

ESTTA Tracking number: **ESTTA1156762**

Filing date: **08/31/2021**

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	Greats Brand Inc.
Granted to Date of previous extension	09/01/2021
Address	101 N 10TH STREET #309 BROOKLYN, NY 11249 UNITED STATES
Attorney information	SUSAN A. SMITH BALLARD SPAHR LLP 1909 K STREET, NW 12TH FLOOR WASHINGTON, DC 20006-1157 UNITED STATES Primary Email: TMDocketing@BallardSpahr.com Secondary Email(s): SmithS@BallardSpahr.com, glasserj@BallardSpahr.com 202-661-2247
Docket Number	00362186

Applicant Information

Application No.	90183072	Publication date	05/04/2021
Opposition Filing Date	08/31/2021	Opposition Period Ends	09/01/2021
Applicant	Lucasfilm Ltd. LLC ONE LETTERMAN DRIVE, BLDG. B SAN FRANCISCO, CA 94129 UNITED STATES		

Goods/Services Affected by Opposition


Class 025. First Use: 0 First Use In Commerce: 0
Opposed goods and services in the class: footwear

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.	5620038	Application Date	04/28/2017
Registration Date	12/04/2018	Foreign Priority	NONE

		Date	
Word Mark	GREATS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2017/03/09 First Use In Commerce: 2017/03/09 Shoes Class 035. First use: First Use: 2017/01/09 First Use In Commerce: 2017/01/09 On-line retail store services featuring shoes		

U.S. Registration No.	5620036	Application Date	04/28/2017
Registration Date	12/04/2018	Foreign Priority Date	NONE

Word Mark	GREATS		
Design Mark			
Description of Mark	The mark consists of a ribbon with the word "GREATS" in the middle of the ribbon, the "G" in the word "GREATS" is stylized with a ribbon in the middle.		
Goods/Services	Class 025. First use: First Use: 2017/04/27 First Use In Commerce: 2017/04/27 Shoes Class 035. First use: First Use: 2017/01/09 First Use In Commerce: 2017/01/09 On-line retail store services featuring shoes		

U.S. Registration No.	5851440	Application Date	03/05/2019
Registration Date	09/03/2019	Foreign Priority Date	NONE
Word Mark	GREATS		

Design Mark	<h1>GREATS</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2018/02/16 First Use In Commerce: 2018/02/16 Retail store services featuring shoes

Attachments	87430158#TMSN.png(bytes) 87430144#TMSN.png(bytes) 88326315#TMSN.png(bytes) GAMING GREATS Notice of Opposition.pdf(16186 bytes) Exhibit A - GAMING GREATS Opposition.pdf(243801 bytes)
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Signature	/sas/
Name	SUSAN A. SMITH
Date	08/31/2021

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

In the Matter of Trademark Application:

Serial No. : 90183072
Applicant : Lucasfilm Ltd. LLC
Filed : September 15, 2020
Mark : GAMING GREATS

Published in the *Official Gazette* of May 4, 2021

Greats Brand Inc.,

Opposer,

v.

Lucasfilm Ltd. LLC,

Applicant.

Opposition No. _____


UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer, Greats Brand Inc. (“GBI”), a Delaware corporation having an address at 101 N 10th Street #309, Brooklyn, NY 11249, believing it will be damaged by the registration of GAMING GREATS for footwear, as shown in Application Serial No. 90183072, hereby opposes its registration pursuant to 15 U.S.C. §§ 1051 *et seq.*, including specifically 15 U.S.C. § 1068.

This Notice of Opposition has been timely filed. As grounds for opposition, GBI alleges as follows:

1. Upon information and belief, Applicant Lucasfilm Ltd. LLC (“Applicant”) is a California limited liability company with an address at One Letterman Drive, Bldg. B, San Francisco, CA 94129.
2. Applicant seeks registration of the mark GAMING GREATS in International Class 25 for numerous goods including footwear. GBI opposes registration of the mark solely in connection with footwear and not for the non-footwear goods listed in the subject application. (Applicant also has applied to register the same mark in International Class 28 for various goods; however, GBI does not oppose registration in Class 28.)
3. Applicant filed Application Serial No. 90183072 on September 15, 2020, claiming an intent to use the mark in commerce.
4. The GAMING GREATS application was published for opposition on May 4, 2021. GBI filed two extensions of time totaling 90 days, which were both accepted, extending the opposition deadline to September 1, 2021. The present opposition is timely filed.
5. GBI has used its GREATS marks in interstate commerce since at least as early as 2017. Since that time, GBI has broadly used its distinctive GREATS marks on and in connection with footwear. GBI owns several federal trademark registrations for its GREATS marks for footwear and related services as reflected in the following chart (“GBI’s Marks”):

Mark	Class	Goods and Services	Status
GREATS	25 35	INT. CL. 25 SHOES INT. CL. 35 ON-LINE RETAIL STORE SERVICES FEATURING SHOES	Registered Reg. No. 5620038
	25 35	INT. CL. 25 SHOES INT. CL. 35 ON-LINE RETAIL STORE SERVICES FEATURING SHOES	Registered Reg. No. 5620036
GREATS	35	INT. CL. 35 RETAIL STORE SERVICES FEATURING SHOES	Registered Reg. No. 5851440

True and correct copies of the electronic records for these registrations, printed from the United States Patent and Trademark Office's ("USPTO") Trademark Status & Document Retrieval ("TSDR") online database, are attached hereto as Exhibit A. Each of the registrations listed above was issued on the Principal Register and is in full force and effect.

6. GBI also possesses significant common law trademark rights in the mark GREATS for footwear by virtue of its long and expansive use of the mark.
7. No issue of priority exists. GBI has used, promoted and advertised GREATS products since at least as early as 2017. Conversely, Applicant alleges only an intent to use the GAMING GREATS mark in commerce.
8. GBI has invested significant resources promoting GBI's Marks to identify itself as the source of footwear sold under the GREATS brand. As such, consumers and others regard GREATS as symbolizing the goodwill inherent in GBI's Marks, and further associate GREATS solely with GBI and its high quality products.
9. Applicant's GAMING GREATS mark is confusingly similar to GBI's registered GREATS trademark in terms of appearance, sound, and commercial meaning, pursuant to 15 U.S.C. § 1052(d). Applicant's mark incorporates GBI's GREATS trademark in its entirety. Applicant's addition of the descriptive word GAMING is not sufficient to distinguish the mark or lessen the likelihood of confusion.
10. The likelihood of confusion between GAMING GREATS and GREATS is further exacerbated by Applicant's proposed use for identical goods, specifically, footwear in International Class 25. (Again, GBI does not oppose registration for non-footwear goods in Class 25 nor Class 28.)

11. Applicant's intended use of GAMING GREATS for footwear is assumed to target the same types of consumers through the same channels of distribution as GBI's, and indeed there is no limitation in Applicant's description of goods to a particular or different class of purchasers.
12. Given the goodwill and public recognition arising from the association of the GREATS mark with GBI, Applicant's proposed use of GAMING GREATS in connection with footwear is likely to cause consumers mistakenly to believe that Applicant's goods are somehow related to GBI or to the GREATS trademark, or that such goods originate from or are sponsored or approved by GBI. This confusion and mistake will cause injury to GBI.
13. If Applicant is awarded a registration for GAMING GREATS in connection with footwear, as shown in International Class 25 of Application Serial No. 90183072, Applicant would be entitled to the presumptions flowing from such a registration, all to the injury of GBI.
14. GBI has not given Applicant permission to use GAMING GREATS or any variant of GBI's GREATS trademark for footwear.
15. Accordingly, registration for the mark in International Class 25 as applied for under Serial No. 90183072 should be partially refused under the provisions of Section 2(d) and Section 18 of the Trademark Act in connection with footwear.

WHEREFORE, Opposer, Greats Brand Inc., requests that this opposition be sustained in favor of GBI, that registration of the mark in Application Serial No. 90183072 be rejected in connection with footwear in International Class 25, and that "footwear" be deleted from the description of goods in the subject application.

Please address all future communications regarding this opposition to:

Susan A. Smith
BALLARD SPAHR LLP
1909 K Street, NW
12th Floor
Washington, DC 20006-1157
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E-Mail: SmithS@ballardspahr.com
TMDocketing@ballardspahr.com

If any fees associated with this proceeding are required and were not paid during the course of the electronic filing process, please charge such fees to Deposit Account 020755 (Our Ref. 00362186).

Respectfully submitted,

BALLARD SPAHR LLP

Dated: August 31, 2021

By: /Susan A. Smith/
Susan A. Smith
BALLARD SPAHR LLP
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12th Floor
Washington, DC 20006-1157
Telephone: (202) 661-2247
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SmithS@ballardspahr.com
TMDocketing@ballardspahr.com

Counsel for Opposer, Greats Brand Inc.

EXHIBIT

A

For assistance with TSDR, email teas@uspto.gov and include your serial number, the document you are looking for, and a screenshot of any error messages you have received.

Processing Wait Times: Please note that due to an extraordinary surge in applications, processing times are longer than usual. See [current trademark processing wait times](#) for more information.

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Mark: GREATS

GREATS

US Serial Number: 87430158

Application Filing Date: Apr. 28, 2017

US Registration Number: 5620038

Registration Date: Dec. 04, 2018

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Dec. 04, 2018

Publication Date: Sep. 18, 2018

Mark Information

Mark Literal Elements: GREATS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Shoes

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 09, 2017

Use in Commerce: Mar. 09, 2017

For: On-line retail store services featuring shoes

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 09, 2017

Use in Commerce: Jan. 09, 2017

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: Greats Brand Inc.

[Privacy - Terms](#)

Owner Address: 101 N 10th Street #309
Brooklyn, NEW YORK UNITED STATES 11249

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Prosecution History

Date	Description	Proceeding Number
Jul. 29, 2021	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Jul. 29, 2021	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jul. 29, 2021	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Jul. 29, 2021	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Jul. 29, 2021	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Oct. 03, 2019	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Oct. 03, 2019	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Sep. 09, 2019	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Sep. 09, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Dec. 04, 2018	REGISTERED-PRINCIPAL REGISTER	
Sep. 18, 2018	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Sep. 18, 2018	PUBLISHED FOR OPPOSITION	
Aug. 29, 2018	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 10, 2018	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 09, 2018	LIE CHECKED SUSP - TO ATTY FOR ACTION	70633
Feb. 08, 2018	REPORT COMPLETED SUSPENSION CHECK CASE STILL SUSPENDED	70633
Feb. 01, 2018	ASSIGNED TO LIE	70633
Jul. 28, 2017	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Jul. 28, 2017	LETTER OF SUSPENSION E-MAILED	6332
Jul. 28, 2017	SUSPENSION LETTER WRITTEN	92568
Jul. 28, 2017	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Jul. 28, 2017	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jul. 26, 2017	ASSIGNED TO EXAMINER	92568
May 04, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 02, 2017	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

Assignment Abstract Of Title Information

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Mark: GREATS

GREATS

US Serial Number: 87430144

Application Filing Date: Apr. 28, 2017

US Registration Number: 5620036

Registration Date: Dec. 04, 2018

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Dec. 04, 2018

Publication Date: Sep. 18, 2018

Mark Information

Mark Literal Elements: GREATS

Standard Character Claim: No

Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of a ribbon with the word "GREATS" in the middle of the ribbon, the "G" in the word "GREATS" is stylized with a ribbon in the middle.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 09.01.04 - Ribbons, hair; Bows, decorative; Ribbons, giftwrap (gift wrap)

Related Properties Information

Goods and Services

Note:

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- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Shoes

International Class(es): 025 - Primary Class

U.S Class(es): 022, 039

Class Status: ACTIVE

Basis: 1(a)

First Use: Apr. 27, 2017

Use in Commerce: Apr. 27, 2017

For: On-line retail store services featuring shoes

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 09, 2017

Use in Commerce: Jan. 09, 2017

Basis Information (Case Level)

Current Owner(s) Information**Owner Name:** Greats Brand Inc.**Owner Address:** 101 N 10th Street #309
Brooklyn, NEW YORK UNITED STATES 11249**Legal Entity Type:** CORPORATION**State or Country Where Organized:** DELAWARE**Attorney/Correspondence Information****Prosecution History**

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Oct. 03, 2019	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
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Sep. 09, 2019	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Dec. 04, 2018	REGISTERED-PRINCIPAL REGISTER	
Sep. 18, 2018	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Sep. 18, 2018	PUBLISHED FOR OPPOSITION	
Aug. 29, 2018	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 10, 2018	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 09, 2018	LIE CHECKED SUSP - TO ATTY FOR ACTION	70633
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Jul. 28, 2017	SUSPENSION LETTER WRITTEN	92568
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Jul. 26, 2017	ASSIGNED TO EXAMINER	92568
May 05, 2017	NOTICE OF DESIGN SEARCH CODE E-MAILED	
May 04, 2017	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 02, 2017	NEW APPLICATION ENTERED IN TRAM	

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[Back to Search](#)

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Mark: GREATS

GREATS

US Serial Number: 88326315

Application Filing Date: Mar. 05, 2019

US Registration Number: 5851440

Registration Date: Sep. 03, 2019

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office.

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Sep. 03, 2019

Publication Date: Jun. 18, 2019

Mark Information

Mark Literal Elements: GREATS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

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- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Retail store services featuring shoes

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 16, 2018

Use in Commerce: Feb. 16, 2018

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: Greats Brand Inc.

Owner Address: 101 N 10th Street #309
Brooklyn, NEW YORK UNITED STATES 11249

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Privacy - Terms

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May 14, 2019	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 14, 2019	ASSIGNED TO EXAMINER	93425
Mar. 22, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Mar. 08, 2019	NEW APPLICATION ENTERED IN TRAM	

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