

ESTTA Tracking number: **ESTTA1373564**
Filing date: **07/26/2024**

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	US PONY HOLDINGS, LLC
Granted to date of previous extension	07/27/2024
Address	1450 BROADWAY 3RD FLOOR NEW YORK, NY 10018 UNITED STATES
Attorney information	EDMUND J. FERDINAND, III MEISTER SEELIG & FEIN PLLC 125 PARK AVENUE 7TH FLOOR NEW YORK, NY 10017 UNITED STATES Primary email: jed@msf-law.com Secondary email(s): ls@msf-law.com, gnm@msf-law.com 212-655-3564
Docket no.	IBG057USL

Applicant information

Application no.	98110189	Publication date	05/28/2024
Opposition filing date	07/26/2024	Opposition period ends	07/27/2024
Applicant	SHAOXING YIXIA EMBROIDERY CO., LTD. 2F, BLDG 6, KEYAN INDUSTRIAL PARK JINGSHUI RD, KEYAN ST, KEQIAO DIST SHAOXING, ZHEJIANG, 312000 CHINA		


Goods/services affected by opposition


Class 024. First Use: None First Use In Commerce: None
All goods and services in the class are opposed, namely: Bed sheets; Cloths for removing make-up; Coasters of textile; Curtains of textile or plastic; Face towels of textile; Handkerchiefs of textile; Household linen; Picnic blankets; Pillow covers; Place mats of textile; Shower curtains of textile or plastic; Table cloths not of paper; Tablemats of textile; Tea towels; Unfitted fabric furniture covers; Upholstery fabrics; Unfitted coverings of plastic for furniture; Unfitted furniture covers not of paper


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.	2666380	Application date	03/01/2002
Register	Principal		
Registration date	12/24/2002	Foreign priority date	NONE
Word mark	PONY		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: 1973 First Use In Commerce: 1973 shirts, t-shirts, [tank tops,] jerseys, sweatshirts, sweatpants, hooded pullovers, [shorts, pants, caps, hats, visors, headbands, wristbands,] jackets, athletic and casual footwear		

U.S. registration no.	2666379	Application date	03/01/2002
Register	Principal		
Registration date	12/24/2002	Foreign priority date	NONE
Word mark	PONY		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: 1973 First Use In Commerce: 1973 shirts, t-shirts, [tank tops, jerseys,] sweatshirts, sweatpants, hooded pullovers, [shorts, pants, caps, hats, visors, headbands, wristbands,] jackets, athletic and casual footwear		

U.S. registration no.	1040116	Application date	01/16/1974
Register	Principal		
Registration date	05/25/1976	Foreign priority date	NONE
Word mark	PONY		
Design mark			
Description of mark	NONE		
Goods/services	Class 018. First use: First Use: Sep 1973 First Use In Commerce: Nov 1973 [TOTE BAGS] Class 025. First use: First Use: Jan 1973 First Use In Commerce: May 1973		

	WEARING APPAREL-NAMELY, [TRACK SUITS, T-SHIRTS AND] SPORTS FOOTWEAR
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U.S. registration no.	2668890	Application date	03/01/2002
Register	Principal		
Registration date	12/31/2002	Foreign priority date	NONE
Word mark	PONY		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: 1978 First Use In Commerce: 1978 shirts, t-shirts, [tank tops, jerseys,] sweatshirts, sweatpants, hooded pullovers, [shorts,] pants, [caps, hats, visors, headbands, wristbands,] jackets, athletic and casual footwear		

Attachments	76376982#TMSN.png(bytes) 76376980#TMSN.png(bytes) 73011177#TMSN.png(bytes) 76377048#TMSN.png(bytes) Notice of Opposition Ap. 98110189 Final.pdf(227260 bytes)
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Signature	/gnm/
Name	Grace N. Monroy
Date	07/26/2024

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 98/110,189

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US PONY HOLDINGS, LLC, : Opposition No. _____
: :
Opposer, : :
: :
v. : :
: :
SHAOXING YIXIA : :
EMBROIDERY CO., LTD. : :
Applicant. : :
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NOTICE OF OPPOSITION




Opposer, US Pony Holdings, LLC, a Delaware limited liability company, having a business address at 1450 Broadway, 3rd Floor New York, New York 10018 (“Opposer”), believes that it will be damaged by the registration of the P PONYSHOES Design Mark, subject of U.S. Trademark Application Serial No. 98/110,189, which was filed on July 31, 2023 on a 1(b) intent to use basis, and hereby opposes registration of said mark for the goods identified in Int.’l Class 24.

As grounds for the Notice of Opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title and interest in the family of trademarks for the famous brand Pony. Opposer’s predecessor adopted and began using the mark PONY and stylized designs thereof (the “PONY Marks”), in interstate commerce in 1973, and Opposer and its predecessors have used the mark widely and continuously in U.S. commerce since that time.

2. Since its founding in New York City in 1972 by Roberto Muller, the Pony brand and PONY Marks have been known for their sporty and street-savvy designs. Pony, which stands for “Product of New York,” quickly gained popularity in the 1970s and 1980s, particularly among professional athletes and urban youth, and remains popular to this day particularly for its distinctive chevron logo and classic sneaker styles. Today, the Pony brand and PONY Marks maintain a strong international presence in urban fashion, appealing to streetwear enthusiasts and athletes alike.

3. Opposer owns several valid and subsisting U.S. Federal Trademark Registrations for the PONY Marks, including the literal mark PONY and related stylized designs for clothing, footwear, and other related goods (“PONY Registrations”):

Mark	Registration Number	Class
PONY	2666380	IC 25: shirts, t-shirts, [tank tops,] jerseys, sweatshirts, sweatpants, hooded pullovers, [shorts, pants, caps, hats, visors, headbands, wristbands,] jackets, athletic and casual footwear
	2666379	IC 25: shirts, t-shirts, [tank tops, jerseys,] sweatshirts, sweatpants, hooded pullovers, [shorts, pants, caps, hats, visors, headbands, wristbands,] jackets, athletic and casual footwear
	1040116	IC 25: WEARING APPAREL- NAMELY, [TRACK SUITS, T-SHIRTS AND] SPORTS FOOTWEAR
	2668890	IC 25: shirts, t-shirts, [tank tops, jerseys,] sweatshirts, sweatpants, hooded pullovers, [shorts,] pants, [caps, hats, visors, headbands, wristbands,] jackets, athletic and casual footwear

4. Opposer's PONY Registrations constitute prima facie evidence of the validity of the Registered Marks and of the registrations thereof, and of Opposer's ownership of the PONY Marks therein. Opposer's PONY Registrations also constitute notice to Applicant of its claim of ownership of the marks shown therein as provided in Sections 7(b), 22 and 33(a) of the Trademark Act.
5. For nearly (fifty) 50 years, Opposer and its predecessors have been using the PONY Marks in connection with the international marketing, promotion, and sale of its goods, namely clothing, shoes, and accessories. Such goods bearing the PONY Marks have been widely and continuously sold at specialty and sporting retail stores, large department stores, online marketplaces and at its dedicated e-commerce page www.pony.com.
6. As a result of Opposer's longstanding use of the PONY Marks in the United States, the public and the trade have come to recognize the PONY Marks as exclusively identifying high quality products emanating from a single source of origin. Through extensive marketing, promotion, and sales the PONY Marks have gained secondary meaning, extensive marketplace goodwill, and a high degree of distinctiveness. As a result, Opposer has and will also assert its common law rights resulting from its ownership and use of its PONY Registrations and PONY Marks therein. Such rights include various prior trademarks uses, which uses have not been abandoned and which have been valid and continuous since a date prior to any alleged first use Applicant can claim.
7. On July 31, 2023, Applicant filed Application Serial No. 98/110,189 seeking to register the P PONYSHOES Design Mark:



(“Applicant’s Mark”) for goods in Int.’1 Class 24 for “Bed sheets; Cloths for removing make-up; Coasters of textile; Curtains of textile or plastic; Face towels of textile; Handkerchiefs of textile; Household linen; Picnic blankets; Pillow covers; Place mats of textile; Shower curtains of textile or plastic; Table cloths not of paper; Tablemats of textile; Tea towels; Unfitted fabric furniture covers; Upholstery fabrics; Unfitted coverings of plastic for furniture; Unfitted furniture covers not of paper”, on an intent to use 1(b) basis. (the “‘189 Application”). Upon information and belief, Applicant has not yet begun using Applicant’s Mark, subject of the ‘189 Application in commerce.

8. Opposer has prior and superior rights as against Applicant in this Opposition, as Opposer has registered and used its PONY Marks in the United States long prior to any first use date Applicant can claim.
9. Opposer has acquired a valuable reputation and extensive goodwill in its PONY Marks by reason of its long use, marketing and promotion, and sale of goods and services in association therewith.
10. The PONY Marks are well-known and recognized as identifying quality products, namely shoes, clothing, accessories, and related goods which have their origin with or have been authorized exclusively by Opposer.
11. Applicant’s Mark is confusingly similar to Opposer’s PONY Marks in sight and commercial impression. The literal element of Applicant’s Mark—P PONYSHOES—fully incorporates Opposer’s PONY Marks.

12. The “P” element in Applicant’s mark does not sufficiently distinguish Applicant’s Mark from Opposer’s PONY Marks, as the term “pony” is the dominate feature of both parties’ marks, and thus the commercial impression of both parties’ marks is the same.
13. What is more, the literal element of Applicant’s Mark, P PONYSHOES references the main category of goods Opposer is known for—shoes. It is therefore immaterial whether the applied for goods of the ‘189 Application are related to home furnishings, because consumers that see PONYSHOES in connection with any goods, will automatically think such goods originate with or are authorized by Opposer. Nonetheless, the category of Applicant’s applied for goods are within the natural zone of expansion for which Opposer may enter.

GROUND FOR RELIEF
LIKELIHOOD OF CONFUSION – 15 U.S.C. 1052(d)

14. Opposer realleges each and every allegation set forth in paragraphs 1 through 13 herein.
15. Applicant’s Mark so resembles Opposer’s PONY Registrations and the PONY Marks therein, when used on or in connection with the applied for goods of Applicant, as to be likely to cause confusion, or to cause mistake, or to deceive.
16. Opposer will be damaged by registration of the ‘189 Application in Class 24 in that Applicant’s Mark so resembles Opposer’s PONY Registrations and the PONY Marks therein, and in which Opposer owns common law trademark rights, as to be likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) when used on or in connection with the services as they are identified in the Application.

WHEREFORE, Opposer prays that its opposition to the registration of U.S. Trademark Application Serial No. 98/110,189 for the P PONYSHOES Mark be sustained and that Applicant's Mark be refused registration, and for such further relief that the Board deems just and proper.

Dated: July 26, 2024

Respectfully submitted,

FERDINAND IP LAW GROUP

/s/ Edmund J. Ferdinand, III

Edmund J. Ferdinand, III

Grace Monroy

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