

ESTTA Tracking number: **ESTTA566527**

Filing date: **10/23/2013**

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

Proceeding	91205338
Party	Plaintiff Ms. Teresa H. Earnhardt
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Date	10/23/2013
Attachments	SAC 91205338_1.PDF(391583 bytes)

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

In the matter of Trademark Application
Serial No. 85/391,456
Filed: August 6, 2011
Trademark: EARNHARDT COLLECTION
Published: January 17, 2012

-----X		
Teresa H. Earnhardt,)	
)	
Opposer)	
)	Opposition No. 91205338
v.)	
)	
Kerry Earnhardt, Inc.,)	
)	
Applicant.)	
-----X		

SECOND AMENDED NOTICE OF OPPOSITION

Teresa H. Earnhardt, an individual having a mailing address of c/o Dale Earnhardt, Inc., 1675 Dale Earnhardt Highway No. 3, Mooresville, North Carolina 28115 (“Opposer”), believes that she will be damaged by the registration of the designation shown in Application Serial No. 85/391,456, filed August 6, 2011, by Kerry Earnhardt, Inc., a North Carolina corporation having a mailing address of P.O. Box 418, Mooresville, North Carolina 28115 (“Applicant”), and hereby opposes the registration of said designation as a service mark.

As grounds of opposition, it is alleged that:

1. Ralph Dale Earnhardt (“Dale Earnhardt”) was born April 29, 1951, the son of Ralph Earnhardt, who was, at that time, a successful competitive short-track stock car driver in North Carolina. Two years after his father’s death, Dale Earnhardt began his own professional career as a stock car driver in 1975. For the first few years of his professional racing career,

Dale Earnhardt drove in only a few races, but in 1979 his career shifted into another gear.

Racing as a rookie on what was then designated as the Winston Cup Series, he was so successful that he not only finished that year as one of the top ten stock car drivers (despite missing several races because of a broken collarbone) but also he won Rookie of the Year honors.

2. In the following years, NASCAR stock car racing enjoyed continuously increasing popularity across the country, and Dale Earnhardt arguably was the most colorful and most popular driver in a sport whose fans passionately identify with the persona of their favorite driver. As a means of identifying themselves to other NASCAR fans as part of Dale Earnhardt's fandom, legions of fans yelled "EARNHARDT!" loudly and proudly not only during races but also wherever and whenever NASCAR fans gathered.

3. During his career, Dale Earnhardt won 76 NASCAR races, 7 NASCAR Winston Cup Series championships, and finished among the top ten drivers in more than 400 races. His aggressive and daringly skillful driving not only brought unequalled success on the race track but also earned him the nickname, "The Intimidator." However, on the very last lap of the 2001 Daytona 500, while racing in the center of three cars side-by-side heading into Turn 3, a slight contact with one of the other two cars ignited a rapid sequence of events which tragically resulted in Dale Earnhardt's car hitting the track's outside wall nose-first at nearly 160 miles per hour. As the race's winner crossed the finish line, Dale Earnhardt had sustained a skull fracture and was mortally injured.

4. As noted above, one of the salient characteristics of NASCAR fans is their passionate identification with their favorite driver. As NASCAR stock car racing itself became much more popular nationwide during Dale Earnhardt's career, that characteristic of its fans spawned lucrative licensing and endorsement opportunities for NASCAR's more popular drivers. Dale Earnhardt, as the greatest persona in NASCAR history, took advantage of those

opportunities, and his name and persona were licensed for use during his lifetime on and in conjunction with a broad spectrum of products and services. Following his death, the commercial rights in Dale Earnhardt's name and persona have passed to his widow, Teresa H. Earnhardt, the Opposer in this proceeding.

5. It has been reported that, before Dale Earnhardt's death, the sales of his licensed merchandise totaled about \$50 million annually (13 B. Mullin, S. Hardy and W. Sutton, *Sport Marketing*, p. 201) and that, following his death, the sales have been even greater. *Id.* Moreover, that same publication states that "over 14,000 **Earnhardt collectibles** were on sale on the online auction site eBay (nearly 10,000 more than Michael Jordan items)." *Id.* In fact, more than a decade after Earnhardt's death, there remains a category of merchandise available and designated by eBay as "**Earnhardt Collectables.**" (See Exhibit A hereto.)

6. Still further, a book pertaining to the current practices of sports management notes the sustained popularity of Earnhardt collectables in recent years:

Possession and Authenticity of Collectables

Who is the world's most celebrated athlete? If you recall the earlier discussion about endorsements, you might answer Jordan, Woods, or Iverson. But if popularity is measured on the basis of sales of licensed products, the answer would be "The Intimidator," deceased NASCAR legend Dale Earnhardt, Sr. The sale of products licensed to Earnhardt, who did not survive a crash on the final lap of the 2001 Daytona 500, still generates millions in revenues and royalties. In addition, in the months following his death, over 14,000 Earnhardt items were reported for sale on eBay, the online auction Web Site. The sales will continue for years....

Principles and Practice of Sport Management by Lisa Pike Masteralexis, Carol A. Barr, and Mary A. Hums (2008), at page 424.

7. Thus, just as it did during his lifetime and racing career, the designation "EARNHARDT" continues to identify Dale Earnhardt to millions of people in this country.

8. Likewise, just as it did during his lifetime and racing career, the term

“EARNHARDT COLLECTABLES,” to many people in this country, connotes merchandise which is associated with and/or enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest.

9. Moreover, since at least as early as 1975, the designations EARNHARDT and DALE EARNHARDT have been used continuously in this country as both trademarks and as service marks by Dale Earnhardt and his successor-in-interest and their licensees, on and in conjunction with a wide array of goods and services. The availability of such merchandise under the EARNHARDT and DALE EARNHARDT marks has been advertised and promoted at considerable expense.

10. By reason of the adoption and continuous use of the EARNHARDT and DALE EARNHARDT marks, each of those designations has a distinctive quality and has acquired special and particular significance and very valuable goodwill as identifying the businesses of Dale Earnhardt and his successor-in-interest and the merchandise authorized by them. The EARNHARDT and DALE EARNHARDT marks have each become famous and distinctive through, *inter alia*, extensive use, advertising and promotion of those marks throughout the United States over a substantial period of time on and in conjunction with a variety of merchandise and services.

11. Consequently, through such usage and recognition, Opposer has acquired common-law rights in each of the EARNHARDT and DALE EARNHARDT designations as a proprietary trademark, which rights extend, without limitation, to Opposer’s exclusive right to use such designations nationwide (directly or through her licensees) on and in conjunction with various goods and services.

12. Opposer is also the owner of a U.S. registration for the DALE EARNHARDT mark, Registration No. 1,644,237 (the “DALE EARNHARDT Registration”). Opposer’s DALE

EARNHARDT Registration is valid, subsisting, and in full force and effect. Moreover, Opposer's DALE EARNHARDT Registration is incontestable, and, as such, serves as conclusive evidence of Opposer's exclusive right to use (or license the use of) the DALE EARNHARDT mark on and in conjunction with all of the goods and services listed in said registration.

13. On July 28, 2011, Applicant filed the intent-to-use application at issue to register the designation EARNHARDT COLLECTION ("Applicant's Mark") as a service mark for use in conjunction with the custom construction of homes. In doing so, Applicant disclaimed the right to use the term "COLLECTION" apart from the designation as a whole. Thus, the only element of Applicant's putative designation not disclaimed is the term "EARNHARDT."

14. Opposer's predecessor-in-interest, Dale Earnhardt, has been known by a substantial portion of the public in this country as "EARNHARDT" and/or as "DALE EARNHARDT," continuously from long prior to Applicant's filing of the subject application through the present time.

15. Merchandise which is associated with and/or enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest has often been referred to by the public as "EARNHARDT COLLECTABLES," continuously from long prior to Applicant's filing of the subject application through the present time.

16. The opposed designation, EARNHARDT COLLECTION, is the same or a close approximation of the name and identity EARNHARDT.

17. The opposed designation, EARNHARDT COLLECTION, is the same or a close approximation of the name and identity DALE EARNHARDT.

18. The opposed designation, EARNHARDT COLLECTION, would be recognized in the United States as pointing uniquely and unmistakably to Dale Earnhardt or his commercial successor-in-interest. Thus, rather than perceiving the EARNHARDT COLLECTION

designation having some other meaning, a substantial portion of the public would view that designation as being associated with Dale Earnhardt.

19. Applicant does not have Opposer's permission to use the designation EARNHARDT COLLECTION, and Applicant's potential use of the designation EARNHARDT COLLECTION in conjunction with custom homes will not enjoy any sponsorship, approval or other commercial connection with Dale Earnhardt or Opposer.

20. However, each of the designations EARNHARDT and DALE EARNHARDT enjoys such fame or reputation that a commercial connection with Dale Earnhardt would be presumed from Applicant's potential use of the designation EARNHARDT COLLECTION in conjunction with custom homes in this country.

21. Thus, just as the usage today of "EARNHARDT COLLECTABLES" connotes in this country merchandise which enjoys a commercial sponsorship or approval of Dale Earnhardt or his successor-in-interest, Applicant's potential use of EARNHARDT COLLECTION in conjunction with custom homes may falsely suggest to the public in this country that such homes enjoy a sponsorship, approval or other commercial connection with Dale Earnhardt or his successor-in-interest.

22. Pursuant to 15 U.S.C. § 1052(a), inasmuch as Applicant's EARNHARDT COLLECTION custom homes designation "may...falsely suggest a connection with" Dale Earnhardt, that designation may not be registered lawfully by Applicant.

23. Still further, each of the EARNHARDT and DALE EARNHARDT marks is not only a distinctive mark, but also a famous mark, particularly when used on and in conjunction with collectables, and each of the EARNHARDT and DALE EARNHARDT marks acquired that status as a famous mark prior to either the first usage in commerce of the Applicant's EARNHARDT COLLECTION designation (if any such usage has been made) or the filing date

of the opposed application.

24. Hence, the application to register the EARNHARDT COLLECTION mark should also be refused pursuant to 15 U.S.C. §§ 1063(a) and 1125(c) on the basis that the usage of that designation in conjunction with custom homes is likely to cause dilution by blurring of each of the famous EARNHARDT and DALE EARNHARDT marks.

25. The first component of Applicant's EARNHARDT COLLECTION designation, "EARNHARDT," is visually and aurally identical to both Opposer's common law EARNHARDT mark and the second component of Opposer's federally registered DALE EARNHARDT mark. These characteristics create a likelihood of confusion with both the EARNHARDT and DALE EARNHARDT marks. Further, the second component of Applicant's designation, COLLECTION, is a descriptive term when used in the context of custom homes, has been disclaimed by Applicant because of that descriptiveness, and thus does not impart any distinctiveness to Applicant's designation. Moreover, the custom homes listed in Applicant's application are types of products or services which the public may reasonably expect or believe to enjoy a license of the EARNHARDT and DALE EARNHARDT marks. Thus Applicant's EARNHARDT COLLECTION designation, when used in connection with custom homes, is likely to deceive or cause confusion or mistake as to the source or sponsorship of Applicant's custom homes in relation to Opposer and the EARNHARDT and DALE EARNHARDT merchandise.

26. Thus, Applicant's application for registration of the EARNHARDT COLLECTION mark should also be refused under 15 U.S.C. § 1052(d).

27. Additionally and/or in the alternative, the designation EARNHARDT COLLECTION is primarily merely a surname.

28. Thus, Applicant's application for registration of the EARNHARDT

COLLECTION mark should also be refused under 15 U.S.C. § 1052(e)(4).

SUMMARY

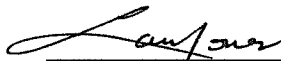
29. The application for registration of EARNHARDT COLLECTION should be refused under any or all of: 15 U.S.C. §1052(a) (false suggestion of a connection); 15 U.S.C. § 1063(a) and 15 U.S.C. § 1125(c) (dilution); 15 U.S.C. § 1052(d) (likelihood of confusion); and/or 15 U.S.C. § 1052(e)(4) (primarily merely a surname).

30. Accordingly, Opposer asserts, pursuant to 15 U.S.C. § 1063, that it will be damaged by the issuance of a registration for the EARNHARDT COLLECTION custom homes designation to Applicant as sought in Trademark Application Serial No. 85/383,910.

WHEREFORE, Opposer prays that the application for registration of Applicant's EARNHARDT COLLECTION designation be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Please charge all fees incurred by Opposer in conjunction with this proceeding to the firm's Deposit Account No. 16-0605.

Respectfully submitted,



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Larry.Jones@alston.com

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www.walmart.com/search/search-ng.do?...earnhardt+collectables

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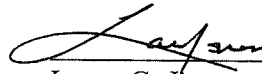
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing *Second Amended Notice of Opposition* was duly served on Applicant by depositing a copy of same in the United States mail, first-class postage prepaid, on the 24th day of October, 2013 addressed to Applicant's attorneys of record as follows:

D. Blaine Sanders
Matthew F. Tilley
Robinson Bradshaw & Hinson, P.A.
101 N. Tryon Street, Suite 1900
Charlotte, NC 28246-0106



Larry C. Jones