

ESTTA Tracking number: **ESTTA421446**

Filing date: **07/25/2011**

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	National Hockey League
Granted to Date of previous extension	07/27/2011
Address	1185 Avenue of the Americas15th Floor New York, NY 10036 UNITED STATES

Attorney information	Conal Berberich NHL Enterprises, L.P. 1185 Avenue of the Americas15th Floor New York, NY 10036 UNITED STATES cberberich@nhl.com, tprochnow@nhl.com, klynch@nhl.com, anunez@nhl.com, vfaraci@nhl.com
----------------------	--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------

**Applicant Information**

Application No	85175044	Publication date	03/29/2011
Opposition Filing Date	07/25/2011	Opposition Period Ends	07/27/2011
Applicant	Stallone, Brian 319 Redbird Road Bloomington, IL 601081337 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. All goods and services in the class are opposed, namely: Hats; Jackets; Pants; Shirts; Shoes; Socks; Sweat shirts; Underwear
--------------------------------------------------------------------------------------------------------------------------------------------

**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2422903	Application Date	07/14/1999
Registration Date	01/23/2001	Foreign Priority Date	NONE
Word Mark	STANLEY CUP		

Design Mark	<b>STANLEY CUP</b>
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1981/12/31 First Use In Commerce: 1981/12/31 clothing, namely, caps, cloth bibs, hats, jackets, jerseys, shirts, shorts, sweaters, sweatpants, sweatshirts, T-shirts, ties, vests and warm-up suits

U.S. Registration No.	3922822	Application Date	07/06/2010
Registration Date	02/22/2011	Foreign Priority Date	NONE
Word Mark	NHL STANLEYCUP PLAYOFFS		
Design Mark			
Description of Mark	The mark consists of the letters "NHL" in a shield embedded in a trophy cup design bearing the banner words "STANLEY CUP PLAYOFFS".		
Goods/Services	Class 041. First use: First Use: 2009/04/00 First Use In Commerce: 2009/04/00 Annual series of professional ice hockey contests to determine the world championship of professional ice hockey		

U.S. Registration No.	3922828	Application Date	07/06/2010
Registration Date	02/22/2011	Foreign Priority Date	NONE
Word Mark	NHL STANLEYCUPS PLAYOFFS		

Design Mark	
Description of Mark	The mark consists of the letters "NHL" in a shield embedded in a trophy cup design bearing the banner words "STANLEY CUP PLAYOFFS".
Goods/Services	Class 025. First use: First Use: 2009/04/00 First Use In Commerce: 2009/04/00 Clothing, namely, bandanas, beach cover-ups, belts, body suits, boxer shorts, caps, cloth bibs, coats, dresses, footwear, ear muffs, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rain wear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, t-shirts, ties, toques, underwear, vests, warm-up suits and wristbands

U.S. Registration No.	3961015	Application Date	07/06/2010
Registration Date	05/17/2011	Foreign Priority Date	NONE

Word Mark	NHL STANLEY CUP FINAL
-----------	-----------------------

Design Mark	
Description of Mark	The mark consists of letters "NHL" in a shield draped by ribbons with 3 stars on each side underneath a trophy cup design bearing the banner words "STANLEY CUP FINAL".
Goods/Services	Class 025. First use: First Use: 2009/05/27 First Use In Commerce: 2009/05/27 Clothing, namely, bandanas, beach cover-ups, belts, body suits, boxer shorts, caps, cloth bibs, coats, dresses, footwear, ear muffs, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rain wear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, t-shirts, ties, toques, underwear, vests, warm-up suits and wristbands

U.S. Registration No.	3922838	Application Date	07/06/2010
Registration Date	02/22/2011	Foreign Priority	NONE

		Date	
Word Mark	NHL STANLEY CUP FINAL		
Design Mark			
Description of Mark	The mark consists of the letters "NHL" in a shield draped by ribbons with 3 stars on each side underneath a trophy cup design bearing the banner words "STANLEY CUP FINAL".		
Goods/Services	Class 041. First use: First Use: 2009/04/30 First Use In Commerce: 2009/05/27 Annual series of professional ice hockey contests to determine the world champions of professional ice hockey		

U.S. Registration No.	3139963	Application Date	05/19/2004
Registration Date	09/05/2006	Foreign Priority Date	NONE
Word Mark	CUP CRAZY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1997/04/01 First Use In Commerce: 1997/04/01 Clothing, namely, shirts, jerseys, jackets, sweatshirts, t-shirts, caps and hats		

U.S. Registration No.	2191055	Application Date	10/07/1997
Registration Date	09/22/1998	Foreign Priority Date	NONE
Word Mark	NHL CUP CRAZY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1997/04/01 First Use In Commerce: 1997/04/01 [ clothing, namely, beach coverups, ] caps [ , cloth bibs, coats, dresses, hats, headbands, jackets, jerseys, robes, scarves, shirts, shorts, socks, sweaters, sweatpants, sweatshirts, T-shirts, ties, underwear and warm-up suits ]

U.S. Registration No.	888872	Application Date	05/02/1969
Registration Date	03/31/1970	Foreign Priority Date	NONE
Word Mark	STANLEY CUP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U107 (International Class 041). First use: First Use: 1893/00/00 First Use In Commerce: 1924/00/00 ANNUAL SERIES OF PROFESSIONAL ICE HOCKEY CONTESTS TO DETERMINE THE WORLD CHAMPIONSHIP OF PROFESSIONAL ICE HOCKEY		

Attachments	75749963#TMSN.gif ( 1 page )( bytes ) 85078501#TMSN.jpeg ( 1 page )( bytes ) 85078542#TMSN.jpeg ( 1 page )( bytes ) 85078712#TMSN.jpeg ( 1 page )( bytes ) 85078622#TMSN.jpeg ( 1 page )( bytes ) 78421716#TMSN.jpeg ( 1 page )( bytes ) 75369498#TMSN.gif ( 1 page )( bytes ) Notice of Opposition - Lace Up For The Cup (NHL).pdf ( 9 pages )(141814 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	/s/ Conal Berberich
Name	Conal Berberich
Date	07/25/2011





2. Opposer is the owner of the following applications and registrations on the Principal Register in the United States Patent and Trademark Office, all of which are valid and subsisting:

Mark	Registration No. / Date	Goods and/or Services	Date of First Use
STANLEY CUP	2,422,903; January 23, 2001	Clothing, namely, caps, cloth bibs, hats, jackets, jerseys, shirts, shorts, sweaters, sweatpants, sweatshirt, T-shirts, ties, vests and warm-up suits.	December 31, 1981
STANLEY CUP	888,872; March 31, 1970	Annual series of professional ice hockey contests to determine the world championship of professional ice hockey.	1893
	3,922,822; February 22, 2011	Annual series of professional ice hockey contests to determine the world championship of professional ice hockey	April 2009
	3,922,828; February 22, 2011	Clothing, namely, bandanas, beach cover-ups, belts, body suits, boxer shorts, caps, cloth bibs, coats, dresses, footwear, ear muffs, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas,	April 2009

		pants, rain coats, rain wear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, t-shirts, ties, toques, underwear, vests, warm-up suits and wristbands	
	3,961,015; May 17, 2011	Clothing, namely, bandanas, beach cover-ups, belts, body suits, boxer shorts, caps, cloth bibs, coats, dresses, footwear, ear muffs, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rain wear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, t-shirts, ties, toques, underwear, vests, warm-up suits and wristbands	May 27, 2009
	3,922,838; February 22, 2011	Annual series of professional ice hockey contests to determine the world champions of professional ice hockey	May 27, 2009

CUP CRAZY	3,139,963; September 5, 2006	Clothing, namely, shirts, jerseys, jackets, sweatshirts, t-shirts, caps and hats.	April 1, 1997
	2,191,055; September 22, 1998	Caps	April 1, 1997

3. Opposer uses the aforesaid registered marks, as well as the common law marks CUP and THE CUP and a family of other related marks (the “STANLEY CUP Marks”) in connection with professional ice hockey exhibitions and a wide range of related goods and services.

4. For many decades and long before Applicant’s November 11, 2010, filing date, Opposer has been using the STANLEY CUP Marks in connection with professional ice hockey exhibitions and a wide variety of related goods and services. In addition, Opposer is engaged in an extensive collateral licensing program of the STANLEY CUP Marks. As part of this program, Opposer and NHL Enterprises, L.P. (the licensing and marketing arm of the NHL and its 30 member clubs) license the STANLEY CUP Marks for use on a wide variety of goods and services, including goods identical to those set forth in the Application.

5. The registrations referenced above are valid, subsisting, and in full force and effect, and many of the registrations are incontestable pursuant to the provisions of Section 15 of the Lanham Act, 15 U.S.C. § 1065. The registrations referenced above

constitute conclusive evidence (in the case of incontestable registrations) or *prima facie* evidence (in the case of those registrations that are not yet incontestable) of Opposer's exclusive right to use the STANLEY CUP Marks in commerce in connection with the goods and services specified in the registrations.

6. During its longstanding, widespread and continuous use of the above-referenced marks, Opposer and its authorized business partners, sponsors, and licensees have expended considerable time, effort and money in advertising and publicizing the sale of goods and services bearing the STANLEY CUP Marks. Therefore, the STANLEY CUP Marks are symbolic of the extensive goodwill and consumer recognition that Opposer has established through substantial expenditures of time, effort and other resources in the advertising and promotion of the goods and services Opposer offers and sells under these marks.

7. On November 11, 2010, shortly after the start of the 2010-2011 NHL season, Applicant filed the Application on an intent-to-use basis (no allegation of use has been filed as of the date this Notice of Opposition was filed). The Application was published for opposition in the *Official Gazette* on March 29, 2011.

8. Applicant derived its LACE UP FOR THE CUP mark by combining CUP—a shorthand reference to the STANLEY CUP Marks—with the phrase “Lace Up” which is closely associated with the sport of ice hockey. Specifically, the sport of ice hockey, by definition, requires that its participants wear ice skates which are generally fastened and secured by laces. To prepare to play a game of ice hockey, one must “lace up” his or her skates and the phrase “Lace Up” is by extension widely understood to indicate the mental and physical preparation required to play the sport at a high level.

“Lace Up for the Cup” is therefore understood as an entreaty for hockey players to prepare themselves for the challenge of winning the Stanley Cup Championship.

9. The goods set forth in the Application are identical to certain of the goods offered by Opposer or its licensees in connection with the STANLEY CUP Marks.

10. Based on the similarities of Applicant’s LACE UP FOR THE CUP designation and the STANLEY CUP Marks, the public is likely to be misled that Applicant’s goods under the LACE UP FOR THE CUP designation are associated with Opposer or Opposer’s goods or services, that Applicant’s goods or services emanate from or are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

11. Applicant’s Application and the presumption of exclusivity that would arise from a registration to Applicant of LACE UP FOR THE CUP pursuant to 15 U.S.C. 1057(b) is inconsistent with Opposer’s prior rights in the STANLEY CUP Marks.

12. Opposer will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

13. Opposer believes it will be damaged by registration of Applicant’s LACE UP FOR THE CUP designation under Section 13 of the Lanham Act, 15 U.S.C. § 1063, on the ground that Applicant’s use and registration of the subject designation will falsely suggest a connection between Applicant and Opposer to the damage of Opposer in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

14. Opposer believes it will be damaged by registration of Applicant's LACE UP FOR THE CUP designation under Section 13 of the Lanham Act, 15 U.S.C. § 1063, on the ground that the subject designation so resembles the STANLEY CUP Marks used by Opposer in the United States as to be likely, when used on or in connection with the goods identified in the Application, to cause confusion, mistake or to deceive consumers, with consequent injury to Opposer and to the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer believes it will be damaged by registration of LACE UP FOR THE CUP shown on Application Serial No. 85/175,044 and respectfully requests that the Opposition be sustained, registration of said mark be denied, and that the Trademark Trial and Appeal Board grant such other and further relief as it deems just and appropriate.

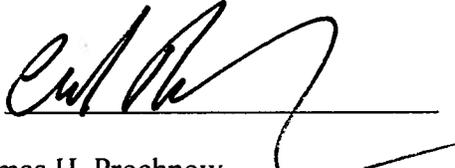
[Remainder of Page Intentionally Blank]

All communication should be addressed to Opposer's counsel, NHL Enterprises,

L.P. at the below stated address.

Dated: New York, New York  
July 25, 2011

Respectfully submitted,

By: 

Thomas H. Prochnow  
Kelley A. Lynch  
Conal M. Berberich  
NHL Enterprises, L.P.  
1185 Avenue of the Americas, 15<sup>th</sup> Floor  
New York, New York 10036  
212.789.2000  
*Attorneys for the National Hockey League*

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Notice of Opposition has been sent via first class mail (certified and return receipt requested), postage prepaid, on this 25th day of July, 2011 to:

Stallone, Brian  
319 Redbird Road  
Bloomington, IL 60108-1337  
*Applicant*

  
Conal M. Berberich  
*Attorney for Opposer*