

ESTTA Tracking number: **ESTTA98317**

Filing date: **09/07/2006**

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 | DUNHAM'S ATHLEISURE CORPORATION | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 5000 Dixie Highway Waterford, MI 48329 UNITED STATES | | |

| | |
|----------------------|--|
| Attorney information | Elizabeth F. Janda / Ronald Nabozny BROOKS KUSHMAN PC 1000 Town Center 22nd Floor Southfield, MI 48170 UNITED STATES ejanda@brookskushman.com, rnabozny@brookskushman.com, lscott@brookskushman.com Phone:248-358-4400 |
|----------------------|--|

Registration Subject to Cancellation

| | | | |
|--|--|-------------------|------------|
| Registration No | 3016520 | Registration date | 11/22/2005 |
| Registrant | NEW BALANCE ATHLETIC SHOE, INC. 20 GUEST STREET BOSTON, MA 02135 UNITED STATES | | |
| Goods/Services Subject to Cancellation | Class 025. First Use: 1999/05/01 , First Use In Commerce: 1999/05/01 Goods/Services: CLOTHING NAMELY, T-SHIRTS, GOLF SHIRTS, DENIM SHIRTS, AND WIND RESISTANT JACKETS | | |

| | |
|-------------|---------------------------------------|
| Attachments | Dunham.pdf (4 pages)(131445 bytes) |
|-------------|---------------------------------------|

| | |
|-----------|-------------------------------------|
| Signature | /elizabeth f janda/ |
| Name | Elizabeth F. Janda / Ronald Nabozny |
| Date | 09/07/2006 |

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

In re Trademark Registration No. 3016520

Registration Date: November 22, 2005

Serial No.: 75/758998

Filed: July 23, 1999

Trademark: **DUNHAM**

Atty. Docket No.:

DUNHAM'S ATHLEISURE)
CORPORATION)
)
Petitioner,)
)
v.)
)
NEW BALANCE ATHLETIC SHOE, INC.,)
)
Registrant.)

PETITION FOR CANCELLATION

FILED ELECTRONICALLY
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir:

Dunham's Athleisure Corporation (hereinafter referred to as "DUNHAM'S"), a Delaware corporation, having its principal place of business at 5000 Dixie Highway, Waterford, MI 48329, believes that it will be damaged by the continued registration of the mark "DUNHAM" shown in Registration No. 3016520 which was granted registration in error on the Principal Register on November 22, 2005, and petitions for cancellation of the same.

As grounds for cancellation, DUNHAM'S states as follows:

1. Registrant, NEW BALANCE ATHLETIC SHOE, INC. (hereinafter referred to as "NEW BALANCE"), is the owner by assignment of Registration No. 3016520, which issued on November 22, 2005 for "DUNHAM" for "clothing namely, t-shirts, golf shirts, denim shirts, and wind resistant jackets" in Class 25. This application was filed in July of 1999, based upon use since May 1999.

2. Upon information and belief, NEW BALANCE had amended the underlying Application Serial No. 75/758,998 to request registration on the Supplemental Register only, and for that reason the Trademark Trial and Appeal Board dismissed Petitioner's prior Opposition No. 91159972 to that application.

3. Petitioner and/or its predecessor in interest has operated retail stores featuring sporting goods and clothing items under the marks incorporating the name "DUNHAM'S" since 1937.

4. Petitioner is the owner of U.S. Trademark Application Serial No. 78/828,267 for "DUNHAM'S" for "retail store services featuring sporting goods and clothing" in Class 35. This application was filed on October 22, 1999, claiming first use in connection with the services since at least as early as 1977, and in another form by a predecessor since 1937. The registration which is the subject of this Cancellation Action has been cited as a barrier to Petitioner's application.

5. Petitioner is the owner of U.S. Trademark Application Serial No. 75/828,266 for "DUNHAM'S SPORTS" for "retail store services featuring sporting goods and clothing" in Class 35. This application was filed on October 22, 1999, claiming first use in connection with the services since at least as early as 1992, and in another form by a predecessor since 1937. The

registration which is the subject of this Cancellation Action has been cited as a barrier to Petitioner's application.

6. Petitioner is the owner of U.S. Trademark Application Serial No. 76/618,514 for "DUNHAM'S SPORTS and DESIGN" for "retail store services and online retail store services featuring sporting goods and apparel" in Class 35. This application was filed on October 22, 1999, claiming first use in connection with the services since at least as early as 1992. The registration which is the subject of this Cancellation Action has been cited as a barrier to Petitioner's application.

7. Petitioner has expended considerable effort and expense in promoting its use of the "DUNHAM'S," "DUNHAM'S SPORTS" and "DUNHAM'S SPORTS & DESIGN" trademarks and the services associated with these marks, with the result that the purchasing public has come to know and recognize the services promoted and sold in connection with these marks as those associated with the Petitioner. Petitioner has an exceedingly valuable goodwill established in its "DUNHAM'S," "DUNHAM'S SPORTS" and "DUNHAM'S SPORTS & DESIGN" marks.

8. There is no issue as to priority. The Petitioner used "DUNHAM'S," "DUNHAM'S SPORTS" and "DUNHAM'S SPORTS & DESIGN" in connection with its services long prior to the claimed date of first use in Registration No. 3,016,520.

9. The Trademark Office has cited this Registration as a barrier to Petitioner's applications under 15 U.S.C. § 1052(d) based upon a likelihood of confusion, and thus Registration No. 3,016,520 is a source of injury and damage to Petitioner.

10. This Registration No. 3,016,520 is further defective and should be cancelled because the Trademark Office passed the application to registration on the Principal Register in error, when the application had been amended and approved for registration only on the Supplemental Register.

11. Registration No. 3,026,520 is a source of continuing damage and injury to Petitioner.

WHEREFORE, Petitioner respectfully requests that this Petition for Cancellation be sustained and that Registration No. 3,016,520 be cancelled.

The filing fee of \$300 and any additional fees as may be required under 37 C.F.R. § 2.(6)(a)(17) are to be charged to Deposit Account No. 502337.

Respectfully submitted,

DUNHAM'S ATHLEISURE CORPORATION

By 

Ronald Nabozny
Elizabeth F. Janda
Attorney/Agent for Petitioner

Date: September 7, 2006

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
Phone: 248-358-4400
Fax: 248-358-3351

DUA0128TUS