

ESTTA Tracking number: **ESTTA236903**

Filing date: **09/16/2008**

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	The B.V.D. Licensing Corporation
Granted to Date of previous extension	09/17/2008
Address	1 Fruit of the Loom Drive Bowling Green, KY 42103 UNITED STATES
Attorney information	Carrie A. Shufflebarger Greenebaum Doll & McDonald PLLC 2900 Chemed Center 255 East Fifth Street Cincinnati, OH 45202 UNITED STATES cas1@gdm.com, lke@gdm.com, plg@gdm.com Phone:513.455.7604

Applicant Information

Application No	77361882	Publication date	05/20/2008
Opposition Filing Date	09/16/2008	Opposition Period Ends	09/17/2008
Applicant	Goddard, Shane 1914 Shafer Drive Murfreesboro, TN 37128 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2007/06/14 First Use In Commerce: 2007/06/14 All goods and services in the class are opposed, namely: Hats; Jackets; Shirts; Underwear

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	49931	Application Date	07/15/1905
Registration Date	02/27/1906	Foreign Priority Date	NONE
Word Mark	B.V.D.		
Design Mark			

Description of Mark	NONE
Goods/Services	Class U039 (International Class 025). First use: First Use: 1876/09/01 First Use In Commerce: 1876/09/01 UNDERSHIRTS AND UNDER-DRAWERS

U.S. Registration No.	546353	Application Date	06/17/1950
Registration Date	08/07/1951	Foreign Priority Date	NONE
Word Mark	B.V.D.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1948/03/23 First Use In Commerce: 1948/03/23 HOSE FOR MEN		

U.S. Registration No.	587588	Application Date	11/28/1952
Registration Date	03/30/1954	Foreign Priority Date	NONE
Word Mark	"NEXT TO MYSELF I LIKE B.V.D. BEST"		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 025). First use: First Use: 1944/01/01 First Use In Commerce: 1944/01/01 CLOTHING FOR MEN AS FOLLOWS: [UNDERSHIRTS,] UNDERSHORTS, ATHLETIC SHIRTS, T-SHIRTS [, NIGHT SHIRTS, SPORT SHIRTS UNION SUITSBRIEFS, DRAWERS, PAJAMAS, LOUNGING ROBES; CLOTHING FOR WOMEN AS FOLLOWS: SPORT SHIRTS, PAJAMAS]		

U.S. Registration No.	764348	Application Date	04/30/1963
Registration Date	02/04/1964	Foreign Priority Date	NONE
Word Mark	B.V.D.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1876/09/01 First Use In Commerce: 1876/09/01 Men's and Boys' [Dress,] [Sport and Work Shirts, Sweat Shirts,] T-Shirts, [Jackets, Work Jackets, Slacks, Pants, Walking Shorts, Clam Diggers, Overalls, Coveralls, Work Pants, Dungarees, Neckties,] [Socks,] [Slipper Socks,] [Lounging Robes, Pajamas,] Underwear, [and Beachwear Consisting of Swim Trunks, Cabana Sets and Beach Robes; Women's Sport Shirts;] [Girls' and Infants' Socks;] [Children's Playsuits, Shorts, Slacks, Pants, Shirts, Dungarees, and Jackets]		

U.S. Registration	2853880	Application Date	07/02/2003
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No.			
Registration Date	06/15/2004	Foreign Priority Date	NONE
Word Mark	BVD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/03/28 First Use In Commerce: 2003/03/28 Men's and Boys' T-Shirts		

U.S. Registration No.	2899674	Application Date	06/25/2003
Registration Date	11/02/2004	Foreign Priority Date	NONE
Word Mark	BVD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/03/28 First Use In Commerce: 2003/03/28 Men's and boys' underwear		

U.S. Registration No.	3475888	Application Date	12/14/2007
Registration Date	07/29/2008	Foreign Priority Date	NONE
Word Mark	THE LEGENDARY QUALITY OF BVD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2004/02/13 First Use In Commerce: 2004/02/13 T-shirts; Briefs; Underwear		

Attachments	71599306#TMSN.gif (1 page)(bytes) 71638684#TMSN.gif (1 page)(bytes) 78269632#TMSN.gif (1 page)(bytes) 78267085#TMSN.jpeg (1 page)(bytes) 77352812#TMSN.jpeg (1 page)(bytes) BTD Notice of Opposition.pdf (6 pages)(139334 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Carrie A. Shufflebarger/
Name	Carrie A. Shufflebarger
Date	09/16/2008

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

In the Matter of

Application No. : 77/361,882
Applicant : Shane Goddard
Mark : BTD (Stylized)
Filing Date : December 31, 2007
Publication Date : May 20, 2008
Opposed Classes: : 25

The B.V.D. Licensing Corporation	:	
	:	
Opposer,	:	
	:	Opposition No. _____
v.	:	
	:	
Shane Goddard	:	
	:	
Applicant.	:	
	:	

NOTICE OF OPPOSITION

The B.V.D. Licensing Corporation (“Opposer”), a Delaware corporation having a mailing address at One Fruit of the Loom Drive, Bowling Green, Kentucky 42103, believes it will be damaged by registration in Class 25 of the mark shown in Application Serial No. 77/361,882, and hereby opposes registration of the same by Shane Goddard (“Applicant”).

As grounds of opposition, it is alleged that:

1. Opposer is the owner of the mark BVD, as well as marks consisting of or incorporating the mark BVD, and the owner of numerous federal registrations therefor, including without limitation the following, all of which are valid and subsisting, and many of which are incontestable under 15 U.S.C. §1065 (collectively, the “BVD Marks”):

Trademark	Registration No.	Registration Date	Goods
B.V.D.	49,931	2/27/1906	Undershirts and under- drawers
B.V.D. (Stylized) 	546,353	8/7/1951	Hose for men
NEXT TO MYSELF I LIKE B.V.D. BEST	587,588	3/30/1954	Clothing for men as follows: undershorts, athletic shirts, T-shirts
B.V.D.	764,348	2/4/1964	Men's and boys' T-shirts, underwear
BVD (Stylized) 	2,853,880	6/15/2004	Men's and boys' T-shirts
BVD & Design 	2,899,674	11/2/2004	Men's and boys' underwear
THE LEGENDARY QUALITY OF BVD	3,475,888	07/29/2008	T-shirts; Briefs; Underwear

2. Opposer and its predecessors in interest have used the trademark BVD continuously since at least as early as 1876 in connection with the manufacture and sale of clothing, and Opposer is currently using its BVD Marks in the U.S.

3. Opposer and its predecessors in interest have expended substantial amounts of money, time, and effort over many years advertising, promoting, and popularizing the BVD Marks, and in preserving the good will associated therewith. To date, Opposer has spent

millions of dollars in such advertising and promotion, resulting in billions of dollars in sales of products bearing the BVD Marks.

4. By virtue of these efforts and the excellence of its goods, Opposer has gained a valuable reputation for its BVD Marks, which have become distinctive of and associated in the minds of the trade and purchasing public with Opposer as a well-known provider of its goods.

5. On December 31, 2007, Applicant filed an application under Section 1(a) of the Lanham Act to register the mark BTM (Stylized), which application was assigned Serial No. 77/361,882. Applicant claims a first use date of June 14, 2007, and seeks registration of the mark BTM (Stylized) in Class 25 for "Hats; Jackets; Shirts; Underwear."

6. Applicant's mark was published for opposition in the Official Gazette of the United States Patent and Trademark Office May 20, 2008.

7. Priority is not an issue. Opposer used its BVD marks with clothing well prior to Applicant's alleged first use date and application date, and Opposer is presently using its BVD Marks with such goods.

8. Applicant's mark BTM (Stylized) is similar in appearance, sound and commercial impression to Opposer's BVD Marks.

9. The Class 25 goods identified in Application No. 77/361,882 are closely related and/or identical to the goods sold under Opposer's BVD Marks.

10. Applicant's application to register the mark BTM (Stylized) and any use Applicant has made of said mark are without Opposer's consent.

COUNT 1 – LIKELIHOOD OF CONFUSION

11. Opposer realleges Paragraphs 1 through 10 as if fully set forth herein.

12. Applicant's use and registration of the mark BTD (Stylized) is likely to cause confusion, to cause mistake, or to deceive insofar as consumers are likely to believe that Applicant's goods are those of Opposer, or that such goods are authorized and/or sponsored by or otherwise connected with Opposer, thus damaging Opposer's valuable and established goodwill and reputation.

13. The mark BTD (Stylized) in Application No. 77/361,882 so resembles Opposer's BVD Marks as to be likely, when applied to the goods of Applicant, to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

COUNT 2 – DILUTION

14. Opposer realleges Paragraphs 1 through 13 as if fully set forth herein.

15. Since long prior to Applicant's December 31, 2007 filing date or its June 14, 2007 alleged date of first use, each of Opposer's BVD Marks had become distinctive and famous within the meaning of the Lanham Act, 15 U.S.C. §1125(c), and BVD has been famous in the United States since the late 19th century.

16. The mark BTD (Stylized) in application Serial No. 77/361,882 so resembles Opposer's famous BVD Marks as to be likely, when applied to the goods of Applicant, to cause dilution of the distinctive quality of Opposer's BVD Marks within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

17. Opposer would be damaged by registration of the mark BTD (Stylized) because registration would grant Applicant statutory rights under the Trademark Act of 1946, and would tend to restrict, interfere with, and damage Opposer in the unhampered conduct of its business and protection of its legitimate interests.

WHEREFORE, Opposer prays that Applicant's application to register the mark BTD (Stylized) in International Class 25 in U.S. Trademark Application Serial No. 77/361,882 be rejected, and that registration of said mark in International Class 25 be refused and denied.

Please charge the filing fee of \$300 and any additional fees to Greenebaum Doll & McDonald PLLC's Deposit Account, No. 50-2904, the account of Opposer's counsel noted below.

Please direct all correspondence to Carrie A. Shufflebarger, Esq., at Greenebaum Doll & McDonald PLLC, 2900 Chemed Center, 255 East Fifth Street, Cincinnati, Ohio 45202-4728, and all calls to the same at (513) 455-7604.

Respectfully submitted,

/s/ Carrie A. Shufflebarger

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Date: September 16, 2008

Notice of Opposition
In re Application Serial No. 77/361,882
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CERTIFICATE OF FILING

I certify that this NOTICE OF OPPOSITION is being submitted electronically to the Trademark Trial and Appeal Board at the United States Patent and Trademark Office on this 16th day of September, 2008.

/s/ Carrie A. Shufflebarger
Carrie A. Shufflebarger

CERTIFICATE OF SERVICE

I certify that a copy of this NOTICE OF OPPOSITION is being served via United States mail, postage prepaid, on the following, on this 16th day of September, 2008.

Shane Goddard
1914 Shafer Dr.
Murfreesboro, TN 37128-2880

/s/ Carrie A. Shufflebarger
Carrie A. Shufflebarger