

ESTTA Tracking number: **ESTTA454391**

Filing date: **02/01/2012**

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	PRL USA Holdings, Inc.
Granted to Date of previous extension	02/01/2012
Address	550 Seventh Avenue New York, NY 10018 UNITED STATES

Attorney information	G ROXANNE ELINGS GREENBERG TRAURIG LLP 200 PARK AVENUE FLOOR 14 NEW YORK, NY 10166-1400 UNITED STATES nytmdkt@gtlaw.com, elingsr@gtlaw.com, falbyo@gtlaw.com, biancoc@gtlaw.com Phone:212.801.9200
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Applicant Information

Application No	85275237	Publication date	10/04/2011
Opposition Filing Date	02/01/2012	Opposition Period Ends	02/01/2012
Applicant	BOUSKILA, Moshe 2056 E 21 Street Brooklyn, NY 11229 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2009/01/01 First Use In Commerce: 2009/01/01 All goods and services in the class are opposed, namely: Clothing for men, women and children, namely, shirts, jeans, denim jeans, pants, coats, dresses, jackets, headwear, hats, knit shirts, woven shirts, shorts, ties, swim wear, sweaters, socks, undergarments, belts, footwear, sneakers, sandals, outerwear, namely, coats and winter jackets
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
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.	1489796	Application Date	01/14/1987
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Registration Date	05/31/1988	Foreign Priority Date	NONE
Word Mark	LAUREN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1978/02/08 First Use In Commerce: 1978/02/08 [COLOGNE, TOILET SOAP,] TOILET WATER, [BODY LOTION, BATH OIL, BODY POWDER AND PERFUME]		

U.S. Registration No.	2246900	Application Date	10/25/1995
Registration Date	05/25/1999	Foreign Priority Date	NONE
Word Mark	LAUREN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1996/07/00 First Use In Commerce: 1996/07/00 wearing apparel, namely, topcoats, raincoats, jackets, suit jackets, suit coats, sport coats, sport jackets, blazers, blouses, shirts, shirt jackets, pants, skirts, dresses, sweaters, tee shirts, hats and scarves		

U.S. Registration No.	2643114	Application Date	10/23/1997
Registration Date	10/29/2002	Foreign Priority Date	NONE
Word Mark	LAUREN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/08/01 First Use In Commerce: 1996/08/01 RETAIL CLOTHING STORE SERVICES		

U.S. Registration No.	2419959	Application Date	03/11/1999
Registration Date	01/09/2001	Foreign Priority Date	NONE
Word Mark	LAUREN		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 014. First use: First Use: 1999/01/00 First Use In Commerce: 1999/07/00 Jewelry Class 018. First use: First Use: 1999/01/00 First Use In Commerce: 1999/07/00 Handbags, clutches, shoulder bags, tote bags, backpacks, duffle bags, travel bags, suit bags, satchels, garment bags for travel, coin purses, drawstring pouches, overnight bags, wallets and key cases

Attachments	75658400#TMSN.gif (1 page)(bytes) A Max Lauren.pdf (21 pages)(1104461 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	/GRE/
Name	G ROXANNE ELINGS
Date	02/01/2012

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

In re: U.S. Application Serial No. 85275237

Mark: MAX LAUREN

Published: October 4, 2011

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PRL USA HOLDINGS, INC.

NOTICE OF OPPOSITION

Opposer,

-against-

MOSHE BOUSKILA

Applicant.

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PRL USA HOLDINGS, INC. (hereinafter referred to as “Ralph Lauren” or “Opposer”) believes that it will be damaged by the registration of the above-identified trademark and hereby opposes the registration thereof:

FACTS

1. Upon information and belief, Moshe Bouskila (“Applicant”) is an individual, residing or having a place of business at 2056 E. 21st Street, Brooklyn, NY 11229.

2. On or about March 24, 2011, Applicant filed Application Serial No. 85275237 (the “Application”), pursuant to Section 1(a) of the Lanham Act, 15 U.S.C. §1051(a), to register the trademark MAX LAUREN (“Applicant’s Mark”), for use on or in connection with the following goods:

Class 25: Clothing for men, women and children, namely, shirts, jeans, denim jeans, pants, coats, dresses, jackets, headwear, hats, knit shirts, woven shirts, shorts, ties, swim wear, sweaters, socks, undergarments, belts, footwear, sneakers, sandals, outerwear, namely, coats and winter jackets.

3. On or about October 4, 2011, Applicant's Mark was published for opposition in the Official Trademark Gazette.

4. Opposer is a corporation organized and existing under the laws of the state of Delaware, having a place of business at 550 Seventh Avenue, New York, NY 10018.

5. In 1967, Mr. Ralph Lauren ("Mr. Lauren"), the iconic and award-winning designer, founded what has become one of the largest and most successful apparel and lifestyle companies in the United States, with multiple brands and trademarks bearing Mr. Lauren's name and embodying his reputation and goodwill. Mr. Lauren and Ralph Lauren are synonymous in the eyes of the consuming public.

6. Today, Ralph Lauren, is recognized as a leader in the design, manufacture, marketing and distribution of premium lifestyle products, *inter alia*, a full range of men's, women's and children's fashions, footwear, jewelry, luxury watches, handbags, fragrances, and consumer home goods ("Opposer's Goods").

7. For the past 45 years, Ralph Lauren's reputation and distinctive image have been consistently developed across an expanding number of products sold under its world renowned house mark, RALPH LAUREN, and other primary marks, such as LAUREN, LAUREN RALPH LAUREN and POLO RALPH LAUREN (collectively, the "LAUREN Marks" or "Opposer's Marks").

8. The LAUREN Marks have become well known, universally recognized and associated with distinctive design, luxury and quality.

9. The LAUREN Marks are the subject of numerous valid and subsisting United States trademark registrations on the Principal Register, some of which are incontestable, pursuant to Section 15 of the Lanham Act, 15 U.S.C. §1065, including, but not limited to, the marks depicted in the chart attached hereto as Exhibit A. There are currently more than 130

active United States trademark applications and registrations for the LAUREN Marks on the Principal Register.

10. Ralph Lauren markets and sells goods bearing the LAUREN Marks in the United States and throughout the world, including through approximately two hundred (200) Ralph Lauren retail stores, as well as through major department and fine retail stores, including Bloomingdale's, Saks Fifth Avenue, Nordstrom, Bergdorf Goodman, Macy's, Lord & Taylor, Belk, Dillard's, and Neiman Marcus.

11. Ralph Lauren also sells its goods on its Internet website located at <www.ralphlauren.com>, and through other online retailers, including, but not limited to, <www.nordstrom.com>, <www.macys.com> and <www.bloomingdales.com>.

12. Ralph Lauren has built its brand and its LAUREN Marks based on quality, success, integrity and a wholesome American lifestyle. Ralph Lauren's advertisements are specifically designed to evoke these qualities and feature, *inter alia*, clean cut models engaged in healthy activities.

13. Opposer has made a substantial investment solidifying this image in the public in the promotion of its goods that bear the LAUREN Marks.

14. Opposer has devoted significant resources to protect the strength, goodwill and value of the LAUREN Marks. Specifically, Ralph Lauren has expended significant time, effort, and money in advertising and promoting the goods and services sold under the LAUREN Marks in trade publications, magazines of general circulation, television ads, billboards, and the Internet, as well as through sporting event sponsorships and advertising and marketing by authorized retailers.

15. Opposer's Goods marketed under the LAUREN Marks have enjoyed widespread and unsolicited media coverage, in print, on television and the Internet, in publications including

The New York Times, Fortune, Vogue and Women's Wear Daily, to name a few. This media coverage has highlighted, *inter alia*, Ralph Lauren's financial success, the success of its marketing campaigns, the honors and awards bestowed upon it, Mr. Lauren's impact on American culture, and the history, fame and widespread recognition of the LAUREN Marks. Opposer and Mr. Lauren have received consistent recognition for the exceptional quality and design of the goods that bear the LAUREN Marks, which has heightened consumer awareness of Opposer's Goods and their quality.

16. As a result, the LAUREN Marks, along with other symbols and marks that are used to identify Opposer's goods in the market place, have achieved widespread fame and recognition among consumers.

17. Upon information and belief, Applicant appears to have commenced use of Applicant's Mark in commerce in connection with at least some of the goods identified in the Notice of Publication. Upon information and belief, Applicant is selling men's dress shirts bearing the label MAX LAUREN through various retail outlets including on the Internet through the retail web site <www.overstock.com>.

18. On March 24, 2011 Applicant submitted the following specimen of use demonstrating the way in which Applicant is using the MAX LAUREN mark on men's dress shirts:



19. As demonstrated below, Applicant's use of MAX LAUREN on its label is nearly identical in appearance to Opposer's use of RALPH LAUREN on its label for its men's dress shirts.



Applicant's Mark



Opposer's Mark

20. Opposer's use of the LAUREN Marks predates Applicant's use of Applicant's Mark in commerce.

COUNT I
LIKELIHOOD OF CONFUSION

21. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 20 herein.

22. The LAUREN Marks are famous in the United States and throughout the world.

23. Opposer commenced use of the LAUREN Marks well before Applicant filed the Application and/or commenced use of Applicant's Mark in commerce.

24. Applicant's Mark is similar to the LAUREN Marks in sight, sound, connotation and overall commercial impression.

25. Applicant's Mark incorporates Opposer's trademark, LAUREN.

26. The goods identified in the Application are identical or similar and/or related to the goods with which Opposer is using the LAUREN Marks.

27. The goods identified in the Application are identical or similar and/or related to the goods with which the LAUREN Marks are registered.

28. Registration of Applicant's Mark is likely to cause confusion, mistake, or deception as to the source of Applicant's goods in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

COUNT II
DILUTION

29. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 28 herein.

30. Through Opposer's extensive advertisement and promotion and substantial sales, the LAUREN Marks have become famous in the United States and throughout the world.

31. Any use by Applicant of Applicant's Mark has occurred after the LAUREN Marks became famous.

32. Relevant consumers are likely to make an association between Applicant's Mark and Opposer's LAUREN Marks.

33. Applicant's Mark is likely to impair the distinctiveness of Opposer's LAUREN Marks.

34. Applicant's Mark is likely to blur and/or tarnish the positive associations of Opposer's LAUREN Marks.

35. Thus, Applicant's registration and/or use of Applicant's Mark is likely to cause dilution of the distinctive quality of Opposer's LAUREN Marks in violation of Section 43 of the Lanham Act, 15 U.S.C. § 1125(c).

COUNT III
FALSE SUGGESTION OF CONNECTION

36. Opposer repeats and realleges each and every allegation set forth in paragraphs 1 through 35 herein.

37. Opposer is one of the most famous and successful apparel and lifestyle companies in the United States and throughout the world and uses “Polo Ralph Lauren,” “Ralph Lauren,” and “Lauren” as trade names.

38. Opposer’s LAUREN Marks are famous in the United States and throughout the world.

39. Mr. Lauren and Ralph Lauren are synonymous in the eyes of the consuming public.

40. Applicant’s Mark contains Opposer’s LAUREN trademark.

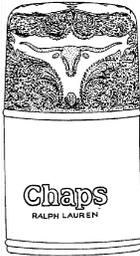
41. Applicant’s Mark creates the same or similar commercial impression or is a close approximation of Mr. Lauren’s personal name and identity, as well as the LAUREN Marks, the “Polo Ralph Lauren,” “Ralph Lauren” and “Lauren” trade names, and/or Opposer’s identity.

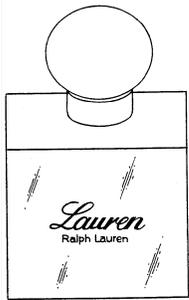
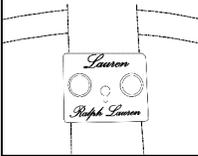
42. Applicant’s Mark is recognized as pointing uniquely and unmistakably to Mr. Lauren and Opposer and their respective identities.

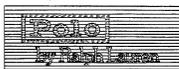
43. Neither Opposer nor Mr. Lauren is connected in any way with the goods of Applicant.

44. Due to the fame of Opposer, Mr. Lauren and the LAUREN Marks, when Applicant’s Mark is used in commerce, a connection with Mr. Lauren and Opposer is presumed by the consuming public.

45. Thus, Applicant’s registration and/or use of Applicant’s Mark is likely to create a false sense of connection to Mr. Lauren and Opposer in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

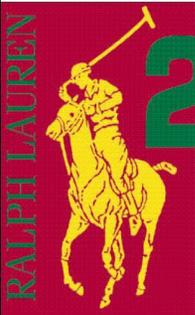
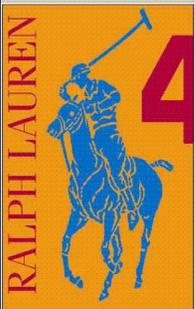
TRADEMARK	APP/REG. NO
BEAUTY BY RALPH LAUREN	SN:77-741936
CHAPS RALPH LAUREN	RN:1,269,952
CHAPS RALPH LAUREN	RN:1,649,559
CHAPS RALPH LAUREN	RN:2,966,823
	RN:1,222,279
	RN:1,259,034
DENIM & SUPPLY RALPH LAUREN	SN:85-284091
DENIM & SUPPLY RALPH LAUREN	SN:85-284101
DENIM & SUPPLY RALPH LAUREN	SN:85-284130
	RN:3,443,612
LAUREN	RN:1,489,796
LAUREN	RN:2,246,900
LAUREN	RN:2,643,114
LAUREN	RN:2,419,959
LAUREN	SN:77-815623

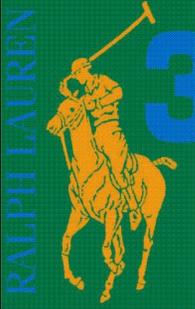
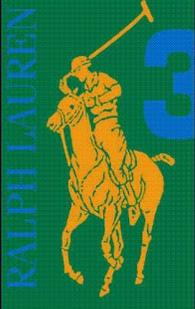
TRADEMARK	APP/REG. NO
LAUREN	SN:77-815625
LAUREN	SN:85-423503
LAUREN ACTIVE	RN:3,254,168
LAUREN JEANS COMPANY	RN:3,254,299
LAUREN RALPH LAUREN	RN:2,046,657
LAUREN RALPH LAUREN	RN:2,845,194
LAUREN RALPH LAUREN	RN:3,875,358
LAUREN RALPH LAUREN	RN:3,920,334
LAUREN RALPH LAUREN	RN:3,920,335
LAUREN RALPH LAUREN	RN:3,935,550
	RN:1,160,547
	RN:1,259,033
	SN:85-145341
LAUREN SPA	RN:3,718,981
LAUREN SUITE	RN:3,888,053
LOVE, RALPH LAUREN	RN:3,545,199
LRL LAUREN JEANS CO. RALPH LAUREN	

TRADEMARK	APP/REG. NO
	RN:4,082,400
POLO BEAR BY RALPH LAUREN	SN:85-120202
POLO BY RALPH LAUREN	RN:1,742,330
	RN:990,395
	RN:978,166
POLO RALPH LAUREN	RN:1,508,314
POLO RALPH LAUREN	RN:1,935,665
POLO RALPH LAUREN	RN:3,733,341
	RN:1,212,059
	RN:2,077,082
	RN:3,306,101
	RN:3,810,821
POLO RALPH LAUREN BLUE	RN:2,728,055
POLO RALPH LAUREN RED WHITE & BLUE	SN:77-735148
POLO RALPH LAUREN RED WHITE & BLUE	RN:3,902,098
POLO RALPH LAUREN SPORTSMAN	RN:1,622,636
RALPH LAUREN	RN:1,222,278
RALPH LAUREN	RN:1,412,059
RALPH LAUREN	RN:1,447,282

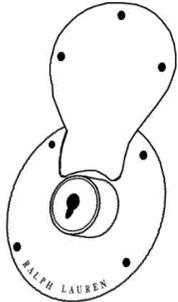
TRADEMARK	APP/REG. NO
RALPH LAUREN	RN:1,449,785
RALPH LAUREN	RN:1,445,307
RALPH LAUREN	RN:1,449,733
RALPH LAUREN	RN:1,469,151
RALPH LAUREN	RN:1,671,467
RALPH LAUREN	RN:1,624,989
RALPH LAUREN	RN:2,040,831
RALPH LAUREN	RN:1,914,205
RALPH LAUREN	RN:1,835,393
RALPH LAUREN	RN:1,962,237
RALPH LAUREN	RN:1,972,538
RALPH LAUREN	RN:1,976,324
RALPH LAUREN	RN:2,042,967
RALPH LAUREN	RN:2,077,090
RALPH LAUREN	RN:2,207,011
RALPH LAUREN	RN:2,567,308
RALPH LAUREN	RN:3,745,487
RALPH LAUREN	RN:3,521,190
RALPH LAUREN	RN:3,699,601
RALPH LAUREN	RN:3,877,439
RALPH LAUREN	RN:3,764,868
RALPH LAUREN	SN:85-020865
RALPH LAUREN	SN:85-020867
RALPH LAUREN	SN:85-020868

TRADEMARK	APP/REG. NO
RALPH LAUREN	SN:85-401801
RALPH LAUREN	SN:85-459386
	SN:77-866946
	SN:77-866976
	RN:3,874,992
	RN:3,884,401

TRADEMARK	APP/REG. NO
	SN:85-285806
	SN:77-866949
	SN:77-866979
	RN:3,874,994
	RN:3,884,393

TRADEMARK	APP/REG. NO
RALPH LAUREN 2 and Design 	SN:85-285802
	SN:77-866950
	SN:77-866981
	RN:3,874,993

TRADEMARK	APP/REG. NO
	RN:3,884,392
	SN:85-285814
	SN:77-866952
	SN:77-867140
	RN:3,874,995

TRADEMARK	APP/REG. NO
	RN:3,875,008
	SN:85-287457
Ralph  Lauren	RN:984,005
Ralph  Lauren	RN:1,203,658
	RN:3,259,886
	SN:85-121193
RALPH LAUREN BEAUTY	SN:77-665052
RALPH LAUREN BLUE	RN:2,846,306
RALPH LAUREN CLASSICS	RN:3,030,329

TRADEMARK	APP/REG. NO
RALPH LAUREN GLAMOUROUS	RN:2,568,195
RALPH LAUREN GOLF	RN:3,213,555
RALPH LAUREN NOTORIOUS	RN:3,514,013
RALPH LAUREN RLX	SN:78-797200
RALPH LAUREN ROMANCE	RN:2,318,372
RALPH LAUREN ROMANCE	RN:2,363,328
RALPH LAUREN ROMANCE	RN:3,380,738
RALPH LAUREN ROMANCE ALWAYS YOURS	RN:3,620,517
RALPH LAUREN ROMANCE SILVER	RN:2,902,464
	RN:3,060,044
	RN:3,305,576
RALPH LAUREN RUNWAY	RN:3,012,066
RALPH LAUREN SPORT	RN:3,218,130
RALPH LAUREN STIRRUP COLLECTION	SN:77-634450
RALPH LAUREN TARTAN COLLECTION	RN:3,963,230
RALPH LAUREN TENNIS	RN:3,215,910

TRADEMARK	APP/REG. NO
RALPH RALPH LAUREN	RN:3,920,333
RALPH RALPH LAUREN COOL	RN:2,993,206
RALPH RALPH LAUREN HOT	RN:3,170,046
RALPH RALPH LAUREN ROCKS	RN:3,292,321
RALPH RALPH LAUREN WILD	RN:3,833,271
	SN:85-302401
	SN:85-222090
RLX RALPH LAUREN	SN:78-797255
	RN:1,932,955
RUFF LAUREN	SN:85-270104
RUFF LAUREN	SN:85-407300

TRADEMARK	APP/REG. NO
 <p>The logo is a rectangular box with a double-line border. Inside, at the top, is a small tree icon. Below the icon, the word "SAFARI" is written in a large, bold, serif font. Underneath "SAFARI", the words "FOR MEN" are written in a smaller, all-caps, sans-serif font. At the bottom of the box, "RALPH LAUREN" is written in a medium-sized, all-caps, serif font.</p>	RN:1,845,305
 <p>The logo is a rectangular label with a decorative border. It features a central illustration of a polo player on horseback. Above the player, the words "TRADE MARK" are written in small letters. Below the player, the text "LAUREN R.L." is written in a larger font, followed by "REGISTERED" and "RALPH LAUREN" in smaller fonts.</p>	SN:85-141103
ULTIMATE RALPH LAUREN	SN:85-314533