

ESTTA Tracking number: **ESTTA440357**

Filing date: **11/09/2011**

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	United Bully Kennel Club Inc		
Entity	Corporation	Citizenship	Florida
Address	P.O. Box 210907 West Palm Beach, FL 33421 UNITED STATES		

Attorney information	Manuel Rodriguez Rodriguez & Rodriguez Law Firm P.C. 1900 S Norfolk St Ste 350 San Mateo, CA 94403 UNITED STATES manuz1@yahoo.com Phone:650-488-8184		
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Applicant Information

Application No	85337929	Publication date	11/01/2011
Opposition Filing Date	11/09/2011	Opposition Period Ends	12/01/2011
Applicant	American Bully Kennel Club, LLC P.O. Box 2677 Spotsylvania, VA 22553 UNITED STATES		

Goods/Services Affected by Opposition


Class 035. First Use: 2005/12/30 First Use In Commerce: 2005/12/30 All goods and services in the class are opposed, namely: Maintaining a registry of breeds in the field of dogs; Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
Dilution	Trademark Act section 43(c)
Other	The mark infringes Opposer's common law trademark rights in its existing marks


Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85291078	Application Date	04/09/2011
Registration Date	NONE	Foreign Priority Date	NONE


Word Mark	UBKC UNITED BULLY KENNEL CLUB
Design Mark	
Description of Mark	The mark consists of a badge design and within the badge, the capital letter "U" in the upper right side of the badge written in black bold print with white background shading, the capital letter "B" in the upper left corner of the badge written in white bold print with black background shading, the capital letter "K" in the lower right corner of the badge written in white bold print with black background shading, the capital letter "C" in the lower left corner of the badge written in black bold print with white background shading, across bottom of badge a ribbon design and it is written inside the ribbon "UNITED BULLY KENNEL CLUB" in black bold print with white background shading in ribbon and black shading in folds of ribbon on right and left side.
Goods/Services	Class 035. First use: First Use: 2003/09/20 First Use In Commerce: 2003/09/20 Maintaining a registry of breeds in the field of dogs

U.S. Application No.	85404276	Application Date	08/22/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	UBKC UNITED BULLY KENNEL CLUB		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/09/20 First Use In Commerce: 2003/09/20 Entertainment, namely, hosting, organizing and coordinating dog shows, dog fairs and dog breed events for bully breed dogs; Entertainment, namely, providing recognition by way of prizes and awards to demonstrate excellence in the field of bully breed dog breeding; Television, video and movie filming services for dog shows, dog fairs and dog breed events for bully breed dogs		

U.S. Application No.	85404307	Application Date	08/23/2011
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	UBKC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/09/20 First Use In Commerce: 2003/09/20 Maintaining a registry of bully breeds in the field of dogs; Services consisting of the pedigree certification and pedigree registration of bully breeds in the field of dogs for commercial, promotional and advertising purposes		

U.S. Application No.	85404535	Application Date	08/23/2011
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	UBKC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/09/20 First Use In Commerce: 2003/09/20 Entertainment, namely, hosting, organizing and coordinating dog shows, dog fairs and dog breed events for bully breed dogs; Entertainment, namely, providing recognition by way of prizes and awards to demonstrate excellence in the field of bully breed dog breeding; Television, video and movie filming services for dog shows, dog fairs and dog breed events for bully breed dogs		

Attachments	85291078#TMSN.jpeg (1 page)(bytes) 85404276#TMSN.jpeg (1 page)(bytes) 85404307#TMSN.jpeg (1 page)(bytes) 85404535#TMSN.jpeg (1 page)(bytes) ABKC Opposition Brief.pdf (8 pages)(44452 bytes)
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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	/Manuel Rodriguez/
Name	Manuel Rodriguez
Date	11/09/2011

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

In the matter of trademark application Serial No. 85/337,929
For the mark ABKC
Published in the Official Gazette on November 1, 2011

UNITED BULLY KENNEL CLUB, INC.

Opposer,

v.

Opposition No. _____

AMERICAN BULLY KENNEL CLUB, LLC,

Applicant.

To the Commissioner of Patents and Trademarks:

NOTICE OF OPPOSITION

United Bully Kennel Club, Inc., a corporation organized and existing under the laws of the State of Florida, with a mailing address at P.O. Box 210907, West Palm Beach, FL 33421, believes that it will be damaged by registration of the mark shown in Application Serial No. 85/337,929 and hereby opposes the same.

As grounds for opposition, it is alleged:

1. By the Application filed on June 3, 2011, Applicant seeks to obtain registration on the Principal Register of the trademark ABKC for “Maintaining a registry of breeds in the field of dogs; Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes” in International Class 35.

2. Opposer is in engaged in the business of providing services consisting of maintaining a registry of dogs for “Bully Breed Dogs” and hosting, organizing and coordinating dog shows, dog fairs and dog breed events for “Bully Breed Dogs”, among other services.

3. Since as early as September 20, 2003, prior to the June 3, 2011 filing date of Applicant's application, and prior to Applicant's claimed date of first use in commerce of December 30, 2005, Opposer has continuously engaged in providing services consisting of "Entertainment, namely, hosting, organizing and coordinating dog shows, dog fairs and dog breed events for bully breed dogs" and "Maintaining a registry of breeds in the field of dogs", among other services, under the marks UBKC UNITED BULLY KENNEL CLUB and UBKC. Opposer has also begun selling and continues to sell clothing products under the marks UBKC UNITED BULLY KENNEL CLUB and UBKC.

4. Opposer is the applicant and owner of Application Serial No. 85/291,078 filed on April 9, 2011, seeking to register the Mark UBKC United Bully Kennel Club for "Maintaining a registry of breeds in the field of dogs" in International Class 35. Opposer has used the trademark UBKC United Bully Kennel Club in interstate commerce for these services, since at least as early as September 20, 2003 and continues to use the trademark UBKC United Bully Kennel Club in advertising, selling and promoting these services in interstate commerce.

5. Opposer is the applicant and owner of Application Serial No. 85/404,276 filed on August 22, 2011 seeking to register the Mark UBKC UNITED BULLY KENNEL CLUB for "Entertainment, namely, hosting, organizing and coordinating dog shows, dog fairs and dog breed events for bully breed dogs; Entertainment, namely, providing recognition by way of prizes and awards to demonstrate excellence in the field of bully breed dog breeding; Television, video and movie filming services for dog shows, dog fairs and dog breed events for bully breed dogs" in International Class 41. Opposer has used the trademark UBKC UNITED BULLY KENNEL CLUB in interstate commerce for these services, since at least as early as September 20, 2003 and continues to use the trademark UBKC UNITED BULLY KENNEL CLUB in advertising, selling and promoting these services in interstate commerce.

6. Opposer is the applicant and owner of Application Serial No. 85/404,307 filed on August 23, 2011 seeking to register the Mark UBKC for “Maintaining a registry of bully breeds in the field of dogs; Services consisting of the pedigree certification and pedigree registration of bully breeds in the field of dogs for commercial, promotional and advertising purposes” in International Class 35. Opposer has used the trademark UBKC in interstate commerce for these services, since at least as early as September 20, 2003 and continues to use the trademark UBKC in advertising, selling and promoting these services in interstate commerce.

7. Opposer is the applicant and owner of Application Serial No. 85/404,535 filed on August 23, 2011 seeking to register the Mark UBKC for “Entertainment, namely, hosting, organizing and coordinating dog shows, dog fairs and dog breed events for bully breed dogs; Entertainment, namely, providing recognition by way of prizes and awards to demonstrate excellence in the field of bully breed dog breeding; Television, video and movie filming services for dog shows, dog fairs and dog breed events for bully breed dogs” in International Class 41. Opposer has used the trademark UBKC in interstate commerce for these services, since at least as early as September 20, 2003 and continues to use the trademark UBKC in advertising, selling and promoting these services in interstate commerce.

8. In addition to the filing of Federal Trademark applications, the earliest of which was filed on April 9, 2011, pre-dating the date of Applicant’s filing of the mark ABKC, opposer has acquired extensive common law rights in its UBKC UNITED BULLY KENNEL CLUB and UBKC marks by their use in commerce. Opposer has used the trademarks UBKC UNITED BULLY KENNEL CLUB and UBKC in interstate commerce for the services of “Entertainment, namely, hosting, organizing and coordinating dog shows, dog fairs and dog breed events for bully breed dogs; Entertainment, namely, providing recognition by way of prizes and awards to demonstrate excellence in the field of bully breed dog breeding” and “Maintaining a registry of breeds in the field of dogs”, since at least as early

as September 20, 2003 and continues to use the trademark UBKC on these services in interstate commerce.

9. Opposer's date of first use in commerce for its marks UBKC UNITED BULLY KENNEL CLUB and UBKC is well prior to the filing date of Application Serial No. 85/337,929 by the Applicant.

10. Opposer's services are marketed, promoted, sold and distributed nationwide and as a result, Opposer's mark is exclusively identified with Opposer's quality services.

11. Opposer is informed of and believes that the mark ABKC is an acronym for "American Bully Kennel Club" which corresponds to the legal name of the applicant, American Bully Kennel Club, LLC.

COUNT I – LIKELIHOOD OF CONFUSION

12. All prior allegations are incorporated herein by reference.

13. Applicant's Mark and Opposer's marks are substantially similar or identical in sight, sound and commercial impression, and as such, a likelihood of confusion exists between Applicant's Mark ABKC and Opposer's marks UBKC and UBKC UNITED BULLY KENNEL CLUB.

14. Opposer will be damaged by registration of the ABKC Application in that the ABKC mark so resembles Opposer's UBKC and UBKC UNITED BULLY KENNEL CLUB marks, which are the subject of various pending trademark registration applications, and in which Opposer owns extensive common law trademark rights, as to be likely, when used on or in connection with the services as they are identified in the ABKC Application, as to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

15. The services described in Applicant's application are identical to the services described in Opposer's federal trademark applications and identical to the services that are related to Opposer's common

law trademark rights. Additionally, the services described in Applicant's application are identical to the services currently promoted, marketed and sold by Opposer.

16. Opposer's Services under Opposer's mark and Applicant's services sold under its mark are sold to the same class of consumers.

17. If Applicant is permitted to use and register Applicant's Mark in connection "maintaining a registry of breeds in the field of dogs" and the "organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes" it is likely to cause confusion and lead to deception as to the source, origin and/or sponsorship of the Services bearing Applicant's Mark, causing damage and injury to Opposer and its UBKC and UBKC UNITED BULLY KENNEL CLUB marks.

18. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a prima facie exclusive right to use the ABKC trademark, causing damage and injury to Opposer.

19. Based on the foregoing, the grant of a federal registration for Applicant's Mark ABKC, as sought in the Application, should be denied because the applied-for mark will give rise to a likelihood of confusion in the trade and purchasing public pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

COUNT II – DILUTION

20. All prior allegations are incorporated herein by reference.

21. Through advertising and promotion, Opposer's UBKC and UBKC UNITED BULLY KENNEL CLUB marks have become famous in the United States.

22. Opposer's UBKC and UBKC UNITED BULLY KENNEL CLUB marks became famous prior to the filing date of the Application.

23. Registration of the Applicant's Mark is likely to cause dilution of Opposer's UBKC and UBKC UNITED BULLY KENNEL CLUB marks, to the injury of Opposer, by lessening the capacity of the UBKC and UBKC UNITED BULLY KENNEL CLUB marks to identify and distinguish Opposer's

goods, or otherwise diluting or tarnishing Opposer's UBKC and UBKC UNITED BULLY KENNEL CLUB marks.

24. Based on the foregoing, the grant of a registration for Applicant's Mark as sought in the Application should be denied based on a likelihood of dilution of the distinctive quality of Opposer's UBKC and UBKC UNITED BULLY KENNEL CLUB marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

COUNT III – DESCRIPTIVENESS

25. All prior allegations are incorporated herein by reference.

26. Opposer is informed of and believes that the mark ABKC is an abbreviation, specifically, an acronym for “American Bully Kennel Club”.

27. American Bully refers to a breed of dog developed in the 1990’s that mixed the American Pit Bull Terrier with a Staffordshire Terrier. The breed is recognized by various private dog breed registries.

28. A “Kennel Club” is a synonym of a “Registry of Breeds” as the primary purpose of most Kennel Clubs is to provide breed registration services.

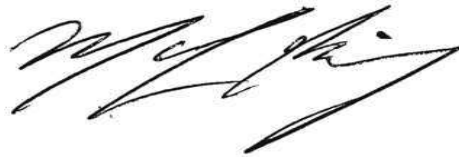
29. Applicant intends to use the mark ABKC to maintain a “Registry of Breeds” of American Bully breed dogs..

30. Applicant’s mark ABKC is an abbreviation for “American Bully Kennel Club” and merely describes the services provided by the applicant, namely, a Registry of Breeds for the American Bully dog breed.

31. Based on the foregoing, the grant of a registration for Applicant's Mark as sought in the Application should be denied because the applied-for mark merely describes Applicant’s Services in violation of the Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1).

WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 85/337,929 be rejected and stricken, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully Submitted
Rodriguez & Rodriguez Law Firm P.C.



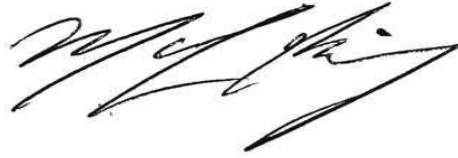
Dated: 11/08/2011

By: _____

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Manuel@RodriguezPC.com
Attorneys for Opposer
UNITED BULLY KENNEL CLUB, INC.

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this NOTICE OF OPPOSITION is being filed electronically with the United States Patent and Trademark Office utilizing the Electronic System for Trademark Trials and Appeals this 9th day of November, 2011.

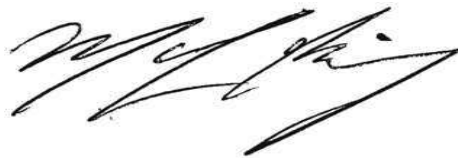


Manuel Rodriguez

CERTIFICATION OF SERVICE

The undersigned hereby certifies that a copy of the foregoing NOTICE OF OPPOSITION was served via United States first class mail, postage pre-paid, on this 9th day of November, 2011 to the following:

Frederick N. Samuels Esq.
Cahn & Samuels, LLP
1100 17Th St. NW Ste. 401
Washington, DC 20036-4650



Manuel Rodriguez