

ESTTA Tracking number: **ESTTA498991**

Filing date: **10/09/2012**

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	EAGLE CREEK, INC.
Granted to Date of previous extension	10/07/2012
Address	3411 Silverside Road Wilmington, DE 19810 UNITED STATES

Attorney information	Noel M. Cook Owen, Wickersham & Erickson, P.C. 455 Market St., Ste. 1910 San Francisco, CA 94105 UNITED STATES chris_turk@vfc.com, ncook@owe.com, egelwicks@owe.com, jrhodes@owe.com, tmparalegal3@owe.com Phone:415-882-3200
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Applicant Information

Application No	85458469	Publication date	04/10/2012
Opposition Filing Date	10/09/2012	Opposition Period Ends	10/07/2012
Applicant	Eleven IP Holdings LLC Suite 403 221 North Hogan Street Jacksonville, FL 32202 UNITED STATES		

Goods/Services Affected by Opposition


Class 043. All goods and services in the class are opposed, namely: HOTELS; HOTEL SERVICES, NAMELY, PROVIDING LUXURY HOTEL ACCOMMODATIONS; RESORT LODGING SERVICES; PROVIDING TEMPORARY LODGING SERVICES IN THE NATURE OF A HOME; PUBS; BAR SERVICES; RESTAURANT SERVICES
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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.	4147204	Application Date	07/02/2010
Registration Date	05/22/2012	Foreign Priority Date	NONE

Word Mark	NONE
Design Mark	
Description of Mark	The mark consists of a stylized diamond with multiple curved lines.
Goods/Services	Class 035. First use: First Use: 2010/12/20 First Use In Commerce: 2010/12/20 ELECTRONIC CATALOG, ONLINE RETAIL STORE AND RETAIL STORE SERVICES FEATURING LUGGAGE, NAMELY, TRAVEL PACKS, BACKPACKS, DAY PACKS, FANNY PACKS, WAIST PACKS AND WHEELED LUGGAGE, GARMENT BAGS FOR TRAVEL, DUFFLE BAGS, SHOULDER BAGS, PACKING CASES AND POUCHES, WALLETS, BRIEFCASES, ATTACHE CASES, TOILETRY CASES SOLD EMPTY, PASSPORT CASES, STRAPS FOR LUGGAGE, LUGGAGE TAGS, FOLDERS FOR COMPRESSING GARMENTS, FOLDERS AND BOXES FOR ORGANIZING GARMENTS, UMBRELLAS, AND TRAVEL ACCESSORIES


U.S. Registration No.	4147203	Application Date	07/02/2010
Registration Date	05/22/2012	Foreign Priority Date	NONE
Word Mark	EAGLE CREEK		
Design Mark			
Description of Mark	The mark consists of the words "EAGLE CREEK" below a stylized diamond with multiple curved lines.		
Goods/Services	Class 035. First use: First Use: 2010/12/20 First Use In Commerce: 2010/12/20 ELECTRONIC CATALOG, ONLINE RETAIL STORE AND RETAIL STORE SERVICES FEATURING LUGGAGE, NAMELY, TRAVEL PACKS, BACKPACKS, DAY PACKS, FANNY PACKS, WAIST PACKS AND WHEELED LUGGAGE, GARMENT BAGS FOR TRAVEL, DUFFLE BAGS, SHOULDER BAGS, PACKING CASES AND POUCHES, WALLETS, BRIEFCASES, ATTACHE CASES, TOILETRY CASES SOLD EMPTY, PASSPORT CASES, STRAPS FOR LUGGAGE, LUGGAGE TAGS, FOLDERS FOR COMPRESSING GARMENTS, FOLDERS AND BOXES FOR ORGANIZING GARMENTS, UMBRELLAS, AND TRAVEL ACCESSORIES		

U.S. Registration No.	4161733	Application Date	07/02/2010
Registration Date	06/19/2012	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a stylized diamond with multiple curved lines.		
Goods/Services	<p>Class 018. First use: First Use: 2010/12/21 First Use In Commerce: 2010/12/21</p> <p>Luggage, namely, backpacks, day packs in the nature of sports packs and lumbar packs, fanny packs, waist packs and wheeled luggage; garment bags for travel; duffle bags; shoulder bags; packing cases in the nature of leather cases, overnight cases, tie cases, travel cases, train cases, vanity cases sold empty, pouches in the nature of drawstring pouches, leather pouches, pouches made of cloth, pouches made of imitation leather, pouches of textile fabric, fabric pouches sold empty, jewelry pouches; wallets, briefcases, attaché cases, toiletry cases sold empty, passport cases; straps for luggage; luggage tags; luggage divider inserts for compressing and organizing garments for use inside luggage; luggage box inserts, namely, packing cubes for organizing garments; and umbrellas</p>		

U.S. Registration No.	4161732	Application Date	07/02/2010
Registration Date	06/19/2012	Foreign Priority Date	NONE
Word Mark	EAGLE CREEK		
Design Mark			
Description of Mark	The mark consists of the words "EAGLE CREEK" below a stylized diamond with multiple curved lines.		
Goods/Services	<p>Class 018. First use: First Use: 2010/12/21 First Use In Commerce: 2010/12/21</p> <p>Luggage, namely, backpacks, day packs in the nature of sports packs and lumbar packs, fanny packs, waist packs and wheeled luggage; garment bags for</p>		

	travel; duffle bags; shoulder bags; packing cases in the nature of leather cases, overnight cases, tie cases, travel cases, train cases, vanity cases sold empty, pouches in the nature of drawstring pouches, leather pouches, pouches made of cloth, pouches made of imitation leather, pouches of textile fabric, fabric pouches sold empty, jewelry pouches; wallets, briefcases, attaché cases, toiletry cases sold empty, passport cases; straps for luggage; luggage tags; luggage divider inserts for compressing and organizing garments for use inside luggage; luggage box inserts, namely, packing cubes for organizing garments; and umbrellas
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U.S. Application No.	85077447	Application Date	07/02/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a stylized diamond with multiple curved lines.		
Goods/Services	Class 025. First use: Clothing for men, women and children, namely, pants, shorts, vests, shirts, blouses, skirts, dresses, sweatshirts, fleece pullovers, coats, jackets, parkas, rainwear, under garments, nightwear, socks; headwear, hats, caps; gloves; scarves; belts; footwear		

U.S. Application No.	85077428	Application Date	07/02/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EAGLE CREEK		
Design Mark			
Description of Mark	The mark consists of the words "EAGLE CREEK" below a stylized diamond with multiple curved lines.		
Goods/Services	Class 025. First use:		

	Clothing for men, women and children, namely, pants, shorts, vests, shirts, blouses, skirts, dresses, sweatshirts, fleece pullovers, coats, jackets, parkas, rainwear, under garments, nightwear, socks; headwear, hats, caps; gloves; scarves; belts; footwear
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Related Proceedings	91207373
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Attachments	85077454#TMSN.jpeg (1 page)(bytes) 85077432#TMSN.jpeg (1 page)(bytes) 85077443#TMSN.jpeg (1 page)(bytes) 85077419#TMSN.jpeg (1 page)(bytes) 85077447#TMSN.jpeg (1 page)(bytes) 85077428#TMSN.jpeg (1 page)(bytes) EAGLE-N.O.O.469.pdf (7 pages)(493942 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	/Noel M. Cook/
Name	Noel M. Cook
Date	10/09/2012

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

In the re matter of Trademark Application

Applicant: Eleven IP Holdings LLC
Serial No.: 85/458,469
Filed: October 27, 2011
Mark: 11 and Design
Publication Date: April 10, 2012

Eagle Creek, Inc.

Opposer,

v.

Eleven IP Holdings LLC

Applicant.

NOTICE OF OPPOSITION




NOTICE OF OPPOSITION




Eagle Creek, Inc., a California corporation (“Opposer”) with an address of 5935 Darwin Court, Carlsbad, California 92008 believes that it will be damaged by registration of the mark **11 and DESIGN** set forth in Application Serial No. 85/458,469, published in the *Official Gazette* on April 10, 2012, for “Hotels; hotel services, namely, providing luxury hotel accommodations; resort lodging services; providing temporary lodging services in the nature of a home; pubs; bar services; restaurant services” in International Class 43, and hereby opposes same.

As grounds for this Opposition, Opposer relies upon its federal registrations and intent-to-use applications and the rights developed by the use and registration of its **DESIGN** and

EAGLE CREEK and DESIGN marks (“Opposer’s Marks). Opposer alleges on knowledge as to itself and otherwise upon information and belief, as follows:

1. Opposer is the owner of multiple federal trademark registrations and intent-to-use applications for Opposer’s Marks (the “Registrations” and “ITU Applications”), including the following:

MARK	REG. / APP. NO. REG. / APP. DATE	GOODS/ SERVICES
	Reg. No. 4,147,204 Reg. Date: May 22, 2012	Electronic catalog, online retail store and retail store services featuring luggage, namely, travel packs, backpacks, day packs, fanny packs, waist packs and wheeled luggage, garment bags for travel, duffle bags, shoulder bags, packing cases and pouches, wallets, briefcases, attaché cases, toiletry cases sold empty, passport cases, straps for luggage, luggage tags, folders for compressing garments, folders and boxes for organizing garments, umbrellas, and travel accessories in International Class 35 . First Use: December 20, 2010
	Reg. No. 4,147,203 Reg. Date: May 22, 2012	Electronic catalog, online retail store and retail store services featuring luggage, namely, travel packs, backpacks, day packs, fanny packs, waist packs and wheeled luggage, garment bags for travel, duffle bags, shoulder bags, packing cases and pouches, wallets, briefcases, attaché cases, toiletry cases sold empty, passport cases, straps for luggage, luggage tags, folders for compressing garments, folders and boxes for organizing garments, umbrellas, and travel accessories in International Class 35 . First Use: December 20, 2010
	Reg. No. 4,161,733 Reg. Date: June 19, 2012	Luggage, namely, backpacks, day packs in the nature of sports packs and lumbar packs, fanny packs, waist packs and wheeled luggage; garment bags for travel; duffle bags; shoulder bags; packing cases in the nature of leather cases, overnight cases, tie cases, travel cases, train cases, vanity cases sold empty, pouches in the nature of drawstring pouches, leather pouches, pouches made of cloth, pouches made of imitation leather, pouches of textile fabric, fabric pouches sold empty, jewelry pouches; wallets, briefcases, attaché cases, toiletry cases sold empty, passport cases; straps for luggage; luggage tags; luggage divider inserts for compressing and organizing garments for use inside luggage; luggage box inserts, namely, packing cubes for organizing garments; and umbrellas in International Class 18 . First Use: December 21, 2010


MARK	REG. / APP. NO. REG. / APP. DATE	GOODS/ SERVICES
	Reg. No. 4,161,732 Reg. Date: June 19, 2012	Luggage, namely, backpacks, day packs in the nature of sports packs and lumbar packs, fanny packs, waist packs and wheeled luggage; garment bags for travel; duffle bags; shoulder bags; packing cases in the nature of leather cases, overnight cases, tie cases, travel cases, train cases, vanity cases sold empty, pouches in the nature of drawstring pouches, leather pouches, pouches made of cloth, pouches made of imitation leather, pouches of textile fabric, fabric pouches sold empty, jewelry pouches; wallets, briefcases, attache cases, toiletry cases sold empty, passport cases; straps for luggage; luggage tags; luggage divider inserts for compressing and organizing garments for use inside luggage; luggage box inserts, namely, packing cubes for organizing garments; and umbrellas in International Class 18 . First Use: December 21, 2010
	App. No. 85/077,447 App. Date: July 2, 2010	Clothing for men, women and children, namely, pants, shorts, vests, shirts, blouses, skirts, dresses, sweatshirts, fleece pullovers, coats, jackets, parkas, rainwear, under garments, nightwear, socks; headwear, hats, caps; gloves; scarves; belts; footwear in International Class 25 .
	App. No. 85/077,428 App. Date: July 2, 2010	Clothing for men, women and children, namely, pants, shorts, vests, shirts, blouses, skirts, dresses, sweatshirts, fleece pullovers, coats, jackets, parkas, rainwear, under garments, nightwear, socks; headwear, hats, caps; gloves; scarves; belts; footwear in International Class 25 .

2. Opposer began actual and constructive use of Opposer's Marks in interstate commerce in connection with its goods and services, and filed its ITU Applications, long prior to Applicant's filing date of October 27, 2011. Opposer's Registrations and ITU Applications are valid, subsisting, and in full force and effect. As such, the registrations serve as evidence of Opposer's exclusive right to use Opposer's Marks. On information and belief, Opposer's rights,

including those conferred by its ITU Applications, began prior to any filing date or date of first use upon which Applicant can rely.

3. Opposer's Marks have been widely promoted and featured throughout the travel and adventure travel industry. Opposer has expended substantial amounts of time and money in promoting its goods and services under Opposer's Marks. As a result of such activities, Opposer's Marks have become well known and favorably received, the relevant public has come to associate Opposer's Marks with Opposer, and Opposer derives substantial goodwill from such association.

4. On October 27, 2011, Applicant filed an intent-to-use application for the mark **11 and Design** as follows:

MARK	REG. / APP. NO. REG. / APP. DATE	GOODS/ SERVICES
	App. No. 85/458,469 App. Date: Oct. 27, 2011	Hotels; hotel services, namely, providing luxury hotel accommodations; resort lodging services; providing temporary lodging services in the nature of a home; pubs; bar services; restaurant services in International Class 43.

Opposer objects to registration of Applicant's Mark.

5. On information and belief, Opposer alleges that the travel and travel hospitality services designated by Applicant's Mark will constitute services which are highly related to Opposer's goods and services and will be offered in the United States to the same class of customers through the same or similar channels of trade.

6. Applicant's Mark is strikingly similar to Opposer's Marks. Based on the similarity of the marks and the highly related goods and services, the public is likely to associate

the services offered by Applicant under its **11 and DESIGN** Mark with Opposer or Opposer's goods and services, or to believe that Applicant's services are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer. Applicant's Mark so resembles Opposer's Marks as to be likely, when applied to Applicant's Class 43 services set forth in the application, to cause confusion, mistake, or deception in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Any such confusion will result in irreparable damage to Opposer's reputation and goodwill.

7. Further, if Applicant is granted the registration herein opposed, it would thereby obtain at least *prima facie* exclusive right to use its mark. Such registration would be a source of damage and injury to Opposer.

8. Opposer is likely to be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of Applicant's Mark sought to be registered, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

9. For the reasons set forth herein, Opposer believes that Applicant is not entitled to register its mark because of Opposer's prior rights in Opposer's Marks, as set forth above, and the application should be denied in accordance with Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

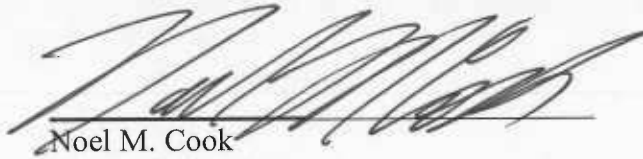
WHEREFORE, Opposer prays that this opposition be sustained in favor of Opposer and that registration of the trademark **11 and DESIGN** shown and specified in Application Serial

No. 85/458,469 be refused in accordance with the provisions of the Trademark Act.

OWEN, WICKERSHAM & ERICKSON, P.C.

Dated: October 8, 2012

By:

A handwritten signature in black ink, appearing to read "Noel M. Cook", written over a horizontal line.

Noel M. Cook
Eric D. Gelwicks
Attorneys for Opposer
Eagle Creek, Inc.

455 Market Street, 19th Floor
San Francisco, California 94105
(415) 882-3200

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing:

NOTICE OF OPPOSITION

has been served on Applicant via email and U.S. Postal Service first-class mail to the following address:

nrich@foley.com

Norman J. Rich
Foley & Lardner LLP
3000 K Street, N.W.
Suite 600
Washington, D.C. 20007-5109

Dated: October 8, 2012


J.D. Rhodes

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