

ESTTA Tracking number: **ESTTA1041167**

Filing date: **03/10/2020**

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 | Department of the Army |
| Granted to Date of previous extension | 03/11/2020 |
| Address | THE PENTAGON WASHINGTON, DC 20310 UNITED STATES |

| | |
|----------------------|------------------------------------------------------------------------------------------------------------------------------------------------|
| Attorney information | SARAH GARDNER-COX ATTN: MAJA-AL 646 SWIFT RD WEST POINT, NY 10996 UNITED STATES sarah.gardner-cox@westpoint.edu 410-836-8150 |
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Applicant Information

| | | | |
|------------------------|-----------------------------------------------------------------------------------------------------------------------------------|------------------------|------------|
| Application No | 88477294 | Publication date | 11/12/2019 |
| Opposition Filing Date | 03/10/2020 | Opposition Period Ends | 03/11/2020 |
| Applicant | Challenge Skateboard Corp., Ltd 29C of North Block, Hubei Building Binhe Road, Futian District Shenzhen, 518048 CHINA | | |

Goods/Services Affected by Opposition

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|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Class 028. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Bodyboards; Paddleboards; Skateboards; Skis; Snowshoes; Surf skis; Surfboard leashes; Surfboards |
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Grounds for Opposition

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|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
|--------------------------------------|----------------------------|

Marks Cited by Opposer as Basis for Opposition


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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2699081 | Application Date | 07/15/1999 |
| Registration Date | 03/25/2003 | Foreign Priority Date | NONE |

| | |
|---------------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Word Mark | BLACK KNIGHTS |
| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 1973/00/00 First Use In Commerce: 1973/00/00 Collegiate sports apparel, namely, [belts;] shirts; sport shirts; knit shirts; golf shirts; T-shirts; sweat shirts and pants; sweaters; shorts; jackets; hats; visors; infant wear; toddler wear, namely, shirts, pants and jackets, sold primarily to students at the United States Military Academy, alumni, Department of Defense employees, and members of the United States Military and their families |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3711271 | Application Date | 11/13/2008 |
| Registration Date | 11/17/2009 | Foreign Priority Date | NONE |

| | |
|---------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Word Mark | BLACK KNIGHTS |
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 024. First use: First Use: 1973/09/00 First Use In Commerce: 2000/09/00 Banners, namely, cloth banners; flags, namely, fabric flags; quilts; blankets, namely, throw blankets Class 041. First use: First Use: 1973/09/00 First Use In Commerce: 1973/09/00 [Educational services, namely, conducting undergraduate and military courses of instruction; entertainment services, namely, collegiate sporting events] |

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 5176324 | Application Date | 09/01/2016 |
| Registration Date | 04/04/2017 | Foreign Priority Date | NONE |

| | |
|----------------|--------------------------------------------------------------------------------------|
| Word Mark | BLACK KNIGHTS |
| Design Mark |  |
| Description of | NONE |

| | |
|----------------|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Mark | |
| Goods/Services | Class 009. First use: First Use: 1973/00/00 First Use In Commerce: 1973/00/00 Cases for mobile phones; Cell phone covers; Protective covers and cases for cell phones, laptops and portable media players |

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| Attachments | 77613828#TMSN.png(bytes) 87158644#TMSN.png(bytes) Notice of Opposition to Black Knight Skateboards.pdf(1175214 bytes) |
|-------------|----------------------------------------------------------------------------------------------------------------------------------|

| | |
|-----------|---------------------|
| Signature | /Sarah Gardner-Cox/ |
| Name | SARAH GARDNER-COX |
| Date | 03/10/2020 |

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

| | | |
|---------------------------------|---|------------------------------|
| DEPARTMENT OF THE ARMY, |) | |
| |) | |
| |) | |
| Opposer, |) | In the matter of Application |
| |) | Serial No. 88477294- |
| |) | BLACK KNIGHT |
| |) | |
| Challenge Skateboard Corp., Ltd |) | |
| |) | |
| |) | |
| Applicant. |) | |

NOTICE OF OPPOSITION

The Department of the Army (“Opposer”), an agency of the United States Government organized under 10 U.S.C. §7011, et seq. and headquartered at the Pentagon, Washington, D.C. 20310, believes it will be damaged by the registration of the mark BLACK KNIGHT (standard characters) as reflected in Application Serial No. 88477294, and opposes the registration of this application pursuant to 15 U.S.C. §1063 and 37 C.F.R §§2.101, 2.104(a). The grounds for the opposition are as follows:

1. Challenge Skateboard Corp., Ltd, is a corporation organized in China with an address of 29C of North Block, Hubei Building, Binhe Road, Futian District, Chenzhen China 518048.
2. On June 21, 2019, Applicant filed the subject application to register the mark BLACK KNIGHT, in standard characters, assigned Application Serial No. 88477294 for “Bodyboards; Paddleboards; Skateboards; Skis; Snowshoes; Surf Skis; Surfboard leashes; and Surfboards” in Class 28.

3. The Applicant has filed the application as an intent to use application.
4. The Applicant has not claimed any font style, size or color.
5. The application was published in the Official Gazette on November 12, 2019.
6. The opposer timely filed a Request for Extension of Time to Oppose which was granted through March 11, 2020. Opposer now timely files this Notice of Opposition.
7. Opposer is a military agency under the Department of Defense and a member of the United States Armed Forces for the United States government.
8. Opposer currently holds three registration for the mark BLACK KNIGHTS, namely:
 - a. USPTO Reg. No. 2699081, originally registered in March 2003;
 - b. USPTO Reg. No. 3711271, originally registered in November 2009;
 - c. USPTO Reg. No. 5176324, registered in 2017.
9. Opposer contends that Applicant's mark BLACK KNIGHT is confusingly similar to Opposer's mark BLACK KNIGHTS.
10. Through its longstanding, widespread, and continuous use of its mark, Opposer has acquired exclusive rights in the mark that predates any rights upon which Applicant may rely.
11. As a result of longstanding and extensive use, Opposer's BLACK KNIGHTS mark is symbolic of the extensive goodwill and public recognition established by the United States Army and the United States Military Academy (USMA).
12. Opposer's mark is famous and became famous before the filing date of Applicant's Application Serial No. 88477294 herein.

13. Opposer's use of its BLACK KNIGHTS mark and common law rights extend to the U.S. Government and USMA before the filing of the Applicant's application herein.

14. Since at least as far back as 1973, Opposer has used and continues to use the Opposer's BLACK KNIGHTS mark in connection with the USMA athletic teams. See attached screenshots of the NCAA Army West Point and West Point Club Hockey webpages as "Exhibit A."

15. The parties' marks share nearly identical words and commercial impressions. The Applicant's BLACK KNIGHT is confusingly similar in sound, meaning and appearance to the Opposer's BLACK KNIGHTS mark.

16. The Applicant wishes to register the mark BLACK KNIGHT in class 28 for games and sporting goods. Opposer already uses their mark BLACK KNIGHTS in connection with items found in class 28. See attached screenshot of cornhole board tailgate toss set and washer toss game set as "Exhibit B." Both parties use their marks in connection with games and sporting goods, thus, Applicant's services are likely to be perceived by the public as sponsored by, affiliated with, approved by or otherwise related to Opposer.

17. Opposer sells skateboards with other marks registered to Opposer. See attached screenshot of skateboard as "Exhibit C." It is not a far stretch of the imagination that Opposer would also sell skateboards with the mark BLACK KNIGHTS. In fact, these skateboards can be personalized as evidenced in "Exhibit D."

18. If Applicant is allowed to register exclusive rights in BLACK KNIGHT in connection with games and sporting goods, the public is likely to be confused as to whether the

U.S. Government, including USMA, or the Applicant controls the quality and nature of the services or endorses or sponsors Applicant's services.

19. Applicant's application for a trademark registration and its intended use of the mark are without the consent, authorization, license or permission of the Opposer.

20. Under Section 13 of the Lanham Act, 15 U.S.C. §1063, Opposer believes it will be damaged by the registration of Applicant's BLACK KNIGHT proposed mark because it so resembles Opposer's BLACK KNIGHTS mark as to be likely to cause confusion, mistake, or deceive consumers, with consequent injury to the Opposer and the public, in violation of Sections 2(a) and 2(d) of the Lanham Act, 15 U.S.C. §1052(a) & (d).

21. Under Section 13 of the Lanham Act, 15 U.S.C. §1063, Opposer believes it will be damaged by the registration of the BLACK KNIGHT mark because the use and registration of designation is likely to dilute the distinctive quality of Opposer's famous BLACK KNIGHTS mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).

WHEREFORE, Opposer requests that Application Serial No. 88477294 be refused registration, that this Notice of Opposition be sustained in Opposer's favor, and that the Trademark Trial and Appeal board grant such other relief as it deems just and proper.

The filing fee of \$400.00 is submitted herewith.

DEPARTMENT OF THE ARMY
Opposer

By /Sarah Gardner-Cox/

Sarah Gardner-Cox
Attorney for Opposer
Administrative and Civil Law Division
United States Military Academy
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West Point, NY 10996
Tel: 410-836-8150
sarah.gardner-cox@westpoint.edu

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION is being served on the Applicant's counsel on March 11, 2020 via US Mail to:

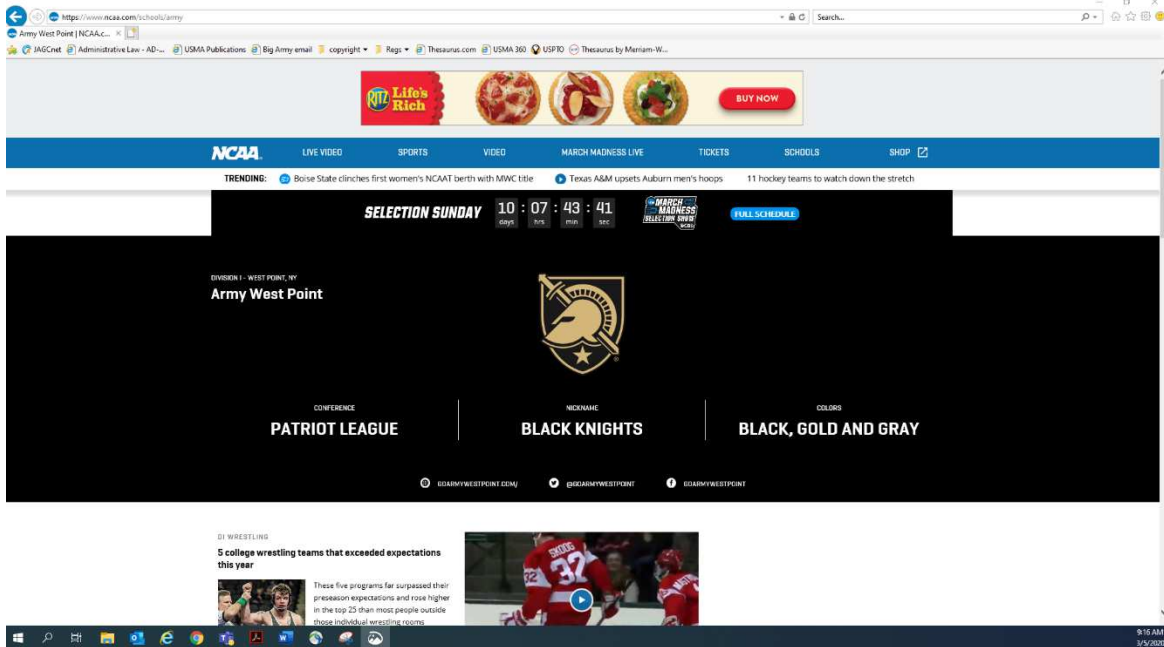
Felipe Rubio
Rubio & Associates
8950 SW 74th Ct, Suite 1804
Miami, FL 33156

A courtesy copy was emailed to Applicant's counsel as well.

 /Sarah Gardner-Cox/
Sarah Gardner-Cox
United States Military Academy

Exhibit A

NCAA page regarding Army West Point



Club Hockey Webpage

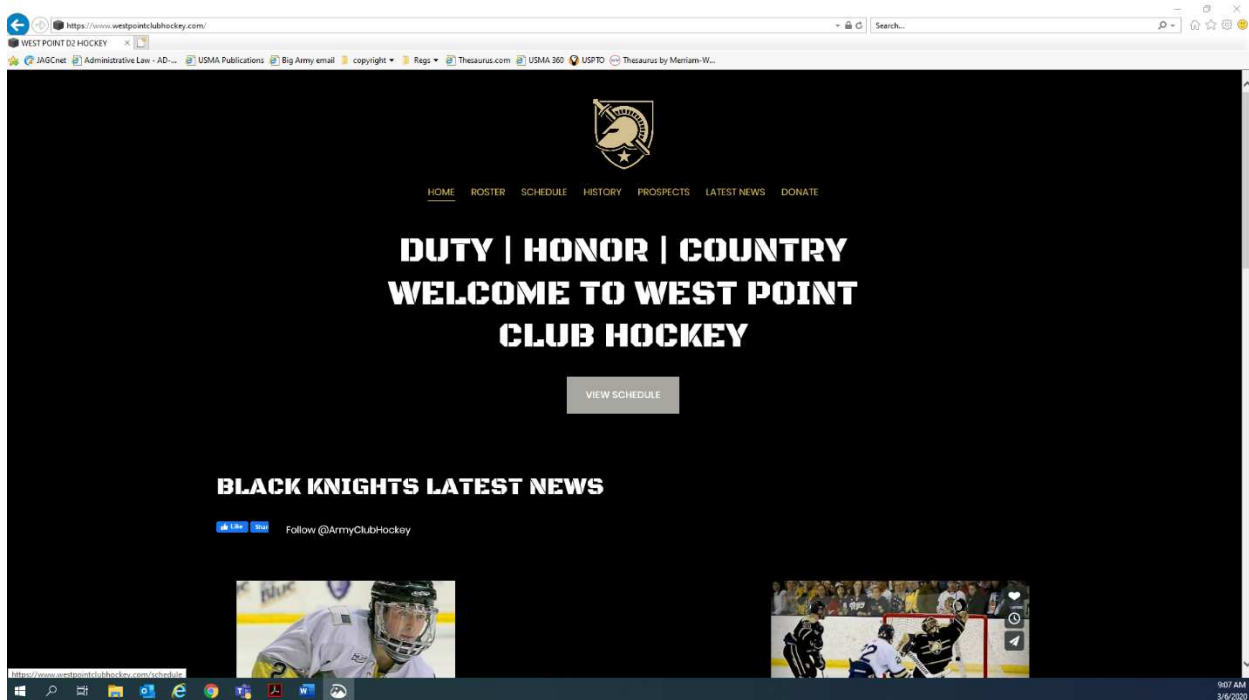


Exhibit B

The screenshot shows a web browser window displaying the Army West Point online store. The URL is <https://shop.goarmysports.com/army-black-knights-onyx-stained-washer-toss-game-set>. The page features a navigation bar with categories like MEN, WOMEN, KIDS, T-SHIRTS, SWEATSHIRTS, HATS, JERSEYS, ACCESSORIES, HOME & OFFICE, GAMEDAY & TAILGATE, and CLEARANCE. A promotional banner at the top indicates 'ENDS SATURDAY AT 11:59 PM ET' and 'UP TO 65% OFF SITEWIDE'. The main product image shows a black carrying case with the Army West Point logo, an open box containing a white cup, and several washers. The product title is 'Army Black Knights Onyx Stained Washer Toss Game Set'. The price is listed as '\$50.99 with code: 65SALE', with a regular price of '\$65.99' and a 'You Save: \$9.00' amount. A quantity selector is set to 1, and an 'Add to Cart' button is visible. Shipping information states 'THIS IS A MANUFACTURER DIRECT ITEM. THIS ITEM SHIPS ON OR BEFORE Thursday, March 12th'. The details section includes product ID 3828714, material (100% Wood - Shell: 100% Plastic - Ring: 100% Metal), washers, age (14+), included instructions, laser engraved logo, 8 washers (4 black, 4 white), dimensions (15" x 13" x 7.5"), and notes that it is for indoor/outdoor play, requires no assembly, and is officially licensed.

The screenshot shows a web browser window displaying the Army West Point online store. The URL is <https://shop.goarmysports.com/army-black-knights-2-x-4-museum-design-cornhole-board-tailgate-toss-set>. The page features a navigation bar with categories like MEN, WOMEN, KIDS, T-SHIRTS, SWEATSHIRTS, HATS, JERSEYS, ACCESSORIES, HOME & OFFICE, GAMEDAY & TAILGATE, and CLEARANCE. A promotional banner at the top indicates 'ENDS SATURDAY AT 11:59 PM ET' and 'UP TO 65% OFF SITEWIDE'. The main product image shows two wooden cornhole boards with the Army West Point logo and 'ARMY WEST POINT BLACK KNIGHTS EST. 1862' text. The product title is 'Army Black Knights 2' x 4' Museum Design Cornhole Board Tailgate Toss Set'. The price is listed as '\$212.49 with code: 65SALE', with a regular price of '\$249.99' and a 'You Save: \$37.50' amount. A quantity selector is set to 1, and an 'Add to Cart' button is visible. Shipping information states 'THIS IS A MANUFACTURER DIRECT ITEM. THIS ITEM SHIPS ON OR BEFORE Thursday, March 12th'. The details section includes product ID 2346454, material (100% Wood - Game Boards; 100% Cotton Duck Cloth - Bags), perfect holes measuring 8 1/2 inches, dimensions (approximately 88 inches x 28 inches x 9 1/2 inches), folding legs for portability, a complete cornhole bag set with regulation-size bags made of duck cloth canvas, regulation size cornhole net, strong pocket joint construction, smooth finish, excellent playability, no visible screw holes or staples on painted surface, and that it is officially licensed and made in the USA.

Exhibit C

The screenshot shows a Zazzle product page for a "United States Military Academy Logo Skateboard". The page features a navigation bar with the Zazzle logo, a search bar, and links for "Create", "Marketplace", "Sign In", and a shopping cart. The product is priced at \$64.75 per skateboard, with a "15% off with code PARTYPLANZAZ" discount. The main image shows a skateboard with a logo featuring an eagle and a star. To the right, there are options for "Designed for you by West Point" (with an "Edit Design" button), "Deck Type" (73" with a "More (8)" link), and "Complete Your Board" (No Extras with a "More info" link). Below the main image, there are social sharing options and a note that the design is previewed with RealView™ technology. At the bottom, there is a section for "Other designs you might like" and a Windows taskbar with the system clock showing 9:22 AM on 3/5/2020.

Exhibit D

