

ESTTA Tracking number: **ESTTA552718**

Filing date: **08/07/2013**

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 parties oppose registration of the indicated application.

Opposers Information

Name	American Express Marketing & Development Corp.
Granted to Date of previous extension	08/07/2013
Address	200 Vesey Street New York, NY 10285 UNITED STATES

Name	American Express Travel Related Services Company
Granted to Date of previous extension	08/07/2013
Address	200 Vesey Street New York, NY 10285 UNITED STATES

Attorney information	Marcia B. Paul, Camille Calman Davis Wright Tremaine LLP 1633 Broadway, 27th Floor New York, NY 10019 UNITED STATES marciapaul@dwt.com, camillecalman@dwt.com, nytmpto@dwt.com Phone: 212-489-8230
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Applicant Information

Application No	85801419	Publication date	04/09/2013
Opposition Filing Date	08/07/2013	Opposition Period Ends	08/07/2013
Applicant	BLACKCARDSTATUS LLC 311 WEST THIRD STREET, STE 3955 CARSON CITY, NV 89703 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2012/11/26 First Use In Commerce: 2012/11/26 All goods and services in the class are opposed, namely: Entertainment in the nature of providing an informational and entertainment website in the fields of celebrity gossip, entertainment, sports and fitness

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
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False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	No bona fide use in commerce, Trademark Act Section 1(a); an entire mark cannot be disclaimed and also registered (IN RE SADORU GROUP, LTD., Serial No. 77941164 (TTAB 4-25-2012)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3613898	Application Date	09/20/2005
Registration Date	04/28/2009	Foreign Priority Date	NONE
Word Mark	BLACKCARD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2009/02/05 First Use In Commerce: 2009/02/05 Credit and debit card services		

U.S. Application No.	77654245	Application Date	01/22/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BLACK CARD CONCIERGE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 Promoting the sale of goods and services of others by awarding incentives to consumers for credit card use; providing information about and making referrals in the field of consumer products and services for retail services concerning products, services, events, activities, attractions and facilities in particular geographic locations; providing concierge services for travelers, namely, making business meeting arrangements</p> <p>Class 036. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 Financial services, namely, charge, credit card and debit card services; bill payment processing services; computerized credit verification and financial risk management services; providing information in the fields of foreign currency; providing cash and other rebates for credit card use as part of a customer loyalty program</p> <p>Class 039. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 Providing travel information; providing flight arrival and departure information; arranging for travel visas, passports and travel documents for persons traveling abroad; making car rental and limousine reservations for others; arranging travel tours for others; providing concierge services for travelers, namely, making travel arrangements</p> <p>Class 041. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 Language translation services; arranging for ticket reservations for entertainment, sporting and cultural events</p>		

	<p>Class 042. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 Rental of computers</p> <p>Class 043. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 Providing advice to travelers on hotels, restaurants and events; making reservations for travel, namely, booking accommodations for travelers; providing concierge services for travelers, namely, making restaurant reservations; making reservations and bookings for others for accommodations and meals at health spas</p> <p>Class 044. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 Making reservations and bookings for others at beauty salons and spas and for physical and beauty treatments at health spas</p> <p>Class 045. First use: First Use: 2009/01/15 First Use In Commerce: 2009/01/15 Concierge services for others, namely, making requested personal and social arrangements and reservations and providing customer-specific information to meet the individual needs of customer card holders and travelers; personal concierge services for others comprised of making requested personal and social arrangements and reservations, personal shopping services; personal gift selection and gift reminder services for others; and providing customer specific information to meet individual needs, all rendered in business establishments, office buildings, airports, hotels, residential complexes and homes; fraud detection services in the field of credit card usage; providing information to travelers regarding foreign protocol</p>
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U.S. Application No.	77627276	Application Date	12/05/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BLACK CARD		
Design Mark			
Description of Mark	The mark consists of the stylized wording BLACK CARD.		
Goods/Services	<p>Class 035. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 Promoting the sale of goods and services of others by awarding incentives to consumers for credit card use; providing concierge services for travelers, namely, making business meeting arrangements</p> <p>Class 036. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 Financial services, namely, charge, credit card and debit card services; bill payment processing services; computerized credit verification and financial risk management services</p> <p>Class 039. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 Providing concierge services for travelers, namely, making travel arrangements</p> <p>Class 041. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 Ticket reservation and booking services for entertainment, sporting and cultural events</p> <p>Class 043. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 Providing advice to travelers on hotels and restaurants; making reservations for travel, namely, booking accommodations for travelers; providing concierge services for travelers, namely, making restaurant reservations</p> <p>Class 045. First use: First Use: 2008/12/01 First Use In Commerce: 2008/12/01 concierge services for others comprised of making requested personal arrangements, making reservations and providing customer-specific information to meet individual needs for a wide variety of types of users, such as individual, household, business, and traveler all rendered in business establishments,</p>		

	office buildings, airports, hotels, residential complexes and private homes, and via the telephone, electronic mail and the Internet; providing concierge services for travelers, namely, personal gift selection for others by making floral and gift purchases, gift reminder services and gift locator services, personal shopping services for others; concierge services for others comprised of making requested personal arrangements and reservations and providing customer-specific information to meet individual needs of card holders and travelers all rendered in business establishments, office buildings, airports, hotels, residential complexes and private homes, and via the telephone, electronic mail and the Internet; providing non-medical personal assistance services for others to meet the needs of individuals in the nature of planning, organizing, coordinating, arranging and assisting individuals to perform daily tasks; fraud detection services in the field of credit cards
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U.S. Application No.	77661119	Application Date	02/02/2009
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	BLACK		
Design Mark			
Description of Mark	The mark consists of the stylized word BLACK.		
Goods/Services	<p>Class 035. First use: First Use: 2009/01/22 First Use In Commerce: 2009/01/22 Promoting the sale of goods and services of others by awarding incentives to consumers for credit card use; providing information about and making referrals in the field of consumer products and services for retail services concerning products, services, events, activities, attractions and facilities in particular geographic locations; providing concierge services for travelers, namely, making business meeting arrangements</p> <p>Class 036. First use: First Use: 2009/01/22 First Use In Commerce: 2009/01/22 Financial services, namely, charge card, credit card and debit card services; bill payment processing services; computerized credit verification and financial risk management services; providing information in the fields of foreign currency; providing cash and other rebates for credit card use as part of a customer loyalty program</p> <p>Class 039. First use: First Use: 2009/01/22 First Use In Commerce: 2009/01/22 Providing travel information; providing flight arrival and departure information; arranging for travel visas, passports and travel documents for persons traveling abroad; making car rental and limousine reservations for others; arranging travel tours for others; providing concierge services for travelers, namely, making travel arrangements</p> <p>Class 041. First use: First Use: 2009/01/22 First Use In Commerce: 2009/01/22 Language translation services; arranging for ticket reservations for entertainment, sporting and cultural events</p> <p>Class 042. First use: First Use: 2009/01/22 First Use In Commerce: 2009/01/22 Rental of computers</p> <p>Class 043. First use: First Use: 2009/01/22 First Use In Commerce: 2009/01/22 Providing advice to travelers on hotels and restaurants; making reservations for travel, namely, booking accommodations for travelers; providing concierge services for travelers, namely, making restaurant reservations; making reservations and bookings for others for accommodations and meals at health spas</p> <p>Class 044. First use: First Use: 2009/01/22 First Use In Commerce: 2009/01/22 Making reservations and bookings for others at beauty salons and spas and for</p>		

	<p>physical and beauty treatments at health spas</p> <p>Class 045. First use: First Use: 2009/01/22 First Use In Commerce: 2009/01/22</p> <p>Concierge services for others, namely, making requested personal and social arrangements and reservations and providing customer-specific information to meet the individual needs of customer card holders and travelers; personal concierge services for others comprised of making requested personal and social arrangements and reservations, personal shopping services; personal gift selection and gift reminder services for others; and providing customer specific information to meet individual needs, all rendered in business establishments, office buildings, airports, hotels, residential complexes and homes; fraud detection services in the field of credit card usage; providing information to travelers regarding foreign protocol</p>
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Attachments	<p>TTAB Opposition - BLACKCARDSTATUS.pdf(40336 bytes)</p> <p>TTAB Opposition Exhibit A.pdf(207511 bytes)</p> <p>TTAB Opposition Exhibit B.pdf(19432 bytes)</p> <p>TTAB Opposition Exhibit C.pdf(88610 bytes)</p>
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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	/Camille Calman/
Name	Marcia B. Paul, Camille Calman
Date	08/07/2013

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

In the matter of Application Serial No. **85/801,419**
Mark: **BLACKCARDSTATUS**
Published in the *Official Gazette* on April 9, 2013

AMERICAN EXPRESS MARKETING &
DEVELOPMENT CORP. and AMERICAN EXPRESS
TRAVEL RELATED SERVICES COMPANY, INC.,

Opposers,

v.

BLACKCARDSTATUS LLC.

Applicant.

Opposition No.:

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

AMERICAN EXPRESS MARKETING & DEVELOPMENT CORP. (“AMEX M&D”), a corporation organized and existing under the laws of Delaware with its principal place of business at 200 Vesey Street, New York, NY 10285, and AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC. (“AMEX”) a corporation organized and existing under the laws of the State of New York with its principal place of business at 200 Vesey Street, New York, NY 10285 (collectively, “American Express” or “Opposers”), hereby oppose the application of BLACKCARDSTATUS LLC (“Applicant”), a limited liability company formed under the laws of the State of Nevada, with its principal place of business at 311 West Third

Street, Suite 3955, Carson City, Nevada 89703, for registration of the trademark BLACKCARDSTATUS, Serial No. 85/801,419, in International Class 41, published in the *Official Gazette* on April 9, 2013 (the “Application”). On May 1, 2013, American Express was granted an extension of time up to and until August 7, 2013 to oppose said Application.

American Express believes that it will be damaged by registration of the mark depicted in application Serial Number 85/801,419, and opposes such registration on the following grounds:

1. American Express, among its varied business operations, issues charge and credit cards to individual and business consumers. It has famously branded its various classes of cards by using colors to differentiate among them including green, gold, and platinum. These colors also denote the level of benefits available to users, the annual fees charged, and – in the eyes of some – the status of the cardholder.

2. The most prestigious and difficult-to-obtain American Express card is the American Express “Centurion Card”, commonly known as “the Black Card”. It is a black charge card made of titanium, with a gold border and a patterned black background, centered by the imprinted image of the head of a Roman centurion. Corresponding to the unique appearance of this card, are exceptional benefits cardholders with this highest American Express status enjoy including airline upgrades, elite status in frequent flyer programs, and companion airfares; room upgrades at various hotel chains; personalized concierge service; and invitations to exclusive events.

3. Because of the Centurion Card’s unique services and the status of its holders, because it is available only to a tiny percentage of American Express cardholders, and because of its unusual appearance, the card is well known among the general public and in popular culture

as the Black Card. As a direct consequence, ownership of a Black Card has become a symbol of unique status, extreme luxury, and unparalleled financial success.

4. “Gold” or higher status card members receive exclusive access to entertainment and sports events (including preferred seating and/or the opportunity to purchase tickets before the general public).

5. American Express’s business activities are not limited to issuance and administration of charge and credit cards or financial services. For example, American Express publishes five magazines (“Travel and Leisure,” “Food and Wine,” “Departures,” “Executive Travel,” and “Black Ink”), offering editorial content regarding luxury vacations, gourmet food, and luxury goods.

6. Consumers who see American Express’s trademarks and trade names used in connection with publications, entertainment services, and related activities are likely to believe that these services emanate from and/or are sponsored by American Express.

AMEX Introduces The Black Card

7. Beginning in the 1980s, American Express offered to a small number of its high net-worth card members a black plastic card containing special customer service numbers, which was not a credit or charge card, but was solely for the purpose of providing information. Rumors began to circulate that American Express was offering a secret “Black Card” charge card to certain individuals and continued to circulate for more than a decade.

8. By the late 1990s, American Express decided to capitalize on these persistent rumors by introducing a brand new product called the Centurion Card – a black-colored charge card available by invitation only, offered only to existing American Express customers who possessed a high net worth and had exhibited a continued high level of spending with their

existing American Express cards. American Express launched its Centurion Card in the United Kingdom in 1998 and in the United States in 1999.

9. In its 1999 initial letter inviting select U.S. card members to apply for the Centurion Card, American Express described the Centurion Card as “the black card,” referred to the persistent rumors of an American Express “black charge card,” and told invitees, “The black card may have started out as a rumor. However, now you have a chance to become one of the first, and I might add, one of the few, to actually carry the legendary black card – the Centurion Card from American Express.”

10. American Express decided to officially call the card “Centurion Card” and to register that name as a service mark in 2001. Nonetheless, American Express fully intended and indeed planned that the general public would refer to the card as “the Black Card”, both because of the long-standing rumors of a black American Express card, and because other American Express charge cards are named after and frequently referred to by, their respective colors.

The Centurion Card Is Widely Known as the Black Card

11. American Express’s intent that the public would react proved correct: the Centurion Card did indeed become widely known as the Black Card, and is referred in popular culture as the Black Card. For example:

- In Lauren Weisberger’s 2005 novel *Everyone Worth Knowing*, a character pays for dinner with a Centurion Card, and the narrator comments: “There it was, the mythical American Express black card. Available by invitation only.... ”
- In the television series *Studio 60 on the Sunset Strip*, one character attempted to pay another characters’ bail with his “American Express Black.”

- In the television series *Entourage*, one of the characters is described as “living off his Black Card.”
- The song “Better Than Yours” by multi-Grammy-winning artist Kanye West features the lyrics: “Oh my God is that a Black Card? I turned around and replied, why yes but I prefer the term African American Express”. In another song, “Who Gon Stop Me,” Mr. West raps: “Extend the beat, Noah, two seats in the 911, no limit on the Black Card.”
- The song “Kiss My Black AmEx” by Draft featuring F.R.E.A.K. contains the lyrics: “I got mad bucks I hit the stash up and spend that cash up and use my new black Amex card for backup.”

12. Journalists also frequently refer to the Centurion Card as the Black Card. For example,

- On January 25, 2011, *Forbes* published a story titled “Amex Reveals Details About Its Secretive Centurion Card,” which begins with the sentence, “The American Express Centurion Card (aka the Black Card) is the Bugatti of credit cards—few can afford it and if you see one in public you’ll probably stop and stare.”
- On January 24, 2011, *The New York Times* published an article by Paul Sullivan, entitled “American Express’s New Service for Its Wealthiest Cardholders” which reported: “Holders of the Centurion Card, more commonly known as the black card, will be able to negotiate the price of a car through the Centurion Website....”

- On July 8, 2011, *The Wall Street Journal* published an article by Mike Ramsey, titled “Have a Black Card? Buy a Hyundai” which reported “American Express Centurion Cardholders – those people who are rich enough that they are offered a “Black Card” with a nearly unlimited line of credit and a host of other niceties – buy Hyundais at a disproportionately high rate compared with other cars.”
- On October 5, 2010, the website style.mtv.com published an article called “Nelly Wants You To Know He Has Good Credit,” which included a photo of the rapper Nelly wearing necklaces made of American Express cards. As the article explained, “There was the invitation-only Black card, a Gold card, and the Platinum card.”
- On August 8, 2004, *BusinessWeek* magazine published an article about the Centurion Card titled “This Black Card Gives You Carte Blanche.”
- The Calcutta, India newspaper *Business Standard* published an article on June 19, 2013, that began with the line, “American Express Banking Corp, which offers the fabled ‘black card’ to the world’s wealthiest, plans to also introduce a credit card for mid-income groups in India by the end of this week.”

13. The Centurion Card is also widely referred to as the Black Card on websites, blogs, and fan pages. For example,

- A July 14, 2011 post on the website www.dailyfinance.com appears under the headline, “American Express ‘Black’: The World's Most Exclusive Charge Card.” <http://www.dailyfinance.com/2011/07/11/american-express-black-the-worlds-most-exclusive-charge-card/>

- A June 4, 2010 post on Yahoo! Finance is titled “How to Get the Amex Black Card.” http://finance.yahoo.com/news/pf_article_109721.html
- A post on a blog called CreditCardForum is titled “American Express Black Card Requirements,” and explains the fees and benefits associated with the Centurion Card. <http://creditcardforum.com/blog/american-express-black-card-requirements/>

14. American Express has also engaged in product placement of the “Black Card” in films.

15. As these many unsolicited references and purposeful American Express cultivation of those references suggest, the general public closely associates the term “Black Card” with American Express, the Centurion Card, and the related services provided by American Express in association with that card.

16. Centurion card members themselves frequently refer to their cards as the “Black Card” when contacting American Express or its concierge service; representatives of the third-party vendor providing those concierge services to Centurion Card holders also frequently refer to it as the Black Card; and American Express employees frequently refer to it as the Black Card, both internally and externally.

17. The fact that the general public calls the Centurion Card the “Black Card” gives rise to protectable trademark rights in “Black Card” that inure to American Express.

18. As a result of American Express’s activities as above-described, it has acquired common law trademark rights in the “Black Card” name and mark.

AMEX's Licensing of the BLACKCARD Mark

19. In 2008, a company called Black Card LLC launched a black Visa card bearing the words "Black Card." Black Card LLC's predecessor in interest had applied for a trademark registration for the mark "BLACKCARD" in International Class 36 for credit and debit card services. Black Card LLC filed a Statement of Use specifying that the mark was first used in commerce at least as early as February 5, 2009, and in April 2009, the PTO granted Trademark Registration No. 3613898 to Black Card LLC.

20. On February 26, 2010, American Express filed an action against Black Card LLC in the United States District Court for the Southern District of New York alleging, *inter alia*, trademark infringement and seeking cancellation of Black Card LLC's registered mark.

21. On November 17, 2011, the United States District Court for the Southern District of New York rejected Black Card LLC's counterclaim in that action, seeking a declaratory judgment that American Express had never used the Black Card mark, expressly finding that American Express had used and had protectable rights in the BLACKCARD mark.

22. American Express and Black Card LLC subsequently entered a settlement agreement which provided, *inter alia*, for an assignment of the BLACKCARD name and mark and the goodwill therein to AMEX M&D, which assignment was duly recorded in the PTO for U.S. Trademark Registration No. 3613898 for the mark "BLACKCARD" in International Class 36 for credit and debit card services on February 17, 2012. AMEX M&D continues to be the owner of said Registration.

23. By means of the same written assignment, Black Card LLC assigned to AMEX M&D all right, title and interest in the following use-based trademark applications: Trademark Application No. 77/654,245 in International Classes 35, 36, 39, 41, 42, 43, 44, and 45 for the

mark “Black Card Concierge”; Trademark Application No. 77/627,276 in International Classes 35, 36, 39, 41, 43, and 45 for the mark “Black Card”; and Trademark Application No. 77/661,119 in International Classes 35, 36, 39, 41, 42, 43, 44, and 45 for the mark “Black”.

24. As part of the aforesaid settlement agreement, AMEX M&D licensed, pursuant to certain conditions, the right to use the BLACKCARD mark to Black Card LLC, which continues to use that mark for credit card and concierge services under and pursuant to the terms of that license agreement to date.

25. Collectively, American Express’s registered trademarks, unregistered trademarks, trademark applications and the use by its licensee of the words “Black” or “Black Card”, constitute a family of marks all including the dominant words “Black Card”, and are referred to herein as the “Black Card Marks.”

26. The Black Card Marks have acquired secondary meaning.

The Instant Application

27. On December 12, 2012, Applicant filed Application Serial No 85/801,419 for the mark “BLACKCARDSTATUS” (the “Claimed Mark”) in International Class 41 for “Entertainment in the nature of providing an informational and entertainment website in the fields of celebrity gossip, entertainment, sports and fitness,” claiming it commenced use of that mark at least as early as November 26, 2012, with a claimed first use in commerce on or before November 26, 2012.

28. In connection with the Application, Applicant submitted a specimen of use, which consisted of the home page of Applicant’s website at www.blackcardstatus.com. On that page, the words “On the jet. Be back later” appeared in block capital letters. In smaller letters, the visitor was encouraged to “[e]nter your email [in a box] for early access to a private world of

opulence and access,” and below that box were the words “blackcardstatus Access to a Private World of Opulence and Excess.” When that visitor typed in his or her email address, he or she received an email but no access to any content. A copy of Applicant’s specimen of use is annexed hereto as Exhibit A.

29. On February 14, 2013, the PTO notified Applicant by Office Action that it appeared from the wording of the “On the Jet. Be Back Later” homepage, that Applicant was not yet offering the identified entertainment services to consumers and that their use-based application was therefore defective.

30. That same day, Applicant (through its owner, Joseph Graziano) responded to the PTO, claiming that “the website was undergoing a refresh; we are constantly working to update and provide new content. The services *were* being rendered in commerce . . . as of the filing date of the application.” Applicant submitted an additional specimen in connection with this response.

31. In addition, Applicant’s February 14, 2013 submission to the PTO added to the Application the following disclaimer: “No claim is made to the exclusive right to use BLACKCARDSTATUS apart from the mark as shown.”

32. The PTO accepted Applicant’s submission and, on April 9, 2013, published the BLACKCARDSTATUS mark for opposition.

Applicant’s Use of the Claimed Mark

33. Despite Applicant’s claims in the Application, upon information and belief, no content regarding celebrity gossip, entertainment, or sports and fitness appeared on the blackcardstatus.com website at the time of Applicant’s trademark application, as of the date that Applicant represented to the PTO that it first began using the mark in commerce, or at the time

that Graziano informed the PTO that the website was “undergoing a refresh.” Indeed, virtually no content at all appeared on this website prior to July 12, 2013. A copy of the blackcardstatus.com home page printed on July 11, 2013 is annexed hereto as Exhibit B.

34. In an email to American Express dated February 20, 2013, Graziano indicated an intent to use the blackcardstatus.com website “to provide reviews on luxury goods. Including, but not limited to, expensive watches, sports cars, champagne, cigars, etc. It will also include photos and blog entries of opulent and decadent vacations and experiences that the average person might not experience in a lifetime.” A copy of that email is annexed hereto as Exhibit C.

Grounds for Opposition

35. Based on the above, including but not limited to the dates of first use by its licensee, American Express has priority of use. The mark BLACKCARDSTATUS, shown in Application Serial No. 85/801,419, is substantially similar to Opposers’ Black Card marks, and when used in association with the services claimed by Application Serial No. 85/801,419, is likely to cause confusion, or to cause mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Based on the strong association of the “BLACKCARD” mark with Opposers’ Centurion Card, consumers are likely to be confused as to the origin, sponsorship, or approval of Applicant’s online information and entertainment services. This is particularly true given Applicant’s stated intention to post content about luxury goods and “opulent and decadent vacations and experiences” – topics that the public associates with the brand image of exclusivity and status that American Express has purposefully created and nurtured for the Centurion Card a/k/a the Black Card, at its own considerable effort and expense.

36. The mark BLACKCARDSTATUS shown in Application Serial No. 85/801,419, when used in association with the services claimed by Application Serial No. 85/801,419, is deceptive within the meaning of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), in that it falsely suggests a connection between American Express and its Centurion Card services on the one hand, and Applicant's online information and entertainment services on the other.

37. For the reasons set forth above, to grant Applicant's registration will cause confusion, irreparably harming American Express, its trademarks, business, and goodwill.

38. Applicant made no bona fide use of the mark BLACKCARDSTATUS in commerce prior to the filing of the use-based Application Serial No. 85/801,419 pursuant to Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a).

39. In connection with the Application, Applicant represented to the PTO that it was using the BLACKCARDSTATUS mark in commerce at the blackcardstatus.com website and had been doing so at least as early as November 26, 2012. In his further submission to the PTO dated February 14, 2013, Graziano stated that when the PTO Examiner viewed the website, "the website was undergoing a refresh; we are constantly working to update and provide new content. The services *were* being rendered in commerce . . . as of the filing date of the application. These statements are materially false.

40. Upon information and belief, prior to July 12, 2013, the home page that Applicant submitted to the PTO as its specimen of use was the only content available on the blackcardstatus.com website. Applicant (through its owner, Graziano) made these materially false statements in the Application and the February 14, 2012 submission with a willful intent to deceive the Patent and Trademark Office in order to procure a registration for the "BLACKCARDSTATUS" mark.

41. By means of Graziano's submission to the PTO dated February 14, 2013, Applicant added to its application the disclaimer, "No claim is made to the exclusive right to use BLACKCARDSTATUS apart from the mark as shown." An application for a trademark that disclaims the mark for which registration is sought is a nullity, as an entire mark cannot be disclaimed and also registered.

WHEREFORE, Opposers respectfully request that this opposition be sustained and that the application for registration by Applicant, Serial No. 85/801,419, be denied and refused.

Please recognize as attorneys for Opposers in this proceeding Marcia B. Paul (member of the Bar of the State of New York), Camille Calman (member of the Bar of the State of New York), and the Davis Wright Tremaine LLP law firm, 1633 Broadway, New York, New York 10019-6708. Please address all communications to **Marcia B. Paul, Esq.** and **Camille Calman, Esq.**, at the above address.

DATED this 7th day of August, 2013.

Respectfully submitted,

DAVIS WRIGHT TREMAINE LLP

/Camille Calman/

By: Marcia B. Paul
Camille Calman

1633 Broadway
New York, New York 10019
(212) 489-8230

Attorneys for Opposers

CERTIFICATE OF SERVICE

I hereby certify that on this 7th day of August, 2013, a true and complete copy of the foregoing **Notice of Opposition** has been served upon Applicant by delivering the same via first-class mail at the following address:

Blackcardstatus LLC.
311 West Third Street, Suite 3955
Carson City, Nevada 89703

 /Camille Calman/
Camille Calman

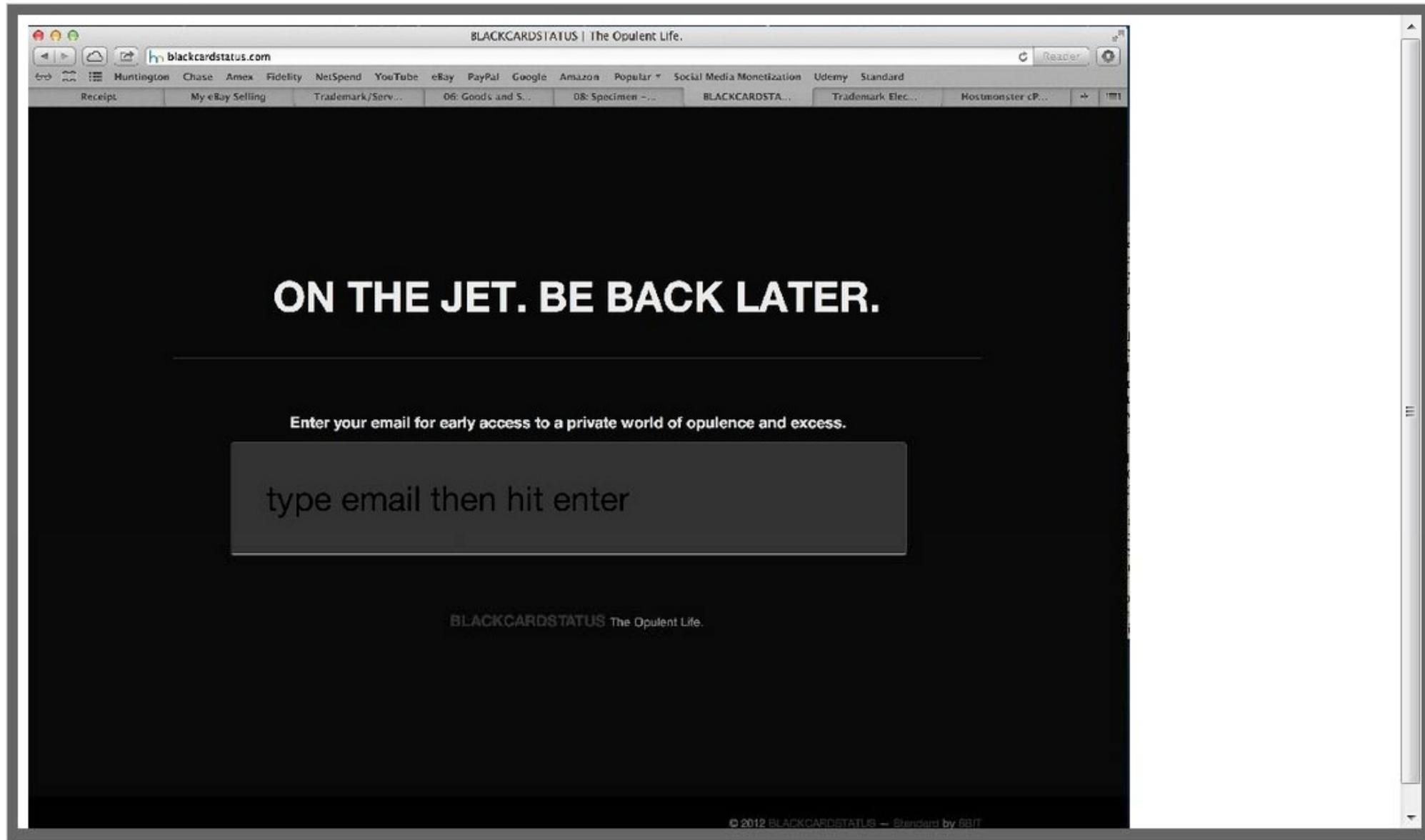
EXHIBIT A

Case Id
85801419

Document Description
15. Specimen

Mail/Create Date
Dec. 12, 2012

Prev Doc 1 of 1 Next Doc



ON THE JET. BE BACK LATER.

Enter your email for early access to a private world of opulence and excess.

type email then hit enter

BLACKCARDSTATUS The Opulent Life.

EXHIBIT B

ON THE JET. BE BACK LATER.

Enter your email for early access to a private world of opulence and excess.

blackcardstatus Access to a Private World of Opulence and Excess.

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EXHIBIT C

Calman, Camille

From: BCS Legal <legal@blackcardstatus.com>
Sent: Wednesday, February 20, 2013 7:32 PM
To: Zimmermann, Michelle L
Subject: Re: American Express Company / Blackcardstatus, LLC and use of BLACKCARD STATUS (Our Ref. 277718)

Michelle,

Your client and your firm need not worry over my company's use of BLACKCARDSTATUS as a business name. As you have already noted, we are registered as a website that is for informational and entertainment purposes. As such, the purpose of the website will be to provide reviews on luxury goods. Including, but not limited to, expensive watches, sports cars, champagne, cigars, etc. It will also include photos and blog entries of opulent and decadent vacations and experiences that the average person might not experience in a lifetime.

There is no intent to use any logo or reference to American Express and/or its Centurion card. There will not be the sale or offering of anything that resembles a credit card. As of the writing of this letter, the only product being offered is information, again, completely unrelated to American Express and its Centurion Card.

While I do have many friends who are members of American Express and holders of the Centurion Card, it is possible some of the experiences we document may involve those persons using their card; with their personal consent. This will be no different than one of the dozens of online blog entries where people brag/talk/discuss the use of their personal Centurion Card. Again, we have no intentions of ever piggy-backing off of American Express' brand, and we will be operating completely within the boundaries of the trademark we have filed.

If you have further questions, please feel free to respond.

Best,
Joseph Graziano

On Feb 20, 2013, at 5:53 PM, "Zimmermann, Michelle L" <mzimmermann@leydig.com> wrote:

Attn: Joseph Graziano

Dear Mr. Graziano,

Please review the attached letter. Please let me know if you have any trouble opening the attachment.

Kind regards,

Michelle L. Zimmermann
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Two Prudential Plaza - Suite 4900
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The information contained in this communication is confidential and may contain information that is privileged and/or exempt from disclosure under applicable law. If you have received this communication in error, please notify me immediately and delete the original and all copies of this communication. Thank you.

<2013.2.20 MLZ to Joseph Graziano.pdf>