

ESTTA Tracking number: **ESTTA620468**

Filing date: **08/08/2014**

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 | Converse Inc. |
| Granted to Date of previous extension | 08/10/2014 |
| Address | One High Street North Andover, MA 01845 UNITED STATES |
| Attorney information | B. Anna McCoy Alleman Hall McCoy Russell & Tuttle LLP 806 SW Broadway Suite 600 Portland, OR 97205 UNITED STATES mccoy@ahmrt.com, mercer@ahmrt.com, hill@ahmrt.com, docketing@ahmrt.com Phone:5034594141 |

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 86043385 | Publication date | 02/11/2014 |
| Opposition Filing Date | 08/08/2014 | Opposition Period Ends | 08/10/2014 |
| Applicant | CON SURFBOARD HOLDINGS, INC. 2751 ROOSEVELT ROAD SAN DIEGO, CA 92106 UNITED STATES | | |

Goods/Services Affected by Opposition

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| <p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: eyewear, namely, sunglasses and goggles for sports; computer carrying cases; pre-recorded video tapes, DVD's, and digital multimedia files featuring surfing and other sports; eyeglasses; accessories for eyeglasses, namely, eyeglass cases, eyeglass rims and frames, replacement parts for eyeglasses, eyeglass chains and cords; sunglasses; accessories for sunglasses, namely, sunglass rims and frames, sunglass cases, sunglass chains and cords</p> |
| <p>Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: books featuring the subjects of sports, fashion, and entertainment, book covers, and calendars</p> |
| <p>Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: leather and imitations of leather, and goods made of leather and imitation leather, namely, shoulder straps and luggage labels; bags, namely, leather and imitation leather bags, sports bags, gym bags, athletics bags, beach bags, all-purpose carrying bags, handbags, school bags, carry-on bags, clutch bags, drawstring bags, duffel bags, tote bags, roll bags, shoulder bags, overnight bags, garment bags for travel, shaving bags sold empty, toiletry bags sold empty, travel bags, sling bags, hiking bags, kit bags, messenger bags, knit-</p> |

ted bags, not of precious metal, belt bags, waist bags, hip bags, bum bags, diaper bags, bags for carrying babies' accessories, bags sold empty for attachment to backpacks, souvenir bags, wheeled bags, and wristlet bags; backpacks, rucksacks; trunks; pouches, namely, drawstring pouches, leather pouches, imitation leather pouches, cloth pouches, textile pouches, felt pouches, jewelry pouches, pouches sold empty for attachment to backpacks, pouches for holding keys, makeup and other personal items, and wearable strap-on pouches, and key cases; purses, wallets, key cases; cosmetic bags, purses and cases, all sold empty; umbrellas, parasols and walking sticks; replacement parts for all of the foregoing; accessories for bags, backpacks, rucksacks, umbrellas and parasols, namely, waterproof covers; accessories for luggage, namely, straps and tags

Class 025. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: footwear; headwear; hats; wetsuits; swimwear; board shorts; sweatshirts; hooded shirts; jackets; coats; shorts; walk shorts; long pants; jeans; denims; rash guards; loungewear; braces/suspenders and gaiters; briefs; belts; socks; gloves; surfboard boots; sandals; thong footwear; surf hoods; boots for sports; surf wear

Class 028. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: surfboards and other water sports apparatus, namely, body boards, paddleboards, wake boards, kite boards, water skis, skim boards and sailboard; bags especially designed for surfboards and other water sports apparatus; surfboard storage racks and surfboard display racks, deck grips for sports equipment boards, namely, surfboards and paddle surfboards; paddle surfboards; swimming flippers and body boarding flippers; gloves for watersports, namely, surfing gloves, bodyboarding gloves, and paddling gloves; accessories for surfboards and other water sports apparatus, namely, leashes for surfboards, leashes for fins, paddles for use with surfboards, surfboard traction pads, fins for body boards, surfboard wax, paddle board wax and skim board wax

Grounds for Opposition

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|--------------------------------------|---------------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |
| Other | Common-law basis for opposition |

Marks Cited by Opposer as Basis for Opposition

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 868375 | Application Date | 01/05/1968 |
| Registration Date | 04/22/1969 | Foreign Priority Date | NONE |
| Word Mark | CONVERSE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class U022 (International Class 016, 018, 020, 022, 025, 028). First use: First Use: 1965/10/00 First Use In Commerce: 1965/10/00 GAMES, TOYS, AND SPORTING GOODS-NAMELY, [GOLF SHOES,] TRACK SHOES, WRESTLING SHOES [, BASEBALL SHOES, FOOTBALL SHOES, AIR FLOATS AND AIR MATTRESSES]</p> <p>Class U039 (International Class 010, 025, 026). First use: First Use: 1916/10/00 First Use In Commerce: 1916/10/00 CLOTHING-NAMELY, [HUNTING BOOTS, FISHING BOOTS,] INDUSTRIAL BOOTS, RUBBER BOOTS, TENNIS SHOES, BASKET BALL SHOES, BOAT SHOES, GENERAL PURPOSE ATHLETIC SNEAKERS, CASUAL SHOES, JACKETS, TROUSERS, PARKAS, SHIRTS, OVERALLS, RAINCOATS AND SUSPENDERS</p> | | |

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|-------------------|---------|------------------|------------|
| U.S. Registration | 1868363 | Application Date | 12/21/1992 |
|-------------------|---------|------------------|------------|

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|---------------------|---|-----------------------|------|
| No. | | | |
| Registration Date | 12/20/1994 | Foreign Priority Date | NONE |
| Word Mark | CONVERSE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1984/01/00 First Use In Commerce: 1984/01/00 clothing; namely, knit T-shirts, collarplacket shirts, woven shirts, swimwear, knit and woven shorts, knit and woven pants, tank tops, fleece tops and bottoms, wind resistant suits and jackets, sports caps and knit caps | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 2466322 | Application Date | 03/17/1999 |
| Registration Date | 07/03/2001 | Foreign Priority Date | NONE |
| Word Mark | CONVERSE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 016. First use: First Use: 1999/06/30 First Use In Commerce: 1999/06/30 [EXERCISE BOOKS,] WIREBOUND BOOKS, WIREBOUND HARDBACK BOOKS, BALLPOINT PENS[, CARTRIDGE PENS, ELASTICATED BINDERS, ERASERS, FILLED PENCIL CASES, PENCILS, PENCIL PACKS, AND PENCIL SETS] Class 018. First use: First Use: 1999/06/30 First Use In Commerce: 1999/06/30 BOOK BAGS, BRIEFCASES-STYLE PORTFOLIOS | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2810717 | Application Date | 03/18/2003 |
| Registration Date | 02/03/2004 | Foreign Priority Date | NONE |
| Word Mark | CONVERSE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1978/00/00 First Use In Commerce: 1978/00/00 socks | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2869353 | Application Date | 03/04/2003 |
| Registration Date | 08/03/2004 | Foreign Priority Date | NONE |
| Word Mark | CONVERSE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 1989/01/00 First Use In Commerce: 1989/01/00 Eyeglasses, sunglasses, all purpose sports goggles, optical frames and accessories therefor | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2872822 | Application Date | 03/18/2003 |
| Registration Date | 08/10/2004 | Foreign Priority Date | NONE |
| Word Mark | CONVERSE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 018. First use: First Use: 2004/04/21 First Use In Commerce: 2004/04/21 sports bags | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3175430 | Application Date | 05/23/2005 |
| Registration Date | 11/21/2006 | Foreign Priority Date | NONE |
| Word Mark | CONVERSE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 035. First use: First Use: 2005/06/15 First Use In Commerce: 2005/06/15 retail store services featuring footwear, clothing, sports bags and book bags | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 3431967 | Application Date | 11/14/2006 |
| Registration Date | 05/20/2008 | Foreign Priority Date | NONE |
| Word Mark | CONVERSE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 2007/06/30 First Use In Commerce: 2007/06/30 Headbands; Wristbands | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1493265 | Application Date | 11/02/1987 |
| Registration Date | 06/21/1988 | Foreign Priority Date | NONE |
| Word Mark | CONS | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 025. First use: First Use: 1986/11/12 First Use In Commerce: 1986/11/12 FOOTWEAR | | |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 1790496 | Application Date | 12/21/1992 |
| Registration Date | 08/31/1993 | Foreign Priority Date | NONE |
| Word Mark | CONS | | |

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|---------------------|--|
| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 1991/06/00 First Use In Commerce: 1991/06/00 clothing; namely, knit T-shirts, [collar placket shirts,]woven shirts, [swimwear, knit and woven shorts,]knit and woven pants, [tank tops, fleece tops and bottoms, wind suits, wind resistant jackets,]sports caps and knit caps, and spandex exercise wear; namely, T-shirts, [sweat shorts,]sweat pants, shorts, and tank tops |

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|-------------|--|
| Attachments | 75662558#TMSN.png(bytes) 78635149#TMSN.png(bytes) 77043833#TMSN.png(bytes) Notice of opposition (App. No. 86043385).pdf(52793 bytes) |
|-------------|--|

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 | /B. Anna McCoy/ |
| Name | B. Anna McCoy |
| Date | 08/08/2014 |

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

| | | |
|------------------------------|---|------------------------|
| Converse Inc., |) | |
| |) | |
| Opposer, |) | Serial No.: 86/043,385 |
| |) | |
| v. |) | Opposition No. _____ |
| |) | |
| CON Surfboard Holdings, Inc. |) | |
| |) | |
| Applicant. |) | |
| _____ |) | |

Commissioner for Trademarks
Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

In the matter of the application of CON Surfboard Holdings, Inc. (“Applicant”), for registration of the mark  (“Stylized CON”), application Serial No. 86/043,385, published in the Official Gazette on February 11, 2014, Converse Inc. (“Opposer”), a corporation organized under the laws of Delaware, with its principal place of business at One High Street, North Andover, Massachusetts 01845-2601, believes that it will be damaged by registration of the mark shown in Serial No. 86/043,385 and hereby opposes registration.

An initial ninety-day extension of time was timely filed on March 5, 2014, extending the deadline to file the notice of opposition to June 11, 2014. With the express consent of the Applicant, a further sixty-day extension of time was timely filed on June 11, 2014, extending the deadline to file the notice of opposition to August 10, 2014.

The grounds for opposition are as follows:

1. Opposer is a corporation, doing business as Converse Inc., organized under the laws of Delaware, with its principal place of business at One High Street, North Andover, Massachusetts 01845-2601.

2. Opposer has been and continues to be engaged in the business of designing, marketing and selling footwear, athletic shoes, sneakers, clothing, eyewear and sunglasses, accessories, and other goods and related services in the United States and abroad.

3. Since at least 1916, Opposer has used at various times in interstate commerce marks consisting solely, or in part, of the word CONVERSE. Opposer owns and uses a number of marks consisting solely, or in part, of the word CONVERSE (“Converse Marks”) to identify footwear, athletic shoes, sneakers, clothing, eyewear and sunglasses, headgear, accessories, wirebound books, bags and sports bags, and other related goods and services originating from the Opposer in commerce.

4. Opposer is the owner of the following United States trademark registrations for its Converse Marks. An example list of registrations is below.

| Registration Number | Registration Date | International Class |
|---------------------|-------------------|---------------------|
| 868,375 | April 22, 1969 | 25 |
| 1,868,363 | Dec. 20, 1994 | 25 |
| 2,466,322 | July 3, 2001 | 16, 18 |
| 2,810,717 | Feb. 3, 2004 | 25 |
| 2,869,353 | Aug. 3, 2004 | 9 |
| 2,872,822 | Aug. 10, 2004 | 18 |
| 3,175,430 | Nov. 21, 2006 | 35 |
| 3,431,967 | May 20, 2008 | 25 |

5. Since at least 1986, Opposer has used at various times in interstate commerce marks consisting solely, or in part, of the words CONS. Opposer owns and uses a number of marks consisting solely, or in part, of the word CONS (“CONS Marks”) to identify footwear, clothing, headgear, and other related goods and services originating from the Opposer in commerce.

6. Opposer is the owner of the following United States trademark registrations for its CONS Marks:

| Registration Number | Registration Date | International Class |
|---------------------|-------------------|---------------------|
| 1,493,265 | June 21, 1988 | 25 |
| 1,790,496 | Aug. 31, 1993 | 25 |

7. Opposer also has common law rights in the Converse Marks and CONS Marks for use in connection with footwear, clothing and related accessories.

8. Opposer has used and continues to use the Converse Marks and CONS Marks and the goods in connection therewith have been popular and the subject of significant advertising and promotional activities.

9. The use of Opposer's Converse Marks and CONS Marks has been valid and continuous since the dates of first use, and Opposer has not abandoned the Converse Marks or CONS Marks. Opposer's Converse Marks and CONS Marks are symbolic of extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion. Opposer's Converse Marks and CONS Marks identify and distinguish Opposer's goods from the goods of others and identify the source and origin thereof to both the trade and the public.

10. Opposer's Converse Marks are famous as that term is defined under 15 U.S.C. §1125.

11. Notwithstanding Opposer's rights in and to its Converse Marks and CONS Marks, Applicant, on August 20, 2013, filed an intent-to-use application for registration of the Stylized CON mark. Applicant's application was given Serial No. 86/043,385 and was published for opposition in the Official Gazette on February 11, 2014.

12. The published intent-to-use application for the Stylized CON mark includes the following goods:

Eyewear, namely sunglasses and goggles; computer carrying cases; pre-recorded video tapes, DVD's, Blu-ray disks, and digital files featuring surf and other sports; eyeglasses; accessories for eyeglasses, namely, eyeglass cases, eyeglass rims and frames, replacement parts for eyeglasses, eyeglass chains and chords; sunglasses; accessories for sunglasses, namely, sunglass rims and frames, sunglass cases, sunglass chains and chords in International Class 9.

Books featuring the subjects of sports, fashion, and entertainment, book covers, and calendars in International Class 16.

Leather and imitations of leather, and goods made of leather and imitation leather, namely, shoulder straps and luggage labels; bags, namely, leather and imitation leather bags, sports bags, gym bags, athletics bags, beach bags, all-purpose carrying bags, handbags, school bags, carry-on bags, clutch bags, drawstring bags, duffel bags, tote bags, roll bags, shoulder bags, overnight bags, garment bags for travel, shaving bags sold empty, toiletry bags sold empty, travel bags, sling bags, hiking bags, kit bags, messenger bags, knitted bags, not of precious metal, belt bags, waist bags, hip bags, bum bags, diaper bags, bags for carrying babies' accessories, bags sold empty for attachment to backpacks, souvenir bags, wheeled bags, and wristlet bags; backpacks, rucksacks; trunks; pouches, namely, drawstring pouches, leather pouches, imitation leather pouches, cloth pouches, textile pouches, felt pouches, jewelry pouches, pouches sold empty for attachment to backpacks, pouches for holding keys, makeup and other personal items, and wearable strap-on pouches, and key cases; purses, wallets, key cases; cosmetics bags, purses and cases, all sold empty; umbrellas, parasols and walking sticks; replacement parts for all of the foregoing; accessories for bags, backpacks, rucksacks, umbrellas and parasols, namely, waterproof covers; accessories for luggage, namely, straps and tags in International Class 18.

Footwear; headwear; hats; wetsuits; swimwear; board shorts; sweatshirts; hooded shirts; jackets; coats; shorts; walk shorts; long pants; jeans; denims; rash guards; loungewear; braces/suspenders and gaiters; briefs; belts; socks; gloves; surfboard boots; sandals; thong footwear; surf hoods; boots for sports; surf wear in International Class 25.

Surfboards and other water sports apparatus, namely body boards, paddleboards, wake boards, kite boards, water skis, skim boards and sail-board; bags especially designed for surfboards and other water sports apparatus; surfboard racks, deck grips for sports equipment boards, namely, surfboards and paddle surfboards; paddle surfboards; swimming flippers and body boarding flippers; gloves for watersports, namely surfing gloves, bodyboarding gloves, and paddling gloves; accessories for surfboards and other water sports apparatus, namely, leashes for surfboards, leashes for fins, paddles for use with surfboards, surfboard traction pads, fins for body boards, surfboard wax, paddle board wax, skim board wax, wax combs for surfboards, wax combs for bodyboards in International Class 28.

13. Applicant's Stylized CON mark has the literal element CON and is described as a stylized showing of the term CON.

14. Applicant does not claim a date of first use, and no statement of use has been filed with the United States Patent and Trademark Office.

15. Opposer's first use of the Converse Marks and CONS Marks is earlier than Applicant's first use, as no first use has been alleged by Applicant.

16. Applicant's filing date is subsequent to Opposer's filing date for each of the Converse Marks and CONS Marks.

17. Applicant's recited goods are closely related to the goods offered by Opposer for the Converse Marks and CONS Marks and consumers likely will be confused as to source of the goods.

18. Applicant's Stylized CON mark, when used in connection with the goods set forth in its application, is confusingly similar to Opposer's use of its Converse Marks and CONS Marks. If Applicant registers and uses its mark for its goods in the U.S. it is likely to cause confusion, mistake, and deception among consumers. Registration of Applicant's mark may damage the goodwill and consumer recognition that Opposer has built up in its Converse Marks and CONS Marks.

19. Applicant's mark dilutes, is likely to dilute, or will dilute Opposer's distinctive and famous Converse Marks in violation of Section 43(c) of the Act.

20. Commercial use of the Applicant's mark will cause or is likely to cause dilution of the distinctive quality of Opposer's famous Converse Marks, as that term is defined in 15 U.S.C. §1125.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's mark, and prays that registration be denied.

Opposer authorizes the Commissioner for Trademarks to charge the fee for filing this Notice of Opposition, or any other additional fees that may be due, to Deposit Account 504816.

DATED this 8th Day of August, 2014.

Respectfully submitted,

Alleman Hall McCoy Russell & Tuttle LLP

A handwritten signature in cursive script, appearing to read "B. Anna McCoy".

B. Anna McCoy
Oregon Bar Member
Attorney for Opposer
806 S.W. Broadway, Suite 600
Portland, Oregon 97204
Telephone: (503) 459-4141
Facsimile: (503) 459-4142

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served by First Class Mail upon CON Surfboard Holdings, Inc. at the address of record below on this 8th day of August, 2014:

Julian McMillan
McMillan Law Group
2751 Roosevelt Road Suite 204
San Diego, CA 92106

A handwritten signature in cursive script, appearing to read "B. Anna McCoy".

B. Anna McCoy
Attorney for Opposer