

ESTTA Tracking number: **ESTTA631683**

Filing date: **10/08/2014**

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	GeorgeA.Powell
Granted to Date of previous extension	10/08/2014
Address	920 Garden St. c/o Koenig & Associates Santa Barbara, CA 93101 UNITED STATES

Attorney information	Kurt Koenig Koenig & Associates 920 Garden St. Santa Barbara, CA 93101 UNITED STATES Kurt@incip.com Phone:805-965-4400
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Applicant Information

Application No	85817997	Publication date	06/10/2014
Opposition Filing Date	10/08/2014	Opposition Period Ends	10/08/2014
Applicant	DeVogler, Wayne D 211 S. State College #228 Anaheim, CA 92806 UNITED STATES		

Goods/Services Affected by Opposition

Class 200. First Use: 1968/03/26 First Use In Commerce: 1968/03/26 All goods and services in the class are opposed, namely: Indicating membership in a brotherhood motorcycle club for the purpose of promoting the interests of motorcycle owners,motorcycling, and activities for motorcycle riders and enthusiasts
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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)
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.	1091899	Application Date	09/01/1977
Registration Date	05/23/1978	Foreign Priority	NONE

		Date	
Word Mark	BONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1977/07/05 First Use In Commerce: 1977/07/05 WHEELS FOR SPORTING ARTICLES-NAMELY, WHEELS FOR SKATE-BOARDS		

U.S. Registration No.	1501450	Application Date	12/23/1987
Registration Date	08/23/1988	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1977/07/00 First Use In Commerce: 1979/06/00 SPORTING GOODS, NAMELY SKATE BOARDS ANDPARTS THEREFOR; AND WHEELS FOR ROLLER SKATES		

U.S. Registration No.	1559066	Application Date	12/23/1987
Registration Date	10/03/1989	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1977/06/00 First Use In Commerce: 1977/06/00 PROMOTIONAL CLOTHING, NAMELY SWEATSHIRTS AND T-SHIRTS		

U.S. Registration No.	1695119	Application Date	05/07/1990
Registration Date	06/16/1992	Foreign Priority	NONE

		Date	
Word Mark	BONES BRIGADE		
Design Mark	<h1>BONES BRIGADE</h1>		
Description of Mark	NONE		
Goods/Services	Class 200. First use: First Use: 1981/03/00 First Use In Commerce: 1981/03/00 indicating membership in an organization of skateboarding enthusiasts		

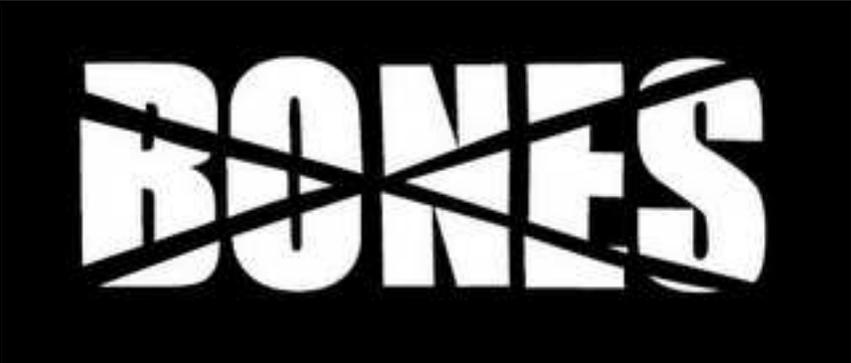
U.S. Registration No.	1705475	Application Date	05/07/1990
Registration Date	08/04/1992	Foreign Priority Date	NONE
Word Mark	BONES BRIGADE		
Design Mark	<h1>BONES BRIGADE</h1>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1979/06/00 First Use In Commerce: 1979/06/00 entertainment services; namely, conducting professional skateboarding team competitions and exhibitions		

U.S. Registration No.	2553383	Application Date	08/23/1999
Registration Date	03/26/2002	Foreign Priority Date	NONE
Word Mark	HARDCORE BONES		

Design Mark	HARDCORE BONES		
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2000/07/12 First Use In Commerce: 2000/07/12 SPORTING GOODS, namely, [SKATEBOARDS AND PARTS THEREFOR,] SKATEBOARD [WHEELS, AND] WHEEL BUSHINGS		

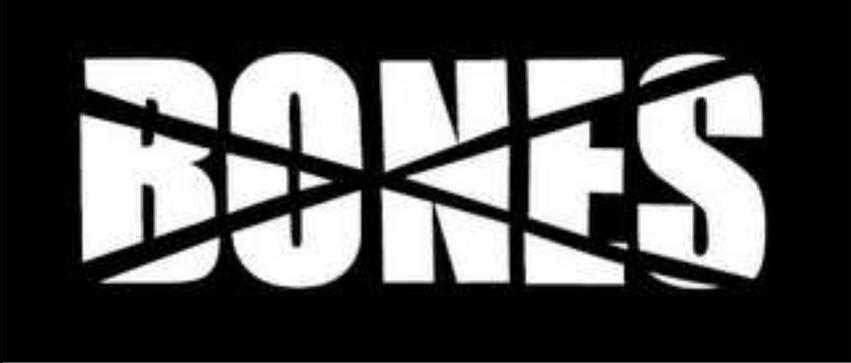
U.S. Registration No.	3061458	Application Date	11/16/2001
Registration Date	02/28/2006	Foreign Priority Date	NONE
Word Mark	BONES		
Design Mark	BONES		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1977/06/30 First Use In Commerce: 1977/06/30 Clothing, namely, hats, shirts, jackets, sweat shirts and belts		

U.S. Registration No.	3810594	Application Date	11/10/2009
Registration Date	06/29/2010	Foreign Priority Date	NONE
Word Mark	BONES		

Design Mark	
Description of Mark	The mark consists of The word "BONES" centered in a rectangular box with two lines in the shape of an "X" or cross through the letters.
Goods/Services	Class 028. First use: First Use: 2006/09/01 First Use In Commerce: 2006/09/01 Skateboard wheels, Skateboard bushings, Skateboard riser pads, Skateboard wax, Skateboard grip tapes, Skateboard hardware, namely, nuts and bolts for skateboards

U.S. Registration No.	3810792	Application Date	11/20/2009
Registration Date	06/29/2010	Foreign Priority Date	NONE

Word Mark	BONES
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Design Mark	
Description of Mark	The mark consists of the word "BONES" centered in a black rectangular box with two diagonal lines that form the shape of an x or a cross through the letters inthe word "BONES" .
Goods/Services	Class 025. First use: First Use: 2006/09/01 First Use In Commerce: 2006/09/01 Baseball caps; Caps; Hats; Headgear, namely, baseball caps, beanies, and caps; Headwear; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleevedt-shirts; Short-sleeved shirts; Sweat shirts; T-shirts; Tops; Wearable garmentsand clothing, namely, shirts

U.S. Registration No.	3584070	Application Date	08/15/2007
Registration Date	03/03/2009	Foreign Priority Date	NONE
Word Mark	ROLLER BONES		

Design Mark	ROLLER BONES
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1981/07/31 First Use In Commerce: 1981/07/31 Roller Skate Wheels

U.S. Registration No.	3633328	Application Date	06/06/2006
Registration Date	06/02/2009	Foreign Priority Date	NONE
Word Mark	RAT BONES		
Design Mark	RAT BONES		
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1983/12/28 First Use In Commerce: 1983/12/28 Sporting goods, namely, skateboard wheels, skateboard wheel assemblies and parts and fittings for any thereof		

U.S. Registration No.	3735248	Application Date	04/15/2009
Registration Date	01/05/2010	Foreign Priority Date	NONE
Word Mark	BONES REDS		

Design Mark	BONES REDS
Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 1999/09/02 First Use In Commerce: 1999/09/02 Ball bearings for skateboards

U.S. Registration No.	3905805	Application Date	06/06/2006
Registration Date	01/11/2011	Foreign Priority Date	NONE
Word Mark	RAT BONES		
Design Mark	RAT BONES		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2010/07/20 First Use In Commerce: 2010/07/20 Clothing, namely, activewear, sportswear, skatewear, and other clothing for sports, namely, T-shirts, shirts, tops, hats, headwear		

U.S. Registration No.	2057174	Application Date	04/15/1996
Registration Date	04/29/1997	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 025. First use: First Use: 1985/02/13 First Use In Commerce: 1985/02/13 clothing, namely, sweatshirts, T-shirts and caps</p> <p>Class 028. First use: First Use: 1985/02/13 First Use In Commerce: 1985/02/13 sporting goods, namely, skateboards and parts thereof, and wheels for skateboards</p>		
U.S. Registration No.	3603333	Application Date	06/28/2007
Registration Date	04/07/2009	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a black image on a white background of a rat face with two bones appearing underneath the rat face.
Goods/Services	<p>Class 025. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Clothing, namely, activewear, sportswear, skatewear, and other clothing for sports, namely, T-shirts, shirts, socks, sweatshirts, tops, hats, headgear, namely, baseball caps, beanies, and caps, headwear</p> <p>Class 028. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 Sporting goods, namely, skateboards, skateboard decks, skateboard wheels, skateboard wheel assemblies and replacement parts and fittings, namely, bearings, bushings; ball bearings for skateboards</p>

Attachments	73703301#TMSN.png(bytes) 73703239#TMSN.png(bytes) 74056716#TMSN.png(bytes) 74056717#TMSN.png(bytes) 75782886#TMSN.png(bytes) 76338768#TMSN.png(bytes) 77869282#TMSN.png(bytes) 77878031#TMSN.png(bytes) 77256251#TMSN.png(bytes) 78980980#TMSN.png(bytes) 77714670#TMSN.png(bytes) 78901655#TMSN.png(bytes) 75088206#TMSN.png(bytes) 77218537#TMSN.png(bytes) NOO-BONES_Motorcycle_Club.pdf(150890 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	/Kurt Koenig/
Name	Kurt Koenig
Date	10/08/2014

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

In the matter of Application Serial No. 85817997
For the mark: BONES MC BONES MC EST 1968
Filing Date: January 8, 2013
Publication Date: June 10, 2014

GEORGE A. POWELL,)	
)	
OPPOSER,)	NOTICE OF OPPOSITION
)	
v.)	
)	
)	
WAYNE D. DEVOGLER,)	
)	
APPLICANT.)	
)	

NOTICE OF OPPOSITION

In the matter of the application of WAYNE D. DEVOGLER, an individual citizen of the United States, having an address of 211 S. State College #228, Anaheim, CA 92806, (hereinafter "Applicant"), for registration of the trademark BONES MC BONES MC EST 1968 ("Applicant's Mark"), as set forth in Application Serial No. 85817997, published in the *Official Gazette* of June 10, 2014, George A. Powell, an individual citizen of the United States of America having an address of 30 South La Patera Lane, Santa Barbara, California 93117 (hereinafter "Opposer"), believes he will be damaged by Applicant's Mark and hereby opposes the same.

The grounds for opposition are as follows:

1. Opposer, through his related companies and licensees, for many years and long prior to any date of first use upon which Applicant can rely, has continuously used, licensed, manufactured, sold, distributed, and advertised in interstate commerce in conjunction with the mark BONES and marks incorporating the word BONES, for various goods and services, including an organization of skateboarding enthusiasts, apparel, streetwear, boardwear, skateboards, action sports apparel, sporting goods, and related accessories, in Classes 200, 25 and 28, respectively.

2. Opposer is the owner of common law rights and at least fifteen (15) valid and subsisting United States trademark registrations, covering a variety of goods and services, for the mark BONES, which mark is used alone and in combination with other words and/or designs (collectively "Opposer's Marks") as shown in the following trademark registrations:

<u>MARK</u>	<u>CLASS</u>	<u>GOODS/SERVICES</u>	<u>REG. NO.</u>	<u>REG. DATE</u>
BONES	28	Wheels for sporting articles - namely, wheels for skateboards.	1091899	05/23/1978
	28	Sporting goods, namely skate boards and parts therefore; and wheels for roller skates.	1501450	08/23/1988
	25	Promotional clothing, namely sweatshirts and t-shirts.	1559066	10/03/1989

BONES BRIGADE	200	Indicating membership in an organization of skateboarding enthusiasts.	1695119	06/16/1992
BONES BRIGADE	41	Entertainment services; namely, conducting professional skateboarding team competitions and exhibitions.	1705475	08/04/1992
HARDCORE BONES	28	Sporting goods, namely skateboards and parts therefore, skateboard wheels, and wheel bushings.	2553383	03/23/2002
BONES	25	Clothing, namely, hats, shirts, jackets, sweat shirts and belts	3061458	2/28/2006
BONES & Design 	28	Skateboard wheels, Skateboard bushings, Skateboard riser pads, Skateboard wax, Skateboard grip tapes, Skateboard hardware, namely, nuts and bolts for skateboards	3810594	6/29/2010
BONES & Design 	25	Baseball caps; Caps; Hats; Headgear, namely, baseball caps, beanies, and caps; Headwear; Shirts; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sweat shirts; T-shirts; Tops; Wearable garments and clothing, namely, shirts	3810792	6/29/2010

ROLLER BONES	28	Roller Skate Wheels	3584070	3/3/2009
RAT BONES	28	Sporting goods, namely, skateboard wheels, skateboard wheel assemblies and parts and fittings for any thereof;	3633328	6/2/2009
BONES REDS	28	Ball bearings for skateboards; Nuts and bolts for skateboards; Skateboard wheels	3735248	1/5/2010
RAT BONES	25	Clothing, namely, active wear, sportswear, skate wear, and other clothing for sports, namely, T-shirts, shirts, tops, shorts, sweatshirts, belts, hats, headgear, namely, visors, baseball caps, beanies, bonnets, headbands, and caps, headwear,	3905805	01/11/2011
	25,28	Class 25: clothing, namely, sweatshirts, T- shirts and caps Class 28: sporting goods, namely, skateboards and parts thereof, and wheels for skateboards	2057174	4/29/1997





25,28 Class 3603333 4/7/2009
25: Clothing,
namely,
activewear,
sportswear,
skatewear, and
other clothing
for sports,
namely, T-shirts,
shirts, socks,
sweatshirts,
tops, hats,
headgear, namely,
baseball caps,
beanies, and
caps, headwear;
Class 28:
Sporting goods,
namely,
skateboards,
skateboard decks,
skateboard
wheels,
skateboard wheel
assemblies and
replacement parts
and fittings,
namely, bearings,
bushings; ball
bearings for
skateboards

Each of Opposer's Marks is valid and subsisting and constitute *prima facie* and/or conclusive evidence of Opposer's ownership of the family of BONES marks and the exclusive right to use Opposer's Marks on the goods and services identified in the registrations. Furthermore, several of the above-noted registered Marks are incontestable under 15 U.S.C. §1065. Because Opposer's Marks are arbitrary and strong and further because Opposer has used the mark BONES BRIGADE continuously since 1981 in connection to indicate membership an organization

of skateboarding enthusiasts in Class 200 and the mark BONES for clothing and apparel in Class 25 long before the filing date for Applicant's Mark or any use that may be asserted for Applicant's Mark on clothing or sporting goods, Opposer is entitled to protection of his distinctive marks.

3. Opposer, through long use of the BONES trademark and substantial advertising and promotion, has developed valuable goodwill in connection with Opposer's Marks. Opposer's membership services, apparel soft goods and skateboard and licensed hard goods have been offered and advertised continuously to the public throughout the United States through various channels of trade, including bike shops, sporting good stores, skate shops, motorcycle affiliated stores, and action sports stores in conjunction with Opposer's Marks since at least as early as June 1977. By reason of such advertising and wide distribution of Opposer's goods and services, the public recognizes the mark BONES as solely signifying such goods and services as emanating from Opposer.

4. Opposer uses the word BONES in conjunction with clothing and skateboard goods which are sold in surf shops, skateboard shops, motorcycle shops, and sporting goods stores which sell to customers that include motorcyclists, snowboarders, skateboarders, paddleboarders, kayakers, and surfers.

5. Opposer also uses the word BONES in conjunction with various "bones design" marks, with such designs appearing with the word BONES to create a visual image in the mind of the consumer of the term "BONES" and Opposer is widely known for the goods sold under such BONES & Design marks.

6. Notwithstanding Opposer's exclusive prior rights in and to the trademarks incorporating the term BONES, Applicant, on January 8, 2013, filed an application to register the trademark BONES and other indicia in a stylized form with a black rectangular box design, in Class 200 for "*Indicating membership in a brotherhood motorcycle club for the purpose of promoting the interests of motorcycle owners, motorcycling, and activities for motorcycle riders and enthusiasts.*" Said application was assigned Serial No. 85817997 and the mark was published for opposition in the *Official Gazette* of June 10, 2014. The application displays the word "BONES MC BONES MC EST 1968" in a stylized format with a design as follows:



7. The mark BONES MC BONES MC EST 1968, which Applicant seeks to register, is confusingly similar in sound, appearance, and connotation to Opposer's Marks.

8. Applicant seeks to register Applicant's Mark for goods that are closely related to the goods of Opposer. The use of the word BONES is likely to be confused with the goods sold by Opposer bearing the trademark BONES and his BONES & Design marks.

9. While Applicant has applied as a collective mark in Class 200, Applicant's specimens show that the word BONES appears prominently on clothing goods and are imprinted or emblazoned on jackets, shirts and hats. Therefore, it is obvious that Applicant's clothing goods are being provided to the exact same class of consumers and through the same channels of trade and distribution as Opposer's clothing goods. The proposed use of the Applicant's Mark is closely related to Opposer's use of BONES on membership services and also on clothing and apparel. Potential purchasers of Applicant's clothing and apparel goods would be potential purchasers of Opposer's clothing goods and are all likely to be sold in the same retail stores and channels of trade.

10. Opposer's Marks are famous throughout the entire action sport and board sports industry and in other areas, including among motorcycle enthusiasts.

11. Applicant's Mark, so resembles Opposer's Marks that the registration of Applicant's Mark and any use by Applicant of Applicant's Mark is likely, when applied to the goods identified in Applicant's application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, all to Opposer's damage.

12. Opposer's Marks became famous before the filing date of App. Ser. No. 85817997 and have strong and distinctive character qualifying them for protection under Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c), as amended.

13. Application Ser. No. 85817997 was filed on January 8, 2013 and therefore is subject to the provisions of Section 43(c) of the Lanham Act, as amended.

14. Opposer believes that the registration of Applicant's Mark in Class 200 will cause dilution of the distinctive quality of Opposer's Marks and seriously and substantially damage Opposer in violation of Section 43(c) of the Lanham Act, as amended.

15. Although the application filed by Applicant under oath asserts that Applicant has used Applicant's Mark in commerce in connection with "*Indicating membership in a brotherhood motorcycle club for the purpose of promoting the interests of motorcycle owners, motorcycling, and activities for motorcycle riders and enthusiasts*" in Class 200, Applicant has in fact had no actual use Applicant's Mark in commerce in connection with

any of the services listed in the Application. Instead, Applicant's Mark has simply been placed on clothing goods.

16. Applicant had not actually used the BONES MC BONES MC EST 1968 mark in commerce as of the date stated in the application for all of the goods specified in Application Serial No. 85817997 and said date of first use was in fact false.

WHEREFORE, Opposer believes he will be damaged by said registration and requests that Application Ser. No. 85817997 for the mark BONES & indicia be denied on the grounds set forth herein and that this Opposition be sustained.

This Notice of Opposition is submitted with the required filing fee of \$300.

Respectfully submitted,

Dated: October 8, 2014

By:


Kurt Koehnig
920 Garden St., Suite A
Santa Barbara, CA 93101
Tel: 805-965-4400

Attorney for Opposer

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office via ESTTA with the required fees on the date identified below.

Dated: October 8, 2014



Kurt Koenig

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing "NOTICE OF OPPOSITION" was served on **October 8, 2014** by email and by first-class mail, postage prepaid, to Applicant addressed as follows:

Wayne D. Devogler
211 S. State College Blvd., #228
Anaheim, CA 92806-4116

Dated: October 8, 2014



Kurt Koenig
