

ESTTA Tracking number: **ESTTA769552**

Filing date: **09/08/2016**

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	CTI SERVICES,LLC
Granted to Date of previous extension	09/10/2016
Address	6430 S. 39 W. AVE Tulsa, OK 74132 UNITED STATES

Attorney information	Rachel Blue McAfee & Taft 2 W. 2nd St.Suite 1100 Tulsa, OK 74103 UNITED STATES rachel.blue@mcafeetaft.com, keli.ewing@mcafeetaft.com, ipdock- et@mcafeetaft.com Phone:918-574-3007
----------------------	--

Applicant Information

Application No	86567083	Publication date	07/12/2016
Opposition Filing Date	09/08/2016	Opposition Period Ends	09/10/2016
Applicant	Black Diamond Structures, LLC 12310 Trail Driver Austin, TX 78737 UNITED STATES		

Goods/Services Affected by Opposition

Class 001. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Carbon nanoparticles, namely, carbon particles of nanoscale dimensions, used inthe production of materials for the energy storage, energy generation, automotive, consumer electronics and construction industries
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: design and development of materials containing carbon nanoparticles for production of energy storage devices, capacitors, industrial coatings, and composites

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
--------------------------------------	----------------------------

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3322311	Application Date	09/28/2006
-----------------------	---------	------------------	------------

Registration Date	10/30/2007	Foreign Priority Date	NONE
Word Mark	BLACK DIAMOND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 2004/07/06 First Use In Commerce: 2004/07/06 Epoxy filler material for repairing pipelines internally or externally Class 019. First use: First Use: 2004/07/06 First Use In Commerce: 2004/07/06 Carbon composite wrap material for repairing pipelines internally or externally		

Attachments	77009563#TMSN.png(bytes) 17878645_1.pdf(85303 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	/rachelblue/
Name	Rachel Blue
Date	09/08/2016

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

In re United States Application No. 86567083
Filing Date: March 17, 2015
Mark: BLACK DIAMOND STRUCTURES
Published in the Official Gazette on July 12, 2016

CTI Services, L.L.C.,)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
Black Diamond Structures, LLC)	
Applicant.)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

CTI Services, LLC (“CTI”) hereby opposes registration of the mark of United States Trademark Application Serial No. 86/567,083 (the “Opposed Application”), which was filed by BLACK DIAMOND STRUCTURES, LLC, in International Classes 001 and 042, on March 17, 2015. CTI’s grounds for opposition are as follows:

1. CTI Services, LLC. is an Oklahoma limited liability company with a principal place of business at 6430 S. 39 W. Ave Tulsa, Oklahoma 74132.

2. As listed in the Opposed Application, BLACK DIAMOND STRUCTURES, LLC (“Applicant”) is a Delaware limited liability company with a principal place of business at 12310 Trail Driver, Austin, Texas 78737.

3. Applicant seeks to register the mark “BLACK DIAMOND STRUCTURES” on the Principal Register for:

Carbon nanoparticles, namely, carbon particles of nanoscale dimensions, used in the production of materials for the energy storage, energy generation, automotive, consumer electronics and construction industries in Class 001

and

Design and development of materials containing carbon nanoparticles for production of energy storage devices, capacitors, industrial coatings, and composites in Class 42.

4. The Opposed Application was filed on March 17, 2015.

5. The Opposed Application published for opposition on July 12, 2016.

6. CTI Services, LLC offers epoxy filler material for repairing pipelines and other structures and carbon composite wrap material for repairing pipelines and structures under the name BLACK DIAMOND.

7. At least as early as 2004, CTI's predecessor in interest began using the mark BLACK DIAMOND in interstate commerce.

8. The BLACK DIAMOND mark has been continuously used in interstate commerce in connection with these goods since that time.

9. On October 3, 2006, CTI's predecessor in interest Roger Walker filed United States Trademark Application Serial No. 77/009,563 to register the mark BLACK DIAMOND in the United States Patent & Trademark Office ("USPTO").

10. On October 30, 2007, the USPTO issued United States Registration Number 3,322,311 for the mark BLACK DIAMOND on the Principal Register. A copy of that registration is attached hereto as Exhibit A and incorporated herein.

11. On October 30, 2013, affidavits of continued use and incontestability were filed in connection with Registration No. 3,322,311.

12. On November 16, 2013, the affidavits of continued use and incontestability were accepted by the USPTO.

13. CTI has expended a great deal of effort and money to market and promote its goods associated with the BLACK DIAMOND mark. By carefully controlling the quality of the

goods and services, CTI has built up an excellent reputation and valuable goodwill in association with the BLACK DIAMOND mark.

14. The goods and services identified in the Opposed Application directly overlap and/or are confusingly similar to the goods and services sold by CTI in association with the BLACK DIAMOND mark and covered by CTI's registration therefor.

15. The Opposed Mark is virtually identical to the BLACK DIAMOND mark in appearance, sound, connotation and commercial impression, differing only by the addition of the disclaimed term STRUCTURES.

16. CTI's rights, to the BLACK DIAMOND mark, through its predecessor in interest, date back to at least as early as 2004.

17. USPTO records indicate that the Applicant's earliest possible constructive use of the mark was on March 17, 2015, the date of priority claimed in the Applicant's 1(b) application filed on that date.

18. CTI thus has priority of use.

19. If Applicant is allowed to register the Opposed Mark, it will obtain statutory rights to the mark that will conflict with and substantially degrade CTI's rights in its above-mentioned and attached registration, as well as CTI's superior common law rights to the BLACK DIAMOND mark.

20. CTI's goodwill and reputation will be jeopardized by Applicant's registration of the Opposed Mark due to CTI's lack of control over the quality of Applicant's goods and services.

21. Concurrent use and/or registration of the Opposed Mark and CTI's BLACK DIAMOND mark is likely to cause confusion and lead to deception as to the origin of the goods

that are associated with the Opposed Mark. Concurrent use and/or registration of the Opposed Mark and CTI's BLACK DIAMOND mark would allow Applicant to be unjustly enriched by, and reap the benefit of, the goodwill and reputation that CTI has developed in association with the BLACK DIAMOND mark. Accordingly, registration of the Opposed Mark will be a source of damage and injury to CTI.

WHEREFORE, CTI prays that the Opposed Application be refused and that this Opposition be sustained and any other and further relief as is deemed just and proper.

Respectfully submitted,



Rachel Blue
McAFEE & TAFT A PROFESSIONAL
CORPORATION
Williams Center Tower II
2 West 2nd Street, Suite 1100
Tulsa, Oklahoma 74119
Phone: 918-574-3007
Fax: 918-574-3107
<mailto:rachel.blue@mcafeetaft.com>
Attorneys for Opposer

CERTIFICATE OF MAILING

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on Applicant by mailing said copy this 8th day of September, 2016, via first class, certified mail, return receipt requested, to:

Daniel P. Mullarkey
Polsinelli PC
1401 Eye Street, NW, Suite 800
Washington, DC 20005

I further hereby certify that true and complete copy of the foregoing NOTICE OF OPPOSITION was transmitted electronically to the Commissioner for Trademarks at <http://estta.uspto.gov/filing-type.jsp>.



Rachel Blue