ESTTA Tracking number: **ESTTA570593**
Filing date: **11/13/2013**

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

Proceeding	91205331
Party	Defendant Kerry Earnhardt, Inc.
Correspondence Address	D BLAINE SANDERS ROBINSON BRADSHAW HINSON PA 101 N TRYON ST, SUITE 1900 CHARLOTTE, NC 28246 0106 UNITED STATES BSanders@RBH.com, MTilley@RBH.com
Submission	Answer
Filer's Name	Jennifer Carusone
Filer's e-mail	jcarusone@rbh.com, mtilley@rbh.com
Signature	/Jennifer Carusone/
Date	11/13/2013
Attachments	91205331 Answer 11.13.2013.pdf(282773 bytes)

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

In the Matter of U.S. Application Serial No. 85/383,910
Mark: EARNHARDT COLLECTION
Filing Date: July 28, 2011

TERESA H. EARNHARDT, **Opposer,** **v.** **KERRY EARNHARDT, INC.,** **Applicant.**	**Opposition No.: 91205331**

ANSWER

Applicant, Kerry Earnhardt, Inc., ("Applicant"), by and through counsel, hereby submits its Answer to Opposer's Second Amended Notice of Opposition.

Applicant responds to the enumerated allegations in the Amended Notice of Opposition as follows:

1. Paragraph 1 is admitted upon information and belief.

2. Responding to Paragraph 2, Applicant admits only so much of the allegations as allege that NASCAR has increased in nationwide popularity, and Dale Earnhardt was one of the most well-known and accomplished drivers in the sport. Except as expressly admitted, the remaining allegations of Paragraph 2 are denied.

3. Paragraph 3 is admitted upon information and belief.

4. Paragraph 4 is denied.

5. Responding to Paragraph 5, Applicant avers that the referenced publication speaks for itself, and that Opposer's characterization of the content of that publication does not

constitute a factual allegation as to which a response is required, but to the extent any response is required, Applicant admits that sales of certain licensed merchandise by Opposer may have totaled in the millions of dollars around the time of Dale Earnhardt's death in 2001. Except as expressly admitted, the remaining allegations of Paragraph 5 are denied. Applicant specifically denies that there is any exclusive category of merchandise associated with Dale Earnhardt designated by eBay as "Earnhardt Collectables."

6. Responding to Paragraph 6, Applicant avers that the referenced publication speaks for itself, and that Opposer's characterization of the content of that publication does not constitute a factual allegation as to which a response is required, but to the extent any response is required, Applicant denies that current or recent sales of licensed merchandise by Opposer generate millions of dollars in revenues and royalties.

7. Paragraph 7 is denied.

8. Paragraph 8 is denied.

9. Responding to Paragraph 9, Applicant specifically denies that the designation EARNHARDT has ever been adopted or used by Opposer, Opposer's predecessor-in-interest or licensees thereof as a trademark or service mark in conjunction with any goods and services. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations of Paragraph 9 and therefore denies the same.

10. Responding to Paragraph 10, Applicant specifically denies that the designation EARNHARDT has ever been adopted or used by Opposer, Opposer's predecessor-in-interest or licensees thereof as a trademark or service mark in conjunction with any goods and services, and accordingly, the allegations that said designation has become famous or acquired distinctiveness are false. Applicant further denies that the designation DALE EARNHARDT is a famous trademark in connection with any licensed merchandise of Opposer. Applicant lacks sufficient

information to form a belief as to the truth of the remaining allegations of Paragraph 10 and therefore denies the same.

11. Responding to Paragraph 11, Applicant specifically denies that the designation EARNHARDT has ever been adopted or used by Opposer, Opposer's predecessor-in-interest or licensees thereof as a trademark or service mark in conjunction with any goods and services, and accordingly, the allegations that Opposer has acquired any common-law rights in said designation as a proprietary trademark are false. Applicant lacks sufficient information to form a belief as to the truth of the remaining allegations of Paragraph 11 and therefore denies the same.

12. Responding to Paragraph 12, Applicant admits only so much of the allegations as allege that the pleaded registration was issued by the U.S. Patent & Trademark Office under Registration No. 1,644,237 and that Opposer is identified as the current owner according to U.S.P.T.O. records. Except as expressly admitted, the remaining allegations of Paragraph 12 are denied and Applicant demands strict proof thereof.

13. Paragraph 13 is admitted.

14. Paragraph 14 is denied upon information and belief.

15. Paragraph 15 is denied upon information and belief.

16. Paragraph 16 is denied.

17. Paragraph 17 is denied.

18. Paragraph 18 is denied upon information and belief.

19. Paragraph 19 is admitted.

20. Paragraph 20 is denied.

21. Paragraph 21 is denied.

22. Paragraph 22 is denied.

23. Paragraph 23 is denied.

24. Paragraph 24 is denied.

25. Responding to Paragraph 25, Applicant admits only so much of the allegations as allege that Applicant has made no claim to exclusive right to use the term "Collection" apart from the mark as shown. Except as expressly admitted, the remaining allegations of Paragraph 25 are denied.

26. Paragraph 26 is denied.

27. Paragraph 27 is denied.

28. Paragraph 28 is denied.

29. Paragraph 29 is denied.

30. Paragraph 30 is denied.

SEPARATE AFFIRMATIVE DEFENSES

FIRST DEFENSE

The allegations in the Notice of Opposition fail to state a claim of any prior proprietary right in a trademark or service mark EARNHARDT in connection with any goods or services sufficient to establish standing.

SECOND DEFENSE

The allegations in the Notice of Opposition fail to state a claim of any prior proprietary right in a trademark or service mark EARNHARDT COLLECTABLES in connection with any goods or services sufficient to establish standing.

THIRD DEFENSE

The allegations in the Notice of Opposition fail to state a claim of any prior use of a trademark or service mark EARNHARDT in commerce, and accordingly, Opposer's dilution

claims and claims under Sections 2(a) and 2(d) of the Trademark Act must be dismissed on this ground.

FOURTH DEFENSE

The allegations in the Notice of Opposition fail to state a claim of any prior use of a trademark or service mark EARNHARDT COLLECTABLES in commerce, and accordingly, Opposer's claims under Sections 2(a) and 2(d) of the Trademark Act must be dismissed on this ground.

FIFTH DEFENSE

Opposer fails to state a claim upon which relief can be granted under Section 2(a) of the Trademark Act, insofar as:

(a) Four generations of the Earnhardt family have competed in auto racing for over half a century;

(b) The surname or designation "Earnhardt" is one of the most recognized names among fans of auto racing as a result of numerous championships and career victories achieved in the sport by Ralph Earnhardt, Dale Earnhardt, Kerry Earnhardt and Dale Earnhardt Jr.;

(c) Opposer is the widow of the late Dale Earnhardt;

(d) Kerry Dale Earnhardt is the grandson of Ralph Earnhardt, son of Dale Earnhardt and half brother of Dale Earnhardt Jr.; he has also enjoyed a successful racing career and has two sons who have also competed in auto racing; and

(e) Accordingly, no single member of the Earnhardt family, including Opposer, has any proprietary right to the name or identity "Earnhardt" alone since it is not and never has been exclusively connected with the name or identity of any one single member of the family and upon information and belief, would not be recognized by the public as such.

SIXTH DEFENSE

Without admitting that Opposer has any proprietary right in or to a trademark or service mark EARNHARDT and without admitting that Opposer has ever made any prior use in commerce of EARNHARDT, Opposer has, through many years of non-use of said designation EARNHARDT, abandoned any and all rights.

SEVENTH DEFENSE

Opposer's claims are barred by the doctrines of acquiescence, laches, estoppel and/or waiver insofar as:

(a) Various members of the Earnhardt family have sought and been granted registration of their trademarks and service marks by the U.S. Patent and Trademark Office that incorporate the surname or designation "Earnhardt," *inter alia*: U.S. Registration No. 3,850,682 for DALE EARNHARDT JR (stylized) in connection with entertainment services, namely participation in professional automobile races and related exhibitions in the name of DEJ Holdings, LLC and U.S. Registration No. 2,812,515 for KERRY EARNHARDT in connection with entertainment services in the nature of participating in professional automobile races and related exhibitions in the name of Applicant[1];

(b) Opposer and Opposer's predecessor-in-interest took no action over the course of the past nine years to oppose or petition to cancel the latter registrations;

(c) At no time over the course of the past eleven years since the death of Dale Earnhardt has Opposer or Opposer's predecessor-in-interest communicated to Applicant any objection to Applicant's adoption, use and/or registration of "Earnhardt" or any trademark, service mark or designation incorporating "Earnhardt"; and

(d) Opposer's undue or unreasonable delay has and will result in economic prejudice to Applicant.

EIGHTH DEFENSE

Opposer's acts, conduct and/or representations constitute unclean hands which bar recovery under any of her claims.

NINTH DEFENSE

If EARNHARDT COLLECTION is determined to be primarily merely a surname, and while specifically denying the same, Applicant states in the alternative that the mark EARNHARDT COLLECTION, through use and promotion in the marketplace, has become

---

[1] Applicant filed to register KERRY EARNHARDT as a trademark with the U.S.P.T.O. on or about January 7, 2003. Counsel for Opposer, Alston & Bird LLP prepared and submitted the application to the U.S.P.T.O. on Applicant's behalf and is still identified by the U.S.P.T.O. as attorneys of record for Applicant with respect to U.S. Registration No. 2,812,515.

distinctive of Applicant's goods in commerce and that the mark therefore should not be denied registration under 15 U.S.C. § 1052(e)(4).

This 13th day of November, 2013.

Respectfully submitted,

D. Blaine Sanders
Matthew F. Tilley
ROBINSON, BRADSHAW & HINSON, P.A.
101 North Tryon Street, Suite 1900
Charlotte, North Carolina 28246-1900
Telephone: (704) 377-2536
Facsimile: (704) 373-4000
E-mail: bsanders@rbh.com; mtilley@rbh.com
Attorneys for Kerry Earnhardt, Inc.

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Answer was served on Petitioner by mailing a copy by first class mail, postage prepaid to the following address of record with the Trademark Trial and Appeal Board:

Larry C. Jones
Carla H. Clements
Alston & Bird LLP
101 S. Tryon Street, Suite 4000
Charlotte, North Carolina 28280-4000
Telephone: (704) 444-1000
Larry.jones@alston.com
Carla.clemments@alston.com

Dated: November 13, 2013.

By: _____
Matthew F. Tilley

3212651v1