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

Proceeding	92046260
Party	Plaintiff DUNHAM'S ATHLEISURE CORPORATION DUNHAM'S ATHLEISURE CORPORATION ,
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Date	05/31/2007
Attachments	DUA Response to Motion w Attachments.pdf (37 pages)(1297832 bytes)

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

Dunham's Athleisure Corporation,)
)
 Petitioner,)
)
 -vs-)
)
 New Balance Athletic Shoe, Inc.,)
)
 Registrant.)

Cancellation No. 92046260

**PETITIONERS RESPONSE TO REGISTRANT'S
MOTION FOR SUMMARY JUDGMENT**

I. INTRODUCTION

Dunham's Athleisure Corporation ("Dunham's") files this document in response to New Balance Athletic Shoe, Inc.'s ("New Balance") Motion for Summary Judgment.

Dunham's initially *opposed* the subject registration, which was published in the *Official Gazette* on March 26, 2002 as Application Serial No. 75/75899. However, New Balance successfully moved for dismissal of the opposition because the application had been amended to the Supplemental Register, and was not eligible for the opposition procedure. Dunham's then commenced this Cancellation once the registration issued.¹

New Balance has moved for summary judgment in this action, relying on the *Morehouse* defense. New Balance asserts that Dunham's cannot be damaged by continued registration of U.S. Trademark Registration No. 3016520 for DUNHAM covering "clothing namely, t-shirts, golf shirts, denim shirts, and wind resistant jackets," because New Balance owns prior registrations for DUNHAM, DUNHAM WAFFLE-STOMPERS and DUNHAM TYROLEANS for "footwear," "leather outdoor shoes for hiking, climbing and casual wear," and "shoes."

As the following will show, New Balance has no *Morehouse* defense under the facts of this case. New Balance's registered marks for "footwear" are not the same as or substantially identical to the subject registration for "t-shirts, golf shirts, denim shirts, and wind resistant jackets." The long period of concurrent use, the coexisting registrations, and the history between

¹Dunham's notes that despite the claim that the mark was approved for registration on the Supplemental Register, it issued in error on the Principal Register.

the parties and their predecessors-in-interest further create issues of fact which must be addressed in this proceeding.

Dunham's respectfully requests that this Board deny New Balance's Motion for Summary Judgment.

II. BACKGROUND

A. Dunham's

Dunham's and/or its predecessors-in-interest, have operated retail stores featuring sporting goods and clothing items under marks incorporating "DUNHAM'S" since 1937.

Dunham's is the owner of the following applications and canceled registration:

- **DUNHAM'S**, Serial No. 75/828267 in Class 35 for "retail store services featuring sporting goods and clothing," filed October 22, 1999 with first use from 1977, and first use in another form from 1937.
- **DUNHAM'S SPORTS**, Serial No. 75828266 in Class 35 for "retail store services featuring sporting goods and clothing," filed October 22, 1999 with first use in 1992.
- **DUNHAM'S SPORTS (Stylized)**, Serial No. 76618514 in Class 35 for "retail store services and retail online store services featuring sporting goods and apparel," filed October 29, 2004 with first use from 1992.
- **SINCE 1937 DUNHAM'S SPORT OUTFITTERS**, Registration No. 1496249 in Class 42 for "retail store services for the sale of sporting goods, exclusive of footwear and clothing," filed September 2, 1986; registered July 12, 1988 under Section 2(f); canceled January 16, 2005 under Section 8; first use from 1937.

Dunham's registration/applications have consistently covered retail services, and Dunham's and its predecessors-in-interest have invested over 80 years in the DUNHAM'S name in connection with its retail services.

B. New Balance

New Balance acquired the DUNHAM brand name for footwear in 1998. (**Attachment 1**, Trademark Assignment Details.) New Balance is therefore the owner *by assignment* from Falcon Shoe Manufacturing Co. of the following registrations (collectively referred to as the "Falcon Shoe Marks"):

- **DUNHAM**, Registration No. 895088 in Class 25 for "footwear," filed May 5, 1969; registered July 21, 1970; first use from 1959.

- **DUNHAM WAFFLE-STOMPERS Design**, Registration No. 973456 in Class 25 for "leather outdoor shoes for hiking, climbing and casual wear," filed June 12, 1972; registered November 20, 1973; first use from 1970.

- **DUNHAM TYROLEANS**, Registration No. 740975 in Class 25 for "shoes," filed February 8, 1962; registered November 20, 1962; first use from 1956. (NOTE: New Balance's 2002 renewal specimen of use for DUNHAM TYROLEANS shows only DUNHAM.)

- **DUNHAM DOUBLE COVERAGE TOES**, Canceled Registration No. 1855821 in Class 25 for "footwear," filed May 4, 1993; registered September 27, 1994; use claimed from 1992. (NOTE: Reg. No. 1855821 canceled October 6, 2001, after it was cited against Dunham's Serial Nos. 75/828266 and 75/828267 in 2000).

New Balance is also the owner of the following applications filed in 2000 (collectively referred to as “New Balance 2000 ITU Applications”), all suspended pending disposition of Dunham’s previously filed Serial Nos. 75/828266 and 75/828267:

- **DUNHAM**, Serial No. 76/015365 in Classes 18 and 25 for “all purpose sports bags and billfolds” and “hats, sweat bands, belts, visors, shirts, shorts, pants, tights, jackets, coats, wind resistant suits, t-shirts, tank tops, socks and footwear,” filed April 3, 2000 with intent-to-use in commerce.

- **DUNHAM and Design**, Serial No. 76/015364 in Classes 18 and 25 for “all purpose sports bags and billfolds” and “hats, sweat bands, belts, visors, shirts, shorts, pants, tights, jackets, coats, wind resistant suits, t-shirts, tank tops, socks and footwear,” filed April 3, 2000 with intent-to-use in commerce.

- **DUNHAM and Design**, Serial No. 76/523055 in Classes 1, 3, 5 and 26 for “shoe water repellants, namely, waterproofing chemical compounds for shoes made of leather; cleaner for use on shoes, shoe conditioner cream, and shoe polish; shoe deodorizers; shoe laces,” filed May 6, 2003 with intent-to-use in commerce.

- **DUNHAM and Design**, Serial No. 76/0529113 in Classes 1, 3, 5 and 26 for “water repellent chemical compositions for clothing, water repellent chemical compositions for footwear, fabric protectants for clothing, fabric protectants for footwear, stain repellents for clothing, stain repellents for footwear; cleaning preparations for use on clothing, cleaning preparations for use on footwear, laundry detergents, fabric softeners for domestic use, shoe polish, shoe whitener, saddle soap, spot remover, shoe conditioner cream, shoe conditioner spray; shoe deodorizers, disinfectants for clothing; shoe laces,” filed July 2, 2003 with intent-to-use in commerce.

C. The Source-i, Inc. and Reg. No. 3016520

The subject Registration No. 3016520 (Serial No. 75/758998) for DUNHAM was initially filed by a company known as The Source-i, Inc. on July 23, 1999 in Class 25 for “clothing namely, t-shirts, golf shirts, denim shirts, and wind resistant jackets,” with first use

claimed from May 1, 1999. The Source-i filed its application a mere three months prior to Dunham's Serial Nos. 75/828266 and 75/828267, and was therefore cited against the same, even though Dunham's use in connection with its retail services predates the priority claimed by The Source-i.

Just as Dunham's applications face refusals based on the Falcon Shoe Marks, Source-i also received initial 2(d) refusals citing the Falcon Shoe Marks. The Source-i successfully overcame refusals based on DUNHAM WAFFLE-STOMPERS, DUNHAM TYROLEANS, and DUNHAMDOUBLE CONVERAGE TOES, by arguing that under *DuPont*, the marks must be considered in their entireties and that the goods and channels of trade were substantially different. See *In re E.I. du Pont de Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973). "The addition of the other verbiage to the marks makes them different in appearance, sound and commercial impression so that no likelihood of confusion should be found." (**Attachment 2**, The Source-i, Inc.'s April 25, 2000 Office Action Response.) On July 11, 2000, the Examiner withdrew her refusal to register Source-i's mark based on DUNHAM WAFFLE-STOMPERS, DUNHAM TYROLEANS, and DUNHAMDOUBLE CONVERAGE TOES, but maintained a final refusal based on Reg. No. 895088.

To further complicate matters, in September 2000 the Source-i's application was also cited against the New Balance 2000 ITU Applications. In an apparent strategic effort to overcome this refusal, New Balance acquired an assignment of the Source-i's application on December 15, 2000, *together with the good will*. This may be an invalid assignment in gross, since there is some question as to whether Source-i assigned the mark with the relevant portion

of its business.² This is the subject of additional discovery, and remains a question of fact. New Balance was likely aware of the fact that the assigned application was cited against Dunham's applications. Rather than demanding that Source-i withdraw its application, New Balance obtained an assignment and subsequently responded to the pending, final office action citing New Balance's registration for DUNHAM. The Source-i application therefore registered to New Balance.

III. ARGUMENT

A. The Standard For Summary Judgment

Summary judgment is not appropriate unless the moving party is entitled to judgment as a matter of law on the undisputed facts. In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A genuine issue with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any factual issues are genuinely in dispute must be resolved against the moving party and all inferences must be viewed in the light most favorable to the nonmoving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). "A party

² In addition, Dunham's references Source-i's January 2, 2001 application for DUNHAM BY SOURCE-I (Serial No. 78/044959) as evidence of the Source-i's continued business and use of DUNHAM.

may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact, which, if proved, would establish the nonmoving party's entitlement to judgment." TBMP 504.02

B. New Balance Has No *Morehouse* Defense

The *Morehouse* defense is based on the theory that the petitioner cannot be injured by the registered or applied-for mark because there already exists a registration so similar that an additional registration can no cause no greater injury to the opposer than the prior registration. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881 (CCPA 1969). For ownership of one or more existing registrations to be an affirmative defense to an opposition, the pre-existing registration or registrations must be for the same or substantially identical mark and the same or substantially identical goods and/or services. See *DC Comics Inc. v. Scholastic Magazines, Inc.*, 210 USPQ 299, 301 (TTAB 1980)(DOUBLE ACTION not the same or substantially identical to ACTION and SCHOLASTIC ACTION).

The *Morehouse* theory does not apply here, and cannot form the basis for summary judgment, where it is evident that petitioner will be injured by continued registration of the subject mark. For many years, Dunham's retail outlets peacefully coexisted with New Balance's predecessors-in-interest's shoe line. The relevant public was accustomed to making distinctions between the parties. New Balance is attempting to change the status quo in this registration by expanding from footwear into "t-shirts, golf shirts, denim shirts, and wind resistant jackets." Dunham's submits that its prior rights cannot be ignored. The acquired Falcon Shoe Mark registration for "footwear" cannot be bootstrapped to establish rights in "t-shirts, golf shirts, denim shirts, and wind resistant jackets."

New Balance makes the inaccurate assertion that it will be “meaningless” for Dunham’s to succeed in this cancellation action, “when three other registrations owned by the same registrant bar its application and affect its rights.” See New Balance Motion for Summary Judgment, p.4, ¶ 5.³ However, New Balance fails to address the fact that all of the New Balance 2000 ITU Applications are suspended pending disposition of Dunham’s applications, which have use dates that precede Source-i’s date of first use in the challenged registration. In an effort to have the Trademark Register reflect the long-standing division of rights between the parties and their predecessors-in-interest, it is in no manner of speaking “meaningless” for Dunham’s to succeed in this action. Moreover, the prior Falcon Shoe Marks are for “footwear,” which the following will illustrate are not “substantially identical” to the goods covered by Reg. No. 3016520.

More importantly, New Balance references a TARR report as evidence that the service description in Dunham’s canceled Reg. No. 1496249 for SINCE 1937 DUNHAM’S SPORTS OUTFITTERS contained the proviso “exclusive of footwear and clothing,” at the “demand” of New Balance. Motion at p. 4, ¶ 5. This unsupported, false assertion alone creates an issue of fact sufficient to defeat summary judgment in favor of New Balance.⁴ The attached copy of the original application shows that the description of goods, *as filed*, contains the quoted

³In effect, not all of the Falcon Shoe Marks would remain a bar to Dunham’s applications. Even Source-i successfully argued that DUNHAM TYROLEANS and DUNHAM WAFFLE-STOMPERS Design were not confusingly similar.

⁴ If New Balance has evidence of a demand, agreement or coexistence understanding between these predecessors-in-interest, it should produce it.

language. (**Attachment 3**, August 27, 1986 Application for SINCE 1937 DUNHAM'S SPORTS OUTFITTERS.)

C. Goods Are Not Substantially Identical

The *Morehouse* defense requires that the pre-existing registration cover “substantially identical” goods as the later-filed mark. Contrary to New Balance’s imaginative suggestion, “footwear” is not synonymous with a full range of clothing items merely because it asserts footwear as “a form of clothing, for the feet.” Motion at p. 7, ¶ 1. More relevant to this twist of logic is the fact that Reg. No. 3016520 does not broadly cover “clothing,” and makes no claim of use on footwear. Rather, Reg. No. 3016520 is specifically limited to “t-shirts, golf shirts, denim shirts, and wind resistant jackets.” This new registration is a clear expansion of the rights previously held under the Falcon Shoe Mark registrations.⁵ Dunham’s common law rights in retail services relating to such clothing items predates Source-i’s date of first use.

Dunham’s again directs the Board to Source-i’s April 25, 2000 Office Action Response, in which applicant clearly distinguished the nature of its goods from New Balance – “Registrant uses the brand name for a particular niche of shoes - - hiking boots and industrial work shoes... [R]egistrant sells shoes at retail, the applicant does not... The applicant does not sell shirts directly to the public. . . [A]pplicant’s apparel ends up with other logos on it for promotional purposes.” See Source-i’s April 25, 2000 Office Action Response, pgs. 2-3. The Board should consider these statements as evidence in determining that the goods covered the

⁵In addition, Dunham’s has served discovery on New Balance requesting verification of its use of each item listed in Reg. No. 3016520. Dunham’s suspects that there may be sufficient evidence of non-use of this mark on certain goods to warrant cancellation for non-use.

Falcon Shoe Marks are not substantially identical to those covered by Reg. No. 3016520. See *Mason Engineering & Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956, 961 n.5 and n.11 (TTAB 1985) (in evaluating "Morehouse" type defense, Board relied on specimens and other materials in applicant's application as evidence of the nature of applicant's services to find that those services were not "substantially identical" to the goods in applicant's subsisting registration).

The standard for determining "legal equivalents" is much higher than that for finding a likelihood of confusion. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991) (the standard for legal equivalents is far higher than the likelihood of confusion standard); *American Paging, Inc. v. American Mobilphone, Inc.*, 13 USPQ2d 2036, 2038 (TTAB 1989) (it is perfectly consistent for the same two marks to be held confusingly similar, but not legally equivalent). The fact that the Examining Attorney cited the Falcon Shoe Marks against Dunham's applications for "retails store services featuring sporting goods and clothing" is not evidence that Dunham's rights are equally affected by the Falcon Shoe Mark registrations for "footwear" as they are by New Balance's registration for "t-shirts, golf shirts, denim shirts, or wind resistant jackets."

Finally, New Balance relies on four decisions in support of its assertion that the earlier registrations do not have to be identical to the later registration, because it would be redundant if the marks and goods were identical in the later registration. On the contrary, the tacking doctrine and *Morehouse* require that the mark and goods are *substantially* identical, such that they are "legal equivalents." In this action, "footwear" is not substantially identical to "t-shirts, golf shirt's denim shirts, or wind resistant jackets."

Each of the cases relied upon are easily distinguished from the present situation. In *College Inn Food Products Corporation v. College Hill Poultry, Inc.*, 133 USPQ 346, (TTAB 1962), the Board dismissed an opposition against COLLEGE HILL for “dressed rabbits, dressed poultry, fresh eggs, eviscerated poultry in packaged form and frozen chicken.”⁶ Contrary to New Balance’s interpretation, the Board’s decision did not turn on whether the goods identified in the later application were identical to applicant’s prior registration for “dressed poultry, dressed rabbit, and eggs.” In fact, the decision does not even include analysis by the Board comparing the goods, as the relevant goods in *College Inn* were identical, with the mere inclusion of “eviscerated poultry in packaged form and frozen chicken” in the later application. Therefore, in support of its assertions that under *Morehouse* the goods need *not* be identical, New Balance relies on a case in which the goods were identical. In this case, there are no overlapping goods.

Curiously, New Balance also relies on the decision in *Joseph & Feiss Co. v. Sportempos, Inc.*, 451 F.2d 1402 (CCPA 1971), in which the goods identified in applicant’s prior registration were, in fact, identical. Sportempos, Inc., owned a 1947 registration covering “ladies’ suits, jackets, and skirts,” which was found to be substantially identical under *Morehouse* to Sportempos’ later application for the same mark covering “**suits, jackets, and skirts**; trousers and slacks; outer shorts, coats, outer dresses and sport shirts, blouses, shells, with and without sleeves; sweaters, shifts; and caps, **all for women, young women and girls.**” (Emphasis added.)

⁶It is worth noting that New Balance erroneously indicates that the application covered “dressed poultry, dressed rabbits, fresh eggs, eviscerated poultry, **in canned and** packaged form, and frozen chicken.” However, prior to the Board’s decision, the applicant amended its application to *delete* reference to poultry in canned form from the identification of goods, because applicant never sold or intended to sell canned poultry. Notably, at the time of the opposition, opposer owned two registrations (Reg. Nos. 557830 and 194678) for primarily *canned* goods.

A registration limited to “ladies’” clothing was held to be substantially identical to an application limited to clothing”for women, young women and girls,” where both the registration and application specifically identified “suits, jackets and skirts.” In the present matter, the Falcon Shoe Marks do not claim use on “t-shirts, golf shirt’s denim shirts, or wind resistant jackets.”

In *Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 USPQ 1022 (TTAB 1983), applicant owned two registrations for VISION CENTER, one for services identified as “**optical, contact lens, and sun glass service**, namely, examination of eyes, prescription eye glasses and custom fitting of eye glasses, and sun glasses.” (Emphasis added.) The prior registrations were found to be substantially identical to a later application for PEARLE VISION CENTER for “retail **optical** store, optometric and opticians’ **services**.” As with the cases discussed above, the relevant identifications contain *identical* language, whereas the Falcon Shoe Marks do not claim use on “t-shirts, golf shirt’s denim shirts, or wind resistant jackets.”

In the final case relied on by New Balance, *Missouri Silver Pages Directory v. Southwestern Bill Media*, 6 USPQ2d 1028 (TTAB 1988), the Board did not issue a final decision, as it required further information from opposer to clarify their interest in the subject mark. In sum, applicant owned a previous registration for SILVER PAGES covering “a **telephone** and discount **directory** addressed to senior citizens,” and its application for the same mark covered “compiling a **telephone directory**; promoting the goods and services of others through placing advertisement and listings in directories,” and “for publication of **telephone directories**.” To the extent opposers were claiming rights in SILVER PAGES only in respect of a senior citizen directory, the *Morehouse* defense would apply because opposers could not be further damaged by the registration of the same mark for the services. 6 USPQ2d at 1031. However, the Board

opined that if opposer amended its notice of opposition to claim use of SILVER PAGES for services of the type listed in applicant's application, *Morehouse* would not apply and summary judgment would be denied. The services in applicant's SILVER PAGES application were not equivalent to the goods in its prior registration.

In sum, the cases relied on by New Balance do not support summary judgment here. New Balance's registrations limited to footwear do not grant it rights in "t-shirts, golf shirt's denim shirts, and wind resistant jackets."

The Register should reflect the reality of the market. Dunham's retails stores for sporting goods and apparel have coexisted in the marketplace with DUNHAM brand footwear since at least 1959. Dunham's has priority over the registration challenged herein.

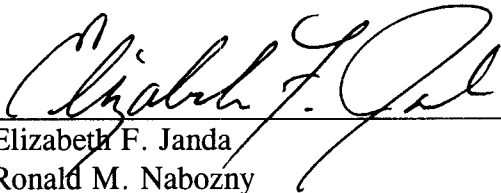
New Balance should not be permitted to rely on prior registrations for differing goods in an effort to expand and maintain rights for goods on which it does not use its mark. All doubts as to whether any factual issues are genuinely in dispute must be resolved against New Balance. All inferences must be viewed in the light most favorable to Dunham's.

IV. CONCLUSION

For the foregoing reasons, Dunham's respectfully requests that the Board deny New Balance's Motion for Summary Judgment.

Respectfully submitted,

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Dated: May 31, 2007

CERTIFICATE OF SERVICE

I certify that I served:

**PETITIONERS RESPONSE TO REGISTRANT'S
MOTION FOR SUMMARY JUDGMENT**

on May 31, 2007 by:

 delivering

X mailing (via First-Class mail)

a copy to:

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Lahive & Cockfield LLP
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Boston, MA 02109
Attorneys for Registrant



ATTACHMENT 1



United States Patent and Trademark Office

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Trademark Assignment Details

Reel/Frame: [1822/0159](#)

Pages: 5

Received: 12/04/1998

Recorded: 11/27/1998

Conveyance: ASSIGNS THE ENTIRE INTEREST

Total properties: 9

1	Serial #: 71486237 Mark: RUGGARDS	Filing Dt: 07/25/1945	Reg #: 419794	Reg. Dt: 03/05/1946
2	Serial #: 72137512 Mark: DUNHAM TYROLEANS	Filing Dt: 02/08/1962	Reg #: 740975	Reg. Dt: 11/20/1962
3	Serial #: 72326362 Mark: DUNHAM	Filing Dt: 05/05/1969	Reg #: 895088	Reg. Dt: 07/21/1970
4	Serial #: 72427031 Mark: DUNHAM WAFFLE-STOMPERS	Filing Dt: 06/12/1972	Reg #: 973456	Reg. Dt: 11/20/1973
5	Serial #: 72447529 Mark: TRUKKERS	Filing Dt: 02/01/1973	Reg #: 993107	Reg. Dt: 09/10/1974
6	Serial #: 73085470 Mark: THE WAY OF NATURE...THRU THE HANDS OF MA	Filing Dt: 04/29/1976	Reg #: 1110565	Reg. Dt: 01/02/1979
7	Serial #: 73154434 Mark: GREAT FOOTWEAR FOR THE GREAT OUTDOORS	Filing Dt: 01/06/1978	Reg #: 1119327	Reg. Dt: 05/29/1979
8	Serial #: 73603157 Mark: TRU-TRAK	Filing Dt: 06/09/1986	Reg #: 1437386	Reg. Dt: 04/21/1987
9	Serial #: 74388256 Mark: DUNHAM DOUBLE COVERAGE TOES	Filing Dt: 05/04/1993	Reg #: 1855821	Reg. Dt: 09/27/1994

Assignor

1 [FALCON SHOE MFG. CO.](#)

Exec Dt: 08/31/1998

Entity Type: CORPORATION

Citizenship: MAINE

Assignee

1 [NEW BALANCE ATHLETIC SHOE, INC.](#)
61 NORTH BEACON STREET
BOSTON, MASSACHUSETTS 02134-1912

Entity Type: CORPORATION

Citizenship: MASSACHUSETTS

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ATTACHMENT 2



04-25-2000

U.S. Patent & TMOtc/TM Mail Ropt Dt. #22



MASON & ASSOCIATES

Professional Association
Attorneys at Law

JA

April 25, 2000

Express Mail: EL498518190US

Box Response NO FEE
Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Applicant: The Source-I, Inc.
Mark: DUNHAM

Dear Sir or Madam:

Enclosed please find the following:

- (1) Response to Office Action mailed November 22, 1999.
- (2) Affidavit
- (3) Substitute Specimen
- (4) Substitute Specimen Declaration
- (5) Post card

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LAW OFFICE 108

Kindly direct all correspondence to the undersigned attorney. The Commissioner is hereby authorized to charge any fees which may be required to Account No. 13-1992.

Sincerely,

Anne S. Mason

ASM/lhc
Enclosures
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CERTIFICATE OF EXPRESS MAIL UNDER 37 CFR 1.10

"Express Mail" mailing label number: EL498518190US

Date of Deposit: April 25, 2000

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Eric H. Costello
Eric H. Costello, Legal Assistant



04-25-2000

U.S. Patent & TMO/TM Mail Rpt Dt #22

108

TRADEMARKS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: The Source-i, Inc.)

S.N.: 75/758,998)

Trademark Attorney:

Filed: July 23, 1999)

Andrea D. Saunders

Law Office No.: 108

Mark: DUNHAM)

CERTIFICATE OF EXPRESS MAIL UNDER 37 C.F.R. §1.10

"Express Mail" mailing label number: EL498518190US

Date of Deposit: April 25, 2000

I hereby certify this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Lia H. Costello

Lia H. Costello, Legal Assistant

Box Response - No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir or Madam:

In response to the Office Action mailed November 22, 1999 (Action No. 1), having a statutory period for response set to expire May 22, 2000, the above-identified trademark application is amended as follows:

LIKELIHOOD OF CONFUSION

The Examining Attorney has refused registration of the mark DUNHAM in connection with apparel on the basis of likelihood of confusion with the mark DUNHAM used in connection with shoes. Applicant believes that there is no likelihood of confusion once the nature of the applicant's business is understood. An

affidavit setting forth the facts underlying this belief is attached as Exhibit "A."

With respect to the similarity of the marks, while the DURHAM mark is identical to one of the registrant's marks, it is not identical to the others cited, as those have additional words or phases in them such as "double coverage toes", "waffle stompers", or "tyroleans." Under du Pont, the marks are to be considered in their entireties as to appearance, sounds connotation and commercial impression. In re E.I. du Pont de Nemours & Co., 177 USPQ 563, 567 (CCPA 1973). The addition of the other verbiage to the marks makes them different in appearance, sound and commercial impression so that no likelihood of confusion should be found.

DUNHAM double coverage shoes is a design mark that includes all of the words and the circular design. This distinguishes that mark in look and appearance from the applicant's word mark.

The nature of the goods and services provided by the applicant and the registrations are very different. Registrant uses the brand name for a particular niche of shoes -- hiking boots and industrial work shoes. Copies of the registrant's web pages and hyperlinks are attached as Exhibit "B." Furthermore, the fact that other suppliers may sell shoes and apparel together is not dispositive. Despite the Land's End catalog attached to the office action and the citation of the Melville case, it remains clear that even where products are sold under one roof, the inquiry is not over. Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391

(Fed. Cir. 1992); Sunenblick v. Harrell, 895 F. Supp. 616, 629 (S.D.N.Y. 1995); aff'd, 101 F.3d 684 (2d Cir. 1996), cert. den., ___ U.S. ___, 117 S. Ct. 386 (1996) (fact that two parties conduct same business in same field does not establish similarity of trade customers or overlap of customers). Such proximity does not automatically signal a potential for confusion. Hot Shot Quality Products, Inc. v. Sifers Chemicals, Inc., 452 F.2d 1080, 172 USPQ 350 (10th Cir. 1971); Nestle Co. v. Flash Finch Co., 4 USPQ2d 1085, 1090 (TTAB 1987) (deli products not sold in same section of store as syrups and powders or dairy products).

The trade channels at issue here are vastly different. While it is clear that the registrant sells shoes at retail outlets, the applicant does not. Applicant is simply a supplier. It sells its apparel to the wholesale market, never to the retail market. Applicant's apparel is sold to advertising specialty groups, corporate sponsorship groups, promotional groups, embroidery groups, banks, restaurants, and golfing events whereby the logo of the customer is placed on the DUNHAM shirt distributed by the applicant. Thus, the applicant's apparel ends up with other logos on it for promotional purposes. The customers purchase the DUNHAM shirts for resale based on quality and cost.

The applicant markets its apparel at trade shows. The applicant does not sell shirts directly to the public. Again, its customers are groups that then place other's logos on them, a further distinguishing feature from the mark used by the registrant.

Sales to the applicant's customers are not impulse buys, since the purchases are generally part of a professional promotional campaign. The shirts are bought in bulk by persons involved in the field of promotions and who are not likely to be confused. Careful purchasing, then, is the norm. This level of sophistication greatly reduces the likelihood of confusion. See, Astra Pharmaceutical Prods., Inc. v. Beckman Instruments, Inc., 718 F.2d 1201 (1983); Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482, 212 USPQ 246, 252 (1st Cir. 1981); Fisher Stoves, Inc. v. All Nighter Stove Works, 626 F.2d 193, 194 (1st Cir. 1980); Societe Anonyme de La Grande Distillerie E. Lusenier Fils Aine & Lie v. Julius Wile Sons & Co., 161 F. Supp. 545 (D.N.Y. 1958). Again, the shirts are not purchased by the end users. The end users will never come across the shirts at retail outlets.

As the affidavit establishes, there has been no confusion between the appoicant's mark and the mark used by the registrant. In fact, the applicant's principal was not even aware of the mark used by the registrant and has never come across it at trade shows, in trade magazines and the like. The applicant's mark is used with what are known as "replenishment" shirts and are never sold directly to the public. There is, therefore, no realistic likelihood of confusion between the mark adopted by the applicant and that used by the registrant on shoes. Because there is no evidence that the registrant intends to use the mark on apparel in the future -- and has not done so despite a date of first use

since 1956 -- there is hardly any chance that there will be confusion in the future that would arise.

THE MARK IS NOT A SURNAME

The applicant's mark was selected because it is the middle name of the president of the company. It was further selected because of the Scottish connotations that the mark connotes. The mark is used with a thistle which is also evocative of Scottish genus, and is used predominantly on golf apparel. The mark is not the surname of any known person and should not be confused as one when used with apparel.

The examining attorney cites In re Kahan & Weiz Jewelry Mfg. Corp., 508 F.2d 831, 184 USPQ 421 (CCPA 1975) as grounds for refusing registration on the basis that the mark is a surname. In that case, the refusal to register was reversed, because the Patent and Trademark Office had not sustained its burden of proof of showing a prima facie case. Instead, the examining attorney had focused on evidence adduced by the applicant that showed that the mark had 6 surname uses in a Manhattan directory. Significant to this case, the Kahan court made clear that the whole purpose of the change in § 1052 was to prohibit the knee-jerk rejection of marks on the basis that they show up in telephone directories. 184 USPQ at 422.

The test now that is appropriate is whether the primary impression on the consuming public is that the mark is a surname. This examination is done on a case-by-case basis. In re Estblissements Darty et Fils, 225 USPQ 652, 653 (Fed. Cir. 1985). In Darty, refusal of the registration was sustained largely

because the principal of the company had the name DARTY as a surname. The surname was also used in the mark as though it were a surname (Darty et Fils means "Darty and Sons" in French). The public, when encountering the mark in the Darty case, would logically perceive it to have primary significance as a surname.

The question of whether a mark had primary significance as a surname was also considered in In re BDH Two, Inc., 26 USPQ2d 1556 (Fed. Cir. 1993). There, the mark GRAINGERS was refused for registration in connection with corn chips and related products on the basis that the mark had surname significance. Three factors were found dispositive at the examination stage: 10 individuals were shown to have that name by virtue of a NEXIS search; 21 individuals were discovered with that name in phone books, and there was no listing in the dictionary for such word, meaning it had no common language meaning.

The court looked to the nature of the product on appeal and reversed the decision. The court observed that there was no person affiliated with the company that had that name and that, as a result, the mark was clearly coined to be suggestive of characteristics of the products with which the mark was attached. That is the case here. Id. at 1558. Likewise, in the instant case, no person affiliated with the company has the same surname as the mark. There is no dictionary definition for the word. As a result, under BDH, registration of applicant's mark here should be allowed on the Principal Register.

IDENTIFICATION OF GOODS

The application was refused on the basis that the identification of goods contains a registered trademark "windbreaker." Applicant amends its identification of goods as follows:

Class 25 - clothing namely, t-shirts, golf shirts, denim shirts, and wind resistant jackets.

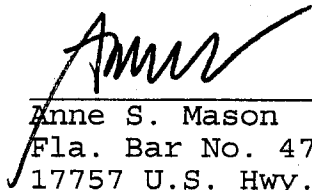
SPECIMENS

Applicant hereby submits substitute specimens that do not bear the "R" designation.

CONCLUSION

If this application cannot be published for opposition at this time, a call to the undersigned at (727) 538-3800 would be greatly appreciated.

MASON & ASSOCIATES, a
Professional Association



Anne S. Mason
Fla. Bar No. 472689
17757 U.S. Hwy. 19 North
Mangrove Bay, Suite 500
Clearwater, FL 33764
(727) 538-3800
Attorney for Applicant

Dated: 4/24/00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: The Source-i, Inc.)
S.N.: 75/758,998) Trademark Attorney:
Filed: July 23, 1999) Andrea D. Saunders
Mark: DUNHAM) Law Office No.: 108
_____)

AFFIDAVIT OF WAYNE WILSON

STATE OF FLORIDA)
COUNTY OF PINELLAS) SS.

I, Wayne Wilson, being duly sworn, depose and say that:

1. I am the president of the applicant company and have personal knowledge of the facts recited herein.

2. I have reviewed the office action received in connection with the application to register the mark DUNHAM and disagree that there is any likelihood of confusion.

3. First, the idea for the mark came from my middle name. It is of Scottish derivation. I use the mark with a thistle logo which emphasizes the Scottish connotation. Further, we have used the mark to date primarily on golfing apparel, thus driving home the Scottish aspect. The mark is not the surname of any person in the company.

4. We adopted the mark without having heard of the registrant's mark. We have never seen the registrant's shoe products at trade shows that we attend, nor have we seen the products advertised in the trade magazines that we advertise in. In fact, we understand that the shoes are sold in retail stores directly to the public.

5. From the web sites located in connection with the registrant's products, it is clear that the name is used by registrant in connection with hiking boots, and other similar heavyduty footwear. In fact, the mark is linked to safety web sites.

6. Our apparel is sold exclusively on a wholesale basis and the price is approximately \$10-14 dollars per shirt. We sell to professional buyers or promotions directors, never directly to the public.

7. We sell our apparel to advertising specialty groups, corporate sponsorship groups, promotional groups, to banks and restaurants.

8. We market our goods via trade shows and catalogs. We are also listed in the Embroidery Network under "supplier." We are also listed in the Screen Printers Guild as a supplier. Our upcoming catalog is directed to the Embroidery Network nationwide.

9. We have experienced absolutely no incidences of confusion between our mark and the registrant's since we started using our mark in May of 1999. We have not been contacted by the registrant, we have not received any misdirected product inquiries, we have not received any misdirected faxes, mail or telephone calls.

10. We do not believe that there is any likelihood of confusion because our purchasers are sophisticated and will not come across the registrant's goods in the channels of trade.

FURTHER AFFIANT SAITH NOT.

Wayne Wilson

Wayne Wilson

STATE OF FLORIDA

COUNTY OF PINELLAS

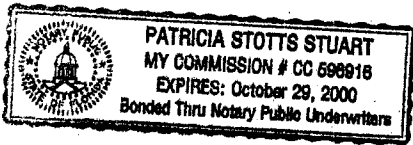
The foregoing instrument was sworn to and subscribed before me this 15th day of February, 2000, by Wayne Wilson, who is personally known to me or has produced _____ as identification.

Patricia Stotts Stuart

Notary Public
PATRICIA STOTTS STUART
(Print Name of Notary Public)

My Commission Expires:
October 29, 2000

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[3039.7]



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: The Source-i, Inc.))	
S.N.: 75/758,998)	Trademark Attorney:
Filed: July 23, 1999)	Andrea D. Saunders
Mark: DUNHAM)	Law Office No.: 108
)	
)	

Box Response No Fee
Assistant Commissioner For Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

SUBSTITUTE SPECIMEN DECLARATION - CORPORATION

I, Wayne Wilson, President of Applicant The Source-I, Inc., hereby declare that the substitute specimens that are submitted herewith have been in continuous use since at least the date of July 23, 1999, when the Application was filed. No changes have been made to said mark, and the specimens depict the mark as actually used by Applicant at the aforesaid time up to and including the present date.

I further declare that I am authorized to make this Declaration on Applicant's behalf, that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any registration of the mark issuing thereon.

The Source-I, Inc.
By: Wayne Wilson Pres.
Wayne Wilson, President

Date: 4-17-00

ATTACHMENT 3



617880

SCHROEDER & SIEGFRIED
A PROFESSIONAL ASSOCIATION
PATENT AND TRADEMARK LAW
2340 IDS CENTER
MINNEAPOLIS, MINNESOTA 55402-2155

EVERETT J. SCHROEDER
KENNETH D. SIEGFRIED
MARK A. WURM

August 27, 1986

TELEPHONE
(612) 339-0120

TELEX
5106004506
SCHROFRIED MPS

HON. COMMISSIONER OF PATENTS & TRADEMARKS
Washington, D.C. 20231

Re: O.N. 60356 U.S. Service Mark Application
Applicant: Dunham's Athleisure Corporation
Mark : SINCE 1937 DUNHAM'S SPORTS OUTFITTERS
Plus Design

Dear Sir:

Enclosed herewith are the following papers in connection with filing an application for registration of the above-identified service mark:

- 1] Complete application properly executed;
- 2] Drawing in the case;
- 3] Five (5) facsimiles of the mark; and
- 4] \$175 Filing Fee.

In the event the amount submitted herewith is insufficient in any respect, the Commissioner is hereby authorized to charge the balance needed to our Deposit Account No. 19-0715 and notify us of the same.

Please place this application on file at your earliest convenience.

Respectfully,



617880

Mark: SINCE 1937
DUNHAM'S SPORTS OUTFITTERS
Plus Design

Int. Class No. 42

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS:

F4(03)
DF
F5(M1)

Dunham's Athleisure Corporation, a Delaware corporation,
5000 Dixie Highway, Drayton Plains, Michigan 48020.

The situs of the corporation is the same as the business address indicated above.

The above-identified applicant has adopted and is using the service mark shown in the accompanying drawing for use in connection with RETAIL STORE SERVICES FOR THE SALE OF SPORTING GOODS, EXCLUSIVE OF FOOTWEAR AND CLOTHING, and requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946. No claim is made to the exclusive right to the use of SPORTS OUTFITTERS apart from the mark as shown.

F3(042)

The mark was first used in connection with the services of applicant's predecessor in business in 1937; was first used in interstate commerce in connection with the services by applicant's predecessor in business in 1937; and is now in use in such commerce.

The mark has become distinctive of applicant's services as a result of substantially exclusive and continuous use in interstate commerce for the five years next preceding the date of filing this application.

PRINT

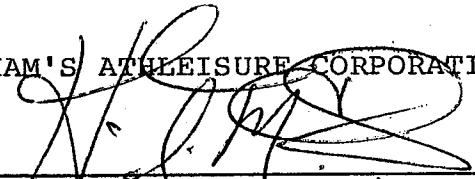
HARVEY THOMAS MCLAIN, being duly sworn, states that:

He is President of applicant corporation and is authorized to execute this affidavit on behalf of said corporation; he believes the said corporation to be the owner of the mark sought to be registered; to the best of his knowledge and belief, no other person, firm, corporation or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the services of such other person, to cause confusion, or to cause mistake, or to deceive; and the facts set forth in this application are true.

Applicant hereby appoints [Everett J. Schroeder, Reg.No. 16,695; Kenneth D. Siegfried, Reg.No. 19,214; and Mark A. Wurm, Reg.No. 31,682; of Schroeder & Siegfried, P.A., 2340 IDS Center, Minneapolis, Minnesota 55402-2155] - Telephone: 612/339-0120, to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to received the Certificate of Registration.

FG (MN)

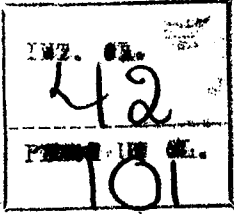
DUNHAM'S ATHLEISURE CORPORATION

By 
Harvey Thomas McLain
Its Vice President and Secretary

STATE OF MINNESOTA]] ss.
COUNTY OF HENNEPIN]

SUBSCRIBED and SWORN to before me, a Notary Public, this 12th day of AUGUST, 1986.





617880

Dunham's Athleisure Corporation
5000 Dixie Highway
Drayton Plains, Michigan 48020

First use: by applicant's predecessor
in business in 1937

Int. Class No. 42

RETAIL STORE SERVICES FOR THE SALE OF
SPORTING GOODS, EXCLUSIVE OF FOOTWEAR
AND CLOTHING

SINCE 1937 DUNHAM'S SPORTS OUTFITTERS

1496249

