

ESTTA Tracking number: **ESTTA1318946**
Filing date: **10/30/2023**

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 | Genesco Brands LLC |
| Granted to date of previous extension | 10/29/2023 |
| Address | 300 DELAWARE AVE., 9TH FLOOR WILMINGTON, DE 19801 UNITED STATES |
| Attorney information | TYWANDA HARRIS LORD KILPATRICK TOWNSEND & STOCKTON LLP 1100 PEACHTREE STREET NE, SUITE 2800 ATLANTA, GA 30309 UNITED STATES Primary email: tlord@ktslaw.com Secondary email(s): tbillups@ktslaw.com, kteilhaber@ktslaw.com, tmadmin@ktslaw.com, spdesai@ktslaw.com 4048156500 |
| Docket no. | |

Applicant information

| | | | |
|------------------------|---|------------------------|------------|
| Application no. | 97338936 | Publication date | 05/02/2023 |
| Opposition filing date | 10/30/2023 | Opposition period ends | 10/29/2023 |
| Applicant | CHALK WARRIOR, LLC 1932 OAKLEIGH WAY KNOXVILLE, TN 37919 UNITED STATES | | |

Goods/services affected by opposition

Class 025. First Use: Nov 29, 2020 First Use In Commerce: Nov 29, 2020
All goods and services in the class are opposed, namely: Athletic apparel, namely, leotards, hooded sweatshirts, sweatpants, leggings, shirts

Grounds for opposition

| | |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
|--------------------------------------|----------------------------|

Marks cited by opposer as basis for opposition

| | | | |
|-----------------------|-----------|------------------|------------|
| U.S. registration no. | 2054259 | Application date | 10/24/1995 |
| Register | Principal | | |


| | | | |
|---------------------|--|-----------------------|------|
| Registration date | 04/22/1997 | Foreign priority date | NONE |
| Word mark | NONE | | |
| Design mark | | | |
| Description of mark | NONE | | |
| Goods/services | Class 025. First use: First Use: Dec 31, 1987 First Use In Commerce: Dec 31, 1987 shoes and clothing, namely, shirts, T-shirts, sweatshirts, jackets, [pants, shorts,] socks and hats | | |

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. registration no. | 3232063 | Application date | 04/10/2001 |
| Register | Principal | | |
| Registration date | 04/24/2007 | Foreign priority date | NONE |
| Word mark | NONE | | |
| Design mark | | | |
| Description of mark | NONE | | |
| Goods/services | Class 035. First use: First Use: Dec 31, 1987 First Use In Commerce: Dec 31, 1987 retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories | | |

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|-------------|---|
| Attachments | 2023.10.30 Notice of Opposition_97338936.pdf(127884 bytes) |
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| | |
|-----------|----------------|
| Signature | /Shreya Desai/ |
| Name | Shreya Desai |
| Date | 10/30/2023 |

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

| | | |
|----------------------|---|--|
| GENESCO BRANDS, LLC, |) | |
| |) | Serial No.: 97/338,936 |
| Opposer, |) | Mark: |
| |) |  |
| v. |) | |
| |) | Opposition No. _____ |
| |) | |
| CHALK WARRIOR, LLC, |) | |
| |) | |
| Applicant. |) | |

NOTICE OF OPPOSITION

Opposer Genesco Brands, LLC (“Opposer”) believes it will be damaged by registration to Applicant Chalk Warrior, LLC (“Applicant”) of the handprint design mark that is the subject of application Serial No. 97/338,936 (the “Application”), and opposes the same pursuant to 15 U.S.C. § 1063 and 37 C.F.R. §§ 2.101 and 2.104. The Application was filed on March 30, 2022, and first published for opposition in the *Official Gazette* on May 2, 2023. Opposer timely filed an extension of time to oppose the Application, and the effective deadline to oppose the Application is October 30, 2023. The grounds for this opposition are as follows:

1. Opposer is the owner and licensor of the trademark JOURNEYS, alone and in conjunction with other words and designs, used in connection with a well-known chain of over seven hundred JOURNEYS and JOURNEYS KIDZ retail stores (the “JOURNEYS stores”) located in major shopping malls throughout the United States, which are owned and operated by Opposer’s predecessor and exclusive licensee, Genesco Inc. (Opposer, Genesco Inc., and their predecessors are collectively referred to as “Genesco”). The JOURNEYS stores sell a wide range of footwear, clothing, fashion accessories, novelties, bags, backpacks, and other goods in

connection with the design mark depicted below (the “Handprint Design Mark”), which is owned by Genesco.



2. The JOURNEYS stores and virtually all advertising for JOURNEYS stores prominently feature the Handprint Design Mark, and the Handprint Design Mark is used on point of purchase materials in connection with clothing, footwear, accessories, bags, novelties, and other products sold in those stores.

3. Genesco has validly and continuously used its Handprint Design Mark in commerce in connection with the advertising, promotion, distribution, and sale of footwear, clothing, and other goods, as well as retail store services, since at least as early as December 31, 1987. By virtue of its use of the Handprint Design Mark, Genesco owns strong common law rights in the design.

4. Genesco also owns federal Registration No. 2,054,259 of its Handprint Design Mark for “shoes and clothing, namely, shirts, T-shirts, sweatshirts, jackets, socks, and hats” in International Class 25. In addition, Genesco owns federal Registration No. 3,232,063 of its Handprint Design mark for “retail store services in the fields of footwear, apparel, backpacks, sports bags, jewelry and fashion accessories” in International Class 35. Registrations Nos. 2,054,259 and 3,232,063 of the Handprint Design are valid and subsisting. Affidavits have been filed and accepted pursuant to Section 15 of the Lanham Act, rendering these registrations incontestable.

5. By virtue of the continuous and extensive advertising of the Handprint Design Mark in connection with Genesco’s retail stores and the products sold therein, and of the extensive sales

under the mark for over 30 years, Genesco’s Handprint Design Mark is widely and favorably known by the public throughout the United States.

6. Genesco’s Handprint Design Mark is symbolic of the substantial goodwill and consumer recognition established by Genesco as a result of the outstanding quality and extensive sales of products through its retail stores throughout the United States for many years. Genesco has expended large amounts of money, time, and effort in advertising and promoting such goods and services under the Handprint Design Mark. By reason of Genesco’s extensive use and advertising of the Handprint Design Mark and resulting favorable public recognition, the Handprint Design Mark uniquely identifies Genesco and its retail stores and related products and services to the public. As such, Genesco has acquired extensive common law rights in the Handprint Design Mark in connection with its retail store services and with footwear, clothing, and other goods.

7. On March 30, 2022, Applicant filed application Serial No. 97/338,936 for the handprint design mark depicted below (“Applicant’s Mark”) for use in connection with, *inter alia*, “Athletic apparel, namely, leotards, hooded sweatshirts, sweatpants, leggings, shirts” in International Class 25.



8. Genesco continuously has used its Handprint Design Mark since long before the Applicant’s actual or constructive first use date.

9. Applicant’s Mark prominently incorporates a handprint design that is virtually identical in appearance and commercial impression to Genesco’s Handprint Design Mark.

10. Applicant's Mark is proposed to be used in connection with goods in International Class 25 that are identical and/or highly related to the goods and services Genesco offers under its Handprint Design Mark.

11. Genesco will be damaged by the registration of Applicant's Mark in International Class 25 because the mark so resembles Genesco's previously used Handprint Design Mark as to be likely to cause consumer confusion, mistake, and deception in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Consumers familiar with Genesco's Handprint Design Mark would be likely, erroneously, to believe that Applicant's goods are those of Genesco or are endorsed, sponsored, or licensed by Genesco. Thus, registration of Applicant's Mark on the Principal Register would be inconsistent with Genesco's rights in its Handprint Design Mark.

Opposer Genesco Brands, LLC therefore requests that application Serial No. 97/338,936 be refused registration.

The required opposition fee for opposing Applicant's Mark in connection with International Class 25 is being electronically processed in connection with this Notice of Opposition. The Director is authorized to debit Kilpatrick Townsend & Stockton's Trademark Deposit Account No. 20-1430 for any deficiency in the required fee.

Date: October 30, 2023

Respectfully Submitted,

/Shreya Desai/
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