

ESTTA Tracking number: **ESTTA566173**

Filing date: **10/21/2013**

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	Genesco Brands, Inc.
Granted to Date of previous extension	10/20/2013
Address	300 Delaware Avenue, 9th Floor Wilmington, DE 19801 UNITED STATES

Attorney information	Nichole Davis Chollet Kilpatrick Townsend & Stockton LLP 1100 Peachtree Street, Ste 2800 Atlanta, GA 30309-4528 UNITED STATES tlord@kilpatricktownsend.com, tadmin@ktslaw.com, jshanks@ktslaw.com, tibrown@ktslaw.com, nchollet@ktslaw.com, lcrumbley@ktslaw.com Phone:404-815-6500
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**Applicant Information**

Application No	85689164	Publication date	04/23/2013
Opposition Filing Date	10/21/2013	Opposition Period Ends	10/20/2013
Applicant	Elia Wise 96 Suffield Ave. San Anselmo, CA 94960 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, shirts, t-shirts, sweatshirts, Halloween costumes, and hooded sweatshirts
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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.	1475093	Application Date	06/15/1987
Registration Date	02/02/1988	Foreign Priority Date	NONE
Word Mark	JOURNEYS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1987/02/09 First Use In Commerce: 1987/02/09 SHOES

U.S. Registration No.	1458854	Application Date	02/17/1987
Registration Date	09/22/1987	Foreign Priority Date	NONE
Word Mark	JOURNEYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1986/12/17 First Use In Commerce: 1986/12/17 RETAIL SHOE STORE SERVICES		

U.S. Registration No.	3099876	Application Date	08/11/2005
Registration Date	06/06/2006	Foreign Priority Date	NONE
Word Mark	JOURNEYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 1987/02/09 First Use In Commerce: 1987/02/09 footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts</p> <p>Class 035. First use: First Use: 1987/02/09 First Use In Commerce: 1987/02/09 retail store services in the fields of footwear, apparel, luggage, handbags, sports bags, backpacks, jewelry and fashion accessories</p>		

U.S. Registration No.	2501052	Application Date	04/04/2000
Registration Date	10/23/2001	Foreign Priority Date	NONE
Word Mark	JOURNEYS ZAPCARD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2001/06/21 First Use In Commerce: 2001/06/21 Providing prepaid payment cards redeemable for purchases in applicant's retail stores		

U.S. Registration No.	2620681	Application Date	06/13/2001
Registration Date	09/17/2002	Foreign Priority Date	NONE
Word Mark	JOURNEYS ZAP CARD		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2000/11/00 First Use In Commerce: 2000/11/00 financial services in connection with the issuance of stored value cards

U.S. Registration No.	1558147	Application Date	01/23/1989
Registration Date	09/26/1989	Foreign Priority Date	NONE
Word Mark	JOURNEYS AN ATTITUDE YOU CAN WEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1988/07/15 First Use In Commerce: 1988/07/15 SHOES Class 042. First use: First Use: 1988/07/15 First Use In Commerce: 1988/07/15 RETAIL SHOE STORE SERVICES		

U.S. Registration No.	2957414	Application Date	12/06/2000
Registration Date	05/31/2005	Foreign Priority Date	NONE
Word Mark	JOURNEYS KIDZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts Class 035. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories		

U.S. Registration No.	2952068	Application Date	12/06/2000
Registration Date	05/17/2005	Foreign Priority Date	NONE
Word Mark	JOURNEYS KIDZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts Class 035. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00 Retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories		

U.S. Registration No.	3406723	Application Date	06/16/2005
Registration Date	04/01/2008	Foreign Priority Date	NONE
Word Mark	SHI BY JOURNEYS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2007/05/08 First Use In Commerce: 2007/05/08 FOOTWEAR AND APPAREL, NAMELY, SHOES, BOOTS, HOSIERY, COATS, SCARVES Class 035. First use: First Use: 2005/11/22 First Use In Commerce: 2005/11/22 RETAIL STORE SERVICES IN THE FILEDS OF FOOTWEAR, APPAREL, HANDBAGS, JEWELRY AND FASHION ACCESSORIES		

Attachments	Wise_Notice of Opp.pdf(240666 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	/Nichole Davis Chollet/
Name	Nichole Davis Chollet
Date	10/21/2013

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

GENESCO BRANDS INC. )  
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 )  
 Opposer, )  
 ) Serial No.: 85/689,164  
 v. ) Opposition No. \_\_\_\_\_  
 )  
 ELIA WISE, )  
 )  
 )  
 Applicant. )



**NOTICE OF OPPOSITION**

Opposer Genesco Brands Inc. will be damaged by registration in International Class 25 of the mark JOURNEY TO THE HEART OF THE MATTER underlying application Serial No. 85/689,164 and states the following grounds under 15 U.S.C. § 1063 and 37 C.F.R. §§ 2.101 and 2.104 for its opposition to that application:

1. Opposer Genesco Brands, Inc. is the owner and licensor of the trademark JOURNEYS, alone and in conjunction with other words and designs, used in connection with a well-known chain of over seven hundred JOURNEYS and JOURNEYS KIDZ retail stores located in major shopping malls throughout the United States, which are owned and operated by Opposer Genesco Brands, Inc.'s predecessor and exclusive licensee, Genesco Inc. (Opposer Genesco Brand Inc. and Genesco Inc. are collectively referred to as "Genesco"). The stores operating under the JOURNEYS trademarks sell a wide range of footwear, clothing, fashion accessories, novelties, bags, backpacks, and other goods in connection with the JOURNEYS marks.

2. Genesco has validly and continuously used the JOURNEYS mark and other marks incorporating the element JOURNEYS in connection with a variety of goods and services since at least as early as December 17, 1986.

3. Genesco owns the following federal registrations for marks comprised of or incorporating the JOURNEYS mark (collectively the “JOURNEYS Marks”), including numerous design marks:

Name of Mark	Registration No.	Goods/Services	First Use Date
JOURNEYS*	1,475,093	“shoes” in International Class 025.	02/09/87
JOURNEYS*	1,458,854	“retail shoe store services” in International Class 042.	12/17/86
JOURNEYS and Design* 	3,099,876	“footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts” in International Class 025;  ”retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories” in International Class 035.	02/9/1987
JOURNEYS ZAPCARD and Design* 	2,501,052	“providing prepaid payment cards redeemable for purchases in Applicant’s retail stores” in International Class 036.	06/21/01
JOURNEYS ZAP CARD*	2,620,681	“financial services in connection with the issuance of stored value cards” in International Class 036.	11/00/00
JOURNEYS AN ATTITUDE YOU CAN	1,558,147	“shoes” in International	07/15/88

WEAR*		Class 025; and “retail shoe store services” in International Class 042.	
JOURNEYS KIDZ and Design*	2,957,414	“footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts” in International Class 025;  ”retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories” in International Class 035.	08/00/00
JOURNEYS KIDZ*	2,952,068	“footwear and apparel, namely, shoes, boots, hats, caps, hosiery, shirts, sweatshirts, sweatpants, coats, jackets, t-shirts, gloves, scarves, shorts, underwear, pants, and skirts” in International Class 025;  ”retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories” in International Class 035.	08/00/00
SHI BY JOURNEYS	3,406,723	“footwear and apparel, namely, shoes, boots, hosiery, coats, scarves” in International Class 025;  “retail stores services in the fields of footwear, apparel, handbags, jewelry and fashion accessories” in International Class 035.	11/22/05

The above-listed registrations of the JOURNEYS mark are valid and subsisting, and affidavits have been filed and accepted pursuant to Sections 8 and 15 of the Lanham Act for the eight (8) registrations listed above that are marked with an asterisk (Reg. Nos. 1,475,093,

1,458,854, 3,099,876, 2,501,052, 2,620,681, 1,558,147, 2,957,414 and 2,952,068), rendering such registrations incontestable.

4. By virtue of continuous and extensive sales and advertising of the JOURNEYS Marks in connection with Genesco's retail stores and the products sold therein, and the extensive sales of such goods for over 20 years, Genesco's JOURNEYS Marks are widely and favorably known by the public throughout the United States.

5. Genesco has expended large amounts of money, time, and effort in advertising and promoting its goods and services under the JOURNEYS Marks. By reason of Genesco's extensive use and advertising of the JOURNEYS Marks and resulting favorable public recognition, Genesco's JOURNEYS Marks uniquely identify Genesco and its products and services to the public. As such, Genesco has established extensive common-law rights in the JOURNEYS Marks in connection with footwear, clothing and other goods, as well as for retail store services.

6. Applicant Elia Wise ("Applicant") filed intent-to-use application Serial No. 85/689,164 on July 27, 2012 to register the mark JOURNEY TO THE HEART OF THE MATTER ("Applicant's Mark"). Applicant's Mark, which was published for opposition in the Official Gazette of April 23, 2013, is proposed to be used with "*clothing, namely, shirts, t-shirts, sweatshirts, Halloween costumes, and hooded sweatshirts*" in International Class 25.

7. Genesco continuously has used its JOURNEYS Marks since long prior to Applicant's filing date and date of first use, actual or constructive.

8. Applicant's Mark is closely similar in sight, sound and commercial impression to Genesco's JOURNEYS Marks.

9. Applicant's Mark is proposed to be used with goods in International Class 25 that are identical or closely related to the goods and services Genesco offers with its JOURNEYS Marks.

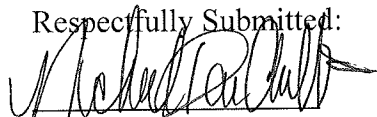
10. Genesco will be damaged by the registration of Applicant's Mark because the mark so resembles Genesco's JOURNEYS Marks as to be likely to cause confusion, mistake, and/or deception. Consumers familiar with Genesco's JOURNEYS Marks would be likely, erroneously, to believe the goods in International Class 25 of Applicant's application are products of Genesco or are endorsed, sponsored, or licensed by Genesco. Thus, registration of Applicant's Mark with respect to International Class 25 on the Principal Register would be inconsistent with Genesco's rights in its JOURNEYS Marks.

11. The required opposition fee is being electronically processed in connection with this Notice of Opposition. The Director is authorized to debit KILPATRICK TOWNSEND & STOCKTON LLP's Trademark Deposit Account No. 20-1430 for any deficiency in the required fee.

Opposer Genesco Brands, Inc. therefore requests that application Serial No. 85/689,164 be refused registration.

Date: October 21, 2013

Respectfully Submitted:



Tywanda H. Lord  
Nichole Davis Chollet  
Jaclyn T. Shanks

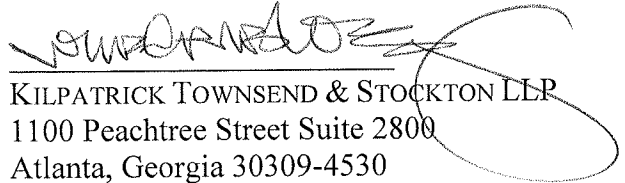
KILPATRICK TOWNSEND &  
STOCKTON LLP  
1100 Peachtree Street, Suite 2800  
Atlanta, GA 30309-4530  
(404) 815-6500

*Attorneys for Opposer*

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being filed electronically through the U.S. Patent and Trademark Office's ESTTA system on October 21, 2013.

BY:

  
KILPATRICK TOWNSEND & STOCKTON LLP  
1100 Peachtree Street Suite 2800  
Atlanta, Georgia 30309-4530  
(404) 815-6500

