

ESTTA Tracking number: **ESTTA67371**

Filing date: **02/21/2006**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Nike, Inc.		
Entity	Corporation	Citizenship	Oregon
Address	One Bowerman Drive Beaverton, OR 97005 UNITED STATES		

Attorney information	Michelle L. Mehok PILLSBURY WINTHROP SHAW PITTMAN LLP 11682 El Camino Real, Suite 200 San Diego, CA 92130 UNITED STATES sdipdocket@pillsburylaw.com
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Registration Subject to Cancellation

Registration No	2431714	Registration date	02/27/2001
Registrant	SURF TECHNICIANS, INC. 5960 "E" Soquel Avenue Santa Cruz, CA 95062 UNITED STATES		
Goods/Services Subject to Cancellation	Class 028. First Use: 1999/08/01 , First Use In Commerce: 1999/08/01 Goods/Services: Surfboards and sailboards		

Related Proceedings	ESTTA67325
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Attachments	S_Petition_For_Cancellation.pdf (9 pages)
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Signature	/michelle mehok/
Name	Michelle L. Mehok
Date	02/21/2006

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

NIKE, INC.,)	CANCELLATION NO.
)	
Petitioner,)	<u>PETITION FOR CANCELLATION</u>
)	
vs.)	
)	TRADEMARK: S and Design
Surf Technicians, Inc.)	Registration Number 2431714
)	Registration Date: February 27, 2001
Respondent.)	
)	

Petitioner, Nike, Inc., an Oregon corporation with an address at One Bowerman Drive, Beaverton, Oregon 97005, believes that it is or will be damaged by Registration No. 2,431,714 for the mark **S and Design**, shown thus:



(Respondent's Mark), which Petitioner believes is currently owned by Respondent, Surf Technicians, Inc., 5960 "E" Soquel Avenue, Santa Cruz, California 95062, and hereby petitions to cancel the registration.

As grounds for cancellation, Petitioner, by its attorneys, avers as follows:

1. On February 27, 2001, the United States Patent and Trademark Office issued Registration No. 2,431,714 to Respondent. Information about this registration is submitted herewith as Exhibit A.

2. Petitioner owns and uses in commerce the device shown thus:


















(the “Swoosh Mark”) for a wide variety of sports related goods and services.












3. Petitioner’s use and registration of its Swoosh Mark is or will be impaired by continued registration of Registrant’s Mark.








4. Petitioner is or will be damaged by continuance of the registration in that Petitioner is using the mark **S and Design** for surfboards and sailboards.









5. Opposer owns the following Patent and Trademark Office registrations consisting of or including the Swoosh Mark:

Mark	Reg. /Appl. No. Reg. Date	Class	Goods
DESIGN ONLY 	2863049 7/13/2004	9 14	eyeglasses and eyeglass frames; computer software in the field of health and fitness used to store and organize digital music, create custom cds, download digital music from the internet, build and transfer play lists, categorize music by tempo, log fitness data, namely, times, paces, heart rate and injuries, create workout schedules and goals, download data from a watch to a computer; digital audio equipment, namely portable digital music players and walkie talkies radio link watches which contain a radio frequency transmitter, receiver and/or transceiver used to monitor heart rate, speed and distance
DESIGN ONLY 	2237852 4/6/1999	9 14	sunglasses and sunglass frames watches
DESIGN ONLY 	2107521 10/21/1997	9	eyewear, namely, sunglasses and parts and accessories for eyewear, namely, cases for eyewear
NIKE & Design 	2239076 4/13/1999	9 28	ear plugs for swimming purposes nose clips for swimming purposes, swim goggles, kickboards and buoys for recreational and training use
DESIGN ONLY 	2490994 9/18/2001	14 41	jewelry entertainment services in the nature of sporting events of all types, namely,

			contests, clinics, camps, tournaments and exhibitions
NIKE & Design 	2209815 12/8/1998	14	timepieces of all types, namely, watches and chronographs
NIKE & Design 	2534358 1/29/2002	14	timepieces of all types, namely, stopwatches
DESIGN ONLY 	1926168 10/10/1995	16 18	binders, student planners, notebooks, portfolio covers pouches for carrying school materials
NIKE & Design 	1866140 12/6/1994	16 18	binders, student planners, notebooks, portfolio covers bookbags; pouches for carrying school materials
NIKE & Design 	1595356 5/8/1990	16	posters
ACG & Design 	2164358 6/9/1998	18 25	backpacks and waist packs footwear; clothing, namely, anoraks, caps, gloves, jackets, pants, parkas, shirts, shorts, socks, tops, T-shirts and vests.
DESIGN ONLY 	1145473 1/6/1981	18	all purpose sports bags, travel bags, hand bags and shoulder bags
NIKE & Design 	1772987 5/25/1993	18	all-purpose sports bags, waist packs, backpacks, fannypacks and duffie bags
AIR & DESIGN  A I R	2068075 6/3/1997	25	footwear and clothing, namely caps, socks and sweatshirts
AIR & DESIGN  A I R	2203050 11/10/1998	25	clothing, namely, hats and T-shirts

DESIGN ONLY 	1323342 3/5/1985	25	footwear
DESIGN ONLY 	0977190 1/22/1974	25 25	athletic shoes with spikes and athletic uniforms for use with such shoes. athletic shoes without spikes and athletic uniforms for use with such shoes
DESIGN ONLY 	1990180 7/30/1996	25	full line of sports clothing
DESIGN ONLY 	1323343 3/5/1985	25	footwear
DESIGN ONLY 	1284385 7/3/1984	25	athletic and casual clothing for men, women and children-namely, shirts, pants, shorts, jackets, warm-up suits, swimwear, tenniswear, skirts, sweaters, underwear, headwear, socks and wristbands
NIKE & Design 	2024717 12/17/1996	25	clothing, namely, caps and T-shirts
NIKE & Design 	2104329 10/7/1997	25	footwear
NIKE & Design 	2180866 8/11/1998	25	clothing, namely, hats, jackets, shirts and warm-up suits
NIKE & Design 	1325938 3/19/1985	25	footwear
NIKE & Design 	1237469 5/10/1983	25	athletic and casual clothing for men, women and children-namely, shirts, pants, shorts, jackets, warm-up suits, swimwear, tenniswear, skirts, sweaters, underwear, headwear, socks, wristbands and handwear
NIKE AIR & Design 	1571066 12/12/1989	25	clothing, namely T-shirts

<p>NIKE AIR & Design</p> 	<p>1284386 7/3/1984</p>	25	footwear
<p>DESIGN ONLY</p> 	<p>2954673 5/24/2005</p>	27 19	<p>Artificial surfaces and underlayments, namely, artificial grass, turf, and mats made of foam, rubber, nylon, leather, cotton, plastic, or polyethylene for indoor and outdoor sports and recreational surfaces</p> <p>Flooring underlayments for indoor and outdoor sports and recreational surfaces with cushioning and padding</p>
<p>NIKE GRIND & DESIGN</p> 	<p>2480935 8/21/2001</p>	27	<p>surfaces and underlayments, namely, artificial grass, turf and mats for indoor and outdoor sports and recreational surfaces; and cushioning and padding used as underlayments for indoor and outdoor sports and recreational surfaces</p>
<p>AIR & DESIGN</p> 	<p>2601303 7/30/2002</p>	28	<p>protective padding and body protectors for the practice of sports and gloves for the practice of sports</p>
<p>DESIGN ONLY</p> 	<p>2813091 2/10/2004</p>	28	<p>sporting goods, namely, sports balls of all types</p>
<p>DESIGN ONLY</p> 	<p>2522877 12/25/2001</p>	28 9	<p>sports balls of all types; weights for exercise and for lifting; weight lifting belts; protective padding, guards and body protectors of all types for the practice of sports; golf bags; head covers for golf clubs; golf tees and ball markers; baseball and softball bats; mitts and gloves for the practice of all types of sports; ice hockey sticks; ice skates and goggles for swimming</p> <p>helmets of all types for the practice of sports</p>
<p>DESIGN ONLY</p> 	<p>2239078 4/13/1999</p>	28 9	<p>nose clips for swimming purposes, swim goggles, kickboards, and buoys for recreational and training use</p> <p>ear plugs for swimming purposes</p>

DESIGN ONLY 	2024437 12/17/1996	28	sports balls
NIKE & Design 	2473828 7/31/2001	28	sports balls of all types; weights for exercise and for lifting; weight lifting belts; protective padding, guards and body protectors of all types for the practice of sports; golf bags, head covers for golf clubs, golf tees and ball markers; baseball, and softball bats; mitts and gloves for the practice of all types of sports; ice skates and goggles for swimming
NIKE & Design 	2024436 12/17/1996	28	sports balls
REUSE A SHOE & Design 	2111692 11/11/1997	40	conducting a recycling program for footwear
DESIGN ONLY 	1264529 1/17/1984	42	retail footwear and apparel store services
NIKE & Design 	1238853 5/17/1983	42	retail footwear and apparel store services
DESIGN ONLY 	78/529400 12/8/2004	9	cellular telephones; video game software; compact disc players; headphones; specialty carrying cases for cellular telephones, portable digital audio equipment, and compact disc players; pedometers
DESIGN ONLY 	78/528588 12/7/2004	28	golf clubs, golf balls, golf gloves, golf club grips, golf bags, golf tees, head covers for golf clubs, golf ball markers

6. Petitioner's Swoosh Mark is distinctive and famous.

7. On information and belief, no actual or constructive use was made of Registrant's Mark prior to August 1, 1999.

8. Petitioner's Swoosh Mark was used in commerce and registered, and said Swoosh Mark became famous, long prior to the first actual or constructive use of Registrant's Mark.

9. Respondent's Mark so resembles Petitioner's Swoosh Mark, as to be likely, when used on or in connection with the goods of Respondent, to cause confusion or to cause mistake or to deceive in violation of Section 2(d) of the Act.

10. Respondent's Mark dilutes and is likely to dilute the distinctive quality of the Swoosh Mark in violation of Section 43(c) of the Act.

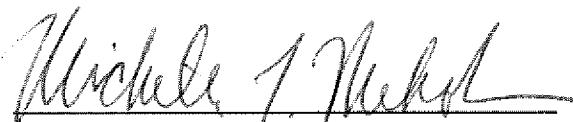
WHEREFORE, Petitioner respectfully requests that Registration No. 2,431,174 be cancelled and that this Petition for Cancellation be sustained in favor of Petitioner.

The official fee is submitted herewith. Charge any missing fee to Account No. 033975 Order No. 518600-0007821.

Date: February 21, 2006

Respectfully submitted,

NIKE, INC.

By: 
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Serial Number: 76016619

Registration Number: 2431714

Mark



(words only): S

Standard Character claim: No

Current Status: Registered.

Date of Status: 2001-02-27

Filing Date: 2000-03-31

Transformed into a National Application: No

Registration Date: 2001-02-27

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2001-09-07

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. SURF TECHNICIANS, INC.

Address:

SURF TECHNICIANS, INC.
5960 "E" Soquel Avenue

Santa Cruz, CA 95062
United States
Legal Entity Type: Corporation
State or Country of Incorporation: California

GOODS AND/OR SERVICES

International Class: 028
Surfboards and sailboards
First Use Date: 1999-08-01
First Use in Commerce Date: 1999-08-01

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-02-27 - Registered - Principal Register
2000-12-05 - Published for opposition
2000-11-03 - Notice of publication
2000-09-21 - Approved for Pub - Principal Register (Initial exam)
2000-09-15 - Case file assigned to examining attorney

CORRESPONDENCE INFORMATION

Correspondent
ALDO J TEST (Attorney of record)

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