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

SPENCER DISTRIBUTING, L.P. and JERRY SPENCER, L.P. Opposer, RACETRAC PETROLEUM, INC., Applicant.	Opposition No. ____ In the matter of: Application Serial No. 76/202,318 MARK: RACETRAC and Building Design Filed on: January 30, 2001 Published in the Official Gazette on January 21, 2003

01-30-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

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

02/05/2003 KGIBBONS 00000054 76202318
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NOTICE OF OPPOSITION

Opposer, Spencer Distributing, L.P. and Jerry Spencer, L.P. ("Opposer"), limited partnerships organized and existing under the laws of the State of Texas, and having their principal place of business at 3008 Highway 155 North, Palestine, Texas 75801, believes that they will be damaged by registration of the mark RACETRAC and Building Design shown in Application Serial Number 76/202,318 and hereby oppose the same.

As grounds of opposition, Opposer alleges:

1. Applicant, RACETRAC PETROLEUM, INC. ("Applicant" or "Racetrac") is the owner of a large chain of gasoline station convenience stores located throughout the southeastern United States. Applicant filed Application Serial Number 76/202,318 on January 30, 2001. Applicant seeks registration of the following mark:

> The mark consists of a three dimensional representation of a gas station which has a ribbed roof, the eave of which is red with a thin white stripe on the bottom and which wraps completely around the edge of the roof. In front of the gas station is a three dimensional representation of a stand-alone canopy covering gas pumps. The canopy has a flat roof. The eave of the roof is gray and contains a thin white stripe bordering a thicker red stripe which wraps completely around the edge of the roof. The word "RACETRAC" is displayed in the middle of the eave, on top of the red strip, and on all four sides of the canopy eave. The word "RACETRAC" is displayed in the middle of the station eave above the front door.

Applicant seeks registration of the RACETRAC mark and building design in International Classes 35 and 37.

2. Applicant alleges that it has been using in commerce the RACETRAC mark and building design in connection with Applicant's goods since 1986. Applicant claims that its mark has become distinctive by virtue of (1) its use in connection with Applicant's goods substantially, exclusively, and continuously for at least five years preceding the filing date of the application, and (2) the fact that it has achieved secondary meaning or source identifying significance with the consuming public. Applicant's claims are incorrect. Applicant has not used its claimed trade dress substantially, exclusively, or continually for the five years preceding the filing date of its application. Further, Applicant's claimed trade dress has not achieved secondary meaning. Finally, the rights of Applicant to the above-referenced mark are currently being litigated in Civil Action No. 3:01-CV-1397-P styled "*RaceTrac Petroleum, Inc. v. J.J. Fast Stop, Inc., et al.*," pending in the United States District Court for the Northern District of Texas, Dallas Division (the "Federal Court Proceedings"). Because any decision by the district court will bind the Trademark Trial and Appeal Board, Opposer has requested this action be suspended.

Applicant's Trade Dress Lacks Distinctiveness.

3. Applicant's claimed trade dress is not subject to registration because it is generic and lacks distinctiveness. Applicant has not used its claimed trade dress exclusively for the five years

preceding the filing date of its application. Rather, Applicant's claimed trade dress is an ordinary or common place design for gas station convenience stores that is shared by many competitors within the industry.

4. Numerous competitors in the industry use a combination of the building design elements claimed by Applicant to constitute its trade dress as part of their gasoline station convenience store designs. Applicant's use of the color red, and even red and white striping, is a common color scheme widely used throughout the gasoline station convenience store industry. This color scheme is in no way exclusive to Applicant. The color red is one of the most popular colors in gasoline station convenience stores. Gasoline station convenience stores routinely use red on pump island canopies, pumps, building exteriors and signage. Red and white striping is also a common color combination regularly used throughout the industry and has been prevalent in the industry for may years. Applicant's placing of its mark RACETRAC onto building design elements does not make them any less generic or commonplace within the industry.

5. In addition to the fact that Applicant has not used its claimed trade dress exclusively, Applicant has not used its claimed trade dress continuously for at least the five years preceding the filing date of its application. The elements Applicant now claims constitute its trade dress are inconsistently used throughout its various stores. Therefore, Applicant has not presented its trade dress in a uniform, consistent, and continuous manner to the public.

Applicant's Trade Dress Has Not Acquired Secondary Meaning

6. Applicant's trade dress has not acquired secondary meaning or source identifying significance in the minds of the consuming public. The public does not understand the primary significance of Applicant's gas station convenience store design to be to identify Applicant as the source of its products. Evidence considered in determining whether a trade dress has acquired

secondary meaning includes the length and manner of use of the trade dress, the volume of sales, the amount and manner of advertising, the nature of use of the trade dress in advertising media, consumer survey evidence and direct consumer testimony.

7. Applicant has produced no direct consumer testimony of secondary meaning. The excerpts from the focus group dialogue do not provide evidence of an association in consumers' minds of Applicant's claimed trade dress with Applicant's services. The focus group dialogue contains only one reference to the Applicant's building design and that reference is an inaccurate description of Applicant's claimed trade dress.

8. Applicant has provided no consumer survey evidence showing that its claimed trade dress has acquired secondary meaning.

9. Applicant has provided no evidence that its advertising features or emphasizes its trade dress.

10. Applicant attempts to prove secondary meaning by virtue of its considerable sales revenue. However, there is absolutely no evidence connecting the sales revenues to Applicant's claimed trade dress. The sales revenues enjoyed by Applicant could be traceable to a number of factors other than its alleged trade dress.

11. Other than its sales revenue and focus group dialogue, Applicant merely relies on its own opinion as to its "striking appearance" and "very unique gas stations" to support its claim of secondary meaning. Although Applicant may feel that its stations are striking and very unique this is not evidence that the trade dress has achieved any source identifying significance in the minds of the consuming public.

The Federal Court Proceedings

12. The rights of Applicant to the above-referenced mark are currently being litigated in

has expended considerable sums of money in developing its trade dress and in designing and configuring its gasoline station convenience stores.

WHEREFORE, Opposer prays that this opposition be sustained in favor of Opposer and that. the Application serial number 76/202,318 be rejected and that no registration be issued to the Applicant.

A duplicate copy of this Notice of Opposition and the fee required in §2.6(a)(17) are enclosed.

Respectfully submitted,

SPENCER DISTRIBUTING, L.P.
JERRY SPENCER, L.P.

By: _____
Joseph F. Cleveland, Jr.
Texas State Bar No. 04378900

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CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.10 (?)

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 in an envelope addressed to: Trademark Trial and Appeal Board, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3512, on January 30, 2003.

_____
Joseph F. Cleveland, Jr.

Express Mail Certification No. **EL 500853807US**

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January 30, 2003

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Via Express Mail EL 500853807US

Re: In the matter of:

Application Serial No. 76/202,318
MARK: RACETRAC and Building Design

Filed on: January 30, 2001
Published in the Official Gazette
on January 21, 2003

Dear Sir:

Enclosed are the following:

1. Original and one copy of Notice of Opposition;

2. Original and one copy of Notice of Court Proceedings and Request to Abate;

3. Check in the amount of $600;

4. Self-addressed, stamped return envelope;

5. Return postcard.

The documents are submitted on behalf of Opposer Spencer Distributing, L.P. and Jerry Spencer, L.P.

Please return file-marked copies of the Notice Of Opposition and Notice Of Court Proceedings And Request To Abate in the envelope.

Very truly yours,

Joseph F. Cleveland, Jr.

JFC:ell

Enclosures

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