

ESTTA Tracking number: **ESTTA1244860**

Filing date: **10/31/2022**

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	Saucony IP Holdings LLC
Granted to date of previous extension	11/02/2022
Address	500 TOTTEN POND ROAD WALTHAM, MA 02451 UNITED STATES
Attorney information	BRIAN D. WASSOM WARNER NORCROSS + JUDD LLP 45000 RIVER RIDGE DR., STE. 300 CLINTON TWP, MI 48038 UNITED STATES Primary email: bwassom@wnj.com Secondary email(s): dkeilch@wnj.com 5863034139
Docket no.	

Applicant information

Application no.	97027110	Publication date	07/05/2022
Opposition filing date	10/31/2022	Opposition period ends	11/02/2022
Applicant	GARAN SERVICES CORP. 4TH FLOOR 200 MADISON AVENUE NEW YORK, NY 10016 UNITED STATES		


Goods/services affected by opposition

Class 025. First Use: None First Use In Commerce: None
All goods and services in the class are opposed, namely: Footwear; Headwear; Hosiery; Sleepwear; Bottoms as clothing; Tops as clothing


Grounds for opposition

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

Marks cited by opposer as basis for opposition

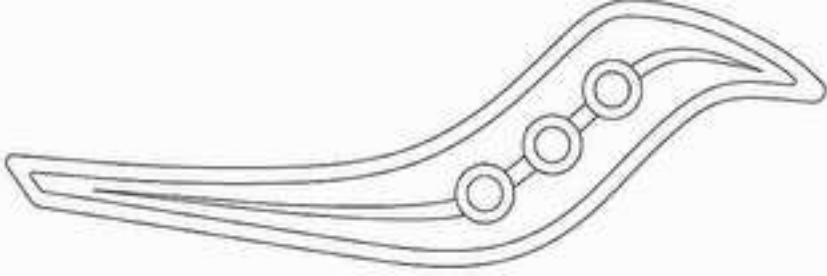
U.S. registration no.	2064602	Application date	11/03/1995
Register	Principal		
Registration date	05/27/1997	Foreign priority date	NONE
Word mark	SAUCONY		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Jan 1, 1995 First Use In Commerce: Jun 30, 1995 house mark for athletic clothing		

U.S. registration no.	3824275	Application date	11/11/2009
Register	Principal		
Registration date	07/27/2010	Foreign priority date	NONE
Word mark	NONE		
Design mark			
Description of mark	The mark consists of an elongated S-shape with an extending bottom tail, three circles on the midsection, and a short top portion.		
Goods/services	Class 025. First use: First Use: 1996 First Use In Commerce: 1996 footwear, shirts [shorts,] and pants [tights, jackets, vests, bras, hats, gloves, socks, headbands, visors, neckwarmers, mittens, and pullovers]		

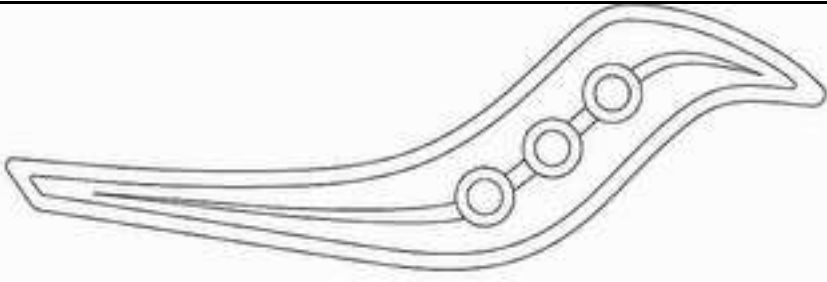
U.S. registration no.	3824276	Application date	11/11/2009
Register	Principal		
Registration date	07/27/2010	Foreign priority date	NONE
Word mark	SAUCONY		
Design mark			
Description of mark	The mark consists of the wording "SAUCONY" with a design element featuring an elongated S-shape with an extending bottom tail, three circles on the midsection, and a short top portion		
Goods/services	Class 025. First use: First Use: 2008 First Use In Commerce: 2008		

	footwear, shirts, [shorts,] pants, tights, jackets, vests, bras, hats, [gloves, socks, headbands, visors,] [neckwarmers,] [mittens,] and pullovers		
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U.S. registration no.	3095051	Application date	10/20/2004
Register	Principal		
Registration date	05/23/2006	Foreign priority date	NONE
Word mark	NONE		
Design mark			
Description of mark	NONE		
Goods/services	Class 018. First use: First Use: Jan 1, 1995 First Use In Commerce: Jan 1, 1995 [Athletic bags, duffel bags, gym bags,shoulder bags] Class 025. First use: First Use: Jan 1, 1995 First Use In Commerce: Jan 1, 1995 Footwear [, shorts, shirts, tank tops, socks, hats, gloves, mittens, pants, jackets, swimwear, swim caps, sweatbands, legwarmers, arm warmers, cycle booties, toe covers, headbands, vests, singlets, tights, athletic brassieres, house mark for athletic clothing]		

U.S. registration no.	4739691	Application date	09/24/2012
Register	Principal		
Registration date	05/19/2015	Foreign priority date	NONE
Word mark	NONE		
Design mark			
Description of mark	The mark consists of an elongated "S"-shape with an extending bottom tail and a short top portion, outlined by double lines, along with three circles on the mid-section with double lines extending to the top and bottom portion.		
Goods/services	Class 025. First use: First Use: Feb 1, 2014 First Use In Commerce: Feb 1, 2014 Footwear		

U.S. registration no.	4724176	Application date	09/24/2012
Register	Principal		
Registration date	04/21/2015	Foreign priority date	NONE
Word mark	NONE		

Design mark	
Description of mark	The mark consists of an elongated "S"-shape with an extending bottom tail and a short top portion, outlined by double lines, along with three circles on the mid-section with double lines extending to the top and bottom portions.
Goods/services	Class 025. First use: First Use: Feb 1, 2014 First Use In Commerce: Feb 1, 2014 shirts, shorts, pants, tights, jackets, vests, bras, hats, gloves, headbands, visors, [neckwarmers,] mittens, and pullovers

U.S. application no.	97258879	Application date	02/09/2022
Registration date	NONE	Foreign priority date	NONE
Word mark	S		
Design mark			
Description of mark	The mark consists of an elongated S-shape with an extending bottom tail, three circles on the midsection, and a short top portion.		
Goods/services	<p>Class 009. First use: First Use: None First Use In Commerce: None Downloadable virtual goods, namely, computer programs featuring footwear, apparel, bags, backpacks, eyewear, sports equipment, and accessories for use in online virtual worlds; Downloadable virtual goods, namely, digital representations of footwear, apparel, bags, backpacks, eyewear, sports equipment, and accessories for use online and in online virtual worlds</p> <p>Class 035. First use: First Use: None First Use In Commerce: None Retail store services featuring virtual merchandise, namely, footwear, apparel, bags, backpacks, eyewear, sports equipment, and accessories for use online; online retail store services featuring virtual merchandise, namely, footwear, apparel, bags, backpacks, eyewear, sports equipment, and accessories</p> <p>Class 041. First use: First Use: None First Use In Commerce: None Entertainment services, namely, providing on-line, non-downloadable virtual footwear, apparel, bags, backpacks, eyewear, sports equipment, and accessories for use in virtual environments created for entertainment purposes</p>		

Attachments	75014474#TMSN.png(bytes) 77870486#TMSN.png(bytes) 85982270#TMSN.png(bytes) 85736611#TMSN.png(bytes) Wolverine - Garanimals Design - Notice of Opposition.pdf(277697 bytes)
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Signature	/Brian D. Wassom/
Name	BRIAN D. WASSOM
Date	10/31/2022

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

SAUCONY IP HOLDINGS LLC.,

Opposition No.:

Opposer,

Mark:



v.

GARAN SERVICES CORP.,


Serial Nos. 97027110, 97311226

Respondent.

NOTICE OF OPPOSITION

Opposer Saucony IP Holdings LLC (“Opposer”), by its attorneys Warner Norcross + Judd LLP, for its Notice of Opposition against Respondent Garan Services Corp. (“Applicant”), alleges as follows:

Parties

1. Opposer is a Delaware limited liability company with an address at 500 Totten Pond Road, Waltham, Massachusetts 02451.
2. Applicant is a Delaware corporation with an address at 200 Madison Avenue, 4th Floor, New York, New York 10016.
3. Opposer believes that it will be damaged by registration of the mark  (“Applicant’s Mark”). Therefore, pursuant to Lanham Act §13(a), 15 U.S.C. § 1063(a), Opposer has standing to oppose Applicant’s Application Nos. 97027110 and 97311226 (the “Applications”).

Opposer and Its Well-Known River Design and New River Design Trademarks



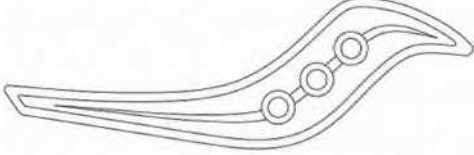
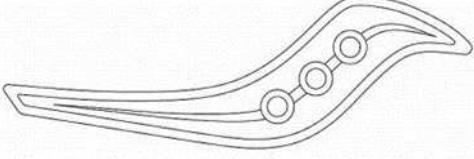

4. Founded in 1898, Saucony is an American designer, manufacturer, and marketer of high performance athletic footwear and apparel for men and women. Saucony has achieved significant commercial success and has become one of the most well-renowned athletic outfitters in the industry.

5. Opposer adopted and first used its River Design mark in connection with footwear and apparel at least as early as 1995. Since that time, Opposer has continuously used the River Design and, later, the New River Design marks in commerce. These marks are shown below:



6. On the strength of this strong consumer recognition, Opposer has obtained the following U.S. Registrations for the River Design Marks:

U.S. Reg. No.	Mark	Goods
2064602		IC 25: house mark for athletic clothing
3824275		IC 25: footwear, shirts, and pants

3824276		IC 25: footwear, shirts, pants, tights, jackets, vests, bras, hats, and pullovers.
3095051		IC 25: Footwear
4739691		IC 25: Footwear
4724176		IC 25: shirts, shorts, pants, tights, jackets, vests, bras, hats, gloves, headbands, visors, mittens, and pullovers.
App. No. 97258879		Various goods and services in IC 9, 35, and 41

7. Several of these registrations are incontestable. Collectively, all of the foregoing registrations and related common law rights in these marks used by Opposer, its affiliates, and its licensees, will be referred to herein as “Opposer’s Marks,” and the goods and services provided in connection therewith by Opposer, its affiliates, and/or its licensees (the goodwill in which all accrues to Opposer’s benefit) are “Opposer’s Goods and Services.”

8. Opposer’s Goods and Services provided under Opposer’s Marks have been extensively and continuously sold, marketed, advertised and promoted throughout the United States. As a result of the quality of Opposer’s Goods and Services and the widespread promotion thereof under Opposer’s Marks, the goods have met with great commercial success and widespread consumer and media recognition. In addition, Opposer’s Marks have become symbols of Opposer

and its related companies. Opposer's Goods and Services, and Opposer's goodwill, had come to be associated with Opposer prior to any use in commerce by Applicant.

Applicant and Its Applications to Register 

9. Applicant's Applications, filed Sep. 14, 2021 and Mar. 14, 2022, seek to register Applicant's Mark for use with goods described as "*Footwear; Headwear; Hosiery; Sleepwear; Bottoms as clothing; Tops as clothing*" and "*Baby bibs not of paper; Shoes for babies and children; robes,*" both in International Class 25 ("Applicant's Goods").

10. Applicant has filed its Applications under Section 1(b) of the Lanham Act, and therefore has not claimed use anywhere or in commerce.

Likelihood of Confusion, 15 U.S.C. §1052(d)

11. Opposer incorporates herein by reference each of the foregoing paragraphs.

12. Opposer has priority based on its valid and subsisting registrations for Opposer's Marks and based on its prior and continuous use of Opposer's Marks in commerce in connection with Opposer's Goods and Services long before the filing date of the opposed Applications and before any use in commerce alleged by Applicant.

13. Applicant's Mark is highly similar to Opposer's Marks in appearance and commercial impression. Both consist of the same basic shape—a curved parallelogram that tapers into narrower points on both ends, and that features multiple circles within the broader, center portion of the design. Viewed at a glance, as the marks are likely to be encountered in commerce, they would be virtually indistinguishable to the average consumer. Therefore, the parties' respective marks are materially identical in both appearance and commercial impression.

14. Applicant's Goods, as described in its Applications, are materially identical to Opposer's Goods and Services. They include "footwear" and "shoes"—Opposer's principal

goods—as well as closely related clothing items, all of which are materially identical to the goods offered by Opposer.

15. Opposer’s Marks are or have been used in a wide variety of mainstream channels of trade, and are marketed generally across virtually all ages and demographic lines. Consumers of Opposer’s Goods and Services are likely to be among those who may purchase or see advertisements for Applicant’s Goods, and Applicant’s Applications do not place any limits on the consumers to whom Applicant’s Goods are marketed or provided.

16. Applicant’s Goods, customers, and marketing channels so closely overlap with Opposer’s Goods and Services as to be highly likely to cause confusion or mistake, or to deceive consumers under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. §1052(d).

WHEREFORE, Opposer prays that Application Serial Nos. 97027110 and 97311226 be refused registration, that no registration be issued thereon to Applicant and that this opposition be sustained in favor of Opposer.

A filing fee for the Notice of Opposition in the appropriate amount is being submitted herewith via electronic funds transfer.

Respectfully submitted,

Date: October 31, 2022

By: Brian D. Wassom
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CERTIFICATE OF TRANSMITTAL

I hereby certify that on October 31, 2022, this correspondence is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA).

/Denise Keilch/