

ESTTA Tracking number: **ESTTA1101655**

Filing date: **12/14/2020**

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	Tommy Hilfiger Licensing LLC
Granted to Date of previous extension	12/13/2020
Address	285 MADISON AVENUE NEW YORK, NY 10017 UNITED STATES
Attorney information	JAMES W. DABNEY HUGHES HUBBARD & REED LLP ONE BATTERY PARK PLAZA NEW YORK, NY 10004 UNITED STATES Primary Email: james.dabney@hugheshubbard.com Secondary Email(s): trademarks@hugheshubbard.com, emma.baratta@hugheshubbard.com, michael.polka@hugheshubbard.com, stefanie.garibyan@hugheshubbard.com 2128376803
Docket Number	

**Applicant Information**

Application No.	88794885	Publication date	06/16/2020
Opposition Filing Date	12/14/2020	Opposition Period Ends	12/13/2020
Applicant	Thom Browne, Inc. 240 W. 35TH STREET NEW YORK, NY 10001 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: footwear
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**Applicant Information**

Application No.	88794742	Publication date	06/16/2020
Opposition Filing Date	12/14/2020	Opposition Period Ends	
Applicant	Thom Browne, Inc. 240 W. 35TH STREET		

	NEW YORK, NY 10001 UNITED STATES
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### 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: Footwear

### Applicant Information

Application No.	88796018	Publication date	06/16/2020
Opposition Filing Date	12/14/2020	Opposition Period Ends	
Applicant	Thom Browne, Inc. 240 W. 35TH STREET NEW YORK, NY 10001 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: footwear

### Applicant Information

Application No.	88794339	Publication date	06/23/2020
Opposition Filing Date	12/14/2020	Opposition Period Ends	
Applicant	Thom Browne, Inc. 240 W. 35TH STREET NEW YORK, NY 10001 UNITED STATES		

### Goods/Services Affected by Opposition

Class 003. First Use: 2019/10/31 First Use In Commerce: 2019/10/31  
All goods and services in the class are opposed, namely: Fragrances; Fragrances for personal use; Perfume

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is merely descriptive	Trademark Act Section 2(e)(1)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1460988	Application Date	11/04/1985
Registration Date	10/13/1987	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	THE TRADEMARK IS A COMBINATION OF DIFFERENT COLORED GEOMETRIC SHAPES.		
Goods/Services	Class 025. First use: First Use: 1985/01/00 First Use In Commerce: 1985/01/00		

	CLOTHING FOR MEN AND WOMEN, NAMELY, SHIRTS, PANTS, JACKETS, SWEATERS, SHORTS, BELTS, VESTS, SPORT JACKETS, COATS, RAIN COATS, PARKAS		
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U.S. Registration No.	1727740	Application Date	07/02/1991
Registration Date	10/27/1992	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1985/01/00 First Use In Commerce: 1985/01/00 clothing for men [ and boys ], namely, shirts, sweaters, sportcoats, pants, sweat-shirts, shorts, sport jackets, raincoats, parkas, overcoats, bathing suits, vests, turtlenecks; * clothing for boys, namely, shirts, sweaters, sportcoats, pants, sweatshirts, shorts, sport jackets, parkas, bathing suits, vests * Class 042. First use: First Use: 1985/08/00 First Use In Commerce: 1985/08/00 retail clothing store services		

U.S. Registration No.	1808520	Application Date	01/30/1991
Registration Date	11/30/1993	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1993/09/25 First Use In Commerce: 1993/09/25 socks, ties, hats, caps and blazers		

U.S. Registration No.	2030406	Application Date	01/30/1991
Registration Date	01/14/1997	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1995/03/00 First Use In Commerce: 1995/03/00 cologne, eau de toilette, shaving lotion, deodorant, soap for personal use Class 018. First use: First Use: 1994/11/00 First Use In Commerce: 1994/11/00 articles of leather and imitation leather, namely wallets, credit card cases, bill-folds, umbrellas, and travelling bags Class 025. First use: First Use: 1994/06/00 First Use In Commerce: 1994/06/00 bathrobes, tuxedos, pajamas, underpants, undershirts, and suspenders		

U.S. Registration No.	2063504	Application Date	09/06/1996
Registration Date	05/20/1997	Foreign Priority	NONE

		Date	
Word Mark	NONE		
Design Mark			
Description of Mark	The mark is lined for the colors red and blue.		
Goods/Services	Class 009. First use: First Use: 1996/07/00 First Use In Commerce: 1996/07/00 eyewear, namely, eyeglasses, sunglasses and eyeglass frames and lenses and eyewear accessories, namely, cases and holders		

U.S. Registration No.	2213511	Application Date	09/06/1996
Registration Date	12/22/1998	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark is lined for the colors red and blue.		
Goods/Services	Class 025. First use: First Use: 1997/01/15 First Use In Commerce: 1997/01/15 footwear, namely, shoes, boots, sneakers, sandals, and slippers		

U.S. Registration No.	2352799	Application Date	09/30/1997
Registration Date	05/23/2000	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 1998/06/00 First Use In Commerce: 1999/05/00 [soap dishes, soap dispensers, trash cans, plastic cups and shower caddies] Class 024. First use: First Use: 1998/06/00 First Use In Commerce: 1999/05/00 Bed accessories, namely, bed spreads, bed blankets, comforters, quilts, duvet covers, [swag window treatments,] bed linens, non-fitted bed sheets, pillow cases, bath accessories, textile bath mats, terry-cloth bath mats, bath linens, shower curtains, towels		

U.S. Registration No.	2575670	Application Date	12/05/2000
Registration Date	06/04/2002	Foreign Priority Date	NONE
Word Mark	TOMMY HILFIGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1985/01/01 First Use In Commerce: 1985/01/01 [ full line of ] apparel, [ footwear and headwear ] namely underwear		

U.S. Registration No.	2634237	Application Date	12/05/2000
Registration Date	10/15/2002	Foreign Priority	NONE

		Date	
Word Mark	TOMMY HILFIGER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1994/06/01 First Use In Commerce: 1994/06/01 [ full line of skin, nail and non-medicated hair care preparations; a full line of makeup, cosmetics and skin care products, namely, a full line of toiletries;soaps; dentifrices; room fragrances and sprays; potpourri; ] fragranced sprays; [ potpourri; fragranced beads for use in the home; and scented sprays to be applied to linen ]		

U.S. Registration No.	3029679	Application Date	06/12/2002
Registration Date	12/13/2005	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 2003/00/00 First Use In Commerce: 2003/00/00 bed accessories, namely, mattress pads and bed pads		

U.S. Registration No.	3075185	Application Date	05/24/2004
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 1982/07/31 First Use In Commerce: 1982/07/31 Publications and printed matter, namely, tags and labels made of paper, anniversary books, fiction and non-fiction books in the field of fashion and the fashion industry, [ personal organizers and planners, address books, ] agendas, [ photo albums, calendars, ] stationery, paperfolders, paper portfolios, [ book marks, ] postcards, stickers, gift wrapping paper, gift boxes made of paper, gift boxes made of cardboard, tissue paper for packaging, shopping bags made of paper, and catalogs and newsletters in the fields of fashion, lifestyles and other topics of general interest, namely, culture, sports, modeling, cosmetics, music and entertainment; mounted and unmounted photographs and posters; and desk accessories comprising of pencil holders, pencil cases, erasers, pencils and pens, and pencil sharpeners</p> <p>Class 024. First use: First Use: 1982/07/31 First Use In Commerce: 1982/07/31 Bed and bath linen, namely, bed covers, eiderdowns, duvets, duvet covers, bed blankets, bed sheets, bed quilts, dust ruffles and pillow cases, pillow shams, mattress covers, [ fitted toilet lid covers made of fabric, ] towels, and face cloths; [ table covers made of fabric, table cloths, table napkins, fabric place mats, ] curtains, and draperies, all made of textile materials or of plastic [, and cloth labels ]</p>		

U.S. Registration No.	6116754	Application Date	09/26/2019
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Registration Date	08/04/2020	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of tag, label and product design features, comprising four contiguous bands, the first and fourth bands being blue, the second band being white, and the third band being red.		
Goods/Services	Class 018. First use: First Use: 2018/08/00 First Use In Commerce: 2018/08/00 All-purpose carrying bags; Backpacks; Crossbody bags; Duffel bags; Fanny packs; Handbags; Luggage; Make-up bags sold empty; Messenger bags; Tote bags; Wallets; Card wallets; Credit card cases and holders		

U.S. Application No.	88848559	Application Date	03/26/2020
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a design element which is a Flag with blue bars at the top and bottom, a red block in the middle section of the mark to the right and a white block to the left with a green border around the Flag.		
Goods/Services	Class 008. First use: First Use: 0 First Use In Commerce: 0 Manicure sets Class 016. First use: First Use: 0 First Use In Commerce: 0 Passport holders; Paper shopping bags Class 018. First use: First Use: 0 First Use In Commerce: 0 All-purpose carrying bags; Athletic bags; Backpacks; Beach bags; Billfolds; Book bags; Briefcase-type portfolios; Briefcases; Business card holders in the nature of card cases; Carrying cases for documents; Clutch bags; Coin purses; Cosmetic cases sold empty; Credit card cases and holders; Credit card holders; Crossbody bags; Duffel bags; Fanny packs; Garment bags for travel; Handbags; Key cases; Leather cases; Leather and imitation leather bags; Luggage; Messenger bags; Overnight bags; Overnight cases; Parasols; Pouches of leather; Pouches of textile; Purses; School bags; Shoulder bags; Tie cases; Toiletry cases sold empty; Tote bags; Traveling bags; Umbrellas; Wallets; Key pouches; Textile shopping bags		

U.S. Application No.	88848554	Application Date	03/26/2020
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a design element which is a Flag with blue bars at the top and bottom, a red block in the middle section of the mark to the right and a white block to the left with a green border around the Flag.		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Athletic pants; Athletic shirts; Beachwear; Belts; Blazers; Blouses; Boxer shorts; Bras; Briefs; Camisoles; Cardigans; Coats; Dresses; Earmuffs; Footwear; Gloves; Golf shirts; Headwear; Hoodies; Hosiery; Jackets; Jeans; Jerseys; Knit bottoms; Knit tops; Leggings; Lingerie; Loungewear; Mittens; Nightgowns; Pajamas; Pants; Pullovers; Rainwear; Robes; Scarves; Shawls; Shirts; Shorts; Skirts;		

	Sleepwear; Socks; Sports bras; Suits; Suspenders; Sweat pants; Sweaters; Sweatshirts; Swim trunks; Swimwear; T-shirts; Tank tops; Ties as clothing; Tights; Trousers; Undershirts; Underwear; Vests; Woven tops; Bow ties; Clothing layettes
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Attachments	12-14-20 FINAL NOP.pdf(205563 bytes )
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Signature	/James W. Dabney/
Name	James W. Dabney
Date	12/14/2020

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

In the Matter of Serial No. 88/794,885

Mark:

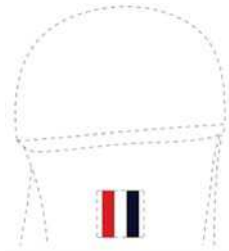


Filing Date: February 12, 2020

Publication Date: June 16, 2020

In the Matter of Serial No. 88/794,742

Mark:



Filing Date: February 12, 2020

Publication Date: June 16, 2020

In the Matter of Serial No. 88/796,018

Mark:



Filing Date: February 12, 2020

Publication Date: June 16, 2020

In the Matter of Serial No. 88/794,339  
Mark:



Filing Date: February 12, 2020  
Publication Date: June 23, 2020

Tommy Hilfiger Licensing LLC,

Opposer,

v.

Thom Browne, Inc.,

Applicant.

Opposition No. \_\_\_\_\_

**CONSOLIDATED NOTICE OF OPPOSITION**

Tommy Hilfiger Licensing LLC (“Opposer”), a limited liability company organized and existing under the laws of the State of Delaware having its principal place of business at 285 Madison Avenue, New York, New York 10017, believes it would be damaged by the issuance of registrations for the purported trademarks shown in Applications Serial Nos. 88/794,885, 88/794,742, 88/796,018, and 88/794,339 (collectively, the “Applications”) filed by Thom Browne, Inc. (“Applicant”), and hereby opposes same.

As grounds for this opposition, Opposer alleges as follows, with knowledge concerning its own acts, and on information and belief as to all other matters:

1. Opposer is one of the best-known fashion companies in the United States. For more than thirty-five (35) years, Opposer and related companies have been engaged in the manufacture, distribution, and sale of diverse types of apparel, shoes, and apparel-related accessories, and have offered such products for sale in commerce throughout the United States, including through Opposer's own Tommy Hilfiger retail stores around the country, Opposer's own Tommy Hilfiger online retail store at <https://usa.tommy.com>, and in hundreds of independent department stores and specialty retail stores located throughout the United States.

2. Since its inception, Opposer has extensively marketed and advertised its products in virtually all types of media including, but not limited to: print advertisements, outdoor and transit advertisements, trade advertising, store advertising, television and cinema advertising, internet advertising, social media advertising, and retail and in-store promotions such as brochures, emails, and mailing cards.

3. Since long prior to the filing dates of the Applications, and since long prior to the claimed first use date in Application Serial No. 88/794,339, Opposer has used trade dress and devices comprising red, white, and blue stripes (collectively, "Opposer's Device Marks") to identify the origin of diverse products, including footwear and fragrances, that Opposer has manufactured, imported, marketed, and sold in United States commerce.

4. Opposer is the owner of U.S. Reg. No. 1,460,988 for a device comprising red, white, and blue stripes.

5. Opposer is the owner of U.S. Reg. No. 1,727,740 for a device comprising red, white, and blue stripes.

6. Opposer is the owner of U.S. Reg. No. 1,808,520 for a device comprising red, white, and blue stripes.

7. Opposer is the owner of U.S. Reg. No. 2,030,406 for a device comprising red, white, and blue stripes.

8. Opposer is the owner of U.S. Reg. No. 2,063,504 for a device comprising red, white, and blue stripes.

9. Opposer is the owner of U.S. Reg. No. 2,213,511 for a device comprising red, white, and blue stripes.

10. Opposer is the owner of U.S. Reg. No. 2,352,799 for a device comprising red, white, and blue stripes.

11. Opposer is the owner of U.S. Reg. No. 2,575,670 for a device comprising red, white, and blue stripes.

12. Opposer is the owner of U.S. Reg. No. 2,634,237 for a device comprising red, white, and blue stripes.

13. Opposer is the owner of U.S. Reg. No. 3,029,679 for a device comprising red, white, and blue stripes.

14. Opposer is the owner of U.S. Reg. No. 3,075,185 for a device comprising red, white, and blue stripes.

15. Opposer's rights to use the marks identified in the registrations listed in paragraphs 4-14, above, are incontestable under 15 U.S.C. §§ 1065 and 1115(b).

16. Opposer is the owner of U.S. Reg. No. 6,116,754 for a device comprising red, white, and blue stripes.

17. Opposer is the owner of U.S. Application No. 88/848,559 for a device comprising red, white, and blue stripes.

18. Opposer is the owner of U.S. Application No. 88/848,554 for a device comprising red, white, and blue stripes

19. By reason of long and extensive use, advertising, and promotion, Opposer's Device Marks had come to symbolize extensive goodwill prior to the filing dates of the Applications and prior to the claimed first use date in Application Serial No. 88/794,339.

20. By reason of long and extensive use, advertising, and promotion, Opposer's Device Marks had come to be famous prior to the filing dates of the Applications and prior to the claimed first use date in Application Serial No. 88/794,339.

21. Applicant is a competitor of Opposer in the sale of wearing apparel, footwear, fragrances, and other products.

22. The goods listed in the Applications are competitive with footwear and fragrances sold by Opposer.

23. The goods listed in the Applications are marketed through the same channels of distribution as are footwear, fragrances, and other products sold by Opposer.

24. Applicant has demanded that Opposer refrain from using one or more of Opposer's Device Marks on certain goods sold by Opposer, based on Applicant's use of one or more marks similar to those identified in the Applications ("Applicant's Marks") and based on the Applications themselves.

25. The Applications were published for opposition on June 16, 2020, and June 23, 2020.

26. Opposer timely filed requests for extensions of time to in which to file opposition to the Applications, which requests were granted; and Opposer is now timely filing this Consolidated Notice of Opposition.

**First Ground of Opposition: 15 U.S.C. § 1052(d)**

27. Paragraphs 1-26, above, are realleged and incorporated by reference as if set forth in full.

28. Applicant has asserted that one or more of Opposer's Device Marks so resemble Applicant's Marks as to be likely, when used in association with Opposer's goods, to cause confusion, to cause mistake, or to deceive.

29. Opposer denies Applicant's assertion identified in paragraph 28, above; however, if Applicant's assertion is true, then Applicant's Marks are not registrable to Applicant under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

30. Opposer believes it would be damaged by registration of Applicant's Marks, for such registration would give false color to Applicant's demands that Opposer refrain from using certain of Opposer's Device Marks to identify the origin of Opposer's goods.

**Second Ground of Opposition: 15 U.S.C. § 1063**

31. Paragraphs 1-30, above, are realleged and incorporated by reference as if set forth in full.

32. Opposer believes it would be damaged by registration of Applicant's Marks, for such registration would be likely to cause and to encourage dilution by blurring.

**Third Ground of Opposition: 15 U.S.C. § 1052(e)(1)**

33. Paragraphs 1-32, above, are realleged and incorporated by reference as if set forth in full.

34. The marks identified in the Applications are design elements of goods.

35. The Applications are unsupported by any evidence that the marks identified therein have secondary, origin-indicating meaning, as distinguished from their functioning to adorn or ornament goods on which they are placed.

36. The marks identified in the Applications are merely descriptive of goods on which they are placed and, as such, are not registrable to Applicant under Trademark Act § 2(e)(1), 15 U.S.C. § 1052(e)(1).

**WHEREFORE**, Opposer prays that this opposition be sustained and that registration of the marks identified in Applications Serial Nos. 88/794,885, 88/794,742, 88/796,018, and 88/794,339 be refused.

Dated: December 14, 2020

HUGHES, HUBBARD & REED LLP

By:     /s/ James W. Dabney      
James W. Dabney  
Emma L. Baratta  
Stefanie M. Garibyan  
Michael M. Polka

One Battery Park Plaza  
New York, New York 10004-1482  
Telephone: (212) 837-6000  
Facsimile: (212) 422-4726

Attorneys for Opposer

CERTIFICATE OF TRANSMISSION

I hereby certify that an original copy of the foregoing Consolidated Notice of Opposition was transmitted online on this 14th day of December, 2020 through the ESTTA page on the website of the Trademark Trial and Appeal Board of the United States Patent and Trademark Office.

Dated: New York, New York  
December 14, 2020

By: /s/ James W. Dabney  
James W. Dabney