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

Proceeding	92052394
Party	Plaintiff Under Armour, Inc.
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Date	07/21/2010
Attachments	92052394 COMBINE First Amended Petition to Cancel.pdf (10 pages)(868549 bytes)

4. Under Armour has many high-profile sponsorships, including its official sponsorship of the “NFL Scouting Combine”—a week-long showcase where college football players perform physical and mental tests in front of NFL coaches, general managers, and scouts.

5. Under Armour also offers its own “Under Armour Combine” in various cities where junior athletes can get tested, scored, and receive instruction in a variety of sports, including football, softball, baseball, lacrosse, basketball, golf, tennis, and soccer.

6. As part of its activities, Under Armour has offered and sold a shoe under the names UA COMBINE II SHOE, UA PROTO COMBINE, UNDER ARMOUR PROTO COMBINE, and UA COMBINE II—developed specifically for the athletes at the NFL Combine, created with ultra-lightweight materials and a multi-directional traction system.

Williams and His Registration

7. Registrant Emory L. Williams is an individual with an address at 11261 Douglas Drive, Miami, Florida 33176.

8. On August 10, 2009, Williams wrote to Under Armour following up on an alleged prior request for a “meeting to discuss a proposed joint venture between Under Armour and [his company] the Combine Nation.” In that letter, Williams contended that he owned several registrations for the COMBINE mark and objected to Under Armour’s use of “Combine” in connection with a sports shoe. Williams also stated “we have our own ‘Combine’ shoe which we ***will be launching*** soon (please visit our site, the shoe is listed under Combine Runner @ www.thecnation.com)” (emphasis added).

9. On September 2, 2009, Williams filed Trademark Application Serial No. 77818521 for the mark COMBINE for “Athletic shoes; Baseball shoes; Football shoes; Golf shoes; Gymnastic shoes; Hockey shoes; Insoles; Leather shoes; Rugby shoes; Running shoes;

Soccer shoes; Tennis shoes; Track and field shoes; Training shoes; Volleyball shoes”
(capitalization in filing), alleging a first-use date of November 25, 2002.

10. Under Armour responded to Williams’ letter on September 4, 2009, explaining that it “is not interested in pursuing a joint venture with your company and does not believe that its footwear infringes upon any trademark rights that you or your company may have.”

11. Williams replied to Under Armour on September 16, 2009, representing that “I have no intent on taking this matter any further,” and that “just like you, I will consider this matter closed.” Williams explained further, that “[s]ince my initial communication with you, I have decided to stay in an area where we have background which is in the drink industry,” “I also own trademark rights to ‘Combine Sports Drink,’” and “[t]he product was supposed to have been launched last month, but with many distractions in other areas we fell behind.”

12. Despite Williams’ promise not to pursue the matter, Under Armour received a letter from his counsel six months later on March 29, 2010 threatening to file suit based on, among other things, Williams’ alleged ownership of pending Application Serial No. 77818521.

13. On April 27, 2010, Williams’ Application Serial No. 77818521 registered under Registration No. 3780641.

14. Williams hosts a website, located at www.thecnation.com, which has explained his company’s history, vision, and product offerings. Specifically the site has contained, among other things, a company overview (www.combineathletics.citymax.com/overview1.html), a discussion of licensing “opportunities” (www.combineathletics.citymax.com/comb3.html), a link to relevant “media” (www.combineathletics.citymax.com/press.html), and the products offered under the alleged “Combine” mark.

15. Williams has used the term “combine” generically to refer to a type of athletic event on his website. Specifically, he has stated, among other things:

“Today, there are athletic combines held in all major sports which include but are not limited to Football, Basketball, Baseball, Soccer, Ice and Field Hockey, Volleyball, Ruby [sic] and Even College Golf.”

“An Athletic Combine is the ultimate in the category of athletic competition camps and always will be.”

“Attention all high school football athletes!!! We will post information on our first football combine here in Miami! We will promise a great one!”

16. Williams has explained further on his website that his “Combine” products are intended to be used in connection with combines. Specifically, Williams has stated:

“Today, Combines and other related athletic camps are being held for athletes as young as 8 years old for boys and girls in all sports. This creates a need and want for Combine athletic wear and accessories (performance shoes, shirts, compression shirts, athletic bags, caps, gloves etc.) for these individuals, expanding the sportswear market. We believe in giving these people what they need. Combine Performance wear and Pro Day Performance wearstart them off on the right foot.”

17. The “Combine” products identified on Williams’ website consist of the following: a sports drink (www.combineathletics.citymax.com/page/page/4578574.htm), a running shoe (www.combineathletics.citymax.com/shoegear.html), skull caps (www.combineathletics.citymax.com/combine6.html), sports caps (www.combineathletics.citymax.com/combine6.html), compression shirts (www.combineathletics.citymax.com/combine6.html), and a few sports balls (www.combineathletics.citymax.com/balls.html).

18. Williams’ website does not offer or depict the following products under the alleged “Combine” mark: baseball shoes, football shoes, gymnastics shoes, hockey shoes,

insoles, leather shoes, rugby shoes, soccer shoes, tennis shoes, track and field shoes, or volleyball shoes.

19. Williams has mentioned golf shoes on his site, but does not offer or depict that product under the alleged “Combine” mark. (See www.combineathletics.citymax.com/combine4.html.)

Under Armour’s Trademark Applications

20. Under Armour owns Trademark Application No. 77723751 for the mark UNDER ARMOUR COMBINES for “Athletic testing, namely, testing the physical performance of athletes for sports training purposes; athletic scoring, namely, scoring the results of measured athletic performance for sports training purposes; athletic training and instruction in the field of sports.” Upon examining the application, the PTO required Under Armour to disclaim the exclusive rights to the term “Combines” because “the word ‘combine’ is a term of art in the sports field and refers to athletic workouts/tryouts to determine suitability and skill levels for playing sports.” Under Armour disclaimed the word “Combines” and the PTO approved the application.

21. Under Armour owns Trademark Application No. 77723781 for the mark  **COMBINES** for “Athletic testing, namely, testing the physical performance of athletes for sports training purposes; athletic scoring, namely, scoring the results of measured athletic performance for sports training purposes; athletic training and instruction in the field of sports.” Upon examining the application, the PTO required Under Armour to disclaim the exclusive rights to the term “Combines” because “the word ‘combine’ is a term of art in the sports field and refers to athletic workouts/tryouts to determine suitability and skill levels for playing sports.” Under Armour disclaimed the word “Combines” and the PTO approved the application.

22. Under Armour owns Trademark Application No. 85027512 for the mark UNDER ARMOUR COMBINE for “Clothing, namely, shirts, t-shirts, and shorts, all used in connection with combine training and combine events; footwear used in connection with combine training and combine events.” Under Armour voluntarily disclaimed the exclusive rights to the word “Combine” and the PTO approved the application.

COUNT I: FRAUD ON THE PTO

23. Under Armour repeats and realleges each and every allegation set forth in Paragraphs 1 through 22.

24. When Williams filed his use-based application Serial No. 77818521 on September 2, 2009, he represented that he (or a related company or licensee) was using the alleged “Combine” mark in commerce on or in connection with the following goods: “Athletic shoes; Baseball shoes; Football shoes; Golf shoes; Gymnastic shoes; Hockey shoes; Insoles; Leather shoes; Rugby shoes; Running shoes; Soccer shoes; Tennis shoes; Track and field shoes; Training shoes; Volleyball shoes” (the “Application”).

25. When Williams filed the Application on September 2, 2009, he represented that the alleged “Combine” mark was first used in Class 25 since at least as early as November 25, 2002.

26. When Williams filed the Application on September 2, 2009, he signed a declaration in support of the Application stating:

The undersigned, being hereby warned that willful false statements and the like so made 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 resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the

application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

27. At the time Williams signed and filed the Application and supporting declaration before the PTO, he did not use the alleged "Combine" mark in commerce in connection with the following goods: baseball shoes, football shoes, golf shoes, gymnastics shoes, hockey shoes, insoles, leather shoes, rugby shoes, soccer shoes, tennis shoes, track and field shoes, or volleyball shoes.

28. Williams has never used the alleged "Combine" mark in commerce in connection with the following goods: baseball shoes, football shoes, golf shoes, gymnastics shoes, hockey shoes, insoles, leather shoes, rugby shoes, soccer shoes, tennis shoes, track and field shoes, or volleyball shoes.

29. Williams did not use the alleged "Combine" mark in commerce in connection with the following goods as of the stated November 25, 2002 first-use date: athletic shoes, baseball shoes, football shoes, golf shoes, gymnastic shoes, hockey shoes, insoles, leather shoes, rugby shoes, running shoes, soccer shoes, tennis shoes, track and field shoes, training shoes, or volleyball shoes.

30. At the time Williams signed and filed the Application and supporting declaration before the PTO, he knew that he was not using the alleged "Combine" mark in commerce in connection with the following goods: baseball shoes, football shoes, golf shoes, gymnastics

shoes, hockey shoes, insoles, leather shoes, rugby shoes, soccer shoes, tennis shoes, track and field shoes, or volleyball shoes.

31. At the time Williams signed and filed the Application and supporting declaration before the PTO, he knew that he had not used the alleged “Combine” mark in commerce in connection with the following goods since at least as early as November 25, 2002: athletic shoes, baseball shoes, football shoes, golf shoes, gymnastics shoes, hockey shoes, insoles, leather shoes, rugby shoes, running shoes, soccer shoes, tennis shoes, track and field shoes, or volleyball shoes.

32. The PTO accepted and relied on the statements in the Application and supporting declaration in approving the Application for publication and issuing Registration No. 3780641 on April 27, 2010. But for Williams’ material, false statements concerning use of his alleged mark in connection with the goods identified in the Application, the PTO would not have issued the registration.

33. On information and belief, Williams, in failing to disclose the foregoing facts to the PTO, acted in a reckless disregard of the truth with an intent to procure a registration to which he was not entitled, and thus committed fraud on the PTO.

COUNT II: ABANDONMENT

34. Under Armour repeats and realleges each and every allegation set forth in Paragraphs 1 through 33.

35. Williams does not now and has never used the alleged “Combine” mark in commerce in connection with the following goods: baseball shoes, football shoes, gymnastics shoes, hockey shoes, insoles, leather shoes, rugby shoes, soccer shoes, tennis shoes, track and field shoes, or volleyball shoes.

36. Accordingly, Williams has abandoned the mark for one or more of the goods set forth above based upon non-use of the mark for three consecutive years with an intent not to resume such use.

COUNT III: MERE DESCRIPTIVENESS

37. Under Armour repeats and realleges each and every allegation set forth in Paragraphs 1 through 36.

38. The word "Combine," as shown in Application Serial No. 77641028, is merely descriptive of the goods identified in that application.

39. Accordingly, registration should be refused under Section 2(e)(1) of the Lanham Act, as amended, 15 U.S.C. § 1052.

WHEREFORE, Under Armour believes that it is being and will be damaged by the continued registration of the COMBINE mark, and respectfully requests that the Petition to Cancel be sustained and that Registration No. 3780641 be cancelled.

A filing fee has been submitted herewith. If the filing fee is found to be insufficient for any reason, please charge such deficiency to our Deposit Account No. 06-0916.

Dated: July 21, 2010

By: /Danny M. Awdeh/

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing FIRST AMENDED PETITION TO CANCEL was served on July 21, 2010 by first-class mail, postage prepaid, to Emory L. Williams at the following addresses of record:

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