

ESTTA Tracking number: **ESTTA875614**

Filing date: **02/06/2018**

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	Rotary Club of Houston, Inc.		
Entity	Corporation	Citizenship	Texas
Address	PO BOX 22027 Houston, TX 77227-2027 UNITED STATES		

Attorney information	Mark A Oathout Oathout Law Firm 3701 KIRBY DR, STE 960 HOUSTON, TX 77098-3922 UNITED STATES Email: mark@oathoutlaw.com Phone: 7135226565
----------------------	--

Applicant Information

Application No	87584637	Publication date	01/09/2018
Opposition Filing Date	02/06/2018	Opposition Period Ends	02/08/2018
Applicant	Lombardi Foundation Inc. 1300 Post Oak Blvd., Suite 2000 Houston, TX 77056 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 1971/01/21 First Use In Commerce: 1971/01/21 All goods and services in the class are opposed, namely: Promoting interest, excellence, discipline and sportsmanship in scholastic football through the medium of an annual award to the outstanding player of the year; providing recognition by the way of awards to demonstrate excellence in the field of football

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is merely descriptive	Trademark Act Section 2(e)(1)
The mark is primarily merely a surname	Trademark Act Section 2(e)(4)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Applicant not rightful owner of mark for identified goods or services	Trademark Act Section 1
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
Other	Priority of common law mark and likelihood of confusion

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LOMBARDI AWARD		
Goods/Services	Promoting interest, excellence, discipline and sportsmanship in scholastic football through the medium of an annual award to the outstanding player of the year; providing recognition by the way of awards to demonstrate excellence in the field of football. Presenting an honor annually to the outstanding college football lineman/player of the year including outstanding athletic performance and skill and exemplifying discipline, virtue, courage and wisdom in the spirit of the late coach Vince Lombardi style of leadership. Fund-raising benefiting cancer research and hospitals.		

Attachments	NoticeOfOpposition.pdf(501970 bytes)
-------------	---------------------------------------

Signature	/Mark Oathout/
Name	Mark A Oathout
Date	02/06/2018

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

Rotary Club of Houston, Inc.)	Serial No.: 87/584,637
)	
Plaintiff-Opposer,)	Opposition No.: _____
)	
v.)	
)	Mark: LOMBARDI AWARD
Lombardi Foundation Inc.)	
)	Published: January 9, 2018
Defendant-Applicant)	Filing Date: August 25, 2017

NOTICE OF OPPOSITION

In the matter of Application Serial No. 87/584,637 for registration of “LOMBARDI AWARD” in International Class 041 by Lombardi Foundation Inc. (Applicant), which was published in the Official Gazette on January 9, 2018 (Application), Rotary Club of Houston, Inc. (Opposer), a non-profit Texas Corporation having a mailing address at PO Box 22027, Houston, TX 77227-2027, believes it will be damaged by the registration and therefore opposes on the following grounds. Allegations with respect to Opposer are based upon actual knowledge. Allegations with respect to Applicant and third parties are based upon information and belief:

1. Opposer is generally a group of Houston business leaders as volunteers working together collaboratively to impact positive change in the greater Houston community and around the world, operating consistently with the Rotary's motto of ‘Service Above Self’. One of its service projects includes the LOMBARDI AWARD honor presented annually to the outstanding college football lineman/player of the year including outstanding athletic performance and skill and exemplifying discipline, virtue, courage and wisdom in the spirit of the late coach Vince Lombardi style of leadership. The LOMBARDI AWARD is also a fund-raising event (for over 45 years running) benefiting cancer research. Opposer

promotes the LOMBARDI AWARD honor and granite trophy annually since 1970 and provides the LOMBARDI AWARD honor and granite trophy annually since 1971 (until impeded this year).

2. Opposer disseminates information from related and/or affiliated websites <http://www.rotaryhouston.org> and www.rotarylombardiaward.org.
3. Vince Lombardi was a famous football coach now deceased. It is believed that Vince Lombardi died of cancer during September of 1970.
4. After Vince Lombardi passed away, the descendants of Vince Lombardi assigned or failed to exercise ownership and/or adequate control over “Lombardi” and/or “LOMBARDI AWARD” as a trademark/servicemark, over quality, and related goods/services; or the descendants of Vince Lombardi never owned “Lombardi” and/or “LOMBARDI AWARD” as a trademark/servicemark,.
5. At least the NFL/ NFL PROPERTIES LLC, not the descendants of Vince Lombardi, own a registered trademark in VINCE LOMBARDI TROPHY, US Registration No. 0983550.
6. Applicant seeks to register the mark “LOMBARDI AWARD ” in connection with “Promoting interest, excellence, discipline and sportsmanship in scholastic football through the medium of an annual award to the outstanding player of the year; providing recognition by the way of awards to demonstrate excellence in the field of football” in International Class 041.
7. Applicant is a Texas Corporation having an address at 1300 Post Oak Blvd., Suite 2000 Houston, Texas 77056. It is believed Applicant’s entity was incorporated in Texas on August 16, 2017.

8. Only nine days later on August 25, 2017, the opposed application serial no. 87/584,637 was filed by Applicant under Section 1(a) on an ‘actual use’ in commerce basis.
9. The opposed application serial no. 87/584,637 was filed by the same attorney(s) who represented Opposer at least in the past on at least application serial no. 85/620,791 filed May 9, 2012 for the mark ROTARY LOMBARDI AWARD.
10. Applicant is not a ‘related company’ of Opposer pursuant to 15 U.S.C. § 1055 and § 1127.
11. For 2018 together with Opposer’s actions as a good faith service organization intending to benefit cancer research and its partners, the Applicant, and Mr. John Lombardi impeded Opposer from moving forward with its LOMBARDI AWARD honor and trophy.
12. Applicant has not used the LOMBARDI AWARD mark since January 21, 1971 as alleged in its application for registration, is not a ‘related company’ of Opposer, and was only formed during August of 2017.
13. Richard Slemaker is reportedly the Chairman of the Applicant. A Richard Slemaker has reportedly been involved in a trademark dispute in the past
<https://www.businesswire.com/news/home/20030325005537/en/World-Energy-Imitator-Ordered-Stop-Infringement> .

Count I

14. Pursuant to 15 U.S.C. §§ 1052(e)(1) & (4) the alleged LOMBARDI AWARD mark as it relates to Applicant is comprised of primarily merely a surname and merely descriptive of the recited services inasmuch as “Lombardi” as it relates to Applicant is a surname, and “Award” describes an ingredient, quality, characteristic, function, feature, purpose or

use of the recited services and has not acquired distinctiveness or secondary meaning under Section 2(f) of the Trademark Act due to: the alleged mark is not adapted to distinguish and does not actually distinguish the services with which it is intended to be used, or in respect to any use of the alleged mark by Applicant. The mark is not inherently distinctive as with respect to Applicant, and has not acquired distinctiveness as with respect to Applicant.

Count II

15. In the Alternative, Opposer alleges, on information and belief, that Opposer has superior rights based on prior use (by it and/or its related company or companies, or affiliates) of LOMBARDI AWARD as a trademark and/or service mark, which use has been valid and continuous and has afforded Opposer superior rights in same, prior to the use and prior to the filing date of Applicant's Application.
16. Opposer, on information and belief, has also used since at least as early as the date of 1970-1971, continues to use and has not abandoned, and never intended to abandon, in interstate commerce its mark LOMBARDI AWARD for its appurtenant services.
17. Opposer alleges, on information and belief that the services set forth in the opposed Application Serial No. 87/584,637 are or will be offered to the same class of purchasers and users who purchase and use Opposer' s services.
18. Opposer believes pursuant to 15 U.S.C. § 1052(d) that the applied-for mark so resembles Opposer's mark that, as used in connection with the applied-for services, it would be likely to cause confusion, mistake, or deception of the relevant trade and public, to the damage of Opposer including damage which would be conferred by granting Applicant a

Registration and irreparable damage to the valuable goodwill established in Opposer's mark and services.

Count III

19. Through Opposer's use, extensive advertising and promotion dating back to 1970-1971 in connection with the services recited in Applicant's application, Opposer is the owner of the LOMBARDI AWARD mark. Applicant is not the rightful owner of the mark for the identified services.

Count IV

20. Through Opposer's use, extensive advertising and promotion, Opposer's LOMBARDI AWARD mark has become distinctive and famous for Opposer's services. The application for Applicant's mark was filed long after Opposer's mark became distinctive and famous for Opposer's services. Applicant's mark is likely to blur or tarnish the positive associations of Opposer's famous mark. Thus, in addition, if Applicant were granted the registration herein opposed, it would cause dilution of the distinctive quality of Opposer's famous LOMBARDI AWARD mark.

Count V

21. Applicant's mark is the same or substantially similar to Opposer's LOMBARDI AWARD mark and because of the extensive use of Opposer's mark by Opposer, Applicant's mark would be recognized by consumers and the trade as pointing uniquely and unmistakably to Opposer.
22. Opposer is not presently connected with the services to be offered by the Applicant identified in the application herein opposed. Yet, because of the renown and reputation

of the Opposer's LOMBARDI AWARD mark and Opposer's identity as a not-for-profit entity, the public and the trade will presume a connection between the Opposer and the Applicant when Applicant's mark is used in connection with such services. Accordingly, Applicant's mark is not entitled to registration pursuant to 15 U.S.C. § 1052(a).

Count VI

23. Applicant's mark was not used in commerce before Applicant's Application Serial No. 87/584,637 was filed.

Count VII

24. Applicant alleged in its Application Serial No. 87/584,637, through its attorney, that Applicant commenced use of its mark on January 21, 1971; indicated that it believed it was the owner of the LOMBARDI AWARD mark sought to be registered; indicated the mark was in use in commerce on the services recited in the application; that the specimen shows the mark as used in connection with its services (said specimen being directly copied from and that of Opposer in conjunction with its volunteers); indicated that it commenced use more than five years immediately before the date the Application Serial No. 87/584,637 was filed; indicated it believed Applicant believed it was entitled to use the mark in commerce; that the facts recited in the application are accurate; that to the best of its signatory knowledge and belief that no other persons has the right to use the mark in commerce; and that after inquiry reasonable under the circumstances that the allegations and other factual contentions made have evidentiary support. In so doing Applicant knowingly made false, material representations with intent to deceive and defraud the US Patent & Trademark Office.

25. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of the mark. Such registration would be a source of damage and injury to the Opposer, requiring Opposer to abandon its use of LOMBARDI AWARD, and change any current or planned promotional and advertising tactics, all to the great detriment of Opposer and its benefactors.
26. As the Opposer (by itself and/or by its related company/companies, or affiliates) presently uses, and has for an extended period of time utilized LOMBARDI AWARD in association with the provision of its services, and as the recited services are within the services rendered by Opposer's business, the Opposer has a direct and personal stake in the outcome of the proceeding.

Relief Requested

Wherefore, Opposer prays that this opposition be sustained, that Application Serial No. 87/584,637 be rejected and denied and the mark applied-for therein refused registration.

Payment in the amount of \$400.00 is enclosed to cover the statutory filing fee.

Respectfully submitted,

Rotary Club of Houston, Inc.

Date: February 6, 2018

/Mark Oathout/

By: Mark A. Oathout
USPTO Reg. No. 33,747
Texas Bar No. 15160300
3701 Kirby Drive, Suite 960
Houston, TX 77098
Telephone: 713-522-6565
Facsimile: 713-522-8889
mark@oathoutlaw.com

Attorney for Plaintiff, Rotary Club of Houston, Inc.