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Attorney Docket: 04145.8051

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

Subaru Investment, Inc.,	)
	)
Opposer,	)
	)
v.	)
	)
Aeroflex International Company, Ltd.,	)
	)
Applicant.	)

Opposition No. \_\_\_\_\_  
Application No.: 76/502,662



04-01-2004  
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

**NOTICE OF OPPOSITION**

Subaru Investment, Inc., through its attorneys, believing that it will be damaged by the registration of Application Serial No. 76/502,662 for the mark AERO OUTBACK, alleges as follows. Allegations relating to Opposer are based upon actual knowledge. All other allegations are based upon information and belief.

1. Subaru Investment, Inc., is a Delaware corporation with a place of business located at 900 Market Street, Wilmington, Delaware 19801.
2. Subaru Investment, Inc., through its related companies (collectively, "Subaru"), manufactures, distributes, sells, and services automobiles and automobile parts through a nationwide network of approximately 600 authorized dealerships. Subaru is a pioneer in crossover all-wheel drive vehicles, combining the functionality of all-wheel drive and sport-utility handling with the comfort and convenience of passenger vehicles.

3. Since at least as early as October 20, 1989, Subaru and its predecessors and/or related companies in interest have used and promoted the OUTBACK mark in connection with a crossover automobile and its structural parts.

4. Subaru is the owner of all right, title, and interest to the OUTBACK mark for automobiles and automobile parts, and owns U.S. Registration No. 1,602,140 for the mark OUTBACK covering automobiles and structural parts therefor in Class 12. This registration, which issued on June 19, 1990, is incontestable.

5. Subaru's OUTBACK automobile has been wildly popular, with between 50,000-70,000 vehicles sold in the U.S. each year for the past several years.

6. The OUTBACK vehicle has been recognized and praised throughout the industry, and has received acclaim and attention for its design and functionality.

7. Subaru has established considerable and valuable goodwill and fame in its OUTBACK mark by virtue of its substantial promotional and marketing efforts, its expenditure of vast sums in advertising and promotional activities, the strong nationwide sales of automobiles and parts under the mark, and third-party acclaim and attention.

8. Applicant Aeroflex International Co., Ltd. is a corporation of Thailand with an address at Khing Amphoe Nikom Pattana, No. 111/1 Moo 2, Tambol Makham-Khoo, Changwad Rayong 21180, Thailand.

9. On April 1, 2003, Applicant filed an intent-to-use application for the mark AERO OUTBACK. The application was assigned Serial No. 76,502,662, was published on November 4, 2003, and covers the following goods: "fitted liners for the cargo area of pick-up truck, truck bed protectors," in Class 12.

10. Applicant filed its application for the AERO OUTBACK mark long after Subaru first used and registered the OUTBACK mark, and long after the OUTBACK mark became famous.

11. Applicant's AERO OUTBACK mark so resembles Subaru's previously used and registered OUTBACK mark as to be likely, when used in connection with Applicant's goods, to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

12. In view of the strength of the OUTBACK mark, the duration and extent of use of the OUTBACK mark by Subaru and its predecessors and/or related companies in interest, the duration and extent of advertising of the OUTBACK mark, and the degree of recognition of the OUTBACK mark, the OUTBACK mark has become famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

13. Given the fame of Opposer's OUTBACK mark, and the close similarities of Applicant's AERO OUTBACK mark to Opposer's OUTBACK mark, Applicant's mark is likely to dilute and does dilute the distinctiveness of Opposer's famous mark OUTBACK under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

14. For these reasons, Subaru would be damaged by the registration of Applicant's AERO OUTBACK mark shown in Application Serial No. 76/502,662.

WHEREFORE, Opposer respectfully requests that registration of the mark AERO OUTBACK, Serial No. 76/502,662, be refused and that this opposition be sustained.

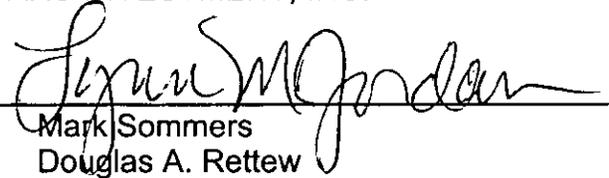
As required, this Notice of Opposition is being submitted in duplicate pursuant to Trademark Rule 37 C.F.R. § 2.104(a) along with a check for \$300 to cover the opposition filing fee. If the filing fee is found to be insufficient for any reason, please charge the deficiency to our Deposit Account No. 06-0916.

Respectfully submitted,

SUBARU INVESTMENT, INC.

Dated: April 1, 2004

By:



Mark Sommers  
Douglas A. Rettew  
Lynn M. Jordan  
Attorneys for Opposer

Finnegan, Henderson, Farabow,  
Garrett & Dunner, L.L.P.  
1300 I Street, N.W.  
Washington, D.C. 20005-3315  
Telephone: 202-408-4000  
Facsimile: 202-408-4400