

ESTTA Tracking number: **ESTTA823786**

Filing date: **05/30/2017**

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	DashAmerica, Inc.		
Entity	Corporation	Citizenship	Colorado
Address	101 S. Taylor Avenue Louisville, CO 80027 UNITED STATES		

Attorney information	Rod S. Berman Jeffer Mangels Butler & Mitchell LLP 1900 Avenue of the Stars, 7th Floor Los Angeles, CA 90067 UNITED STATES trademarkdocket@jmbm.com Phone:310-203-8080		
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### Applicant Information

Application No	87275145	Publication date	05/02/2017
Opposition Filing Date	05/30/2017	Opposition Period Ends	06/01/2017
Applicant	R and S Impressions, Inc. 125 Marshall Street Syracuse, NY 13210 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Hats; headwear, namely, baseball caps and hats, and caps; clothing, namely, shirts; and clothing, namely, t-shirts, athletic shirts, sweatshirts, hooded sweatshirts, sports shirts made of moisture-wicking material, polo shirts, and short-sleeved shirts
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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.	1421998	Application Date	12/03/1985
Registration Date	12/23/1986	Foreign Priority Date	NONE
Word Mark	PEARL IZUMI		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 025. First use: First Use: 1971/00/00 First Use In Commerce: 1977/00/00 CLOTHING, NAMELY, COTTON AND SYNTHETIC BLEND CLOTHING TO BE WORN FOR BICYCLE RACING AND/OR TOURING, NAMELY, JERSEYS, SHIRTS, PANTS, TIGHTS, JACKETS, SWEATERS, VESTS, RACING SUITS AND WARM-UP SUITS

U.S. Registration No.	3401010	Application Date	05/16/2007
Registration Date	03/25/2008	Foreign Priority Date	NONE

Word Mark	PEARL IZUMI
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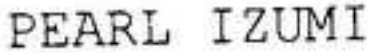
Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 025. First use: First Use: 1971/00/00 First Use In Commerce: 1977/00/00 Footwear; clothing, namely socks, shoe covers, leg warmers, knee warmers, shorts, cycling shorts, underwear, tights, knickers, pants, warm up pants, shirts, skirts, pullovers, jackets, vests, rainwear, cycling jerseys, sports bras, crop tops, tank tops, tops, arm warmers, gloves, split-fingered gloves, bicycling gloves, balaclavas, caps, visors, hats, headbands, swimwear; and baselayers, namely underclothes, tops, bottoms and underwear
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U.S. Registration No.	2719732	Application Date	08/18/2000
Registration Date	05/27/2003	Foreign Priority Date	NONE

Word Mark	PEARL IZUMI
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 025. First use: First Use: 2002/03/31 First Use In Commerce: 2002/03/31 FOOTWEAR
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Attachments	77182051#TMSN.png( bytes ) 76112551#TMSN.png( bytes ) Notice of Opposition - PEARL - R and S Impressions Inc.pdf(215646 bytes )
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Signature	/rod s. berman/
Name	Rod S. Berman
Date	05/30/2017

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

DASHAMERICA, INC.,

Opposer,

v.

R AND S IMPRESSIONS, INC.,

Applicant.

Opposition No. \_\_\_\_\_

Application Serial No. 87/275,145

Mark: PEARL

Date of Publication: May 2, 2017

Our ref.: 74379-9019

**NOTICE OF OPPOSITION**

Opposer DashAmerica, Inc. ("DashAmerica"), a Colorado corporation having a mailing address located at 101 S. Taylor Avenue, Louisville, Colorado 80027, believes that it will be damaged by the registration on the Principal Register of the mark PEARL that is the subject of federal Trademark Application Serial No. 87/275,145 (the "Application"), allegedly owned by R and S Impressions, Inc. ("Applicant"), in connection with goods in International Class 25 as identified in the Application, and Opposer hereby opposes registration thereof.

As grounds for this Opposition, Opposer alleges that:

1. Opposer is the owner of record of U.S. Reg. No. 1,421,998 for the mark "PEARL IZUMI", issued on December 23, 1986 for "Clothing, namely, cotton and synthetic blend clothing to be worn for bicycle racing and/or touring, namely, jerseys, shirts, pants, tights, jackets, sweaters, vests, racing suits and warm-up suits", and the common law rights thereto.

Opposer's registration has not been revoked or cancelled.

2. Opposer is the owner of record of U.S. Reg. No. 3,401,010 for the mark "PEARL IZUMI", issued on March 25, 2008 for "Footwear; clothing, namely socks, shoe covers, leg warmers, knee warmers, shorts, cycling shorts, underwear, tights, knickers, pants, warm up

pants, shirts, skirts, pullovers, jackets, vests, rainwear, cycling jerseys, sports bras, crop tops, tank tops, tops, arm warmers, gloves, split-fingered gloves, bicycling gloves, balaclavas, caps, visors, hats, headbands, swimwear; and baselayers, namely underclothes, tops, bottoms and underwear", and the common law rights thereto. Opposer's registration has not been revoked or cancelled.

3. Opposer is the owner of record of U.S. Reg. No. 2,719,732 for the mark "PEARL IZUMI", issued on May 27, 2003 for "Footwear", and the common law rights thereto. Opposer's registration has not been revoked or cancelled.

4. Opposer has been doing business as PEARL IZUMI for over thirty (30) years and has used that name and mark continuously for this time period in connection with a variety of goods and services including the manufacture, sale and distribution of sports related apparel in the United States and in many countries outside of the United States. Opposer has sold millions of dollars of PEARL IZUMI branded goods, and the mark is well known to consumers.

5. Opposer's PEARL IZUMI marks described in Paragraphs 1-4 above, and as reflected in Opposer's U.S. Reg. Nos. 1,421,998, 3,401,010 and 2,719,732, are collectively referred to herein as "Opposer's Mark."

6. On information and belief, Applicant's principal place of business is located at 125 Marshall Street, Syracuse, New York 13210.

7. On information and belief, Applicant is the owner of record of U.S. Trademark Application Serial No. 87/275,145, filed on December 20, 2016, for registration of the mark PEARL for use in connection with "Hats; headwear, namely, baseball caps and hats, and caps; clothing, namely, shirts; and clothing, namely, t-shirts, athletic shirts, sweatshirts, hooded

sweatshirts, sports shirts made of moisture-wicking material, polo shirts, and short-sleeved shirts" in International Class 25 ("Applicant's Mark").

8. Since long prior to December 20, 2016, the filing date of Applicant's application, Opposer has used, widely advertised and promoted Opposer's Mark in connection with its goods and services with the result that Opposer's Mark has become well known and exclusively associated with Opposer in the United States.

9. By virtue of the widespread and longstanding distribution of goods and services under Opposer's Mark, Opposer's Mark has come to identify the source of such goods and to distinguish those goods from those of others.

10. Because of Opposer's use and its efforts in advertising and promotion, and by virtue of the excellence and success of the goods and services offered and provided by Opposer under Opposer's Mark, Opposer has built up a valuable reputation and tremendous goodwill in Opposer's Mark, which goodwill belongs exclusively to Opposer.

11. Applicant's Mark so resembles Opposer's Mark as to be likely, when used in connection with Applicant's goods, as to cause confusion, or mistake, or deception. Applicant's and Opposer's goods are related and Applicant's Mark creates a commercial impression confusingly similar to Opposer's Mark. Consumers are likely to believe that Applicant's use of Applicant's Mark in connection with Applicant's goods is in some way associated or connected with or sponsored, authorized, or warranted by Opposer. Any objection or fault with Applicant's goods offered in connection with Applicant's Mark would reflect upon and seriously injure Opposer's reputation in connection with goods and services offered under Opposer's Mark.

12. If Applicant is granted the registration herein opposed, Applicant would be granted at least a prima facie exclusive right to use of the mark PEARL which Opposer contends

is likely to cause consumer confusion and falsely represent the source of Applicant's goods.

Such registration would be a source of damage and injury to Opposer.

13. WHEREFORE, in accordance with Section 13 of the Trademark Act (15 U.S.C. § 1063), Opposer prays that this Opposition be sustained and that Application Serial No. 87/275,145 be refused.

Respectfully submitted,

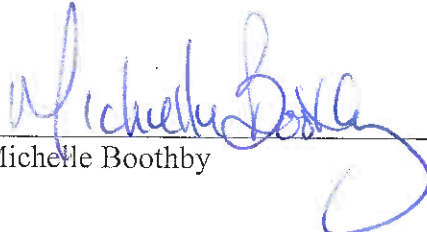
Dated: May 30, 2017

/s/ Rod S. Berman  
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E-mail: trademarkdocket@jmbm.com  
Attorneys for Opposer DashAmerica, Inc.

CERTIFICATE OF SERVICE

It is hereby certified that on **May 30, 2017**, a copy of the foregoing NOTICE OF OPPOSITION has been sent via email to Applicant's counsel of record as follows:

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Michelle Boothby