

ESTTA Tracking number: **ESTTA872462**

Filing date: **01/22/2018**

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	PVH Corp.
Granted to Date of previous extension	01/21/2018
Address	200 Madison Avenue New York, NY 10016 UNITED STATES

Attorney information	Edward E. Vassallo & Lisa Mottes FITZPATRICK, CELLA, HARPER & SCINTO 1290 AVENUE OF THE AMERICAS NEW YORK, NY 10104-3800 UNITED STATES Email: lmottes@fchs.com, khamilton@fchs.com, docketing@fchs.com Phone: 212-218-2100
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### Applicant Information

Application No	87379335	Publication date	07/25/2017
Opposition Filing Date	01/22/2018	Opposition Period Ends	01/21/2018
Applicant	Loyalty Bound LLC P.O. Box 1337 Midlothian, TX 76065 UNITED STATES		

### Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0  
All goods and services in the class are opposed, namely: Clothing, namely, shirts and caps

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	110603	Application Date	10/26/1914
Registration Date	06/06/1916	Foreign Priority Date	NONE
Word Mark	EAGLE		

Design Mark	<b>EAGLE</b>
Description of Mark	NONE
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1868/10/00 First Use In Commerce: 1868/10/00 WOVEN DRESS-SHIRTS, [ NEGLIGEE SHIRTS, AND UNDERSHIRTS, DRAWERS, AND SLEEPING GARMENTS ]

U.S. Registration No.	986469	Application Date	10/20/1972
Registration Date	06/18/1974	Foreign Priority Date	NONE
Word Mark	EAGLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1868/10/00 First Use In Commerce: 1868/10/00 SHIRTS, [SWIM TRUNKS, SWEATERS, ] * AND * NECKTIES [ AND SLACKS ]		

U.S. Registration No.	988980	Application Date	03/28/1973
Registration Date	07/23/1974	Foreign Priority Date	NONE
Word Mark	EAGLE SHIRTMAKERS SINCE 1867		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1961/11/15 First Use In Commerce: 1961/11/15 SHIRTS[, SWIM TRUNKS [, ] * AND * SWEATERS [ AND LEISURE SLACKS ]]		

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	Notice of Opposition - EAGLE45.pdf(121546 bytes )
Signature	/LisaMottes/
Name	Edward E. Vassallo & Lisa Mottes
Date	01/22/2018

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

PVH Corp.	)	In re Serial No. 87/379,335
	)	Mark: <b>EAGLE45</b>
	)	
	)	
Opposer,	)	
	)	Opposition No.:
	)	
v.	)	
	)	
Loyalty Bound LLC	)	Atty Docket No. <b>01915. 002331.US</b>
	)	
Applicant.	)	

**NOTICE OF OPPOSITION**


In the matter of pending trademark application Serial No. 87/379,335 for the mark **EAGLE45** (hereinafter “Opposed Application”) for “clothing, namely, shirts and caps” in International Class 25 (hereinafter “Opposed Goods”), published on July 25, 2017 and filed by Loyalty Bound LLC (hereinafter “Applicant”), with an address at P.O. Box 1337, Midlothian, Texas 76065, Opposer, PVH. Corp. (hereinafter “PVH”), with a business address at 200 Madison Avenue, New York, New York 10016, believes it will be damaged by the registration of Applicant’s mark for such goods and hereby opposes the same.


The grounds for opposition follow:

1. PVH Corp. is one of the world’s largest apparel companies. PVH Corp. markets directly or through licensees or subsidiaries a number of brands, including *inter alia* its own well-known brands such as EAGLE, IZOD, ARROW, CALVIN KLEIN, TOMMY HILFIGER, VAN HEUSEN, WARNER’S, and OLGA. In the March 2011, March 2012, March 2013, March 2014, March 2015, March 2016, and March 2017 issues


of *Fortune* magazine, PVH Corp. (formerly, Phillips-Van Heusen Corporation) was recognized as one of the world’s most admired companies. In 2017, it ranked third on the list of the most admired apparel companies; in 2013, 2015, and 2016, it ranked fourth; in both 2011 and 2012, it ranked fifth; and in 2014, it ranked seventh. *See* Exhibit 1 hereto (March 2011, March 2012, March 2013, March 2014, March 2015, March 2016, and March 2017 *Fortune* Magazine articles).

1. As part of its Heritage Brands, PVH markets and sells products under the

trademarks EAGLE and EAGLE & Eagle Design [  ] (hereinafter the “EAGLE Marks”). Goods bearing Opposer’s EAGLE mark have been marketed and sold in the United

States since the brand’s introduction in 1868, and goods bearing Opposer’s  mark have been marketed and sold in the United States for over 55 years. In the last five years, sales of apparel sold under the EAGLE Marks were many millions of dollars. As a result of these and other efforts for sales, advertising, and promotion of goods bearing the EAGLE Marks, the EAGLE Marks have become exclusively associated with PVH and have acquired an eminent reputation and valuable goodwill throughout the United States. These EAGLE Marks are famous and entitled to a broad scope of protection. This fame was achieved well before the March 21, 2017 filing date of the Opposed Application.

2. In the United States, the federal registrations for PVH’s EAGLE Marks include:

<u>Trademark</u>	<u>Registration No.</u>	<u>Registration Date</u>	<u>Goods</u>
EAGLE	110,603	June 6, 1916	Woven dress-shirts
EAGLE	986,469	June 18, 1974	Shirts and neckties
	988,980	July 23, 1974	Shirts and sweaters

These registrations protect the EAGLE Marks for a variety of apparel related goods. Proof as to current status and title of PVH's registrations for these trademarks will be made of record during the PVH testimony period. Moreover, PVH has developed common law rights in its EAGLE Marks through its long history of use of the EAGLE Marks in the United States.

3. Applicant's EAGLE45 mark is substantially similar to PVH's famous EAGLE Marks. Indeed, Applicant's mark is substantially similar in appearance, sound, and overall commercial impression to PVH's EAGLE Marks and appears to be a part of PVH's EAGLE Marks.

4. The Opposed Goods for which Applicant seeks to register its mark, namely, "clothing, namely, shirts and caps" in International Class 25 include identical and/or similar goods to those associated with PVH's EAGLE Marks. Because of the long use and registration of Opposer's EAGLE Marks on identical and/or similar goods, the registration of EAGLE45 for the Opposed Goods creates a strong likelihood of confusion with PVH's EAGLE Marks.

5. Upon information and belief, in the ordinary course of movement of the goods identified in the opposed Application, those goods would be marketed in the same channels of trade as those associated with PVH'S EAGLE products and those actually used by PVH. Moreover, as PVH's registrations and Applicant's EAGLE45 mark do not contain channels of trade limitations, the goods identified in the Opposed Application are deemed to pass through the same channels of trade to the same class of consumers.

6. As a result, Applicant's mark is confusingly similar to PVH'S EAGLE Marks in appearance, sound, and the overall commercial impression it imparts to

consumers. Registration of Applicant's mark for the Opposed Goods is likely to cause confusion, mistake, or deception among the buying public with regard to source, sponsorship and affiliation. Such registration will cause great and irreparable harm to PVH.

7. The EAGLE Marks are famous, as that term is used in the likelihood of dilution context, and enjoy widespread recognition by the general public. For instance, the EAGLE word mark has been used in the United States for almost 150 years and the



EAGLE & Eagle Design mark ( ) has been used in the United States for over 55 years. PVH's EAGLE products are also advertised, promoted, and marketed throughout the United States. As a result, the registration of Applicant's mark for the Opposed Goods also will cause a likelihood of dilution of the famous EAGLE Marks and will lessen the ability of PVH's EAGLE Marks to designate and distinguish the goods offered by PVH under such marks.

CLAIM ONE  
LIKELIHOOD OF CONFUSION  
WITH THE REGISTERED EAGLE TRADEMARKS

8. PVH hereby incorporates paragraphs 1 – 7 set forth above.

9. The registration and use of Applicant's EAGLE45 mark on the Opposed Goods is likely to cause confusion among consumers and the public with PVH's well-known registered EAGLE Marks and will infringe those marks.

10. For the foregoing reasons, PVH will be irreparably damaged by the registration and use of Applicant's mark on the Opposed Goods and such registration should be denied pursuant to 15 U.S.C. §§ 1052 and 1063.

CLAIM TWO  
LIKELIHOOD OF CONFUSION  
WITH THE COMMON LAW EAGLE TRADEMARKS

11. PVH hereby incorporates paragraphs 1 – 7 set forth above.

12. The registration and use of Applicant’s EAGLE45 mark on the Opposed Goods is likely to cause confusion among consumers and the public with PVH’s well-known common law EAGLE Marks and will infringe those marks.

13. For the foregoing reasons, PVH will be irreparably damaged by the registration and use of Applicant’s mark on the Opposed Goods and such registration should be denied pursuant to 15 U.S.C. §§ 1052 and 1063.

CLAIM THREE  
LIKELIHOOD OF DILUTION OF THE EAGLE TRADEMARKS

14. PVH hereby incorporates paragraphs 1 – 7 set forth above.

15. PVH’s EAGLE Marks, both registrations and common law, were famous before Applicant’s filing of its Opposed Application, and the registration and use of the EAGLE45 mark on the Opposed Goods is likely to dilute the famous EAGLE Marks.

16. For the foregoing reasons, PVH will be damaged by the registration and use of Applicant’s mark on the Opposed Goods and such registration should be denied pursuant to 15 U.S.C. §§ 1052 and 1063.

PRAYER FOR RELIEF

PVH hereby requests:

A. A declaration that registration of the alleged EAGLE45 mark set forth in U.S. Application Serial No. 87/379,335 should be refused for the Opposed Goods because registration and use of such mark on the aforementioned goods will cause both a likelihood of confusion and a likelihood of dilution with the famous EAGLE trademarks and the registrations therefor.

