

ESTTA Tracking number: **ESTTA454429**

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	Daytona Regional Chamber of Commerce, Inc.
Granted to Date of previous extension	03/14/2012
Address	126 East Orange Avenue Daytona Beach, FL 32114 UNITED STATES

Attorney information	Kelly Parsons Kwiatek Cobb & Cole, P.A. 150 Magnolia Avenue Daytona Beach, FL 32114 UNITED STATES Kelly.Parsons@CobbCole.com,celto@cobbcole.com Phone:386-323-9269
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**Applicant Information**

Application No	85203979	Publication date	11/15/2011
Opposition Filing Date	02/02/2012	Opposition Period Ends	03/14/2012
Applicant	Chelmsford Gift Co 719 Eastern Pk St3 Bklyn, NY 11213 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 014. All goods and services in the class are opposed, namely: Imitation jewelry
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**Grounds for Opposition**

The mark is merely descriptive	Trademark Act section 2(e)(1)
Genericness	Trademark Act section 23
Other	Doesn't function as a trademark

Attachments	Notice of Opposition with exhibit A (01318205).PDF ( 20 pages )(1094960 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	/Kelly Parsons Kwiatek/
Name	Kelly Parsons Kwiatek
Date	02/02/2012



4. On July 7, 2009, Consolidated Distributors, Inc. a/k/a Joe Cool filed an application for the federal trademark registration, Serial No. 77776138, of the phrase "Daytona Beach Bike Week" in International Class 025 for use with clothing, namely, t-shirts, shirts, caps, tops, bottoms, which was opposed by Opposer in the Trademark Trial and Appeal Board ("TTAB") action, Opposition Number 91193908, on February 24, 2010.

5. On February 11, 2011, Opposer filed a complaint for declaratory relief under 28 U.S.C. § 2201 and 15 U.S.C. § 1125(a) and cancellation of a state trademark registration pursuant to section 495.101, Florida Statutes, in the United States District Court for the Middle District of Florida, Orlando Division. The case was styled *Good Sports Daytona, Inc., a Florida corporation, Good Sports, Inc., a Connecticut corporation, and Daytona Regional Chamber of Commerce, Inc., a Florida non-profit corporation v. Consolidated Distributors, Inc. a/k/a Joe Cool, Inc., a New York corporation, Joe Cool, Inc., a Florida corporation, and Mettemp, Inc., a New York corporation*, Case No. 6:11-cv-00233-MSS-DAB.

6. On December 20, 2011, a Final Judgment was rendered in favor of Opposer and against Consolidated Distributors, Inc. a/k/a Joe Cool, Inc. on all counts of the complaint. The Final Judgment incorporated the Order entered on December 19, 2011, by the Honorable Mary S. Scriven, United States District Judge. The Final Judgment and Order are attached as Composite Exhibit A.

7. In the Order, the Court stated, "[T]he Court finds that the phrase 'Daytona Beach Bike Week' and its functional equivalents are generic and cannot receive trademark protection. See Knights Armament, 654 F.3d 1179, 1188; see also 15 U.S.C. §1125(a)." (Order, §III(B)).

8. Based on the language of the Final Judgment and Order rendered by the United States District Court for the Middle District of Florida regarding the generic nature of the phrase "Daytona Beach Bike Week," the phrase "Bike Week," a part and functional equivalent of the longer phrase, is generic and cannot receive trademark protection. As such, Applicant cannot obtain a registration for this generic phrase.

9. Further, in the Final Judgment and Order rendered in United States District Court for the Middle District of Florida, a permanent injunction was ordered against, among others, Consolidated Distributors, Inc. a/k/a Joe Cool, Inc. and its "agents, employees, officers, directors, subsidiaries, and attorneys, and upon those persons in active concert or participation with [Consolidated Distributors, Inc. a/k/a Joe Cool, Inc.] who receive actual notice of this Order by personal service or otherwise: a) From further asserting, contending, claiming, or alleging ownership, infringement, and/or dilution of the 'Daytona Beach Bike Week' phrase..."

10. In its Application and other filed documents, Consolidated Distributors, Inc. a/k/a Joe Cool, Inc. stated that it is a New York corporation having an address of 719 Eastern Parkway, Suite 3, Brooklyn, NY 11213. Then, in early correspondence during the Opposition proceeding, a man named David Lipsker held himself out as the attorney representing Consolidated Distributors and used the e-mail davidlipsker@gmail.com.

11. In the instant proceeding, the Applicant, Chelmsford Gift Co., filed an application for the federal trademark registration, Serial No. 85203979, of the phrase "Bike Week." In its

Application and other filed documents, Applicant stated that it is a limited partnership, then later, a limited liability company, legally organized under the laws of Massachusetts<sup>1</sup> having an address of 719 Eastern Parkway, Suite 3, Brooklyn, NY 11213. Applicant also stated that its contact e-mail is davidlipsker@gmail.com. (Application filed December 22, 2010 and Response to Office Action filed September 12, 2011.)

12. The entity with the Final Judgment against it, Consolidated Distributors, Inc. a/k/a Joe Cool, Inc., and the Applicant in the instant proceeding, Chelmsford Gift Co., seek a similar trademark registration, have the same entity address, and are represented by the same agent, David Lipsker.

13. As such, not only does the Final Judgment and Order rendered in United States District Court for the Middle District of Florida prohibit the registration of the phrase "Bike Week" as a functional equivalent to phrase "Daytona Beach Bike Week," but it also specifically prevents Chelmsford Gift Co., as an entity in active concert or participation with Consolidated Distributors, Inc. a/k/a Joe Cool, from asserting, contending, claiming, or alleging ownership of the phrase "Bike Week."

14. If Applicant is granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to prohibit others from using a phrase that has been declared by the United States District Court for the Middle District of Florida as one that is generic and cannot receive trademark protection. Further, it would have been procured by an entity that is prevented from asserting, contending, claiming, or alleging such ownership, thereby damaging Opposer, its members, and all other vendors who have a right to use the phrase.

## **II. THE PHRASE "BIKE WEEK" DOES NOT FUNCTION AS A TRADEMARK.**

15. Bike Week is an annual event that has been held in Daytona Beach since 1939. Hundreds of thousands of motorcycle enthusiasts congregate in Daytona Beach to ride, admire other motorcycles, and enjoy the Daytona Beach area.

16. The term "Bike Week" is often used to describe a gathering of motorcycle riders in a single location. In the more than seventy (70) years that Bike Week has been held in Daytona Beach, innumerable vendors have sold products, including all manner of clothing and jewelry, bearing the phrase "Bike Week."

17. The phrase "Bike Week" has been used by innumerable vendors, including jewelry vendors. For many years, no one entity had any control over the use of the phrase "Bike Week," or the quality of the products on which the phrase "Bike Week" was applied.

18. A term or phrase does not function as a trademark when it is used by so many different entities that consumers can not distinguish the goods of the Applicant from the goods of others.

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<sup>1</sup> Based on a search with Massachusetts' Secretary of the Commonwealth, Corporations Division, there is no record of a business entity called Chelmsford Gift Co.

19. The phrase "Bike Week" does not function as a trademark and Applicant cannot obtain a registration for a phrase that does not function as a trademark. 15 U.S.C. § 1052.

20. If Applicant is granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to prohibit others from using a phrase that does not function as a trademark, thereby damaging Opposer, its members, and all other vendors who have a right to use the phrase.

### **III. THE PHRASE "BIKE WEEK" IS GENERIC.**

21. Bike Week is an annual event that has been held in Daytona Beach since 1939. Hundreds of thousands of motorcycle enthusiasts congregate in Daytona Beach to ride, admire other motorcycles, and enjoy the Daytona Beach area.

22. The term "Bike Week" is often used to describe a gathering of motorcycle riders in a single location. In the more than seventy (70) years that Bike Week has been held in Daytona Beach, innumerable vendors have sold products, including all manner of clothing and jewelry, bearing the phrase "Bike Week."

23. The phrase "Bike Week" has been used by innumerable vendors, including jewelry vendors. For many years, no one entity had any control over the use of the phrase "Bike Week," or the quality of the products on which the phrase "Bike Week" was applied.

24. A term or phrase is deemed generic when it is used by so many different entities that consumers do not associate the term or phrase with any one source.

25. The phrase "Bike Week" is generic and Applicant cannot obtain a registration for this generic phrase.

26. If Applicant is granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to prohibit others from using a generic phrase, thereby damaging Opposer, its members, and all other vendors who have a right to use the generic phrase.

### **IV. APPLICANT IS A NON-EXISTENT ENTITY, THEREFORE, THE APPLICATION WAS VOID AB INITIO.**

27. Applicant filed an application for federal trademark registration of the phrase "Bike Week" as Chelmsford Gift Co., a limited partnership. (Applicant's Application of Dec. 22, 2010).

28. Later, Applicant changed its entity status to a limited liability company, or LLC. (Applicant's Response to Office Action of October 5, 2011, confirmed in Notation to File on October 11, 2011).

29. Based on a search with Massachusetts' Secretary of the Commonwealth, Corporations Division, there is no record of any business entity, limited partnership or LLC, named Chelmsford Gift Co. As such, the application in the instant proceeding was filed by a non-existent entity, not by

a "person" authorized to file an intent-to-use application pursuant to Trademark Act Sections 1(b) and 45, 15 U.S.C. Sections 1051(b) and 1127.

30. Because the application was filed by a non-existent entity, the application was void ab initio. Aloe Creme Laboratories, Inc. v. The Magic of Aloe, Inc., 182 USPQ 45 (Comm'r Pats.1973) ("... if the applicant did not exist at [the time the application was filed], the application is null and void"). This defect may not be cured by amending the application to name another entity, nor may the application be assigned.

31. If Applicant is granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to prohibit others from using the phrase "Bike Week," even though the Applicant is a non-existent entity and the application was void ab initio, thereby damaging Opposer, its members, and all other vendors who have a right to use this generic phrase.

WHEREFORE, Opposer requests that Application Serial No. 85203979 be rejected and stricken, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully Submitted,

Dated: February 2, 2012

By: /s/Kelly Parsons Kwiatek  
Kelly Parsons Kwiatek  
Cobb Cole, P.A.  
150 Magnolia Avenue  
Daytona Beach, FL 32114  
Telephone: (386) 255-8171  
Facsimile: (386) 944-7958  
Email: Kelly.Parsons@CobbCole.com  
ATTORNEYS FOR OPPOSER

### **CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing Notice of Opposition has been served this 2<sup>nd</sup> day of February, 2012 via Certified U.S. Mail, on:

Chelmsford Gift Co., LLC  
719 Eastern Parkway, Apt. 3  
Brooklyn, NY 11213

By: /s/Kelly Parsons Kwiatek  
Kelly Parsons Kwiatek, Esq.

**UNITED STATES DISTRICT COURT  
MIDDLE DISTRICT OF FLORIDA  
ORLANDO DIVISION**

**FILED**

2011 DEC 20 AM 8:45

US DISTRICT COURT  
MIDDLE DISTRICT OF FLORIDA  
ORLANDO, FLORIDA

**GOOD SPORTS DAYTONA, INC., a  
Florida corporation, GOOD SPORTS,  
INC., a Connecticut corporation and  
DAYTONA REGIONAL CHAMBERS  
OF COMMERCE, INC., a Florida  
non-profit corporation,**

**Plaintiffs,**

**v.**

**Case No.: 6:11-cv-233-ORL-35-DAB**

**CONSOLIDATED DISTRIBUTORS,  
INC. a/k/a JOE COOL, INC., a New  
York corporation, JOE COOL, INC.,  
a Florida corporation, and METTEMP,  
INC., a New York corporation,**

**Defendants.**

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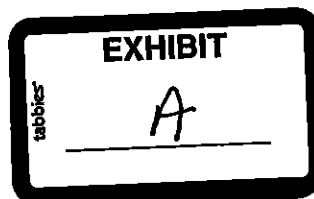
**JUDGMENT IN A CIVIL CASE**

**Decision by Court.**

This action came to trial or hearing before the Court. The issues have been tried or heard and a decision has been rendered regarding the liability of Defendants Consolidated Distributors, Inc. a/k/a Joe Cool, Inc., a New York Corporation, and Mettemp, Inc., a New York Corporation.

**IT IS ORDERED AND ADJUDGED** that Final Judgment is rendered in favor of Plaintiffs and against Defendants Consolidated Distributors, Inc. a/k/a Joe Cool, Inc., a New York Corporation, and Mettemp, Inc. on all Counts of Plaintiffs' Complaint.

**IT IS FURTHER ORDERED AND ADJUDGED** that pursuant to the Court's





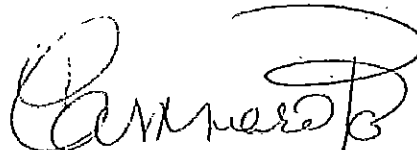
Order, entered on December 19, 2011 (Dkt. 42), the Court incorporates herein the terms of the Permanent Injunction entered against Defendants Consolidated Distributors, Inc. a/k/a Joe Cool, Inc., a New York Corporation, and Mettemp, Inc.

**IT IS FURTHER ORDERED AND ADJUDGED** that pursuant to FLA. STAT. § 495.101, State of Florida trademark registration, No. T09000000380, for the phrase "Daytona Beach Bike Week" **SHALL BE CANCELLED.**

**IT IS FURTHER ORDERED AND ADJUDGED** that Plaintiffs' continued right to use the phrase "Daytona Beach Bike Week" shall be free and clear of interference or harassment without any obligation or liability to Defendants Consolidated Distributors, Inc. a/k/a Joe Cool, Inc., a New York Corporation, and Mettemp, Inc.

Date: December --, 2011

SHERYL L. LOESCH, CLERK

  
s/J. Deputy Clerk

**CIVIL APPEALS JURISDICTION CHECKLIST**

1. **Appealable Orders:** Courts of Appeals have jurisdiction conferred and strictly limited by statute:
  - (a) **Appeals from final orders pursuant to 28 U.S.C. Section 1291:** Only final orders and judgments of district courts, or final orders of bankruptcy courts which have been appealed to and fully resolved by a district court under 28 U.S.C. Section 158, generally are appealable. A final decision is one that "ends the litigation on the merits and leaves nothing for the court to do but execute the judgment." Pitney Bowes, Inc. v. Mestre, 701 F.2d 1365, 1368 (11th Cir. 1983). A magistrate judge's report and recommendation is not final and appealable until judgment thereon is entered by a district court judge. 28 U.S.C. Section 636(c).
  - (b) **In cases involving multiple parties or multiple claims,** a judgment as to fewer than all parties or all claims is not a final, appealable decision unless the district court has certified the judgment for immediate review under Fed.R.Civ.P. 54(b), Williams v. Bishop, 732 F.2d 885, 885-86 (11th Cir. 1984). A judgment which resolves all issues except matters, such as attorneys' fees and costs, that are collateral to the merits, is immediately appealable. Budinich v. Becton Dickinson & Co., 486 U.S. 196, 201, 108 S. Ct. 1717, 1721-22, 100 L.Ed.2d 178 (1988); LaChance v. Duffy's Draft House, Inc., 146 F.3d 832, 837 (11th Cir. 1998).
  - (c) **Appeals pursuant to 28 U.S.C. Section 1292(a):** Appeals are permitted from orders "granting, continuing, modifying, refusing or dissolving injunctions or refusing to dissolve or modify injunctions..." and from "[i]nterlocutory decrees...determining the rights and liabilities of parties to admiralty cases in which appeals from final decrees are allowed." Interlocutory appeals from orders denying temporary restraining orders are not permitted.
  - (d) **Appeals pursuant to 28 U.S.C. Section 1292(b) and Fed.R.App.P.5:** The certification specified in 28 U.S.C. Section 1292(b) must be obtained before a petition for permission to appeal is filed in the Court of Appeals. The district court's denial of a motion for certification is not itself appealable.
  - (e) **Appeals pursuant to judicially created exceptions to the finality rule:** Limited exceptions are discussed in cases including, but not limited to: Cohen v. Beneficial Indus. Loan Corp., 337 U.S. 541, 546, 69 S.Ct. 1221, 1225-26, 93 L.Ed. 1528 (1949); Atlantic Fed. Sav. & Loan Ass'n v. Blythe Eastman Paine Webber, Inc., 890 F. 2d 371, 376 (11th Cir. 1989); Gillespie v. United States Steel Corp., 379 U.S. 148, 157, 85 S. Ct. 308, 312, 13 L.Ed.2d 199 (1964).
2. **Time for Filing:** The timely filing of a notice of appeal is mandatory and jurisdictional. Rinaldo v. Corbett, 256 F.3d 1276, 1278 (11th Cir. 2001). In civil cases, Fed.R.App.P.4(a) and (c) set the following time limits:
  - (a) **Fed.R.App.P. 4(a)(1):** A notice of appeal in compliance with the requirements set forth in Fed.R.App.P. 3 must be filed in the district court within 30 days after the entry of the order or judgment appealed from. However, if the United States or an officer or agency thereof is a party, the notice of appeal must be filed in the district court within 60 days after such entry. **THE NOTICE MUST BE RECEIVED AND FILED IN THE DISTRICT COURT NO LATER THAN THE LAST DAY OF THE APPEAL PERIOD - no additional days are provided for mailing.** Special filing provisions for inmates are discussed below.
  - (b) **Fed.R.App.P. 4(a)(3):** "If one party timely files a notice of appeal, any other party may file a notice of appeal within 14 days after the date when the first notice was filed, or within the time otherwise prescribed by this Rule 4(a), whichever period ends later."
  - (c) **Fed.R.App.P.4(a)(4):** If any party makes a timely motion in the district court under the Federal Rules of Civil Procedure of a type specified in this rule, the time for appeal for all parties runs from the date of entry of the order disposing of the last such timely filed motion.
  - (d) **Fed.R.App.P.4(a)(5) and 4(a)(6):** Under certain limited circumstances, the district court may extend the time to file a notice of appeal. Under Rule 4(a)(5), the time may be extended if a motion for an extension is filed within 30 days after expiration of the time otherwise provided to file a notice of appeal, upon a showing of excusable neglect or good cause. Under Rule 4(a)(6), the time may be extended if the district court finds upon motion that a party did not timely receive notice of the entry of the judgment or order, and that no party would be prejudiced by an extension.

(e) **Fed.R.App.P.4(c):** If an inmate confined to an institution files a notice of appeal in either a civil case or a criminal case, the notice of appeal is timely if it is deposited in the institution's internal mail system on or before the last day for filing. Timely filing may be shown by a declaration in compliance with 28 U.S.C. Section 1746 or a notarized statement, either of which must set forth the date of deposit and state that first-class postage has been prepaid.

3. **Format of the notice of appeal:** Form 1, Appendix of Forms to the Federal Rules of Appellate Procedure, is a suitable format. See also Fed.R.App.P. 3(c). A pro se notice of appeal must be signed by the appellant
4. **Effect of a notice of appeal:** A district court loses jurisdiction (authority) to act after the filing of a timely notice of appeal, except for actions in aid of appellate jurisdiction or to rule on a timely motion of the type specified in Fed.R.App.P. 4(a)(4).

Rev. 4/04

UNITED STATES DISTRICT COURT  
MIDDLE DISTRICT OF FLORIDA  
ORLANDO DIVISION

**GOOD SPORTS DAYTONA , INC., a  
Florida corporation, GOOD SPORTS,  
INC., a Connecticut corporation and  
DAYTONA REGIONAL CHAMBERS  
OF COMMERCE, INC., a Florida  
non-profit corporation,**

**Plaintiffs,**

**v.**

**Case No.: 6:11-cv-233-ORL-35-DAB**

**CONSOLIDATED DISTRIBUTORS,  
INC. a/k/a JOE COOL, INC., a New  
York corporation, JOE COOL, INC.,  
a Florida corporation, and METTEMP,  
INC., a New York corporation,**

**Defendants.**

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**ORDER**

**THIS CAUSE** comes before the Court for consideration of Plaintiffs' Motion for Entry of Final Default Judgment against Defendants Consolidated Distributors, Inc a/k/a Joe Cool, Inc., a New York Corporation ("Defendant Consolidated") and Mettemp, Inc., a New York Corporation ("Defendant Mettemp"). (Dkt. 36) Upon consideration of all relevant filings, case law, and being otherwise fully advised, the Court **GRANTS** Plaintiffs' Motion for Entry of Final Default Judgment (Dkt. 36), as described herein.

**I. BACKGROUND**

On February 11, 2011, Plaintiffs filed their Complaint in this case, seeking a declaration that the phrase "Daytona Beach Bike Week" does not function as a valid

trademark pursuant to 15 U.S.C. § 1125 and 28 U.S.C. § 2210 (Count I) and cancellation of trademark registration pursuant to FLA. STAT. § 495.101 (Counts II, III and IV). (Dkt. 1 at 4-8) Plaintiffs made several unsuccessful attempts to serve Defendants Consolidated and Mettemp. (See Dkts. 10, 11, 28, 28-1, 29, 29-1) As noted by this Court in its Order granting Plaintiff's Motion for Entry of Clerk's Default Against Defendants:

As shown by the affidavits that Plaintiffs have submitted, Plaintiffs have diligently searched for the Defendants. Plaintiffs have complied with [FLA. STAT.] § 48.161, the substitute service statute on nonresidents, by having the Secretary of State accept service on behalf of Consolidated and Mettemp; sending copies of the acceptance and copies of the process, including the Complaint, to every known address for the Defendants, and by filing an affidavit of compliance, attaching the certified mail envelopes showing that the certified mail was undeliverable. Though the return receipts were not filed, as the certified mail could not be delivered, where the nonresident defendant doing business in the state fails to file a correct address for the purposes of substituted service, plaintiff's attempt to effect service at the address furnished by the defendant is valid.

(Dkt. 31 at 4-5) (internal citation and quotation marks omitted) On July 6, 2011, the Clerk entered default against Defendants Consolidated and Mettemp. (Dkt. 32)

## II. FACTS

Based on the Complaint (Dkt. 1) and Plaintiffs' Motion (Dkt. 36), the Court finds as follows:

1. Plaintiffs are suing Defendants to invalidate their putative trademarking and enforcement of the phrase "Daytona Beach Bike Week," which Plaintiffs contend is generic and has been in use for the last seventy years.
2. This Court has jurisdiction over Plaintiffs and Defendants and has subject matter jurisdiction over this action.

3. Bike Week is an annual event that has been held in Daytona Beach, Florida since 1939. Hundreds of thousands of motorcycle enthusiasts congregate in Daytona Beach to ride, admire other motorcycles, and enjoy the Daytona Beach area.

4. Plaintiff Daytona Regional Chamber of Commerce (the "Chamber") has been the official manager and organizer of Bike Week since 1988, which was memorialized and ratified by the Daytona Beach City Commission by Resolution in 1995. The Chamber is the only entity with the authority to designate sponsors as "Official" Daytona Beach Bike Week sponsors (e.g. "Official Beer of Daytona Beach Bike Week"), and it has the exclusive right to license the official logo to vendors.

5. On April 14, 2009, Defendant Mettemp filed and obtained trademark No. T09000000380 from the State of Florida for use of the phrase "Daytona Beach Bike Week" in association with "clothing, shirts, and t-shirts," claiming first use on December 31, 1987, and claiming that "no other person . . . has the right to use such mark in Florida."

6. Plaintiffs used the phrase "Daytona Beach Bike Week" before the date claimed by Mettemp. At the time of Mettemp's application, Plaintiff Good Sports, Inc. had been using the phrase "Daytona Beach Bike Week" in association with clothing, namely t-shirts, shirts, caps, tops, bottoms, and jackets in the United States since 1983, when the company was first organized. Plaintiff Good Sports Daytona, Inc. had been selling such clothing since 2001.

7. On July 10, 2009, Defendant Consolidated filed Its Intent to Use Application No. 77/776,138 with the United States Patent and Trademark Office for use

of "Daytona Beach Bike Week" in association with "clothing, namely t-shirts, shirts, caps, tops, and bottoms." The Chamber opposed the application.

8. Since Bike Week's inception, innumerable vendors have sold products, including all manner of clothing, bearing the words "Daytona Beach Bike Week."

9. Consumers do not associate the phrase "Daytona Beach Bike Week" with any one source.

10. Defendants Consolidated and Mettemp have sent numerous letters to clothing vendors that use the phrase "Daytona Beach Bike Week," threatening that the use of the phrase is a violation of the Lanham Act and state law and constitutes infringement and counterfeiting of their alleged trademark, which they claimed is held by Defendant Mettemp and licensed to Defendant, Joe Cool, Inc., a Florida corporation.

11. Plaintiffs attempted to serve Defendants Consolidated and Mettemp at the addresses listed on the State of New York's Division of Corporations website. (Dkt. 28-1) The process server was unable to locate Consolidated or Mettemp at the addresses provided by Defendants to the New York Division of Corporations. Returns of Non-Service were filed with the Court on March 10, 2011. (Dkt. 10; Dkt. 11)

12. Defendants Consolidated and Mettemp operate, conduct, and engage in business in the State of Florida without having registered with the State of Florida Division of Corporations. On March 21, 2011, Plaintiffs served Defendants Consolidated and Mettemp via substituted service on the Florida Secretary of State, pursuant to Florida law. See FLA. STAT. §§ 48.161, 48.181.

13. Defendants had up to and including April 11, 2011, to file their response to Plaintiffs' Complaint. To date, Defendants Consolidated and Mettemp have failed to answer or otherwise defend this matter.

### III. LEGAL STANDARD AND ANALYSIS

"When a party against whom a judgment for affirmative relief is sought has failed to plead or otherwise defend as provided by these rules and that fact is made to appear by affidavit or otherwise, the clerk shall enter the party's default." Fed. R. Civ. P. 55(a). However, a defendant's default alone does not require the Court to enter a default judgment. DIRECTV, Inc. v. Trawick, 359 F. Supp. 2d 1204, 1206 (M.D. Ala. 2005). To enter a judgment, there must be sufficient basis in the pleadings to support the relief sought. Id. "The defendant is not held to admit facts that are not well-pleaded or to admit conclusions of law. In short . . . a default is not treated as an absolute confession of the defendant of his liability and of the plaintiff's right to recover." Nishimatsu Constr. Co., Ltd. v. Houston Nat'l Bank, 515 F.2d 1200, 1206 (5th Cir. 1975). If the facts in the complaint are sufficient to establish liability, then the court must conduct an inquiry to ascertain the amount of damages. See Adolph Coors Co. v. Movement Against Racism & the Klan, 777 F.2d 1538, 1543-44 (11th Cir. 1985). Damages may be awarded only if the record adequately reflects the basis for the award via a hearing or a demonstration of detailed affidavits establishing the necessary facts. See id. at 1544.

#### **A. Cancellation of Trademark – Counts II, III, and IV**

Pursuant to FLA. STAT. § 495.101, the Florida Department of State must cancel any trademark registration, if, inter alia:

[A] court of competent jurisdiction finds that:



- (a) The registered mark has been abandoned.
- (b) The registrant is not the owner of the mark.
- (c) The registration was granted improperly.
- (d) The registration was obtained fraudulently.
- (e) The mark is or has become the generic name for the goods or services, or a portion thereof, for which the mark has been registered.
- (f) The registered mark is so similar, as to be likely to cause confusion or mistake or to deceive, to a mark registered by another person in the United States Patent and Trademark Office, prior to the date of the filing of the application for registration by the registrant hereunder, and not abandoned; however, should the registrant prove that the registrant is the owner of a concurrent registration of a mark in the United States Patent and Trademark Office covering an area including this state, the registration hereunder shall not be canceled.

FLA. STAT. § 495.101(3)(a)-(f). Additionally, a registration must be cancelled by the Florida Department of State "when a court of competent jurisdiction . . . order[s] cancellation . . . on any ground." FLA. STAT. § 495.101(4).

Here, there is a sufficient basis for cancellation of Defendant Mettemp's trademark because it was fraudulently obtained or, alternatively, was improperly granted. At the time of Mettemp's application in April 2009, Plaintiff Good Sports, Inc. had been using the phrase "Daytona Beach Bike Week" in association with clothing and other goods since 1983. (Dkt. 1 at 4; Dkt. 36 at 6) Similarly, Plaintiff Daytona Regional Chamber of Commerce had been the official manager, organizer, and only entity with the authority to designate sponsors as "Official" Daytona Beach Bike Week sponsors since 1988. (Dkt. 1 at 4; Dkt. 36 at 5) Given these uncontested facts and the more than seventy year history of Daytona Beach Bike Week, from 1939 to present, the Court finds Defendant Mettemp's representation to the Florida Department of State in its trademark registration application that "no other person . . . has the right to use such mark in Florida" is fraudulent. Therefore, cancellation of the registration is appropriate

because it was fraudulently and/or improperly obtained. See FLA. STAT. § 495.101(3)(c),(d). Accordingly, Plaintiffs' request for a Final Default Judgment cancelling State trademark registration No. T09000000380 for the phrase "Daytona Beach Bike Week" is **GRANTED**.

**B. Declaration of Rights Under the Lanham Act and Request for Injunctive Relief – Count I**

Pursuant to 15 U.S.C. § 1125(a):

Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a)(1). A "trademark" includes "any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127. Trademark protection is available only to "distinctive" marks, i.e., marks that serve the purpose of identifying the source of goods or services. Welding Servs., Inc. v. Forman, 509 F.3d 1351,1357 (11th Cir. 2007). "Some marks are inherently distinctive; some marks, though not inherently distinctive, acquire distinctiveness by becoming associated

in the minds of the public with the products or services offered by the proprietor of the mark; and some marks can never become distinctive.” Id.

Trademark law distinguishes four gradations of distinctiveness of marks, in descending order of strength: fanciful or arbitrary, suggestive, descriptive, and generic. Tana v. Dantanna's, 611 F.3d 767, 774 (11th Cir. 2010). A “generic” mark describes the class to which a good belongs and suggests the basic nature of goods or services. Knights Armament Co. v. Optical Sys. Tech., Inc., 654 F.3d 1179, 1188 (11th Cir. 2011). Because generic marks are not distinctive and cannot acquire secondary meaning, they are generally incapable of receiving trademark protection and may never be registered as trademarks under the Lanham Act. Id.; see also 15 U.S.C. §1125(a).

Daytona Beach Bike week has been held in Daytona Beach, Florida for over seventy years. (Dkt. 1 at 3; Dkt. 36 at 5) During that time, innumerable vendors have sold products, including all manner of clothing, bearing the words “Daytona Beach Bike Week.” Plaintiff Good Sports, Inc. has been using the phrase “Daytona Beach Bike Week” on clothing, such as t-shirts, shirts, caps, tops, bottoms, and jackets since 1983. (Dkt. 1 at 4; Dkt. 36 at 5) Similarly, Plaintiff Good Sports Daytona, Inc. has been selling such clothing since 2001. (Id.) Since 1988, Plaintiff Daytona Regional Chamber of Commerce has managed and organized Bike week and maintains the exclusive right to license the official logo to vendors. (Id.) Because the phrase “Daytona Beach Bike Week” has been used by so many different entities over the past few decades, consumers do not associate the term or phrase with any one source and no one entity has had any control over the use of the phrase “Daytona Beach Bike Week” or the quality of the products on which the phrase was applied. (See id.) Therefore, the Court

finds that the phrase "Daytona Beach Bike Week" and its functional equivalents are generic and cannot receive trademark protection. See Knights Armament, 654 F.3d 1179, 1188; see also 15 U.S.C. §1125(a). Accordingly, Plaintiffs are entitled to a Final Default Judgment declaring that the phrase "Daytona Beach Bike Week" does not function as a trademark and is generic.

Plaintiffs are also entitled to an Order enjoining Defendants from threatening clothing vendors with letters stating that use of the phrase "Daytona Beach Bike Week" violates the Lanham Act and state law and constitutes infringement and counterfeiting of Defendants' purported trademark. Section 1116(a) provides that the Court:

[S]hall have power to grant injunctions, according to the principles of equity and upon such terms as the court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office or to prevent a violation under subsection (a), (c), or (d) of § 1125 of this title. Any such injunction may include a provision directing the defendant to file with the court and serve on the plaintiff within thirty days after the service on the defendant of such injunction, or such extended period as the court may direct, a report in writing under oath setting forth in detail the manner and form in which the defendant has complied with the injunction.

15 U.S.C. § 1116(a). Under the statute, a plaintiff is entitled to permanent injunctive relief if the plaintiff succeeds on the merits of his claims and if the equities involved favor injunctive relief. Defendants Consolidated and Mettempt have made false allegations of trademark infringement with the intent to interfere wrongfully with, disrupt, and injure the business operations of Plaintiffs and other vendors in Florida by harassing vendors for royalty payments earned in the distribution of t-shirts and other clothing bearing the phrase "Daytona Beach Bike Week." In this case, Plaintiffs assert and the Court agrees that this harassing and threatening conduct would likely continue in the absence of a permanent injunction. (Dkt. 36 at 7-8)

Accordingly, pursuant to Plaintiffs' request, it is hereby **ORDERED** that:

A Permanent Injunction is entered as to Defendants Consolidated Distributors, Inc a/k/a Joe Cool, Inc., a New York Corporation, and Mettemp, Inc., enjoining the Defendants, their agents, servants, employees, officers, directors, subsidiaries, and attorneys, and upon those persons in active concert or participation with them who receive actual notice of this Order by personal service or otherwise:

(a) From further asserting, contending, claiming, or alleging ownership, infringement, and/or dilution of the "Daytona Beach Bike Week" phrase; and

(b) From further harassment of Plaintiffs and other vendors via letter or otherwise.

**It is further ORDERED that:**

Plaintiffs' continued right to use the phrase "Daytona Beach Bike Week" shall be free and clear of interference or harassment without any obligation or liability to Defendants Consolidated Distributors, Inc a/k/a Joe Cool, Inc., a New York Corporation, and Mettemp, Inc.

**It is further ORDERED that:**

This Court shall retain jurisdiction of this action for purposes of enforcing the provisions of the Permanent Injunction by way of contempt or otherwise.

#### **IV. CONCLUSION**

Upon consideration of the foregoing, it is hereby **ORDERED** as follows:

(1) Plaintiffs' Motion for Entry of Final Default Judgment against Defendants Consolidated Distributors, Inc. a/k/a Joe Cool, Inc., a New York Corporation, and Mettemp, Inc. (Dkt. 36) is **GRANTED** as to all Counts and judgment is entered in

favor of Plaintiffs upon the Complaint herein;

(2) Plaintiffs' request for a permanent injunction is **GRANTED** as described herein;

(3) Pursuant to FLA. STAT. § 495.101, State of Florida trademark registration, No. T09000000380, for the phrase "Daytona Beach Bike Week" is hereby **CANCELLED**; and,

(4) The **CLERK** is directed to **ENTER JUDGMENT** consistent with this Order and **TERMINATE** all pending motions.

**DONE** and **ORDERED** in Orlando, Florida, this 19th day of December 2011.



MARY S. SCRIVEN  
UNITED STATES DISTRICT JUDGE

Copies Furnished to:  
All Counsel of Record  
Any Unrepresented Party