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

In the Matter of Application:

Serial No.:78039658
Mark: PACBELLY
Published in the Official Gazette on: 10/2/2001
Class:35

PACIFIC TELESIS GROUP)
)
Opposer)
v.)
)
AKOS SIMON)
)
Applicant)

Opposition No. _____
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NOTICE OF OPPOSITION

Pacific Telesis Group (“Opposer”) believes it will be damaged by registration of the mark PACBELLY, as shown in Application Serial No. 78039658 filed by Akos Simon (“Applicant”), and hereby opposes that application.

Opposer is a California corporation with its corporate headquarters at 175 E. Houston Street, San Antonio, Texas 78205.

Applicant is, on information and belief, a California resident who lists a mailing address of P.O. Box 8173, Green Valley Lake, California 92341-8173, and who resides at 14622 Ventura Boulevard, Sherman Oaks, California 91403.

As grounds for this opposition, Opposer alleges as follows:

1. Applicant seeks to register the word mark PACBELLY for “advertising services, namely, dissemination of advertising for others via an on-line electronic communications network” in

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Att’y Docket No. 28787.15 (761)

International Class 35, as evidenced by publication of the mark in the *Official Gazette* dated October 2, 2001.

2. Opposer Pacific Telesis Group is one of the Regional Bell Operating Companies formed as part of the 1983 divestiture of AT&T whereby Opposer became one of the concurrent use owners of all of AT&T's rights in the famous BELL trademark and federal registrations for the BELL marks. The BELL word mark has been recognized by consumers for over a century as a trademark and trade name, first of AT&T and its regional divisions, and then, after the 1983 court-ordered divestiture, of the Baby Bells.
3. Opposer is the owner of several federal trademark registrations for the mark BELL for a wide variety of goods and services related to telecommunications. For example, United States Registration No. 1,545,199 covers "telephone and business directories" in Class 16; "promoting the goods and services of others through consulting on directory advertising programs, designing directory advertisements and listings, and placing such advertisements and listings in directories; managing telecommunications systems and equipment for others" in Class 35; "installing and maintaining telecommunications systems and equipment for others, and related consulting services" in Class 37; "providing telecommunications services to others" in Class 38; "providing educational services, seminars and workshops in telecommunications skills and the use of telecommunications equipment and services" in Class 41; and "designing and engineering telecommunications systems and equipment for others and related consulting services." Pursuant to 37 C.F.R. § 2.122(d)(1), Opposer attaches hereto as Exhibit A two copies of United States Registration No. 1,545,199, prepared and issued by the Patent and Trademark Office, showing both the current status of and the current title to Registration No. 1,545,199.

4. Opposer is the owner of several federal trademark registrations for the mark PACIFIC BELL for a wide variety of goods and services related to telecommunications. For example, United States Registration No. 1,459,202 covers “telephone and business directories and educational books and pamphlets in telecommunications skills and the use of telecommunications equipment and services” in Class 16; “promoting the goods and services of others through consulting on directory advertising programs, designing directory advertisements and listings, and placing such advertisements and listings in directories, managing telecommunications systems and equipment for others” in Class 35; “installing and maintaining telecommunications systems and equipment for others” in Class 37; “providing telecommunications services to others” in Class 38; “providing educational services, seminars and workshops in telecommunications skills and the use of telecommunications equipment and services” in Class 41; and “designing and engineering telecommunications systems and equipment for others and related consulting services” in Class 42. Pursuant to 37 C.F.R. § 2.122(d)(1), Opposer attaches hereto as Exhibit B two copies of United States Registration No. 1,459,202, prepared and issued by the Patent and Trademark Office, showing both the current status of and the current title to Registration No. 1,459,202.
5. Since at least as early as 1984, Opposer has used the composite mark PACIFIC BELL, and owns incontestable Registration No. 1,459,202 for that mark.
6. For decades, the public and press has used the short hand expression “PACBELL” to refer to Opposer and to the products and services offered by Opposer.
7. As a result of the extensive sales of goods and services under the BELL and PACIFIC BELL marks by Opposer, complemented by extensive advertising, promotion and press coverage,

BELL and PACIFIC BELL are famous marks as defined in Section 43(c)(1) of the Lanham Act, 15 U.S.C. § 1125(c)(1).

8. As a result of the substantial and widespread use of PACBELL by the public and the press to refer to Opposer and only to Opposer, that name has acquired distinctiveness as a unique identifier of Opposer.
9. There can be no issue as to priority as the subject application is based on an intent-to-use the subject mark and Opposer has used the PACIFIC BELL mark at least as early as 1984, Opposer and its predecessors and concurrent use owners have used the BELL marks for decades, and the public has referred to Opposer as PACBELL for decades.
10. Use of PACBELLY by Applicant for the goods described in the opposed application is likely to lead the public to mistakenly conclude that Applicant is or has been authorized, sponsored, licensed by, or otherwise affiliated with Opposer.

For the foregoing reasons, among others, Opposer Pacific Telesis Group respectfully asks the Board to grant its Opposition and deny registration to Applicant of the subject mark for the goods described in the subject application or for any goods encompassed by that description. Opposer hereby files this Notice of Opposition in duplicate, in accordance with 37 C.F.R. 2.104 (a).

Respectfully submitted,



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ATTORNEYS FOR OPPOSER
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CERTIFICATE OF MAILING

I hereby certify that on this 30th day of January, 2002 the foregoing NOTICE OF OPPOSITION is being deposited with the United States Postal Service, postage prepaid, as "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 in an envelope addressed to BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

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