

EXPRESS MAIL #ET960830574US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**AMENDMENT SEEKING GEOGRAPHIC RESTRICTION
BASED ON PRIOR COURT AND TTAB DECISIONS**

Mark: ADVANCE AUTO PARTS. WE'RE READY IN ADVANCE. & design

Serial No.: 78/258939

Applicant: Advance Merchandising Company, Inc., a Virginia corporation
5673 Airport Road
Roanoke, Virginia 24012



Application Filed: June 5, 2003

04-27-2004

Published for Opposition: February 24, 2004

U.S. Patent & TMOft/TM Mail Rcpt Dt. #22

To: Trademark Trial and Appeal Board
U. S. Patent and Trademark Office
2900 Crystal Drive
Arlington, VA 22202-3514

Attn: E. S. "Jean" Brown
(703) 308-9300, x. 123

Applicant Advance Merchandising Company, Inc. seeks amendment of the above-referenced service mark application in order to include a geographic restriction on the application and subsequent registration, if issued, on the basis of a court determination of concurrent rights and the Trademark Trial and Appeal Board's decision in a prior proceeding.

Background

Applicant owns substantially similar registration numbers 1,815,267 and 1,847,137.

In or around October 1994, Refinishing Specialties, Inc. petitioned the Patent and Trademark Office's Trademark Trial and Appeal Board to cancel Applicant's (known as Laralev, Inc. prior to merger) registration numbers 1,815,267 and 1,847,137 (Cancellation No. 23,372). The cancellation proceeding was suspended pending the outcome of litigation between the two parties.

In August 1999, the United States Court of Appeals for the Sixth Circuit upheld a decision by the United States District Court for the Western District of Kentucky, finding that Refinishing Specialties, Inc. has the exclusive right to use the name "Advance Auto Parts" within its trade territory of Jefferson County, Kentucky, and that Applicant is entitled to the exclusive

use of the name "Advance Auto Parts" throughout the United States except for Jefferson County, Kentucky. Advance Stores Co. v. Refinishing Specialties, 188 F.3d 408 (6th Cir. 1999).

The cancellation proceeding was resumed, and in September 2000 the TTAB ordered that, in accordance with the litigation outcome and Applicant's agreement to abide by the geographic restrictions, registration numbers 1,815,267 and 1,847,137 would be limited to the entire United States except for Jefferson County, Kentucky, and the proceeding was dismissed with prejudice. See Exhibit A. The Deputy Commissioner for Trademark Operations subsequently ordered that the registrations were "restricted to the territory comprising the entire United States except for Jefferson County, Kentucky." See Exhibit B. The PTO's Post Registration Division issued office actions on October 30, 2002, and the certificates of registration were submitted for the necessary modifications.

The current application under consideration (Serial No. 78/258939) is substantially similar to registration numbers 1,815,267 and 1,847,137. Accordingly, Applicant seeks registration of the mark in connection with retail auto parts store services in the entire United States except for Jefferson County, Kentucky.

Amendment: Geographic Restriction

Please amend the above-referenced application to include the following geographic restriction:

APPLICATION AND ANY RESULTING REGISTRATION
IS LIMITED TO THE ENTIRE UNITED STATES EXCEPT
FOR JEFFERSON COUNTY, KENTUCKY, PURSUANT TO
THE DECREE OF THE UNITED STATES COURT OF APPEALS
FOR THE SIXTH CIRCUIT, Advance Stores Co. v. Refinishing
Specialties, 188 F.3d 608 (6th Cir. 1999), CONCURRENT
REGISTRATION WITH REFINISHING SPECIALTIES, INC.,
4101 TAYLOR BOULEVARD, LOUISVILLE, KENTUCKY 40215.

Respectfully submitted,

ADVANCE MERCHANDISING COMPANY, INC.

By: T.A. Branscom

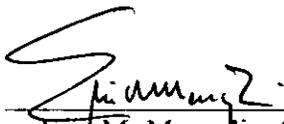
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ATTORNEY FOR APPLICANT

DECLARATION

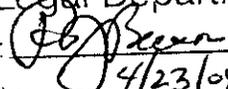
The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the applicant; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true.

ADVANCE MERCHANDISING COMPANY, INC.

Date: 4/23/04

By: 
Eric M. Margolin, Secretary

Approved as to Form
Legal Department

By: 
Date: 4/23/04

Wolfson

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD
2900 Crystal Drive
Arlington, Virginia 22202-3513

MAILED
SEP 29 2000
PAT. & T.M. OFFICE

Cancellation No. 23,372

Refinishing Specialties,
Inc. d/b/a/ Advance Auto
Parts

v.

Laralev, Inc.

On August 17, 2000, respondent confirmed its agreement to abide by the geographical restrictions in accordance with the civil action between the parties. The registrations will be limited to the entire United States except for Jefferson County, Kentucky.¹

Further, in accordance with petitioner's request that proceedings be dismissed with prejudice, the petition to cancel is dismissed with prejudice.²

*By the Trademark Trial
and Appeal Board*

09/06/00

¹ Registration Nos. 1,815,267 and 1,847,137.

² It is noted that any determination whether petitioner may be entitled to a geographically-restricted trademark registration for Jefferson County, Kentucky, can be made only in the context of a concurrent use proceeding involving an application filed by petitioner and will not be determined herein. See Trademark Rule 2.99(h).

KY

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U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

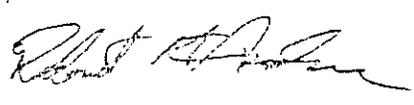
Order

In re Registration No. 1,815,267 , issued January 4, 1994.

Laralev, Inc.

The Trademark Trial and Appeal Board has found in Cancellation Proceeding No. 23,372 that respondent therein, Laralev, Inc., is entitled to retain its registration of the mark ADVANCE AUTO PARTS for "retail auto part stores" subject to its restriction to the area comprising the entire United States except for Jefferson County, Kentucky.

The registration of Laralev, Inc. for the mark ADVANCE AUTO PARTS for "retail auto part stores" is restricted to the territory comprising the entire United States except for Jefferson County, Kentucky.



Robert M. Anderson
Deputy Commissioner
for Trademark Operations

cc:

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April 27, 2004

VIA EXPRESS MAIL

(ET960830574US)

Trademark Trial and Appeal Board
U. S. Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3514

Attn: E. S. "Jean" Brown
(703) 308-9300, x. 123

Re: Applicant : Advance Merchandising Company, Inc.
 Mark : ADVANCE AUTO PARTS. WE'RE READY IN ADVANCE.
 Serial Number : 78/258939
 Mark : ADVANCE AUTO PARTS
 Serial Number : 78/258959
 Mark : ADVANCE AUTO PARTS. WE'RE READY IN ADVANCE.
 Serial Number : 78/258981
 Filing Date : June 5, 2003
 Publication Date : February 24, 2004
 Status : Extensions of Time to Appeal have been granted to a potential opposing party but no oppositions yet filed—attempting to resolve without formal TTAB proceeding by amending the applications

Dear Sir:

Enclosed for Ms. Brown's attention please find Advance Merchandising Company, Inc.'s Amendments Seeking Geographic Restriction Based On Prior Court and TTAB Decisions for the above-referenced marks. Also enclosed are three self-addressed postcards, each listing one of the amendments. Please acknowledge receipt of this letter and its enclosures by date stamping each of the enclosed postcards and mailing them to us.

If you have any questions, please let me know.



Very truly yours,

T.A. Branscom

04-27-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Tara A. Branscom

TAB/mat
0059-494
Enclosures

cc: Joel T. Beres, Esq.
 Counsel to Potential Opposer Refinishing Specialties, Inc. (w/ encls.)