

ESTTA Tracking number: **ESTTA880437**

Filing date: **02/28/2018**

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	Surefoot, L.C.
Granted to Date of previous extension	02/28/2018
Address	Suite A100 1500 Kearns Boulevard Park City, UT 84060 UNITED STATES

Correspondence information	Lester K. Essig Ray Quinney & Nebeker, P.C. 36 South State Street Suite 1400 Salt Lake City, UT 84111 UNITED STATES Email: lessig@rqn.com Phone: 8013233320
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Applicant Information

Application No	87502251	Publication date	10/31/2017
Opposition Filing Date	02/28/2018	Opposition Period Ends	02/28/2018
Applicant	Shen Jiangwu Floor3, No.5-1, Lane 2, Zhonghuan Street Guangzhou CHINA		


Goods/Services Affected by Opposition


<p>Class 010. First Use: 2017/04/08 First Use In Commerce: 2017/05/03 All goods and services in the class are opposed, namely: Abdominal belts; Abdominal corsets; Abdominal hernia belts; Arch supports for footwear; Baby bottles; Belts for medical purposes; Belts, electric, for medical purposes; Breast pumps; Feeding bottle teats; Feeding bottle valves; Love dolls; Orthopedic footwear; Orthopedic soles; Orthopedic apparatus for talipes; Orthopedic braces; Orthopedic cushions; Orthopedic cushions and padding; Orthopedic devices for diagnostic and therapeutic use; Orthopedic shoes; Orthopedic support bandages; Orthopedic supports; Orthopedic walkers; Supporters for medical purposes; Supports for general medical use; Teats; Teething rings; Teething rings incorporating baby rattles; Arch supports for boots or shoes; Electrical weight loss body belt; Massage apparatus for massaging necks and backs, feet; Maternity support belts for medical purposes; Medical boots for foot fractures and broken ankles; Orthopaedic belts; Orthopaedic inner-soles incorporating arch supports; Orthopedic belts; Orthopedic device to stretch and exercise the toes and feet; Orthotics for foot, hand; Padding for orthopedic casts; Post-pregnancy abdominal support and compression undergarments, girdles and underwear for medical purposes; Splints; Support belts for use during pregnancy for medical purposes; Surgical apparatus and instruments for use in orthopedic surgery; Templates for orthopedic purposes; Vertebral orthopedic apparatus</p>
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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.	3621266	Application Date	07/09/2004
Registration Date	05/19/2009	Foreign Priority Date	NONE
Word Mark	SUREFOOT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 1994/12/10 First Use In Commerce: 1994/12/10 custom molded orthotics and custom molded orthotic supports for ski boots, golfshoes, biking shoes, hiking shoes, athletic shoes and athletic footwear		

U.S. Registration No.	2586447	Application Date	09/29/2000
Registration Date	06/25/2002	Foreign Priority Date	NONE
Word Mark	SUREFOOT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1995/02/08 First Use In Commerce: 1995/02/08 retail stores featuring outdoor recreation products, sporting goods, athletic equipment, ski boots, ski boot liners, ski boot warmers, ski boot straps, skis, ski bindings, ski poles, ski straps, snowboards, snowboard boots, athletic footwear, athletic shoes, hiking shoes, golf shoes, biking shoes, inline skates, orthotic supports, goggles, sunglasses, eye glass retainers, sports bags, backpacks, water bottles, computer screen savers, computer screen pictures, clothing, clothing accessories, athletic apparel, T-shirts, sweatshirts, jackets, shorts, socks, handwear, mittens, gloves, headgear, hats, caps and helmets		

U.S. Registration No.	3621267	Application Date	07/09/2004
Registration Date	05/19/2009	Foreign Priority Date	NONE

Word Mark	SUREFOOT
Design Mark	
Description of Mark	NONE
Goods/Services	Class 011. First use: First Use: 1994/12/10 First Use In Commerce: 1994/12/10 electric ski boot warmers and electric ski boot dryers Class 025. First use: First Use: 1994/12/10 First Use In Commerce: 1994/12/10 ski boots; after ski boots; athletic footwear; athletic shoes; hiking shoes; and clothing and clothing accessories, namely, golf shirts, jackets, shorts, headwear, caps, and handwear, namely, mittens and gloves Class 028. First use: First Use: 1994/12/10 First Use In Commerce: 1994/12/10 detachable devices placed on the bottom of ski boots to improve ski boot traction

U.S. Registration No.	3621268	Application Date	07/09/2004
Registration Date	05/19/2009	Foreign Priority Date	NONE
Word Mark	SUREFOOT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1994/12/10 First Use In Commerce: 1994/12/31 ski goggles; snowboarding goggles; sunglasses; eyewear accessories, namely, straps and cords attached to eyeglasses and sunglasses to be worn around the neck; protective helmets; safety helmets; helmets for use during sporting activit- ies; and computer screen saver software Class 028. First use: First Use: 1994/12/10 First Use In Commerce: 1994/12/10 snow skis; ski bindings; ski poles; ski straps; and in-line skates		

U.S. Registration No.	3828584	Application Date	09/29/2000
Registration Date	08/03/2010	Foreign Priority Date	NONE
Word Mark	SUREFOOT		

Design Mark	SUREFOOT
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 1994/12/10 First Use In Commerce: 1994/12/15 All purpose sports bags Class 025. First use: First Use: 1994/12/11 First Use In Commerce: 1994/12/11 Ski boot liners; straps used for carrying ski boots; T shirts; sweatshirts; socks; and hats

Attachments	76601269#TMSN.png(bytes) 76138346#TMSN.png(bytes) 76601270#TMSN.png(bytes) 76601271#TMSN.png(bytes) 76138341#TMSN.png(bytes) Sufoot Opposition.pdf(1067173 bytes)
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Signature	/Lester K. Essig/
Name	Lester K. Essig
Date	02/28/2018

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

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SUREFOOT, L.C.,)	
)	Opposition No.
Opposer,)	
)	
vs.)	
)	Mark: SUFOOT
SHEN JIANGWU,)	Application Serial No.: 87502251
)	Filed: June 23, 2017
Applicant.)	Published: October 31, 2017
_____)	

NOTICE OF OPPOSITION

Surefoot, L.C., a Utah limited liability company doing business at 1500 Kearns Boulevard, Suite A100, Park City, Utah 84060 (“Opposer”), believes that it will be damaged by registration of the trademark SUFOOT shown in application Serial No. 87502251, filed for use in connection with “abdominal belts; abdominal corsets; abdominal hernia belts; arch supports for footwear; baby bottles; belts for medical purposes; belts, electric, for medical purposes; breast pumps; feeding bottle teats; feeding bottle valves; love dolls; orthopedic footwear; orthopedic soles; orthopedic apparatus for talipes; orthopedic braces; orthopedic cushions; orthopedic cushions and padding; orthopedic devices for diagnostic and therapeutic use; orthopedic shoes; orthopedic support bandages; orthopedic supports; orthopedic walkers; supporters for medical purposes; supports for general medical use; teats; teething rings; teething rings incorporating baby rattles; arch supports for boots or shoes; electrical weight loss body belt; massage apparatus for massaging necks and backs, feet; maternity support belts for medical purposes; medical boots for foot fractures and broken ankles; orthopaedic belts; orthopaedic inner soles incorporating

arch supports; orthopedic belts; orthopedic device to stretch and exercise the toes and feet; orthotics for foot, hand; padding for orthopedic casts; post-pregnancy abdominal support and compression undergarments, girdles and underwear for medical purposes; splints; support belts for use during pregnancy for medical purposes; surgical apparatus and instruments for use in orthopedic surgery; templates for orthopedic purposes; and vertebral orthopedic apparatus” in International Class 10, by Shen Jiangwu, an individual (hereinafter “Applicant”), believed to be doing business at Floor 3, No. 5-1, Lane 2, Zhonghuan Street Guangzhou, China. Opposer hereby opposes registration of said mark and application. Said mark was published in the Official Gazette on October 31, 2017, with a request to extend the time to oppose filed and granted thereafter, which, by operation of 37 C.F.R. § 2.196, gave Opposer until February 28, 2018, in which to file a Notice of Opposition. The Notice of Opposition was timely filed on February 28, 2018.

As grounds for opposition, it is alleged that:

1. Opposer has been actively engaged in the sale of orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear, including for street shoes, sports and other footwear, for many years, and is currently engaged in said business. Opposer has also been actively engaged in the manufacture, custom manufacture and retail and online sale of footwear, ski boots, orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear, including for street shoes, sports and other footwear, and other related goods and services, for many years, and is currently engaged in said business.

2. Based on information and belief, Applicant is engaged in the sale of orthotic,

therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear, including for street shoes, sports and other footwear, and in the manufacture and retail and online sale of orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear, including for street shoes, sports and other footwear, having entered the business in connection with its mark much more recently than Opposer.

3. Opposer has acquired extensive common law rights in the SUREFOOT mark in the United States as a trademark and service mark and is the exclusive owner of the mark. Opposer has actively and continuously used the SUREFOOT mark as a trademark on its own behalf or through its predecessors and/or licensees in the United States since at least 1994 through the present. It has used the mark extensively in connection with orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear, and other goods. Opposer has also actively and continuously used the SUREFOOT mark as a service mark on its own behalf or through its predecessors and/or licensees in the United States since at least 1995 through the present. It has used the mark extensively in connection with the manufacture, custom manufacture and retail and online sale, including through stores, websites, social media and other means, of footwear, ski boots, orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear. Opposer's use of its mark extends to most or all fifty states and beyond.

4. Opposer's extensive common law rights in its SUREFOOT trademark and services mark as noted above are more than sufficient to preclude registration of Applicant's mark and application. In this regard, the Lanham Act governing trademarks and service marks in the United States expressly states that a mark shall be refused registration if it consists of a mark

which so resembles “a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). See also 15 U.S.C. §§ 1053 and 1063. While Opposer has extensive federal trademark and service mark registrations, Opposer need not rely on its federal registrations in order to prevail. Its prior common law rights are sufficient.

5. Based on information and belief, Applicant has minimal or no common law rights in its SUFOOT mark. Applicant’s federal application for the mark SUFOOT alleges first use of the mark in 2017, with no other filings evidencing use of the mark in the United States, to the best of Opposer’s knowledge. Accordingly, it appears that Applicant has little or no use of its mark in commerce or interstate commerce. Even if it has used the mark in the United States, its use is presumably very recent and limited geographically, with such use constituting infringement of Opposer’s mark. Applicant’s application for and use of the SUFOOT mark are without Opposer’s consent.

6. In addition to its extensive common law rights, Opposer has also acquired significant federal registration rights with the United States Patent and Trademark Office for the SUREFOOT mark as a trademark and service mark in typed drawing form on the Principal Register of the United States Patent and Trademark Office granting it nationwide prior rights. This includes the following:

(a) The registration, identified as Registration No. 3621266, was filed on July 9, 2004 and registered on May 19, 2009 in International Class No. 10 in connection with “custom molded orthotics and custom molded orthotic supports for ski boots, golf shoes, biking shoes,

hiking shoes, athletic shoes and athletic footwear.”

(b) The registration, identified as Registration No. 2586447, was filed on September 29, 2000 and registered on June 25, 2002 in International Class No. 35 in connection with “retail stores featuring outdoor recreation products, sporting goods, athletic equipment, ski boots, ski boot liners, ski boot warmers, ski boot straps, skis, ski bindings, ski poles, ski straps, snowboards, snowboard boots, athletic footwear, athletic shoes, hiking shoes, golf shoes, biking shoes, inline skates, orthotic supports, goggles, sunglasses, eye glass retainers, sports bags, backpacks, water bottles, computer screen savers, computer screen pictures, clothing, clothing accessories, athletic apparel, T-shirts, sweatshirts, jackets, shorts, socks, handwear, mittens, gloves, headgear, hats, caps and helmets.”

(c) The registration, identified as Registration No. 3621267, was filed on July 9, 2004 and registered on May 19, 2009 in International Class No. 11 in connection with “electric ski boot warmers and electric ski boot dryers”; in International Class 25 in connection with “ski boots; after ski boots; athletic footwear; athletic shoes; hiking shoes; and clothing and clothing accessories, namely, golf shirts, jackets, shorts, headwear, caps, and handwear, namely, mittens and gloves”; and in International Class 28 in connection with “detachable devices placed on the bottom of ski boots to improve ski boot traction.”

(d) The registration, identified as Registration No. 3621268, was filed on July 9, 2004 and registered on May 19, 2009 in International Class No. 9 in connection with “ski goggles; snowboarding goggles; sunglasses; eyewear accessories, namely, straps and cords attached to eyeglasses and sunglasses to be worn around the neck; protective helmets; safety helmets; helmets for use during sporting activities; and computer screen saver software,” and in

International Class 28 in connection with “snow skis; ski bindings; ski poles; ski straps; and in-line skates.”

(e) The registration, identified as Registration No. 3828584, was filed on September 29, 2000 in International Class No. 18 in connection with “all purpose sports bags,” and in International Class No. 25 in connection with “ski boot liners; straps used for carrying ski boots; golf shoes, biking shoes; t shirts; sweatshirts; socks and hats,” with a notice of allowance issued on May 26, 2009.

7. Based on information and belief, Applicant has but one application for the SUFOOT mark with the United States Patent and Trademark Office. Applicant’s only application for said mark in the United States is the subject of the current opposition proceeding.

8. There is no issue as to priority, with Opposer’s first use substantially predating Applicant’s. Opposer first used its SUREFOOT mark in commerce and interstate commerce on or around December 10, 1994 with its goods and on or around February 8, 1995 with its services. Based on information and belief, Applicant, whose application alleges first use on April 8, 2017 and first use in commerce on May 3, 2017, has only very recently used its proposed SUFOOT mark in commerce or interstate commerce. Opposer’s first use predates Applicant’s first use by more than twenty two years, making Opposer the prior user of the mark in the United States.

9. Opposer has developed substantial goodwill, a most valuable reputation, and a large and profitable national business identified by its SUREFOOT mark. Customers, the general public and others throughout much of the United States have come to know, rely upon, and recognize Opposer’s orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear. Customers, the general public and others

throughout much of the United States have also come to know, rely upon, and recognize Opposer's orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear, and other goods and services, by its mark. Opposer has expended significant money, effort, and personnel resources over a period exceeding twenty three years advertising, promoting and selling its goods and services in connection with its mark and developing a reputation for excellence in connection with its goods and services.

10. The trademark and service mark Applicant proposes to register is very similar to Opposer's SUREFOOT mark. Applicant seeks registration of the word SUFOOT in typed drawing form, thereby seeking a broad scope of registration protection. All of Opposer's registrations referenced above are also in typed drawing form, according Opposer a broad scope of registration protection. In addition, Opposer's common law rights as referenced above accord Opposer a broad scope of protection. More importantly, Applicant's proposed SUFOOT mark is very similar in appearance, sound, meaning and commercial impression to Opposer's mark. Applicant's proposed mark uses the same dominant distinctive word as Opposer's mark, namely the word FOOT, a word in which Opposer has longstanding prior exclusive rights. It also begins with the letters SU as the first element in the mark, precisely as with Opposer's mark. In addition, both marks have the same number and sequence of syllables and utilize a combined one-word format with no space. The only difference is the addition of the letters RE in Registrant's mark, with the E being silent and of no affect. Notably, both parties' marks begin with precisely the same letters, namely SU, and both end with precisely the same words, namely the word FOOT, leaving only two letters of potential difference. Likewise, the marks are also similar in sound. As expressed vocally, the first two letters and the last four letters also sound

the same. Applicant's proposed mark incorporates the key elements of Opposer's mark, assuring likelihood of confusion.

11. The goods and services in connection with which Applicant proposes to register its mark are nearly identical to, and a subset of, many of the goods and services offered by Opposer in connection with its mark at common law. Applicant seeks registration of the SUFOOT mark for use in connection with "orthotics for foot," "orthopedic footwear," "orthopedic insoles," "orthopedic apparatus," "orthopedic braces," "orthopedic cushions," "orthopedic padding," "orthopedic devices," "orthopedic shoes," "orthopedic supports," "supports for general use," "arch supports," "orthopedic inner soles incorporating arch supports," and more in International Class 10. Notably, Opposer's SUREFOOT mark as used at common law for many years, and continuing through the present, provides Opposer with exclusive rights in connection with the same type of goods, namely orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear. In addition, based on information and belief, Applicant has or will offer services the same or related to those offered by Opposer at common law, including manufacturing or otherwise supplying, and retail and online sale, of orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear. Opposer has been marketing and selling its goods and services with its mark for more than twenty three years. Given the identical and overlapping nature of the parties' goods and services, confusion as to the SUFOOT and SUREFOOT marks is virtually certain.

12. The goods in connection with which Applicant proposes to register its mark are also the same as and a subset of some of the specific goods and services set forth in Opposer's

federal trademark and service mark registrations. Applicant seeks registration for use in connection with “orthotics for foot,” “orthopedic footwear,” “orthopedic insoles,” “orthopedic apparatus,” “orthopedic braces,” “orthopedic cushions,” “orthopedic padding,” “orthopedic devices,” “orthopedic shoes,” “orthopedic supports,” “supports for general use,” “arch supports,” “orthopedic inner soles incorporating arch supports,” and more in International Class 10.

Opposer’s federal registrations for its SUREFOOT mark provide exclusive rights in connection with “custom molded orthotics and custom molded orthotic supports for ski boots, golf shoes, biking shoes, hiking shoes, athletic shoes and athletic footwear” in International Class 10 (Reg. No. 3621266), various types of footwear in class 25 (Reg. No. 3621267), and retail stores featuring “orthotic supports” and footwear in class 35 (Reg. No. 2586447). The overlapping goods and services create likelihood of confusion.

13. The target markets, trade channels and advertising venues of the parties are believed to be highly similar or identical as it relates to customers and the use of professional practitioners. Applicant’s mark will be used in connection with the sale of “orthotics for foot,” “orthopedic footwear,” “orthopedic insoles,” “orthopedic apparatus,” “orthopedic braces,” “orthopedic cushions,” “orthopedic padding,” “orthopedic devices,” “orthopedic shoes,” “orthopedic supports,” “supports for general use,” “arch supports,” “orthopedic inner soles incorporating arch supports” and similar items to customers in need of the same. Likewise, for more than twenty three years, Opposer’s mark at common law has been used to provide orthotic, therapeutic and other insoles, inserts, supports, cushions, padding and apparatus for the foot and footwear. Moreover, it is believed that both Opposer and Applicant will advertise on a national basis, with both utilizing internet ads, print ads and other promotional mediums. In this regard,

for purposes of this opposition proceeding the parties are deemed to operate in immediate geographic proximity. See, e.g., In re Appetito Provisions Co., 3 U.S.P.Q. 2d 1553, 1554 n.4 (TTAB 1987); 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:78, at 23-289 (4th ed. 2008). Furthermore, the fame of Opposer's mark after more than twenty three years of extensive use, and Opposer's extensive common law rights, further demonstrate likelihood of confusion, damaging Opposer's rights and interests.

14. Applicant's proposed SUFOOT mark so resembles Opposer's SUREFOOT mark, as previously used throughout most or all of the United States, as to be likely, when applied to the identical or highly similar goods and services of the Applicant, with the same or highly similar target markets and trade channels, to cause confusion, or to cause mistake, or to deceive. Confusion, mistake and/or deception as to the source or origin of the goods and services, and the ownership, affiliation and related party status of each business, among customers, potential customers, the general public, and the business community, is likely. Many familiar with Opposer's mark will be likely to buy Applicant's goods and services under the assumption that they were provided by Opposer. Even if some should notice a difference between Opposer's mark and Applicant's mark, they will nevertheless be likely to believe that Opposer's mark and Applicant's mark are companion marks, originating from the same source or origin. Confusion will increase as Applicant expands sales of its goods, services and mark in interstate commerce. The resulting confusion, mistake and/or deception will be to the detriment of Opposer as the prior user of the mark.

15. The registration and use of Applicant's mark will eventually deprive Opposer's mark of distinctiveness, blurring identification of Opposer's mark with its goods and services,

and tarnishing Opposer's goodwill, value and reputation as associated with its mark through association with Applicant's mark, goods and services. Adverse conditions, business failures, defects, or defaults on the part of Applicant's goods, services or business will reflect upon and seriously injure Opposer's mark, reputation, and business.

16. If Applicant is granted the registration herein opposed, Applicant will obtain a prima facie exclusive right to use its proposed mark in commerce with its goods and services, its mark will likely be deemed incontestable five years from the date of registration, and Applicant will thereby obtain an incontestable right to use the mark in commerce. As a consequence, Opposer's common law and registration rights would be greatly impaired, Applicant would be able to trade on Opposer's good will, substantial confusion, deception and mistake would result, and great damage and injury would result to Opposer as the prior user of the SUREFOOT mark.

17. Based on the foregoing, issuance of a federal registration with the United States Patent and Trademark Office for the SUFOOT mark to Applicant would be in violation of Opposer's rights to the SUREFOOT mark, causing Opposer substantial damage and injury.

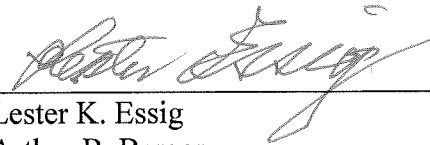
WHEREFORE, Opposer prays that the present opposition be sustained and that the registration sought by Applicant identified as Serial No. 87502251 be refused.

Please recognize Lester K. Essig and Arthur B. Berger, members of the Bar of the State of Utah, and the law firm of Ray Quinney & Nebeker P.C., whose mailing address is 36 South State Street, Suite 1400, Salt Lake City, Utah 84111, with telephone number (801) 532-1500, as attorneys for Opposer in the above-captioned opposition. Please address all correspondence to them.

DATED this 28th day of February, 2018.

Respectfully submitted,

SUREFOOT, L.C.



Lester K. Essig
Arthur B. Berger
RAY QUINNEY & NEBEKER P.C.
36 South State Street, Suite 1400
Salt Lake City, Utah 84111
Telephone: (801) 532-1500

Attorneys for Opposer

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