

ESTTA Tracking number: **ESTTA471589**

Filing date: **05/09/2012**

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	Ashland Licensing and Intellectual Property LLC
Granted to Date of previous extension	07/08/2012
Address	3400 Blazer Parkway Lexington, KY 40509 UNITED STATES
Correspondence information	Ashland Inc 3400 Blazer Parkway Lexington, KY 40509 UNITED STATES emhoward@ashland.com, cmhughes@ashland.com Phone:859-357-7405

Applicant Information

Application No	85310158	Publication date	01/10/2012
Opposition Filing Date	05/09/2012	Opposition Period Ends	07/08/2012
Applicant	Total Import Solutions, Inc. 511 S. Harbor Blvd., #P La Habra, CA 90631 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. Opposed goods and services in the class: Automobile carpet and upholstery cleaning preparations; Cleaning preparations for cleaning surfaces; Upholstery cleaners
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1638817	Application Date	02/05/1990
Registration Date	03/26/1991	Foreign Priority Date	NONE
Word Mark	EAGLE ONE		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 003. First use: First Use: 1978/00/00 First Use In Commerce: 1978/00/00 automobile wheel cleaners, namely - magnesium and special finish cleaners, motorcycle wheel and engine cleaners, magnesium and chrome liquid and cream polishes, wire hub cap and kits consisting primarily of cleaning preparations for cleaning automobile wheels, wheel cover and white wall cleaning solutions, aluminum wheel wash and brighteners, tire cleaners, dressings and protectants and aluminum and chrome corrosion protective solutions; automobile finish cleaners, including washing solutions and wax conditioners, carnauba sprays, liquids and paste waxes and cleaners, pre-wax cleaners and conditioners and sealers and scratch remover solutions and detail solutions; and upholstery and interior cleaners, including spot removers, velour and fabric guards, cleaning solutions, creme leather solutions, plastic polishes, anti-fog solutions and glass cleaners
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U.S. Registration No.	1467894	Application Date	04/06/1987
Registration Date	12/08/1987	Foreign Priority Date	NONE
Word Mark	EAGLE ONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1978/07/00 First Use In Commerce: 1978/07/00 AUTOMOBILE CLEANERS AND POLISHES - NAMELY, WHEEL CLEANERS, PLASTIC POLISHES, TIRE DRESSINGS AND INTERIOR CLEANERS		

Related Proceedings	Automobile cleaners, liquid upholstery & interior cleaners, spot removers, velour & fabric guards, cleaning solutions & cream leather solutions
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Attachments	Notice of Opposition--EAGLE SHINE.pdf (6 pages)(19467 bytes) eagleone.pdf (2 pages)(151383 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	/vernon f. venne/
Name	Ashland Inc
Date	05/09/2012

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

<u>In re Application Serial No. 85310158</u>)	Opposition No. _____
Ashland Inc.)	
)	Mark: EAGLE SHINE
Opposer,)	Published for Opposition:
v.)	January 10, 2012
)	
Total Import Solutions, Inc.)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer, Ashland Inc. (hereafter “Ashland” or “Opposer”), is a corporation organized under the laws of the State of Delaware, having its principal place of business at 50 E. RiverCenter Blvd., Covington, Kentucky 41012-0391.

Opposer believes that it will be damaged by registration of the mark “**EAGLE SHINE**” shown in Application Serial No. 85310158, and hereby opposes same, and opposes registration for the goods set forth therein, namely:

Automobile carpet and upholstery cleaning preparations; cleaning preparations for cleaning surfaces; upholstery cleaners, in International Class 3.

The subject application (“Application”) was filed on May 2, 2011 under Section 1(b) of the Trademark Act, and published in the Official Gazette of January 10, 2012. Opposer obtained an extension of time to file an opposition to the Application, up to and including May 9, 2012. Thus, this Notice of Opposition is timely filed.

As grounds for the opposition, it is alleged that:

1. Ashland is the owner of several U.S. trademark registrations of marks that comprise or include the term EAGLE ONE, covering a variety of goods and services, namely:

- **EAGLE ONE**, U.S. Registration No. 1638817 covering automobile wheel cleaners, namely – magnesium and special finish cleaners, motorcycle wheel and engine cleaners, magnesium and chrome liquid and cream polishes, wire hub cap and kits consisting primarily of cleaning preparations for cleaning automobile wheels, wheel cover and white wall cleaning solutions, aluminum wheel wash and brighteners, tire cleaners, dressings and protectants and aluminum and chrome corrosion protective solutions; automobile finish cleaners, including washing dressings and protectants and aluminum and chrome corrosion protective solutions; automobile finish cleaners, including washing solutions and wax conditioners, carnauba sprays, liquids and paste waxes and clears pre-wax cleaners and conditioners and sealers and scratch remover solutions and detail solutions; and upholstery and interior cleaners, including spot removers, velour and fabric guards, cleaning solutions, crème leather solutions, plastic polishes, anti-fog solutions and glass cleaners. (Class 003)
- **EAGLE ONE**, U.S. Registration No. 1467894 covering automobile cleaners and polishers – namely, wheel cleaners, plastic polishes, tire dressings and interior cleaners (Class 003)

The above-listed registrations are presently valid and in good standing. Copies of the Certificates of Registration corresponding to each of the above-listed registrations are attached hereto as **Exhibit A**. In addition to the above-listed registrations, Ashland owns and uses several other marks comprised of or containing the term “EAGLE ONE” in connection with the goods and services it promotes through its website, and through other media. These marks and the above-listed registrations are collectively referred to hereinafter as the “EAGLE ONE Marks.”

2. Ashland uses the EAGLE ONE Marks in the online environment, including use in connection with interactive communications with existing and potential customers both through its website, and through social networking and social media services.

3. Ashland has continuously used one or more of the EAGLE ONE Marks in U.S. commerce in connection with the above-described goods and/or services on a continuous and exclusive basis since at least as early as 1978.

4. Ashland has expended substantial amounts of time, money and effort over the years in advertising, promoting and popularizing the EAGLE ONE Marks and in developing and preserving the good will associated therewith.

5. The public has come to know the EAGLE ONE Marks and recognize that any goods or services so marked originate with EAGLE ONE. The EAGLE ONE Marks have been so extensively used and advertised throughout the United States that these marks are associated exclusively with EAGLE ONE as a well-known provider of its goods.

6. The EAGLE ONE Marks are famous within the meaning of the Lanham Act, and have been famous for a number of years.

7. Upon information and belief, Applicant Total Import Solutions, Inc. (“Applicant”) is the owner of U.S. Trademark Application Serial No. 85310158 for the mark EAGLE SHINE for services described in the application as:

Automobile carpet and upholstery cleaning preparations; cleaning preparations for cleaning surfaces; upholstery cleaners, in International Class 003.

8. Upon information and belief, Applicant is a limited liability company organized under the laws of the State of California with an address of 511 S. Harbor Blvd., #P, La Habra, California, 90631.

12. Applicant's DAP APP mark is confusingly similar to Opposer's EAGLE ONE Marks in appearance, sound, meaning, connotation, and commercial impression, and is used in connection with services that are closely related to services offered by DAP.

13. Applicant knew or should have known of Opposer's EAGLE ONE Marks when it adopted the mark EAGLE SHINE.

14. Applicant's adoption and use of the mark EAGLE SHINE is without the license or permission of Opposer.

15. The mark Applicant seeks to register, namely, EAGLE SHINE, so resembles Opposer's EAGLE ONE Marks as to be likely, when applied to the goods of Applicant, to cause confusion or mistake or to deceive persons by creating the erroneous impression that Applicant's goods originate with or come from Opposer, or are authorized, licensed, endorsed, sponsored by, or are connected in some way with Opposer, and therefore, the registration thereof by Applicant would be injurious to Opposer.

16. Registration of the EAGLE SHINE mark by Applicant is barred by the provisions of 15 U.S.C. §1052(d), for the reason that it consists of or comprises a mark which so resembles Opposer's EAGLE ONE previously registered in the United States Patent and Trademark Office, previously used by Opposer and not abandoned, as to be likely, when used in connection with the services of Applicant, to cause confusion, mistake or to deceive. For the above reasons, any use of the mark EAGLE SHINE by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the services offered under the mark EAGLE SHINE emanate from or are otherwise sponsored or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

17. Applicant's use of the EAGLE SHINE mark is likely to cause dilution of the distinctiveness and good will associated with Opposer's EAGLE SHINE and therefore should be denied registration pursuant to 15 U.S.C. §1125(c).

18. By reason of the foregoing, Opposer will be damaged by registration of the EAGLE SHINE mark to Applicant.

The opposition fee in the amount of \$300.00 is filed herewith.

WHEREFORE, Opposer prays that said Application Serial No. 85310158 be rejected; that registration of the mark EAGLE SHINE as a trademark to Applicant be refused and denied; and that this opposition be sustained in Opposer's favor.

Opposer requests such other and further relief as the Board may deem just and proper.

Date: _____

Respectfully submitted,
Ashland Inc.

Vernon F. Venne
Attorney for Opposer, Ashland Inc.
Email: emhoward@ashland.com

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Notice of Opposition has been served upon the following by regular U.S. mail this ____ day of May 9, 2012:

Total Import Solutions, Inc.
511 S. Harbor Blvd., #P
La Habra, CA 90631

Vernon F. Venne
Attorney for Opposer, Ashland Inc.
Email: emhoward@ashland.com



Int. Cl.: 3

Prior U.S. Cls.: 4 and 52

United States Patent and Trademark Office

Reg. No. 1,467,894

Registered Dec. 8, 1987

**TRADEMARK
PRINCIPAL REGISTER**

EAGLE ONE

EGL 1, INC. (CALIFORNIA CORPORATION)
15 CHRYSLER
IRVINE, CA 92714

FOR: AUTOMOBILE CLEANERS AND POLISHES - NAMELY, WHEEL CLEANERS, PLASTIC POLISHES, TIRE DRESSINGS AND INTERIOR CLEANERS, IN CLASS 3 (U.S. CLS. 4 AND 52).

FIRST USE 7-0-1978; IN COMMERCE 7-0-1978.

OWNER OF U.S. REG. NOS. 1,130,649, 1,262,118 AND OTHERS.

SER. NO. 653,295, FILED 4-6-1987.

HELEN ROBERTS WENDEL, EXAMINING ATTORNEY



Int. Cl.: 3

Prior U.S. Cls.: 4 and 52

Reg. No. 1,638,817

United States Patent and Trademark Office Registered Mar. 26, 1991

**TRADEMARK
PRINCIPAL REGISTER**

EAGLE ONE

EGL 1, INC. (CALIFORNIA CORPORATION),
DBA EAGLE ONE INDUSTRIES
SUITE 210
2386 FARADAY AVENUE
CARLSBAD, CA 92009

FOR: AUTOMOBILE WHEEL CLEANERS, NAMELY - MAGNESIUM AND SPECIAL FINISH CLEANERS, MOTORCYCLE WHEEL AND ENGINE CLEANERS, MAGNESIUM AND CHROME LIQUID AND CREAM POLISHES, WIRE HUB CAP AND KITS CONSISTING PRIMARILY OF CLEANING PREPARATIONS FOR CLEANING AUTOMOBILE WHEELS, WHEEL COVER AND WHITE WALL CLEANING SOLUTIONS, ALUMINUM WHEEL WASH AND BRIGHTENERS, TIRE CLEANERS, DRESSINGS AND PROTECTANTS AND ALUMINUM AND CHROME CORROSION PROTECTIVE SOLUTIONS; AUTOMOBILE FINISH CLEANERS, INCLUDING WASHING SOLUTIONS AND

WAX CONDITIONERS, CARNAUBA SPRAYS, LIQUIDS AND PASTE WAXES AND CLEANERS, PRE-WAX CLEANERS AND CONDITIONERS AND SEALERS AND SCRATCH REMOVER SOLUTIONS AND DETAIL SOLUTIONS; AND UPHOLSTERY AND INTERIOR CLEANERS, INCLUDING SPOT REMOVERS, VELOUR AND FABRIC GUARDS, CLEANING SOLUTIONS, CREME LEATHER SOLUTIONS, PLASTIC POLISHES, ANTI-FOG SOLUTIONS AND GLASS CLEANERS, IN CLASS 3 (U.S. CLS. 4 AND 52).

FIRST USE 0-0-1978; IN COMMERCE 0-0-1978.

OWNER OF U.S. REG. NOS. 1,411,953, 1,467,894 AND OTHERS.

SER. NO. 74-025,882, FILED 2-5-1990.

MARIE-ANNE MASTROVITO, EXAMINING ATTORNEY