

ESTTA Tracking number: **ESTTA795909**

Filing date: **01/18/2017**

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	Eagles, Ltd.
Granted to Date of previous extension	01/18/2017
Address	H2 Management 201 Santa Monica Blvd Suite 480 Santa Monica, CA 90401 UNITED STATES
Attorney information	Douglas N. Masters Loeb & Loeb LLP 321 N. Clark Street, Suite 2300 Chicago, IL 60654 UNITED STATES chdocket@loeb.com, dmasters@loeb.com, tjirgal@loeb.com, bfe-lars@loeb.com

Applicant Information

Application No	86822138	Publication date	09/20/2016
Opposition Filing Date	01/18/2017	Opposition Period Ends	01/18/2017
Applicant	Hotel California Baja LLC 361 North Canon Drive Beverly Hills, CA 90210 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 003. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Fragrances, perfumes, eau de toilette, essential oils for personal use, perfumeoils; toiletries and cosmetics, namely, shower gel, facial washes, facial scrubs, face creams, eye cream, hair gel, bath soaps in solid form, shaving cream, shaving gel, shaving preparations, shavingbalm, after-shave; body and beauty care cosmetics and toiletries, namely, soaps for body care, liquid soaps for hands, face and body, facial cleansers, skin toners, skin cleansers and emollients, cleansing creams, body scrub, facial scrub, skin lotions, skin cleansing lotions, face lotions, body lotions, skin moisturizers, cosmetic creams for skin care, nutritional oils for cosmetic purposes, body oil, bath oil, lip balm, dentifrices, toothpaste, non-medical mouthwash and gargle, bath gel, shampoos, hair conditioners, hair care preparations, hair styling gels, hair lotions, hair styling preparations, deodorants for body care, body powder, anti-perspirants, cosmetic suntan lotions, cosmetic sun-protecting and sun-tanning preparations, cocoa butter for cosmetic purposes</p>
<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Eyewear, eyeglasses, sunglasses; frames, lenses and protective cases for eyewear, eyeglasses, and sunglasses; eyewear accessories, namely, straps, neck cords, chains and head straps which restrain eyewear from movement on a wearer; headphones; earphones; protective carrying cases specially adapted for cell phones and personal di-</p>

gital assistants
Class 014. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Jewelry, namely, bracelets, rings, necklaces, pins, amulets, brooches, chains and charms; horological and chronometric instruments, namely, watches, wrist watches and clocks; watch bands; watch straps; watch chains; cases for watches; cases for clocks
Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Backpacks, knapsacks, daypacks, fanny packs, messenger bags, shoulder bags, tote bags, duffel bags, overnight bags, athletic bags, carry-on bags and luggage, leather key chains, key cases, handbags, wallets, purses, coin purses, clutch purses, cosmetics cases sold empty, toiletry bags sold empty; pet accessories, namely, clothing for pets, collars for animals, covers for animals, leather leashes and dog collars
Class 024. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bedsheets, bedspreads, bed shams, bed skirts, comforters, bed blankets, duvet covers, pillow cases, pillow shams, pillow covers, towels, shower curtains, textile table napkins, fabric placemats and fabric tablecloths
Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Footwear, namely, shoes, slippers, boots, sandals, flip-flops, and athletic shoes; clothing, namely, shirts, tank tops, sweat pants, sweat suits, jeans, pants, shorts, overalls, jumpsuits, skirts, dresses, blouses, jackets, sweaters, vests, swimwear, bathing suits, cover-ups, sleepwear, pajamas, robes, nightgowns, leotards, lingerie, panties, bras, boxer shorts, underwear, scarves, belts, socks, stockings, tights, leggings, gloves; outerwear, namely, coats and raincoats; headgear, namely, hats, headbands, visors and bandanas

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. Application No.	87306414	Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services			

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	HOTEL CALIFORNIA		
Goods/Services	On January 18, 2017, Opposer applied to register HOTEL CALIFORNIA for a variety of goods and was assigned App. Serial No. 87,306,414. Because the application has not yet processed through the USPTO system, Opposer takes the additional step of alleging its common law rights in the mark HOTEL CALIFORNIA for goods including, but not limited to, t-shirts; sweatshirts; bathrobes; posters; keychains; playing cards; mugs; guitar picks; and refrigerator magnets.		

Attachments	Eagles Opposition Against HOTEL CALIFORNIA Application.pdf(794036 bytes)
Signature	/Elisabeth K. O'Neill/
Name	Elisabeth K. O'Neill
Date	01/18/2017

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

In the Matter of Application Ser. No. 86/822,138: HOTEL CALIFORNIA

Eagles, Ltd.)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
Hotel California Baja LLC,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Eagles, Ltd., a corporation organized and existing under the laws of the State of California, with a business address at H2 Management 201 Santa Monica Blvd., Suite 480, Santa Monica, CA 90401 (“Opposer”), believes it will be damaged by the registration of Application Ser. No. 86/822,138 for HOTEL CALIFORNIA (the “Application”) filed by Hotel California Baja LLC (the “Applicant”) on the Principal Register and opposes the same.

As grounds for this opposition, Opposer alleges:

1. Opposer owns the intellectual property rights of the famous American rock & roll band Eagles, including all trademark rights.

2. The Eagles formed in 1971 and went on to become one of most successful American rock bands of all time. The band has released seven studio albums, two live albums, and 10 compilation albums, including *Their Greatest Hits (1971-1975)*, which was the best-selling album of the 20th Century.

3. Although their first album, *Eagles*, released in 1972, met with immediate acclaim and sales, far and away their most successful studio album was *Hotel California*, released at the end of 1976.

4. “Hotel California” also is without question the Eagles’ most popular song, and in many ways embodies the very essence of the band itself. The song continues to be hugely popular, and the song’s name has become synonymous with the band.

5. Since many years prior to Applicant’s priority filing date of November 16, 2015, for Application Serial No. 86/822,138 (“Filing Date”) and continuing today, Opposer, itself and through its predecessors-in-interest, related companies, and licensees, have marketed and engaged in the retail sale and distribution of a variety of goods and services under the trademark HOTEL CALIFORNIA.

6. Products marketed and sold by Opposer, its predecessors-in-interest, related companies and licensees under the trademark HOTEL CALIFORNIA have included, but not been limited to, t-shirts; sweatshirts; bathrobes; posters; keychains; playing cards; mugs; guitar picks; and refrigerator magnets.

7. Opposer is the owner of Trademark Application No. 87/306,414 for HOTEL CALIFORNIA.

8. Since long prior to Applicant’s Filing Date, Opposer, its predecessors-in-interest, related companies and licensees, have spent a significant amount of money and other resources marketing and otherwise promoting Opposer’s goods under its HOTEL CALIFORNIA trademark.

9. As a result of the above extensive advertisement, promotion and sales, and prior to Applicant's Filing Date, Opposer's HOTEL CALIFORNIA trademark developed substantial consumer recognition and valuable goodwill, and such goodwill had become uniquely identified with Opposer.

10. On November 16, 2015, Applicant filed the Application for the following goods:

Class 3: Fragrances, perfumes, eau de toilette, essential oils for personal use, perfume oils; toiletries and cosmetics, namely, shower gel, facial washes, facial scrubs, face creams, eye cream, hair gel, bath soaps in solid form, shaving cream, shaving gel, shaving preparations, shaving balm, after-shave; body and beauty care cosmetics and toiletries, namely, soaps for body care, liquid soaps for hands, face and body, facial cleansers, skin toners, skin cleansers and emollients, cleansing creams, body scrub, facial scrub, skin lotions, skin cleansing lotions, face lotions, body lotions, skin moisturizers, cosmetic creams for skin care, nutritional oils for cosmetic purposes, body oil, bath oil, lip balm, dentifrices, toothpaste, non-medical mouthwash and gargle, bath gel, shampoos, hair conditioners, hair care preparations, hair styling gels, hair lotions, hair styling preparations, deodorants for body care, body powder, anti-perspirants, cosmetic suntan lotions, cosmetic sun-protecting and sun-tanning preparations, cocoa butter for cosmetic purposes

Class 9: Eyewear, eyeglasses, sunglasses; frames, lenses and protective cases for eyewear, eyeglasses, and sunglasses; eyewear accessories, namely, straps, neck cords, chains and head straps which restrain eyewear from movement on a wearer; headphones; earphones; protective carrying cases specially adapted for cell phones and personal digital assistants

Class 14: Jewelry, namely, bracelets, rings, necklaces, pins, amulets, brooches, chains and charms; horological and chronometric instruments, namely, watches, wrist watches and clocks; watch bands; watch straps; watch chains; cases for watches; cases for clocks

Class 18 Backpacks, knapsacks, daypacks, fanny packs, messenger bags, shoulder bags, tote bags, duffel bags, overnight bags, athletic bags, carry-on bags and luggage, leather key chains, key cases, handbags, wallets, purses, coin purses, clutch purses, cosmetics cases sold empty, toiletry bags sold empty; pet accessories, namely, clothing for pets, collars for animals, covers for animals, leather leashes and dog collars

Class 24 Bedsheets, bedspreads, bed shams, bed skirts, comforters, bed blankets, duvet covers, pillow cases, pillow shams, pillow covers, towels, shower curtains, textile table napkins, fabric placemats and fabric tablecloths

Class 25: Footwear, namely, shoes, slippers, boots, sandals, flip-flops, and athletic shoes; clothing, namely, shirts, tank tops, sweat pants, sweat suits, jeans, pants, shorts, overalls, jumpsuits, skirts, dresses, blouses, jackets, sweaters, vests, swimwear, bathing suits, cover-ups, sleepwear, pajamas, robes, nightgowns, leotards, lingerie, panties, bras, boxer shorts, underwear, scarves, belts, socks, stockings, tights, leggings, gloves; outerwear, namely, coats and raincoats; headgear, namely, hats, headbands, visors and bandanas.

11. By virtue of Opposer's prior use of its HOTEL CALIFORNIA trademark, Opposer's HOTEL CALIFORNIA trademark has priority over any alleged rights of Applicant in the Application and Applicant's Mark.

12. Because the marks are identical and because Applicant has applied for goods that are identical and closely related to those offered by Opposer under the HOTEL CALIFORNIA trademark, Applicant's use of Applicant's Mark is likely to cause confusion among consumers and others as to source, affiliation, connection or association with Opposer and its HOTEL CALIFORNIA trademark. As such, Applicant is not entitled to registration of Applicant's Mark pursuant to 15 U.S.C. § 1052(d).

13. Applicant intends to create confusion, by trading off of the Eagles' goodwill and creating a connection between Applicant's "Hotel California" goods and Eagles.

14. Among other things, Applicant implies on its website that its hotel is "the" hotel written about in the Eagles' song, even though there is no such hotel. It says that "many visitors

are mesmerized by the ‘coincidences’ between the lyrics of the hit song and the physicality of the hotel and its surroundings.”¹

(a) Applicant’s website says its hotel “is accessed by driving down a long desert highway from either Los Cabos to the south or La Paz to the east.” The Eagles’ song famously begins with the song’s protagonist saying he is traveling “On a dark desert highway . . .” before he stops to rest for the night at the “Hotel California.”

(b) Applicant’s website says: “During the 'Hippie Era" of the 1960s and 1970s, people were know [sic] to easily grow their own marijuana in the extremely fertile land of the Todos Santos area and then roll them into "Colitas" which is a Mexican slang term for 'Joint" or Marijuana cigarette.” In the Eagles’ song, the song’s protagonist indicates that the “warm smell of colitas” is “rising up through the air” as he is driving.

(c) Applicant’s website says: “The Mission Church of Pilar is located directly adjacent to the hotel and mission bells are heard daily. Since the Church is so close it sounds like they are almost inside the hotel at times.” In the Eagles’ song, the song’s protagonist says he could “hear[] the mission bell” from the hotel.

(d) Applicant’s website says: “Countless stories and firsthand witnesses relating to spirits and ghosts in the courtyard of the hotel.” The second verse in the Eagles’ song speaks of “spirit[s],” “voices . . . calling from far away,” and dances “in the courtyard.”

¹ Applicant’s website was last accessed on January 18, 2017. A printout of the webpage referenced is attached hereto as Exhibit A.

15. Opposer believes it will be damaged by the registration sought herein of Applicant's Mark for Class 3, 9, 14, 18, 24, and 25 goods within the meaning of 15 U.S.C. § 1063(a).

Please debit our Deposit Account No. 502876 for the \$2,400.00 filing fee and any additional necessary fees.

Please address all correspondence to Douglas N. Masters, Loeb & Loeb LLP, 321 North Clark Street, Suite 2300, Chicago, Illinois 60654.

Date: January 18, 2017

LOEB & LOEB LLP

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EXHIBIT A

Mexico Vacation Accom... x
hotelcaliforniabaja.com/history.html

funky... Todos Santos... lined with artisans shops, and it is here that you will find The Hotel California." -Janis Fair

During the 1960s and 1970s, the precise details of the hotel's history are a bit "jazzy" — not uncommon for the culture of that particular era in general... There are numerous stories. Whether fact or myth, nobody knows for sure. However, one rumor, fabricated in the 1990's by someone with no connection to any owners of the hotel, states that the Eagles once owned it. This is unequivocally false. Many of the other legends are less black and white and continue to fascinate the public. Although the present owners of the hotel do not have any affiliation with the Eagles, nor do they promote any association, many visitors are mesmerized by the "coincidences" between the lyrics of the hit song and the physicality of the hotel and its surroundings.

- Hotel California is accessed by driving down a long desert highway from either Los Cabos to the south or La Paz to the east.
- The Mission Church of Pilar is located directly adjacent to the hotel and mission bells are heard daily. Since the Church is so close it sounds like they are almost inside the hotel at times.
- Countless stories and firsthand witnesses relating to spirits and ghosts in the courtyard of the hotel.
- During the "Hippie Era" of the 1960s and 1970s, people were known to easily grow their own marijuana in the extremely fertile land of the Todos Santos area and then roll them into "Colifas" which is a Mexican slang term for "Joint" or Marijuana cigarette.
- The simple fact that the Hotel California in Todos Santos was built in 1947 which was of course far before the "Hippie" or "Classic Rock" eras

During the 1980's and 1990's, the picture became much more clear again. The hotel had become neglected and in 2001, a Canadian couple John and Debbie Stewart purchased the hotel. After completing a masterful renovation, which would later win numerous awards for design and décor, the original 16 rooms were transformed into the eclectic 11 suite hotel it is today. The restaurant, La Coronela and bar were added and the area of the original gas station became the tienda Emporio, the hotel's boutique gallery/bazaar.

"A little jewel in the middle of the desert."
John Stewart, creator of the modern era Hotel California

Today the "legendary" Hotel California is an icon, shining brighter than ever. It continues to

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1/18/2017