

ESTTA Tracking number: **ESTTA525310**

Filing date: **03/07/2013**

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    | Zakk Wylde   |             |               |
| Entity  | Individual   | Citizenship | UNITED STATES |
| Address | PO Box 1787<br>Canyon Country, CA 91386<br>UNITED STATES |             |               |

|                      |   |  |  |
|----------------------|---|--|--|
| Attorney information | Victor K. Sapphire, Esq.<br>Novak Druce Connolly Bove + Quigg LLP<br>333 S Grand Avenue Twenty-third Floor<br>Los Angeles, CA 90071<br>UNITED STATES<br>trademarks@cblh.com, vsapphire@cblh.com, epritsker@cblh.com<br>Phone:2137872523 |  |  |
|----------------------|---|--|--|

### Applicant Information

|                        |  |                        |            |
|------------------------|--|------------------------|------------|
| Application No         | 85541606   | Publication date       | 02/05/2013 |
| Opposition Filing Date | 03/07/2013   | Opposition Period Ends | 03/07/2013 |
| Applicants             | James A. Baltutis<br>PO Box 464<br>Burbank, CA 91503<br>UNITED STATES<br><br>Mark Ferguson<br>PO Box 464<br>Burbank, CA 91503<br>UNITED STATES |                        |            |

### Goods/Services Affected by Opposition

|  |
|--|
| Class 025. First Use: 2010/01/05 First Use In Commerce: 2010/10/14<br>All goods and services in the class are opposed, namely: clothing, namely: t-shirts, shirts, tank tops, thermal shirts, long sleeve shirts, short sleeve shirts, woven shirts, polo shirts, jackets, leather jackets, pants, denim jeans, denim jackets, denim shorts, jeans, shorts, board shorts, sweatshirts, hooded shirts, hooded sweatshirts, hats, caps, footwear |
|--|

### Grounds for Opposition

|   |   |
|---|---|
| Deceptiveness                                   | Trademark Act section 2(a)                  |
| False suggestion of a connection                | Trademark Act section 2(a)                  |
| Priority and likelihood of confusion            | Trademark Act section 2(d)                  |
| Dilution  | Trademark Act section 43(c)                 |
| <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. Registration No. | 3518532  | Application Date      | 07/18/2005 |
| Registration Date     | 10/14/2008   | Foreign Priority Date | NONE       |
| Word Mark             | BLACK LABEL SOCIETY  |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | <p>Class 009. First use: First Use: 1999/05/05 First Use In Commerce: 1999/05/05<br/>           Motion picture films about musical performances; audio and visual recordings, namely, cassette tapes, compact discs, phonograph records, pre-recorded audio and video tapes, discs and cassettes featuring music, musical performances, and entertainment in the nature of interviews and dramatic performances</p> <p>Class 016. First use: First Use: 2005/07/18 First Use In Commerce: 2005/07/18<br/>           Posters; music books; stickers</p> <p>Class 025. First use: First Use: 2005/07/18 First Use In Commerce: 2005/07/18<br/>           Clothing, namely, shirts, panties, lingerie, underpants, undershirts, t-shirts, bras, brassieres, camisoles, halter tops, gloves, bandannas, aprons, cloth jackets, jerseys; headwear, namely, hats, and caps, all of the foregoing associated with the well-known entertainer Zakk Wylde</p> |                       |            |
| U.S. Registration No. | 3677873  | Application Date      | 07/18/2005 |
| Registration Date     | 09/01/2009   | Foreign Priority Date | NONE       |
| Word Mark             | BLACK LABEL SOCIETY  |                       |            |
| Design Mark           |    |                       |            |
| Description of Mark   | NONE   |                       |            |

|                |   |  |  |
|----------------|---|--|--|
| Goods/Services | Class 009. First use: First Use: 2001/12/31 First Use In Commerce: 2001/12/31<br>Amplifiers |  |  |
|----------------|---|--|--|

|                       |         |                  |            |
|-----------------------|---------|------------------|------------|
| U.S. Registration No. | 2367010 | Application Date | 08/07/1998 |
|-----------------------|---------|------------------|------------|

|                   |            |                       |      |
|-------------------|------------|-----------------------|------|
| Registration Date | 07/11/2000 | Foreign Priority Date | NONE |
|-------------------|------------|-----------------------|------|

|           |                     |  |  |
|-----------|---------------------|--|--|
| Word Mark | BLACK LABEL SOCIETY |  |  |
|-----------|---------------------|--|--|

|             |                            |  |  |
|-------------|----------------------------|--|--|
| Design Mark | <b>BLACK LABEL SOCIETY</b> |  |  |
|-------------|----------------------------|--|--|

|                     |      |  |  |
|---------------------|------|--|--|
| Description of Mark | NONE |  |  |
|---------------------|------|--|--|

|                |  |  |  |
|----------------|--|--|--|
| Goods/Services | Class 041. First use: First Use: 1998/10/28 First Use In Commerce: 1998/10/28<br>Entertainment services in the nature of live musical performances |  |  |
|----------------|--|--|--|

|             |  |  |  |
|-------------|--|--|--|
| Attachments | 78980543#TMSN.jpeg ( 1 page )( bytes )<br>78672797#TMSN.jpeg ( 1 page )( bytes )<br>75532512#TMSN.gif ( 1 page )( bytes )<br>Document(21).pdf ( 13 pages )(2687335 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 | /victorsapphire/         |
| Name      | Victor K. Sapphire, Esq. |
| Date      | 03/07/2013               |

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

Zakk Wylde,

Opposer,

v.

Mark Ferguson DBA All Access Entertainment LLC

and

James A. Baltutis DBA Concepts In Concert,

Applicants

Opposition No. \_\_\_\_\_

Application Serial No. 85/541,606

Mark: THE BLACK LABEL ORDER  
TBLO (and Design)

Published for Opposition:

February 5, 2013

**NOTICE OF OPPOSITION**

Commissioner for Trademarks  
PO Box 1451  
Alexandria, VA 22313-1451

Opposer Zakk Wylde, a United States individual, having a business address PO Box 1787, Canyon Country, California 91386, believes that he will be damaged by the registration on the Principal Register of THE BLACK LABEL ORDER TBLO and Design in connection with "clothing, namely, t-shirts, shirts, tank tops, thermal shirts, long sleeve shirts, short sleeve shirts, woven shirts, polo shirts, jackets, leather jackets, pants, denim jeans, denim jackets, denim shorts, jeans, shorts, board shorts, sweatshirts, hooded shirts, hooded sweatshirts,

hats, caps, footwear" in International Class 25. The mark is the subject of federal trademark application Serial No. 85/541,606, allegedly owned by Mark Ferguson DBA All Access Entertainment LLC and James A. Baltutis DBA Concepts in Concert ("Applicants"), and Opposer hereby opposes registration thereof.

As grounds for this Opposition, it is alleged that:

1. Opposer Zakk Wylde is a musician, songwriter and multi-instrumentalist who gained renown as the former guitarist in Ozzy Osbourne's rock band. He went on to found and lead the heavy metal rock band Black Label Society. He has released albums with other bands and solo projects as well.
2. With his band Black Label Society, Mr. Wylde has released several albums, including "Sonic Brew" (1999), "Stronger Than Death" (2000), "Alcohol Fueled Brewtality Live!! +5" (2001), "1919 Eternal" (2002), "The Blessed Hellride" (2003), "Hangover Music Vol. VI" (2004), "Mafia" (2005), "Shot to Hell" (2006), "Skullage" (2009), "Order of the Black" (2010), and "The Song Remains Not the Same" (2011).
3. Opposer's BLACK LABEL SOCIETY band has sold over one and a half million full-length albums, and has toured throughout the United States and the world, playing before millions of people.
4. Black Label Society has appeared on national television in live performances, as well as via its music videos, which have been widely broadcast.
5. Opposer has also written and had published in 2012 an autobiography, "Bringing Metal to the Children", which was well-received in the hard-rock/heavy metal music community and brought him and Black Label Society further acclaim.
6. Opposer formed Black Label Society in 1998 and adopted the BLACK LABEL SOCIETY mark at that time.
7. Since its adoption, BLACK LABEL SOCIETY has been exclusively used by Opposer in connection with music and entertainment services, as well as with ancillary merchandise and fan club services associated therewith. Opposer, through

his licensees, has derived substantial revenue from the design, marketing and sale of apparel merchandise bearing and/or associated with the BLACK LABEL SOCIETY mark and the music group Black Label Society.

8. Opposer is the owner of valuable rights in the marks BLACK LABEL SOCIETY and BLACK LABEL COMEDY HOUR in connection with goods similar or identical to many if not all of those identified in the '606 Application, as well as of the business and goodwill connected therewith.
9. Opposer is the owner of US Reg. No. 3,518,532 for BLACK LABEL SOCIETY in connection with, among other things, "clothing, namely, shirts, panties, lingerie, underpants, undershirts, t-shirts, bras, brassieres, camisoles, halter tops, gloves, bandannas, aprons, cloth jackets, jerseys; headwear, namely, hats, and caps, all of the foregoing associated with the well-known entertainer Zakk Wylde".
10. Opposer owns other federal registrations for BLACK LABEL SOCIETY in connection with entertainment services and other goods and services.
11. Opposer is the owner of US Appl. Ser. No. 85/600,717 for BLACK LABEL COMEDY HOUR in connection with "clothing and accessories, namely, shirts, hats, caps, visors, scarves, bandannas, belts, wristbands and headbands".
12. In conjunction with the 2010 album entitled "Order of the Black", Opposer initiated an official fan club and adopted the name THE BLACK LABEL ORDER for use with the fan club. Among other things, the fan club was to exist online as a community forum for Opposer's fans to interact with one another and Opposer's organization, and it was to provide news updates and exclusive premiums to members via the web site, including special ticket packages, enhanced access packages for "meet and greets", and the like.
13. On information and belief, Applicants are the purported joint owners of US Appl. Ser. No. 85/541,606 for THE BLACK LABEL ORDER TBLO and Design for use in connection with "clothing, namely, t-shirts, shirts, tank tops, thermal shirts, long sleeve shirts, short sleeve shirts, woven shirts, polo shirts, jackets, leather jackets, pants, denim jeans, denim jackets, denim shorts, jeans, shorts, board shorts,

- sweatshirts, hooded shirts, hooded sweatshirts, hats, caps, footwear" (the "'606 Appl.>").
14. Applicants filed the '606 Appl. on February 13, 2012.
  15. Applicants were employed by Opposer during the period around 2010 through early 2012 to administer Opposer's online presence via his web sites. They were also responsible for management and administration of Opposer's fan club, including the arrangement, provision and marketing of premium "meet and greet" ticket packages via the site.
  16. Applicants administered Opposer's THE BLACK LABEL ORDER fan club and developed web site content at Opposer's instruction and direction following his adoption of the "Order of the Black" album title and the "THE BLACK LABEL ORDER" fan club name.
  17. Opposer entrusted the administrative and operational details of the fan club and web sites to Applicants, particularly Applicant Baltutis, who represented himself as an Internet web site developer with information technology experience.
  18. Unbeknownst to Opposer, Applicant Baltutis had without authorization fraudulently registered in his own name the "theblacklabelorder.com" domain name where the fan club site was hosted, rather than registering it in the name of his employer, Opposer, in violation of Opposer's trust.
  19. A variety of issues culminated in the termination of Applicants in early 2012, when they were informed that their services would no longer be required by Opposer. Around this time, Baltutis' misappropriation of the fan club site's domain name came to the attention of Opposer. Shocked, Opposer investigated further and learned of the existence of the unauthorized and improper '606 Appl. and its unauthorized sister application.
  20. The Applicants have not merely misappropriated the words THE BLACK LABEL ORDER in the '606 Appl. from Opposer: the design elements are also a prominent feature of Opposer's BLACK LABEL SOCIETY live performances and merchandising. Applicant has been using the identical skull design, referred to in the

description of the '606 Design's subject mark as "a stylized medical skull design with numbers and dotted lines appearing on across the frontal, forehead and temporal bones of the skull design", for many years prior to Applicant's alleged date of first use.

21. Opposer selected the skull design from among a variety of skull images several years ago and has used it extensively and continuously in connection with BLACK LABEL SOCIETY, including on merchandise, on his live performance outfits, on endorsement and specialty merchandise, and as an enormous backdrop hung behind the stage at live performances. Some representative examples of Opposer's use of the skull design, including a photo taken before Applicants went rogue of Opposer holding a garment bearing a "The Black Label Order" design mark, are attached to this Notice as Exhibit "A".
22. As a result of Opposer's extensive, continuous and longstanding substantially exclusive use of the skull design, it has come to be associated strongly with Opposer and Opposer's group BLACK LABEL SOCIETY in connection with entertainment-related goods and services, including without limitation apparel goods such as those identified in the '606 Appl.
23. As a result of Opposer's extensive, continuous and longstanding substantially exclusive use of the BLACK LABEL SOCIETY mark in connection with music recordings, performances, entertainment services and ancillary merchandise including apparel goods, the BLACK LABEL SOCIETY mark has come to be associated strongly with Opposer and his band throughout the United States and the world.
24. Likewise, Opposer has used Gothic typeface identical to that appearing in the '606 Appl. in connection with his BLACK LABEL SOCIETY mark since long before Applicants' alleged first-use date of the '606 Appl.'s subject mark.
25. Applicants have misappropriated Opposer's mark and in the '606 Appl. have filed a fraudulent application to register same.

26. Applicants did not create the subject mark of the '606 Appl., nor are they the owners of the mark.
27. Applicants filed the '606 Appl. in bad faith with the intent to damage Opposer.
28. On May 14, 2012, in response to Opposer's Letter of Protest which was lodged before publication, the Office of the Deputy Commissioner for Trademark Examination Policy issued a Memorandum to the Examining Attorney in the '606 Appl, stating that the Letter of Protest "has been accepted because the evidence submitted by the protester [Opposer] is relevant and may support a reasonable ground for refusal appropriate in *ex parte* examination."
29. The same Letter of Protest, which was concurrently submitted in Applicants' fraudulent sister application for the word mark THE BLACK LABEL ORDER in connection with fan club services, was accepted and made the basis for refusal of registration of that mark.
30. Applicants' mark is likely, when used in connection with the subject goods in the application, to cause confusion, mistake, or deception. Because the mark was created by and has always been associated with Opposer, consumers may believe that Applicant's use of the mark in connection with the goods set forth in the '606 Appl. is in some way associated with or connected with or sponsored, authorized or warranted by Opposer. Any objection to or fault with Applicants' goods offered in connection with the mark would reflect upon and injure Opposer's reputation in connection with goods and services offered by Opposer under the identical mark.
31. Indeed, throughout its existence, Applicants have maintained the website at "theblacklabelorder.com" with a consistent appearance and focus on Opposer that misleads visitors to believe that the site is official or otherwise authorized by Opposer, which is not the case, and have used the web site to sell memberships, merchandise and apparel, and advertising space for their own enrichment and to Opposer's detriment.

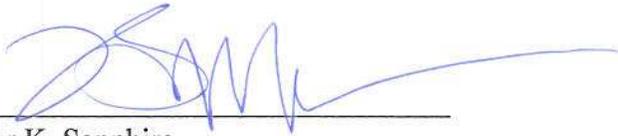
32. If Applicants are granted the registration herein opposed, Applicants would thereby obtain at least a *prima facie* exclusive right to use of the THE BLACK LABEL ORDER and Design mark in connection with the goods identified in the '606 Appl. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, in accordance with Section 13 of the Trademark Act (15 U.S.C. Section 1063), Opposer prays that this Opposition be sustained and that Application Serial No. 85/541,606 be refused.

The required fee three-hundred dollars (\$300) is submitted herewith.

Respectfully submitted,

Dated: March 6, 2013

By: 

Victor K. Sapphire

Attorneys for Opposer

NOVAK DRUCE CONNOLLY BOVE + QUIGG LLP

333 South Grand Avenue, Twenty-third Floor

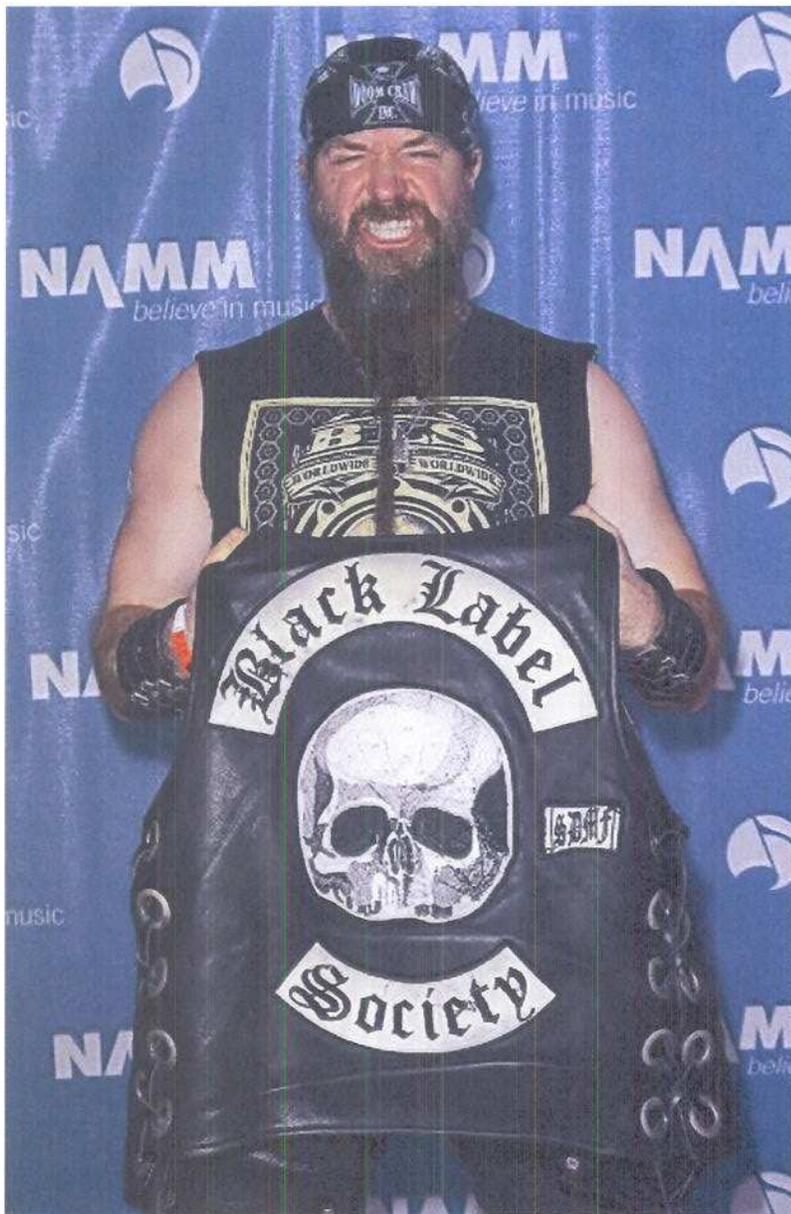
Los Angeles, California 90071

vsapphire@novakdruce.com

(213) 787-2523

# EXHIBIT "A"

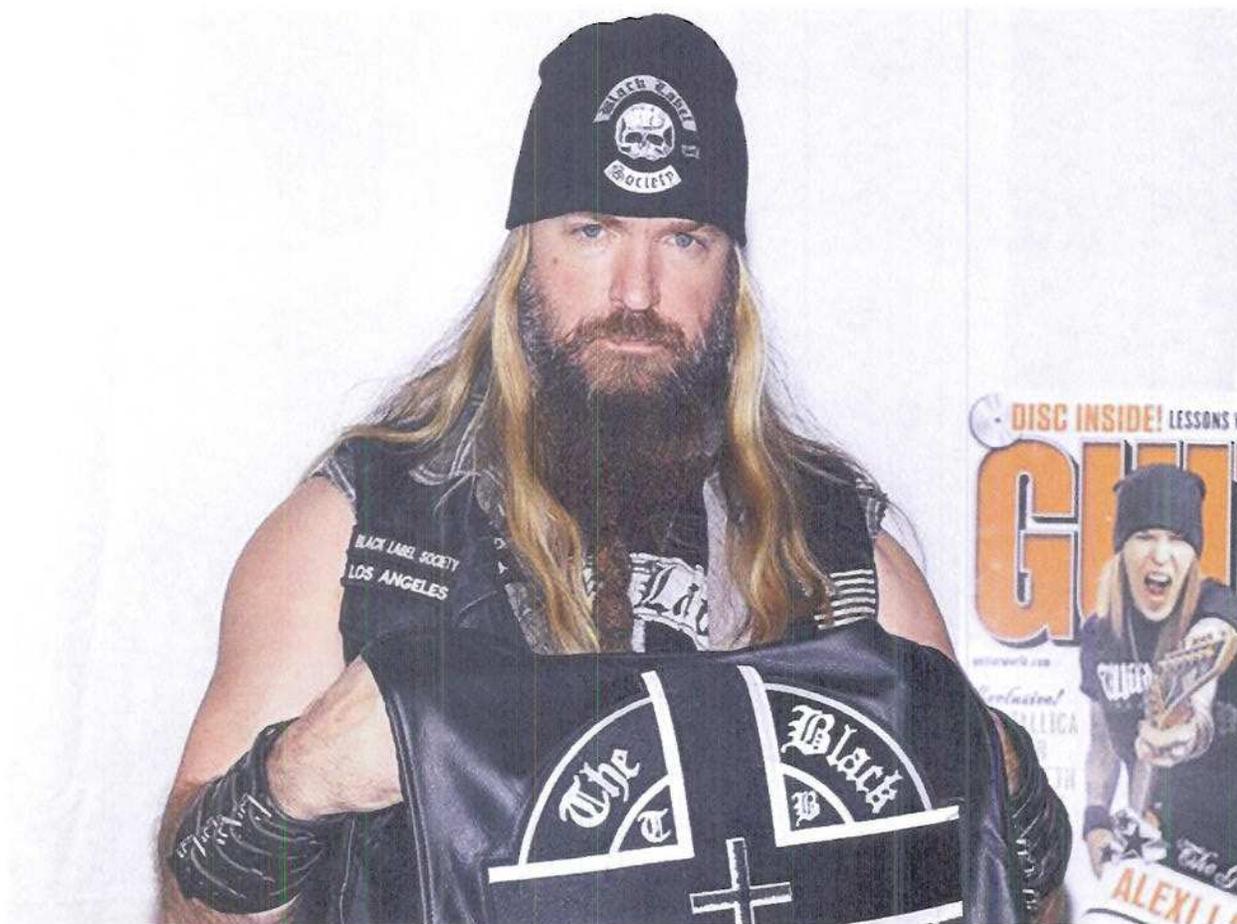






Photography By: Lisa Turner at Cool Springs Harley Davidson, Franklin TN

Artwork By: Ken Scott at <http://www.357customs.com>



## CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of March 2013 a true and correct copy of the NOTICE OF OPPOSITION was served on Applicants Jim Baltutis and Mark Ferguson at PO Box 464, Burbank CA 91503, via first class mail.

/s/ 

Victor K. Sapphire