

ESTTA Tracking number: **ESTTA560934**

Filing date: **09/23/2013**

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	Competitor Group, Inc.
Granted to Date of previous extension	12/04/2013
Address	9477 Waples Street Suite 150 San Diego, CA 92121 UNITED STATES

Attorney information	John Paul Oleksiuk Cooley LLP 1299 Pennsylvania Ave., NW Suite 700 Washington, DC 20004 UNITED STATES trademarks@cooley.com,jpo@cooley.com,pwillsey@cooley.com Phone:310.883.6400
----------------------	---

**Applicant Information**

Application No	85882798	Publication date	08/06/2013
Opposition Filing Date	09/23/2013	Opposition Period Ends	12/04/2013
Applicant	Kona Running Company, Inc. 18186 Blue Heron Dr. W. Northville, MI 48168 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 041. First Use: 2011/09/01 First Use In Commerce: 2011/11/22 All goods and services in the class are opposed, namely: Organizing, arranging, and conducting running events
---

**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.	4336334	Application Date	07/12/2011
Registration Date	05/14/2013	Foreign Priority Date	NONE
Word Mark	ROCK 'N' ROLL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1998/06/21 First Use In Commerce: 1998/06/21 Entertainment services, namely, arranging and organizing a sporting event in the nature of a running race

U.S. Registration No.	4394562	Application Date	07/12/2011
Registration Date	09/03/2013	Foreign Priority Date	NONE
Word Mark	ROCK 'N' ROLL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1998/06/21 First Use In Commerce: 1998/06/21 Providing entertainment events, namely, organizing community festivals featuring vendor booths; party planning, namely, planning parties and special-event dinners; all of the aforementioned offered in connection with endurance sports events		

U.S. Registration No.	4313803	Application Date	07/12/2011
Registration Date	04/02/2013	Foreign Priority Date	NONE
Word Mark	ROCK 'N' ROLL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1998/06/21 First Use In Commerce: 1998/06/21 Organizing, promoting and conducting exhibitions and tradeshows for business purposes featuring booths and displays relating to competitive endurance sports events		

U.S. Registration No.	2131333	Application Date	09/05/1996
Registration Date	01/20/1998	Foreign Priority Date	NONE
Word Mark	ROCK 'N' ROLL MARATHON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1996/08/00 First Use In Commerce: 1996/08/00 entertainment in the nature of marathon foot races		

Attachments	SD- #866051-v2-Sept_2013_Notice_of_Opposition_SHAMROCK_N_ROLL_RUN.pdf(93301 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 Overnight Courier on this date.

Signature	/John Paul Oleksiuk/
Name	John Paul Oleksiuk
Date	09/23/2013

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

In the matter of Application Serial No. 85/882,798  
For the Trademark SHAMROCK N ROLL RUN  
Published in the Official Gazette on August 6, 2013

COMPETITOR GROUP, INC.	)	
	)	
Opposer,	)	
	)	Opposition No.
v.	)	
	)	
KONA RUNNING COMPANY, INC.	)	
	)	
	)	
Applicant.	)	
<hr style="border: 0.5px solid black;"/>		

**NOTICE OF OPPOSITION**

Opposer Competitor Group, Inc. (“CGI”), a Delaware corporation having its principal place of business at 9477 Waples Street, Suite 150, San Diego, CA 92121, will be damaged by the issuance of a registration for the mark SHAMROCK N ROLL RUN (the “Applicant’s Mark”), as applied for in Application Serial No. 85/882,798 filed on March 21, 2013 by Applicant Kona Running Company, Inc., a Michigan corporation located at 18186 Blue Heron Dr. W., Northville, MI 48168 (“Applicant”). CGI, having previously been granted an extension of time to oppose Applicant’s Mark, hereby opposes same.

As grounds for opposition, CGI alleges as follows.

1. CGI is the world’s largest endurance sports platform, and organizes and presents, among other things, a series of running events under the distinctive ROCK ‘N’ ROLL brand. The running events offered by CGI under its ROCK ‘N’ ROLL brand can be found in cities all

across America. These races draw over 500,000 participants each year and have raised hundreds of millions of dollars in charitable contributions.

2. CGI owns dozens of United States trademark registrations relating to its ROCK ‘N’ ROLL brand, including the following:

ROCK ‘N’ ROLL, Registration No. 4,336,334, covering “Entertainment services, namely, arranging and organizing a sporting event in the nature of a running race;”

ROCK ‘N’ ROLL, Registration No. 4,394,562, covering “Providing entertainment events, namely, organizing community festivals featuring vendor booths; party planning, namely, planning parties and special-event dinners; all of the aforementioned offered in connection with endurance sports events;”

ROCK ‘N’ ROLL, Registration No. 4,313,803. covering “Organizing, promoting and conducting exhibitions and tradeshow for business purposes featuring booths and displays relating to competitive endurance sports events;” and

ROCK ‘N’ ROLL MARATHON, Registration No. 2,131,333, covering “entertainment in the nature of marathon foot race” (collectively, the “ROCK ‘N’ ROLL Marks.”)

3. CGI and its predecessors-in-interest have consistently and continually marketed running races under the ROCK ‘N’ ROLL Marks since at least as early as 1998. By virtue of CGI’s marketing, widespread event participation, and press recognition, the public has come to know, rely on, and recognize the ROCK ‘N’ ROLL Marks as source identifiers for CGI’s events.

4. Through extensive public participation, advertising and promotion, as well as national and international recognition from the press and running community publications, the ROCK ‘N’ ROLL Marks are famous and achieved fame prior to the filing date of Applicant’s

application opposed herein, prior to any date of first use that may be claimed by Applicant, and before any priority date claimed for Applicant's Mark.

5. Several of the registered ROCK 'N' ROLL Marks, including the mark contained in Registration No. 2,131,333, have become incontestable under the Lanham Act. CGI's incontestable registrations are conclusive evidence of the validity of the registered marks, of CGI's ownership of the marks, and of CGI's exclusive right to use the registered marks in commerce.

6. Upon information and belief, CGI alleges that on March 21, 2013 Applicant filed an application to register the mark SHAMROCK N ROLL RUN, claiming a date of first use of September 1, 2011. Applicant seeks registration in connection with "organizing, arranging, and conducting running events."

7. Upon information and belief, CGI alleges that Applicant has disclaimed the descriptive word "run" within Applicant's Mark.

8. Applicant's Mark is likely to be confused with and mistaken for CGI's events marketed under the ROCK 'N' ROLL Marks because Applicant's Mark is confusingly similar in sight, sound, and meaning to the ROCK 'N' ROLL Marks. Applicant's Mark and the ROCK 'N' ROLL Marks share the identical and dominant ROCK 'N' ROLL component.

9. Applicant's Mark is used on and in connection with identical services to CGI's services, namely, arranging and organizing running events.

10. Applicant's targeted customer and consumer base overlaps with the customers and consumers of CGI.

11. As Applicant's services description contains no restrictions or limitations as to Applicant's marketing channels, CGI may assume that Applicant's Mark, like CGI's own ROCK

'N' ROLL Marks, will be used in all standard marketing channels. Therefore, in addition to overlapping consumer bases, Applicant's marketing channels for its events overlap with the channels used by CGI in marketing and promoting its events under the ROCK 'N' ROLL Marks.

12. If Applicant is permitted to register Applicant's Mark for the services specified in the Application herein opposed, confusion, mistake, or deception resulting in damage and injury to CGI would likely occur. Persons familiar with the ROCK 'N' ROLL Marks would likely perceive Applicant's races as associated, affiliated with, offered by, or sponsored by CGI. Such confusion would inevitably result in damage to CGI.

13. Upon information and belief, Applicant's Mark is used in connection with a race held on or about St. Patrick's Day. Given the similarities between the marks and the services of the parties, participants, spectators, and other members of the public may believe that the term "SHAMROCK" denotes a special edition of CGI's race series occurring on or around St. Patrick's Day.

14. Any defect or fault found with Applicant's services marketed under Applicant's Mark would necessarily reflect on and seriously injure the reputation that CGI has established for its races.

15. Registration of Applicant's Mark would give Applicant prima facie evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use Applicant's Mark, all to the detriment of CGI.

16. Applicant's Mark so resembles the ROCK 'N' ROLL Marks previously used and registered by CGI, as to be likely, when applied to the identified services, to cause confusion, or to cause mistake, or to deceive in violation of 15 U.S.C. § 1052(d).



**CERTIFICATE OF SERVICE**

I hereby certify that on September 23, 2013, I sent the foregoing NOTICE OF OPPOSITION regarding Competitor Group, Inc. v. Kona Running Company, Inc. to the Correspondent on Applicant's USPTO record for Serial No. 85/882,798, by overnight courier, in an envelope addressed to:

**Michael Sneyd  
Kerr, Russell and Weber, PLC  
500 Woodward Avenue Suite 2500  
Detroit, MI 48226-3427**

Date: September 23, 2013

/John Paul Oleksiuk/  
John Paul Oleksiuk