

ESTTA Tracking number: **ESTTA1182617**

Filing date: **01/05/2022**

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

Proceeding no.	91273187
Party	Defendant PASHUN PRODUCTS LTD
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Date	01/05/2022
Attachments	Pashun 10.2-001 Answer and Defenses to Opposition Jan. 2022.pdf(148517 bytes)

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

Pacific Sunwear of California LLC,

Opposer,

v.

Pashun Products Ltd,

Applicant.

Mark: **PASHUN LIFESTYLE**

Serial No. 90/503,209

Opposition No. 91/269,950

APPLICANT’S ANSWER TO NOTICE OF OPPOSITION

Applicant Pashun Products Ltd. (hereinafter referred to as “Applicant” or “PASHUN”) by and through its attorneys, answers the Notice of Opposition filed by Pacific Sunwear of California LLC (hereinafter referred to as “Opposer” or “Pacific”), as follows. Except as hereinafter expressly admitted, qualified, or otherwise answered, Applicant, Pashun Products Ltd. denies each and every allegation and assertion made in the Notice of Opposition (“NOP”).

1. Regarding the allegations set forth in Paragraph 1 of the NOP, PASHUN admits them.
2. Regarding the allegations set forth in Paragraph 2 of the NOP, PASHUN admits them.
3. Regarding the allegations set forth in Paragraph 3 of the NOP, PASHUN admits them.

4. Regarding the allegations set forth in Paragraph 4 of the NOP, PASHUN admits them.

5. Regarding the allegations set forth in Paragraph 5 of the NOP, PASHUN admits them.

6. Regarding the allegations set forth in Paragraph 6 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

7. Regarding the allegations set forth in Paragraph 7 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

8. Regarding the allegations set forth in Paragraph 8 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

9. Regarding the allegations set forth in Paragraph 9 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

10. Regarding the allegations set forth in Paragraph 10 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

11. Regarding the allegations set forth in Paragraph 11 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

12. Regarding the allegations set forth in Paragraph 12 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

13. Regarding the allegations set forth in Paragraph 13 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

14. Regarding the allegations set forth in Paragraph 14 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

15. Regarding the allegations set forth in Paragraph 15 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

16. Regarding the allegations set forth in Paragraph 16 of the NOP, PASHUN absolutely denies them in their entirety.

17. Regarding the allegations set forth in Paragraph 17 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

18. PASHUN admits the allegations in Paragraph 18 of the NOP.

19. Regarding the allegations set forth in Paragraph 19 of the NOP, PASHUN is without knowledge or information sufficient to form a belief as to the truth of these allegations and therefore denies them.

20. PASHUN admits the allegations in Paragraph 20 of the NOP.

21. Regarding the allegations set forth in Paragraph 21 of the NOP, PASHUN absolutely denies them in their entirety.

22. Regarding the allegations set forth in Paragraph 22 of the NOP, PASHUN absolutely denies them in their entirety.

23. Regarding the allegations set forth in Paragraph 23 of the NOP, PASHUN absolutely denies them in their entirety.

24. Regarding the allegations set forth in Paragraph 24 of the NOP, PASHUN absolutely denies them in their entirety.

25. PASHUN admits the allegations in Paragraph 25 of the NOP.

26. Regarding the allegations set forth in Paragraph 26 of the NOP, PASHUN absolutely denies them in their entirety.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

27. With regard to PASHUN 's prosecution of its **PASHUN LIFESTYLE** trademark (Ser. No. 90/503,209), the U.S. Patent & Trademark Office approved the **PASHUN LIFESTYLE** trademark for publication on October 5, 2021, after the trademark examining attorney found no conflicting marks that would bar registration under Trademark Act Section 2(d).

28. Thus, the U.S. Patent & Trademark Office approved Applicant's **PASHUN LIFESTYLE** trademark over Opposer's **PACSUN** trademark registrations, and thereby determined that it did not conflict with any of Opposer's **PACSUN** trademark registrations. *See 3 McCarthy on Trademarks and Unfair Competition* § 20:13

(5th ed.)("[O]nce the applicant's mark is published, it is presumed that the Examiner is satisfied that the mark meets the criteria of the [Lanham] Act.").

SECOND AFFIRMATIVE DEFENSE

(The Coexistence of Multiple Trademarks Having the Terms PAC and SUN (and variations thereof) for Use with Related Goods to Applicant's Goods Proves that Opposer's marks are Limited in Scope of Protection)

29. Opposer's **PACSUN** trademarks are not entitled to broad protection and are not strong because there are several registered trademarks and third-party unregistered usages using the words PAC and SUN and variations thereof for use with related goods to Applicant's goods. *See 2 McCarthy on Trademarks and Unfair Competition* § 11:88 (5th ed.)("Evidence of third party use of similar marks on similar goods [or services] is admissible and relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection."). As just one example, the mark SUN PAC was registered in class 35 for retail store services featuring storage containers. (U.S. Reg. No. 4,771,367).

30. On information and belief, trademarks using the words PAC and SUN are ubiquitous for use with related goods to those of Applicant's goods in the subject application.

31. On information and belief, there is a "crowded" field of such marks with the words PAC and SUN that are used by many third parties. Each member of this crowd, including Opposer's **PACSUN** trademarks, is "weak" in its ability to prevent use by others in the crowd. *See 2 McCarthy on Trademarks and Unfair Competition* § 11:85 (4th ed.).

32. On information and belief, the third-party usages and registrations with the terms PAC and SUN are owned by various different companies, and the third-party marks and registrations with the terms PAC and SUN are valid, subsisting and co-exist on the Principal Trademark Register and in the marketplace.

33. On information and belief, instead of the common terms PAC and SUN, it is the additional words or variations of wording and/or distinctive logos that distinguishes the source of each of these goods or services from another.

26. On information and belief, Opposer's trademark rights are limited by the rights of third parties using marks that incorporate the terms PAC and SUN.

34. On information and belief, Opposer cannot claim exclusive rights to all variations of marks for use with Applicant's goods or related goods which include the ubiquitous terms PAC and SUN, in view of the indisputable facts that there are extensive and numerous third-party usages and federal trademark registrations that incorporate the terms PAC and SUN in combination with other wording in Opposer's field of products covered in its asserted registrations.

35. On information and belief, since Opposer's PACSUN trademarks are limited in their scope of protection, and since PASHUN 's accused "**PASHUN LIFESTYLE**" mark has a substantially different wording in terms of sound and appearance and overall commercial impression, there can be no likelihood of confusion in this crowded field.

36. On information and belief, Opposer's PACSUN marks are dissimilar in sound, appearance, meaning, and commercial impression from PASHUN 's accused

“PASHUN LIFESTYLE” mark and is therefore not likely to lead to confusion, as defined by Section 2(d) of the Lanham Act.

THIRD AFFIRMATIVE DEFENSE

37. Applicant’s mark is highly dissimilar to Opposer’s asserted marks with respect to sound (pronunciation), appearance, meaning, and overall commercial impression.

FOURTH AFFIRMATIVE DEFENSE

38. Applicant’s Goods are dissimilar and sufficiently unrelated for purposes of determining likelihood of confusion with Opposer’s Goods. In particular, Applicant’s goods of backpacks specially adapted for holding laptops are not included in any of the registrations asserted by Opposer, and Opposer goods are focused on clothing. Opposer does not distribute its goods in the **electronics accessories** field.

FIFTH AFFIRMATIVE DEFENSE

39. Applicant’s intended channels of trade are sufficiently different from Opposer’s channels of trade for purposes of determining likelihood of confusion with Opposer’s marks as used on Opposer’s Goods.

SIXTH AFFIRMATIVE DEFENSE

40. Opposer states that it is the owner of the U.S. Trademark Mark Registration No. 4,537,517 for “PACSUN” filed on October 16, 2013, and registered on May 27, 2014, with first use in commerce dates of at least as early as October 1, 2013, for “eyewear; sunglasses” in Class 9. These goods are wholly unrelated to Applicant’s “backpacks especially adapted for holding laptops”, and there is therefore no likelihood of confusion with respect to the mark and the goods set forth in the ‘517 registration.

SEVENTH AFFIRMATIVE DEFENSE

41. Opposer states that it is the owner of the U.S. Service Mark Registration No. 2,579,269 for “PACSUN.COM” filed on May 7, 1999 and registered on June 11, 2002, with a first use in commerce date of at least as early as June 17, 1999 for “on-line retail store services featuring clothing and sports apparel” in Class 35. These services are wholly unrelated to Applicant’s “backpacks especially adapted for holding laptops”, and there is therefore no likelihood of confusion with respect to the mark and the services set forth in the ‘269 registration.

EIGHT AFFIRMATIVE DEFENSE

42. The Google search method referred to in the Notice of Opposition is an unreliable way to compare the respective marks for confusion purposes, since the

Google algorithm merely attempts to find the nearest comparison - inconsistently and often unsuccessfully. It finds different result based on a user's IP Address, new words being submitted over time any many other factors. Furthermore, the inconsistency is shown as follows: A google search for "Pashun bags" does NOT find results for applicant's mark "Pashun Lifestyle." Second, a google search for "Pacsun bags" also does NOT find results related to the applicant's mark Pashun Lifestyle. Third, a google search for "Pashun Lifestyle bags" does NOT find any results related to the mark "Pacsun." And fourth, a google search for "Pashun Lifestyle backpack" does NOT find any results related to the mark "Pacsun."

NINTH AFFIRMATIVE DEFENSE

Applicant's mark was adopted innocently and with a good faith intent, since it is derived from its owner's name Paul Ashun, and this is how the first word in the mark PASHUN was derived.

Accordingly, in view of the foregoing defenses, Applicant Pashun Products Ltd. requests that the Pacific Sunwear of California LLC's Notice of Opposition be dismissed with prejudice, and that the subject **PASHUN LIFESTYLE** mark be allowed to proceed to registration, and that such other relief be granted as may deemed appropriate.

Respectfully submitted,

Sutton IP Associates, PA

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Dated: January 5, 2022

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Answer and Affirmative Defenses to Notice of Opposition is being filed electronically via the Electronic System for Trademark Trials and Appeals (ESTTA) this 5th day of January 2022, which will effect service on Opposer's counsel of record, with a courtesy copy sent by electronic mail to:

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