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

Proceeding	91205331
Party	Plaintiff Ms. Teresa H. Earnhardt
Correspondence Address	LARRY C JONES ALSTON & BIRD LLP 101 S TRYON STREET, SUITE 4000 CHARLOTTE, NC 28280 4000 UNITED STATES Larry.Jones@Alston.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Larry C. Jones
Filer's e-mail	Larry.Jones@Alston.com
Signature	/Larry C. Jones/
Date	04/23/2013
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Teresa H. Earnhardt,	§	Consolidated Opposition Nos.
	§	91205331 (parent) and 91205338
Opposer,	§	
	§	In the matter of:
vs.	§	
	§	Application Serial No. 85/383,910
Kerry Earnhardt, Inc.,	§	Mark: EARNHARDT COLLECTION
	§	(Intl. Class 20)
Applicant.	§	
	§	Application Serial No. 85/391,456
	§	Mark: EARNHARDT COLLECTION
		(Intl. Class 37)

**OPPOSER'S MOTION FOR LEAVE TO AMEND  
NOTICES OF OPPOSITION**

Pursuant to Rule 15(a), Fed. R. Civ. P., and the related rules and precedents of the Board, Opposer Teresa H. Earnhardt moves for leave to amend her two original notices of opposition to add an additional ground for each opposition, namely, an assertion that the opposed designation, EARNHARDT COLLECTION, is primarily merely a surname.

This motion is filed and served March 11, 2013, nearly two months prior to the current deadline for discovery, *i.e.*, May 4, 2013. Accordingly, granting this motion will not be prejudicial to any right of Applicant, and justice requires that Applicant's applications be vetted as to the primary significance of the designation for which registrations are sought.

Attached hereto as Exhibits A and B are the amended notices of opposition which Opposer seeks leave to file. Each original notice of opposition has been amended merely to add new Paragraphs 27 and 28 and to modify Paragraph 29 to allege that the term EARNHARDT COLLECTION is primarily merely a surname such that each application should be rejected also pursuant to Section 2(e)(4) of the Lanham Act (15 U.S.C. § 1052(e)(4)).

In support of this motion, Opposer submits the following argument and authorities.

Recent TTAB Decision

The very recently published (February 25, 2013) precedential decision of the Board in *Miller v. Miller*, 105 USPQ2d 1615 (TTAB 2013), held that a composite designation comprised of (i) a term which is primarily merely a surname and (ii) a disclaimed generic term, is considered, as a matter of law, to be, in its entirety, “primarily merely a surname” despite the inclusion of the non-surname component in the composite designation. That recent precedential holding is clearly applicable to the oppositions in this consolidated proceeding inasmuch as the mark made the subject of each proceeding, EARNHARDT COLLECTION, is comprised of (i) “EARNHARDT,” a term which the evidence may show to be primarily merely a surname, and (ii) the disclaimed generic term, “COLLECTION.” Accordingly, justice requires that leave be given to vet the issue of whether the composite designation EARNHARDT COLLECTION is primarily merely a surname. Fed. R. Civ. P. 15(a).

The Proposed Amendment Is Not Prejudicial to Applicant’s Rights

The additional issue to be considered via the amended notices of opposition is an issue which anyone with standing may assert in a future cancellation proceeding if the opposed applications mature as registrations. Thus, vetting the issue now in this proceeding works no cognizable prejudice against Applicant’s rights.

Moreover, this proceeding is still in the discovery stage, and the discovery stage may be further extended as necessary to allow the parties to take discovery on all issues. This Board has often noted that granting a motion for leave to amend a notice of opposition prior to the commencement of the first testimony period is particularly favored by the provisions liberally permitting amendments under Rule 15(a), Fed. R. Civ. P. *See, e.g., Commodore Electronics Ltd.*

*v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993); *United States Olympic Cmte. v. O-M Bread Inc.*, 26 USPQ2d 1221, 1223 (TTAB 1993); *Focus 21 Int'l Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732, 1733-34 (TTAB 1990).

Conclusion

Opposer respectfully submits that, because (i) justice requires that the Board vet the issue whether EARNHARDT COLLECTION is primarily merely a surname, and (ii) doing so will not prejudice Applicant's rights in any cognizable manner, the Board should grant leave for Opposer to file the two amended notices of opposition attached hereto as Exhibits A and B.

Respectfully submitted,



Larry C. Jones  
Carla H. Clements  
Alston & Bird, LLP  
Bank of America Plaza  
101 South Tryon Street, Suite 4000  
Charlotte, North Carolina 28280-4000  
Telephone: (704) 444-1000

Attorneys for Opposer,  
Teresa H. Earnhardt

# **EXHIBIT A**



Dale Earnhardt drove in only a few races, but in 1979 his career shifted into another gear.

Racing as a rookie on what was then designated as the Winston Cup Series, he was so successful that he not only finished that year as one of the top ten stock car drivers (despite missing several races because of a broken collarbone) but also he won Rookie of the Year honors.

2. In the following years, NASCAR stock car racing enjoyed continuously increasing popularity across the country, and Dale Earnhardt arguably was the most colorful and most popular driver in a sport whose fans passionately identify with the persona of their favorite driver. As a means of identifying themselves to other NASCAR fans as part of Dale Earnhardt's fandom, legions of fans yelled "EARNHARDT!" loudly and proudly not only during races but also wherever and whenever NASCAR fans gathered.

3. During his career, Dale Earnhardt won 76 NASCAR races, 7 NASCAR Winston Cup Series championships, and finished among the top ten drivers in more than 400 races. His aggressive and daringly skillful driving not only brought unequalled success on the race track but also earned him the nickname, "The Intimidator." However, on the very last lap of the 2001 Daytona 500, while racing in the center of three cars side-by-side heading into Turn 3, a slight contact with one of the other two cars ignited a rapid sequence of events which tragically resulted in Dale Earnhardt's car hitting the track's outside wall nose-first at nearly 160 miles per hour. As the race's winner crossed the finish line, Dale Earnhardt had sustained a skull fracture and was mortally injured.

4. As noted above, one of the salient characteristics of NASCAR fans is their passionate identification with their favorite driver. As NASCAR stock car racing itself became much more popular nationwide during Dale Earnhardt's career, that characteristic of its fans spawned lucrative licensing and endorsement opportunities for NASCAR's more popular

drivers. Dale Earnhardt, as the greatest persona in NASCAR history, took advantage of those opportunities, and his name and persona were licensed for use during his lifetime on and in conjunction with a broad spectrum of products and services. Following his death, the commercial rights in Dale Earnhardt's name and persona have passed to his widow, Teresa H. Earnhardt, the Opposer in this proceeding.

5. It has been reported that, before Dale Earnhardt's death, the sales of his licensed merchandise totaled about \$50 million annually (13 B. Mullin, S. Hardy and W. Sutton, *Sport Marketing*, p. 201) and that, following his death, the sales have been even greater. *Id.* Moreover, that same publication states that "over 14,000 **Earnhardt collectibles** were on sale on the online auction site eBay (nearly 10,000 more than Michael Jordan items)." *Id.* In fact, more than a decade after Earnhardt's death, there remains a category of merchandise available and designated by eBay as "**Earnhardt Collectables.**" (See Exhibit A hereto.)

6. Still further, a book pertaining to the current practices of sports management notes the sustained popularity of Earnhardt collectables in recent years:

**Possession and Authenticity of Collectables**

Who is the world's most celebrated athlete? If you recall the earlier discussion about endorsements, you might answer Jordan, Woods, or Iverson. But if popularity is measured on the basis of sales of licensed products, the answer would be "The Intimidator," deceased NASCAR legend Dale Earnhardt, Sr. The sale of products licensed to Earnhardt, who did not survive a crash on the final lap of the 2001 Daytona 500, still generates millions in revenues and royalties. In addition, in the months following his death, over 14,000 Earnhardt items were reported for sale on eBay, the online auction Web Site. The sales will continue for years....

*Principles and Practice of Sport Management* by Lisa Pike Masteralexis, Carol A. Barr, and Mary A. Hums (2008), at page 424.

7. Thus, just as it did during his lifetime and racing career, the designation "EARNHARDT" continues to identify Dale Earnhardt to millions of people in this country.

8. Likewise, just as it did during his lifetime and racing career, the term “EARNHARDT COLLECTABLES,” to many people in this country, connotes merchandise which is associated with and/or enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest.

9. Moreover, since at least as early as 1975, the designations EARNHARDT and DALE EARNHARDT have been used continuously in this country as both trademarks and as service marks by Dale Earnhardt and his successor-in-interest and their licensees, on and in conjunction with a wide array of goods and services. The availability of such merchandise under the EARNHARDT and DALE EARNHARDT marks has been advertised and promoted at considerable expense.

10. By reason of the adoption and continuous use of the EARNHARDT and DALE EARNHARDT marks, each of those designations has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying the businesses of Dale Earnhardt and his successor-in-interest and the merchandise authorized by them. The EARNHARDT and DALE EARNHARDT marks have each become famous and distinctive through, *inter alia*, extensive use, advertising and promotion of those marks throughout the United States over a substantial period of time on and in conjunction with a variety of merchandise and services.

11. Consequently, through such usage and recognition, Opposer has acquired common-law rights in each of the EARNHARDT and DALE EARNHARDT designations as a proprietary trademark, which rights extend, without limitation, to Opposer’s exclusive right to use such designations nationwide (directly or through her licensees) on and in conjunction with various goods and services.

12. Opposer is also the owner of a U.S. registration for the DALE EARNHARDT mark, Registration No. 1,644,237 (the “DALE EARNHARDT Registration”). Opposer’s DALE EARNHARDT Registration is valid, subsisting, and in full force and effect. Moreover, Opposer’s DALE EARNHARDT Registration is incontestable, and, as such, serves as conclusive evidence of Opposer’s exclusive right to use (or license the use of) the DALE EARNHARDT mark on and in conjunction with all of the goods and services listed in said registration.

13. On July 28, 2011, Applicant filed the intent-to-use application at issue to register the designation EARNHARDT COLLECTION (“Applicant’s Mark”) as a trademark for use on furniture. In doing so, Applicant disclaimed the right to use the term “COLLECTION” apart from the designation as a whole. Thus, the only element of Applicant’s putative designation not disclaimed is the term “EARNHARDT.”

14. Opposer’s predecessor-in-interest, Dale Earnhardt, has been known by a substantial portion of the public in this country as “EARNHARDT” and/or as “DALE EARNHARDT,” continuously from long prior to Applicant’s filing of the subject application through the present time.

15. Merchandise which is associated with and/or enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest has often been referred to by the public as “EARNHARDT COLLECTABLES,” continuously from long prior to Applicant’s filing of the subject application through the present time.

16. The opposed designation, EARNHARDT COLLECTION, is the same or a close approximation of the name and identity EARNHARDT.

17. The opposed designation, EARNHARDT COLLECTION, is the same or a close approximation of the name and identity DALE EARNHARDT.

18. The opposed designation, EARNHARDT COLLECTION, would be recognized in the United States as pointing uniquely and unmistakably to Dale Earnhardt or his commercial successor-in-interest. Thus, rather than perceiving the EARNHARDT COLLECTION designation having some other meaning, a substantial portion of the public would view that designation as being associated with Dale Earnhardt.

19. Applicant does not have Opposer's permission to use the designation EARNHARDT COLLECTION, and Applicant's potential use of the designation EARNHARDT COLLECTION on furniture will not enjoy any sponsorship, approval or other commercial connection with Dale Earnhardt or Opposer.

20. However, each of the designations EARNHARDT and DALE EARNHARDT enjoys such fame or reputation that a commercial connection with Dale Earnhardt would be presumed from Applicant's potential use of the designation EARNHARDT COLLECTION on furniture in this country.

21. Thus, just as the usage today of "EARNHARDT COLLECTABLES" connotes in this country merchandise which enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest, Applicant's potential use of EARNHARDT COLLECTION on furniture may falsely suggest to the public in this country that such goods enjoy a sponsorship, approval or other commercial connection with Dale Earnhardt or his successor-in-interest.

22. Pursuant to 15 U.S.C. § 1052(a), inasmuch as Applicant's EARNHARDT COLLECTION furniture designation "may...falsely suggest a connection with" Dale Earnhardt, that designation may not be registered lawfully by Applicant.

23. Still further, each of the EARNHARDT and DALE EARNHARDT marks is not only a distinctive mark, but also a famous mark, particularly when used on and in conjunction

with collectables, and each of the EARNHARDT and DALE EARNHARDT marks acquired that status as a famous mark prior to the first usage in commerce of the Applicant's EARNHARDT COLLECTION designation (if any such usage has been made).

24. Hence, the application to register the EARNHARDT COLLECTION mark should also be refused pursuant to 15 U.S.C. §§ 1063(a) and 1125(c) on the basis that the usage of that designation on the goods listed in the subject application is likely to cause dilution by blurring of each of the famous EARNHARDT and DALE EARNHARDT marks.

25. The first component of Applicant's EARNHARDT COLLECTION designation, "EARNHARDT," is visually and aurally identical to both Opposer's common law EARNHARDT mark and the second component of Opposer's federally registered DALE EARNHARDT mark. These characteristics create a likelihood of confusion with both the EARNHARDT and DALE EARNHARDT marks. Further, the second component of Applicant's designation, COLLECTION, is a descriptive term when used in the context of furniture, has been disclaimed by Applicant because of that descriptiveness, and thus does not impart any distinctiveness to Applicant's designation. Moreover, the goods listed in Applicant's application are types of goods which the public may reasonably expect or believe to enjoy a license of the EARNHARDT and DALE EARNHARDT marks. Thus Applicant's EARNHARDT COLLECTION designation, when used on or in connection with the furniture goods listed in the application at issue, is likely to deceive or cause confusion or mistake as to the source or sponsorship of Applicant's furniture goods in relation to Opposer and the EARNHARDT and DALE EARNHARDT merchandise.

26. Thus, Applicant's application for registration of the EARNHARDT COLLECTION mark should also be refused under 15 U.S.C. § 1052(d).

27. Additionally and/or in the alternative, the designation EARNHARDT COLLECTION is primarily merely a surname.

28. Thus, Applicant's application for registration of the EARNHARDT COLLECTION mark should also be refused under 15 U.S.C. § 1052(e)(4).

**SUMMARY**

29. The application for registration of EARNHARDT COLLECTION should be refused under any or all of: 15 U.S.C. §1052(a) (false suggestion of a connection); 15 U.S.C. § 1063(a) and 15 U.S.C. § 1125(c) (dilution); 15 U.S.C. § 1052(d) (likelihood of confusion); and/or 15 U.S.C. § 1052(e)(4) (primarily merely a surname).

30. Accordingly, Opposer asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for the EARNHARDT COLLECTION furniture designation to Applicant as sought in Trademark Application Serial No. 85/383,910.

WHEREFORE, Opposer prays that the application for registration of Applicant's EARNHARDT COLLECTION designation be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Please charge all fees incurred by Opposer in conjunction with this proceeding to the firm's Deposit Account No. 16-0605.

Respectfully submitted,



\_\_\_\_\_  
Larry C. Jones  
Attorney for Opposer  
Alston & Bird LLP  
101 S. Tryon Street, Suite 4000  
Charlotte, North Carolina 28280-4000  
Telephone: (704) 444-1000  
[Larry.Jones@alston.com](mailto:Larry.Jones@alston.com)

# **EXHIBIT B**

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

In the matter of Trademark Application  
Serial No. 85/391,456  
Filed: August 6, 2011  
Trademark: EARNHARDT COLLECTION  
Published: January 17, 2012

-----X	)	
Teresa H. Earnhardt,	)	
	)	
Opposer	)	
	)	Opposition No. 91205338
v.	)	
	)	
Kerry Earnhardt, Inc.,	)	
	)	
Applicant.	)	
-----X	)	

**AMENDED NOTICE OF OPPOSITION**

Teresa H. Earnhardt, an individual having a mailing address of c/o Dale Earnhardt, Inc., 1675 Dale Earnhardt Highway No. 3, Mooresville, North Carolina 28115 (“Opposer”), believes that she will be damaged by the registration of the designation shown in Application Serial No. 85/391,456, filed August 6, 2011, by Kerry Earnhardt, Inc., a North Carolina corporation having a mailing address of P.O. Box 418, Mooresville, North Carolina 28115 (“Applicant”), and hereby opposes the registration of said designation as a service mark.

As grounds of opposition, it is alleged that:

1. Ralph Dale Earnhardt (“Dale Earnhardt”) was born April 29, 1951, the son of Ralph Earnhardt, who was, at that time, a successful competitive short-track stock car driver in North Carolina. Two years after his father’s death, Dale Earnhardt began his own professional career as a stock car driver in 1975. For the first few years of his professional racing career,

Dale Earnhardt drove in only a few races, but in 1979 his career shifted into another gear.

Racing as a rookie on what was then designated as the Winston Cup Series, he was so successful that he not only finished that year as one of the top ten stock car drivers (despite missing several races because of a broken collarbone) but also he won Rookie of the Year honors.

2. In the following years, NASCAR stock car racing enjoyed continuously increasing popularity across the country, and Dale Earnhardt arguably was the most colorful and most popular driver in a sport whose fans passionately identify with the persona of their favorite driver. As a means of identifying themselves to other NASCAR fans as part of Dale Earnhardt's fandom, legions of fans yelled "EARNHARDT!" loudly and proudly not only during races but also wherever and whenever NASCAR fans gathered.

3. During his career, Dale Earnhardt won 76 NASCAR races, 7 NASCAR Winston Cup Series championships, and finished among the top ten drivers in more than 400 races. His aggressive and daringly skillful driving not only brought unequalled success on the race track but also earned him the nickname, "The Intimidator." However, on the very last lap of the 2001 Daytona 500, while racing in the center of three cars side-by-side heading into Turn 3, a slight contact with one of the other two cars ignited a rapid sequence of events which tragically resulted in Dale Earnhardt's car hitting the track's outside wall nose-first at nearly 160 miles per hour. As the race's winner crossed the finish line, Dale Earnhardt had sustained a skull fracture and was mortally injured.

4. As noted above, one of the salient characteristics of NASCAR fans is their passionate identification with their favorite driver. As NASCAR stock car racing itself became much more popular nationwide during Dale Earnhardt's career, that characteristic of its fans spawned lucrative licensing and endorsement opportunities for NASCAR's more popular

drivers. Dale Earnhardt, as the greatest persona in NASCAR history, took advantage of those opportunities, and his name and persona were licensed for use during his lifetime on and in conjunction with a broad spectrum of products and services. Following his death, the commercial rights in Dale Earnhardt's name and persona have passed to his widow, Teresa H. Earnhardt, the Opposer in this proceeding.

5. It has been reported that, before Dale Earnhardt's death, the sales of his licensed merchandise totaled about \$50 million annually (13 B. Mullin, S. Hardy and W. Sutton, *Sport Marketing*, p. 201) and that, following his death, the sales have been even greater. *Id.* Moreover, that same publication states that "over 14,000 **Earnhardt collectibles** were on sale on the online auction site eBay (nearly 10,000 more than Michael Jordan items)." *Id.* In fact, more than a decade after Earnhardt's death, there remains a category of merchandise available and designated by eBay as "**Earnhardt Collectables.**" (See Exhibit A hereto.)

6. Still further, a book pertaining to the current practices of sports management notes the sustained popularity of Earnhardt collectables in recent years:

**Possession and Authenticity of Collectables**

Who is the world's most celebrated athlete? If you recall the earlier discussion about endorsements, you might answer Jordan, Woods, or Iverson. But if popularity is measured on the basis of sales of licensed products, the answer would be "The Intimidator," deceased NASCAR legend Dale Earnhardt, Sr. The sale of products licensed to Earnhardt, who did not survive a crash on the final lap of the 2001 Daytona 500, still generates millions in revenues and royalties. In addition, in the months following his death, over 14,000 Earnhardt items were reported for sale on eBay, the online auction Web Site. The sales will continue for years....

*Principles and Practice of Sport Management* by Lisa Pike Masteralexis, Carol A. Barr, and Mary A. Hums (2008), at page 424.

7. Thus, just as it did during his lifetime and racing career, the designation "EARNHARDT" continues to identify Dale Earnhardt to millions of people in this country.

8. Likewise, just as it did during his lifetime and racing career, the term “EARNHARDT COLLECTABLES,” to many people in this country, connotes merchandise which is associated with and/or enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest.

9. Moreover, since at least as early as 1975, the designations EARNHARDT and DALE EARNHARDT have been used continuously in this country as both trademarks and as service marks by Dale Earnhardt and his successor-in-interest and their licensees, on and in conjunction with a wide array of goods and services. The availability of such merchandise under the EARNHARDT and DALE EARNHARDT marks has been advertised and promoted at considerable expense.

10. By reason of the adoption and continuous use of the EARNHARDT and DALE EARNHARDT marks, each of those designations has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying the businesses of Dale Earnhardt and his successor-in-interest and the merchandise authorized by them. The EARNHARDT and DALE EARNHARDT marks have each become famous and distinctive through, *inter alia*, extensive use, advertising and promotion of those marks throughout the United States over a substantial period of time on and in conjunction with a variety of merchandise and services.

11. Consequently, through such usage and recognition, Opposer has acquired common-law rights in each of the EARNHARDT and DALE EARNHARDT designations as a proprietary trademark, which rights extend, without limitation, to Opposer’s exclusive right to use such designations nationwide (directly or through her licensees) on and in conjunction with various goods and services.

12. Opposer is also the owner of a U.S. registration for the DALE EARNHARDT mark, Registration No. 1,644,237 (the “DALE EARNHARDT Registration”). Opposer’s DALE EARNHARDT Registration is valid, subsisting, and in full force and effect. Moreover, Opposer’s DALE EARNHARDT Registration is incontestable, and, as such, serves as conclusive evidence of Opposer’s exclusive right to use (or license the use of) the DALE EARNHARDT mark on and in conjunction with all of the goods and services listed in said registration.

13. On July 28, 2011, Applicant filed the intent-to-use application at issue to register the designation EARNHARDT COLLECTION (“Applicant’s Mark”) as a service mark for use in conjunction with the custom construction of homes. In doing so, Applicant disclaimed the right to use the term “COLLECTION” apart from the designation as a whole. Thus, the only element of Applicant’s putative designation not disclaimed is the term “EARNHARDT.”

14. Opposer’s predecessor-in-interest, Dale Earnhardt, has been known by a substantial portion of the public in this country as “EARNHARDT” and/or as “DALE EARNHARDT,” continuously from long prior to Applicant’s filing of the subject application through the present time.

15. Merchandise which is associated with and/or enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest has often been referred to by the public as “EARNHARDT COLLECTABLES,” continuously from long prior to Applicant’s filing of the subject application through the present time.

16. The opposed designation, EARNHARDT COLLECTION, is the same or a close approximation of the name and identity EARNHARDT.

17. The opposed designation, EARNHARDT COLLECTION, is the same or a close approximation of the name and identity DALE EARNHARDT.

18. The opposed designation, EARNHARDT COLLECTION, would be recognized in the United States as pointing uniquely and unmistakably to Dale Earnhardt or his commercial successor-in-interest. Thus, rather than perceiving the EARNHARDT COLLECTION designation having some other meaning, a substantial portion of the public would view that designation as being associated with Dale Earnhardt.

19. Applicant does not have Opposer's permission to use the designation EARNHARDT COLLECTION, and Applicant's potential use of the designation EARNHARDT COLLECTION in conjunction with custom homes will not enjoy any sponsorship, approval or other commercial connection with Dale Earnhardt or Opposer.

20. However, each of the designations EARNHARDT and DALE EARNHARDT enjoys such fame or reputation that a commercial connection with Dale Earnhardt would be presumed from Applicant's potential use of the designation EARNHARDT COLLECTION in conjunction with custom homes in this country.

21. Thus, just as the usage today of "EARNHARDT COLLECTABLES" connotes in this country merchandise which enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest, Applicant's potential use of EARNHARDT COLLECTION in conjunction with custom homes may falsely suggest to the public in this country that such homes enjoy a sponsorship, approval or other commercial connection with Dale Earnhardt or his successor-in-interest.

22. Pursuant to 15 U.S.C. § 1052(a), inasmuch as Applicant's EARNHARDT COLLECTION custom homes designation "may...falsely suggest a connection with" Dale Earnhardt, that designation may not be registered lawfully by Applicant.

23. Still further, each of the EARNHARDT and DALE EARNHARDT marks is not

only a distinctive mark, but also a famous mark, particularly when used on and in conjunction with collectables, and each of the EARNHARDT and DALE EARNHARDT marks acquired that status as a famous mark prior to the first usage in commerce of the Applicant's EARNHARDT COLLECTION designation (if any such usage has been made).

24. Hence, the application to register the EARNHARDT COLLECTION mark should also be refused pursuant to 15 U.S.C. §§ 1063(a) and 1125(c) on the basis that the usage of that designation in conjunction with custom homes is likely to cause dilution by blurring of each of the famous EARNHARDT and DALE EARNHARDT marks.

25. The first component of Applicant's EARNHARDT COLLECTION designation, "EARNHARDT," is visually and aurally identical to both Opposer's common law EARNHARDT mark and the second component of Opposer's federally registered DALE EARNHARDT mark. These characteristics create a likelihood of confusion with both the EARNHARDT and DALE EARNHARDT marks. Further, the second component of Applicant's designation, COLLECTION, is a descriptive term when used in the context of custom homes, has been disclaimed by Applicant because of that descriptiveness, and thus does not impart any distinctiveness to Applicant's designation. Moreover, the custom homes listed in Applicant's application are types of products or services which the public may reasonably expect or believe to enjoy a license of the EARNHARDT and DALE EARNHARDT marks. Thus Applicant's EARNHARDT COLLECTION designation, when used in connection with custom homes, is likely to deceive or cause confusion or mistake as to the source or sponsorship of Applicant's custom homes in relation to Opposer and the EARNHARDT and DALE EARNHARDT merchandise.

26. Thus, Applicant's application for registration of the EARNHARDT

COLLECTION mark should also be refused under 15 U.S.C. § 1052(d).

27. Additionally and/or in the alternative, the designation EARNHARDT COLLECTION is primarily merely a surname.

28. Thus, Applicant's application for registration of the EARNHARDT COLLECTION mark should also be refused under 15 U.S.C. § 1052(e)(4).

### SUMMARY

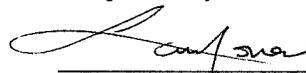
29. The application for registration of EARNHARDT COLLECTION should be refused under any or all of: 15 U.S.C. §1052(a) (false suggestion of a connection); 15 U.S.C. § 1063(a) and 15 U.S.C. § 1125(c) (dilution); 15 U.S.C. § 1052(d) (likelihood of confusion); and/or 15 U.S.C. § 1052(e)(4) (primarily merely a surname).

30. Accordingly, Opposer asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for the EARNHARDT COLLECTION custom homes designation to Applicant as sought in Trademark Application Serial No. 85/383,910.

WHEREFORE, Opposer prays that the application for registration of Applicant's EARNHARDT COLLECTION designation be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Please charge all fees incurred by Opposer in conjunction with this proceeding to the firm's Deposit Account No. 16-0605.

Respectfully submitted,



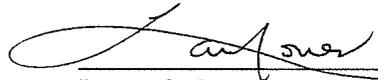
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Larry C. Jones  
Attorney for Opposer  
Alston & Bird LLP  
101 S. Tryon Street, Suite 4000  
Charlotte, North Carolina 28280-4000  
Telephone: (704) 444-1000  
[Larry.Jones@alston.com](mailto:Larry.Jones@alston.com)

CERTIFICATE OF SERVICE

I hereby certify that the foregoing "Opposer's Motion for Leave to Amend Notices of Opposition" was duly served on Applicant by depositing a copy of same in the United States mail, first-class postage prepaid, on the 11<sup>th</sup> day of March, 2013 addressed to Applicant's attorneys of record as follows:

D. Blaine Sanders  
Matthew F. Tilley  
Robinson Bradshaw & Hinson, P.A.  
101 N. Tryon Street, Suite 1900  
Charlotte, NC 28246-0106

  
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Larry C. Jones