

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

-----)	)	
TOMTOM B.V.,	)	
Opposer,	)	Serial No. 76/125,536
	)	Opp. No. 91-166,346
v.	)	
	)	
TOMTOM LICENSING GMBH LLC,	)	
Applicant.	)	
-----)	)	

**AMENDED NOTICE OF OPPOSITION**

Now comes the Opposer, TomTom B.V., (“Opposer”) by and through its undersigned attorneys, and hereby submit this Amended Notice of Opposition against the registration of U.S. Trademark Application No. 76/125,536 (the “Application”) 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.



09-29-2005

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 for registration of 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. 78/231,460 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, such as Best Buy, Circuit City, and CompUSA, which sell Opposer's goods bearing the TOMTOM mark in the United States. 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](http://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 acquired a common law trademark for 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 09 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 the Application for registration in 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 international classes 09, 24, 30, 38, and 39. The goods listed in the Application run the gamut, from telecommunications systems to tapioca.

12. In support of the 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 personal knowledge of 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 the mark on such goods in commerce.

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

16. Upon information and belief, 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 the published Application.

17. Opposer will be harmed by Applicant's registration of the TOMTOM mark by 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-file identification of goods.

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

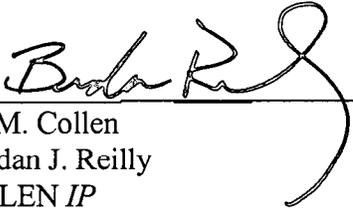
20. Upon information and belief, Applicant's amendment was expressly intended to block Opposer (or others) from securing trademark rights to the TOMTOM mark in the United States, despite an absence of use or bona fide intent to use on at least some of the goods alleged in the amendment, to wit, those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

21. Upon information and belief, Applicant's actions were undertaken in bad faith, as evidenced by, among other things, the language of the amendment itself, which lists, verbatim, the precise goods listed in Opposer's 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 the 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:   
\_\_\_\_\_

Jess M. Collen

Brendan J. Reilly

COLLEN *IP*

The Holyoke-Manhattan Building

80 South Highland Ave

Ossining, NY 10562

(914) 941-5668

(914) 941-6091

Dated: September 27, 2005

**EXHIBIT A**



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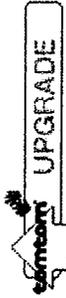


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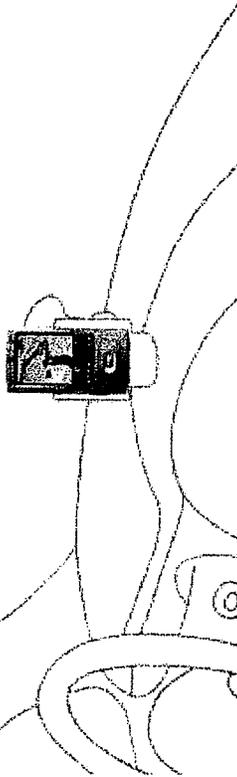
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TOMTOM LICENSING GMBH LLC,	)	
Applicant.	)	
-----)	)	

**NOTICE OF FILING AMENDED NOTICE OF OPPOSITION**

Now comes the Opposer, TomTom B.V., (“Opposer”) by and through its undersigned attorneys, and hereby submit this Notice of Filing an Amended Notice of Opposition against the registration of U.S. Trademark Application No. 76/125,536 (the “’536 Application”) pursuant to 37 C.F.R. §2.102, 37 C.F.R. § 2.107(a), 15 U.S.C. § 1063, and Federal Rule of Civil Procedure 15(a).

1. On August 24, 2005, Opposer filed a Notice of Opposition with the United States Patent and Trademark Office Trademark Trial and Appeal Board. (Opposition No. 91-166,346.)

2. In paragraph 4 of the Notice of Opposition, Opposer alleged that it was the owner of a U.S. Trademark Application for the mark TOMTOM. Opposer is the owner of U. S. Trademark Application No. 78/231,460. Due to a typographical error, however, Opposer cited U.S. Trademark Application No. 76/231,460 (emphasis added).

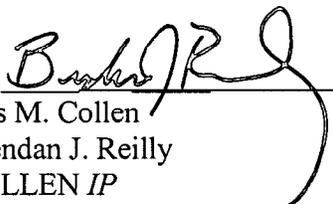
3. Opposer hereby encloses and files the Amended Notice of Opposition, which correctly lists U.S. Application No. 78/231,460 in paragraph 4.

4. Pursuant to 37 C.F.R. § 2.107(a), pleadings in an opposition proceeding “may be amended in the same manner and to the same extent as in a civil action in a United States district court.”

5. Federal Rule of Civil Procedure 15(a), the applicable rule regarding amendments to pleadings in civil actions in United States district courts, provides in pertinent part: “a party may amend the party’s pleading once as a matter of course at any time before a responsive pleading is served.”

6. Applicant has not filed an answer or other responsive pleading to the Notice of Opposition. Accordingly, Opposer may file the enclosed Amended Notice of Opposition as a matter of course.

Respectfully submitted for  
Opposer, TomTom B.V.

By: 

Jess M. Collen

Brendan J. Reilly

COLLEN IP

The Holyoke-Manhattan Building

80 South Highland Ave

Ossining, NY 10562

(914) 941-5668

(914) 941-6091

Our Ref.: 95095  
Enc. Amended Notice of Opposition  
Dated: September 27, 2005

**CERTIFICATE OF MAILING**

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 DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR TRADEMARKS, P.O. BOX 1451, ALEXANDRIA, VIRGINIA 22313.

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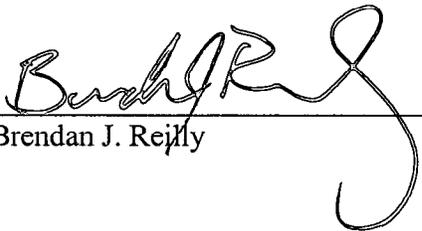
By: 

Date: September 27, 2005

**CERTIFICATE OF SERVICE**

I, Brendan J. Reilly, hereby certify that I caused a true and correct copy of Opposer's Notice of Filing Amended Notice of Opposition and the Amended Notice of Opposition upon opposing counsel via First Class Mail on September 27, 2005 at the following address:

John Clarke Holman  
Jacobson Holman PLLC  
400 Seventh Street, N.W.  
Washington, D, 20004.

  
Brendan J. Reilly