

ESTTA Tracking number: **ESTTA420860**

Filing date: **07/20/2011**

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	Pico Manufacturing Sales Corp.
Granted to Date of previous extension	09/18/2011
Address	463 Seventh Avenue, Suite 1500 New York, NY 10018 UNITED STATES

Attorney information	Robert S. Weisbein Foley & Lardner LLP 90 Park Avenue New York, NY 10016 UNITED STATES ptomailnewyork@foley.com, rweisbein@foley.com, tgangaram@foley.com, spippin@foley.com Phone:212.338.3528
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Applicant Information

Application No	85144266	Publication date	03/22/2011
Opposition Filing Date	07/20/2011	Opposition Period Ends	09/18/2011
Applicant	Joseph, Jake 2902 Stonewall Ct. Missouri City, TX 77459 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2008/01/10 First Use In Commerce: 2008/06/15 All goods and services in the class are opposed, namely: Boxer briefs; Boxer shorts; Briefs; Briefs; Knitted underwear; Ladies' underwear; Loungewear; Sleepwear; Trunks; Underwear; Women's underwear; Woven or knitted underwear
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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.	1687935	Application Date	12/06/1990
Registration Date	05/19/1992	Foreign Priority Date	NONE
Word Mark	JAKE & CO.		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1990/11/08 First Use In Commerce: 1990/11/08 men's and boys' boxer underwear shorts

U.S. Registration No.	3534666	Application Date	02/08/2007
Registration Date	11/18/2008	Foreign Priority Date	NONE
Word Mark	JAKE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2008/07/24 First Use In Commerce: 2008/07/24 Undergarments, Knit and Thermal Underwear, Woven and Knitted Boxer Shorts, Undershirts, Briefs		

Attachments	77102685#TMSN.jpeg (1 page)(bytes) Notice of Opp.pdf (4 pages)(1363472 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	/Robert S. Weisbein/
Name	Robert S. Weisbein
Date	07/20/2011

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

Mark: JAKE JOSEPH
Serial No: 85/144,266
Filed: October 4, 2010
Published: March 22, 2011

PICO MANUFACTURING
SALES CORPORATION

		Opposer,	
	v.		
JAKE JOSEPH,			
		Applicant.	

Opposition No. _____

NOTICE OF OPPOSITION

Pico Manufacturing Sales Corporation, a New York corporation, located and doing business at 463 Seventh Avenue, Suite 1500, New York, New York, 10018 (“Pico” or “Opposer”), believes that it will be damaged by the registration of Application Serial No. 85/144,266 and hereby opposes grant of same.

As grounds for its opposition, Opposer alleges as follows:

1. Established in 1931, Opposer is a premier manufacturer and merchandiser of men’s, women’s and children’s sleepwear and underwear.
2. Continuously, since November 1990, and long prior to the acts of Applicant alleged herein or Applicant’s claimed dates of first use and first use in commerce for the subject mark of January 10, 2008 and June 15, 2008, respectively, Opposer has used the mark JAKE & CO. in connection with clothing products, namely, various items of underwear.

3. Opposer owns the following marks that consist of or include the term JAKE (the “JAKE Marks”):

<u>MARK</u>	<u>REG. NO.</u>	<u>FILING DATE</u>	<u>GOODS</u>
JAKE & CO.	Reg. No. 1,687,935	December 6, 1990	men’s and boys’ boxer underwear shorts
JAKE	Reg. No. 3,534,666	February 8, 2007	undergarments, knit and thermal underwear, woven and knitted boxer shorts, undershirts, briefs

These registrations are valid, subsisting and owned by Opposer, and Registration Number 1,687,935 is incontestable.

4. Through long and substantial sales of its clothing products sold under the JAKE Marks, and since long prior to the filing of the application opposed herein or Applicant’s claimed dates of first use or first use in commerce of January 10, 2008 and June 15, 2008, respectively, Opposer’s JAKE Marks have become invaluable assets of Opposer.

5. On October 4, 2010, Applicant, Jake Joseph, filed Application Serial No. 85/144,266 to register the mark JAKE JOSEPH for “boxer briefs, boxer shorts; briefs; briefs; knitted underwear; ladies’ underwear; loungewear; sleepwear; trunks; underwear; women’s underwear; woven or knitted underwear;” in International Class 25, based on first use and first use of the mark in commerce since January 10, 2008 and June 15, 2008, respectively. This application was published for opposition in the March 22, 2011 Official Gazette and Opposer has obtained an extension of time up to and including September 18, 2011 to oppose said Application.

6. Applicant’s claimed dates of first use and first use in commerce of the mark JAKE JOSEPH in Application Serial No. 85/144,266 of January 10, 2008 and June 15, 2008,

respectively, are subsequent to both Opposer's filing dates in connection with its JAKE Marks and its date of first use of the mark JAKE & CO.

7. In view of the close similarities of the parties' respective marks and goods, Applicant's JAKE JOSEPH mark so resembles Opposer's JAKE Marks as to be likely to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Trademark Act.

8. For these reasons, Opposer would be damaged by the registration of Applicant's JAKE JOSEPH mark shown in Application Serial No. 85/144,266.

WHEREFORE, Opposer respectfully requests that Application Serial No. 85/144,266 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Pursuant to 37 C.F.R. § 2.101 Opposer has served a copy of the Notice of Opposition on the correspondent of record for Applicant identified on the USPTO's TARR database by first class mail on July 20, 2011. A copy of the certificate of service is attached.

The required fee of \$300 is enclosed. Please charge additional costs to our Deposit Account No. 19-0741.

Respectfully submitted,

FOLEY & LARDNER LLP

Dated: New York, New York
July 20, 2011


By: /Robert Weisbein/
Robert S. Weisbein
90 Park Avenue
New York, NY 10016
(212) 338-3528

*Attorneys for Opposer
Pico Manufacturing Sales Corporation*

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION was served by first-class mail this day of July 20, 2011 upon Applicant's correspondent of record, as follows:

JAKE JOSEPH
2902 Stonewall Ct.
Missouri City, Texas 77459



Tara Gangaram