

ESTTA Tracking number: **ESTTA963113**

Filing date: **03/27/2019**

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	New Balance Athletics, Inc.		
Entity	Corporation	Citizenship	Massachusetts
Address	100 Guest Street Boston, MA 21208 UNITED STATES		

Attorney information	Thomas L. Holt Perkins Coie LLP 131 South Dearborn St. Suite 1700 Chicago, IL 60603 UNITED STATES tholt@perkinscoie.com, pctrademarks@perkinscoie.com 3123248438
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Applicant Information

Application No	88171415	Publication date	03/26/2019
Opposition Filing Date	03/27/2019	Opposition Period Ends	04/25/2019
Applicant	I Work for Dick Jones Damnit, LLC Suite 304 1004 Reisterstown Road. Pikesville, MD 21208 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Men's, women's, children's and infant's clothing, namely, aprons, ski boots, aprons, ascots, gauchos, baby bibs not of paper, baby booties and baby creepers, baby pants, bandanas, baseball pants, baseball shirts, basketball shooter shirts, bathing caps, bathrobes, beach cover-ups, belts, berets, Bermuda shorts, bicycle pants, bicycle shirts, bicycle shoes, blazers, bloomers, blouses, bodices, boleros, bonnets, boots, bottoms, bow ties, bowling shirts, boxer shorts, braces as suspenders, brassieres, breeches, briefs, bustiers, caftans, camisoles, capes, caps being headwear, cardigans, cassocks, chaps, cheerleader outfits being skirts and tops, chef's hats, chemises, clogs, coats, cocktail dresses, corselets, corsets, costumes for use in role-playing games, beach cover-ups, cowboy boots, cowboy hats, cravats, crew neck sweat-shirts, crop tops, culottes, cummerbunds, denim jackets, denim shorts, dress pants, dresses, dressing gowns, dusters in the nature of coats, ear bands, elastic waist shorts, espadrilles, evening gowns, face warming masks being balaclavas, fedoras, fixed waist shorts, fleece pullovers, flip-flops, footwear, foulards, foundation garments, frocks, gabardines, gaiters, galoshes, garter belts, girdles, gloves, golf pants, golf shirts, golf shoes, gowns, gym shirts, gym shorts, gym suits, Halloween cos-</p>
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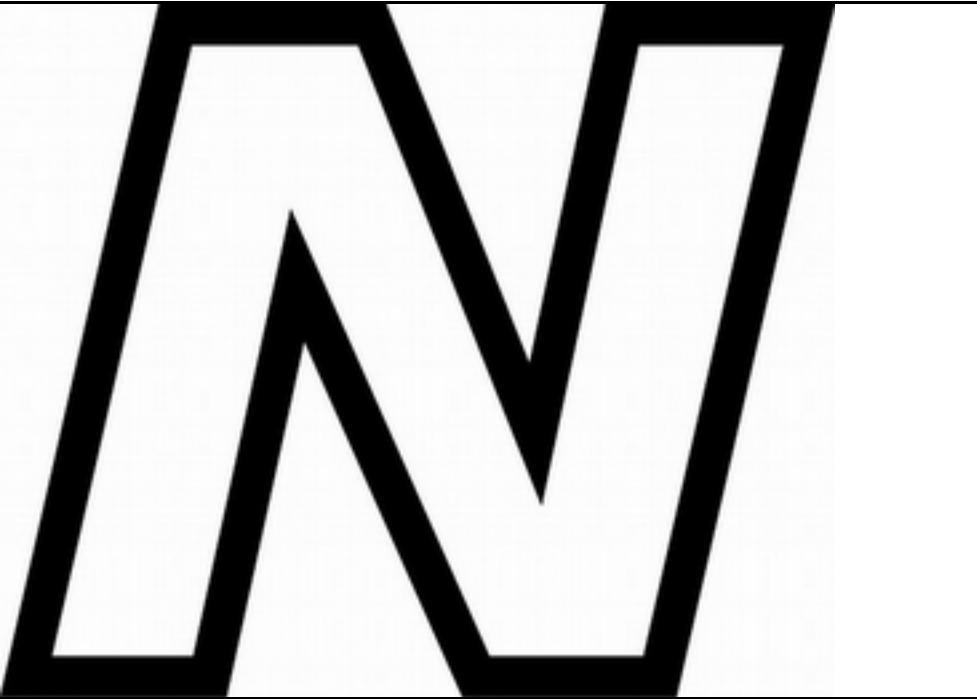
tumes, halter tops, hats, headbands, artificial flower and flower headdresses, headwear, hooded sweatshirts, hoods, hosiery, housecoats, Hula skirts, hunting vests, infantwear, jackets, jeans, jerseys, jogging shoes, jogging suits, jumpers, jumpsuits, kerchiefs, kilts, kimonos, knee-highs, knickers, knit pants, knit shirts, knit shorts, knit skirts, knitted hats, leggings, leotards, light-reflecting caps being headwear, light-reflecting clothing, namely, light-reflecting coats, light-reflecting hats, light-reflecting jackets, light-reflecting pants, light-reflecting shoes, light-reflecting shorts, light-reflecting vests, lingerie, loungewear, maillots, mantillas, mantles, masquerade costumes, miniskirts, mittens, moccasins, mufflers as neck scarves, mukluks, muu muus, neck ties, neckbands, neckwear, night gowns, night shirts, nurse dresses, nurse overalls, nurse pants, nurse shirts, nurse smocks, one piece garment for infants, overalls, overcoats, pajamas, panties, pants, pantyhose, paraments, pareu, parkas, pedal pushers, peignoirs, petticoats, pinafores, placket shirts, plus fours, pocket tee-shirts, polo shirts, ponchos, portshirts, pullovers, pumps as footwear, quilted vests, rain hats, rain jackets, raincoats, rainwear, robes, rompers, running shoes, sandals, saris, sarongs, sashes, scarves, shawls, shifts as clothing, shirts, shoes, short sets, shorts, shrugs, singlets, skating outfits, ski bibs, ski boots, ski gloves, ski masks, ski pants, ski suits, ski wear, skirts, skorts, slacks, sleepwear, slippers, slips being underclothing, smocks, snow boots, snow pants, snow suits, snowwear being snow suits, socks, stocking caps, stockings, stoles, suits, suspenders, sweat pants, sweatshirts, sweat suits, sweater vests, sweaters, swimming trunks, swimsuits, swimwear, tank tops, tap pants, teddies being underclothing, tennis shirts, tennis shoes, tennis shorts, thermal underwear, thongs as underclothing, toe shoes, togas, topcoats, tops, toques, toreador pants, trench coats, trousers, T-shirts, tunics, turbans, turtleneck sweaters, tu-tus, tuxedo shirts, tuxedos, underclothes, undergarments, underpants, undershirts, uniform jackets, uniform pants, uniform shirts, unitards, veils, vests, visors being headwear, fishing waders, waistcoats, warm-up suits, wedding gowns, wet suits, wind resistant jackets, wind shirts, work pants, work shirts, clothing wraps, zippered hood sweatshirts, zootsuits, and zoris

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3282106	Application Date	11/10/2006
Registration Date	08/21/2007	Foreign Priority Date	NONE
Word Mark	N		

Design Mark	
Description of Mark	The mark consists of a stylized representation of the letter N with a contrasting border.
Goods/Services	Class 025. First use: First Use: 1977/01/02 First Use In Commerce: 1977/01/02 Athletic footwear

U.S. Registration No.	4477442	Application Date	05/30/2013
Registration Date	02/04/2014	Foreign Priority Date	NONE

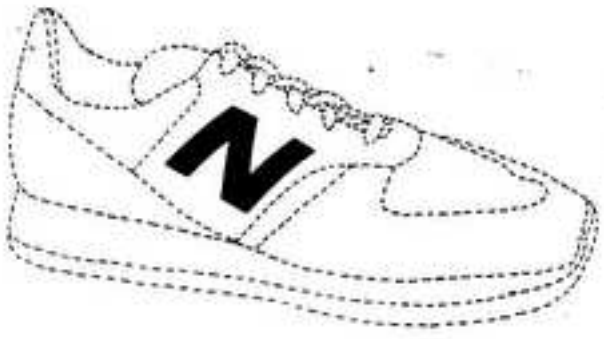
Word Mark	N
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Design Mark	
Description of	The mark consists of a stylized representation of the letter "N" with a contrasting

Mark	border.
Goods/Services	Class 025. First use: First Use: 1996/01/01 First Use In Commerce: 1996/01/01 Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Sweatshirts

U.S. Registration No.	1308133	Application Date	10/13/1983
Registration Date	12/04/1984	Foreign Priority Date	NONE

Word Mark	N
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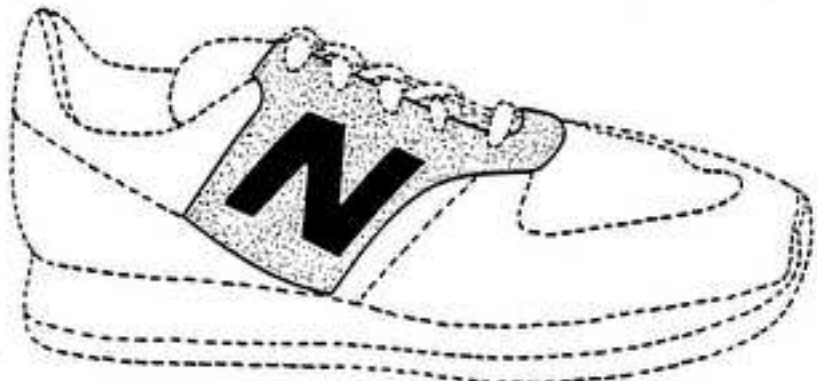
Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 025. First use: First Use: 1977/01/02 First Use In Commerce: 1977/01/02 Athletic Footwear
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U.S. Registration No.	1344589	Application Date	10/13/1983
Registration Date	06/25/1985	Foreign Priority Date	NONE

Word Mark	N
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Design Mark	
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Description of Mark	THE SHOE OUTLINE SHOWN IN BROKEN LINES IN THE DRAWING FORMS NO PART OF THE MARK, BUT IS FURNISHED TO SHOW THE LOCATION OF THE MARK IN USE.
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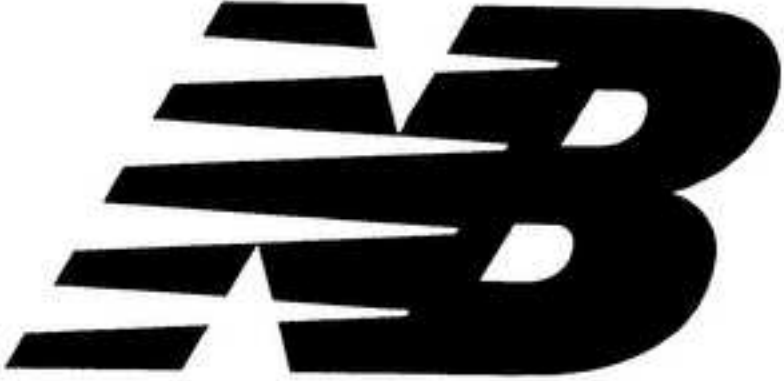
Goods/Services	Class 025. First use: First Use: 1979/02/01 First Use In Commerce: 1979/02/01 ATHLETIC FOOTWEAR
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U.S. Registration No.	1065726	Application Date	10/26/1976
Registration Date	05/17/1977	Foreign Priority Date	NONE
Word Mark	NB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 010. First use: First Use: 1973/00/00 First Use In Commerce: 1973/00/00 [ARCH SUPPORTS] Class 025. First use: First Use: 1974/00/00 First Use In Commerce: 1974/00/00 ATHLETIC SHOES, INSOLES, [HEEL PADS,]AND T-SHIRTS		

U.S. Registration No.	1260939	Application Date	09/28/1982
Registration Date	12/13/1983	Foreign Priority Date	NONE
Word Mark	NB		
Design Mark			

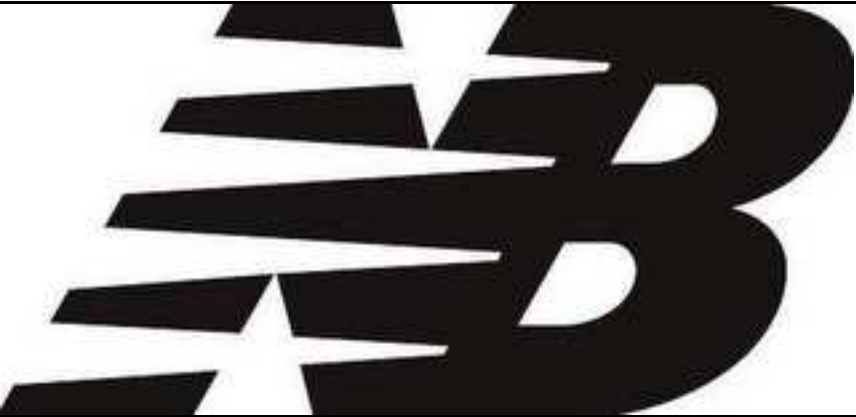
Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 1977/07/00 First Use In Commerce: 1977/07/00 Tote Bags Class 025. First use: First Use: 1977/03/00 First Use In Commerce: 1977/03/00 Hats, Sweat Bands, Visors, Sport Shirts, Singlets, Running Shorts, Running Suits, All-Weather Suits, Recreational Tops and Shorts, Socks, Walking Shoes, Boat Shoes, Aerobic Dancing Shoes and Hiking Boots

U.S. Registration No.	3427255	Application Date	10/30/2003
Registration Date	05/13/2008	Foreign Priority Date	NONE

Word Mark	NB
Design Mark	

Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 2007/08/01 First Use In Commerce: 2007/08/02 All purpose sport bags, back packs, shoulder bags, hand bags, billfolds and wallets Class 025. First use: First Use: 2007/08/01 First Use In Commerce: 2007/08/02 Hats, caps, head bands, sweat bands, wrist bands, visors, shirts, T-shirts, tank shirts, sport shirts, singlets, sportstops, sports bras, tights, briefs, shorts, pants, jackets, running suits, all-weather suits, socks, belts, gloves, footwear, and cushioning inserts for shoes

U.S. Registration No.	3475802	Application Date	12/13/2007
Registration Date	07/29/2008	Foreign Priority Date	NONE
Word Mark	NB		

Design Mark	
Description of Mark	The mark consists of "NB".
Goods/Services	<p>Class 025. First use: First Use: 2007/01/01 First Use In Commerce: 2007/01/02</p> <p>Basketball sneakers; Sneakers; Button-front aloha shirts; Camp shirts; Dress shirts; Golf shirts; Knit shirts; Long-sleeved shirts; Night shirts; Open-necked shirts; Polo shirts; Rugby shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts; Sports shirts; Sports shirts with short sleeves; Sweat shirts; T-shirts; Tee shirts; Triathlon clothing, namely, triathlontights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; Wind shirts; Yoga shirts; Bermuda shorts; Board shorts; Boxer shorts; Fleece shorts; Gym shorts; Panties, shorts and briefs; Rugby shorts; Short trousers; Underwear, namely, boy shorts; Walking shorts; Capri pants; Cargo pants; Jogging pants; Lounge pants; Pants; Ski pants; Snow pants; Stretch pants; Sweat pants; Track pants; Waterproof jackets and pants; Wind pants; Yoga pants; Jackets; Light-reflecting jackets; Men and women jackets, coats, trousers, vests; Rain jackets; Ski jackets; Sports jackets; Wind-jackets; Athletic shoes</p>

Attachments	<p>77041477#TMSN.png(bytes) 85946109#TMSN.png(bytes) 73447937#TMSN.png(bytes) 73447946#TMSN.png(bytes) 73104228#TMSN.png(bytes) 73391302#TMSN.png(bytes) 76559803#TMSN.png(bytes) 77350997#TMSN.png(bytes) Notice of Opposition I Work for Dick Jones Final.pdf(160735 bytes)</p>
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Signature	/Thomas L. Holt/
Name	Thomas L. Holt
Date	03/27/2019

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

NEW BALANCE ATHLETICS, INC.,)	
)	
Opposer,)	Opposition No. _____
)	
v.)	Serial No.: 88/171,415 (N & Design)
)	
I WORK FOR DICK JONES DAMNIT, LLC)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, New Balance Athletics, Inc. (“New Balance”), a Massachusetts corporation, with offices at 100 Guest Street, Boston, Massachusetts, 02135, believes that it will be damaged by the registration of the N & Design mark reflected in U.S. Application Serial No. 88/171,415 (“IWFDJD’s N Design Mark”) owned by I Work for Dick Jones Damnit, a Maryland limited liability company, with an address at 1004 Reisterstown Rd., Pikesville, MD 21208 (“IWFDJD”). New Balance hereby opposes registration of the subject mark on the following grounds:

1. New Balance is a private company that was founded in 1906. Today, New Balance is one of the largest shoe manufacturers in the world, with over 8,000 employees and \$4.2 billion in annual sales worldwide in 2018. It is the only major company that manufactures athletic footwear in factories in the United States.

2. Since its earliest days, New Balance has focused on fit and authenticity as its core brand message. New Balance is one of the few sneaker manufacturers to make shoes in true width sizing, rather than the more common narrow and wide. Because of its brand qualities, New Balance has the most brand loyal customers in the marketplace. New Balance won the No. 1 Customer Loyalty Award in the athletic footwear category for eight consecutive years from Brand

Keys, an independent group that identifies the brands that are best able to engage consumers and create loyal customers.









3. New Balance has designed and developed numerous well-recognized and even iconic shoe designs and models and has sold hundreds of millions of pairs of shoes worldwide, representing many billions in sales.

4. Since as early as January 1, 1974, New Balance has adopted and used in United States commerce a family of trademarks featuring a stylized letter “N” and design on its own or in combination with other elements, including a similarly stylized letter “B,” (collectively the “N Marks”) in connection with footwear and apparel, among other things.

5. New Balance consistently and prominently uses and displays the N Marks in connection with the advertising, promotion and sale of its goods and services.

6. As a result of the extensive sales, advertising and promotion of footwear, apparel, and other goods and services under the N Marks, and through favorable industry acceptance and recognition, the consuming public and the trade have come to recognize the N Marks as identifying a single source of high quality products and services.

7. New Balance is the owner of, among others, the following United States trademark registrations for the N Marks for use in connection with footwear, apparel, and/or related goods and services, all of which are valid and subsisting on the Principal Register of the United States Patent and Trademark Office (“PTO”):

Mark	Reg. No.	Reg. Date	First Use in U.S. Commerce
	3,282,106	Aug. 21, 2007	Jan. 2, 1977 (Class 25)
	4,477,442	Feb. 4, 2014	Jan. 1, 1996 (Class 25)
	1,308,133	Dec. 4, 1984	Jan. 2, 1977 (Class 25)
	1,344,589	June 25, 1985	Feb. 1, 1979 (Class 25)
	1,065,726	May 17, 1977	Jan. 1, 1974 (Class 25)
	1,260,939	Dec. 13, 1983	July 1, 1977 (Class 18) Mar. 1, 1977 (Class 25)
	3,427,255	May 13, 2008	Aug. 2, 2007 (Class 18) Aug. 2, 2007 (Class 25)
	3,475,802	July 29, 2008	Jan. 2, 2007 (Class 25)

8. Pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b), New Balance's federal registration certificates are *prima facie* evidence of the validity of these marks as well as New Balance's ownership and exclusive right to use these marks in connection with the identified goods and services. In fact, New Balance's exclusive right to use the NEW BALANCE N Marks for the goods recited in Registration Nos. 1,065,726, 1,260,939, 1,308,133, 1,344,589, 3,282,106, 3,427,255, 3,475,802 and 4,477,442 has achieved incontestable status under 15 U.S.C. § 1065.

9. By reason of extensive advertising and sale, the N Marks have become, through widespread and favorable public acceptance and recognition, famous and an asset of incalculable value as a symbol of New Balance, its quality products and services, and its goodwill.

10. Long after New Balance first used the N Marks, after the PTO issued federal registrations for the N Marks, and after the N Marks became famous and well known, IWFDJD applied to register IWFDJD's N & Design Mark under Serial No. 88/171,415.

11. Long after New Balance first used the N Marks, after the PTO issued federal registrations for the N Marks, and after the N Marks became famous and well known IWFDJD adopted IWFDJD's N & Design Mark in connection with various shoes and apparel.

12. New Balance's rights in the N Marks predate IWFDJD's rights in the IWFDJD's N & Design Mark.

13. The IWFDJD's N & Design Mark are confusingly similar in sight, sound, and commercial impression to New Balance's N Marks.

14. The goods offered under New Balance's N Marks are directly competitive with or at least highly related to the goods recited in the application of the IWFDJD's N & Design Mark.

15. New Balance did not authorize IWFDJD's adoption and use of the IWFDJD's N & Design Mark.

16. IWFDJD's N & Design Mark so closely resembles New Balance's N Marks that, when used in connection with the applied-for goods, they are likely to cause confusion, mistake or deception of the relevant trade and public under Section 2(d) of the Trademark Act. Consumers will likely believe that IWFDJD's goods are in some way associated with or connected with, or approved or authorized by, New Balance, when this is not the case.

17. IWFDJD's N & Design Mark so closely resembles New Balance's N Marks that, when used in connection with the applied-for goods, it is likely to cause dilution by blurring of the Marks in violation of Section 43(c) of the Trademark Act. Due to the similarity between New Balance's N Marks and IWFDJD's N & Design Mark, consumers will likely associate IWFDJD and/or IWFDJD's goods with New Balance or New Balance's goods, which will impair the distinctiveness of the famous N Marks.

18. WHEREFORE, New Balance believes that it will be being damaged by registration of IWFDJD's N & Design Mark, and therefore respectfully requests that U.S. Application Serial No. 88/171,415 be refused registration based on a likelihood of confusion and dilution.

Dated: March 27, 2019

Respectfully submitted,

NEW BALANCE ATHLETICS, INC.

By: /s/ Thomas L. Holt
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Attorneys for Opposer