

ESTTA Tracking number: **ESTTA283626**

Filing date: **05/13/2009**

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 parties oppose registration of the indicated application.

Opposers Information

| | | | |
|---------|--|-------------|----------|
| Name | 100 Blacks in Law Enforcement Who Care, Inc. | | |
| Entity | Corporation | Citizenship | New York |
| Address | 593 Vanderbilt Avenue Suite 133 Brooklyn, NY 11238 UNITED STATES | | |

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|---------|--|-------------|----------|
| Name | 100 Blacks Who Care, Inc. | | |
| Entity | Corporation | Citizenship | New York |
| Address | 593 Vanderbilt Avenue Suite 133 Brooklyn, NY 11238 UNITED STATES | | |

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|----------------------|---|--|--|
| Attorney information | Karen Bekker Norris, McLaughlin & Marcus, P.A. 875 Third Avenue New York, NY 10022 UNITED STATES kbekker@nmmlaw.com Phone:212-808-0700 | | |
|----------------------|---|--|--|

Applicant Information

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|------------------------|---|------------------------|------------|
| Application No | 77626835 | Publication date | 04/14/2009 |
| Opposition Filing Date | 05/13/2009 | Opposition Period Ends | 05/14/2009 |
| Applicant | 100 BLACKS IN LAW ENFORCEMENT WHO CARE 223-07 135 Avenue Laurelton, NY 11413 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 035. First Use: 1993/01/01 First Use In Commerce: 1993/01/01 All goods and services in the class are opposed, namely: Association services, namely, promoting the interests of Civil Rights |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |
| Other | Applicant is not the owner of the mark |

Mark Cited by Opposer as Basis for Opposition

| | | | |
|-------------------|------|------------------|------|
| U.S. Application/ | NONE | Application Date | NONE |
|-------------------|------|------------------|------|

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|-------------------|---|--|--|
| Registration No. | | | |
| Registration Date | NONE | | |
| Word Mark | 100 BLACKS IN LAW ENFORCEMENT WHO CARE | | |
| Goods/Services | Advocating civil and human rights on behalf of citizens of New York State; education and providing information in connection with civil and human rights. | | |

| | |
|-------------|---|
| Attachments | 100 blacks.pdf (5 pages)(407405 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 | /karen bekker/ |
| Name | Karen Bekker |
| Date | 05/13/2009 |

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

In the matter of Application Number 77626835 for **ONE HUNDRED BLACKS IN LAW ENFORCEMENT WHO CARE** *Published on April 14, 2009*

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| <p>100 BLACKS IN LAW ENFORCEMENT WHO CARE, INC. AND 100 BLACKS WHO CARE, INC.,</p> <p style="text-align: center;">Opposers,</p> <p style="text-align: center;">v.</p> <p>MARQUEZ CLAXTON AND 100 BLACKS IN LAW ENFORCEMENT WHO CARE, an unincorporated association,</p> <p style="text-align: center;">Applicant.</p> | <p>Opposition no. _____</p> |
|---|-----------------------------|

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514
BOX TTAB / FEE

NOTICE OF OPPOSITION

100 Blacks in Law Enforcement Who Care, Inc. (“100 Blacks”) is a New York Corporation with a principal place of business at 593 Vanderbilt Avenue, Suite 133, Brooklyn, New York, 11238. 100 Blacks Who Care, Inc. (“100 Blacks Who Care”) is a New York Not-for-Profit Corporation, with a principal place of business at 593 Vanderbilt Avenue, Suite 133, Brooklyn, New York, 11238, affiliated with 100 Blacks (together, referred to as “Opposers”). 100 Blacks and 100 Blacks Who Care believe they will be damaged by the registration of the mark “100 Blacks in Law Enforcement Who Care” in international class 035, which is the subject of the above-referenced application. In support of this petition, Opposers hereby allege

as follows:

1. 100 Blacks and 100 Blacks Who Care began as an unincorporated association that was founded in 1995 by a core group of concerned African Americans representing a variety of professions within the field of law enforcement, who wanted to participate in being part of a social solution and who shared an unfulfilled desire to “give back” in some meaningful way. The mission statement was to be the vanguard for justice on behalf of those who traditionally have no voice in society, to vigorously challenge racism, sexism and other forms of discrimination, and to uplift people through education.

2. The original unincorporated association evolved into two groups, a New York corporation, 100 Blacks, and a New York Not-for-Profit, 100 Blacks Who Care. The group 100 Blacks Who Care operates a service hotline, and 100 Blacks is primarily involved with speaking out publicly on issues of racism and law enforcement in press conferences.

3. Opposers have registered a New York State service mark, 100 Blacks in Law Enforcement Who Care, Registered with the New York State Department of State, Registration Number S20721, Registered November 17, 2008 in the name of Noel Leader, who is one of the original founding members of Opposer 100 Blacks and who holds the position of Minister of Finance with that group. The description of Services on the Registration provides that the mark is “Used to identify an organization which advocates civil and human rights on behalf of citizens of NYS. Also serves as a conduit for additional services such as education seminars, and variety of other informational public services.”

4. Opposers have been using the mark 100 Blacks Who Care as well as the mark 100 Blacks in Law Enforcement Who Care since the inception of the group, in or about 1995. Opposers have been using this mark for publicity purposes, in print, television, and radio

news, and to provide services to the public for well over a decade. Opposer 100 Blacks also operates the website 100blacksinlawenforcement.org, and has operated this site since approximately 2000.

5. Opposers have used, and are using, their marks, in the present or related format, in United States commerce, well before Applicant's filing date, in connection with the services set forth in paragraphs 3 and 4 above. Because of the continuous and exclusive use of Opposers' mark in connection with the services set forth above, as well as other goods, such as printed matter and promotional items, Opposers have established valuable goodwill in the marks, and the consuming public recognizes Opposers as being the sole source of quality services provided in connection with the marks, as well as spokespeople for the African American law enforcement community. Accordingly, Opposers have significant common law and statutory rights in the marks as applied to the goods and services set forth above.

6. Applicant's application is for the mark 100 Blacks in Law Enforcement Who Care, which is identical to the mark Opposers have been using for well over a decade. Applicant's application is based on the false premise that applicant has been using the mark since 1993. In fact, Applicant began to use the mark only upon being invited to join Opposers as a member. Applicant is no longer affiliated with Opposers and is attempting to utilize the trademark process to hijack Opposers' rights to the trade name that has belonged to Opposers since the inception of the original unincorporated association in 1995. Therefore, Opposers' rights are superior based on their earlier date of use.

7. Moreover, Applicant's application is for services in class 35, which includes "services rendered by advertising establishments primarily undertaking communications to the public, declarations or announcements by all means of diffusion and concerning all kinds

of goods or services. . . .” Opposer 100 Blacks has been involved with publicity and the dissemination of information since its inception in 1995.

8. As grounds for opposition, Opposers state that Applicant’s application is based on the false statement that Applicant has used the mark since 1993, when in fact it was Opposers who invented and who first used the mark. Accordingly, Applicant is not the rightful owner of the mark as of the date of filing. Applicant’s registration of its mark will damage Opposers because Opposers are the true owner of the mark.

9. In addition, Applicant seeks to use the identical mark for a similar purpose, that is, speaking publicly on issues important to the African American law enforcement community in New York. If Applicant were granted rights to the mark, any use by Applicant would be likely to cause confusion, or to cause mistake, or to deceive the public as to the source, authorization or sponsorship of Opposers’ or Applicant’s services.

10. Applicant’s registration of its mark will cause dilution of Opposers’ mark because Opposers’ mark is famous; it has been using the marks in publicity, on radio, television, and print news, since at least 1995, well before the Applicant’s filing date. Therefore, Applicant’s use of its mark is likely to cause dilution by blurring and creating a likelihood of association with Opposers’ famous marks that is likely to impair the distinctiveness of Opposers’ famous mark.

WHEREFORE, for the foregoing reasons, Opposers believe that they will be damaged by registration of Applicant's application, and requests that such application be rejected.

Dated: May 13, 2009
New York, NY

Respectfully submitted,

/s/ Karen Bekker
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