

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



10-15-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

TBC BRANDS, LLC,)
)
Opposer,)
)
v.) Opposition No.
)
KUMHO INDUSTRIAL CO., LTD.,)
)
Applicant.)

NOTICE OF OPPOSITION

In the matter of an application to register a trademark under the Trademark Act of 1946, Serial No. 76/416,504, filed June 3, 2002, in the name of Kumho Industrial Co., Ltd., published for opposition in the Trademark Official Gazette of June 17, 2003, Vol. 1271, No. 3, at page TM 265, for the mark MATRAC, the Opposer, TBC Brands, LLC, believes it will be damaged by registration of said alleged trademark and hereby opposes same. The grounds for opposition are as follows:

1. The Opposer, TBC Brands LLC [hereinafter "TBC"], is a corporation duly organized and existing under the laws of the State of Delaware and having its place of business at 639 Isbell Road, Reno, Nevada 89502. Opposer, through its licensee, TBC Corporation of Memphis, Tennessee, distributes and sells, throughout the world and in commerce, a variety of vehicle products and services, including tires. (Opposer and its licensee, TBC Corporation, hereafter collectively are referred to as "TBC".)

2. Commencing long prior to the filing date of the application opposed herein, TBC has, and is now, engaged in the distribution and sale of tires, in commerce in the United States, under and in connection with the trademark **MATRIX**, alone and in conjunction with other words and designs;

commencing long prior to the filing date of the application opposed herein, TBC also has, and is now, engaged in the distribution and sale of tires, in commerce in the United States, under and in connection with the trademark **MULTI-TRAC**, alone and in conjunction with other words and designs. TBC continuously has used said Opposer's **MATRIX** and **MULTI-TRAC** marks, in commerce in connection with tires, produced, advertised, offered for sale, and sold by TBC, and to identify and designate same, and to distinguish those goods from those of others.

3. Opposer is the owner of, and will rely on herein, the following U.S. trademark registrations:

REGISTRATION NO.	ISSUE DATE
981,104	March 26, 1974
1,478,574	March 1, 1988

Said registrations are valid and subsisting, and constitute conclusive evidence of Opposer's ownership of Opposer's **MATRIX** and **MULTI-TRAC** marks, and exclusive right to use same in commerce in connection with the goods set forth in said registrations.

4. Since TBC's initial use of its **MATRIX** and **MULTI-TRAC** marks, TBC has used, and advertised, produced, offered for sale and sold its tires under and in connection with each of said marks to the public, through various channels of trade, and in commerce, with the result that TBC's customers and the public in general have come to know and recognize each of said marks of Opposer and associate same with TBC and/or the tires produced, advertised, marketed, distributed, offered for sale, and sold directly or indirectly by TBC. Opposer thus has built up goodwill in connection with the sale of its tires under Opposer's **MATRIX** and **MULTI-TRAC** marks.

5. On June 3, 2002, Applicant filed an application to register the mark MATRAC. Said application was accorded serial no. 76/416,504, and was published for opposition in the Official Gazette of June 17, 2003, at page TM 265, identifying the goods as "automobile tires."

6. The MATRAC mark sought to be registered by Applicant is a colorable imitation of, and so resembles, Opposer's prior and aforesaid **MATRIX** and **MULTI-TRAC** marks as to be likely, when used in connection with the goods of Applicant, to cause confusion or mistake or to deceive.

7. On information and belief, the goods set forth in the application opposed herein are identical and/or similar and/or related to, the goods in connection with which TBC uses Opposer's **MATRIX** and **MULTI-TRAC** marks, and on information and belief, the goods set forth in the opposed application are and/or will be sold through the same and/or similar channels of trade, and/or to the same general class of purchasers, in and to which TBC's products are marketed and/or sold.

8. On information and belief, Applicant had actual knowledge of Opposer's prior **MATRIX** mark, as used by TBC, prior to the filing date of the opposed application.

9. On information and belief, Applicant had actual knowledge of Opposer's prior **MULTI-TRAC** mark, as used by TBC, prior to the filing date of the opposed application.

10. The registration and/or use of the MATRAC mark, as set forth in the opposed application, is likely to cause confusion, mistake, and/or to deceive as to origin, sponsorship, and/or association of Applicant's goods to be sold under the MATRAC mark sought to be registered by Applicant vis-a-vis TBC and/or Opposer's **MATRIX** and **MULTI-TRAC** marks, and/or to mislead purchasers of Applicant's and/or TBC's goods, and/or the public in general, into believing that Applicant's goods are sold by, emanate from, and/or in some way, directly or indirectly, are

associated with TBC, and/or Opposer's **MATRIX** and **MULTI-TRAC** marks, or products, or vice versa, to the damage and detriment of TBC.

11. By virtue of the foregoing, Opposer believes it will be damaged by the registration by Applicant of the MATRAC mark, as set forth in the application therefor, serial no. 76/416,504.

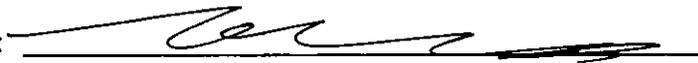
12. If Applicant is granted the registration opposed herein, and Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, Applicant will obtain unlawful gain and advantage to which it is not entitled under the Trademark Act of 1946, to the detriment and harm of Opposer.

WHEREFORE, this Opposer, TBC Brands, LLC, believes and alleges that it will be damaged by registration of the MATRAC mark of application serial no. 76/416,504, as aforesaid, and prays that:

- B. judgment in the present opposition be entered in favor of Opposer;
- C. the present opposition be sustained; and
- D. registration of application serial no. 76/416,504 be rejected and refused.

Respectfully submitted,

TBC BRANDS, LLC

By: 

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Date: October 15, 2003

TTAB



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October 15, 2003



10-15-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

RE: New Opposition
TBC Brands, LLC v. Kumho Industrial Co., Ltd.
MATRAC - Serial No. 76/416,504
Our Ref.: 1952/I-4939

Sir:

We enclose the following for filing in the Patent and Trademark Office:

- Notice of Opposition (in duplicate)
- Notice of Appeal

Also enclosed is our check for the required filing fee in the amount of \$300.00. Should this check become detached, or the amount be insufficient, please charge our Deposit Account, No. 06-1358.

Respectfully submitted,

Marsha G. Gentner

MGG/tlb
Enclosures