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Janice E. Fayreau

~~Janice E. Favreau~~  
(TYPED OR PRINTED NAME OF PERSON MAILING PAPER OR FEE)

(SIGNATURE OF PERSON MAILING PAPER OR FEE)

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

**In the matter of:**

Application Serial No. 76/201,760

Applicant: Sturgis Area Chamber  
of Commerce

Filed on: January 30, 2001

Mark: BLACK HILLS

Published: September 3, 2002

**Opposition No.:**

Atty. Docket No. 6633-02

Assistant Commissioner for Trademarks  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, VA 22202-3513

## NOTICE OF OPPOSITION

Good Sports Sturgis, Inc., (Good Sports) a Connecticut corporation, having its principal place of business located at 349 Progress Drive, Manchester, Connecticut 06045, believes that it will be damaged by registration of the mark in the following application:

Application Serial No. 76/201,760 (Application) filed January 30, 2001 by the Sturgis Area Chamber of Commerce (Applicant) published for opposition in the

Official Gazette on September 3, 2002 on Page TM 118, seeking registration of the mark **BLACK HILLS** in non-stylized form for the goods and/or services listed in the following classifications:

**International Class: 6**

Metal key rings, metal license plates, metal boxes, non-luminous and non-mechanical metal signs, and die-cast metal piggy banks, all of the aforementioned goods relating to the **STURGIS** motorcycle rally.

**International Class: 8**

Hand tools, namely, hunting knives, fishing knives, pocket knives, sidearm knives, folding knives, sport knives, knives made of precious metal, wrenches, socket sets, namely, socket wrenches and sockets, and pliers, all of the aforementioned goods relating to the **STURGIS** motorcycle rally.

**International Class: 9**

Sunglasses, novelty telephones, pre-recorded videos featuring live music concerts, music videos, documentaries, and footage of vehicle rallies, exhibits and competitions, and footage of the Black Hills area of South Dakota and Wyoming, computer mouse pads, magnets, electronic video game software, protective helmets, toy helmets, computer screen savers, and neon signs, all of the aforementioned goods relating to the **STURGIS** motorcycle rally.

**International Class: 11**

Lamps, all of the aforementioned goods relating to the **STURGIS** motorcycle rally.

**International Class: 12**

License plate holders and handlebar grips for motorcycles, all of the aforementioned goods relating to the **STURGIS** motorcycle rally.

**International Class: 13**

Firearms, all of the aforementioned goods relating to the **STURGIS** motorcycle rally.

**International Class: 14**

Jewelry, watch bands, belt buckles of precious metal for clothing, non-monetary coins, medallions, non-monetary tokens of precious metal, cigarette lighters of precious metal, clocks, and watches, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 16**

Pencils; pens; and paper goods and printed matter, namely, posters; bumper stickers; trading cards; decals; iron-on and plastic transfers; window stickers; wall calendars; note pads; desk sets; lithographs; mounted photographs; unmounted photographs; prints, namely, art prints, cartoon prints, color prints, photographic prints, lithographic prints, and pictorial prints; brochures and books featuring information about motorcycles, automobiles and trucks; paper pennants; paper banners; temporary tattoos; paper and plastic bags for packaging; paper and plastic gift bags; postcards, and picture frame mat boards, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 18**

Wallets, motorcycle bags, athletic bags, all purpose sport bags, beach bags, book bags, carry-on bags, duffel bags, gym bags, shoulder bags, tote bags, travel bags, overnight bags, dog collars, and leashes for animals, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 20**

Non-metal key rings, plastic novelty license plates, and jewelry boxes not of metal, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 21**

Glassware, namely, shot glasses, drinking glasses, drinking cups, and drinking mugs; insulating sleeve holders made of rubber, plastic or foam for beverage cans; insulating sleeve holders made of rubber, plastic or foam for beverage bottles; paper cups; grease and polish rags; portable coolers; coasters not of paper and not being table linen; bottle openers; water bottles sold empty;

sports bottles sold empty; beer steins; and kitchen utensils, namely, spatulas, turners, tongs, pan scrappers, grill scrappers, and grill baskets, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 024**

Afghans, towels, cloth flags, cloth pennants, cloth banners, and quilts, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 25**

Clothing, namely, shirts, T-shirts, long sleeve T-shirts, sleeveless T-shirts, denim shirts, henley shirts, knit shirts, golf shirts, sport shirts, sweaters, jackets, anoraks, coats, tank tops, polo shirts, sweatershirts, pullovers, boxer shorts, sleepwear, women's tops, chemises, cloth wraps, bikinis, beachwear, bathing suits, swim wear, head wear, bandannas, caps, cloth headwraps, berets, hats, scarves, head bands, belts, chaps, jeans, dungarees, boots, footwear, gloves, and sun visors, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 026**

Cloth and embroidered patches for clothing, ornamental cloth patches, hat pins for securing hats, belt buckles not of precious metal, and novelty pins, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 27**

Floor mats for vehicles, textile floor mats for use in the home, rubber floor mats for use as door mats, textile floor mats for use as door mats, and rugs, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 28**

Miniature toy vehicles, electric miniature toy vehicles, radio controlled toy vehicles, model vehicles, miniature banks in the shape of vehicles, Christmas tree ornaments, fishing lures, balloons, gaming chips, sports balls, and decorative wind socks; die-cast toy banks; and handlebar

grips for sporting equipment, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 32**

Bottled water and beer, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 33**

Distilled liquor, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 34**

Ashtrays not of precious metal, cigars, cigar cutters, cigarette lighters not of precious metal, and matches, all of the aforementioned goods relating to the STURGIS motorcycle rally.

**International Class: 35**

Promoting sports competitions and conducting events of others, namely, motorcycle and vehicle rallies, exhibits, and competitions; promoting economic development in the city of Sturgis and the Black Hills area of South Dakota and Wyoming; and mail order, catalog, retail store, wholesale store, on-line retail store, and retail television store services featuring a variety of general merchandise and products.

**International Class: 41**

Entertainment services in the nature of organizing, sponsoring, and conducting a motorcycle and vehicle exhibitions and rallies; and entertainment services in the nature of organizing, sponsoring and conducting civic productions and live music concerts.

Accordingly, Good Sports opposes the Application, and in particular opposes registration in the following international classes (IC):

- 1) IC: 14, Jewelry;
- 2) IC: 21, Housewares and glass;
- 3) IC: 25, Clothing;
- 4) IC: 26, Fancy goods; and
- 5) IC: 35, Advertising and business.

The grounds for the Opposition are as follows:

1. Good Sports has continuously used the name BLACK HILLS in commerce on or in connection with the sale of "Rally Products" as defined in the Application, including, clothing, t-shirts, bandanas, jewelry, pins, patches, and glassware at the Sturgis Motorcycle Rally (Rally", also as defined in the Application), held in an around Sturgis in the Black Hills area of South Dakota each year since at least 1985.
2. Good Sports has continuously used the name BLACK HILLS in the promotion of the Rally since at least 1985.
3. Good Sports' use of the name BLACK HILLS in its sales of Rally Products at the Rally has been through the same channels of trade and to the same class of customers as the Rally Products allegedly offered by the Applicant at the Rally and bearing the mark BLACK HILLS MOTOR CLASSIC STURGIS RALLY & RACES BLACK HILLS S.D. and Design of Applicant's Trademark Registration No. 1,948,097.
4. Good Sports has had gross sales of Rally Products totaling approximately \$1.5 million each year at the Rally since at least the year 2000.
5. Good Sports has owned and operated an on-line retail store since 1996 featuring Rally Products and promoting the Rally on the Internet at the web sites [www.hotleathers.com](http://www.hotleathers.com) and [www.good-sports.com](http://www.good-sports.com).
6. Good Sports has had gross sales of Rally Products totaling approximately \$7.5 million since 1987.
7. Good Sports has had gross sales of Rally Products bearing the name BLACK HILLS totaling approximately \$2.6 million since 1987.

8. Many of over 700 vendors use the name BLACK HILLS in connection with the sale of Rally Products each year at the Rally.

9. Many of over 700 vendors use the name BLACK HILLS in connection with the promotion of the Rally.

10. The City of Sturgis, South Dakota uses the name BLACK HILLS in connection with the promotion of the Rally.

#### **First Ground of Opposition**

##### **The name BLACK HILLS Is Primarily Geographically Descriptive**

11. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

12. Black Hills is the name of a mountainous region in western South Dakota and northeastern Wyoming in the United States.

13. The name BLACK HILLS is primarily recognized in the State of South Dakota and elsewhere as the identifier of the geographic region known as the Black Hills.

14. The Rally in and around the City of Sturgis, S.D. is held each year in the Black Hills region of South Dakota.

15. The name BLACK HILLS is primarily geographically descriptive when used on or in connection with Rally Products and related services.

**Second Ground of Opposition**

**The name BLACK HILLS is Merely Descriptive**

16. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

17. The name BLACK HILLS is merely descriptive when used on or in connection with Rally Products and related services.

**Third Ground of Opposition**

**The name BLACK HILLS has not become  
distinctive of Applicant's goods or services**

a) **Applicant and its licensees have not been substantially exclusive users  
of the name BLACK HILLS in connection with the sale of Rally Products or the  
Promotion of the Rally for at least five years preceding November 2, 2001**

18. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

19. Good Sports, as well as others, has used the name BLACK HILLS continuously since at least as early as 1982 in connection with the sale of Rally Products at the Rally and elsewhere.

20. Good Sports, as well as others, has used the name BLACK HILLS continuously since at least as early as 1982 in connection with promoting the Rally.

21. Good Sports, as well as others, continues to use the name BLACK HILLS in commerce on or in connection with the sale of Rally Products at the Rally and otherwise.



22. Good Sports, as well as others, continues to use the name BLACK HILLS in connection with promoting the Rally.

**b) The name BLACK HILLS is not the same as or similar to the mark in the '097 Registration**

23. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

24. Applicant's claim of acquired distinctiveness under § 2(f) of the Lanham Act is based on Applicant's use of the mark BLACK HILLS MOTOR CLASSIC STURGIS RALLY & RACES BLACK HILLS S.D. and Design identified on the Principal Register as Registration No. 1,948,097 (the '097 Registration).

25. The mark in the '097 Registration is a combined word and design mark.

26. The name BLACK HILLS is not the same as or similar to the mark in the '097 Registration.

27. The name BLACK HILLS does not create the same commercial impression as the BLACK HILLS MOTOR CLASSIC STURGIS RALLY & RACES BLACK HILLS S.D. and Design mark registered in the '097 Registration such that a consumer would consider them the same mark.

28. The name BLACK HILLS is not a dominant part of the mark of the '097 Registration.

29. The name BLACK HILLS is not a separable element of the mark of the '097 Registration.

30. Applicant has acknowledged that the name BLACK HILLS is not the same as or similar to the mark in the '097 Registration.

**c) Rally Products are not the same as or similar to or related to the services identified in the '097 Registration**

31. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

32. Rally Products are unrelated to the services in International Class 35 for "promoting sports competitions and/or events of others, namely motorcycle rallies, exhibits and competitions and promoting economic development in the city of Sturgis and the Black Hills area of South Dakota and Wyoming."

33. The source of Rally Products sold at or in connection with the Rally is not likely to be perceived to be the same as the source of the promotional services identified in the '097 Registration.

**d) Applicant's reliance on its prior trademark registration, the '097 Registration, is improper and unavailing**

34. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

35. Applicant, voluntarily and without a demand from the Examiner, disclaimed any right to the exclusive use of the term BLACK HILLS, S.D. in conjunction with the services identified in Applicant's '097 Registration.

36. Applicant admitted in the '097 Registration that the name BLACK HILLS is descriptive and not capable of becoming distinctive.

37. Due to Applicant's disclaimer of the name BLACK HILLS, Applicant's '097 Registration cannot be deemed prima facie evidence of distinctiveness or of any evidentiary value with respect to Applicant's claim of acquired distinctiveness for the name BLACK HILLS.

e) **Applicant's claim for distinctiveness is based on a defective Declaration**

38. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

39. Applicant's Declaration of November 2, 2001 fails to claim substantially exclusive and continuous use of BLACK HILLS on Rally Products.

**Fourth Ground of Opposition**

**The mark in U.S. Trademark Registration No. 1,948,097 is not distinctive because Applicant has failed to supervise and control the nature of the quality of goods and services of its licensees**

40. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

41. Applicant has failed to supervise and control the use of the name BLACK HILLS on Rally Products.

42. Because Applicant has failed to supervise and control the use of the name BLACK HILLS, the mark is not distinctive and cannot serve as a trademark.

**Fifth Ground of Opposition**

**Applicant has attempted to procure registration of the name BLACK HILLS by fraud**

43. Good Sports repeats and realleges all of the above allegations as if fully restated herein.

44. Applicant knows it has not used the name BLACK HILLS substantially exclusively in conjunction with the sale of Rally Products in the five years preceding November 2, 2001.

45. Applicant has knowledge of the substantial use by others of the name BLACK HILLS in conjunction with the promotion of the Rally.

46. Applicant knows that many of over 700 vendors use the name BLACK HILLS on or in connection with Rally Products.

47. At least as early as 1990, Applicant knew of Good Sports use of the name BLACK HILLS in commerce in connection with the sale of Rally Products.

48. Applicant's claim of acquired distinctiveness of the name BLACK HILL is fraudulent and contains false information because on November 2, 2001, Applicant knew of the substantial use of the name BLACK HILLS by Good Sports and others, in commerce, on or in connection with the sale of Rally Products.

WHEREFORE Opposer requests that Trademark Application Serial No. 76/201,760 be denied and rejected on the following grounds:

1. BLACK HILLS used on Rally Products is primarily geographically descriptive, 15 U.S.C. § 1052(e)(2);
2. BLACK HILLS used on Rally Products is merely descriptive, 15 U.S.C. § 1052(e)(1);
3. BLACK HILLS used on Rally Products has not become distinctive of Applicant's goods or services, 15 U.S.C. § 1052(f), because:
  - a.) Applicant never claimed or established substantially exclusive use of the name BLACK HILLS on Rally Products;

b). **BLACK HILLS** is not the same as or similar to the mark in Trademark Registration No. 1,948,097;

c). Rally Products bearing the name **BLACK HILLS** are not the same as or related to the services in Trademark Registration No. 1,948,097;

d). Use of **BLACK HILLS** name on Rally Products by Applicant or its licensees has not been substantially exclusive for the five years prior to November 2001, nor at any time since 1981;

e). Applicant's disclaimer of the name **BLACK HILLS** in Trademark Registration No. 1,948,097 precludes Applicant's ownership of the '097 Registration from being deemed prima facie evidence of distinctiveness or of any evidentiary value with respect to Applicant's claim of acquired distinctiveness for the name **BLACK HILLS**.

4. Rally Products have been sold under mark in Trademark Registration 1,948,097 without proper supervision or control of the products by Applicant.

5. Applicant has attempted to procure a registration for the name **BLACK HILLS** by fraud by submitting a declaration in support of its claim of acquired distinctiveness containing statements known by Applicant to be false.

**POWER OF ATTORNEY**

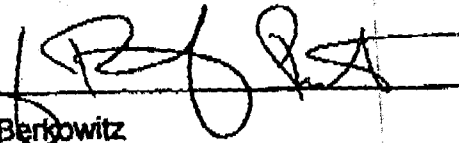
The undersigned hereby appoints John C. Linderman, Donald K. Huber, John C. Hilton, Frederick J. Haesche, J. Kevin Grogan, Arthur F. Dionne, Richard R. Michaud, Daniel G. Mackas, Marina F. Cunningham, Nicholas J. Tuccillo, Wm. Tucker Griffith, Susan C. Oygard, Stephen P. Scuderi, Richard D. Getz, William Gowanlock, Donald J. MacDonald, all of the firm of McCORMICK, PAULDING & HUBER LLP, CityPlace II, 18th Floor, 185 Asylum Street, Hartford, CT 06103-4102, (860) 549-5290, its attorneys with full power of substitution and revocation to prosecute this Opposition, to make alterations and amendments therein and to transact all business in the U.S. Patent and Trademark Office and elsewhere in connection therewith.


**DECLARATION**

The undersigned, declares that he is an officer of GOOD SPORTS STURGIS, INC. named in the foregoing NOTICE OF OPPOSITION and that he has been warned that willful false statements and the like so made herein are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code; he further declares that he is duly appointed and authorized to execute this instrument on behalf of said corporation; that he has read signed the foregoing NOTICE and knows the contents thereof, and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

GOOD SPORTS STURGIS, INC.

10/31/02  
Date

  
\_\_\_\_\_  
Jerry Berkowitz  
President

IN THE OPPOSITION OF Ser/Pat/TM No. <u>76/201,760</u> File No. <u>6693-02</u> OPPOSED <u>GOOD SPORTS</u> Inventor Name(s) <u>STURGIS</u> Atty/Secretary <u>WELDER 11/1/02</u>		Date Received:  11-01-2002 U.S. Patent & TMO/TM Mail Rpt Dt #70
Hon. Commissioner of Patents/Trademarks Please acknowledge receipt of the attachments by stamping the date received in the space indicated and returning this card to the addressee.		
McCormick, Paulding & Huber LLP		
<input type="checkbox"/> Specification - # of pages..... <input type="checkbox"/> Claims - # of pages..... <input type="checkbox"/> Drawings - # of sheets ..... <input type="checkbox"/> Amendment <input type="checkbox"/> Issue Fee/Publication Fee <input type="checkbox"/> English translation document <input type="checkbox"/> Assignment <input type="checkbox"/> Marked up copy of specification/claims <input type="checkbox"/> Clean copy of specification/claims <input type="checkbox"/> Dec/POA	<input type="checkbox"/> Transmittal letter <input checked="" type="checkbox"/> Check - \$ <u>1,500.00</u> <u>5</u> CLASSES <input type="checkbox"/> IDS and PTO/SB/08A <input type="checkbox"/> Copies of IDS citations <input type="checkbox"/> Maintenance Fee <input type="checkbox"/> Extension of Time <input checked="" type="checkbox"/> NOTICE OF OPPOSITION <input checked="" type="checkbox"/> w/ 2 COPIES <input type="checkbox"/> ..... <input type="checkbox"/> .....	



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November 1, 2002

**BOX TTAB - FEE**  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Re: Notice of Opposition for U.S. Trademark  
Application No. 76/201,760 for mark BLACK HILLS  
(Our File No. 6633-02)

Dear Sirs:

Attached hereto, in duplicate in accordance with Rule 2.104, is a Notice of Opposition to be filed against U.S. Trademark Application Serial No. 76/201,760 for the mark BLACK HILLS in the following International Classes (IC):

- 1) IC: 14, Jewelry;
- 2) IC: 21, Housewares and glass;
- 3) IC: 25, Clothing;
- 4) IC: 26, Fancy goods; and
- 5) IC: 35, Advertising and business.

A check in the amount of \$1,500.00 is enclosed in payment of the Notice of Opposition filing fee. Please charge any deficiency in this fee, and any additional fees which may be due to our Deposit Account No. 13-0235.

Very truly yours,

McCormick, Paulding &amp; Huber LLP

By 

John Linderman

Enclosures