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

Proceeding	91205827
Party	Defendant Nucci, Charles
Correspondence Address	CHARLES NUCCI 1199 1/2 TENNESSEE ST SAN FRANCISCO, CA 94107 charlie@nuccistudio.com
Submission	Answer and Counterclaim
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Signature	/Matthew A. Stratton/
Date	08/07/2012
Attachments	Answer and CC.120807.STURGIS CHOPPERS.pdf (9 pages)(176137 bytes)

Registrations Subject to the filing

Registration No	3923284	Registration date	02/22/2011
Registrant	STURGIS MOTORCYCLE RALLY, INC. 1612 JUNCTION AVE, SUITE 4 STURGIS, SD 57785 UNITED STATES		

Goods/Services Subject to the filing

<p>Class 025. First Use: 1984/08/31 First Use In Commerce: 1984/08/31 All goods and services in the class are requested, namely: Clothing, namely, shirts, T-shirts, long sleeve T-shirts, sleeveless T-shirts, denim shirts, golf shirts, jackets, coats, tank tops, polo shirts, sweatshirts, pullovers, women's tops, chemises, cloth wraps, head wear, bandannas, caps, cloth headwraps, hats, scarves, belts, chaps, gloves, and sun visors, all of the aforementioned goods relating to the STURGIS motorcycle rally</p>
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Registration No	3818703	Registration date	07/13/2010
Registrant	STURGIS MOTORCYCLE RALLY, INC. 1612 Junction Avenue, STE 4 Sturgis, SD 57785 UNITED STATES		

Goods/Services Subject to the filing

<p>Class 025. First Use: 2000/09/00 First Use In Commerce: 2000/09/00 All goods and services in the class are requested, namely: Clothing, namely, shirts, sweatshirts, bandanas, embroidered clothing, namely, shirts, sweatshirts</p>

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

In the Matter of Application Serial No. 85274747 for the mark STURGIS CHOPPERS,
filed on March 23, 2011, and published in the Official Gazette on March 6, 2012.

<p>STURGIS MOTORCYCLE RALLY, INC., a South Dakota not-for-profit company,</p> <p style="text-align:center">Opposer,</p> <p style="text-align:center">v.</p> <p>CHARLES NUCCI, an individual,</p> <p style="text-align:center">Applicant.</p>	<p>Opposition No. 91205827</p> <p>ANSWER TO NOTICE OF OPPOSITION; COUNTERCLAIM FOR CANCELLATION</p>
<p>CHARLES NUCCI, an individual,</p> <p style="text-align:center">Petitioner,</p> <p style="text-align:center">v.</p> <p>STURGIS MOTORCYCLE RALLY, INC., a South Dakota not-for-profit company,</p> <p style="text-align:center">Registrant.</p>	

ANSWER

Charles Nucci (“Applicant”), by his counsel, hereby answers the Notice of Opposition of Sturgis Motorcycle Rally, Inc. (“Opposer”) as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 and therefore denies each and every allegation.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2 and therefore denies each and every allegation.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3 and therefore denies each and every allegation.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 and therefore denies each and every allegation.

5. Applicant denies each and every allegation of Paragraph 5.

6. Applicant admits that the U.S. Patent and Trademark Office's online records show Opposer as the owner of the trademark registrations cited in Paragraph 6. Applicant denies each and every remaining allegation.

7. Applicant denies each and every allegation of Paragraph 7.

8. Applicant admits the allegations of Paragraph 8.

9. Applicant admits that the word STURGIS is an element in his applied-for trademark and that the word CHOPPERS as used in the applied-for trademark refers to motorcycles. Applicant denies each and every remaining allegation in Paragraph 9.

10. Applicant denies each and every allegation of Paragraph 10.

11. Applicant denies each and every allegation of Paragraph 11.

12. Applicant denies each and every allegation of Paragraph 12.

13. Applicant denies each and every allegation of Paragraph 13.

14. Applicant denies each and every allegation of Paragraph 14.

15. Applicant denies each and every allegation of Paragraph 15.

16. Applicant denies each and every allegation of Paragraph 16.

AFFIRMATIVE DEFENSES

First Affirmative Defense (Failure to State a Claim)

17. The allegations of the Notice of Opposition fail to state a claim upon which relief may be granted.

Second Affirmative Defense (No Confusion)

18. This Opposition is barred by the absence of any likelihood of confusion.

Third Affirmative Defense
(Abandonment)

19. This Opposition is barred because Opposer has abandoned all rights to its trademarks under the doctrine of abandonment by naked licensing and/or assignment in gross.

Fourth Affirmative Defense
(Waiver)

20. This Opposition is barred by the doctrine of waiver.

Fifth Affirmative Defense
(Acquiescence)

21. This Opposition is barred by the doctrine of acquiescence

Sixth Affirmative Defense
(Laches)

22. This Opposition is barred by the doctrine of laches

Seventh Affirmative Defense
(Unclean Hands)

23. This Opposition is barred by the doctrine of unclean hands.

Eighth Affirmative Defense
(Estoppel)

24. This Opposition is barred by the doctrine of estoppel because Opposer has long been aware of Applicant and has taken no action to protect its rights.

Ninth Affirmative Defense
(No Superior Rights)

25. Opposer lacks standing to bring this Notice of Opposition because Opposer does not have rights, superior or otherwise, sufficient to support its underlying claims.

Tenth Affirmative Defense
(No Standing)

26. Opposer lacks standing to bring this Notice of Opposition because Opposer is not likely to be damaged by the registration of the mark at issue.

Eleventh Affirmative Defense
(Cited Marks Geographically Descriptive)

27. This Opposition is barred because Opposer's cited registrations are primarily geographically descriptive of the goods/services they represent and therefore are not entitled to protection as trademarks.

Twelfth Affirmative Defense
(Cited Marks Primarily Geographically Deceptively Misdescriptive)

28. This Opposition is barred because Opposer's cited registrations are primarily geographically deceptively misdescriptive of the goods/services they represent and therefore are not entitled to protection as trademarks.

COUNTERCLAIM
PETITION FOR CANCELLATION

Applicant and Petitioner Charles Nucci ("Petitioner") believes that he is being damaged by registration of the marks owned by Opposer and Registrant Sturgis Motorcycle Rally, Inc. ("Registrant") shown in Registration Nos. 3,923,284 and 3,818,703 and hereby petitions to cancel the same as to Class 25 for each such mark.

Registrant's Marks

1. Registrant is the owner of record of Registration No. 3,923,284 for the word mark STURGIS in Class 25 for "Clothing, namely, shirts, T-shirts, long sleeve T-shirts, sleeveless T-shirts, denim shirts, golf shirts, jackets, coats, tank tops, polo shirts, sweatshirts, pullovers, women's tops, chemises, cloth wraps, head wear, bandannas, caps, cloth headwraps, hats, scarves, belts, chaps, gloves, and sun visors, all of the aforementioned goods relating to the STURGIS motorcycle rally" (the "STURGIS Mark"), as well as for goods and services in other classes. The STURGIS Mark was registered on February 22, 2011.

2. Registrant is the owner of record of Registration No. 3,818,703 for the word mark STURGIS BIKE WEEK in Class 25 for "Clothing, namely, shirts, sweatshirts, bandanas,

embroidered clothing, namely, shirts, sweatshirts” (the “STURGIS BIKE WEEK Mark”). The STURGIS BIKE WEEK Mark was registered on July 13, 2010.

The Geographic Location of Sturgis, South Dakota

3. Sturgis is a town located in Meade County, North Dakota.
4. On information and belief, for substantially every year since 1938, the “Sturgis Motorcycle Rally” has been held in Sturgis, North Dakota. In recent years, over 500,000 participants have annually attended the Sturgis Motorcycle Rally, strengthening the public’s association of the word “Sturgis” with the town of Sturgis, North Dakota.
5. The primary significance of the term “Sturgis” is the generally known geographic location of Sturgis, North Dakota.

FIRST GROUND FOR CANCELLATION

The STURGIS Mark Is Primarily Geographically Descriptive

6. Petitioner realleges and incorporates by reference the matters alleged in Paragraphs 1-5 of this Petition for Cancellation.
7. The STURGIS Mark consists entirely of the word “Sturgis.”
8. The primary significance of the term “Sturgis” in the minds of the consuming public is a generally known geographic location, namely, Sturgis, North Dakota.
9. On information and belief, the goods identified in Registrant’s Class 25 registration for the STURGIS Mark originate from, are related to, or are associated with the geographic location of Sturgis, North Dakota.
10. Consumers are likely to make, and in fact do make, a goods-place association between the goods identified in Registrant’s Class 25 registration for the STURGIS Mark and Sturgis, North Dakota, namely, that Registrant’s branded clothing items originate in Sturgis, North Dakota.
11. Registrant is not entitled to trademark rights in, or registration of, the STURGIS Mark because the term “Sturgis” is primarily geographically descriptive of Registrant’s goods

and therefore the STURGIS Mark in Class 25 should be cancelled pursuant to Section 2(e) of the Lanham Act.

12. Petitioner, as a member of the general public and user of the STURGIS designation, is being harmed by the continued registration of the STURGIS Mark.

SECOND GROUND FOR CANCELLATION

The STURGIS BIKE WEEK Mark Is Primarily Geographically Descriptive

13. Petitioner realleges and incorporates by reference the matters alleged in Paragraphs 1-12 of this Petition for Cancellation.

14. The STURGIS BIKE WEEK Mark consists primarily of the word “Sturgis,” which is the dominant element of the STURGIS BIKE WEEK Mark.

15. The primary significance of the term “Sturgis” in the minds of the consuming public is a generally known geographic location, namely, Sturgis, North Dakota.

16. On information and belief, the goods identified in Registrant’s registration for the STURGIS BIKE WEEK Mark originate from, are related to, or are associated with the geographic location of Sturgis, North Dakota.

17. Consumers are likely to make, and in fact do make, a goods-place association between the goods identified in Registrant’s registration for the STURGIS BIKE WEEK Mark and Sturgis, North Dakota, namely that Registrant’s branded clothing items originate in Sturgis, North Dakota.

18. Registrant is not entitled to trademark rights in, or registration of, the STURGIS BIKE WEEK Mark because the term “Sturgis” is primarily geographically descriptive of Registrant’s goods and therefore the STURGIS BIKE WEEK Mark should be cancelled in its entirety pursuant to Section 2(e) of the Lanham Act.

19. Petitioner, as a member of the general public and user of the STURGIS designation, is being harmed by the continued registration of the STURGIS BIKE WEEK Mark.

PRAYER FOR RELIEF

WHEREFORE, Petitioner prays that (i) the Notice of Opposition be dismissed in its entirety and that a registration issue for Application Serial No. 85274747, and (ii) this Petition for Cancellation be granted and that Registration No. 3,923,284 be cancelled as to Class 25 and that Registration No. 3,818,703 be cancelled in its entirety.

Petitioner hereby appoints Harvey Siskind LLP, a law firm composed of members of the bar of the State of California, to act as attorneys for Petitioner herein, with full power to prosecute this opposition and cancellation proceeding, to transact all relevant business with the Patent and Trademark Office and in the United States Courts, and to receive all official communications in connection with this opposition and cancellation proceeding.

Dated: August 7, 2012

Respectfully submitted,
HARVEY SISKIND LLP
IAN K. BOYD
MATTHEW A. STRATTON

By /Matthew A. Stratton/
Matthew A. Stratton

Attorneys for Applicant,
Charles Nucci

CERTIFICATE OF TRANSMISSION

I hereby certify that this **ANSWER TO NOTICE OF OPPOSITION; COUNTERCLAIM FOR CANCELLATION**, (Opposition No. 91205827), dated August 7, 2012, is being electronically transmitted to the Trademark Trial and Appeal Board on August 7, 2012.

/Matthew A. Stratton/

Matthew A. Stratton

CERTIFICATE OF MAILING

I hereby certify that a true and correct copy of the attached **ANSWER TO NOTICE OF OPPOSITION; COUNTERCLAIM FOR CANCELLATION**, dated August 7, 2012 (Opposition No. 91205827), was served on Opposer by sending a copy thereof via U.S. Mail, postage prepaid, on August 7, 2012 addressed to:

Jason M. Sneed
Sneed PLLC
610 Jetton Street, Suite 120-107
Davidson, NC 28036

/Cynthia Lee/
Cynthia Lee