

ESTTA Tracking number: **ESTTA360457**

Filing date: **07/28/2010**

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	Marc and Aeron Arlin-Genet
Granted to Date of previous extension	08/07/2010
Address	560 Higuera Street, Suite B San Luis Obispo, CA 93401 UNITED STATES
Party who filed Extension of time to oppose	MarcGenet
Relationship to party who filed Extension of time to oppose	Has been changed to include joint opposer, opposer's wife.

Attorney information	Linda Somers Smith 560 Higuera Street, Suite B San Luis Obispo, CA 93401 UNITED STATES lss@dshlawfirm.com
----------------------	---

**Applicant Information**

Application No	77952080	Publication date	06/08/2010
Opposition Filing Date	07/28/2010	Opposition Period Ends	08/07/2010
Applicant	Continental Event and Sports Management Group LLC 16935 SW 84 Ct miami, FL 33157 UNITED STATES		

**Goods/Services Affected by Opposition**

<p>Class 041. First Use: 2010/01/04 First Use In Commerce: 2010/01/04 All goods and services in the class are opposed, namely: Entertainment in the nature of organizing a series of sporting events throughout the country, in the nature of a running race and related sporting and entertainment events, namely, organizing community fairs featuring vendor booths of food and other race related sporting goods, and planning parties and dinners related to the sporting games; Organizing sporting events, namely, running events, primarily half marathons, 10K and 5K running races</p>
--

**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
---------------	----------------------------

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2970414	Application Date	04/25/2004
Registration Date	07/19/2005	Foreign Priority Date	NONE
Word Mark	RUNNING DIVAS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/01/01 First Use In Commerce: 2003/06/01 Clothing, namely, men's, women's and children's t-shirts, pants, shorts, shirts, dance pants, tank tops, cover-ups, leggings, capris, jerseys, underwear, running jog-bras, sweatshirts, sweatpants, pajamas, socks, gloves; headwear, namely, visors, sweatbands, beanies, hats, and caps		

Attachments	78407630#TMSN.jpeg ( 1 page )( bytes ) NOOFinalSig072810.pdf ( 10 pages )(509983 bytes ) 20100728144644412.pdf ( 1 page )(508100 bytes )
-------------	--

### 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	/lss/
Name	Linda Somers Smith
Date	07/28/2010

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

_____ )	Trademark Application
MARC GENET, an Individual )	
AND )	Mark: DIVA'S HALF
AERON ARLIN-GENET, an Individual )	MARATHON
)	
Opposer, )	Serial No.: 77/952080
)	
v. )	Int. Class: 41
)	
CONTINENTAL EVENT AND SPORTS )	Filed: 2010/03/05
MANAGEMENT GROUP, LLC )	
)	Published: 2010/06/08
Applicant. )	
)	Opposition No: _____
_____ )	

**NOTICE OF OPPOSITION**

Marc Genet and Aeron Arlin-Genet, their registered place of business at 318 Mar Vista, Los Osos, California, 93402, (collectively hereinafter "Opposer"), hereby oppose the registration of the mark described in Application Serial No. 77/952080.

In support of its Opposition, Opposer alleges the following:

1. Opposer consists of two individuals, husband and wife, who jointly own a valid and subsisting Registration Number 2970414 for RUNNING DIVAS, which has been registered in International Class 25 since 2005 for "Clothing, namely, men's, women's and children's t-shirts, pants, shorts, shirts, dance pants, tank tops, cover-ups, leggings, capris, jerseys, underwear, running jog-bras, sweatshirts, sweatpants, pajamas, socks, gloves; headwear, namely, visors, sweatbands, beanies, hats, and caps" ("Opposer's Mark").
2. Opposer duly filed a Combined Declaration of Use and Incontestability for Opposer's Mark under Sections 8 and 15 on July 19, 2010.
3. Continental Event and Sports Management Group, LLC ("Applicant"), a limited liability company organized under the laws of the State of Florida, filed an application for DIVA'S HALF MARATHON ("Applicant's Proposed Mark" or "Proposed Mark") in the United States Patent and Trademark Office ("PTO") on March 5, 2010, which was assigned Serial No. 77/952080 (the "Application").

4. Applicant based its Application on use in connection with: "Entertainment in the nature of organizing a series of sporting events throughout the country, in the nature of a running race and related sporting and entertainment events, namely organizing community fairs featuring vendor booths of food and other race related sporting goods, and planning parties and dinners related to the sporting games; Organizing sporting events, namely, running events, primarily half marathons, 10K and 5K running races. ("Applicant's Proposed Services").
5. The Application was published for opposition on June 8, 2010.
6. Within the time required for filing a Notice of Opposition, on July 6, 2010, Opposer filed and received an extension of time to file an opposition with the Trademark Trial and Appeal Board.
7. This Notice of Opposition is timely filed within the time granted under the Extension pursuant to *Paragraph 6*.
8. Opposer's use of the term and mark RUNNING DIVAS ("Opposer's Mark" or "Running Divas Mark") has been associated with running apparel and related clothing and gifts since 2003.
9. Since 2004, Opposer has promoted and sold such items through vendor booths at cross country, track and field and road races throughout the United States including but not limited to, the Boston Marathon, New York Marathon, Los Angeles Marathon and 5K, Chicago Marathon, and races associated with the Rock and Roll Marathon Series®, including half marathons.
10. Opposer's products are also sold online at [www.runningdivas.com](http://www.runningdivas.com), as well as in retail stores throughout the United States.
11. Opposer has an over five-year continuous history of promoting, and participating in, various running events using the Running Divas Mark.
12. Opposer considers the Running Divas Mark to be among its most valuable assets.
13. Opposer has performed its due diligence in protecting the Running Divas Mark continuously and thoroughly since registration.
14. Attached hereto as Exhibit A are true and correct copies of current printouts from the electronic database records of the PTO showing the current status and title of the registration listed in *Paragraph 1*, above.
15. Since 2004, Opposer, its licensees and/or sponsored teams and athletes, have engaged in the promotion and encouragement of women's running and the sales of merchandise bearing the Running Divas Mark at running events and expositions throughout the United States.

16. In addition to the registered trademark identified above, Opposer has acquired extensive common law rights to use the Running Divas Mark in connection with running expositions at road racing events and otherwise.

### FIRST GROUND FOR RELIEF

17. Opposer incorporates by reference paragraphs 1 through 16 as if fully set forth herein.

18. The Application was filed based on Trademark Act Section 1(a) reciting January 4, 2010, as the date of first use and as the date of first use in commerce. The listing of Services described in *Paragraph 4*, above, was preceded by the following statement: "Applicant is using or is using through a related company, the mark in commerce on or in connection with the below identified goods/services." The Application was accompanied by a signed declaration attesting to the truth of the statements made in the Application, which statement was false and material to the Application.

19. Upon information and belief, Applicant had not used Applicant's Proposed Mark in connection with all of Applicant's Proposed Services anywhere in U.S. interstate commerce as of the filing date of the Application.

20. Upon information and belief, Applicant did not first use Applicant's Proposed Mark in U.S. interstate commerce in connection with Applicant's Proposed Services on January 4, 2010.

21. Upon information and belief, one or more material representations of fact were made by Applicant at the time of filing Application and/or during the prosecution of Application. It is alleged that Applicant knew, or should have known, that such misrepresentations of fact as referenced in *Paragraphs 18, 19 and 20* herein were false and/or misleading. It is alleged that Applicant has committed fraud in attempting to procure a registration for Applicant's Proposed Mark, thus making the Application void *ab initio*.

22. Upon information and belief, Applicant has organized one race in association with the Application, not a series of races, including only one half marathon and 5K, to be held October 3, 2010, and has not advertised or used the mark with any other services indicated or named as in use in Applicant's Application.

23. Upon information and belief, Applicant material and knowingly misstated the services associated with its Application to procure a registration for goods or services not in use as of the date of the Application.

**SECOND GROUND FOR RELIEF**  
UNDER 15 U.S.C. §1052(d)

24. Opposer incorporates by reference paragraphs 1 through 23 as if fully set forth herein.
25. No person or entity may use in commerce any simulation of the protected marks "tending to cause mistake, to deceive or to falsely suggest a connection with" such mark without the consent of the owners of such mark.
26. The Applicant's Proposed Mark constitutes a simulation of RUNNING DIVAS, which is a "protected mark", in association with running events which are integrally tied to Opposer's Mark and its distribution channels, including sales through booths operated at road racing events through which Opposer's products are sold.
27. Applicant's Proposed Mark is highly similar in appearance and commercial impression to Opposer's Running Divas Mark, as it incorporates and associates the word "Divas" with organizing races and selling items through vendor booths at road races, including vendor booths of sporting goods.
28. Opposer has marketed the Running Divas Mark to the running community and has acquired a favorable reputation among runners and running road race consumers. Opposer's products are sold through its vendor booths at road racing expositions held in association with road races. The specific use and manner of operating road race vendor expositions reinforces the distinctiveness and favorable reputation and goodwill enjoyed by Opposer and its Mark.
29. Registration and use of Applicant's Proposed Mark is likely to cause injury to Opposer's business reputation and to injure and impair Opposer's rights in its trademark and common law use by causing confusion, mistake and/or deception as to the respective rights of the parties and as to the source of the goods and services offered.
30. Applicant's Proposed Mark will necessarily infringe on Opposer's Running Divas Mark and common law rights.
31. The registration of Applicant's Proposed Mark for the Applicant's Services will be inconsistent with the rights of Opposer, based on Opposer's ownership of the federal registration for the Running Divas Mark (*Paragraph 1*), and its use of RUNNING DIVAS as common law, including promotion and exposure at running expositions and races.
32. Applicant's Proposed Services include a reference to the sale of "running related sporting goods", but has its registration in International Class 41, which is a service class. Accordingly, the Application's Proposed Services contain identified items that are outside registration in International Class 41.
33. Upon information and belief, running road races historically include the sale or distribution of running related apparel in conjunction with races, consisting of race shirts

and/or other apparel, which generally include the name of the race. Applicant's Proposed Mark, if used with race t-shirts advertising the Diva's Half Marathon, will violate Opposer's Mark.

34. Opposer has priority over Applicant due to its use, application filing date, and registration dates for the Running Divas Mark, long preceding Applicant's filing date for its Application and/or any claimed use (first use claimed is January 04, 2010) by Applicant for the Proposed Mark.

35. In reviewing Applicant's Proposed Mark, the PTO examiner required that Applicant disclaim the use of "Half-Marathon", which leaves only the word "Divas" as registered in association with the proposed racing and exposition events, thereby directly conflicting with Opposer's Running Divas Mark and its common law use. Registration is barred by provisions of Section 2(d) of the Lanham Act as said Mark so resembles Opposer's Mark previously registered in the PTO as used by Opposer and not abandoned, as to be likely, when used in conjunction with the Applicant's Proposed Mark.

36. The likelihood of confusion, mistake or deception that would arise from concurrent registration of Applicant's Proposed Mark with Opposer's use and registration of RUNNING DIVAS, is that persons are likely to believe that Applicant's Proposed Mark is legitimately connected or affiliated with Opposer's Mark through sponsorships, endorsements, licenses, or authorization by Opposer. Accordingly, registration of Applicant's Proposed Mark is barred by provisions of Section 2(d) of the Lanham Act.

37. Opposer has not authorized Applicant to use or register Applicant's Proposed Mark, nor does Opposer exercise any control over Applicant's use of Applicant's Proposed Mark, including reference to "sporting goods" associated with Opposer's Mark and common law use thereof.

**THIRD GROUND FOR RELIEF**  
UNDER 15 U.S.C. §1052(e)

38. Opposer incorporates by reference paragraphs 1 through 37 as if fully set forth herein.

39. Applicant's Proposed Mark is deceptively misdescriptive as it includes the term "Half-Marathon," whereas the Class description states that it is intended to apply to "half marathons, 10K and 5K road races," all of which are distinct running distances. Advertising all distances using the term "half marathon" would mislead the public and participants if registered and used with all or any one of such named events, excluding a half marathon.

40. Applicant's Proposed Mark is further deceptively misdescriptive in that Applicant plans to use "Divas" in association with ". . . organizing community fairs, vendor booths of . . . race related sporting goods, . . ." which suggests Applicant's use of the Proposed Mark with "sporting goods," which would directly conflict with Opposer's apparel as registered in International Class 25. The description is too broad and includes goods or services in other International Classes, such as International Class 25.

41. Applicant's Proposed Mark is further deceptively misdescriptive in that it is too broad in applying to entertainment services and referencing the sale of individual goods that must be registered in separate classes, i.e. the sale of food, which would require registration in other Classes.

42. Applicant's Proposed Mark is deceptively misdiscriptive in that the Application names services and events not being promoted by Applicant as of date of the Application.

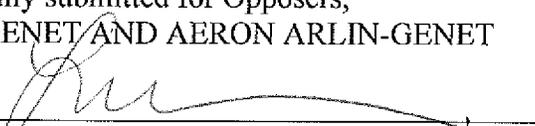
43. In sum, Applicant's Proposed Mark is deceptively misdescriptive in that it is too broad and includes goods and services in other International Classes, and includes services not being used by Applicant in violation of 15 U.S. C §1502(e)(1), and registration should be denied.

Opposer hereby appoints Linda Somers Smith, member of the Bar of the State of California, at DUGGAN SMITH & HEATH LLP, 560 Higuera Street, Suite B, San Luis Obispo, California, 93401, to act as attorney in the matter of the Opposition identified above, to prosecute said Opposition, to transact all business in the Patent and Trademark Office, and in the United States courts connected with the Opposition, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

Opposer has included the fee required by § 2.6(a)(17) with this Notice of Opposition.

Respectfully submitted for Opposers,  
MARC GENET AND AERON ARLIN-GENET

Dated: July 28, 2010

By:   
Linda Somers Smith  
Duggan, Smith and Heath LLP  
560 Higuera Street, Suite B  
San Luis Obispo, CA 93401  
Phone: 805-546-2060  
Fax: 805-546-8865  
Email: [lss@dshlawfirm.com](mailto:lss@dshlawfirm.com)

MARC GENET AND AERON ARLIN-GENET  
318 Mar Vista Drive  
Los Osos, CA 93402

**EXHIBIT A**

Thank you for your request. Here are the latest results from the TARR web server:

This page was generated by the TARR system on 2010-07-02 13:51:19 ET

Serial Number: 78407630 Assignment Information      Trademark Document Retrieval

Registration Number: 2970414

Mark

**RUNNING DIVAS**

(words only): RUNNING DIVAS

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2005-07-19

Filing Date: 2004-04-25

Transformed into a National Application: No

Registration Date: 2005-07-19

Register: Principal

Law Office Assigned: LAW OFFICE 105

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2005-07-19

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. Genet, Marc

**Address:**

Genet, Marc  
1146 First Street  
Los Osos, CA 93402  
United States

**Legal Entity Type:** Individual  
**Country of Citizenship:** United States  
**Phone Number:** 805-541-5756  
**Fax Number:** 805-546-8865

2. Arlin-Genet, Aeron

**Address:**

Arlin-Genet, Aeron  
1146 First Street  
Los Osos, CA 93402  
United States

**Legal Entity Type:** Individual  
**Country of Citizenship:** United States  
**Phone Number:** 805-541-5756  
**Fax Number:** 805-546-8865

---

**GOODS AND/OR SERVICES**

**International Class:** 025

**Class Status:** Active

Clothing, namely, men's, women's and children's t-shirts, pants, shorts, shirts, dance pants, tank tops, cover-ups, leggings, capris, jerseys, underwear, running jog-bras, sweatshirts, sweatpants, pajamas, socks, gloves; headwear, namely, visors, sweatbands, beanies, hats, and caps

**Basis:** 1(a)

**First Use Date:** 2003-01-01

**First Use in Commerce Date:** 2003-06-01

---

**ADDITIONAL INFORMATION**

(NOT AVAILABLE)

---

**MADRID PROTOCOL INFORMATION**

(NOT AVAILABLE)

---

**PROSECUTION HISTORY**

**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2005-07-19 - Registered - Principal Register

2005-04-26 - Published for opposition

2005-04-06 - Notice of publication

2005-02-08 - Law Office Publication Review Completed

2005-01-31 - Assigned To LIE

2004-12-13 - Assigned To LIE

2004-12-07 - Approved for Pub - Principal Register (Initial exam)  
2004-12-03 - Amendment From Applicant Entered  
2004-11-29 - Communication received from applicant  
2004-11-29 - TEAS Response to Office Action Received  
2004-11-18 - Examiner's Amendment And/Or Priority Action E-Mailed  
2004-11-18 - Examiners Amendment And/Or Priority Action - Completed  
2004-11-18 - Assigned To Examiner  
2004-05-03 - New Application Entered In Tram

---

**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**  
Linda Somers Smith

**Correspondent**  
Linda Somers Smith  
979 OSOS ST STE F  
SAN LUIS OBISPO CA 93401-3258  
Phone Number: 805-546-2060  
Fax Number: 805-546-8865

**PROOF OF SERVICE BY MAIL**

The undersigned declares and says as follows: my business address is 560 Higuera Street, Suite B, San Luis Obispo, CA 93401. I am employed in the City and County of San Luis Obispo; I am over the age of 18 years, and I am not a party to this cause. I am readily familiar with this business' practices for collection and processing of correspondence for mailing with the United States Postal Services. On the same day that a sealed envelope is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service with postage fully prepaid.

Date of Deposit: July 28, 2010

I served the within NOTICE OF OPPOSITION on Applicant/Registrant and counsel for Applicant/Registrant at the following address:

Continental Events and Sports Management Group, LLC  
16935 SW 84 CT  
MIAMI, FL 33157-4668

by placing a true copy thereof, enclosed in a sealed envelope with postage thereon fully prepaid, for deposit in the United States mail for collection and certified mailing on this day following ordinary business practices of Duggan, Smith & Heath LLP.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this Declaration is executed in San Luis Obispo, California, this 28th day of July, 2010.

By: 