

ESTTA Tracking number: **ESTTA81786**

Filing date: **05/22/2006**

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	National Association for Stock Car Auto Racing, Inc. (a/k/a NASCAR)		
Entity	Corporation	Citizenship	Florida
Address	1801 W. International Speedway Blvd. Daytona Beach, FL 32114 UNITED STATES		

Attorney information	Edward M. Prince Alston & Bird LLP 950 F Street, N.W. Washington, DC 20004-1404 UNITED STATES edward.prince@alston.com Phone:(202) 756-3358		
----------------------	--	--	--

Applicant Information

Application No	78695838	Publication date	04/25/2006
Opposition Filing Date	05/22/2006	Opposition Period Ends	05/25/2006
Applicant	Speed Channel, Inc. 10201 West Pico Boulevard Los Angeles, CA 90035 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Entertainment services in the nature of a television series featuring auto racing
--

Attachments	Notice_of_Opposition.pdf (5 pages)(164082 bytes)
-------------	---

Signature	/Edward M. Prince/
Name	Edward M. Prince
Date	05/22/2006

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

National Association for Stock Car Auto)	
Racing, Inc.,)	
)	
Opposer,)	Opposition No. _____
)	
v.)	Ser. No. 78/695,838
)	
SPEED CHANNEL, INC.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

In the matter of the application for registration of the mark THE CHASE IS ON, Serial No. 78/695,838, filed August 18, 2005, by Speed Channel, Inc., and published for opposition on April 25, 2006, National Association for Stock Car Auto Racing, Inc. (a/k/a NASCAR), a Florida corporation, having its principal place of business at 1801 W. International Speedway Blvd., Daytona Beach,, Florida 32114, by its attorneys, Alston & Bird LLP, The Atlantic Building, 950 F Street, N.W., Washington, D.C. 20004-1404, believes it would be damaged by such registration and hereby opposes said application.

The grounds for opposition are as follows:

1. National Association for Stock Car Auto Racing, Inc., commonly known as NASCAR, is engaged in interstate commerce in the field of motorsports racing and in particular conducts, regulates, governs and sanctions motorsports racing events.

2. The annual series of NASCAR motorsports races culminates in the last ten races which are identified by a family of marks all containing the word "CHASE." The initial filing on February 5, 2004, was an intent-to-use application to register the mark THE CHASE for entertainment services in the nature of motorsports racing events; regulating, governing and sanctioning motorsports racing events. Actual use of the mark commenced in August of 2005, following which the mark was registered on November 8, 2005, as Reg. No. 3,014,033.

3. Additional registered marks covering entertainment services in the nature of motorsports racing events; regulating, governing, sanctioning and promoting motorsports racing events include CHASE FOR THE CHAMPIONSHIP, Reg. No. 3,080,681; CHASE FOR THE CUP, Reg. No. 3,074,627; RACE TO THE CHASE, Reg. No. 3,051,718; as well as intent-to-use applications on the marks CHASE FOR THE NASCAR CHAMPIONSHIP, Ser. No. 78/442,271, CHASE FOR THE NASCAR CUP, Ser. No. 78/362,894; CHASE RACE, Ser. No. 78/442,263; RACE TO THE CHASE FOR THE CUP; Ser. No. 78/442,243; and RACE TO THE CHASE FOR THE NASCAR CUP, Ser. No. 78/442,249, all with filing dates prior to the filing date of the application opposed herein.

4. In addition to registrations and applications in International Class 41, NASCAR has registered the marks CHASE FOR THE CUP, Reg. No. 2,953,745, for goods in International Class 16 including video game machines and programs for use in connection with a computer or television; video and computer game programs, cartridges, cassettes, discs and tapes; pre-

recorded compact discs, video tapes, audio-visual cassettes, CD-ROMs and DVD's in the field of motorsports, and THE CHASE, Reg. No. 3,024,807, for goods in International Class 16 including paper and paper articles, namely, writing paper, loose leaf paper; stationery; gift wrapping paper, paper party goods, namely, paper party bags, paper party decorations, paper party hats, paper cake decorations; pictures, photographic prints, mounted photographs, unmounted photographs, posters and art reproductions; pens and pencils; pen and pencil boxes; appliques in the form of decals; greeting, note, and blank cards; decals; stickers; bumper stickers; publications, namely, magazines, books, newspapers, brochures, pamphlets relating to motorsports events. Moreover, there are pending applications for the mark THE CHASE in International Classes 9, 21 and 25, again with constructive filing dates prior to the filing date of the application opposed herein.

5. NASCAR's constructive date of first use of February 5, 2004, is prior to the filing date of the intent-to-use application opposed herein.

6. Speed Channel, Inc. (hereinafter "Applicant"), is well aware of NASCAR and NASCAR'S marks.

7. Applicant entered into an agreement with NASCAR, dated September 14, 2000, which agreement provided in part, "All uses and displays of the NASCAR Marks, on the NASCAR Channel and in advertising, promotion and publicity for the NASCAR Channel, are subject to NASCAR's prior approval, which approval will not be unreasonably withheld."

8. Applicant is in violation of this agreement.

9. Applicant is familiar with NASCAR's family of CHASE marks.
10. Applicant's mark THE CHASE IS ON is a further extension of NASCAR's family of CHASE marks.
11. Applicant's mark is derived from, and incorporates the entirety of, NASCAR's mark THE CHASE.
12. The entertainment services covered by Applicant's mark comprise a television series featuring auto racing.
13. Applicant's television series features NASCAR's motorsports racing events and in particular NASCAR's Nextel Cup Series.
14. The races featured on Applicant's television series under the mark THE CHASE IS ON are the same races identified by NASCAR's family of CHASE marks including the mark THE CHASE.
15. The potential customers for Applicant's services identified by the mark THE CHASE IS ON are the same as the customers for NASCAR's services identified by NASCAR'S family of CHASE marks.
16. NASCAR is damaged or will be damaged by the rendering of Applicant's services bearing the mark THE CHASE IS ON since this mark, as used in connection with Applicant's services, falsely suggests a connection with NASCAR, or falsely suggests that Applicant is associated with, or sponsored by, NASCAR.
17. The mark THE CHASE IS ON so resembles NASCAR's mark THE CHASE, previously used in interstate commerce by NASCAR, and not

abandoned, as to be likely, when applied to the services of the Applicant, to cause confusion, or to cause mistake or to deceive.

18. The mark THE CHASE IS ON so resembles NASCAR's family of CHASE marks, previously adopted or used in interstate commerce by NASCAR, and not abandoned, as to be likely, when applied to the services of the Applicant, to cause confusion, or to cause mistake or to deceive.