

ESTTA Tracking number: **ESTTA556302**

Filing date: **08/27/2013**

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	Ms.Teresa H Earnhardt
Granted to Date of previous extension	08/28/2013
Address	c/o Dale Earnhardt, Inc. 1675 Dale Earnhardt Highway No. 3 Mooresville, NC 28115 UNITED STATES
Party who filed Extension of time to oppose	Ms.TeresaHEarnhardt
Relationship to party who filed Extension of time to oppose	Same name---typo/spacing corrected

Attorney information	Larry C. Jones ALSTON & BIRD LLP 101 South Tryon Street Suite 4000 Charlotte, NC 28280-4000 UNITED STATES Larry.Jones@alston.com Phone:704 444 1019
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Applicant Information

Application No	85686394	Publication date	04/30/2013
Opposition Filing Date	08/27/2013	Opposition Period Ends	08/28/2013
Applicant	Bobby Dale Earnhardt LLC 309 40th St. SE Charleston, WV 25304 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Photographic albums; Photographic prints; Stickers
Class 021. All goods and services in the class are opposed, namely: Beverage glassware; Thermal insulated bags for food or beverages
Class 025. All goods and services in the class are opposed, namely: Hats; Jackets; Pants; Shirts; Shorts; Sweatshirts; Tank-tops; Underwear

Class 028.

All goods and services in the class are opposed, namely: Model cars; Model racing car bodies; Play motor cars; Remote control toys, namely, race cars; Toy cars

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1644237	Application Date	08/28/1989
Registration Date	05/14/1991	Foreign Priority Date	NONE
Word Mark	DALE EARNHARDT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 1981/00/00 First Use In Commerce: 1981/00/00 METAL KEY RINGS Class 008. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 POCKET KNIVES Class 016. First use: First Use: 1979/00/00 First Use In Commerce: 1979/00/00 PAPER GOODS AND PRINTED MATERIAL, NAMELY, POSTERS, BUMPER STICKERS, DECALS, WALL CALENDARS, WINDOW STICKERS AND [BROCHURES AND] BOOKS DIRECTED TO AUTOMOBILE RACING Class 025. First use: First Use: 1976/00/00 First Use In Commerce: 1976/00/00 CLOTHING, NAMELY, SWEATSHIRTS, WARM-UP SETS, SHORTS, SPORT SHORTS, GOLF SHIRTS, T-SHIRTS, [SWEATERS,] JACKETS, [HEADBANDS,] CAPS AND SOCKS Class 026. First use: First Use: 1979/00/00 First Use In Commerce: 1979/00/00 [FANCY GOODS, NAMELY, EMBROIDERED PATCHES] Class 028. First use: First Use: 1981/00/00 First Use In Commerce: 1981/00/00 TOYS, NAMELY, MINIATURE CARS [AND RADIO CONTROLLED CARS] Class 041. First use: First Use: 1975/00/00 First Use In Commerce: 1975/00/00 [ENTERTAINMENT SERVICES IN THE NATURE OF CONDUCTING AND SPONSORING AUTOMOBILE RACES;] ENTERTAINMENT SERVICES IN THE NATURE OF PARTICIPATING IN PROFESSIONAL AUTOMOBILE [RACES AND] * RACING * RELATED EXHIBITIONS		

U.S. Registration No.	2035107	Application Date	09/12/1995
Registration Date	02/04/1997	Foreign Priority Date	NONE
Word Mark	DALE EARNHARDT		
Design Mark			
Description of Mark	The mark consists of the signature of "DALE EARNHARDT".		
Goods/Services	Class 006. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 metal key rings, metal license plates and metal tag holders		

	<p>Class 008. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 pocket knives</p> <p>Class 014. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 jewelry, namely, lapel pins, charms and belt buckles</p> <p>Class 016. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 paper goods and printed material, namely, posters, bumper stickers, decals, wall calendars, window stickers, card sets, and brochures and books directed to automobile racing</p> <p>Class 021. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 housewares and glass, namely, drinking glasses, cups, mugs; rubber, plastic or foam insulating beverage holders and water bottles sold empty</p> <p>Class 024. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 cloth flags, afghans, towels, cloth [flags] * pennants *</p> <p>Class 025. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 clothing, namely, sweatshirts, warm-up sets, shorts, shirts, sport shirts, golf shirts, T-shirts, [suspenders, sweaters,] jackets, headbands, caps, visors, straw hats, socks and infant sets</p> <p>Class 028. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 toys, namely, miniature cars and trucks; and radio controlled cars</p> <p>Class 041. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 entertainment services in the nature of conducting [and sponsoring automobile races;] entertainment services in the nature of participating in professional automobile races and related exhibitions</p>
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Attachments	Opposition 85_686394_1.PDF(157538 bytes)
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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	/Larry C. Jones/
Name	Larry C. Jones
Date	08/27/2013

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

In the matter of Trademark Application
Serial No. 85/686,394
Filed: July 25, 2012
Trademark: BOBBY DALE EARNHARDT
Published: April 30, 2013

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Teresa H. Earnhardt,)
)
Opposer)
)
v.)
)
Bobby Dale Earnhardt LLC,)
)
Applicant.)
-----X

Opposition No. _____

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. 85/686,394, filed July 25, 2012, by Bobby Dale Earnhardt LLC, a West Virginia limited liability company having a mailing address of 309 40th St. SE, Charleston, West Virginia 25304 (“Applicant”), and hereby opposes the registration of said designation as a trademark.

As grounds of opposition, it is alleged that:

1. Since at least as early as 1976, and, in any event, since long prior to either July 25, 2012, the filing date of the subject ITU application, or Applicant’s actual date of first use of the subject mark, Opposer (directly and/or through her predecessors-in-interest and/or their licensees) has used continuously the designation DALE EARNHARDT as a trademark on and in

connection with various goods in the United States. Among those goods are goods which are classified in International Classes 16, 21, 25 and 28. The availability of such products under the DALE EARNHARDT mark has been promoted and advertised to the public at considerable expense.

2. By reason of the adoption and continuous use of the DALE EARNHARDT mark on and in connection with goods sold by or under license from Opposer, that designation has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying Opposer and her goods. As noted above, Opposer's DALE EARNHARDT mark has become particularly distinctive through, *inter alia*, Opposer's extensive use, advertising and promotion of that mark throughout the United States, over a substantial period of time, for a variety of goods, including paper goods and printed material in International Class 16, glassware and other goods in International Class 21, clothing in International Class 25, and toy cars and other goods in International Class 28.

3. Consequently, through such usage and recognition, Opposer has acquired common-law rights in the DALE EARNHARDT designation as a proprietary trademark, which rights extend, without limitation, to the exclusive right to use such designation nationwide in conjunction with Opposer's goods, including, without limitation, goods of the types referenced in Paragraph 2 above.

4. Opposer is also the owner of multiple U.S. registrations for the DALE EARNHARDT mark, including Registration Nos. 1,644,237 and 2,035,107. U.S. Trademark Registration No. 1,644,237 pertains to the use of the DALE EARNHARDT mark on various goods, including, without limitation, goods classified in International Classes 16, 25 and 28, and U.S. Trademark Registration No. 2,035,107 pertains to the use of the DALE EARNHARDT

designation in signature form (the “DALE EARNHARDT Signature Mark”) on various goods, including, without limitation, goods classified in International Classes 16, 21, 25 and 28. (These two registrations shall be referenced collectively hereinafter as “Opposer’s DALE EARNHARDT Registrations.”)

5. Each of Opposer’s DALE EARNHARDT Registrations is valid, subsisting, in full force and effect, and incontestable. Moreover, each of Opposer’s DALE EARNHARDT Registrations serves as prima facie evidence of Opposer’s exclusive right to use the DALE EARNHARDT mark and the DALE EARNHARDT Signature Mark on the goods listed in the respective registration thereof.

6. On July 25, 2012, Applicant filed the application at issue to register the mark BOBBY DALE EARNHARDT (“Applicant’s Mark”) for use on certain goods in each of International Classes 16, 21, 25 and 28.

7. Applicant’s Mark, BOBBY DALE EARNHARDT, incorporates the entirety of Opposer’s DALE EARNHARDT mark. Thus, Applicant’s Mark is visually and aurally similar to Opposer’s DALE EARNHARDT mark. These characteristics create a likelihood of confusion. Moreover, the goods listed in Applicant’s application are the same as, or are closely related to, the goods on which Opposer has used and registered her DALE EARNHARDT mark and her DALE EARNHARDT Signature Mark. This further enhances the likelihood of confusion. Thus, Applicant’s BOBBY DALE EARNHARDT mark, when used on or in connection with the 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 goods in relation to Opposer.

8. Still further, each of the DALE EARNHARDT mark and the DALE EARNHARDT Signature Mark is not only a distinctive mark, but also a famous mark, and each

designation acquired that status as a famous mark prior to the first usage in commerce of the Applicant's BOBBY DALE EARNHARDT mark (if any such usage has been made).

9. Hence, the application to register the BOBBY DALE EARNHARDT mark should also be refused on the basis that the usage of that mark on the goods listed in the subject application is likely to cause dilution by blurring of each of the famous DALE EARNHARDT mark and the DALE EARNHARDT Signature Mark, so as to be unlawful pursuant to 15 U.S.C. § 1125(c).

SUMMARY

10. Applicant's application for registration of the BOBBY DALE EARNHARDT designation should be refused under either or both 15 U.S.C. § 1063(a) and 15 U.S.C. § 1052(d).

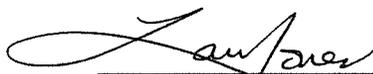
11. Accordingly, Opposer asserts, pursuant to 15 U.S.C. § 1063, that she will be damaged by the issuance of a registration for the BOBBY DALE EARNHARDT mark to Applicant as sought in Trademark Application Serial No. 85/686,394.

WHEREFORE, Opposer prays that the application for registration of Applicant's BOBBY DALE EARNHARDT mark 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.

Date: August 27, 2013

Respectfully submitted,



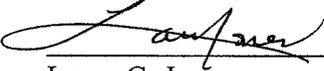
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing "Notice of Opposition" was duly served on Applicant by depositing a copy of same in the United States mail, first-class postage prepaid, on the 27th day of August, 2013, addressed to Applicant's attorney of record as follows:

Matthew H. Swyers
The Trademark Company
344 Maple Ave. W, Suite 151
Vienna, VA 22180-5612



Larry C. Jones