

ESTTA Tracking number: **ESTTA618543**

Filing date: **07/30/2014**

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	Sturgis Motorcycle Rally, Inc.
Granted to Date of previous extension	07/30/2014
Address	1612 Junction Ave., Suite 4 Sturgis, SD 57785 UNITED STATES
Attorney information	Jason M Sneed; Gina R Iacona SNEED PLLC 610 Jetton Street, Suite 120-107 Davidson, NC 28036 UNITED STATES JSneed@SneedLegal.com, Glacona@SneedLegal.com, litigation@SneedLegal.com

**Applicant Information**

Application No	86112261	Publication date	04/01/2014
Opposition Filing Date	07/30/2014	Opposition Period Ends	07/30/2014
Applicant	Hansen, Gary, St. Martin 10079 Valley Rd. NE Bainbridge Island, WA 98110 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 040. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Custom imprinting of T-shirts; Custom imprinting of bumper sticker with decorative designs; Custom imprinting of slogan with messages; Imprinting messages on T-shirts; Imprinting messages on wearing apparel and mugs; Imprinting of decorative designs on T-shirts; Silk screen printing; T-shirt embroidering services
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3955170	Application Date	01/30/2001
Registration Date	05/03/2011	Foreign Priority	NONE

	Date
Word Mark	BLACK HILLS
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 006. First use: First Use: 2006/08/31 First Use In Commerce: 2006/08/31 Metal key rings, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 009. First use: First Use: 1995/08/31 First Use In Commerce: 1995/08/31 Sunglasses, magnets and protective helmets, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 013. First use: First Use: 1998/06/30 First Use In Commerce: 1998/06/30 Firearms, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 014. First use: First Use: 2010/06/30 First Use In Commerce: 2010/06/30 Jewelry and clocks, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 016. First use: First Use: 1987/08/31 First Use In Commerce: 1987/08/31 Pens; and paper goods and printed matter, namely, posters; bumper stickers; decals; iron-on and plastic transfers; window stickers; note pads; mounted photographs; unmounted photographs; prints, namely, color prints, photographic prints, and pictorial prints; paper and plastic bags for packaging; and postcards; all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 020. First use: First Use: 2002/08/31 First Use In Commerce: 2002/08/31 Non-metal key rings and jewelry boxes not of metal, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 021. First use: First Use: 1995/08/31 First Use In Commerce: 1995/08/31 Glassware, namely, shot glasses, drinking glasses, drinking cups, and drinking mugs; insulating sleeve holders made of rubber, plastic or foam for beverage cans; insulating sleeve holders made of rubber, plastic or foam for beverage bottles; coasters not of paper and not being table linen; bottle openers; and beer steins; all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 024. First use: First Use: 2004/08/30 First Use In Commerce: 2004/08/30 Cloth flags and quilts, all of the aforementioned goods relating to the STURGIS-motorcycle rally</p> <p>Class 025. First use: First Use: 1986/08/31 First Use In Commerce: 1986/08/31 Clothing, namely, shirts, T-shirts, long sleeve T-shirts, sleeveless T-shirts, denim shirts, henley shirts, knit shirts, sport 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> <p>Class 026. First use: First Use: 1986/08/31 First Use In Commerce: 1986/08/31</p>

	<p>Cloth and embroidered patches for clothing, ornamental cloth patches, hat pins for securing hats, belt buckles not of precious metal, and novelty pins, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 028. First use: First Use: 2001/06/30 First Use In Commerce: 2001/06/30 Christmas tree ornaments and gaming chips, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 032. First use: First Use: 2005/06/30 First Use In Commerce: 2005/06/30 Bottled water and beer, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 033. First use: First Use: 2002/06/30 First Use In Commerce: 2002/06/30 Distilled liquor, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 034. First use: First Use: 2007/06/30 First Use In Commerce: 2007/06/30 Ashtrays not of precious metal and cigarette lighters not of precious metal, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 035. First use: First Use: 2002/06/30 First Use In Commerce: 2002/06/30 Promoting sports competitions and conducting events of others, namely, motorcycle and vehicle rallies, exhibits, and competitions; promoting economic development in the city of Sturgis and the Black Hills area of South Dakota and Wyoming; and on-line retail store services</p> <p>Class 041. First use: First Use: 2002/06/30 First Use In Commerce: 2002/06/30 Entertainment services in the nature of organizing, sponsoring, and conducting a motorcycle and vehicle exhibitions and rallies</p>
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U.S. Registration No.	4301562	Application Date	01/30/2001
Registration Date	03/12/2013	Foreign Priority Date	NONE
Word Mark	BLACK HILLS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1996/05/31 First Use In Commerce: 1996/05/31 Metal license plates, non-luminous and non-mechanical metal signs, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 008. First use: First Use: 1990/05/31 First Use In Commerce: 1990/05/31 Hand tools, namely, sidearm knives, and knives made of precious metal, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 009. First use: First Use: 2012/05/31 First Use In Commerce: 2012/05/31 Computer mouse pads, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 014. First use: First Use: 2002/04/30 First Use In Commerce: 2002/04/30</p>		

	<p>Non-monetary coins, medallions, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 016. First use: First Use: 2005/08/31 First Use In Commerce: 2005/08/31 Paper and plastic gift bags; all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 018. First use: First Use: 2012/05/31 First Use In Commerce: 2012/05/31 Book bags, shoulder bags, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 025. First use: First Use: 2010/06/30 First Use In Commerce: 2010/06/30 Head bands, all of the aforementioned goods relating to the STURGIS motorcycle rally</p> <p>Class 035. First use: First Use: 2010/06/30 First Use In Commerce: 2010/06/30 Catalog, retail store, wholesale store services featuring a variety of general merchandise and products</p>
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Attachments	<p>76979109#TMSN.png( bytes )</p> <p>76979154#TMSN.png( bytes )</p> <p>2014-07-30 Notice of Opposition.pdf(300497 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	/Jason M. Sneed/
Name	Jason M Sneed; Gina R lacona
Date	07/30/2014

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

In the matter of U.S. Trademark Application

Serial No. 86/112,261

Mark: IT'S A BLACK HILLS THING! YOU WOULDN'T UNDERSTAND, 'TILL YOU BEEN  
HERE!

Filed: November 6, 2013

Published: April 1, 2014

_____	)	
Sturgis Motorcycle Rally, Inc.,	)	
	)	
Opposer,	)	
	)	Opposition No. _____
v.	)	
	)	
Gary St. Martin Hansen,	)	
	)	
Applicant,	)	
_____	)	

**NOTICE OF OPPOSITION**

Sturgis Motorcycle Rally, Inc., a South Dakota not-for-profit company having a principal place of business at 1612 Junction Ave., Suite 4, Sturgis, South Dakota 57785 (“Opposer” or “SMRI”), believes that it will be damaged by the mark shown in Application Serial No. 86/112,261, filed November 6, 2013, by Gary St. Martin Hansen, an individual having an address of 10079 Valley Road NE, Bainbridge Island, Washington 98110 (“Applicant”), and hereby opposes the registration of said mark.

As grounds for the opposition, SMRI alleges that:

1. Since long prior to the earlier of November 6, 2013, the date on which the subject intent-to-use application was filed by Applicant, or the actual date of first use of the IT'S A BLACK HILLS THINGS! YOU WOULDN'T UNDERSTAND, 'TILL YOU BEEN HERE! mark by Applicant, Opposer, its predecessors, related companies and licenses (“Opposer and its Affiliates”)

continuously have been in the business in this country of offering for sale and selling a wide variety of products and services in conjunction with the marks BLACK HILLS® and BLACK HILLS MOTOR CLASSIC (collectively, the “BLACK HILLS Marks”).

2. By reason of the adoption and continuous use of the BLACK HILLS Marks, these designations have a distinctive quality and have acquired special and particular significance and very valuable goodwill as identifying Opposer and its goods and services.

3. Opposer and its licensee, the City of Sturgis, South Dakota, are the official organizers and promoters for the STURGIS Motorcycle Rally which is the largest and most famous motorcycle enthusiast event in the world, and which annually draws approximately half a million motorcycle enthusiasts and tourists to the City of Sturgis, South Dakota and surrounding Black Hills region of South Dakota and Wyoming. Opposer and its Affiliates use the BLACK HILLS Marks in the organization, operation, sponsorship, promotion and administration of the STURGIS Motorcycle Rally.

4. Consequently, through such usage and recognition, Opposer has acquired common law rights in and to the BLACK HILLS Marks as proprietary trademarks, which rights extend, without limitation, to the exclusive right to use such designations nationwide in conjunction with Opposer’s goods and services offered and sold under the BLACK HILLS Marks, and so as to prevent the use of confusingly similar marks in conjunction with related goods and services.

5. Opposer owns U.S. Reg. No. 3,955,170 for the mark BLACK HILLS®, covering goods and services in sixteen (16) classes, including, without limitation, the following:

- a. **International Class 16**, in connection with, *inter alia*, “Pens; and paper goods and printed matter, namely posters; bumper stickers; decals; iron-on and plastic transfers; window stickers; note pads; mounted photographs; unmounted photographs; prints, namely, color prints, photographic prints, and pictorial prints; paper and plastic bags for packaging; and postcards; all of the aforementioned goods relating to the STURGIS motorcycle rally”, with use as early as 1987;

- b. **International Class 25**, in connection with, *inter alia*, “Clothing, namely, T-shirts, long sleeve T-shirts, sleeveless T-shirts, denim shirts, henley shirts, knit shirts, sport 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”, with use as early as 1986;
- c. **International Class 26**, in connection with, *inter alia*, “Cloth and embroidered patches for clothing, ornamental cloth patches, hat pins for securing hats, belt buckles not of precious metal, and novelty pins, all of the aforementioned goods relating to the STURGIS motorcycle rally”, with use as early as 1986;
- d. **International Class 35**, in connection with, *inter alia*, “Promoting sports and competitions and conducting events of others, namely, motorcycle and vehicle rallies, exhibits, and competitions; promoting economic development in the city of Sturgis and the Black hills area of South Dakota and Wyoming; and on-line retail store services, all of the aforementioned goods relating to the STURGIS motorcycle rally”, with use as early as 2002;
- e. **International Class 41**, in connection with, *inter alia*, “Entertainment services in the nature of organizing, sponsoring, and conducting a motorcycle and vehicle exhibitions and rallies, all of the aforementioned goods relating to the STURGIS motorcycle rally”, with use as early as 2002.

6. Opposer also owns U.S. Reg. No. 4,301,562 for the mark BLACK HILLS®, covering goods and services in eight (8) classes, including, without limitation, the following:

- a. **International Class 06**, in connection with, *inter alia*, “Metal license plates, non-luminous and non-mechanical metal signs, all of the aforementioned goods relating to the STURGIS motorcycle rally”, with use as early as 1996;
- b. **International Class 09**, in connection with, *inter alia*, “Computer mouse pads, all of the aforementioned goods relating to the STURGIS motorcycle Rally”, with use as early as 2012;
- c. **International Class 18**, in connection with, *inter alia*, “Book bags, shoulder bags, all of the aforementioned goods relating to the STURGIS motorcycle rally”, with use as early as 2012;
- d. **International Class 35**, in connection with, *inter alia*, “Catalog, retail store, wholesale store services featuring a variety of general merchandise and products”, with use as early as 2010.

(all the above-listed registrations shall be referred to herein as “Opposer’s BLACK HILLS Registrations.”)

7. Opposer’s BLACK HILLS Registrations are valid, substituting and in full force and effect.

8. On November 6, 2013, Applicant filed the intent-to-use application at issue to register the term IT’S A BLACK HILLS THING! YOU WOULDN’T UNDERSTAND, ‘TILL YOU BEEN HERE! in connection with “Custom imprinting of T-shirts; Custom imprinting of bumper sticker with decorate designs; Custom imprinting of slogan messages; Imprinting messages on T-shirts; Imprinting messages on wearing apparel and mugs; Imprinting of decorative designs on T-shirts; Silk screen printing; T-shirt embroidering services” in International Class 40.

9. Applicant’s mark contains many words, the most prominent of which is identical to Opposer’s BLACK HILLS® mark and the first two words of Opposer’s BLACK HILLS MOTOR CLASSIC. The characteristics of Applicant’s mark create a false impression or connotation that Applicant and its services are associated, affiliated, approved, connected or sponsored by Opposer and/or the STURGIS Motorcycle Rally, and, moreover, these characteristics create a likelihood of confusion with Opposer and its BLACK HILLS Marks and the goods and services offered and sold thereunder.

10. Applicant’s goods and services are identical or substantially related to the goods and services offered and sold under and in connection with Opposer’s BLACK HILLS Marks and described in Opposer’s BLACK HILLS Registrations.

11. Accordingly, the Applicant’s mark, when used in connection with the goods and services listed in the application at issue, is likely to deceive or cause consumer confusion or mistake among members of the public and potential purchasers of the parties’ respective goods and services

as to the source or sponsorship of Applicant's goods and services in relation to Opposer and its goods and services.

12. Applicant's application for registration should be refused on the basis that it creates, in violation of 15 U.S.C. § 1125(a), a false designation of origin, or a false or misleading description of fact, or a false or misleading representation of fact, which is likely to cause mistake, or to deceive as to the affiliation, connection or association of the Applicant with the Opposer, the STURGIS Motorcycle Rally and Opposer's goods, services and commercial activities.

13. Applicant's application for registration should be refused on the basis that it consists of or comprises, in violation of 15 U.S.C. § 1052(d):

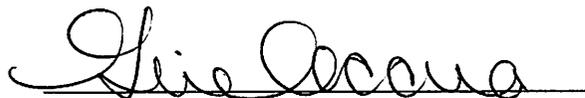
A mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.

14. Opposer asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for the IT'S A BLACK HILLS THING! YOU WOULDN'T UNDERSTAND, 'TILL YOU BEEN HERE! mark to Applicant as sought in U.S. Application Serial No. 86/112,261.

WHEREFORE, Opposer, Sturgis Motorcycle Rally, Inc., requests that the application for registration of Applicant's mark be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Dated: July 30, 2014

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Jason M. Sneed", written over a horizontal line.

Jason M. Sneed, Esq.

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*Attorney for Opposer, Sturgis Motorcycle  
Rally, Inc.*

**Certificate of Filing**

The undersigned certifies that this correspondence is being filed via electronic means by filing with the Electronic System for Trademark Trial and Appeals.



An Attorney for Opposer

Date of Signature: July 30, 2014

**Certificate of Service**

The undersigned counsel of record hereby certifies that a copy of the foregoing *Notice of Opposition* was served by placing a copy in U.S. Mail, postage, prepaid, this 30th day of July, 2014 and addressed to the following:

Gary St. Martin Hansen  
10079 Valley Rd. NE  
Bainbridge Island, Washington 98110  
*Applicant*



An Attorney for Opposer