

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

In re application of: Carlson Capital, L.P.
Serial No.: 76/496,763
Filed: March 12, 2003
Class: 36
Mark: BLACK DIAMOND FUNDS
Published in Official Gazette: July 6, 2004

00392/30240

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Dear Sir:

**FIRST REQUEST FOR EXTENSION OF TIME
TO FILE NOTICE OF OPPOSITION**

Potential Opposer, Black Diamond Capital Management, L.L.C., having its principal place of business at One Conway Park, 100 North Field Drive, Lake Forest, Illinois, by and through its attorneys, hereby requests that the Board grant a thirty (30) day extension of time from the expiration of the opposition period, namely until September 5, 2004, to file a Notice of Opposition in the above-identified matter.

The extension is necessary in order for Potential Opposer to investigate and evaluate the necessity of filing a Notice of Opposition.

This request is being submitted in triplicate as required by 37 CFR § 2.102(d).

Respectfully submitted,



Charles S. Cotropia
Registration No. 27,189

Serial No. 76/496,763

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Charles S. Cotropia
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Serial No. 76/496,763

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing was served upon the below-identified counsel for by first class mail, postage prepaid, on this 5th day of August, 2004.

Lisa W. Rosaya
Coudert Brothers LLP
1627 I Street N.W.
Washington, D.C. 20006-4007



Charles S. Cotropia

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Mark: BLACK DIAMOND FUNDS
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Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3514

Dear Sir:

**REQUEST FOR INCORPORATION OF RELEVANT INFORMATION IN
PROSECUTION HISTORY OF U.S. TRADEMARK APPLICATION NO. 76/496,763**

The above referenced application was published for opposition on July 6, 2004. The application was filed on March 12, 2003, and included a declaration submitted on Applicant's behalf alleging that the Applicant, Carlson Capital, L.P., was the owner of the mark BLACK DIAMOND FUNDS and that no other person, firm, corporation or association has the right to use the mark in commerce, either in the identical form or in such near resemblance thereto as may be likely when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive.

This submission is made by and on behalf of Black Diamond Capital Management, L.L.C. (BDCM), having offices at One Conway Park, 100 North Field Drive, Lake Forest, Illinois. For many years, and from a date long before Applicant's filing of this application, BDCM has provided financial and investment services in interstate and international commerce

under the BLACK DIAMOND mark, using the mark to identify its services and investment funds managed by BDCM. Such funds have been sold to financial institutions, public and private pension funds, insurance companies, foundations and others. BDCM's use of the mark has been open and extensive, and in view of the products and services provided and the investors served by BDCM, such use has been distinct from Applicant's use of the mark the subject of this application.

BDCM's use of the BLACK DIAMOND mark has been known to Applicant, and Applicant has acquiesced in BDCM's use of its mark. BDCM has relied upon such acquiescence, having made substantial investments in promoting and advertising the mark as the identifier of the BDCM's products and services. As a result, substantial goodwill has been created in its mark, and the mark is recognized by institutional, professional and other investors as identifying the services and investment products offered by BDCM.

Respectfully submitted,




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Attorneys for
Black Diamond Capital Management, L.L.C.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document was served upon the below-identified counsel for Applicant by Federal Express, postage prepaid, on this 5th day of August 2004.

Lisa W. Rosaya
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WRITER'S DIRECT NUMBER
214-981-3305

WRITER'S E-MAIL ADDRESS
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August 5, 2004

Via Hand Delivery

Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Request for Incorporation of Relevant Information in Prosecution History
of U.S. Trademark Application No. 76/496,763
For the mark: **BLACK DIAMOND FUNDS**
Serial No.: 76/496,763
Applicant: Carlson Capital, L.P.
Our File No. 00392/30240

Dear Sir:

Enclosed for filing in the above referenced file is a "Request for Incorporation of Relevant Information in Prosecution History of U.S. Trademark Application No. 76/496,763". Please enter this document in the subject file.

It is not believed that a fee is required for this submission. In the event a fee is required, please charge the requisite fee to Sidley Austin Brown & Wood LLP deposit account no. 18-1260. Please direct all correspondence regarding this submission to the submitting party's attorney at the above address.

Very truly yours,



Charles S. Cotropia
Registration No. 27,189
Attorney for Submitting Party

CSC:ia
Enclosure