

TTAB

TRADEMARK

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

Rolls-Royce plc and Hireus Limited,

Opposers,

Opposition No.

v.

BOX TTAB/FEE

Trail King Industries, Inc.,

Applicant.

U.S. Patent & TMO/c/TM Mail Rcpt. Dt. #57



09-06-2002

Application Serial No. 76/369,366 for the mark "RR"
Published in the Official Gazette on August 13, 2002, Week No. 33 at TM 206.

TO THE HONORABLE COMMISSIONER OF PATENTS AND TRADEMARKS:

NOTICE OF OPPOSITION

Opposer, Rolls-Royce plc, a corporation organized and existing under the laws of England and having its registered office at 65 Buckingham Gate, London SW1E 6AT, England, and Opposer, Hireus Limited, a corporation organized and existing under the laws of England and having its registered office at Kempson House, 35-37 Camomile Street, London, England, each believes that it would be damaged by the registration of the mark shown in U.S. Trademark Application Serial No. 76/369,366 and hereby opposes the application for registration in all classes.

As grounds of opposition, it is alleged that:

1. Applicant Trail King Industries, Inc. is, on information and belief, a manufacturer of trailers for the construction, commercial and specialized heavy hauling industries.

2. Applicant seeks to register on the Principal Register the mark "RR" for cargo trailers, including dump trailers, live bottom trailers, bottom dump trailers, and end dump trailers, and parts therefor, in Class 12 -- Vehicles, and for trailer repair services, in Class 37, claiming a date of first use in Class 12 -- Vehicles of January 1, 1958. A copy of Applicant's mark is annexed hereto as Exhibit "A".

3. Since at least 1907 and continuously to date, Opposer Rolls-Royce plc and its predecessors in interest have adopted and used the name "ROLLS-ROYCE", the Rolls-Royce insignia of the interlocking letters "RR" and the "ROLLS-RR-ROYCE" badge (collectively the "Rolls-Royce" Marks) in connection with its business operations, including the manufacturing of gas turbine engines for use in aircraft and for other purposes and in other businesses characterized by a high degree of technology and attention to quality and excellence. Rolls-Royce plc also uses the "ROLLS-ROYCE" name and "ROLLS-RR-ROYCE" badge on cargo trailers and transport vehicles that it uses for the delivery of aircraft engines and other products. Copies of the Rolls-Royce Marks are reproduced and annexed hereto as Exhibit "B."

4. Opposer Hireus Limited is in the business of establishing a new production facility in England for high quality luxury motor cars to be sold under the ROLLS-ROYCE brand.

5. Opposer Rolls-Royce plc is the registered owner of numerous United States trademark and service mark registrations for the Rolls-Royce Marks, all of which have been registered or renewed and remain in full force and effect, for automobiles, aircraft engines and other products and services which include the following:

Mark	Number	Original Date of Issue
"ROLLS-RR-ROYCE"	197,089	April 7, 1925
"ROLLS-ROYCE"	325,195	June 11, 1935
"ROLLS-ROYCE"	325,316	June 18, 1935
Letters "RR"	343,053	February 9, 1937
Letters "RR"	344,372	March 23, 1937
"ROLLS-ROYCE"	912,848	June 8, 1971
"ROLLS-RR-ROYCE"	1,068,022	June 21, 1977
Letters "RR"	1,068,023	June 21, 1977
"ROLLS-RR-ROYCE"	1,160,411	July 7, 1981
"ROLLS-RR-ROYCE"	1,275,757	May 1, 1984
"ROLLS-RR-ROYCE"	1,946,820	January 9, 1996

6. Pursuant to Section 15 of the Trade-Mark Act of 1946, as amended (15 U.S.C. Section 1065), the rights to the use of the registered Rolls-Royce Marks enumerated above are all incontestable

7. Opposer, Hireus Limited, by assignment from the registered owner Rolls-Royce plc, is the beneficial owner of the following two Rolls-Royce plc marks for use on automobiles:

Mark	Number	Original Date of Issue
"ROLLS-RR-ROYCE"	197,089	April 7, 1925
"ROLLS-ROYCE"	325,195	June 11, 1935

8. Opposers Rolls-Royce plc and Hireus Limited, and their subsidiaries, related companies, affiliates, licensees, sublicensees and predecessors (collectively the "Rolls-Royce Companies") make use of the Rolls-Royce Marks through appropriate licenses and permissions, including for the manufacture of the world-famous Rolls-Royce automobile.

9. Opposer Rolls-Royce plc's use of its "RR" mark, and registration therefor, as well as recognition of the famous mark status thereof, long predates Applicant's use of its "RR" mark.

10. The Rolls-Royce Companies have spent well over three-quarters of a century producing goods and rendering services recognized in the United States and throughout the world to be of the highest quality and excellence and have expended large sums of money for worldwide advertising of their products and services.

11. By reason of these efforts and care, and the excellent quality of Rolls-Royce products and services, the Rolls-Royce Marks have become unique and are identified by the public solely with the Rolls-Royce Companies and their products and services. Accordingly, the Rolls-Royce Companies enjoy an exceedingly valuable reputation and goodwill in the United States and throughout the world, not only among purchasers of their products and users of their services but also among other members of the public.

12. The public has long recognized the Rolls-Royce Marks as identifying and distinguishing products and services produced and rendered only by the Rolls-Royce Companies.

13. Since as early as 1925, the "ROLLS-ROYCE" name and trademark has been recognized as a famous mark, thereby entitling it to protection even as against non-competing products and services because the name "ROLLS-ROYCE" had "become associated all over the world with the excellence of its product" (See Wall v. Rolls-Royce of America, Inc., 4 F.2d 333 (3d Cir. 1925) in which use of the name "Rolls-Royce" on radio tubes was enjoined.) In this connection, a noted trademark authority has written:

Famous trademarks, especially those which embody an aura of pre-eminent excellence and quality, are generally given broad protection as to non-competing products. The public is likely upon encountering a mark which is virtually synonymous with quality, to assume that even entirely different products are at least sponsored by the trademark owner. ROLLS-ROYCE for automobiles and

airplanes, for example, has been enforced against Rolls-Royce for radio tubes

1 Gilson, Trademark Protection and Practice, Section 5.05[3].

14. Similarly, in Kroll Bros. Co. v. Rolls-Royce, Limited, 126 F. 2d 495 (C.C.P.A. 1942), the United States Patent and Trademark Office, as affirmed by the Court of Customs and Patent Appeals, also extended protection of the Rolls-Royce Marks to products other than motor cars, holding that the Rolls-Royce Marks were entitled to protection against registration of the confusingly similar "Kroll's-Royce" mark for baby carriages and go carts.

15. Opposer Rolls-Royce plc's "RR" mark is a long recognized abbreviation of the "ROLLS-ROYCE" name and has equally been recognized as a "famous mark." Specifically, through extensive use and promotion, the interlocking letters "RR" trademark has become so identified with Rolls-Royce that whenever it is used it designates Rolls-Royce in the public mind. The United States Patent and Trademark Office has itself so held, noting as well the famous mark status of the letters "RR". For example, in refusing registration of a mark consisting of the interlocking letters "RR" combined with the words "Communications, Inc. and design" for a telephone communications system, Trademark Attorney G.T. Glynn cited six Rolls-Royce plc registrations and noted as follows:

N.B. - applicant has appropriated a significant International Trademark of Rolls-Royce, i.e., double R Logo. Although the merchandise of the parties may differ, inevitable false attribution, mistake, deception and likelihood of confusion will arise under Section 2(d) of the Trademark Act. The double R logo is an extremely famous international mark, and the prospective

purchaser or user of applicant's telephonic products will readily assume sponsorship by Rolls-Royce Limited [now known as Rolls-Royce plc].

See Application Serial No. 73/497165 filed on August 30, 1984. See also Bose v. QSC Audio Products, Inc., Fed. Cir., No. 01-1216, 6/14/02.

16. Similarly, the United States Court of Appeals for the Second Circuit has noted the association of the letters "RR" with Rolls-Royce. The Court wrote in the case of Warner Bros., Inc. v. Gay Toys, Inc., 724 F.2d 327, 334 (2d Cir. 1983):

Different people, for example, buy Rolls-Royce automobiles for different reasons . . . but the distinctive overlapping "R's" symbol is nevertheless surely protectable. Irrespective of customers' motivations in making a purchase, they recognize and associate the symbol with the auto manufacture.

17. Applicant's use of the letters "RR" is confusingly similar to, and a colorable imitation of, the world-famous "RR" mark, and constitutes an infringement and dilution of the rights of Opposers Rolls-Royce plc and Hireus Limited and is damaging to them.

18. Applicant Trail King Industries, Inc., by virtue of its use or intended use of the mark "RR" for land vehicles and repair service for land vehicles is or would be trading upon and taking advantage of the enormous good will and reputation for excellence and quality that the Rolls-Royce Companies have created for their products and services at their sole expense and effort for more than three-quarters of a century. These products include the world-famous Rolls-Royce automobile for which Opposer Rolls-Royce plc maintains a registration in Class 12.

19. If Applicant Trail King Industries, Inc. were granted a registration for the mark "RR," it would defeat the purpose of the trademark laws.

As Arthur J. Greenbaum, a noted trademark lawyer, and Ronald O. Thomas noted in a Practicing Law Institute program on contemporary trademark problems:

[C]an anyone deny that the marks Kodak, Esso and Rolls-Royce, for example, are so well known as original marks of distinction that confusion, deception or error could result on the part of the public as well as customers were they to be used by interlopers even on the likes of vegetables, candy or tricycles? Of course not. If such protection were not available to these marks of distinction, the owners of such marks would constantly be going "back to the drawing board", so to speak, for another effort to obtain exceptional uniqueness. That cannot be an aid to effective competition.

R.J. Oziel, Contemporary Trademark Problems in Contested Patent Office Proceedings 111-112 (PLI Transcript Series 1969).

20. Registration and use by Applicant Trail King Industries, Inc. of the name and mark "RR" in connection with Applicant's goods and services, would interfere with Opposer Rolls-Royce plc's and Opposer Hireus Limited's rights in and use of the trademark "RR."

21. Applicant's registration and use of the mark "RR" is likely to deceive mislead and confuse the public, and suggest or induce the public falsely to believe that the business conducted by the Applicant Trail King Industries, Inc. is sponsored or authorized by or connected with the business of the Rolls-Royce Companies.

22. Applicant Trail King Industries, Inc.'s mark "RR" is deceptive and/or may disparage or falsely suggest a connection with Opposers Rolls-Royce plc, Hireus Limited and/or any of the other Rolls-Royce Companies, or bring it or them into contempt or disrepute.

23. Applicant Trail King Industries, Inc.'s mark "RR" constitutes a false designation of origin or false or misleading description or representation of fact in respect of Opposer Rolls-Royce plc's trademark "RR."

24. Applicant Trail King Industries, Inc.'s mark "RR" constitutes dilution of the distinctive quality of the Rolls-Royce mark "RR."

25. Registration and use by Applicant Trail King Industries, Inc. of the mark "RR" would seriously damage Opposer Rolls-Royce plc and Opposer Hireus Limited and the other Rolls-Royce Companies.

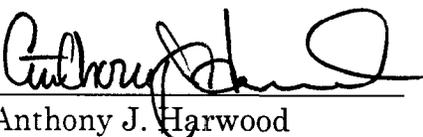
WHEREFORE, Opposer Rolls-Royce plc and Opposer Hireus Limited pray that this opposition be sustained and that registration of the mark in Application Serial No. 76/369,366 filed February 11, 2002 be denied in all classes.

The required opposition fee of \$1,200 accompanies this Notice.

Dated: September 6, 2002

Rolls-Royce plc and Hireus Limited

By:

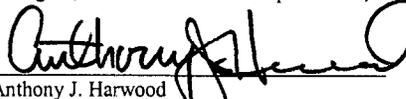


Anthony J. Harwood
Ruth L. Lansner
Attorney for Opposers
Rolls-Royce plc and Hireus Limited
Holland & Knight LLP
195 Broadway
New York, New York 10007
Tel: (212) 513-3440

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I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" in an envelope addressed to: BOX TTAB FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on September 6, 2002.



Anthony J. Harwood

Date of Signature: September 6, 2002

SN 76-369,306, TRAIL KING INDUSTRIES, INC., MITCH-
ELI, SD. FILED 4-11-2002.

RR

CLASS 12—VEHICLES

FOR CARGO TRAILERS, INCLUDING DUMP TRAILERS, LIVE BOTTOM TRAILERS, BOTTOM DUMP TRAILERS, AND END DUMP TRAILERS, AND PARTS THEREFOR (U.S. CLS. 19, 21, 23, 31, 33 AND 41).
FIRST USE 1-1-1938; IN COMMERCE 1-1-1938.

CLASS 37—CONSTRUCTION AND REPAIR

FOR TRAILER REPAIR SERVICES (U.S. CLS. 100, 103 AND 106).

TOTAL P. 02



UNITED STATES PATENT AND TRADEMARK OFFICE

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List At: OR to record: **Record 61 out of 65**

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(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark RR

Goods and Services IC 012. US 019. G & S: MOTOR ROAD VEHICLES AND CHASSIS THEREFOR. FIRST USE: 19070000. FIRST USE IN COMMERCE: 19070000

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 71381818

Filing Date August 4, 1936

Registration Number 0344372

Registration Date March 23, 1937

Owner (REGISTRANT) **ROLLS-ROYCE LIMITED CORPORATION** GREAT BRITAIN
 NIGHTINGALE ROAD DERBY ENGLAND

(LAST LISTED OWNER) **ROLLS-ROYCE PLC** COMPANY BY CHANGE OF NAME FROM
 UNITED KINGDOM 65 BUCKINGHAM GATE LONDON, SW1E 6AT ENGLAND

Assignment Recorded ASSIGNMENT RECORDED

Attorney of

Record RUTH L LANSNER
Section 44 Indicator SECT44
Priority Date July 18, 1935
Prior Registrations 0197089
Description of Mark THE HORIZONTAL LINES ARE MERELY USED FOR PURPOSES OF SHADING.
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 12C. SECT 15.
Renewal 3RD RENEWAL 19970327
Live/Dead Indicator LIVE

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ROLLS - ROYCE

Word Mark ROLLS-ROYCE
Goods and Services IC 012. US 019. G & S: AUTOMOBILES AND CHASSIS. FIRST USE: 19060000. FIRST USE IN COMMERCE: 19060000
Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number 71359008
Filing Date December 6, 1934
Registration Number 0325195
Registration Date June 11, 1935
Owner (REGISTRANT) ROLLS-ROYCE LIMITED CORPORATION GREAT BRITAIN NIGHTINGALE ROAD DERBY ENGLAND

(LAST LISTED OWNER) ROLLS-ROYCE PLC COMPANY BY CHANGE OF NAME FROM UNITED KINGDOM 65 BUCKINGHAM GATE LONDON, SW1E 6AT ENGLAND

Assignment Recorded ASSIGNMENT RECORDED
Attorney of

Record EDWARD M. PRINCE
Section 44 Indicator SECT44
Priority Date April 9, 1907
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 12C. SECT 15.
Renewal 3RD RENEWAL 19950727
Live/Dead Indicator LIVE

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Word Mark ROLLS ROYCE RR

Goods and Services IC 012. US 019. G & S: AUTOMOBILES AND CHASSIS. FIRST USE: 19050101. FIRST USE IN COMMERCE: 19050101

Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 261111

Serial Number 71197394

Filing Date May 21, 1924

Registration Number 0197089

Registration Date April 7, 1925

Owner (REGISTRANT) ROLLS-ROYCE OF AMERICA, INC. CORPORATION DELAWARE PAGE BLVD. SPRINGFIELD MASSACHUSETTS

(LAST LISTED OWNER) ROLLS-ROYCE LIMITED CORPORATION BY CHANGE OF NAME FROM ENGLAND P. O. BOX 31 DERBY DE2 8BJ ENGLAND

Assignment Recorded ASSIGNMENT RECORDED

Prior Registrations 0186458
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 12C. SECT 15.
Renewal 3RD RENEWAL 19850910
Live/Dead Indicator LIVE

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Law Offices

HOLLAND & KNIGHT LLP

195 Broadway
New York, New York 10007-3189
212-513-3200
FAX 212-385-9010
www.hklaw.com

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September 6, 2002

ANTHONY J. HARWOOD
212-513-3559
ajharwood@hklaw.com

U.S. Patent & TMO/c/TM Mail Rcpt. Dt. #57



09-06-2002

EXPRESS MAIL

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

Re: Rolls-Royce plc and Hireus Limited v. Trail King Industries, Inc.
(Application 76/369,366)

02 NOV -5 PM 9:30
TRAIL KING INDUSTRIES, INC.

Dear Commissioner:

Enclosed for filing please find two copies of a Notice of Opposition that we are submitting on behalf of Rolls-Royce plc and Hireus Limited opposing the application of Trail King Industries, Inc. for registration of the mark "RR" in classes 12 and 37. We have also enclosed a check for the filing fees of \$1,200. Kindly acknowledge receipt of these materials on the enclosed, self-addressed, pre-paid post card. Thank you.

Respectfully submitted,


Anthony J. Harwood