

ESTTA Tracking number: **ESTTA408341**

Filing date: **05/11/2011**

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		
Entity	Corporation	Citizenship	Delaware
Address	One Fruit of the Loom Drive Bowling Green, KY 42103 UNITED STATES		

Attorney information	Carrie A. Shufflebarger Thompson Hine, LLP 312 Walnut Street Fourteenth Floor Cincinnati, OH 45202 UNITED STATES carrie.shufflebarger@thompsonhine.com, lou.ebling@thompsonhine.com, sharon.bella@thompsonhine.com, docket@thompsonhine.com, ipdocket@thompsonhine.com Phone:513.352.6678
----------------------	--

Applicant Information

Application No	85071284	Publication date	05/10/2011
Opposition Filing Date	05/11/2011	Opposition Period Ends	06/09/2011
Applicant	Black Veil Brides Touring, Inc. c/o Mitchell Silberberg & Knupp LLP 11377 West Olympic Boulevard Los Angeles, CA 900641683 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: CLOTHING, NAMELY, PANTS, SHIRTS, T-SHIRTS, CAPS, JACKETS AND SWEATSHIRTS

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			

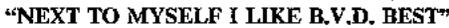
Description of Mark	NONE
Goods/Services	Class U039 (International Class 025). First use: First Use: 1876/09/01 First Use In Commerce: 1876/09/01 UNDERSHIRTS AND UNDER-DRAWERS

U.S. Registration No.	367184	Application Date	11/30/1938
Registration Date	05/09/1939	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: 1876/00/00 First Use In Commerce: 1876/00/00 [CLOTHING FOR MEN AS FOLLOWS--] UNDERWEAR [OF WOVEN AND TEXTILE FABRICS, namely,], SHIRTS, [DRAWERS, UNION SUITS], SHORTS [AND SKI UNDERWEAR, PAJAMAS; ATHLETIC OUTER CLOTHING NAMELY, ATHLETIC SHIRTS AND RUNNING PANTS, BRIEFS, COMBINED GIRDLE AND KNIT SHORTS, BATHING SUITS, BATHING TRUNKS, SWEATERS; NEGLIGEE SHIRTS, SPORT SHIRTS, NIGHT SHIRTS, ROBES FOR PERSONAL WEAR, BEACHWEAR, TO WIT, WOVEN AND KNIT SHIRTS, HANDKERCHIEFS; CLOTHING FOR WOMEN AS FOLLOWS-- BATHING SUITS, BEACHWEAR, TO WIT, SLACKS, SHIRTS AND SHORTS, CAPES, SCARFS FOR PERSONAL WEAR, BANDANAS; SPORT SHIRTS, SWEATERS, HOUSECOATS, PAJAMAS, ROBES FOR PERSONAL WEAR, KNIT SKI SHIRTS] AND [SHORTS, UNION SUITS, HANDKERCHIEFS; CLOTHING FOR CHILDREN, UNDERWEAR, BATHING SUITS AND BATHING TRUNKS, AND CHILDREN'S WAIST SUITS]

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 No.	2853880	Application Date	07/02/2003
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	71413295#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) Notice of Opposition.pdf (6 pages)(95505 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	/Carrie A. Shufflebarger/
-----------	---------------------------

Name	Carrie A. Shufflebarger
Date	05/11/2011

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

In the Matter of

Application No. : 85/071,284
Applicant : Black Veil Brides Touring, Inc.
Mark : BVB (STYLIZED)
Filing Date : June 24, 2010
Publication Date : May 10, 2011
Opposed Class: : 25

The B.V.D. Licensing Corporation	:	
	:	
Opposer,	:	
	:	Opposition No. _____
v.	:	
	:	
Black Veil Brides Touring, Inc.	:	
	:	
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 International Class 25 of the mark shown in Application Serial No. 85/071,284 by Black Veil Brides Touring, Inc., a business organized under the laws of the state of California (“Applicant”), and hereby opposes registration of the same.

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.	First Use Date	Registration Date	Goods
B.V.D.	49,931	1876	2/27/1906	Undershirts and under-drawers
B.V.D.	367,184	1876	5/9/1939	Underwear; shirts; shorts
“NEXT TO MYSELF I LIKE B.V.D. BEST”	587,588	1944	3/30/1954	Clothing for men as follows: undershorts, athletic shirts, T-shirts
B.V.D.	764,348	1876	2/4/1964	Men’s and boys’ T-shirts, underwear
BVD (Stylized) 	2,853,880	2003	6/15/2004	Men’s and boys’ T-shirts
BVD & Design 	2,899,674	2003	11/2/2004	Men’s and boys’ underwear
THE LEGENDARY QUALITY OF BVD	3,475,888	2004	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 June 24, 2010, Applicant filed an application under Section 1(b) of the Lanham Act to register the mark BVB (Stylized) ("Applicant's Mark"), which application was assigned Serial No. 85/071,284. Applicant seeks to register Applicant's Mark for goods in International Classes 9, 16, and 25, including the following opposed goods in International Class 25: "CLOTHING, NAMELY, PANTS, SHIRTS, T-SHIRTS, CAPS, JACKETS AND SWEATSHIRTS."

6. Applicant's Mark was published for opposition in the Official Gazette of the United States Patent and Trademark Office May 10, 2011.

7. Priority is not an issue: Opposer used its BVD marks in U.S. commerce with clothing well prior to Applicant's filing date, and Opposer is presently using its BVD Marks with such goods.

8. Applicant's Mark is similar in appearance, sound, and commercial impression to Opposer's BVD Marks.

9. The opposed goods identified in Application No. 85/071,284 are identical and/or closely related to the goods sold under Opposer's BVD Marks.

10. Applicant's application to register Applicant's Mark and any use Applicant has made of said mark are without Opposer's consent.

11. Applicant's Mark 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). The aforesaid likelihood of confusion will damage Opposer within the meaning of 15 U.S.C. § 1063.

12. Since long prior to Applicant's filing date, 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.

13. Applicant's Mark 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).

14. Opposer would be damaged by registration of Applicant's Mark 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 U.S. Trademark Application Serial No. 85/071,284 to register the mark BVB (Stylized) in International Class 25 be rejected, and that registration of said mark in International Class 25 be refused and denied.

The filing fee of \$300 is being submitted herewith by a credit card of Opposer's counsel noted below.

Notice of Opposition
In re Application Serial No. 85/071,284
Page 5

Please direct all correspondence to Carrie A. Shufflebarger, Esq., at Thompson Hine, LLC, 312 Walnut Street, Fourteenth Floor, Cincinnati, Ohio 45202, and all calls to the same at (513) 352-6678.

Respectfully submitted,

/s/ Carrie A. Shufflebarger

Louis K. Ebling, Esq.

Carrie A. Shufflebarger, Esq.

Thompson Hine LLC

312 Walnut Street

Fourteenth Floor

Cincinnati, Ohio 45202

(513) 352-6678

(513) 241.4771 (facsimile)

carrie.shufflebarger@thompsonhine.com

lou.ebling@thompsonhine.com

Date: May 11, 2011

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 11th day of May, 2011.

/s/ Carrie A. Shufflebarger
Carrie A. Shufflebarger

CERTIFICATE OF SERVICE

I certify that a copy of this NOTICE OF OPPOSITION is being served via mail, postage prepaid, on the following, on this 11th day of May, 2011

LUCY B. ARANT
MITCHELL SILBERBERG & KNUPP LLP
11377 W OLYMPIC BLVD
LOS ANGELES, CA 90064-1625

/s/ Carrie A. Shufflebarger
Carrie A. Shufflebarger