

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

In re Application Serial No. 78/002,901 for the mark ECOMEX filed on April 6, 2000, and published in the *Official Gazette* on January 29, 2002

NEW YORK MERCANTILE)
EXCHANGE, INC.,)
)
Opposer,)
)
v.)
)
GLOBAL ECOMEX LTD.,)
)
Applicant.)

Opp. No. _____

BOX TTAB FEE
Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

NOTICE OF OPPOSITION

New York Mercantile Exchange, Inc. (NYMEX), a Delaware corporation, having its principal place of business at One North End Avenue, World Financial Center, New York, New York, 10282-1101, believes that it will be damaged by the registration of the above-identified mark, and hereby opposes the same pursuant to the provisions of Section 13 of the Lanham Act, 15 U.S.C. §1063.

As grounds for the opposition, it is alleged that:

1. Opposer NYMEX is a well-known physical commodity futures exchange, and a preeminent trading forum for energy and precious metals in North America.

2. Opposer is the parent company of Commodity Exchange, Inc. (hereinafter "Commodity Exchange"), a New York corporation with a principal place of business at One North End Avenue, World Financial Center, New York, New York, 10282-1101. Commodity Exchange is a wholly-owned subsidiary of NYMEX.

3. Commodity Exchange, commonly referred to as COMEX, is a premier trading forum for metals, including gold, silver, copper, and aluminum.

4. Commodity Exchange has obtained three federal registrations for its COMEX marks, Registration Nos. 1,036,378, 1,035,011 and 1,415,140 (hereinafter the "COMEX Marks"). Registration No. 1,036,378 has been in use since June 13, 1963, Registration No. 1,035,011 has been in use since September 1973, and Registration No. 1,415,140 has been in use since December 1984.

5. Commodity Exchange is the owner of all right, title, and interest in and to the COMEX marks for a variety of goods and services including the "operation of an exchange market for trading in commodity futures contracts, primarily metals" in International Class 36, and for "computer game programs recorded on discs" in International Class 28 (collectively referred to as the "COMEX Products and Services").

6. Since long prior to Applicant's filing date of April 6, 2000, Opposer, through its wholly-owned subsidiary Commodity Exchange, has extensively used and promoted the COMEX Marks throughout the United States and the world in connection with services offered thereunder, including the operation of a financial exchange market and trading in commodity futures contracts.

7. As a result of the extensive use and promotion of Opposer's COMEX Marks, the marks have become well-known as a distinctive indicator of the origin of Opposer's goods and services, and the marks are imbued with valuable goodwill.

8. Furthermore, as a result of Opposer's long, continuous, and extensive use of the COMEX Marks, the marks have become well-known and famous as distinctive indicators of the origin of Opposer's goods and services, and are valuable symbols of Opposer's goodwill.

9. All three registrations for the COMEX Marks are valid and incontestable. Accordingly, these registrations provide prima facie and conclusive evidence of Opposer's ownership of the COMEX Marks, and of Opposer's exclusive right to use the marks in commerce.

10. The COMEX Marks have become particularly well-known among brokers, traders, corporations, and other consumers in the metals industry, as well as among those who trade commodity futures.

11. Notwithstanding Opposer's prior rights in the COMEX Marks, Applicant filed an application with the United States Patent and Trademark Office to register the mark ECOMEX (Ser. No. 78/022,901) for "electronic commerce services, namely, providing a website featuring auction, sale, and purchase services" in International Class 35; "electronic commerce services, namely, providing a website featuring stock and commodity exchange services" in International Class 36; and "computer services, namely hosting the websites of others on a computer server for a global computer network" in International Class 42.

12. Upon information and belief, Applicant filed its application based on an intention to use its alleged mark, and had not used its alleged mark in commerce in the United States prior to the filing date of its application.

13. Upon information and belief, Applicant knew of, had reason to know of, or was aware of the COMEX Marks when Applicant adopted its alleged mark.

14. Upon information and belief, Opposer's goods and services and Applicant's services would be advertised, promoted, and sold in the same or similar channels of trade, and would be directed to the same or similar purchasers.

15. Opposer, through Commodity Exchange, has used its COMEX Marks continuously on or in connection with its goods and services in interstate commerce long prior to the date of first use alleged by Applicant in Application Serial No. 78/002,901.

**Lanham Act Section 2(d)
Likelihood of Confusion**

16. Applicant restates paragraphs 1 through 15 as if fully set forth herein.

17. Applicant's alleged mark ECOMEX so resembles the COMEX Marks in sound, appearance, meaning, and commercial impression that the use and registration thereof is likely to cause confusion, mistake and/or deception as to the source or origin of Applicant's services, in violation of Section 2(d) of the Lanham Act, and will injure or damage Opposer and the reputation and goodwill symbolized by the COMEX Marks.

18. The services to be offered under Applicant's alleged mark are so closely related to the goods and services Opposer offers, through Commodity Exchange, under the COMEX Marks that the public is likely to be confused, to be deceived and to assume erroneously that Applicant's services are those of Opposer and/or Commodity Exchange, or that Applicant is in some way connected with, sponsored by, or affiliated with Opposer and/or Commodity Exchange, all to Opposer's irreparable damage.

19. Applicant is not affiliated with, connected with, endorsed by, or sponsored by Opposer or Commodity Exchange, nor have Opposer or Commodity Exchange approved any of the services offered or sold or intended to be sold by Applicant under its alleged mark.

20. Likelihood of confusion in this case is enhanced by the fame of the COMEX Marks, and by the fact that consumers in the metals industry and consumers who trade commodity futures associate the COMEX Marks with the goods and services sold, approved, or endorsed by Opposer through Commodity Exchange.

**Lanham Act Section 2(a)
Deception/False Suggestion of Connection**

21. Applicant restates paragraphs 1 through 20 as if fully set forth herein.

22. Applicant's alleged mark and Opposer's marks are predominantly composed of the word "comex," and thus, are virtually identical.

23. Applicant's alleged mark points uniquely and unmistakably to Commodity Exchange.

24. The COMEX Marks are so well-known and famous that purchasers will presume that services offered under Applicant's alleged mark are connected with Opposer and/or Commodity Exchange.

25. Applicant's alleged mark ECOMEX so closely resembles the COMEX Marks that the use and registration of Applicant's alleged mark will falsely suggest a connection with Opposer in violation of Section 2(a) of the Lanham Act, and will result in irreparable damage and injury to Opposer.

**Lanham Act Section 43(d)
Dilution**

26. Applicant restates paragraphs 1 through 25 as if fully set forth herein.
27. For many years, the COMEX Marks have been widely used in the United States, particularly in the metals industry and in commodity futures trading. As a result, the COMEX Marks have become well-known and famous as distinctive symbols of Opposer's goodwill.
28. Upon information and belief, Applicant intends to use the alleged mark, ECOMEX, in commerce with the willful intent to trade on Opposer's reputation, or to cause dilution of the famous COMEX Marks.
29. The COMEX Marks became well-known and famous, particularly in the metals industry and in commodity futures trading, long before Applicant filed its application to register its alleged mark, ECOMEX.
30. The alleged mark ECOMEX, shown in Applicant's service mark application, will dilute the distinctive quality of the COMEX Marks.
31. Use or registration of the alleged mark ECOMEX will lessen the capacity of the famous COMEX Marks to identify and distinguish the goods and services offered under the COMEX Marks.
32. Applicant's use and/or registration of the alleged mark ECOMEX will deprive Opposer of the ability to protect its reputation and goodwill.
33. Applicant's use and/or registration of the alleged mark ECOMEX for the services listed in its application will tarnish the goodwill symbolized by the COMEX Marks.
34. Likelihood of tarnishment and damage to Opposer's goodwill is enhanced by Applicant's alleged mark, and prospective customers who encounter deficiencies in the quality

of Applicant's services will attribute those deficiencies to Opposer, thereby tarnishing the goodwill associated with the COMEX Marks.

35. By reason of the foregoing, Opposer will be damaged by the use and registration of Applicant's alleged mark ECOMEX. As a result, registration of ECOMEX should be denied.

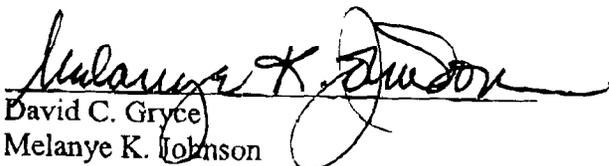
WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

This Notice of Opposition is being filed in triplicate, and statutory filing fees of \$900.00 are being submitted herewith. To the extent that this payment is insufficient or the payment becomes detached from the filing, the Assistant Commissioner is authorized to charge the fees associated with this filing to Deposit Account No. 01-2300.

Respectfully Submitted,

**NEW YORK MERCANTILE
EXCHANGE, INC.**

By:

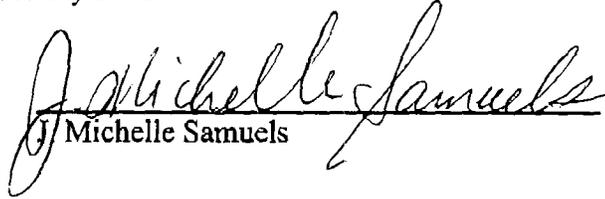


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1050 Connecticut Avenue, NW
Washington, D.C. 20036
(202) 857-6000

Attorneys for Opposer
New York Mercantile Exchange, Inc.

CERTIFICATE OF MAILING

It is hereby certified that the attached *Notice of Opposition* and *Communication* is being deposited with the United States Postal Service addressed to BOX TTAB FEE, Hon. Assistant Commissioner of Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, marked first class mail, postage prepaid, this 29th day of May 2002.


J Michelle Samuels

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

In re Application Serial No. 78/002,901 for the mark ECOMEX filed on April 6, 2000, and published in the *Official Gazette* on January 29, 2002

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BOX TTAB FEE
Assistant Commissioner of Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

COMMUNICATION

Dear Sir/Madam:

Enclosed please find the following documents for filing:

1. Notice of Opposition (filed in triplicate);
2. A check in the amount of \$900.00; and
3. Post card receipt (please date stamp and return).

Please debit any additional necessary amounts or credit any overpayments to Direct Deposit Account Number 01-2300.

Respectfully Submitted,

**NEW YORK MERCANTILE
EXCHANGE, INC.**

By:


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December 17, 2002

VIA FACSIMILE

Ms. Tisa Williams
Legal Assistant
U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, VA 22203-3513

Leo M. Loughlin
202/857-6140
loughlil@arentfox.com

Reference Number
020139.00365

Re: Opposition to Mark: ECOMEX
Serial No. 78/002,901

Dear Ms. Williams:

Following up on your telephone message to me on December 12, 2002, attached please find the Notice of Opposition which was timely filed on May 29, 2002 and the PTO Communication granting an extension of time to file until May 29, 2002. In view of these materials, please contact us regarding when the opposition to the mark ECOMEX (Serial No. 78/002,901) will be formally instituted on behalf of the New York Mercantile Exchange and the Notice of Allowance withdrawn.

We look forward to receiving your response at your earliest convenience.

Very truly yours,

Leo M. Loughlin

MKJ/

cc: Jason Lott, PTO Law Office 104
David C. Gryce, Esq.

**UNITED STATES PATENT AND TRADEMARK
OFFICE****Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

Mailed: June 4, 2002

Applicant: Global Ecomex Ltd
Serial No.: 78002901
Filed: 04/06/2000
Mark: ECOMEX

MELANYE K. JOHNSON
ARENT FOX KINTNER PLOTKIN & KAHN, PLLC
1050 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

Tisa Williams, Legal Assistant

The request for extension of time to oppose, filed under Trademark Rule 2.102 on behalf of **NEW YORK MERCANTILE EXCHANGE, INC.** (copy attached), was timely filed but is just now being acted on. The Board regrets the delay and any resulting inconvenience caused to the potential opposer or to applicant.

The request for extension of time to oppose is granted. If any further request for extension of time to oppose or any notice of opposition was filed on or before **5/29/02**, it will be considered as having been timely filed.

