

ESTTA Tracking number: **ESTTA715125**

Filing date: **12/16/2015**

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	Whitehardt, Inc.
Granted to Date of previous extension	12/16/2015
Address	45 Music Square West Nashville, TN 37203 UNITED STATES

Attorney information	Phillip E. Walker 1600 Division Street, Suite 700 Nashville, TN 37203 UNITED STATES pwalker@babco.com Phone:615-252-2389
----------------------	--

Applicant Information

Application No	86568706	Publication date	08/18/2015
Opposition Filing Date	12/16/2015	Opposition Period Ends	12/16/2015
Applicant	Gordon McKernan Injury Attorneys, Limited Liability Company 5630 Bankers Avenue Baton Rouge, LA 70808 UNITED STATES		

Goods/Services Affected by Opposition

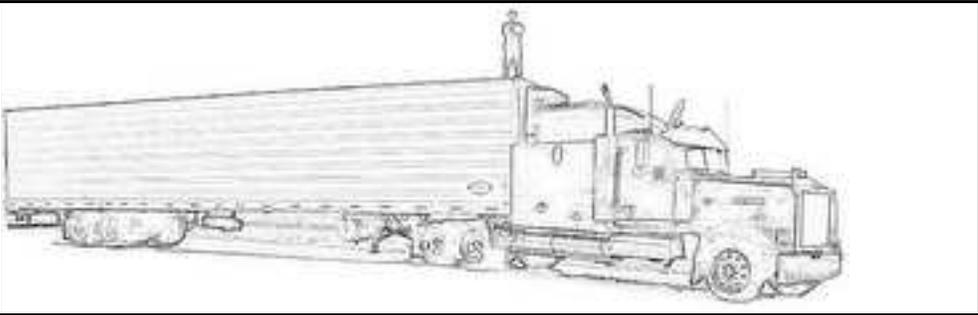
Class 045. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Legal services

Grounds for Opposition

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)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86633231	Application Date	05/18/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	The mark consists of a man standing on a semi-tractor-trailer.
Goods/Services	Class 045. First use: First Use: 2010/04/05 First Use In Commerce: 2010/04/05 Legal services

Related Proceedings	U.S. Federal Court in the Middle District of Tennessee as case number 3:15-CV-01307 entitled Whitehardt, Inc. v. McKernan et al. filed on November 20, 2015
---------------------	---

Attachments	86633231#TMSN.png(bytes) WHvMcKernan-TM_Opposition_re_86568706_LOTH_line_drawing.pdf(50740 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 First Class Mail on this date.

Signature	/Phillip E. Walker/
Name	Phillip E. Walker
Date	12/16/2015

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

In the Matter of Application Serial No. 86/568,706 for a “stylized line drawing of a man standing on top of a semi-truck trailer” as published in the *Official Gazette* on August 18, 2015 at TM 2942;

WHITEHARDT, INC)	
)	
Opposer,)	
)	
v.)	Opposition No.:
)	
)	
GORDON MCKERNAN)	
INJURY ATTORNEYS LLC,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

This Notice of Opposition is brought by Whitehardt, Inc., a Tennessee corporation (“Opposer”) in the pending trademark application Serial No. 86/568,706 filed by Gordon McKernan Injury Attorneys, LLC (“Applicant”) for the design mark of a “stylized line drawing of a man standing on the hood of a semi-truck”, for goods identified in the Application as, “Legal services,” in International Class 45. This opposition is brought pursuant to 15 USC § 1063(a); 37 CFR § 2.101; and TBMP § 102.02. The Applicant’s mark was published for opposition in the *Official Gazette* on August 18, 2015. Opposer believes it will be damaged by the registration or extension of protection of this trademark and hereby opposes registration of the same. Accordingly, Opposer alleges as follows:

1. Opposer is a Tennessee corporation having its principal place of business at 45 Music Square West, Nashville, Tennessee 37203.
2. Opposer currently is and has been in the business as a full-service advertising and consulting agency specializing in law firm advertisements in interstate commerce in the United States.

3. Opposer creates compelling, direct response branding and public service television advertisements that motivate potential clients to call and sign up with the attorney that the Opposer makes the subject of the advertisement.

4. Opposer strategically focuses an attorney's advertising dollars through expert media planning and negotiation, online and offline campaigns, and constant analysis, tracking and reporting.

5. Opposer has clients in various jurisdictions that use Opposer's services, wherein those clients maintain their activity within that jurisdiction.

6. Opposer owns numerous trademarks, including U.S. Trademark Registration numbers 4,193,711, 3,886,100, 3,471,956, and 3,538,353, all for "Legal services" in International Class 045.

7. Opposer owns numerous copyright registrations, including Registration numbers PA 1-942-166, PA 1-942-163, PA 1-942-165, PA 1-942-164, PA 1-947-877, PA 1-943-304, PA 1-943-356, PA 1-943-357, and PA 1-943-359 (collectively the LOTT Copyrighted Works).

8. Opposer is also in the business of licensing its intellectual property to attorneys for use within certain jurisdictions as part of advertising directed to motivate potential clients to call and sign up with the attorney that the Opposer makes the subject of the advertising.

9. Opposer is the owner of the Application Serial No. 86/633,231 (Opposer's '231 Application) that is currently pending for the design mark of "a man standing on a semi-tractor-trailer" for "Legal services" in International Class 045. The Opposer's '231 Application claims a first use date of April 5, 2010.

10. The brand equity and residual goodwill in the mark as seen in Opposer's '231 Application rightfully belongs to Opposer.

11. Applicant's current Application Serial No. 86/568,706 (Applicant's '706 Application) is an intent-to-use application filed on March 18, 2015 and has no use date on file at the Trademark Office.

12. The Examiner in Opposer's '231 Application cited Applicant's '706 Application in the refusal to register Opposer's '231 Application.

13. The first use date of April 5, 2010 claimed in Opposer's '231 Application predates the filing date of March 18, 2015 of Applicant's '706 Application.

14. According to the Examiner of the Opposer's '231 Application, if "the marks in the (Applicant's '706 Application) register, (Opposer's) mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion with the registered mark(s)."

15. Opposer's '231 Application has as the "Description of Mark" as "a man standing on a semi-tractor-trailer". Applicant's '706 Application has as the "Description of Mark" as a "stylized line drawing of a man standing on the hood of a semi-truck". Both marks actually picture a man standing on the top of semi-tractor-trailer type vehicle.

16. Additionally, both the Opposer's '231 Application and the Applicant's '706 Application list identical goods – legal services.

17. Because the goods for both marks are identical, the Opposer's services and the Applicant's services could have overlapping channels of trade and a similar class of customers.

18. Applicant's mark should be refused registration based on the earlier priority of Opposer's mark, identical services associated with Applicant's mark and Opposer's mark, and the likelihood of confusion with Opposer's mark.

19. If the Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration

would be a source of damage and injury to the Opposer. Opposer's marks and property will be harmed by Applicant's registration of the design mark identified in Serial No. 86/568,706.

20. Applicant, by way of Applicant's representative Pam Jones, Marketing Director, made the following declaration with the filing of Applicant's '706 Application:

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

21. At least as of September 17, 2013, Applicant was aware that Opposer utilized the LOTT Copyrighted Works and associated LOTT advertising campaign with other personal injury lawyers in additional jurisdictions, including but not limited to Ken Nugent in Atlanta, Georgia.

22. Applicant's drawing of the mark contained in Applicant's '706 Application is a derivative of the Opposer's LOTT Copyrighted Works.

23. Applicant, by way of Applicant's representative, made a false declaration in connection with Applicant's '706 Application by declaring that "no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive."

24. Applicant, by way of Applicant's representative, made a false declaration in connection with Applicant's '706 Application by declaring that "the applicant is entitled to use the mark in commerce."

25. Applicant had knowledge or belief that such declarations were false when signing Applicant's '706 Application.

26. Applicant had knowledge that others had rights superior to the Applicant's, had knowledge that their applications were likely to cause confusion, and filed Applicant's '706 Application under false pretenses based upon this knowledge.

27. If the Applicant were granted the registration herein opposed, that registration would be 1) based upon a false declaration, 2) in spite of the fact that others had rights superior to the Applicant's, 3) in spite of the fact that Applicant had knowledge that Applicant's application was likely to cause confusion, or/and 4) in spite of the fact that Applicant filed

Applicant's '706 Application under false pretenses based upon that knowledge. The integrity of the registration process will be harmed by Applicant's registration of the design mark identified in Serial No. 86/568,706.

28. Applicant is also the listed owner of U.S. Registration Nos. 4,681,608 and 4,525,497 (Applicant's Registrations).

29. The Examiner also cited Applicant's Registrations in the refusal to register Opposer's '231 Application.

30. Opposer filed a civil action in U.S. Federal Court in the Middle District of Tennessee as case number 3:15-CV-01307 entitled Whitehardt, Inc. v. McKernan et al. on November 20, 2015 (the Federal Case).

31. As part of the relief sought in the Federal Case, Opposer seeks cancelation of Applicant's Registrations. As such, Opposer seeks to remove all impediments to the registration of Opposer's '231 Application.

32. Opposer reserves the right to amend this Notice of Opposition upon further investigation and discovery.

WHEREFORE, Opposer respectfully requests that this opposition be sustained, and the registration of Application Serial No. 86/568,706 for the design mark sought by Applicant be refused.

Because the Application is in one (1) International Class and there is a total of one Opposer, a total fee of \$300.00 under 37 CFR § 2.6(a)(17) is enclosed. The Commissioner is authorized to charge any further fees required to Deposit Account Number 50-4293, in the name of Bradley Arant Boult Cummings LLP.

Respectfully submitted,



Phillip E. Walker (Tennessee BPR No. 21739)
BRADLEY ARANT BOULT CUMMINGS, LLP
1600 Division Street, Suite 700
Nashville, TN 37203
615-252-2389 (phone)
615-252-3019 (fax)

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on December 16, 2015, I caused the foregoing **NOTICE OF OPPOSITION** to be served by United States mail, postage prepaid, in an envelope addressed to:

Attorney of record in the Trademark Office files:

Robert C. Tucker
Jones Walker LLP
8555 United Plaza Blvd Fl 5
Baton Rouge, Louisiana 70809-2260

And by email to:

Correspondent e-mail in the Trademark Office files:

jwtrademarks@joneswalker.com

Robert C. Tucker Attorney of record Jones Walker LLP:

rtucker@joneswalker.com

Bernard F. Meroney Attorney of in the pending litigation Jones Walker LLP:

bmeroney@joneswalker.com

By: _____



Phillip E. Walker