

ESTTA Tracking number: **ESTTA668163**

Filing date: **04/22/2015**

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	L.A. Gear, Inc.
Granted to Date of previous extension	07/08/2015
Address	844 Moraga Drive Los Angeles, CA 90024 UNITED STATES
Attorney information	Matthew H. Swyers, Esq. The Trademark Company, PLLC 344 Maple Avenue West, Suite 151 Vienna, VA 22180 UNITED STATES mswyers@thetrademarkcompany.com Phone:18009068626100

**Applicant Information**

Application No	86380134	Publication date	03/10/2015
Opposition Filing Date	04/22/2015	Opposition Period Ends	07/08/2015
Applicant	Black Biscuit 2B New York, NY 10018 UNITED STATES		

**Goods/Services Affected by Opposition**


Class 025. First Use: 2013/01/15 First Use In Commerce: 2013/01/15 All goods and services in the class are opposed, namely: Apparel, namely, pants, tee shirts, hats, jerseys, socks
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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.	1792665	Application Date	10/05/1990
Registration Date	09/14/1993	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1990/04/05 First Use In Commerce: 1990/04/05 footwear


U.S. Registration No.	1768103	Application Date	10/10/1990
Registration Date	04/27/1993	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1991/02/22 First Use In Commerce: 1991/02/22 apparel; namely, pants, dresses, shorts, skirts, shirts, blouses, jackets, socks, hats, leotards and tights		


U.S. Registration No.	3844628	Application Date	02/01/2010
Registration Date	09/07/2010	Foreign Priority Date	NONE
Word Mark	LA		

Design Mark	
Description of Mark	The mark consists of "L" with a stylized "A".
Goods/Services	Class 025. First use: First Use: 1992/02/03 First Use In Commerce: 1992/02/03 Footwear

U.S. Registration No.	2160298	Application Date	03/31/1997
Registration Date	05/26/1998	Foreign Priority Date	NONE

Word Mark	LA
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Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1997/02/00 First Use In Commerce: 1997/02/00 footwear[ and apparel products for men,women and children] , namely, shoes [

	,boots, pants, shorts, shirts, blouses, skirts, jackets, overalls, warm-up suits, sweatshirts, socks, hats, leotards, and tights ]		
U.S. Registration No.	1815958	Application Date	04/30/1992
Registration Date	01/11/1994	Foreign Priority Date	NONE
Word Mark	LA GEAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1992/02/03 First Use In Commerce: 1992/02/03 footwear and apparel products for men, women and children; namely, shoes, pants, shorts, shirts, blouses, jackets, overalls, warm-up suits, socks, hats, leotards and tights		

Attachments	74103578#TMSN.png( bytes ) 74104716#TMSN.png( bytes ) 77925036#TMSN.png( bytes ) 75266551#TMSN.png( bytes ) 74270774#TMSN.png( bytes ) Notice of Opposition 42215.pdf(219387 bytes ) Exhibits 1-5.pdf(147795 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	/Matthew H. Swyers/
Name	Matthew H. Swyers, Esq.
Date	04/22/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**The Trademark Trial and Appeal Board**


In the Matter of Serial No. 86/380,134;

For the trademark		
L.A. GEAR, INC.,	:	
	:	
Opposer,	:	
	:	
vs.	:	Opposition No. _____
	:	
Black Biscuit,	:	
	:	
Applicant.	:	

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**NOTICE OF OPPOSITION**

COMES NOW L.A. Gear, Inc., a California Corporation, with a principal place of business located at 844 Moraga Drive Los Angeles, California 90049 (hereinafter, "Opposer"), by counsel, The Trademark Company, PLLC and states that it believes it will be damaged by the registration of the

trademark  as more fully set forth in Federal Trademark Application Serial No. 86/380,134 as filed for by Black Biscuit, a partnership legally organized under the laws of Minnesota, having as partners Mr. Jon Paskoff, a U.S. Citizen, and Mr. Paul Hughes, a U.S. Citizen, having an address of 372 Fifth Avenue #2B, New York, New York 10018 (hereinafter "Applicant") and, accordingly, opposes the granting of said registration.

As grounds for this opposition, it is alleged that:

1. For many years, L.A. Gear, Inc. (referred to as "Opposer") has been and now is engaged in the development and production of footwear and apparel products for men, women and children; namely shoes, pants, shorts, shirts, dresses, skirts, blouses, jackets, overalls, warm-up suits, socks, hats, leotards, tights, legwarmers, caps, visors, and headbands; eyewear, namely eyeglasses, sunglasses, and

reading glasses; bags; namely gym bags, backpacks, duffle bags, tote bags, and overnight bags; stationary portfolios, notebooks, memo pads, writing pads, and stationery.

2. From a time long prior to the date of filing of Applicant's Application, Opposer has used its L.A. GEAR and related marks in commerce in the United States on and in connection with Opposer's Goods and Services, for which the L.A. GEAR and related marks have become famous. Moreover, Opposer's L.A. GEAR and related marks maintain a valuable reputation by virtue of the excellence of the goods and services sold under the same.

3. Opposer has spent large sums of money and expended tremendous effort in promoting goods and services under its L.A. GEAR and related marks which have become famous and associated exclusively with Opposer and its goods and services. The goodwill of the business connected with the use of, and symbolized by, the L.A. GEAR marks and is an asset of incalculable value.

4. Specifically, Opposer is the owner of the United States Patent and Trademark Registration No. 1,815,958, which was filed on April 30, 1992 for the mark LA GEAR and Design:



(hereinafter "Opposer's Mark") for the following goods: "footwear and apparel products for men, women and children; namely, shoes, pants, shorts, shirts, blouses, jackets, overalls, warm-up suits, socks, hats, leotards and tights" in International Class 25 (hereinafter "Opposer's Goods"). The registration maintains a date of first use of at least as early as February 3, 1992. *See* Exhibit No. 1.

5. Opposer is the owner of the United States Patent and Trademark Registration No.




2,160,298 which was filed on March 31, 1997 for the mark LA and Design:


(collectively, with the mark above hereinafter referred to as "Opposer's Marks") for the following goods: "footwear; namely, shoes" in International Class 25 (collectively, with the goods above hereinafter

referred to as “Opposer’s Goods”). The registration maintains a date of first use of at least as early as February 1997. *See* Exhibit No. 2.

6. Opposer is the owner of the United States Patent and Trademark Registration No.

3,844,628 which was filed on February 1, 2010 for the mark LA and Design:  (collectively, with the marks above hereinafter referred to as “Opposer’s Marks”) for the following goods: “Footwear” in International Class 25 (collectively, with the goods above hereinafter referred to as “Opposer’s Goods”). The registration maintains a date of first use of at least as early as February 3, 1992. *See* Exhibit No. 3.

7. Opposer is the owner of the United States Patent and Trademark Registration No.

1,768,103 which was filed on October 10, 1990 for the Design Mark  (collectively, with the mark above hereinafter referred to as “Opposer’s Marks”) for the following goods: “apparel; namely, pants, dresses, shorts, skirts, shirts, blouses, jackets, socks, hats, leotards and tights,” in International Class 25 (collectively, with the goods above hereinafter referred to as “Opposer’s Goods”). The registration maintains a date of first use of at least as early as February 22, 1991. *See* Exhibit No. 4.

8. Opposer is the owner of the United States Patent and Trademark Registration No.

1,792,665 which was filed on October 5, 1990 for the Design Mark (collectively, with the mark above hereinafter referred to as “Opposer’s Marks”) for the following goods: “footwear,” in International Class 25 (collectively, with the goods above hereinafter referred to as “Opposer’s Goods”). The registration maintains a date of first use of at least as early as April 5, 1990. *See* Exhibit No. 5.

9. Opposer’s use of Opposer’s Marks in connection with the above-identified goods has

been continuous since the date of first use in commerce claimed on each of Opposer’s Registrations as set out hereinabove.

10. Upon information and belief, Applicant is Black Biscuit, a partnership legally organized under the laws of Minnesota, having as partners Mr. Jon Paskoff, a U.S. Citizen, and Mr. Paul Hughes, a U.S. Citizen, having an address of 372 Fifth Avenue #2B, New York, New York 10018.

11. Applicant filed an Application with the United States Trademark Office for the mark



(hereinafter “Applicant’s Mark”) on or about August 28, 2014 to be used in connection with the following goods “Apparel, namely, pants, tee shirts, hats, jerseys, socks” in International Class 25 (hereinafter “Applicant’s Goods”).

12. Applicant’s Application received Serial Number 86/380,134.

13. Applicant’s Application claims a date of first use of Applicant’s mark in commerce on January 15, 2013.

14. Applicant’s mark published for opposition on or about March 10, 2015.

15. Applicant’s applied-for mark is confusingly similar to the marks of Opposer identified in the attached Exhibits 1-5.

16. Opposer’s first use and filing dates of applications for Opposer’s Marks identified in Exhibits 1-5 are earlier than Applicant’s filing date of the Application. Additionally, upon information and belief, Opposer began using its marks in commerce prior to Applicant’s use of its mark in commerce.


17. Opposer’s Marks became famous in the minds of consumers long prior to the date of filing of Applicant’s Mark.


18. Upon information and belief, Applicant’s Goods will be offered to the same classes of consumers and at least through some of the same channels of trade as Opposer’s Goods. As applied to



Applicant’s goods, Applicant’s Mark so resembles the Opposer’s Marks that it is likely to cause confusion, or cause to mistake, or to deceive as to the source of the goods.




19. Upon information and belief, registration of Applicant's Mark  as more fully identified in Application Serial No. 86/380,134, will diminish and dilute the distinctive quality of Opposer's famous marks identified hereinabove. Customers and potential customers are likely to believe that Applicant's Goods originate from, or are sponsored and approved by Opposer when that is not the case. Any dissatisfaction with Applicant's Goods would reflect upon and irreparably damage Opposer's reputation and goodwill embodied in Opposer's Marks and name.

20. Opposer will be damaged by Applicant's registration of Applicant's Mark:  for the goods identified in Application Serial No. 86/380,134 as a result of the aforementioned confusion, mistake, and deception.

21. If Applicant is granted the registration of the mark as more fully identified by Application Serial No. 86/380,134, it would support statutory rights for Applicant in violation and derogation of Opposer's prior rights which would be a source of damage to Opposer.

22. By reason of the foregoing, Applicant is not entitled to registration of the mark:

 as more fully identified in Federal Trademark Application Serial No. 86/380,134 for the goods covered in International Class 25.

WHEREFORE, Opposer respectfully requests that the Application, Serial No. 86/380,134 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of the Opposer.

Respectfully submitted this 22nd day of April, 2015.

THE TRADEMARK COMPANY, PLLC

/Matthew H. Swyers/

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Vienna, VA 22180

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Counsel for Opposer

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
The Trademark Trial and Appeal Board**

In the Matter of Serial No. 86/380,134

		
For the trademark		
L.A. GEAR, INC.,	:	
	:	
Opposer,	:	
	:	
vs.	:	Opposition No. _____
	:	
Black Biscuit,	:	
	:	
Applicant.	:	

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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that I caused a copy of the foregoing this 22<sup>nd</sup> day of April, 2015 to be served, via first class mail, postage prepaid, upon:

Black Biscuit  
Mr. Jon Paskoff and Mr. Paul Hughes  
372 Fifth Avenue #2B  
New York, NEW YORK 10018

And

NEIL M. ZIPKIN, ESQ.  
AMSTER ROTHSTEIN & EBENSTEIN LLP  
90 PARK AVE  
NEW YORK, NEW YORK 10016-1301

/Matthew H. Swyers/  
Matthew H. Swyers

Int. Cl.: 25

Prior U.S. Cl.: 39

**United States Patent and Trademark Office** Reg. No. 1,815,958  
Registered Jan. 11, 1994

**TRADEMARK  
PRINCIPAL REGISTER**



L.A. GEAR, INC. (CALIFORNIA CORPORATION)  
4221 REDWOOD AVENUE  
LOS ANGELES, CA 90066

FOR: FOOTWEAR AND APPAREL PRODUCTS FOR MEN, WOMEN AND CHILDREN; NAMELY, SHOES, PANTS, SHORTS, SHIRTS, BLOUSES, JACKETS, OVERALLS, WARM-UP SUITS, SOCKS, HATS, LEOTARDS AND TIGHTS, IN CLASS 25 (U.S. CL. 39).

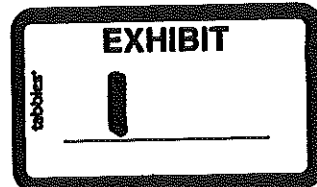
FIRST USE 2-3-1992; IN COMMERCE 2-3-1992.

OWNER OF U.S. REG. NOS. 1,449,818, 1,668,581 AND OTHERS.

SEC. 2(F) AS TO "LA GEAR".

SER. NO. 74-270,774, FILED 4-30-1992.

JULIE CLINTON, EXAMINING ATTORNEY



# United States of America

United States Patent and Trademark Office



Reg. No. 3,844,628  
Registered Sep. 7, 2010  
Int. Cl.: 25

TRADEMARK  
PRINCIPAL REGISTER

L.A. GEAR, INC. (CALIFORNIA CORPORATION)  
844 MORAGA DRIVE  
LOS ANGELES, CA 90049

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

FIRST USE 2-3-1992; IN COMMERCE 2-3-1992.

OWNER OF U.S. REG. NOS. 1,792,665, 2,160,298 AND OTHERS.

THE MARK CONSISTS OF "L" WITH A STYLIZED "A".

SEC. 2(F) AS TO "LA".

SER. NO. 77-925,036, FILED 2-1-2010.

KATHY DE JONGE, EXAMINING ATTORNEY



*David J. Kyffos*

Director of the United States Patent and Trademark Office



Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,160,298

United States Patent and Trademark Office

Registered May 26, 1998

TRADEMARK  
PRINCIPAL REGISTER



L.A. GEAR, INC. (CALIFORNIA CORPORATION)  
2850 OCEAN PARK BOULEVARD  
SANTA MONICA, CA 90404

FOR: FOOTWEAR AND APPAREL PRODUCTS FOR MEN, WOMEN AND CHILDREN, NAMELY, SHOES, BOOTS, PANTS, SHORTS, SHIRTS, BLOUSES, SKIRTS, JACKETS, OVERALLS, WARM-UP SUITS, SWEATSHIRTS, SOCKS, HATS, LEOTARDS, AND TIGHTS, IN CLASS 25 (U.S. CLS. 22 AND 39).

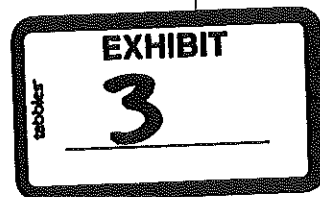
FIRST USE 2-0-1997, FIRST USED IN ANOTHER FORM IN FEBRUARY 1992; IN COMMERCE 2-0-1997, FIRST USED IN COMMERCE IN ANOTHER FORM IN FEBRUARY 1992.

OWNER OF U.S. REG. NOS. 1,792,665, 1,959,616 AND OTHERS.

SEC. 2(F) AS TO "LA".

SER. NO. 75-266,551, FILED 3-31-1997.

CHARLES WEIGELL, EXAMINING ATTORNEY



Int. Cl.: 25

Prior U.S. Cl.: 39

**United States Patent and Trademark Office**

Reg. No. 1,768,103

Registered Apr. 27, 1993

**TRADEMARK  
PRINCIPAL REGISTER**



L.A. GEAR, INC. (CALIFORNIA CORPORATION)  
4221 REDWOOD AVENUE  
LOS ANGELES, CA 90066

FOR: APPAREL; NAMELY, PANTS, DRESSES, SHORTS, SKIRTS, SHIRTS, BLOUSES, JACKETS, SOCKS, HATS, LEO-

TARDS AND TIGHTS, IN CLASS 25 (U.S. CL. 39).

FIRST USE 2-22-1991; IN COMMERCE 2-22-1991.

SN 74-104,716, FILED 10-10-1990.

JULIE CLINTON, EXAMINING ATTORNEY

EXHIBIT

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Int. Cl.: 25

Prior U.S. Cl.: 39

**United States Patent and Trademark Office** **Reg. No. 1,792,665**  
Registered Sep. 14, 1993

**TRADEMARK  
PRINCIPAL REGISTER**



L.A. GEAR, INC. (CALIFORNIA CORPORATION)  
4221 REDWOOD AVENUE  
LOS ANGELES, CA 90066

FIRST USE 4-5-1990; IN COMMERCE  
4-5-1990.

SER. NO. 74-103,578, FILED 10-5-1990.

FOR: FOOTWEAR, IN CLASS 25 (U.S. CL. 39).

JULIE CLINTON, EXAMINING ATTORNEY

