

ESTTA Tracking number: **ESTTA410575**

Filing date: **05/24/2011**

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    | Excelsior-Henderson Motorcycles                                |             |    |
| Entity  | Corporation  | Citizenship | MN |
| Address | 1509 Keller Lake Road<br>Burnsville, MN 55306<br>UNITED STATES |             |    |

|                      |   |  |  |
|----------------------|---|--|--|
| Attorney information | Matthew H. Swyers<br>The Swyers Law Firm, PLLC<br>344 Maple Ave. West, Suite 389<br>Vienna, VA 22180<br>UNITED STATES<br>mswyers@SwyersLaw.com Phone:(866) 455-8800 |  |  |
|----------------------|---|--|--|

### Applicant Information

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 77886633  | Publication date       | 04/26/2011 |
| Opposition Filing Date | 05/24/2011  | Opposition Period Ends | 05/26/2011 |
| Applicant              | John's Repair, Inc.<br>301 North Main Street<br>Le Sueur, MN 56058<br>UNITED STATES |                        |            |

### Goods/Services Affected by Opposition

|   |
|---|
| Class 012. First Use: 2002/08/16 First Use In Commerce: 2002/08/16<br>All goods and services in the class are opposed, namely: Structural parts for motorcycles and motorcycle accessories, namely, gas tanks, suspension struts and parts therefor, brake foot levers, shift foot levers, suspension coil springs, fenders and parts therefor, and kick stands; all of the above excluding tires |
|---|

### Grounds for Opposition

|   |   |
|---|---|
| Priority and likelihood of confusion            | Trademark Act section 2(d)                  |
| <i>Torres v. Cantine Torresella S.r.l.Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) |

### Marks Cited by Opposer as Basis for Opposition

|                      |                     |                       |            |
|----------------------|---------------------|-----------------------|------------|
| U.S. Application No. | 85091536            | Application Date      | 07/23/2010 |
| Registration Date    | NONE                | Foreign Priority Date | NONE       |
| Word Mark            | EXCELSIOR-HENDERSON |                       |            |

|                     |  |
|---------------------|--|
| Design Mark         | <b>EXCELSIOR-HENDERSON</b>   |
| Description of Mark | NONE   |
| Goods/Services      | Class 025. First use: First Use: 1995/12/19 First Use In Commerce: 1995/12/19<br>Bandanas; Cardigans; Coats; Hats; Headbands; Jackets; Leggings; Long-sleeved shirts; Pullovers; Rompers; Short-sleeved shirts; Sweat shirts; T-shirts; Tank tops; Vests |

|                      |          |                       |            |
|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 85091531 | Application Date      | 07/23/2010 |
| Registration Date    | NONE     | Foreign Priority Date | NONE       |

|           |                       |
|-----------|-----------------------|
| Word Mark | EXCELSIOR-HENDERSON X |
|-----------|-----------------------|

|             |   |
|-------------|---|
| Design Mark |  |
|-------------|---|

|                     |   |
|---------------------|---|
| Description of Mark | The mark consists of a banner containing the words EXCELSIOR-HENDERSON, displayed in front of a large stylized X. |
|---------------------|---|

|                |  |
|----------------|--|
| Goods/Services | Class 012. First use: First Use: 1999/01/30 First Use In Commerce: 1999/01/30<br>Motorcycles and structural parts therefor<br>Class 025. First use: First Use: 1995/12/19 First Use In Commerce: 1995/12/19<br>Bandanas; Cardigans; Coats; Hats; Headbands; Jackets; Leggings; Long-sleeved shirts; Pullovers; Rompers; Short-sleeved shirts; Sweat shirts; T-shirts; Tank tops; Vests |
|----------------|--|

|                     |  |
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| Related Proceedings | 92052259 (Lead Case of Four Consolidated Cases), 92052333, 92053604, and 91198561. |
|---------------------|--|

|             |   |
|-------------|---|
| Attachments | 85091536#TMSN.jpeg ( 1 page )( bytes )<br>85091531#TMSN.jpeg ( 1 page )( bytes )<br>Notice of Opposition.pdf ( 7 pages )(266442 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 | /Matthew H. Swyers/ |
| Name      | Matthew H. Swyers   |
| Date      | 05/24/2011          |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
The Trademark Trial and Appeal Board**

In the matter of Ser. No. 77/886,633,  
For the mark EXCELSIOR HENDERSON,

|                                  |   |                      |
|----------------------------------|---|----------------------|
| Excelsior-Henderson Motorcycles, | : |                      |
|                                  | : |                      |
| Opposer,                         | : |                      |
|                                  | : |                      |
|                                  | : | Opposition No. _____ |
| vs.                              | : |                      |
|                                  | : |                      |
| John's Repair, Inc.              | : |                      |
|                                  | : |                      |
| Applicant.                       | : |                      |

**NOTICE OF OPPOSITION**

Opposer, Excelsior-Henderson Motorcycles (hereinafter "Opposer"), a Minnesota corporation, doing business at 1509 Keller Lake Road, Burnsville, Minnesota, 55306, believes that it will be damaged by the registration of Ser. No. 77/886,663 for the mark EXCELSIOR HENDERSON and, accordingly, hereby files this instant opposition proceeding.

**Grounds for Opposition**

As grounds for the instant Notice of Opposition, it is alleged that the registration of Applicant John's Repair, Inc. (hereinafter "Applicant") mark EXCELSIOR HENDERSON, as more fully displayed in Ser. No. 77/886,663 (hereinafter "JR Mark"), would be likely to cause confusion with Opposer's mark EXCELSIOR-HENDERSON and related marks (hereinafter "Opposer's Marks") which retain priority of use over the JR Mark by virtue of their prior use in commerce in the United States. In addition, it is alleged that the Applicant is attempting to obtain the JR Mark through fraudulent means by virtue of misrepresentation of information supplied on the application to register the mark.

## Statement of Facts

In support of the instant Notice of Opposition, it is alleged that:

1. Opposer and/or its predecessors in interests, is the owner of the mark EXCELSIOR-HENDERSON and related marks used on or in connection with motorcycles, motorcycle parts, and memorabilia.
2. Opposer has used Opposer's Marks in connection with the above-identified goods in interstate commerce since as early as December 19, 1995.
3. Opposer has maintained continuous use and/or periods of permissible non-use of the Opposer's Marks in connection with the above-identified goods since as early as December 19, 1995.
4. Opposer has invested significant sums of money in the promotion of Opposer's Marks and the Opposer's goods in the United States.
5. As a result of the aforesaid, Opposer has developed a valuable reputation and goodwill in Opposer's Marks and has achieved a following among relevant consuming public prior to the filing, registration and/or priority date of the JR Mark.
6. Opposer had several previous registrations with the United States Patent and Trademark Office (hereinafter "USPTO"). These marks are identified more fully in U.S. Registration No. 2,477,236, U.S. Registration No. 2,250,626, and U.S. Registration No. 2,143,816.
7. Due to financial hardship, Opposer permitted his registrations to expire.
8. Based upon information and belief, Applicant is a Minnesota corporation, owned and operated by John Jones, a U.S. citizen, located and doing business at 301 North Main Street, Le Sueur, Minnesota, 56058.

9. Applicant claims to use the JR Mark in connection with “[s]tructural parts for motorcycles and motorcycle accessories, namely, gas tanks, suspension struts and parts therefor, brake foot levers, shift foot levers, suspension coil springs, fenders and parts therefor, and kick stands; all of the above excluding tires” in International Class 12.

10. The JR Mark, identified more fully in Ser. No. 77/886,663, was filed with the USPTO on December 4, 2009.

11. In the application to register the JR Mark, Applicant claims a date of first use of its mark of August 16, 2002.

12. Of note, Applicant’s principal, John Jones, was an employee of the Opposer in 1999, years prior to the filing of the JR Mark.

13. Only following the separation of employment by principal of the Applicant John’s Repair from the Opposer did Applicant file for the JR Mark.

14. Upon information and belief, Applicant first used the mark EXCELSIOR HENDERSON in connection with the goods covered by its application in the United States no earlier than 2002.

**Count I  
Likelihood of Confusion**

15. Opposer hereby incorporates Paragraphs 1 through 14 as if fully set forth herein.

16. Opposer’s rights in the Opposer’s Marks have priority of use over Applicant’s rights, if any, in the JR Mark, inasmuch as Opposer commenced its use of the Opposer’s Marks in connection with its goods in interstate commerce prior to the filing, registration, and/or priority of use date of the Applicant’s application and use of the JR Mark.

17. Opposer believes that consumers confronted with the JR Mark will inevitably be confused and deceived into the mistaken belief that the Applicant’s goods have their origin or are

in some manner connected with the Opposer and/or Opposer's goods offered in connection with the Opposer's Marks.

18. The registration of the JR Mark would confer upon Applicant rights to which it is not entitled and is inconsistent with the prior established rights of Opposer in the Opposer's Marks.

19. By reason foregoing, Applicant will be seriously damaged by the registration of the JR Mark.

**Count II**  
**Fraud in the Application of Ser. No. 77/886,663**

20. Opposer hereby incorporates Paragraphs 1 through 19 as if fully set forth herein.

21. As stated above, the principal of the Applicant was employed by Opposer in 1999.

22. Following leaving the employ of the Opposer Applicant intentionally began use of Opposer's Marks in an effort to misappropriate the good will associated therewith.

23. Opposer initially approached Applicant to become a licensee of Opposer's Marks upon discovering the misappropriation thereof.

24. Despite ongoing conversations between Opposer and the principal of the Applicant to become a licensee of the Opposer's Marks Applicant, on December 4, 2009, filed the instant application.

25. In the subject application Applicant claimed a date of first use anywhere as early as August 16, 2002 also with a date of first use in commerce of August 16, 2002.

26. In so doing, Applicant provided knowingly false and material representations to the U.S. Patent and Trademark Office concerning its non-existent rights in the mark as a whole insofar as it knew it had no legitimate rights to the mark based upon Opposer's rights therein. Applicant's filing was merely perpetrated with the subjective intent of misleading the U.S. Patent

and Trademark Office to grant rights in a mark for the Applicant in an ongoing effort to misappropriate the trademark rights and good will of the Opposer.

27. Specific instances of Applicant's knowingly false and intentional material misrepresentations to the U.S. Patent and Trademark Office in its effort to mislead the same to induce a registration from the instant application include:

(a) Providing a date of first use which Applicant knew was false at the time of filing the application;

(b) Submitting a declaration under 18 U.S.C. Section 1001 declaring he/she believes the applicant to be the owner of the trademark/service mark sought to be registered and to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive all the while during licensing negotiations with the true trademark owner, the Opposer in the instant matter.

28. By reason foregoing, Applicant will be seriously damaged by the registration of the JR Mark.

WHEREFORE Opposer Excelsior-Henderson Motorcycles, by counsel, prays that the instant opposition be granted and Ser. No. 77/886,663 not be entitled to register.

Opposer hereby appoints Matthew H. Swyers, Esquire of The Swyers Law Firm, PLLC, 344 Maple Ave. West, Suite 389, Vienna, Virginia 22180, to act as his attorney for Opposer herein, with full power to prosecute said petition, to transact all relevant business with the United States Patent and Trademark Office, and to receive all official communication in connection with this petition.

Respectfully submitted this 24<sup>th</sup> day of May, 2011.

THE SWYERS LAW FIRM, PLLC

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Attorney for Opposer

