

TTAB

5569-52573

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

The Chamberlain Group, Inc.)

Opposer,)
v.)

AWI Acquisition Company d/b/a Allied)
International)

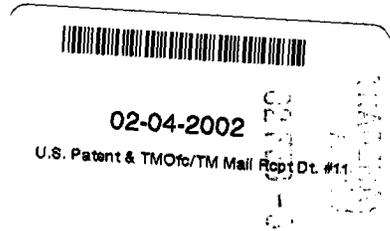
Applicant,)

Serial No.: 76/019,995)
Filed: April 6, 2000)
Mark: FORMULA 1)
Published: October 2, 2001)

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on this date.

01/30/02
Date

Joseph P. White
Attorney for Opposer



NOTICE OF OPPOSITION

The Chamberlain Group, Inc., a Connecticut corporation, located and doing business at 845 Larch Avenue, Elmhurst, Illinois 60126-1196 (hereinafter referred to as "CGI") believes that it will be damaged by Registration of the trademark, Application No. 76/019,995 by AWI Acquisition Company d/b/a Allied International and hereby opposes the same upon the following grounds:

COUNT I - TRADEMARK INFRINGEMENT

1. In its Application Serial No. 76/019,995, Applicant is seeking to obtain registration on the Principal Register of the mark FORMULA 1 as a trademark for use

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on manually operated automotive tools for lifting, namely, bottle jacks, trolley jacks, and engine hoists.

2. Since at least as early as early as January 4, 1993 CGI adopted and began using the mark FORMULA I for use on electric garage door openers which are and have been marketed in commerce throughout the United States. On January 9, 1992, CGI applied for registration of the mark FORMULA I with the U.S. Patent and Trademark Office and on November 16, 1993, the United States Patent and Trademark Office registered on the Principal Register and issued Registration No. 1,805,160 for the mark FORMULA I for use on said goods. Said Registration is presently valid and subsisting and is now owed by CGI and is *prima facie* evidence of CGI's exclusive right to use said mark in commerce on goods. Said Registration is also incontestable under the provision of §15 of the Lanham Act.

3. CGI owns U.S. Trademark Registration No. 1,805,160 registered on November 16, 1993, for the mark FORMULA I for electric garage door openers with constructive use at least as early as January 9, 1992.

4. CGI has been using its FORMULA I mark on electric garage door openers, which generate for CGI common law rights in addition to its rights by virtue of its federal registration.

5. CGI is the owner of the FORMULA I mark in connection with its goods having adopted and continuously used the FORMULA I in connection with said goods in commerce throughout the United States beginning at least as early as January 4, 1993.

6. CGI has expended substantial monies in marketing, advertising and promoting the FORMULA I mark in connection with its goods in the United States.

7. CGI has enjoyed substantial sales of said goods in the United States with the FORMULA I mark.

8. By reason of the extensive marketing, advertising and promotion of said goods with the FORMULA I mark and the high quality of those goods, this mark has come to represent an extremely valuable goodwill associated with CGI long prior to April 15, 1999, the date of first use of Application Serial No. 76/019,995 for the FORMULA 1 trademark by Applicant and for which Applicant is now seeking registration.

9. On information and belief, the earliest date of constructive or actual use of the FORMULA 1 trademark on manually operated automotive tools for lifting, namely, bottle jacks, trolley jacks, and engine hoists, that Applicant can rely on is no earlier than April 15, 1999, the date of first use specified in Application Serial No. 76/019,995.

10. Applicant's intended adoption and use of the FORMULA 1 trademark has been without the consent or permission of CGI.

11. On information and belief, Applicant's intended adoption and use of its FORMULA 1 trademark has been with actual or constructive knowledge of CGI's prior use of and registration of its FORMULA I mark in connection with its goods.

12. On information and belief, the goods for which Applicant seeks registration of the FORMULA 1 mark are similar to CGI's goods with its FORMULA I mark.

13. On information and belief, the goods for which the Applicant seeks registration of its FORMULA 1 mark are likely to be sold to the same customers or channels of trade to which CGI sells its goods with the FORMULA I mark.

14. The FORMULA 1 trademark for which Applicant seeks registration is similar, if not identical, to the FORMULA I mark that is used by CGI to sell its goods in the United States.

15. If Applicant is granted registration of its FORMULA 1 trademark as shown in Application Serial No. 76/019,995, Applicant will thereby obtain the *prima facie* exclusive right to use such mark, and such registration will impair, diminish, and dilute CGI's goodwill and rights in its FORMULA I mark, causing irreparable injury to CGI.

16. Applicant's FORMULA 1 trademark is confusingly similar to CGI's FORMULA I trademark, and use thereof by the Applicant on the goods specified in Application No. 76/019,995 is likely to cause confusion, mistake, or deception that Applicant's goods are those of CGI or are otherwise endorsed, sponsored, or approved by CGI, whereby CGI will be damaged by the registration of Applicant's FORMULA 1 trademark on the Principal Register of the United States Patent and Trademark Office.

COUNT II -DILUTION

17. Paragraphs nos. 1-16 are incorporated by reference herein.

18. CGI, the owner of the mark FORMULA I, has adopted and has continuously used said mark on and in connection with various goods in commerce throughout the United States beginning at least as early as January 4, 1993.

19. CGI owns a federal trademark registration of the FORMULA I mark.

20. CGI has expended substantial monies in marketing, advertising and promoting its FORMULA I marks on its goods.

21. By reason of its extensive use, marketing, publicity, advertising, geographical extent of its trading use and promotion of its goods, using the above FORMULA I mark and the high quality of those goods, CGI is possessed with extremely valuable good will associated with its mark long prior to the filing of this Application Serial No. 76/019,995 for Applicant's FORMULA 1 mark.

22. CGI has for several years made extensive sales of goods with the FORMULA I mark.

23. The FORMULA I mark is famous and distinctive within the meaning of the Lanham Act, and is entitled to the protection of the anti-dilution provisions of the Lanham Act, including 15 U.S.C. § 1125 (c).

24. Based upon information and belief, Applicant's filing of the application was made at a period of time after which CGI's FORMULA I mark became famous and distinctive.

25. If Applicant is granted registration of its FORMULA 1 mark as shown in Application Serial No. 76/019,995, Applicant will thereby obtain the *prima facie* exclusive right to use such mark, and such registration will impair, diminish, and dilute CGI's goodwill and rights in its FORMULA I mark, causing irreparable injury to CGI. Therefore, CGI opposes registration of Applicant's FORMULA 1 mark pursuant to 15 U.S.C. §1052 AND 1063(a), as amended by the Trademark Amendment Act of 1999,

which permits opposition of trademark applications filed on or after January 16, 1996 on grounds of dilution.

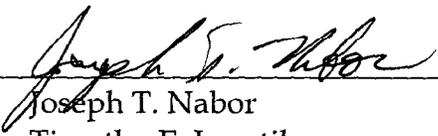
26. If Applicant is granted registration of its claimed FORMULA I mark as shown in Application Serial No. 76/019,995, Applicant will thereby obtain the prima facie exclusive right to use such mark in the United States, and such registration will impair and diminish CGI's goodwill and rights in its FORMULA 1 mark causing irreparable damage and injury to CGI.

PRAYER FOR RELIEF

WHEREFORE, The Chamberlain Group, Inc. prays that Application Serial No. 76/019,995 be rejected and that registration of the FORMULA 1 trademark for the goods specified therein be refused.

January 30, 2002

Respectfully submitted,

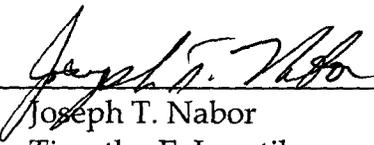
By: 
Joseph T. Nabor
Timothy E. Levstik
FITCH, EVEN, TABIN & FLANNERY

CERTIFICATE OF OPPOSER'S ATTORNEYS

We hereby certify that we are trademark attorneys for The Chamberlain Group, Inc., Opposer herein, and that we have been instructed to file the foregoing Opposition. We are, therefore, filing this Opposition under Section 13 of the Trademark Act of 1946 and under Trademark Rule 2.101.

FITCH, EVEN, TABIN & FLANNERY

January 30, 2002

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January 30, 2002

Hon. Commissioner of Patents
and Trademarks

Arlington, VA 22202-3513

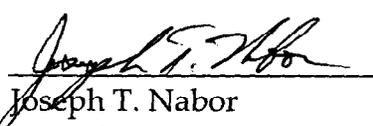
BOX TTAB FEE

Re: Transmittal of Notice of Opposition for:
**The Chamberlain Group, Inc. v. AWI Acquisition Company d/b/a Allied
International: Mark: FORMULA I**
Ser. No. 76/019,995 Filed: April 6, 2000
Our File No. 5569-52573

Honorable Sir:

Please file the enclosed Notice of Opposition. The Commissioner is hereby authorized to charge the \$300.00 to Deposit Account No. 06-1135. The Commissioner is hereby authorized to charge any fees which may be required in this proceeding during its entire pendency, or credit any overpayment, to Deposit Account No. 06-1135.

Respectfully Submitted,

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JTN:dir
Encls.

