

ESTTA Tracking number: **ESTTA383773**

Filing date: **12/15/2010**

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	Retail Royalty Company
Granted to Date of previous extension	12/15/2010
Address	101 Convention Center Drive Las Vegas, NV 89109 UNITED STATES

Attorney information	Kristin G. Garris Kilpatrick Stockton LLP 1001 West Fourth Street Winston-Salem, NC 27101 UNITED STATES lamiller@kilpatrickstockton.com, tmadmin@kilpatrickstockton.com, kgarris@kilpatrickstockton.com
----------------------	--

Applicant Information

Application No	77969536	Publication date	08/17/2010
Opposition Filing Date	12/15/2010	Opposition Period Ends	12/15/2010
Applicant	Hawke & Company Outfitters LLC 131 W. 35th Street, 7th Floor New York, NY 10001 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Jackets, shirts, pants, swimwear, socks, hats, belts and scarves

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2086693	Application Date	03/11/1993
Registration Date	08/12/1997	Foreign Priority Date	NONE
Word Mark	AMERICAN EAGLE OUTFITTERS		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1977/10/00 First Use In Commerce: 1977/10/00 clothing; namely, outerwear; namely, coats, vests, parkas, and anoraks, pants, jeans, shorts, sweaters, shirts, underwear, neckwear, headwear, belts, hosiery, skirts, jackets, blazers, footwear, fleecewear; namely, fleece sweatshirts and fleece jackets Class 042. First use: First Use: 1977/10/00 First Use In Commerce: 1977/10/00 retail clothing store services

U.S. Registration No.	2050115	Application Date	01/24/1994
Registration Date	04/08/1997	Foreign Priority Date	NONE
Word Mark	AMERICAN EAGLE OUTFITTERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1983/08/00 First Use In Commerce: 1983/08/00 footwear, slippers, leather and rubber boots, and insoles		

U.S. Registration No.	2856574	Application Date	01/03/2003
Registration Date	06/22/2004	Foreign Priority Date	NONE
Word Mark	AMERICAN EAGLE OUTFITTERS EST. 1977 SERIAL NO# 01977-AE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/02/15 First Use In Commerce: 2003/02/15 Jeans, denim pants, denim shorts, denim skirts, denim jackets, denim vests		

U.S. Registration No.	3888496	Application Date	02/26/2009
Registration Date	12/14/2010	Foreign Priority Date	NONE
Word Mark	AMERICAN EAGLE OUTFITTERS		

Design Mark	<p style="text-align: center;">AMERICAN EAGLE OUTFITTERS</p>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1977/00/00 First Use In Commerce: 1998/05/00 Retail store services and online retail store services in the field of clothing, clothing accessories, footwear and headwear, and bags

U.S. Registration No.	3878197	Application Date	01/31/2006
Registration Date	11/16/2010	Foreign Priority Date	NONE

Word Mark	NONE
-----------	------

Design Mark	
-------------	---

Description of Mark	NONE
---------------------	------

Goods/Services	<p>Class 003. First use: First Use: 2006/10/00 First Use In Commerce: 2006/10/00 After-shave lotions, body cream, cologne, perfume, liquid soaps for hand, face, and body</p> <p>Class 018. First use: First Use: 2004/07/00 First Use In Commerce: 2004/07/00 Athletic bags, backpacks, barrel bags, beach bags, book bags, duffel bags, shoulder bags, tote bags, clutch purses, coin purses, drawstring pouches, handbags, purses, and wallets</p> <p>Class 025. First use: First Use: 2003/08/00 First Use In Commerce: 2003/08/00 Clothing and accessories, namely, blazers, vests, sweaters, turtleneck sweaters, skirts, pants, jeans, shorts, shirts, t-shirts, blouses, polo shirts, rugby shirts, sweatshirts, sweatpants; swimwear; sleepwear; underwear, namely, boxer shorts, shell bra tanks, and undershirts; outerwear, namely, jackets, vests, coats, pea coats, gloves, scarves; belts; footwear, namely, socks, shoes, slippers, leather boots, sandals, flipflops, sneakers, clogs and slides; canvas shoes, headwear, namely, hats, caps, baseball caps, visors, headbands</p> <p>Class 035. First use: First Use: 2004/07/00 First Use In Commerce: 2004/07/00 Retail store services, computerized online retail store services, and phone order</p>
----------------	--

	services all featuring a wide range of goods in the nature of fragrances, personal care goods; sunglasses; jewelry and wristwatches; a wide range of bags and wallets, handbags, purses, shoulder bags, school bags, backpacks, duffle bags; and wearing apparel and clothing accessories, namely, clothing, headwear and footwear
--	--

Attachments	76480046#TMSN.gif (1 page)(bytes) 77679197#TMSN.jpeg (1 page)(bytes) 78803194#TMSN.jpeg (1 page)(bytes) HAWKE & CO. OUTFITTER & design_Notice of Opposition._Dec 15.pdf (9 pages)(81232 bytes)
-------------	--

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	/Kristin Garris/
Name	Kristin G. Garris
Date	12/15/2010

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

In the Matter of Serial No. 77/969,536
Mark: HAWKE & CO. OUTFITTER and Design



Filing Date: March 26, 2010
Publication Date: August 17, 2010
Our Reference No.: 57289-389728

RETAIL ROYALTY COMPANY,

Opposer,

v.

HAWKE & COMPANY OUTFITTERS LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer is Retail Royalty Company, a Nevada corporation with an address at 101 Convention Center Drive, Las Vegas, Nevada 89109 (“Opposer”). Opposer believes that it will be damaged by the registration of the trademark shown in Application Serial No. 77/969,536 (the “Application”) and hereby opposes the same pursuant to 15 U.S.C. § 1063.

As grounds for its opposition, Opposer alleges as follows:

1. Opposer, together with its affiliated company American Eagle Outfitters, Inc. (collectively “AEO”), is a leading retailer that designs, markets, and sells clothing, footwear, accessories, and other products and operates retail stores under multiple word and design

trademarks including AMERICAN EAGLE OUTFITTERS and the eagle design shown below (the “AEO Eagle Design”):



The AMERICAN EAGLE OUTFITTERS Mark

2. Since at least as early as 1977, AEO has continuously used the AMERICAN EAGLE OUTFITTERS trademark in interstate commerce to identify the full range of apparel, accessories and other products sold in its AMERICAN EAGLE OUTFITTERS retail stores and on its website. The goods offered and sold under the AMERICAN EAGLE OUTFITTERS mark include, but are not limited to, coats, vests, parkas, pants, jeans, shorts, sweaters, shirts, underwear, neckwear, headwear, belts, hosiery, skirts, jackets, blazers, footwear, fleece sweatshirts and fleece jackets, and leather and rubber boots, among other goods. AEO has also continuously used the AMERICAN EAGLE OUTFITTERS mark in interstate commerce in connection with its retail store services and related services for such clothing and accessories since at least 1977.

3. AEO operates more than 950 stand-alone retail stores under the AMERICAN EAGLE OUTFITTERS mark, and offers products bearing the AMERICAN EAGLE OUTFITTERS mark in all such stores, as well as on its web site <www.ae.com>.

4. AEO has spent substantial sums of money to promote the goods and services offered under the AMERICAN EAGLE OUTFITTERS mark. Based on AEO’s extensive use and promotion of the AMERICAN EAGLE OUTFITTERS mark, the AMERICAN EAGLE OUTFITTERS mark has acquired a highly favorable reputation and goodwill, and has come to

be immediately identified with AEO. Accordingly, AEO has developed broad rights at common law in the AMERICAN EAGLE OUTFITTERS mark.

5. In addition to its common law rights, AEO is the owner of, *inter alia*, the following U.S. trademark and service mark registrations for the AMERICAN EAGLE OUTFITTERS mark or a variation thereof:

Mark	Reg. No.	Goods/Services	Reg. Date
AMERICAN EAGLE OUTFITTERS	2086693	clothing; namely, outerwear; namely, coats, vests, parkas, and anoraks, pants, jeans, shorts, sweaters, shirts, underwear, neckwear, headwear, belts, hosiery, skirts, jackets, blazers, footwear, fleecewear; namely, fleece sweatshirts and fleece jackets (Class 25) retail clothing store services (Class 42)	August 12, 1997
AMERICAN EAGLE OUTFITTERS	2050115	footwear, slippers, leather and rubber boots, and insoles (Class 25)	April 8, 1997
AMERICAN EAGLE OUTFITTERS	3888496	Retail store services and online retail store services in the field of clothing, clothing accessories, footwear and headwear, and bags (Class 35)	December 14, 2010
 AMERICAN EAGLE OUTFITTERS EST. 1977 SERIAL NO# 01977-AE	2856574	Jeans, denim pants, denim shorts, denim skirts, denim jackets, denim vests (Class 25)	June 22, 2004

Collectively, the above-listed registrations for the AMERICAN EAGLE OUTFITTERS mark and a variation thereof will be referred to hereinafter as the “AMERICAN EAGLE OUTFITTERS Mark.”

The AEO Eagle Design

6. Since at least as early as 2003, AEO has also continuously used the AEO Eagle Design as a design mark to identify its AMERICAN EAGLE OUTFITTERS products and retail stores. The labels on AEO’s merchandise depict both marks, as shown below:



7. AEO has spent substantial sums of money to promote the goods and services offered under the AEO Eagle Design. Based on AEO’s extensive use and promotion of the AEO Eagle Design, the AEO Eagle Design has acquired a highly favorable reputation and goodwill, and has come to be immediately identified with AEO. Accordingly, AEO has developed broad rights at common law in the AEO Eagle Design.

8. In addition to its common law rights, AEO is the owner of the following U.S. trademark and service mark registration for the AEO Eagle Design (the “AEO Eagle Design Mark”):



Reg. No.	Goods/Services	Reg. Date
3878197	After-shave lotions, body cream, cologne, perfume, liquid soaps for hand, face, and body (Class 3) Athletic bags, backpacks, barrel bags, beach bags,	November 16, 2010

	<p>book bags, duffel bags, shoulder bags, tote bags, clutch purses, coin purses, drawstring pouches, handbags, purses, and wallets (Class 18)</p> <p>Clothing and accessories, namely, blazers, vests, sweaters, turtleneck sweaters, skirts, pants, jeans, shorts, shirts, t-shirts, blouses, polo shirts, rugby shirts, sweatshirts, sweatpants; swimwear; sleepwear; underwear, namely, boxer shorts, shell bra tanks, and undershirts; outerwear, namely, jackets, vests, coats, pea coats, gloves, scarves; belts; footwear, namely, socks, shoes, slippers, leather boots, sandals, flipflops, sneakers, clogs and slides; canvas shoes, headwear, namely, hats, caps, baseball caps, visors, headbands (Class 25)</p> <p>Retail store services, computerized online retail store services, and phone order services all featuring a wide range of goods in the nature of fragrances, personal care goods; sunglasses; jewelry and wristwatches; a wide range of bags and wallets, handbags, purses, shoulder bags, school bags, backpacks, duffel bags; and wearing apparel and clothing accessories, namely, clothing, headwear and footwear (Class 35)</p>	
--	---	--

9. Notwithstanding AEO’s prior rights in its AMERICAN EAGLE OUTFITTERS Mark and AEO Eagle Design Mark in connection with clothing, accessories, and related goods and services, Hawke & Company Outfitters LLC (the “Applicant”), with an address at 131 W. 35th Street, 7th Floor, New York, New York 10001, filed an intent-to-use application on March 26, 2010, in the U.S. Patent and Trademark Office for registration of the mark shown below (the “HAWKE & CO. OUTFITTER & Bird Design Mark”):



10. The description of goods in Applicant's Application includes "[j]ackets, shirts, pants, swimwear, socks, hats, belts and scarves" in International Class 25.

11. There is no issue as to priority. AEO began using its AMERICAN EAGLE OUTFITTERS Mark in commerce at least as early as 1977 and its AEO Eagle Design in commerce at least as early as 2003. AEO's use of its AMERICAN EAGLE OUTFITTERS Mark and AEO Eagle Design Mark pre-dates Applicant's actual or constructive first use of the HAWKE & CO. OUTFITTER & Bird Design Mark.

12. The mark Applicant seeks to register combines a silhouette of a bird confusingly similar to AEO's Eagle Design Mark with the name of a bird and the term OUTFITTER, which are the dominant elements of AEO's AMERICAN EAGLE OUTFITTERS Mark.

13. The goods listed by Applicant in the Application are identical to the goods offered by AEO under its AMERICAN EAGLE OUTFITTERS Mark and AEO Eagle Design Mark.

14. Accordingly, Applicant's use of the HAWKE & CO. OUTFITTER & Bird Design Mark for the goods set forth in the Application is likely to cause consumers to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of AEO, or that Applicant is in some way connected with, sponsored by, or affiliated with AEO, all in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and with consequent injury to AEO and the public.

15. Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), AEO believes that it will be damaged by registration of Applicant's HAWKE & CO. OUTFITTER & Bird Design Mark in that members of the purchasing public are likely to be confused or mistaken that Applicant's goods offered under Applicant's HAWKE & CO. OUTFITTER & Bird Design Mark originate from AEO, or from the same source as goods sold under AEO's AMERICAN

EAGLE OUTFITTERS Mark and AEO Eagle Design Mark, or that such goods of Applicant are sponsored by, endorsed by, or affiliated with the source of goods sold under the AMERICAN EAGLE OUTFITTERS Mark and AEO Eagle Design Mark. Such likelihood of confusion results in damage to the goodwill among purchasers and the trade that the AMERICAN EAGLE OUTFITTERS Mark and AEO Eagle Design Mark symbolize.

16. Registration of Applicant's HAWKE & CO. OUTFITTER & Bird Design Mark will support and assist Applicant in the confusing and misleading use of Applicant's HAWKE & CO. OUTFITTER & Bird Design Mark, and, in addition, will give color and exclusive statutory right to Applicant in violation and derogation of AEO's prior and superior rights in its AMERICAN EAGLE OUTFITTERS Mark and AEO Eagle Design Mark.

WHEREFORE, Opposer requests that that registration of Application Serial No. 77/969,536 be denied pursuant to 15 U.S.C. §§ 1052(d) and 1063(a).

The opposition fee in the amount of \$300.00 for a notice of opposition in one class is filed herewith. If for any reason this amount is insufficient, it is requested that Kilpatrick Stockton LLP's Deposit Account No. 11-0855 be charged with any deficiency. This paper is being filed electronically.

Please recognize Lisa Pearson, Laura C. Miller, Kristin G. Garris and the law firm of Kilpatrick Stockton LLP as attorneys for Opposer in connection with this opposition proceeding. Please address all correspondence regarding this proceeding to Laura Miller at Kilpatrick Stockton LLP, 1001 West Fourth Street, Winston-Salem, NC 27101.

Dated: December 15, 2010

Respectfully submitted,

KILPATRICK STOCKTON LLP

By: /Kristin Garris/

Lisa Pearson
31 West 52nd Street, 14th Floor
New York, New York 10019
Telephone: (212) 775-8700
Facsimile: (212) 775-8800

Laura C. Miller
Kristin G. Garris
1001 West Fourth Street
Winston-Salem, NC 27101
Telephone: (336) 607-7300
Facsimile: (336) 607-7500

Attorneys for Opposer, Retail Royalty Company

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

In the Matter of Serial No. 77/969,536
Mark: HAWKE & CO. OUTFITTER and Design



Filing Date: March 26, 2010
Publication Date: August 17, 2010
Our Reference No.: 57289-389728

RETAIL ROYALTY COMPANY,

Opposer,

v.

HAWKE & COMPANY OUTFITTERS LLC,

Applicant.

Opposition No. _____

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** has been served on the attorney-of-record for Applicant Hawke & Company Outfitters LLC by mailing said copy on December 15, 2010, via First Class Mail, postage prepaid, and addressed as follows:

BERNARD MALINA
MALINA & ASSOCIATES, PLLC
444 MADISON AVE FL 17
NEW YORK, NY 10022-6903

/Kristin Garris/
Kristin G. Garris
*Attorney for Opposer,
Retail Royalty Company*