

ESTTA Tracking number: **ESTTA426923**

Filing date: **08/24/2011**

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	Surf Line Hawaii, Ltd.
Granted to Date of previous extension	08/24/2011
Address	1451 Kalani Street Honolulu, HI 96817 UNITED STATES

Attorney information	Megan Gray Gray Matters 2017 Kalorama Road NW # 3 Washington, DC 20009 UNITED STATES mg@megangray.com Phone:202-265-2738
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Applicant Information

Application No	85181292	Publication date	04/26/2011
Opposition Filing Date	08/24/2011	Opposition Period Ends	08/24/2011
Applicant	Jimmy Jams LLC P.O. Box 1166 Stowe, VT 05672 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: After ski boots; Bath slippers; Bathing caps; Bathing suits; Beach cover-ups; Beach coverups; Beach footwear; Beach shoes; Boots; Bucket caps; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Children's headwear; Cloth bibs; Costumes for use in children's dress up play; Dressing gowns and bath robes; Hats; Hats for infants, babies, toddlers and children; Hiking boots; Infant and toddler one piece clothing; Infant cloth diapers; Pajamas; Rain boots; Rain hats; Robes; Sandals and beach shoes; Shirts for infants, babies, toddlers and children; Ski boots; Slipper socks; Slippers; Snow boarding suits; Snow boots; Snow pants; Snow suits; Sports caps and hats; Sweat suits; Swim suits; Wet suit gloves; Wet suits; Wraps
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Other	No bona fide intent to use
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	920266	Application Date	09/04/1970
Registration Date	09/14/1971	Foreign Priority Date	NONE
Word Mark	JAMS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1964/08/01 First Use In Commerce: 1965/01/12 MEN'S SWIMMING TRUNKS		

U.S. Registration No.	1497797	Application Date	06/21/1985
Registration Date	07/26/1988	Foreign Priority Date	NONE
Word Mark	JAMS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1964/08/01 First Use In Commerce: 1965/01/12 MEN'S, WOMEN'S AND CHILDREN'S PANTS, SHIRTS, WALKING SHORTS, SWIMMING TRUNKS, UNDERWEAR, HATS, BELTS AND SCARVES		

U.S. Registration No.	1537352	Application Date	12/07/1987
Registration Date	05/02/1989	Foreign Priority Date	NONE
Word Mark	JAMS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1987/04/00 First Use In Commerce: 1987/04/00 [WATCHES AND COSTUME JEWELRY, NAMELY, BROOCHES] Class 018. First use: First Use: 1986/10/00 First Use In Commerce: 1986/10/00 [SPORTS BAGS, NAMELY, BACK PACKS, HIP PACKS, HANDBAGS, WALLETS, KEY HOLDERS] Class 025. First use: First Use: 1964/08/01 First Use In Commerce: 1965/01/12 WEARING APPAREL, NAMELY, SHIRTS, SHORTS, [SPORTCOATS,] T-SHIRTS, SWEATSHIRTS, SWEATPANTS, JERSEYS, TANK TOPS, CAPS [, SHOES] Class 030. First use: First Use: 1987/01/00 First Use In Commerce: 1987/01/00 [CANDY AND CHEWING GUM]		

U.S. Registration No.	1766979	Application Date	08/15/1991
Registration Date	04/20/1993	Foreign Priority	NONE

		Date	
Word Mark	JAMS WORLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1991/09/01 First Use In Commerce: 1991/09/01 retail clothing store services		

U.S. Registration No.	1888564	Application Date	04/13/1994
Registration Date	04/11/1995	Foreign Priority Date	NONE
Word Mark	JAMS WORLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1987/03/00 First Use In Commerce: 1987/03/00 men's, women's and children's casual wear, namely pants, shirts, walking shorts, swimming shorts, sports shorts, running shorts, jackets, blazers, vests, shirts, sweatshirts, T-shirts, hats, ties, belts, dresses, blouses, slacks, pantsuits, jumpsuits, sports jackets, [warmup suits]and workout wear, namely running suits		

Attachments	Opposition.pdf (6 pages)(36706 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	/megan e. gray/
Name	Megan Gray
Date	08/24/2011

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

In the matter of application Serial No. 85181292
Filed November 19, 2010
For the mark JIMMY JAMS
Published in the Official Gazette on April 26, 2011

SURF LINE HAWAII, LTD.,

Opposer,

v.

JIMMY JAMS LLC,

Applicant

OPPOSITION NO. _____

NOTICE OF OPPOSITION

The above-identified Opposer believes it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

General Allegations

1. Opposer Surf Line Hawaii, Ltd. (“Surf Line”) has for many years continuously engaged in the manufacture and sale of clothing and other products, including t-shirts, swimming trunks, pants, shirts and shorts.
2. Surf Line manufactures and sells its products worldwide, and in the United States makes and sells clothing under the JAMS and JAMS WORLD marks.

3. Surf Line is the owner of the following trademark registrations on the principal register in the United States Patent and Trademark Office:

<u>Reg. #</u>	<u>Mark</u>	<u>Goods or Services</u>
0920266	JAMS	Men's swimming trunks – Int. Class 25
1497797	JAMS	Men's, women's and children's pants, shirts, walking shorts, swimming trunks, underwear, hats, belts and scarves – Int. Class 25
1537352	JAMS	Wearing apparel, namely shirts, shorts, t-shirts, sweatshirts, sweatpants, jerseys, tank tops, and caps – Int. Class 25
1766979	JAMS WORLD	Retail clothing store services – Int. Class 42; and
1888564	JAMS WORLD	Men's, women's and children's casual wear, namely, pants, shirts, walking shorts, swimming shorts, sport shorts, running shorts, jackets, blazers, vests, shirts, sweatshirts, t-shirts, hats, ties, belts, dresses, blouses, slacks, pantsuits, jumpsuits, sports jackets, and workout wear, namely, running suits – Int. Class 25

The aforesaid registrations are valid, subsisting, more than five years old, and have become incontestable under the provisions of Section 15 of the Trademark Act.

4. Surf Line opposes Applicant's intent-to-use application to register the mark JIMMY JAMS for "After ski boots; Bath slippers; Bathing caps; Bathing suits; Beach cover-ups; Beach coverups; Beach footwear; Beach shoes; Boots; Bucket caps; Children's and infant's apparel, namely, jumpers, overall sleepwear, pajamas, rompers and one-piece garments; Children's headwear; Cloth bibs; Costumes for use in children's dress up play; Dressing gowns and bath robes; Hats; Hats for infants, babies, toddlers and children; Hiking boots; Infant and toddler one piece clothing; Infant cloth diapers; Pajamas; Rain boots; Rain hats; Robes; Sandals and beach shoes; Shirts for infants, babies, toddlers and children; Ski boots; Slipper socks; Slippers; Snow boarding suits; Snow boots; Snow pants; Snow suits; Sports caps and hats; Sweat

suits; Swim suits; Wet suit gloves; Wet suits; Wraps.” The application for registration of the mark JIMMY JAMS was filed on November 19, 2010 by Jimmy Jams LLC, with an address of P.O. Box 1166 Stowe, Vermont 05672.

5. Wearing apparel or casual wear items such as, for example, t-shirts, swimming trunks, pants, shoes, shirts, walking shorts, underwear, hats, belts, scarves, sports coats, sweatshirts, sweatpants, jerseys and tank tops, are closely related goods that travel in the same and/or substantially similar channels of trade.

6. Opposer’s JAMS and JAMS WORLD clothing products are marketed to clothing retailers, and, the description of goods in Applicant’s application, if registered, would similarly cover products sold through the same channels of trade.

Opposer’s First Claim for Relief

7. Opposer repeats and realleges paragraphs 1 through 6 of this Notice of Opposition with the same force and effect as if each was set forth in full at this point.

8. On information and belief, the applied-for mark comprises a mark which so resembles Opposer’s JAMS and/or JAMS WORLD registered marks – at least one of which has been used in the United States since at least as early as 1965 and none of which have been abandoned – as to be likely, when used on or in connection with Applicant’s products, to cause confusion, to cause mistake or to deceive as to Applicant’s affiliation, connection, association or origin with, or sponsorship or approval by, Opposer.

9. Applicant's application should be rejected, and the registration of the mark sought therein for goods specified in International Class 25 be denied and refused in accordance with 15 U.S.C. § 1125(c).

Opposer's Second Claim for Relief

10. Opposer repeats and realleges paragraphs 1 through 6 of this Notice of Opposition with the same force and effect as if each was set forth in full at this point.

11. On information and belief, Applicant had no bona fide intent to use Applicant's mark in commerce or interstate commerce at the time of its filing of the application for its registration under Section 1(b) of the Act, 15 U.S.C. § 1051(a).

12. On information and belief, Applicant committed fraud in the registration process by falsely representing to the U.S. Trademark Office that Applicant had such bona fide intent at the time of filing the subject application.

13. Applicant's application should be rejected, and the registration of the mark sought therein for goods specified in International Class 25 be denied and refused.

Opposer's Third Claim for Relief

14. Opposer repeats and realleges paragraphs 1 through 6 of this Notice of Opposition with the same force and effect as if each was set forth in full at this point.

15. On information and belief, Applicant committed fraud in the registration process by falsely representing to the U.S. Trademark Office that "he/she believes applicant to be entitled to use such mark in commerce" and representing that Jimmy Jams LLC had a bona fide intent to use such mark, while knowing that there was no such corporate entity in existence at the time of filing the application for registration. On information and belief, Jimmy Jams LLC was registered as a limited liability company in the State of Vermont on November 22, 2010, whereas the trademark application was filed 3 days earlier, on November 19, 2010.

16. On information and belief, Applicant knew or should have known that its representations to the U.S. Trademark Office were false. The U.S. Trademark Office reasonably

relied on such material and false statements and was induced to approve Applicant's application for publication. If the registration of Applicant's Mark is granted, Opposer will be harmed as Applicant would receive at least a prima facie exclusive right to the use of Applicant's Mark.

17. Applicant's application should be rejected, and the registration of the mark sought therein for goods specified in International Class 25 be denied and refused.

WHEREFORE, Opposer requests that this Opposition be sustained and that the requested registration of the Applicant mark be refused.

Dated: Washington, DC
August 24, 2011

By _____/s/_____
Megan E. Gray

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Attorney for Opposer
Surf Line Hawaii, Ltd.

Certificate of Service

Surf Line Hawaii, Ltd. V. Jimmy Jams LLC

Opposition No.: _____

I hereby certify that the attached:

NOTICE OF OPPOSITION

was served on the following parties by the method indicated above each name on the below date.

<p><u>By First Class US Mail</u></p>
<p>Jimmy Jams LLC PO Box 1166 Stowe, Vermont 05672-1166</p>

Date: August 24, 2011

_____/s/_____
Megan E. Gray