

# ShawPittman LLP

A Limited Liability Partnership Including Professional Corporations

NANCY S. LAPIDUS  
202-663-8851  
nancy.lapidus@shawpittman.com



February 14, 2005

The Honorable Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

Re: AutoZone Parts, Inc. v. PartsZone, LLC  
(Notice of Opposition Against Serial Nos. 78/248346 and 78/248318)  
Our File No. 18610.4246

Dear Madam:

Attached hereto is the following documents:

## NOTICE OF OPPOSITION (in duplicate)

The Director of the U.S. Trademark Office is authorized to charge the filing fee in the amount of SIX HUNDRED DOLLARS (\$600.00) to our Deposit Account No. 19-1565. We believe that this amount is accurate but if it is insufficient for this filing, please also charge any additional fee required to our Deposit Account No. 19-1565.

If there are any questions, please contact the undersigned.

Sincerely,

Handwritten signature of Nancy S. Lapidus in cursive.

Nancy S. Lapidus

NSL/Inf  
Attachment

Document #: 1461111 v.1



02-14-2005

U.S. Patent & TMOtc/TM Mail RcptDt. #64

TTAB

BOX TTAB - FEE  
Docket No. 18610.4246

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

In the Matter of Applications:

Serial No.: 78/248,346  
Filed: May 12, 2003  
Applicant: PartsZone, LLC  
Mark: PARTSZONE  
Class: 35  
Published in the *Official Gazette* of August 17, 2004

Serial No.: 78/248,318  
Filed: May 12, 2003  
Applicant: PartsZone, LLC  
Mark: PARTSZONE  
Class: 7  
Published in the *Official Gazette* of January 25, 2005

AUTOZONE PARTS, INC.	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. _____
	)	Serial Nos. 78/248,346 and 78/248,318
PARTSZONE, LLC	)	
	)	
Applicant	)	

NOTICE OF OPPOSITION

AutoZone Parts, Inc., a Nevada corporation (by change of name from Speedbar, Inc.), located and doing business at 123 South Front Street, Memphis, Tennessee 38103 (hereinafter "Opposer"), believes that it will be damaged by registration of the marks shown in Application Serial Nos. 78/248,346 and 78/248,318 and hereby opposes same.

The grounds for the opposition are as follows:

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(1) Application Serial Nos. 78/248,346 and 78/248,318 (hereinafter the "opposed applications") seek registration of the mark PARTSZONE for the following goods and services:

Online ordering services in the field of replacement parts and accessories for aerial work platforms, cranes, telehandlers, forklifts, asphalt and concrete paving equipment, compaction equipment, crawler loaders, dozer-crawler wheels, excavators, loader backhoes, skid steers, wheel loaders, and personnel and burden carriers, in Class 35; and

Replacement parts, excluding automobile parts and accessories, for aerial work platforms, cranes, telehandlers, asphalt and concrete paving equipment, compaction equipment, crawler loaders, dozer-crawler wheels, excavators, loader backhoes, skid steers, wheel loaders, fork-lift trucks and personnel and burden carriers, namely, gaskets for internal combustion engines, motors, spark plugs, ignition parts for internal combustion engines, namely, points, condenser points, spark plug wires and distributors, liquid propane gas parts, namely, LP tank, connecting lines and gauges, fuel systems comprising fuel tanks, fuel lines and fuel pumps, exhaust systems comprising manifolds for engines, muffler exhaust pipes and mufflers, steer axles, wheels being parts of machines, tires for vehicles other than land vehicles, brakes for machines, brakes for vehicles other than land vehicles, universal joints for machines, universal joints for vehicles other than land vehicles, transmission gears for machines, differentials for machines, hydraulic systems comprising manifolds, valves, coils, hydraulic pumps, hydraulics hoses and fittings, o-rings for machines, cooling systems comprising radiators, hoses and thermostats, air filters, hydraulics oil filters, motor oil filters, machine parts, namely, bearings and bushings, belts for machines, seats for vehicles other than land vehicles, mechanical seals, brushes for electrical contacts in motors, horns for vehicles other than land vehicles, hydraulic cylinders for vehicles other than land vehicles, electric generators, outriggers for vehicles other than land vehicles, electric pumps, regulators being parts of machines, suspension struts for vehicles other than land vehicles, and valves being parts of brushes for electrical contacts in motors, in Class 7.

(2) The opposed applications were filed on May 12, 2003, based on a claim of Applicant's bona fide intent to use the mark PARTSZONE in commerce.

(3) Long prior to the May 12, 2003 filing date of the opposed applications, Opposer's predecessors adopted, used and Opposer, through its related company AutoZone, Inc., is still using the trade name, trademark and service mark AUTOZONE in interstate

commerce for retail auto parts store services, automotive testing, repair, diagnostic and installation services, and a variety of automotive products and accessories.

(4) In accordance with § 5 of the Federal Trademark Act, all use of the trade name and mark AUTOZONE by Opposer's related company AutoZone, Inc., as alleged herein, inures to the benefit of Opposer.

(5) Opposer is the owner of the trade name, trademark and service mark AUTOZONE. Opposer and its predecessors and related company have continuously used said name and mark for retail auto parts store services, automotive testing, repair, diagnostic and installation services, and various automotive products, and in the advertising and sale thereof, in interstate commerce since long prior to the filing date of the opposed applications of the mark PARTSZONE.

(6) The retail auto parts stores operated by Opposer's related company AutoZone, Inc. under the trade name and service mark AUTOZONE offer for sale and sell numerous automotive related products. Opposer's predecessors and related company AutoZone, Inc also provide online ordering services in the field of automotive parts and accessories through the web site at [www.autozone.com](http://www.autozone.com), automobile repair and installation services, as well as information and advice related to those services.

(7) By virtue of the prior and continuous advertising and sales of retail automotive products and accessories, retail automotive parts store services and provision of automobile repair and installation services and the maintenance of high quality standards relating thereto, purchasers of such services and goods and others have come to recognize the mark AUTOZONE as a singular indication of origin, as a consequence of which Opposer has established valuable goodwill and exclusive rights in this mark.

(8) The mark AUTOZONE had become exceedingly well-known and a famous mark within the meaning of § 43(c) of the Federal Trademark Act long prior to the filing date of the opposed applications.

(9) Opposer, through its related company AutoZone, Inc., adopted, used and is using a family of ZONE marks including the marks AUTOZONE, AUTOZONE.COM, GET IN THE ZONE, KIDZONE, OILZONE, CHECKOUTZONE, BATTERYZONE, PARTSZONE and ZONE since well prior to the filing date of the opposed applications to register the mark PARTSZONE and has promoted these ZONE marks in a manner that creates public recognition and an association of common origin based on the ZONE portion of the marks.

(10) In accordance with § 5 of the Federal Trademark Act, all use of the marks AUTOZONE, AUTOZONE.COM, GET IN THE ZONE, KIDZONE, OILZONE, CHECKOUTZONE, BATTERYZONE, PARTSZONE and ZONE by Opposer's related company AutoZone, Inc., as alleged herein, inures to the benefit of Opposer.

(11) Opposer changed its corporate name from Speedbar, Inc. to AutoZone Parts, Inc. on February 10, 2004 and filed a copy of the Certificate of Amendment to its Articles of Incorporation for recordation in the Assignment Branch of the U.S. Patent and Trademark Office on June 16, 2004. That change of name was recorded at Reel 2996 and Frame 0255.

(12) Opposer's predecessor duly registered AUTOZONE as a service mark for retail auto parts store services in the United States Patent and Trademark Office under Registration No. 1,550,569 which issued August 1, 1989. Opposer is the record owner of Registration No. 1,550,569 by virtue of an Assignment recorded in the Assignment Branch on July 7, 1998 at Reel 1758, Frame 0786.

(13) Opposer's predecessor duly registered AUTOZONE & Design as a service mark for retail auto parts store services in the United States Patent and Trademark Office

under Registration No. 1,501,718 which issued August 23, 1988. Opposer is the record owner of Registration No. 1,501,718 by virtue of an Assignment recorded in the Assignment Branch on July 7, 1998 at Reel 1758, Frame 0786.

(14) Opposer's predecessor duly registered AUTOZONE & Design as a trademark for automotive batteries in the United States Patent and Trademark Office under Registration No. 1,496,638 which issued July 19, 1988. Opposer is the record owner of Registration No. 1,496,638 by virtue of an Assignment recorded in the Assignment Branch on July 7, 1998 at Reel 1758, Frame 0786.

(15) Opposer's predecessor duly registered AUTOZONE & Design as a trademark for cleaning preparations for hands and automobiles and vehicle engine parts, namely, thermostats in the United States Patent and Trademark Office under Registration No. 1,700,101 which issued July 14, 1992. Opposer is the record owner of Registration No. 1,700,101 by virtue of an Assignment recorded in the Assignment Branch on July 7, 1998 at Reel 1758, Frame 0786.

(16) Opposer's predecessor duly registered AUTOZONE & Design as a trademark for windshield washing fluid in the United States Patent and Trademark Office under Registration No. 2,225,191 which issued February 23, 1999. Opposer is the record owner of Registration No. 2,225,191 by virtue of an Assignment recorded in the Assignment Branch on July 7, 1998 at Reel 1758, Frame 0786.

(17) Opposer duly registered AUTOZONE & Design as a service mark for retail automobile parts and accessories store services in the United States Patent and Trademark Office under Registration No. 2,397,635 which issued October 24, 2000.

(18) Opposer duly registered AUTOZONE as a service mark for automotive repair services, namely, testing, repair, diagnosis and installation of automotive parts and

accessories in the United States Patent and Trademark Office under Registration No. 2,721,079 which issued June 3, 2003.

(19) Opposer duly registered GET IN THE ZONE as a service mark for retail auto parts store services in the United States Patent and Trademark Office under Registration No. 2,527,429 which issued January 8, 2002.

(20) Opposer's predecessor duly registered AUTOZONE.COM as a service mark for on-line electronic services, namely, on-line ordering services in the field of automotive parts and accessories, and providing information regarding automotive repair and maintenance via a global computer network in the United States Patent and Trademark Office under Registration No. 2,449,353 which issued May 8, 2001. Opposer is the record owner of Registration No. 2,449,353 by virtue of an Assignment recorded in the Assignment Branch on July 7, 1998 at Reel 1758, Frame 0786.

(21) Opposer duly registered KIDZONE as a service mark for retail auto parts store services in the United States Patent and Trademark Office under Registration No. 2,746,897 which issued August 5, 2003.

(22) Opposer duly registered ZONE as a service mark for retail automotive store services in the United States Patent and Trademark Office under Registration 2,525,758 which issued January 1, 2002.

(23) Opposer duly registered BATTERYZONE as a service mark for retail auto parts store services in the United States Patent and Trademark Office under Registration No. 2,855,757 which issued June 22, 2004.

(24) Opposer duly registered PARTSZONE as a service mark for retail auto parts store services in the United States Patent and Trademark Office under Registration No. 2,855,758 which issued June 22, 2004. The date of first use claimed in Registration No.

2,855,758 of the mark PARTSZONE is March, 2002, which is prior to the filing date of the opposed applications of the mark PARTSZONE.

(25) Opposer duly registered CHECKOUTZONE as a service mark for retail auto parts store services in the United States Patent and Trademark Office under Registration No. 2,855,756 which issued June 22, 2004.

(26) Opposer, through its related company AutoZone, Inc., has used OILZONE as a service mark for retail auto parts store services in interstate commerce since March 2002 and has filed Application Serial No. 76/528,878 to register said mark.

(27) Registration Nos. 1,550,569, 1,501,718, 1,496,638, 1,700,101, 2,225,191, 2,397,635, 2,721,079, 2,527,429, 2,449,353, 2,746,897, 2,525,758, 2,855,758, 2,855,757 and 2,855,756 are *prima facie* evidence of the validity thereof and Opposer's ownership and exclusive right to use the marks AUTOZONE, AUTOZONE & Design, GET IN THE ZONE, AUTOZONE.COM, KIDZONE, ZONE, BATTERYZONE, PARTSZONE, and CHECKOUTZONE in commerce, and are constructive notice of Opposer's ownership thereof, all as provided by §§ 7(b) and 22 of the Federal Trademark Act of 1946, as amended. The right to use the mark AUTOZONE having become incontestable, Registration Nos. 1,550,569, 1,501,718, 1,496,638, and 1,700,101 are conclusive evidence of Opposer's exclusive right to use the marks shown therein in commerce as provided by §§ 15 and 33(b) of the Federal Trademark Act.

(28) The services and goods described in Opposer's Registration Nos. 1,550,569, 1,501,718, 1,496,638, 1,700,101, 2,225,191, 2,397,635, 2,721,079, 2,527,429, 2,449,353, 2,746,897, 2,525,758, 2,855,758, 2,855,757 and 2,855,756 and in Opposer's Application Serial No. 76/528,881 and otherwise sold or rendered in AUTOZONE stores and/or via Opposer's website, [www.autozone.com](http://www.autozone.com), and the goods and services described in the

opposed applications are commercially related, and are likely sold and/or rendered to the same or overlapping classes of purchasers. Therefore, purchasers, prospective purchasers and others are likely to be confused, mistaken or deceived into the belief, contrary to fact, that Applicant's goods and services rendered under the mark PARTSZONE emanate from and/or are in some way sponsored or approved by Opposer and/or that Applicant is somehow affiliated with Opposer, thereby damaging Opposer.

(29) The use of the mark PARTSZONE in connection with the goods and services described in the opposed applications dilutes and/or is likely to dilute the distinctive qualities of the famous mark AUTOZONE within the meaning of § 43(c) of the Federal Trademark Act.

(30) Applicant is not lawfully entitled to the registrations which it seeks for the reason, *inter alia*, that Applicant's mark PARTSZONE so resembles Opposer's previously used and/or registered marks AUTOZONE, AUTOZONE & Design, AUTOZONE.COM, PARTSZONE, GET IN THE ZONE, KIDZONE, ZONE, OILZONE, CHECKOUTZONE, and/or BATTERYZONE and is identical to Opposer's previously used and registered mark PARTSZONE as to be likely to cause confusion, to cause mistake or to deceive within the meaning of § 2(d) of The Federal Trademark Act, thereby damaging Opposer.

(31) Applicant is not lawfully entitled to the registrations which it seeks for the reason, *inter alia*, that Applicant's mark PARTSZONE, as used in connection with goods and services described in the opposed applications, so resembles AUTOZONE and each other member of Opposer's previously used family of ZONE marks as to be likely to cause confusion, to cause mistake or to deceive within the meaning of § 2(d) of The Federal Trademark Act, thereby damaging Opposer.

(32) Applicant is not lawfully entitled to the registrations which it seeks for the reason, *inter alia*, that the use of Applicant's mark PARTSZONE in connection with the goods and services described in the opposed applications dilutes or is likely to dilute the distinctiveness of Opposer's famous mark AUTOZONE within the meaning of § 43(c) of the Federal Trademark Act.

WHEREFORE, Opposer believes that the present opposition should be sustained and the registration of Applicant's marks refused.

The requisite filing fee for the Notice of Opposition is submitted herewith.

AUTOZONE PARTS, INC.

Dated: February 14, 2005

By: Alan Cooper /ms  
Alan S. Cooper  
Nancy S. Lapidus  
Attorneys for Opposer  
Shaw Pittman, LLP  
2300 N Street, N.W.  
Washington, D.C. 20037-1128  
(202) 663-8000