

**UNITED STATES PATENT AND TRADEMARK
OFFICE**
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: October 18, 2004

Opposition No 91162527
Serial No. 78313196

TTAB

Kimberly A. Chasteen
Williams Mullen
721 Lakefront Commons, Suite 210
Newport News, VA 23606

North Carolina Automobile Dealers
Association, Inc.

v.

CarMax Auto Superstores West
Coast, Inc.

SHAWN D. MERCER, ESQ.
JOHNSON, HEARN, VINEGAR, GEE & MERCER, PLLC
N.C.S.B. 19182 - TWO HANNOVER SQUARE, SUITE 2200, P.O. BOX
1776
RALEIGH, NC 27602

Tracey Fleming, Legal Assistant.

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

ANSWER IS DUE FORTY DAYS after the mailing date hereof.
(See Trademark Rule 2.196 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that affect the rules of practice before the TTAB. See Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68



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Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003). Notices concerning the rules changes, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), are available at www.uspto.gov.

The parties are particularly referred to Trademark Rule 2.126 pertaining to the form of submissions. Paper submissions, including but not limited to exhibits and depositions, not filed in accordance with Trademark Rule 2.126 may not be given consideration or entered into the case file.

Discovery and testimony periods are set as follows:

Discovery period to open: November 07, 2004

Discovery period to close: May 06, 2005

30-day testimony period for party in position of plaintiff to close: August 04, 2005

30-day testimony period for party in position of defendant to close: October 03, 2005

15-day rebuttal testimony period for plaintiff to close: November 17, 2005

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). The notice is available at

<http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

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

In the matter of trademark application Serial)
No. 78-313, 196.)
For the mark "We'll Buy your car even if you)
don't Buy Ours.")
Published in the Official Gazette on August)
10, 2004)
North Carolina Automobile Dealers) Case Number
Association, Inc.)
Opposer)
v.)
Carmax Auto Superstores West Coast, Inc.)
Applicant)

TTAB

NOTICE OF OPPOSITION

The North Carolina Automobile Dealers Association, Incorporated ("NCADA"), a North Carolina non-profit corporation whose address is 1029 Wade Avenue, Raleigh, North Carolina 27605, believes that it and its individual members will be damaged by the registration of the mark shown in the above-identified application and hereby opposes the same.

The grounds for the opposition are as follows:

1. NCADA is an association organized under the laws of the State of North Carolina as a non-profit corporation, which association is comprised of approximately seven hundred (700) individual car dealers located throughout the State of North Carolina;

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2. Pursuant to its Charter, NCADA is charged with representing and protecting its constituent members consistent with the purposes of the Association.
3. One purpose of the association is to minimize to the extent reasonably possible restraints on the right of its constituents to conduct their businesses in a legitimate and lawful manner;
4. NCADA believes that the proposed registration by Applicant will impinge upon the legitimate rights of the NCADA's members to conduct their businesses;
5. The proposed mark, "We'll Buy your car even if you don't Buy Ours," is purely descriptive of the business practices of car dealers located throughout North Carolina and elsewhere. Many car dealers are willing to inspect and purchase used cars regardless of whether the seller is willing to buy a car from that dealer and many of those dealers advertise their willingness to do so.
6. The proposed mark is descriptive, does not have any secondary meaning and has been used by companies both inside and outside of the United States to describe an automobile dealer's willingness to consider buying a prospective buyer's automobile even if the buyer doesn't buy one from the dealer.
7. The proposed mark is generic and merely describes the generic willingness of an automobile dealer to consider buying a prospective buyer's automobile even if the buyer does not purchase an automobile from the dealer.

For the reasons stated above, North Carolina Automobile Dealers Association, Inc. opposes the issuance of the above trademark.

Respectfully submitted this the 4th day of October, 2004,

North Carolina Automobile Dealers Association, Incorporated

By its attorney:



Shawn D. Mercer, Esq.
Johnson, Hearn, Vinegar,
Gee & Mercer, PLLC
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Two Hannover Square, Suite 2200
Post Office Box 1776
Raleigh, NC 27602
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CERTIFICATE OF SERVICE

This is to certify that I have this day served a copy of the foregoing Notice of Opposition by depositing a copy of the same in the United States mail, addressed to counsel for the Applicant as follows:

Kimberly A. Chasteen, Esq.
Williams Mullen
721 Lakefront Commons, Suite 210
Newport News, VA 23606

Kenneth J. Gumbiner, Esq.
Tuggle, Duggins & Meschan
228 W. Market Street
Greensboro, NC 27401

This 4th day of October, 2004.


Shawn D. Mercer

JOHNSON, HEARN, VINEGAR, GEE & MERCER, PLLC
ATTORNEYS AT LAW

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TELEPHONE (919) 544-3302

JEAN WINBORNE BOYLES*
OF COUNSEL

*CERTIFIED MEDIATOR

October 4, 2004

TTAB

Director of the U.S. Patent & Trademark Office
Trademark Trial & Appeal Board
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Serial No. 78-313, 196

Dear Sir or Madam:

Enclosed please find for filing on behalf of the North Carolina Automobile Dealers Association, Incorporated a Notice of Opposition in the matter of trademark application Serial No. 78-313, 196 for the mark "We'll Buy your car even if you don't Buy Ours" published in the Official Gazette on August 10, 2004. A check in the sum of \$300.00 representing the filing fee is also enclosed.

Please do not hesitate to contact me should you have questions.

Sincerely,

JOHNSON, HEARN, VINEGAR,
GEE & MERCER, PLLC


Shawn D. Mercer

SDM/bb
Enclosures

cc: Kimberly A. Chasteen, Esq.
Kenneth J. Gumbiner, Esq.
North Carolina Automobile Dealers Association, Incorporated

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**TTAB NOTICE CONCERNING CORRESPONDENCE ADDRESS
(TRADEMARK RULE 2.18)**

The Trademark Trial and Appeal Board will mail correspondence to only one address for each party.

If a party is located in the U.S., correspondence will be sent to the party's own address, unless (1) papers filed with the Board are filed by a party's attorney, (2) a written power of attorney is filed, (3) a written authorization of some other person entitled to be recognized is filed, or (4) the party requests in writing that correspondence be sent to another address. In these situations, correspondence will be sent, respectively, to (1) the attorney filing papers, (2) the attorney named in the power of attorney, (3) the other person designated in the written authorization, or (4) the other address specified by the party.

When one attorney or other authorized representative makes an appearance on behalf of a party, his address is noted on the proceeding file as the correspondence address. If a second attorney or other authorized representative makes an appearance on behalf of the party, and requests that correspondence be directed to him, the correspondence address on the proceeding file will be changed, and future correspondence will be sent to the second attorney or other authorized representative, rather than to the first one. If the second attorney or other authorized representative does not request that correspondence be sent to him, the Board will continue to send correspondence to the first attorney or authorized representative.

If a power of attorney from a party to one attorney has been filed, and thereafter another attorney or authorized representative makes an appearance on behalf of the party and asks that correspondence be sent to him, the second attorney or authorized representative will be required to submit authorization, from the party or from the first attorney, for the requested change in correspondence address.

If a power of attorney from a party to one attorney has been filed, and thereafter a power of attorney from the party to another attorney is filed, the second power of attorney will be construed as a written request to change the correspondence address from the first attorney to the second one, even if there is no revocation of the first power, unless the party or the first attorney directs otherwise. Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney has been filed, and thereafter that attorney files an "associated power of attorney" to another attorney, the correspondence address will remain unchanged, and the Board will continue to send correspondence to the first attorney, unless the first attorney or the party directs otherwise.

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address. Thereafter, the correspondence address may be changed as described in Trademark Rule 2.18.

In the case of a party whose registration is the subject of a Board proceeding, any representative which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself unless and until another correspondence address is established in the manner described in Trademark Rule 2.18.