

ESTTA Tracking number: **ESTTA43078**

Filing date: **08/24/2005**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	TomTom B. V
Granted to Date of previous extension	08/24/2005
Address	Rembrandtplein 35 Amsterdam, 1017 CT NETHERLANDS

Attorney information	Jess M. Collen, Brendan J. Reilly COLLEN IP The Holyoke-Manhattan Bldg.80 South Highland Ave. Ossining, NY 10562 UNITED STATES breilly@collenIP.com Phone:914-941-5668
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Applicant Information

Application No	76125536	Publication date	04/26/2005
Opposition Filing Date	08/24/2005	Opposition Period Ends	08/24/2005
Applicant	TOMTOM LICENSING GMBH NEULERCHENFELDERSTRASSE 12 1160 VIENNA,		

Goods/Services Affected by Opposition**Class 009.**

All goods and services in the class are opposed, namely: audio and video tape recorders; radio and telephone transmitters; CD, digital audio tape, and phonograph record players; automatic vending machines; cash registers; calculators; data processors and computers; fire extinguishers, eyeglasses and sunglasses; eyeglass frames and lenses; computer game software recorded on discs, diskettes and tapes; interactive virtual reality game software recorded on discs, diskettes and tapes; educational software for instruction in the fields of interpersonal skills, languages, and mathematics recorded on discs, diskettes and tapes; digital dictionary and translation software recorded on discs, diskettes and tapes; computer e-commerce software to allow users to perform electronic business transactions via a global computer network recorded on discs, diskettes and tapes; computer software for communicating with users of hand-held computers recorded on discs, diskettes and tapes; software featuring travel and route planning information recorded on discs, diskettes and tapes; hand-held personal computers and personal digital assistant computers; mobile telephones; global positioning system (GPS) consisting of computers, computer software, transmitters, receivers, and network interface devices

Class 014.

All goods and services in the class are opposed, namely: Precious metals and their alloys sold in bulk; goods made from or coated with precious metals and precious metal alloys, namely, jewelry and jewelry boxes; precious and semi-precious stones; chronographs and chronometers, namely, watches and clocks

Class 021.

All goods and services in the class are opposed, namely: household and kitchen containers not of precious metal; household and kitchen containers not of precious metal, namely, mugs; household utensils, namely, pots, pans, scrapers, spatulas, rolling pins, turners, whisks, and baking sheets; hair combs; sponges for household and cosmetic purposes; brushes, namely, blacking, clothes, cleaning, cosmetic, eyebrow, hair, and shaving brushes; brush-making materials; articles for cleaning purposes, namely, cleaning cloths and pads and steel wool; glass, namely, enameled, pressed, speckled and decorative stained glass; beverage ware and bowls including cut glass beverage ware and bowls; porcelain and earthenware dishes

Class 024.

All goods and services in the class are opposed, namely: Textiles and textile goods, namely, bed sheets, bed mattress covers and bed blankets, pillow cases, table cloths, napkins, towels, bath mats, curtains and fabrics for making curtains

Class 028.

All goods and services in the class are opposed, namely: Games, namely, action-type target, action skill, board, card, manipulative, parlor and pinball type games and

instruction sheets therefor sold together as a unit, hand held units for playing electronic and video games; toy figures, toy mobiles, toy gliders, bath tub toys, party favors in the nature of small toys, plush toys, stuffed toys, wind-up toys, mechanical toys and electric action toys; gymnastic apparatus, sports balls; Christmas tree ornaments and decorations

Class 030.

All goods and services in the class are opposed, namely: sugar; rice; tapioca; flour and cereal-based products, namely, breakfast cereal, snack-foods, and other processed cereals; candy; honey, treacle; yeast and baking powder; vinegar; salt

Attachments	95095.notice of opp_20050824113049.pdf (13 pages)
Signature	/s/Brendan J. Reilly
Name	Brendan J. Reilly
Date	08/24/2005

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

-----)	
TOMTOM B.V.,)	
)	Serial No. 76/125,536
Opposer,)	Opp. No. _____
)	
v.)	
)	
TOMTOM LICENSING GMBH LLC,)	
)	
Applicant.)	
-----)	

NOTICE OF OPPOSITION

The Opposer, TomTom B.V., (“Opposer”) hereby opposes the above-captioned application and submits this Notice of Opposition against the registration of U.S. Trademark Application No. 76/125,536 (the “Application”) in all classes pursuant to 37 C.F.R. §2.102 and 15 U.S.C. § 1063.

As the basis for this Opposition, Opposer hereby alleges the following:

1. Opposer is a corporation duly organized under the laws of the Netherlands, with a principal place of business at Rembrandtplein 35, 1017 CT Amsterdam, The Netherlands.
2. Applicant, Tomtom Licensing GMBH LLC, (“Applicant”) is a Limited Liability Company organized under the laws of Austria with a principal place of business at Neulerchenfelderstrasse 12, 1160 Vienna, Austria.

3. Opposer is the manufacturer of a variety of goods, including high quality GPS systems, navigation tools and related goods. Opposer sells these wares in the United States and various countries around the world, including the United Kingdom, France, and Spain, among others.

4. In association with this business, Opposer has adopted and applied the trademark TOMTOM. Opposer owns several international trademark registrations for the TOMTOM mark for its goods. Opposer is also the owner of U.S. Trademark Application No. 76/231,460 for the mark TOMTOM, filed March 28, 2003 (the "Opposer's Application").

5. Opposer's mark is used in commerce, including by popular retailers of electronic goods as Best Buy, Circuit City, and CompUSA. An excerpt showing Opposer's goods as advertised in the United States under the trademark TOMTOM is attached hereto as Exhibit A. Opposer's mark is also extensively used on the Internet. Opposer is owner of the domain name www.tomtom.com.

6. Opposer has used its TOMTOM mark in commerce extensively and has acquired a considerable and valuable goodwill and widescale recognition for its mark. The public has come to associate the TOMTOM mark with Opposer and Opposer's GPS systems, navigation tools, and related goods.

7. As a result of such use, Opposer has developed a valuable right in the mark TOMTOM.

8. Applicant's mark is confusingly similar to Opposer's trademark and is likely, when applied to the goods of the Applicant, to cause confusion, or to cause mistake or to deceive between Opposer's goods and at least certain of those goods recited in class 9 of the

Application . 15 USC § 1052(e). Applicant's mark makes a highly similar commercial impression to Opposer's mark due to its identical sound and appearance. Applicant has completely appropriated Opposer's entire mark, without change. The overall commercial impression of Applicant's mark, when applied to the same or similar goods, would cause confusion or be likely to cause confusion, mistake, or deception.

9. Upon information and belief, use by the Applicant on at least certain of its goods identified in its application for registration in international class 09 will likely cause confusion, mistake and deception with respect to those goods, by virtue of the Opposer's prior use of its TOMTOM mark.

10. Upon information and belief, both the Applicant's mark and Opposer's mark are applied to highly related goods and are likely to be sold to the same or similar channels of distribution. Applicant's TOMTOM mark so resembles Opposer's well-known trademark, as used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistake or to deceive.

11. Further, and in the alternative, the Application lists scores of various goods in a wide range of international classes, specifically international class 09, 24, 30, 38, and 39. The goods listed in the subject Application run the gamut, from telecommunications systems to tapioca.

12. In support of its Application, Applicant filed a specimen of use of the TOMTOM mark on April 27, 2004, being the only specimen of use submitted by the Applicant in support of the Application.

13. The specimen does not demonstrate use of all of the goods listed in the Application.

14. Upon information and belief, Applicant's declaration alleging use was not executed by an individual with requisite knowledge of the Applicant's use or bona fide intention to use, or who lacked the requisite knowledge as to whether all of the goods listed in the Application are in use in commerce in the United States, or that the Applicant possesses the requisite statutory bona fide intent to use to mark in on such goods in commerce.

15. Upon information and belief, Applicant does not use or have a bona fide intention to use in commerce all of the goods listed in the Application, as filed or as amended.

16. Upon information and belief, the Applicant's amendment dated August 18, 2005 acts to confirm that Applicant did not use, or have a bona fide intent to use all of the goods listed in published Application.

17. Opposer will be harmed by Applicant's registration of the TOMTOM mark, pursuant to an application which issued pursuant to a defective or insufficient declaration.

18. Further, and in the alternative, the goods added to the Application by a proposed amendment dated April 27, 2004, and an examiner's amendment dated June 4, 2004 impermissibly expanded the scope of the Application contrary to trademark office practice and in violation of 37 C.F.R. § 2.71(a), TMEP §§ 1402.06 and 1402.07 et seq., including, but not limited to, addition of goods such as GPS systems, navigational tools and related goods, which exceed the scope of the originally-filed identification of goods.

19. Upon information and belief, Applicant was aware of the Opposer's Application (which was pending) and Opposer's TOMTOM mark when it submitted the April 27, 2004 amendment to its Application.

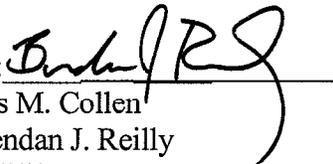
20. Upon information and belief, the Applicant's amendment was expressly intended to block Opposer, (or others), from securing trademark rights to the TOMTOM mark in the United States, despite an absence of use or bona fide intent to use on at least some of the goods alleged in the amendment, to wit, those goods which identically tracked the goods recited in the Opposer's Application. .

21. Upon information and belief, Applicant's actions were undertaken in bad faith, as evidenced, among other things, from the language of the amendment itself, which lists, verbatim, the precise goods listed in Opposer's pending Application. Upon information and belief, as a result of Applicant's impermissibly overbroad amendment the Applicant's mark has been cited as a potential obstacle to registration of the Opposer's Application, leading to suspension thereof.

22. The facts alleged above, and, upon information and belief, Applicant's actions, would substantially harm the Opposer, by permitting registration in favor of Applicant for a mark which the Opposer used on its goods from an earlier date and further, will harm Opposer by blocking its right to registration in the United States Patent and Trademark Office, based on goods for which Opposer has been the first user, and on goods which the Applicant has amended to its application in violation of trademark office rules and practice, which prohibit expanding the identification of goods beyond the scope of the originally filed application..

WHEREFORE for the foregoing reasons, Opposer prays that this application, Serial No. 76/125,536, be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of Opposer.

Respectfully submitted for
Opposer, TomTom B.V.

By: 
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Brendan J. Reilly
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Our Ref.: 94255
Encs.: Opposition fee \$300.00 per class (\$1500.00)
Exhibit A (Opposer's use of the TOMTOM mark in commerce)
Duplicate copies

DATED: August 24, 2005

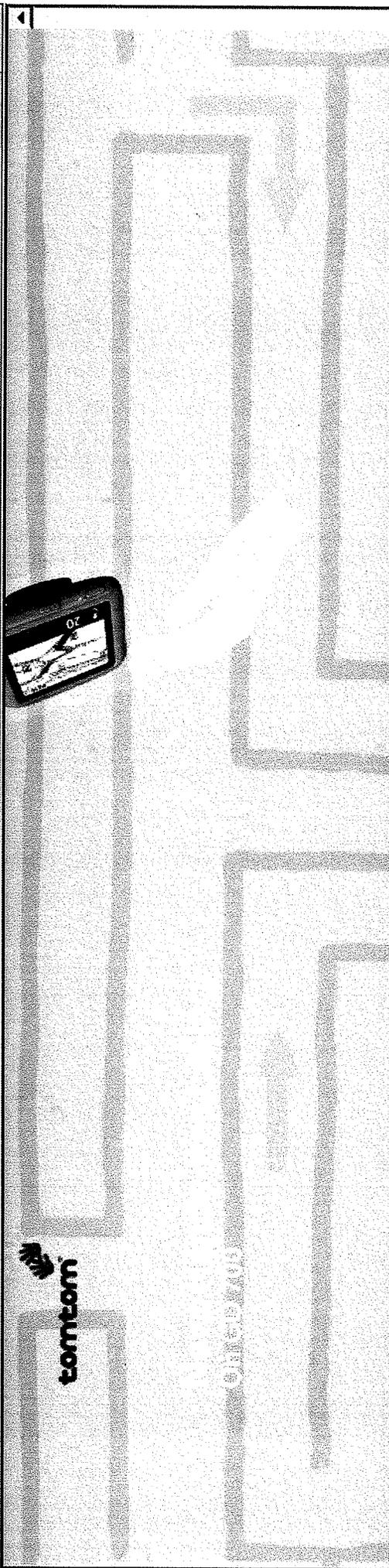
SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FILED ELECTRONICALLY WITH UNITED STATES PATENT AND TRADEMARK OFFICE TRADEMARK TRIAL AND APPEAL BOARD.

COLLEN IP

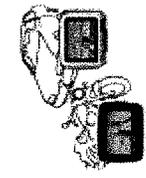
By: 
Date: August 24, 2005

EXHIBIT A



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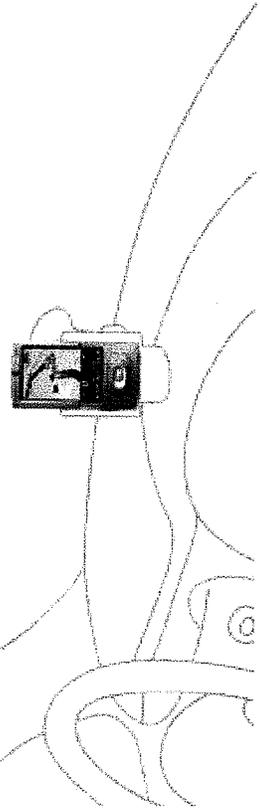
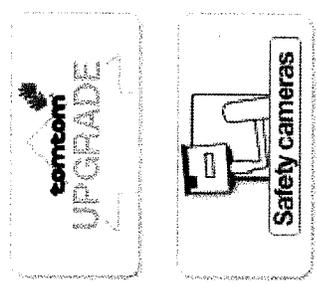
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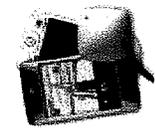


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