(212) 684-3900

By: s/Amy B. Goldsmith/  
Amy B. Goldsmith

Dated: February 8, 2011  
New York, New York



# EXHIBIT A

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,067,427

**United States Patent and Trademark Office**

Registered June 3, 1997

**TRADEMARK  
PRINCIPAL REGISTER**

**THEORY**

BELDOCH INDUSTRIES CORPORATION  
(DELAWARE CORPORATION)  
1411 BROADWAY  
NEW YORK, NY 10018

FIRST USE 8-17-1996; IN COMMERCE  
8-17-1996.

SN 74-446,792, FILED 10-8-1993.

FOR: SWEATERS, IN CLASS 25 (U.S. CLS. 22  
AND 39).

ODETTE BONNET, EXAMINING ATTORNEY

**Int. Cl.: 25**

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

**United States Patent and Trademark Office**

**Reg. No. 2,338,012**

**Registered Apr. 4, 2000**

**TRADEMARK  
PRINCIPAL REGISTER**

**THEORY**

THEORY LLC (NEW YORK CORPORATION)  
1114 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

SCARVES AND CAPS, IN CLASS 25 (U.S. CLS.  
22 AND 39).

FIRST USE 2-0-1997; IN COMMERCE  
2-0-1997.

FOR: WEARING APPAREL, NAMELY T-  
SHIRTS, TOPS, SHORTS, PANTS, SKIRTS,  
BLOUSES, DRESSES, EVENING GOWNS,  
JACKETS, COATS, SUITS, VESTS, SOCKS,

SER. NO. 75-631,960, FILED 2-3-1999.

DOMINICK J. SALEMI, EXAMINING ATTOR-  
NEY

Int. Cls.: 18, 25, and 35

Prior U.S. Cls.: 1, 2, 3, 22, 39, 41, 100, 101, and 102

**United States Patent and Trademark Office**

**Reg. No. 2,802,700**

Registered Jan. 6, 2004

**TRADEMARK  
SERVICE MARK  
PRINCIPAL REGISTER**

**THEORY**

THEORY LLC (NEW YORK CORPORATION)  
1114 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

FOR: LEATHER GOODS, NAMELY BELTS, HANDBAGS, KEY CASES, WALLETS, TOTE BAGS, COSMETIC BAGS SOLD EMPTY, BACKPACKS, FANNY PACKS, DIARY AND ADDRESS BOOK COVERS, AND LUGGAGE; AND UMBRELLAS, IN CLASS 18 (U.S. CLS. 1, 2, 3, 22 AND 41).

FIRST USE 2-0-1997; IN COMMERCE 2-0-1997.

FOR: WEARING APPAREL, NAMELY BELTS, SLEEPWEAR, BATHING SUITS, STOCKINGS, LINGERIE, UNDERWEAR, WRAPS, HATS, GLOVES

AND FOOTWEAR, IN CLASS 25 (U.S. CLS. 22 AND 39).

FIRST USE 2-0-1997; IN COMMERCE 2-0-1997.

FOR: RETAIL STORE SERVICES IN THE FIELDS OF APPAREL, FOOTWEAR, BAGS AND LUGGAGE AND WATCHES AND JEWELRY, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 2-0-1997; IN COMMERCE 2-0-1997.

OWNER OF U.S. REG. NO. 2,067,427.

SN 75-980,638, FILED 1-18-1999.

DOMINICK J. SALEMI, EXAMINING ATTORNEY

Int. Cl.: 14

Prior U.S. Cls.: 2, 27, 28, and 50

**United States Patent and Trademark Office**

**Reg. No. 3,004,691**

Registered Oct. 4, 2005

**TRADEMARK  
PRINCIPAL REGISTER**

**THEORY**

THEORY LLC (NEW YORK CORPORATION)  
1114 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

OWNER OF U.S. REG. NO. 2,067,427.

FOR: JEWELRY, CLOCKS AND WATCHES, IN  
CLASS 14 (U.S. CLS. 2, 27, 28 AND 50).

SN 76-417,051, FILED 6-6-2002.

FIRST USE 6-23-2003; IN COMMERCE 6-23-2003.

DOMINICK J. SALEMI, EXAMINING ATTORNEY

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51 and 52

United States Patent and Trademark Office

Reg. No. 3,388,829

Registered Feb. 26, 2008

TRADEMARK  
PRINCIPAL REGISTER

THEORY

THEORY LLC (NEW YORK LTD LIAB CO)  
1114 AVENUE OF THE AMERICAS  
NEW YORK, NY 10036

FOR: LIP BALM, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50,  
51 AND 52).

FIRST USE 1-31-2005; IN COMMERCE 1-31-2005.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,076,973.

SER. NO. 78-658,069, FILED 6-24-2005.

MYRIAH HABEEB, EXAMINING ATTORNEY

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

**United States Patent and Trademark Office**

**Reg. No. 3,490,184**

Registered Aug. 19, 2008

**TRADEMARK  
PRINCIPAL REGISTER**

**THEORY**

THEORY LLC (NEW YORK LTD LIAB CO)  
38 GANSEVOORT STREET  
NEW YORK, NY 10014

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

FOR: EYEGLASSES, EYEGASS FRAMES AND  
SUNGLASSES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36  
AND 38).

SN 78-539,450, FILED 12-29-2004.

FIRST USE 4-24-2008; IN COMMERCE 4-24-2008.

ANNE FARRELL, EXAMINING ATTORNEY

Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

United States Patent and Trademark Office

Reg. No. 3,672,075

Registered Aug. 25, 2009

TRADEMARK  
PRINCIPAL REGISTER

THEORY

THEORY LLC (NEW YORK LIMITED LIABILITY  
COMPANY)  
38 GANSEVOORT STREET  
NEW YORK, NY 100160601

FOR: MEN'S WEAR, NAMELY, TAILORED  
SUITS, TAILORED SPORTS COATS, TAILORED  
TROUSERS, TAILORED VESTS, TAILORED TOP  
COATS, TIES AND BOW TIES; MEN'S WEAR,  
NAMELY, TUXEDOS; MEN'S WEAR, NAMELY, T-  
SHIRTS, LONG-SLEEVED SHIRTS, SWEATERS,  
PANTS, VESTS, COATS, BLAZERS, SCARVES AND  
LEATHER JACKETS, IN CLASS 25 (U.S. CLS. 22 AND  
39).

FIRST USE 1-1-1999; IN COMMERCE 1-1-1999.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,067,427, 2,802,700  
AND OTHERS.

SER. NO. 77-603,433, FILED 10-29-2008.

RUDY R. SINGLETON, EXAMINING ATTORNEY