

ESTTA Tracking number: **ESTTA455906**

Filing date: **02/10/2012**

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

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	AMERICAN MOTORCYCLIST ASSOCIATION		
Entity	Corporation	Citizenship	Ohio
Address	13515 Yarmouth Dr Pickerington, OH 43147 UNITED STATES		

Attorney information	Jeffrey S. Standley, Stephen L. Grant Standley Law Group LLP 6300 Riverside Dr Dublin, OH 43017 UNITED STATES jstandley@standleyllp.com, standleydocketing@standleyllp.com Phone:614-792-5555
----------------------	---

**Registration Subject to Cancellation**

Registration No	3208173	Registration date	02/13/2007
Registrant	Racer Productions, Inc. 122 Vista Del Rio Morgantown, WV 26508 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 041. First Use: 1995/03/06 First Use In Commerce: 1995/03/06 All goods and services in the class are cancelled, namely: Organizing and conducting athletic competitions, sports, exhibitions, entertainment events and contests involving motor vehicles, motorcycles and ATV's in the nature of jumps, races, exhibitions and skills-based events; Entertainment services, namely providing television programs, cable television programs, video and still photo exhibitions and webcast television and video programs via a global computer network, all in the field of the foregoing sports entertainment events
---

**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

**Marks Cited by Petitioner as Basis for Cancellation**

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	GRAND NATIONAL		

Goods/Services	conducting, organizing, sanctioning, officiating, and making rules for motorcycle racing competitions		
----------------	---	--	--

U.S. Application/ Registration No.	NONE	Application Date	NONE
---------------------------------------	------	------------------	------

Registration Date	NONE		
-------------------	------	--	--

Word Mark	GRAND NATIONAL CHAMPIONSHIP SERIES		
-----------	------------------------------------	--	--

Goods/Services	conducting, organizing, sanctioning, officiating, and making rules for motorcycle racing competitions		
----------------	---	--	--

Attachments	Petition for Cancellation.pdf ( 6 pages )(21057 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	/Stephen L Grant, RegNo33390/
Name	Stephen L. Grant
Date	02/10/2012

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

IN THE MATTER OF REGISTRATION NO.: 3,208,173

MARK: GRAND NATIONAL CROSS COUNTRY

AMERICAN MOTORCYCLIST ASSOCIATION  
Petitioner,

v.

RACER PRODUCTIONS INC.  
Registrant.

CANCELLATION NO. \_\_\_\_\_

**PETITION FOR CANCELLATION**

American Motorcyclist Association (“Petitioner”) believes that it is being damaged by the continued registration of the mark GRAND NATIONAL CROSS COUNTRY (“the MARK”) shown in U.S. Registration No. 3,208,173 (“the ’173 registration”), and hereby petitions to cancel the same. Petitioner alleges, on personal knowledge (unless specifically stated to the contrary), as follows

**PETITIONER**

1. Petitioner is an Ohio corporation with a business address located at 13515 Yarmouth Drive, Pickerington, OH 43147;
2. Petitioner is engaged in, and has been long engaged in, conducting, organizing, sanctioning, officiating, and making rules for motorcycle racing competitions;
3. Petitioner’s involvement in the motorcycle and motor sport industry is well-known to the public;
4. Petitioner’s involvement in the motorcycle and motor sport industry is evidenced, among other ways, by its numerous trademark registrations in the United States Trademark Office;
5. Petitioner often, but not always, uses its house brand “AMA,” as a part of its trademarks and servicemarks;

6. Petitioner has made continuous use of the marks GRAND NATIONAL and GRAND NATIONAL CHAMPIONSHIP SERIES (collectively “Petitioner’s Marks”) for decades;

7. Petitioner’s use of Petitioner’s Marks began at least as early as 1954;

8. Petitioner’s have used Petitioner’s Marks since at least as early as 1954 in motorcycle competitions, motorcycle racing, and other motorcyclist applications;

9. Petitioner’s continuous involvement in the motorcycle and motor sport industry has resulted in valuable goodwill to Petitioner and identification by the public of its marks, including Petitioner’s Marks, as source indicators;

#### REGISTRANT AND THE ‘173 REGISTRATION

10. On information and belief, and as stated in the US Trademark Office records associated with the ‘173 registration, Racer Productions, Inc. (“Registrant”) is a West Virginia corporation with an address of 122 Vista Del Rio, Morgantown, WV 26508;

11. On information and belief, and as stated in the US Trademark Office records associated with the ‘173 registration, Registrant filed Application Serial No. 78/827,648 (“the ‘648 application”) on 2 March 2006, based on actual use of the mark in commerce;

12. On information and belief, and as stated in the US Trademark Office records associated with the ‘173 registration, Registrant’s mark is GRAND NATIONAL CROSS COUNTRY (“the MARK”);

13. On information and belief, and as stated in the US Trademark Office records associated with the ‘173 registration, Registrant alleged first use and first use in commerce of the MARK since “at least as early as 03/06/1995”;

14. On information and belief, and as stated in the US Trademark Office records associated with the ‘173 registration, the MARK is registered for the services, in International Class 041, “Organizing and conducting athletic competitions, sports, exhibitions, entertainment events and contests involving motor vehicles, motorcycles and ATV’s in the nature of jumps, races, exhibitions and skills-based events; Entertainment services, namely providing television programs, cable television programs, video and still photo exhibitions and webcast television and video programs via a global computer network, all in the field of the foregoing sports entertainment events”;

15. On information and belief, and as stated in the US Trademark Office records associated with the '173 registration, the declaration required by the Trademark Act states that the person signing is authorized to sign the application on the part of the applicant;

16. On information and belief, and as stated in the US Trademark Office records associated with the '173 registration, the declaration required by the Trademark Act states that the person signing believes the applicant to be the owner of the trademark/service mark sought to be registered;

17. On information and belief, and as stated in the US Trademark Office records associated with the '173 registration, the declaration required by the Trademark Act states that the person signing believes, to the best of his/her knowledge and belief that no other person, firm, corporation or association has the right to use the mark in commerce, either in identical form thereof or in such near resemblance thereto as to be likely to cause confusion or to cause mistake or to deceive;

18. On information and belief, and as stated in the US Trademark Office records associated with the '173 registration, the declaration required by the Trademark Act was signed by Carrie Coombs, holding the position of Vice President of applicant;

19. On information and belief, and as shown in the US Trademark Office records associated with the '173 registration, the specimen ("the SPECIMEN") filed in the US Trademark Office consists of an advertisement associated with "Round 1 of the 2006 GRAND NATIONAL CROSS COUNTRY SERIES" that was being held in "De Leon Springs, FL" on "Sunday, March 5" and "Tuesday, March 7";

20. On information and belief, and as shown in the US Trademark Office records associated with the '173 registration, the SPECIMEN states that the event is "produced by Racer";

21. On information and belief, and as shown in the US Trademark Office records associated with the '173 registration, the SPECIMEN, in the lower right corner thereof, bears a servicemark known to Registrant and to the public to be that of Petitioner, with the word "Sanctioned";

22. On information and belief, and as shown in the US Trademark Office records associated with the '173 registration, the US Trademark Office allowed the application, after

requiring a disclaimer of the phrase “CROSS COUNTRY”, published the application and issued the ‘173 registration on 13 February 2007;

#### LIKLIHOOD OF CONFUSION

23. Prior to the first use date alleged by Registrant, Petitioner has used Petitioner’s Marks in association with the services of “conducting, organizing, sanctioning, officiating, and making rules for motorcycle racing competitions;”

24. Petitioner-Sanctioned events that utilize Petitioner’s Marks are a large part of Petitioner’s history and brand;

25. In the 2006 competition advertised in the SPECIMEN, Petitioner was actively involved in each of the services of “conducting, organizing, sanctioning, officiating, and making rules for” the competition and in fact sanctioned the event;

26. In years subsequent to 2006, Petitioner has been actively involved in each of the services of “conducting, organizing, sanctioning, officiating, and making rules for” the competition at which the MARK has been used by Registrant;

27. Upon information and belief, prior to 2012, Registrant did not make any use of the MARK unless the use was related to an event being sponsored or sanctioned by Petitioner;

28. Petitioner did not object to Registrant’s use of the MARK which occurred prior to 2012 only because Registrant was utilizing the MARK on behalf of Petitioner;

29. As a result of the activity alleged in paragraphs 1 – 9 and 23 – 28, Petitioner has acquired common law rights in Petitioner’s Marks as well as in the mark GRAND NATIONAL CROSS COUNTRY in association with services that are substantially identical to the services recited in the ‘173 registration;

30. As a result of the activity alleged in paragraphs 1 – 9 and 23 – 28, Petitioner is a senior user with regard to Petitioner’s Marks as well as the MARK;

31. The Registrant has neither sought, nor has the Petitioner given, any consent to the Registrant’s registration of the MARK, as was done in prosecuting the application that resulted in the ‘173 registration;

32. Upon information and belief, Petitioner only discovered that Registrant filed for and obtained a registration for the Mark within the past several months;

33. The extent of potential confusion as to the source of the services recited in the '173 registration is substantial if the '173 registration is allowed to remain registered.

#### REGISTRANT IS NOT THE OWNER

34. On information and belief, the party signing the declaration in the application that resulted in the '173 registration knew or should have known by reasonable investigation that Petitioner and not Registrant was the owner of the trademark/servicemark sought to be registered;

35. On information and belief, the party signing the declaration in the application that resulted in the '173 registration knew or should have known by reasonable investigation that the Petitioner and not the Registrant had the right to use the MARK in commerce, either in identical form thereof or in such near resemblance thereto as to be likely to cause confusion or to cause mistake or to deceive;

36. On information and belief, the party signing the declaration in the application that resulted in the '173 registration knew or should have known by reasonable investigation that the Petitioner and not the Registrant had the right to use the MARK in commerce, either in identical form thereof or in such near resemblance thereto as to be likely to cause confusion or to cause mistake or to deceive;

37. Upon information and belief, the Registrant's conduct alleged in paragraphs 34-36 is evidence of intent to deceive the Trademark Office sufficient to result in an order cancelling the '173 registration;

#### CONCLUSIONS

38. Petitioner is the rightful owner of the MARK as well as the rightful owner of Petitioner's Marks;

39. Continued registration of the '173 registration to Registrant and use of the MARK by Registrant is likely to cause confusion, or to cause mistake, or to deceive, particularly as to the source or origin of the goods and services with which Registrant uses its mark, to induce purchasers to believe that the services of Registrant are those of Petitioner and/or Petitioner's licensees, or are endorsed by, or are in some way affiliated or associated with Petitioner.

40. Continued registration of the '173 registration to Registrant would presumptively entitle Registrant to prima facie exclusive ownership and rights to the MARK represented by the

'173 registration and would cause confusion among consumers of the relevant goods and services as to the source of the goods and services.

WHEREFORE, Petitioner prays that this Petition for Cancellation be sustained and that the 3,208,173 registration for the mark "GRAND NATIONAL CROSS COUNTRY" be cancelled.

The Commissioner is also authorized to charge any fees which may be required to Deposit Account 19-4076.

Respectfully submitted,

AMERICAN MOTORCYCLIST ASSOCIATION

Date: 10 February 2012

By: /Stephen L Grant, RegNo33390/  
Stephen L. Grant  
Jeffrey S. Standley  
Melissa A. Rogers  
STANDLEY LAW GROUP LLP  
6300 Riverside Drive  
Dublin, Ohio 43017  
Telephone: (614) 792-5555  
Facsimile: (614) 792-5536  
E-mail: [sgrant@standleyllp.com](mailto:sgrant@standleyllp.com)  
E-mail: [jstandley@standleyllp.com](mailto:jstandley@standleyllp.com)

#### CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing PETITION FOR CANCELLATION to be served, via first class mail, postage prepaid, on this 10<sup>th</sup> day of February 2012, to Registrant at the address identified on the US Patent and Trademark Office's TARR database as follows:

Racer Productions, Inc.  
122 Vista Del Rio  
Morgantown, WV 26508

/Stephen L. Grant/

Stephen L. Grant