

Customer No. 03000
Attorney Docket S2018/40004

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

In re Application of :

Applicant	:	Sturgis Area Chamber of Commerce
Trademark/Service Mark	:	STURGIS
Serial Number	:	76/201,759
Filing Date	:	January 30, 2001
Published Official Gazette	:	October 15, 2002

NOTICE OF OPPOSITION

Box TTAB - FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Sir :

In the matter of Application Serial No. 76/201,759 filed by Sturgis Area Chamber of Commerce on January 30, 2001 and published in the *Official Gazette* of the United States Patent and Trademark Office for October 15, 2002, Sturgis Bike Week, Inc., a corporation organized and existing under the laws of the State of South Dakota and having a mailing address at P.O. Box 189, Sturgis, SD 5778, believes it is and will continue to be damaged by the registration of the trademark shown in the above identified application and hereby opposes the same.

The grounds for the opposition are as follows:

No. 1

1. As evidenced by the publication of the mark STURGIS (Application Serial No. 76/201,759), in the *Official Gazette* of October 15, 2002, pages TM 121, 122 and 123, Applicant Sturgis Area Chamber of Commerce (hereinafter "Applicant"), seeks to register the mark STURGIS for goods and services in twenty International Classes, including the following International Classes for the following goods:

- Class 14: Jewelry, watch bands, belt buckles of precious metal, non-monetary coins, medallions, non-monetary tokens, clocks and watches, all of the aforementioned goods relating to the STURGIS motorcycle rally.
- Class 16: Pencils; pens; and paper goods and printed matter, namely, posters; bumper stickers; trading cards; decals; iron-on and plastic transfers; window stickers; wall calendars; note pads; desk sets; lithographs; mounted photographs; unmounted photographs; prints, namely, art prints, cartoon prints, color prints, photographic prints, lithographic prints, and pictorial prints; brochures and books about motorcycles, automobiles and trucks; paper pennants; paper banners; temporary tattoos; paper and plastic bags for packaging; paper and plastic gift bags; postcards, and picture frame mat boards, all of the aforementioned goods relating to the STURGIS motorcycle rally.
- Class 21: Glassware, namely, shot glasses, drinking glasses, drinking cups and drinking mugs; insulating sleeve holders made of rubber, plastic or foam for beverage cans; insulating sleeve holders made of rubber, plastic or foam for beverage bottles; paper cups; grease and polish rags; portable coolers; coasters not of paper and not being table linen; bottle openers; water bottles sold empty; sports bottles sold empty; beer steins; and kitchen utensils, namely, spatulas, turners, tongs, pan scrappers, grill scrappers, and grill baskets, all of the aforementioned goods relating to the STURGIS motorcycle rally.
- Class 25: Clothing, namely, shirts, T-shirts, long sleeve T-shirts, sleeveless T-shirts, denim shirts, woven shirts, knit shirts, golf shirts, sport shirts, sweaters, jackets, anoraks, coats, tank tops, polo shirts, sweatshirts, pullovers, boxer shorts, sleepwear, women's tops, chemises, cloth wraps, bikinis, beachwear, bathing suits, swim wear, head wear, bandannas, caps, cloth headwraps, berets, hats, scarves, head bands, belts, chaps, jeans, dungarees, boots, footwear, gloves, and sun visors,

all of the aforementioned goods relating to the STURGIS motorcycle rally.

Class 26:

Cloth and embroidered patches for clothing, ornamental cloth patches, hat pins for securing hats, belt buckles not of precious metal and novelty ornamental pins, all of the aforementioned goods relating to the STURGIS motorcycle rally.

Class 28:

Miniature toy vehicles, electric miniature toy vehicles, radio controlled toy vehicles, toy model vehicles, miniature toy banks in the shape of vehicles, Christmas tree ornaments, fishing lures, balloons, gaming chips, sports balls, and toy and/or decorative wind socks; die-cast toy banks; and toy helmets, all of the aforementioned goods relating to the STURGIS motorcycle rally.

Applicant's application Serial No. 76/201,759 to register the mark STURGIS was filed on January 30, 2001 as an intent-to-use application. No date of first use has been claimed for any of the goods in the above International Classes.

2. Sturgis Bike Week, Inc. (hereinafter "Opposer") is a South Dakota corporation located and doing business in Sturgis, South Dakota. Opposer promotes sporting competitions and/or events for others, including motorcycle bike shows, exhibits, and related events. Opposer licenses and/or intends to license its STURGIS BIKE WEEK trademark for use in connection with a variety of different goods. Many of these goods are, or will be, specifically directed for sale to consumers in and around Sturgis, South Dakota, or to consumers who want goods relating to Sturgis, South Dakota.

3. Opposer is the owner of U.S. Trademark Registration No. 2,070,955 for its mark STURGIS BIKE WEEK for use in connection with clothing, namely, T-shirts and caps, in International Class 25, dated June 17, 1997, as evidenced by the United States Trademark Office assignment records. The application for that registration claimed a date of first use of January 1984

and a date of first use in commerce of January 1984. On August 2, 2002, Opposer's Section 8 and Section 15 Declarations were accepted and acknowledged

4. Opposer is also the owner of pending intent-to-use application Serial No. 76/012,800 for the mark STURGIS BIKE WEEK, filed on March 29, 2000, for smokers' articles, namely, cigarettes, cigarette lighters not of precious metal, cigarette cases not of precious metal, ash trays and matches in International Class 34. No date of first use is claimed.

5. Opposer is also the owner of pending, intent-to-use application Serial No. 76/012,802 for the mark STURGIS BIKE WEEK, filed on March 29, 2000, for jewelry, including watches in International Class 14. No date of first use is claimed.

6. Opposer is also the owner of pending intent-to-use application Serial No. 76/012,840 for the mark STURGIS BIKE WEEK, filed on March 29, 2000, for paper goods, namely, stationery, postcards, table mats and napkins; and printed publications, namely, pamphlets, brochures and magazines relating to an annual motorcycle event in International Class 16. No date of first use is claimed.

7. Opposer is also the owner of pending intent-to-use application Serial No. 76/012,841 for the mark STURGIS BIKE WEEK, filed on March 29, 2000, for clothing, namely, shirts, sweaters, sweatshirts, scarves, bandanas, and aprons, and embroidered clothing, namely, shirts, sweaters, sweatshirts, scarves, bandanas and aprons in International Class 25. No date of first use is claimed.

8. Opposer is also the owner of pending intent-to-use application Serial No. 76/012,877 for the mark STURGIS BIKE WEEK, filed on March 29, 2000, for embroidered goods, namely, patches and emblems in International Class 26. No date of first use is claimed.

9. Opposer is also the owner of pending intent-to-use application Serial No. 76/012,878 for the mark STURGIS BIKE WEEK, filed on March 29, 2000, for toys and sporting goods, namely, soccer balls, stuffed toy animals and golf balls and Christmas tree ornaments and decorations in International Class 28. No date of first use is claimed.

10. Opposer is also the owner of pending intent-to-use application Serial No. 76/012,893 for the mark STURGIS BIKE WEEK, filed on March 29, 2000, for giftwares and housewares, namely, beverage ware glasses, drinking glasses, mugs, shot glasses and beer steins in International Class 21. No date of first use is claimed.

11. Opposer's U.S. Registration No. 2,070,955 for the mark STURGIS BIKE WEEK for clothing, namely, T-shirts and caps in International Class 25 is prior to the filing date of Applicant's intent-to-use application Serial No. 76/201,759 for the mark STURGIS, namely, January 30, 2001. The filing date of Opposer's pending intent-to-use applications to register the mark STURGIS BIKE WEEK in Classes 14, 16, 21, 25, 26, 28 and 34, namely, March 29, 2000, is prior to the filing date of Applicant's intent-to-use application to register the mark STURGIS, namely, January 30, 2001. Applicant's pending intent-to-use application Serial No. 76/201,759 claims no date of first use in connection with any of the identified goods or services in any of the classes identified in that application.

12. In view of the similarity of Applicant's mark and Opposer's marks and the closely related nature of the goods of the respective parties and their respective customers in International Classes 14, 16, 21, 25, 26 and 28, it is alleged that Applicant's mark so resembles Opposer's marks as to be likely to cause confusion, or to cause mistake, or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public. It is further alleged that the registration of

Applicant's mark for the claimed goods in International Classes 14, 16, 21, 25, 26 and 28 will dilute the power of Opposer's marks to quickly and effectively communicate that the goods offered under the marks are those of the Opposer, thereby causing loss, damage and injury to Opposer and the purchasing public.

13. Opposer's predecessor registered and Opposer and its predecessor have continued to use its STURGIS BIKE WEEK mark for nearly nineteen (19) years in connection with clothing, namely, T-shirts and caps. Said use has been valid, continuous and has not been abandoned in the period. Opposer's mark is symbolic of the extensive good will and consumer recognition built up by Opposer for a substantial investment of time, effort, advertising and promoting its goods. In view of the similarity of Opposer's mark and Applicant's mark and the related nature of the goods and services and customers of the respective parties, it is alleged that the Applicant's mark so resembles the Opposer's mark previously used in the United States and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public.

14. Opposer's STURGIS BIKE WEEK marks create substantially the same commercial impression and are likely to be confused with Applicant's mark STURGIS used in connection with the goods of International Classes 14, 16, 21, 25, 26 and 28 and will result in a likelihood of confusion that will damage the Opposer.

15. In view of the substantial similarity between Opposer's STURGIS BIKE WEEK marks and Applicant's mark STURGIS for use in connection with goods in Classes 14, 16, 21, 25, 26 and 28, covered by application Serial No. 76/201,759, use and registration by the Applicant of

its mark is likely to deceive the public into falsely believing that Applicant's goods are associated with or are those of Opposer, which, in turn, will cause great damage to the Opposer.

16. Opposer asserts that Applicant's trademark application Serial No. 76/201,759 for the mark STURGIS should be refused pursuant to 15 U.S.C. §1052(d) on the grounds that it consists of or comprises a mark registered in the Patent and Trademark Office, or a mark or tradename previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive.

17. Opposer asserts that Applicant's trademark application Serial No. 76/201,759 for the mark STURGIS should be refused pursuant to 15 U.S.C. §1052(a) on the grounds that it consists of or comprises matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.

18. Opposer further alleges that Applicant's mark STURGIS is geographically descriptive of the city of Sturgis, South Dakota, and of goods associated therewith.

19. On information and belief, and contrary to the Declaration of Marlin Martin, President of Applicant, filed on November 8, 2001 in Applicant's application Serial No. 76/201,759 in support of Applicant's claim of acquired distinctiveness under Section 2(f) of the Trademark Act, use of the term "STURGIS" by Applicant and/or its licensees has not been substantially exclusive and continuous by Applicant since at least as early as July 1, 1987. Indeed, Opposer's continuous use of the mark STURGIS BIKE WEEK dates to at least January 1984.

20. On information and belief, the purchasing public has not come to recognize that Applicant's STURGIS mark distinguishes its products from those sold by others.

21. Because Applicant's mark STURGIS is primarily geographically descriptive and has no acquired distinctiveness, Applicant's application for registration of the STURGIS mark should be refused pursuant to 15 U.S.C. §1052(e) on the grounds that it consists of a mark which, when used on or in connection with the goods of the Applicant, is primarily geographically descriptive of them.

WHEREFORE, Opposer believes that it will be damaged by the registration sought by Applicant for its goods covered under International Classes 14, 16, 21, 25, 26 and 28 in application Serial No. 76/201,759, and therefore, prays that application Serial No. 76/201,759 for registration of Applicant's mark STURGIS be rejected for International Classes 14, 16, 21, 25, 26 and 28, that no registration be issued thereon to Applicant, and this Notice of Opposition be sustained in favor of the Opposer, Sturgis Bike Week, Inc.

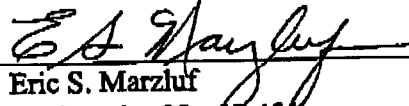
This Notice of Opposition is being submitted in triplicate, including a copy for billing purposes. Please charge the required fees in the amount of One Thousand Eight Hundred Dollars (\$1,800.00) to our Deposit account No. 03-0075. In the event that the Filing Fee is deemed incorrect, please charge the deficiency to our account No 03-0075.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.


February 12, 2003

By


Eric S. Marzluf
Registration No. 27,454
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Attorneys for Opposer

CERTIFICATE OF MAILING

I hereby certify that the foregoing NOTICE OF OPPOSITION, in triplicate, re Application Serial No. 76/201,759 of Sturgis Area Chamber of Commerce is being deposited with the United States Postal Service as ^{FIRST CLASS} ~~Express~~ Mail, in an envelope addressed to : Box TTAB - FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, this 12th day of February, 2003.


Eric S. Marzluft

In re Application of:

Applicant : Sturgis Area Chamber of Commerce
 TM/SM : STURGIS
 Serial No. : 76/201,759
 Filing Date : January 30, 2001
 Published in OG: October 15, 2002

The ~~PTO~~ stamp upon this card acknowledges the receipt
 of a ~~TTAB~~

Notice of Opposition, in triplicate.



re the above entitled matter.

02-20-2003

ESM:pn
 S2018/40004

U.S. Patent & TMOs/TM Mail Rpt Dt #01

Date Mailed: February 12, 2003

No. 2



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FACSIMILE TRANSMITTAL SHEET

TO: Monique Tyson, Paralegal
Trademark Trial and Appeal Board

DATE: August 28, 2003

FACSIMILE NO: 703/746-7109

FROM: Eric S. Marzluf, Esq./Peggy Norris, Secretary

NO. OF PAGES 13 (Including Cover)

Our Reference No.: S2018/40004

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COMMENTS:

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August 28, 2003

Monique Tyson, Paralegal
 Trademark Trial and Appeal Board
SENT BY FAX TO: 703/746-7109

Re: Sturgis Bike Week, Inc. v.
 The Sturgis Area Chamber of Commerce

Sub: Opposition Opposing Application
 Serial No. 76/201,759 for the mark STURGIS
 (Our Ref: S2018/40004)

Dear Ms. Tyson:

Thank you for your attention to this matter this morning. Enclosed are copies of the following:

1. Notice of Opposition, dated February 12, 2003, including the Certificate of Mailing; and
2. Return Receipt Postcard showing receipt in the PTO on February 20, 2003.

Cordially yours,

CAESAR, RIVISE, BERNSTEIN,
 COHEN & POKOTILOW, LTD.

ESM:pn
 enc.

By


 Eric S. Marzluf
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Received from < > at 8/28/03 11:45:20 AM [Eastern Daylight Time]

August 28, 2003
Monique Tyson, Paralegal
Trademark Trial and Appeal Board
Page - 2 -

CERTIFICATE OF FAXING

I hereby certify that the foregoing Letter with (2) enclosures re Application Serial No. 76/201,759 of Sturgis Area Chamber of Commerce is being transmitted by facsimile to Monique Tyson, Paralegal, Trademark Trial and Appeal Board, at 703/746-7109, this 28th day of August, 2003.


Eric S. Marzluf