

ESTTA Tracking number: **ESTTA454496**

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

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	Indian Motorcycle International, LLC		
Entity	limited liability company	Citizenship	Delaware
Address	8161 15th Street East Sarasota, FL 34243 UNITED STATES		

Attorney information	Scott W. Johnston Merchant & Gould P.C. P.O. Box 2910 Minneapolis, MN 55402-0910 UNITED STATES sjohnston@merchantgould.com, slindemeier@merchantgould.com Phone:612-332-5300
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Applicant Information

Application No	79103480	Publication date	01/03/2012
Opposition Filing Date	02/02/2012	Opposition Period Ends	02/02/2012
International Registration No.	1028480	International Registration Date	11/24/2009
Applicant	UVEX WINTER HOLDING GmbH & Co. KG WÄrzburger Straße 181 90766 FÜRTH GERMANY		

Goods/Services Affected by Opposition

<p>Class 009. All goods and services in the class are opposed, namely: Motorcycle goggles, ski goggles, sports glasses, sunglasses, cycling glasses, golf glasses, shooting glasses, riding glasses, diving goggles, swimming goggles, reading glasses, goggles for industrial safety, laser protection goggles, optical glasses, spectacle frames and lenses; spectacle glasses of plastic; spectacle cases; laser protection windows, laser safety curtains, optical filters, optical measuring devices; reading aids, magnifying glasses; industrial safety helmets, protective helmets for motorcycling, cycling, skiing, ski jumping, bobsleighting, tobogganing, skeleton sledding, rollerblading, inline skating, snowboarding, canoeing, kite flying, paragliding; sports helmets; helmets for alpine sports, helmets for horse riding; face protection visors for workers, protective shields for workers, in particular protective shields for welding; protective work shoes and protective work clothing; laser safety textiles, protective work gloves; respirators, other than for artificial respiration, in particular respiratory masks and respiratory apparatus for workers, earmuffs, ear plugs, banded hearing protection for workers; fall-prevention apparatus for workers, namely safety nets, safety tarpaulins, safety signals, safety signs, restraining belts, safety belts, seat belts, restraining/safety/seat belts integrated into protective work clothing, safety vests, stay ropes, safety belt straps, safety belt straps with integrated shock absorbers, energy absorbers, crash barriers, lanyard lifelines, safety ropes, fall arresters for safety equipment; parts of</p>

the aforesaid goods; all the aforesaid goods included in this class

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2388763	Application Date	05/24/1999
Registration Date	09/19/2000	Foreign Priority Date	NONE
Word Mark	CHIEF		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1999/06/01 First Use In Commerce: 1999/06/01 MOTORCYCLES		

Attachments	75714285#TMSN.gif (1 page)(bytes) 2012 02 02 Notice of Opposition 79103480.PDF (12 pages)(437550 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 Overnight Courier on this date.

Signature	/SWJ/
Name	Scott W. Johnston
Date	02/02/2012

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

Indian Motorcycle International, LLC,)	Opposition No. _____
)	
Opposer,)	Mark: CHIEF 10
)	
v.)	Serial No.: 79/103,480
)	
UVEX WINTER HOLDING GmbH)	Filing Date: September 12, 2011
& Co. KG,)	
)	Published: January 3, 2012
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Indian Motorcycle International, LLC (hereinafter "Opposer"), a Delaware limited liability company with a principal place of business at 8161 15th Street East, Sarasota, Florida 34243, believes it will be damaged by the registration of the mark shown in Application Serial No. 79/103,480, filed September 12, 2011, by UVEX WINTER HOLDING GmbH & Co. KG (hereinafter "Applicant"), and hereby opposes registration of the mark. The grounds for opposition are as follows:

1. Applicant's mark published for opposition on January 3, 2012. This Notice of Opposition is timely filed.
2. Applicant is seeking to register the mark CHIEF 10 in connection with "motorcycle goggles, ski goggles, sports glasses, sunglasses, cycling glasses, golf glasses, shooting glasses, riding glasses, diving goggles, swimming goggles, reading glasses, goggles for industrial safety, laser protection goggles, optical glasses, spectacle frames and lenses; spectacle glasses of plastic; spectacle cases; laser protection windows, laser safety curtains, optical filters, optical measuring devices; reading aids, magnifying glasses; industrial safety helmets, protective

helmets for motorcycling, cycling, skiing, ski jumping, bobsleighbing, tobogganing, skeleton sledding, rollerblading, inline skating, snowboarding, canoeing, kite flying, paragliding; sports helmets; helmets for alpine sports, helmets for horse riding; face protection visors for workers, protective shields for workers, in particular protective shields for welding; protective work shoes and protective work clothing; laser safety textiles, protective work gloves; respirators, other than for artificial respiration, in particular respiratory masks and respiratory apparatus for workers, earmuffs, ear plugs, banded hearing protection for workers; fall-prevention apparatus for workers, namely safety nets, safety tarpaulins, safety signals, safety signs, restraining belts, safety belts, seat belts, restraining/safety/seat belts integrated into protective work clothing, safety vests, stay ropes, safety belt straps, safety belt straps with integrated shock absorbers, energy absorbers, crash barriers, lanyard lifelines, safety ropes, fall arresters for safety equipment; parts of the aforesaid goods; all the aforesaid goods included in this class,” in International Class 9.

3. Opposer or its predecessors in interest first used the mark CHIEF in connection with motorcycles in the early 1900s, and has been using the mark continuously since well before Applicant’s filing date.

4. Opposer owns U.S. trademark Registration No. 2,388,763, issued September 19, 2000, for the mark CHIEF for “motorcycles,” in International Class 12. A current printout of information from the electronic database records of the USPTO showing the current status and title of the registration is attached hereto as Exhibit A.

5. Opposer’s U.S. Registration No. 2,388,763 is incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065. Consequently, this registration is conclusive evidence of the validity of the registered mark and of the registration of the mark, of Opposer’s ownership of the

mark, and of Opposer's exclusive right to use the registered mark in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

6. Opposer has advertised and promoted its CHIEF mark continuously and extensively, and made substantial sales of products under said mark. As a result of such continuous use and promotion, the CHIEF mark has developed and represents valuable goodwill inuring to the benefit of Opposer. In addition, Opposer's CHIEF mark is famous and became famous before Applicant's filing date.

7. There is no issue of priority concerning Application Serial No. 79/103,480 since Opposer used and registered its CHIEF mark prior to Applicant's September 12, 2011, filing date. Opposer's usage of its CHIEF mark commenced in the early 1900s, and Opposer has continuously used the CHIEF mark as the name for its flagship motorcycle since long before Applicant's September 12, 2011, filing date. Opposer therefore has priority over Applicant with respect to the marks at issue.

8. Upon information and belief, Applicant had knowledge of the fact that Opposer used the term CHIEF as a trademark before it adopted the CHIEF 10 mark.

9. Applicant's CHIEF 10 mark is confusingly and deceptively similar to Opposer's previously used and duly registered CHIEF mark.

10. Applicant's CHIEF 10 mark is nearly identical in sight, sound and commercial impression to Opposer's CHIEF mark.

11. Applicant's alleged goods are closely related to Opposer's goods marketed and sold by Opposer in connection with its CHIEF mark, and for which Opposer owns a registration. For example, Applicant's goods include motorcycle goggles and protective helmets for motorcycling.

12. Upon information and belief, Opposer's goods and Applicant's goods are promoted in the same channels of trade to the same consumers or class of consumers.

13. Due to the similarity between Applicant's claimed mark, CHIEF 10, and Opposer's previously used and registered CHIEF mark, the closely related nature of the goods of the respective parties, customers and potential customers are likely to believe that Applicant's goods originate from Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

14. The use and registration by Applicant of the mark CHIEF 10 for Applicant's goods is likely to cause confusion or to cause mistake or deception in the trade, and among purchasers and potential purchasers, with Opposer's previously used CHIEF mark, again resulting in damage to Opposer.

15. Because of the closely related nature of the goods of the parties, and that the marks are nearly identical, use and registration of the term CHIEF 10 by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer for use with Opposer's products causing further damage to Opposer.

16. Applicant's use and registration of Applicant's mark is likely to dilute Opposer's famous CHIEF mark.

17. Registration of the mark shown in Application Serial No. 79/103,480 will result in damage to Opposer under the provisions of Section 2 of the U.S. Trademark Act, 15 U.S.C. Section 1052, pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that registration of the term CHIEF 10 for the goods set forth therein be refused.

Please direct all correspondence to:

**Scott W. Johnston
MERCHANT & GOULD P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910**

Opposer herein appoints John A. Clifford, Reg. No. 30,247; Gregory C. Golla; Andrew S. Ehard; Scott W. Johnston, Reg. No. 39,721; Heather J. Kliebenstein; Danielle I. Mattessich; Scott M. Oslick; Christopher J. Schulte; William D. Schultz, and all other attorneys of the firm of Merchant & Gould P.C., its attorneys to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,

INDIAN MOTORCYCLE INTERNATIONAL, LLC

By its Attorneys,




Scott W. Johnston
Andrew S. Ehard
MERCHANT & GOULD P.C.
80 South Eighth Street, Suite 3200
Minneapolis, Minnesota 55402-2215
(612) 332-5300

Date: 2-2-12

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served upon the following attorney of record for Applicant by Federal Express this 2nd day of February, 2012:

Rau, Schneck & Hubner
Patentanwalte Rechtsanwälte
Königstrasse 2
90402 Nürnberg
GERMANY



Scott W. Johnston

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-01-31 17:14:14 ET

Serial Number: 75714285 Assignment Information Trademark Document Retrieval

Registration Number: 2388763

Mark (words only): CHIEF

Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2010-09-20

Filing Date: 1999-05-24

Transformed into a National Application: No

Registration Date: 2000-09-19

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: (NOT AVAILABLE)

Date In Location: 2010-09-20

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. INDIAN MOTORCYCLE INTERNATIONAL, LLC

Address:

INDIAN MOTORCYCLE INTERNATIONAL, LLC
8161 15TH STREET EAST
SARASOTA, FL 34243
United States

Legal Entity Type: Limited Liability Company
State or Country Where Organized: Delaware

GOODS AND/OR SERVICES

International Class: 012

Class Status: Active

MOTORCYCLES

Basis: 1(a)

First Use Date: 1999-06-01

First Use in Commerce Date: 1999-06-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

USPTO Reference Number: Z1231600

International Registration Number: 0836866

International Registration Date: 2004-10-01

Original Filing Date with USPTO: 2004-10-01

International Registration Status: Application For IR Registered By IB

Date of International Registration Status: 2004-12-09

International Registration Renewal Date: 2014-10-01

Irregularity Reply by Date: (DATE NOT AVAILABLE)

Madrid History:

12-09-2004 - 12:45:14 - Application For IR Registered By IB

10-06-2004 - 13:32:09 - Manually Certified

10-06-2004 - 10:40:10 - New Application For IR Received

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2011-10-03 - Attorney Revoked And/Or Appointed

2011-10-03 - TEAS Revoke/Appoint Attorney Received

2010-09-21 - TEAS Change Of Correspondence Received

2010-09-20 - First renewal 10 year

2010-09-20 - Section 8 (10-year) accepted/ Section 9 granted

2010-09-18 - Case Assigned To Post Registration Paralegal

2010-09-17 - TEAS Section 8 & 9 Received

2007-04-26 - Section 8 (6-year) accepted

2007-04-18 - Assigned To Paralegal

2007-03-19 - Section 8 (6-year) filed

2007-03-19 - PAPER RECEIVED

2006-02-13 - Case File In TICRS

Latest Status Info

2002-04-02 - Cancellation terminated for Proceeding
2002-04-02 - Cancellation dismissed for Proceeding
2001-10-03 - Cancellation Instituted No. 999999
2000-09-19 - Registered - Principal Register
2000-07-06 - Allowed for Registration - Principal Register (SOU accepted)
2000-06-30 - Assigned To Examiner
2000-06-26 - Statement Of Use Processing Complete
2000-05-04 - Use Amendment Filed
2000-04-04 - NOA Mailed - SOU Required From Applicant
2000-01-11 - Published for opposition
1999-12-10 - Notice of publication
1999-09-20 - Approved For Pub - Principal Register
1999-09-17 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Andrew S. Ehard

Correspondent

Andrew S. Ehard

Merchant & Gould P.C.

P.O. Box 2910

Minneapolis MN 55402-0910

Phone Number: 612-332-5300

Fax Number: 612-332-9081



United States Patent and Trademark Office

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Assignments on the Web > Trademark Query

Trademark Assignment Abstract of Title

Total Assignments: 7Serial #: 75714285

Filing Dt: 05/24/1999

Reg #: 2388763

Reg. Dt: 09/19/2000

Registrant: FEULING, JAMES J.

Mark: CHIEF

Assignment: 1Reel/Frame: 2237/0529

Received: 02/18/2001

Recorded: 01/29/2001

Pages: 2

Conveyance: ASSIGNMENT OF AN UNDIVIDED PART OF ASSIGNORS INTEREST

Assignor: FEULING, JAMES J.

Exec Dt: 01/22/2001

Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Entity Type: INDIAN TRIBE

Citizenship: OREGON

Assignee: COW CREEK BANK OF UMPOUA TRIBE OF INDIANS

2371 NE STEPHENS, SUITE 100

ROSEBURG, OREGON 97470

Correspondent: KELLY BAUERSFELD LOWRY & KELLEY, LLP

SCOTT W. KELLEY

6320 CANOGA AVENUE

SUITE 1650

WOODLAND HILLS, CA 91367

Assignment: 2Reel/Frame: 2295/0392

Received: 05/11/2001

Recorded: 05/07/2001

Pages: 3

Conveyance: NULLIFICATION OF RECORDING

Assignor: FEULING, JAMES J.

Exec Dt: 01/22/2001

Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Entity Type: INDIAN TRIBE

Citizenship: NONE

Assignee: COW CREEK BAND OF UMPOUA TRIBE OF INDIANS

SUITE 100

2371 NE STEPHENS

ROSEBURG, OREGON 97470

Correspondent: KELLY BAUERSFELD LOWRY & KELLEY, LLP

SCOTT W. KELLEY

6320 CANOGA AVENUE

SUITE 1650

WOODLAND HILLS, CA 91367

Assignment: 3Reel/Frame: 2421/0398

Received: 01/14/2002

Recorded: 01/07/2002

Pages: 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: FEULING, JAMES J.

Exec Dt: 11/28/2001

Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: IMCOA LICENSING AMERICA, INC.

200 EAST TENTH STREET

GILROY, CALIFORNIA 95020

Correspondent: MORRISON & FOERSTER LLP

JENNIFER LEE TAYLOR

425 MARKET STREET

SAN FRANCISCO, CALIFORNIA 94105-2482

Assignment: 4Reel/Frame: 2805/0984

Received: 08/21/2003

Recorded: 08/01/2003

Pages: 6

Conveyance: SECURITY INTEREST**Assignor:** IMCOA LICENSING AMERICA, INC.**Exec Dt:** 07/29/2003**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Entity Type:** LIMITED PARTNERSHIP**Citizenship:** DELAWARE**Assignee:** AUDAX PRIVATE EQUITY FUND, L.P.101 HUNTINGTON AVENUE
BOSTON, MASSACHUSETTS 02199**Correspondent:** ROPES & GRAYSEAN MURPHY, ESQ.
ONE INTERNATIONAL PLACE
BOSTON, MA 02110**Assignment: 5****Reel/Frame:** 2945/0446 **Received:** 09/24/2004**Recorded:** 09/24/2004**Pages:** 7**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** IMCOA LICENSING AMERICA, INC.**Exec Dt:** 05/12/2004**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Entity Type:** CORPORATION**Citizenship:** CALIFORNIA**Assignee:** CREDIT MANAGERS ASSOCIATION OF CALIFORNIA**DBA/AKA/TA:** DBA CMA BUSINESS CREDIT SERVICES
40 EAST VERDUGO AVENUE
BURBANK, CALIFORNIA 91502-1931**Correspondent:** JENNIFER LEE TAYLORMORRISON & FOERSTER LLP, 425 MARKET ST.
SAN FRANCISCO, CA 94105-2482**Assignment: 6****Reel/Frame:** 2948/0813 **Received:** 09/30/2004**Recorded:** 09/30/2004**Pages:** 6**Conveyance:** RELEASE OF SECURITY INTEREST**Assignor:** AUDAX PRIVATE EQUITY FUND, L.P.**Exec Dt:** 07/19/2004**Entity Type:** LIMITED PARTNERSHIP**Citizenship:** DELAWARE**Entity Type:** CORPORATION**Citizenship:** DELAWARE**Assignee:** IMCOA LICENSING AMERICA, INC.200 EAST TENTH STREET
GILROY, CALIFORNIA 95020**Correspondent:** JENNIFER LEE TAYLORMORRISON & FOERSTER LLP, 425 MARKET ST.
SAN FRANCISCO, CA 94105-2482**Assignment: 7****Reel/Frame:** 2945/0946 **Received:** 09/27/2004**Recorded:** 09/27/2004**Pages:** 6**Conveyance:** ASSIGNS THE ENTIRE INTEREST**Assignor:** CREDIT MANAGERS ASSOCIATION OF CALIFORNIA, DBA CMA
BUSINESS CREDIT SERVICES**Exec Dt:** 07/21/2004**Entity Type:** CORPORATION**Citizenship:** CALIFORNIA**Entity Type:** LIMITED LIABILITY COMPANY**Citizenship:** DELAWARE**Assignee:** INDIAN MOTORCYCLE INTERNATIONAL, LLC8161 15TH STREET EAST
SARASOTA, FLORIDA 34243**Correspondent:** JENNIFER LEE TAYLORMORRISON & FOERSTER LLP, 425 MARKET ST.
SAN FRANCISCO, CA 94105-2482

Search Results as of: 01/31/2012 05:14 PM

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