

ESTTA Tracking number: **ESTTA51547**

Filing date: **11/02/2005**

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	Ashland Licensing and Intellectual Prope
Granted to Date of previous extension	11/02/2005
Address	5200 Blazer Parkway Dublin, OH 43017 UNITED STATES
Party who filed Extension of time to oppose	Ashland Inc.
Relationship to party who filed Extension of time to oppose	Ashland Inc. reorganized its corporate structure and established an intellectual property holding company for all of Ashland's patents and trademarks. On June 29, 2005 Ashland Inc. assigned all intellectual property (patents and trademarks)to Ashland Licensing and Intellectual Property LLC, thus the difference in the name. If you require more information, I will be glad to provide.

Correspondence information	Ashland Inc. 3499 Blazer Parkway Lexington, KY 40509 UNITED STATES pafredrick@ashland.com Phone:859-357-7405
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Applicant Information

Application No	78401852	Publication date	07/05/2005
Opposition Filing Date	11/02/2005	Opposition Period Ends	11/02/2005
Applicant	Valero Refining and Marketing Company Commercial Law Dept., 5th Floor One Valero Place San Antonio, TX 782491112 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 20000815 First Use In Commerce: 20000815
All goods and services in the class are opposed, namely: Retail gasoline station services

Attachments	E001.PDF (2 pages) E002.PDF (3 pages)
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Signature	/J. Michael Pepper/
Name	Ashland Inc.
Date	11/02/2005

NOTICE OF OPPOSITION

Pursuant to Section 1063 of Title 15, United States Code, and Section 2.104, Title 37, Code of Federal Regulations, ASHLAND LICENSING AND INTELLECTUAL PROPERTY LLC, a Delaware limited liability company, ("Opposer"), believes it would be damaged by the registration of the mark of Valero Energy Corporation ("Applicant"), shown in Serial No. 78-401,852 in International Class 35 for retail gasoline station services, and Opposer hereby opposes same.

As grounds of opposition, it is alleged that:

1. Valero Energy Corporation ("Applicant"), is, on information and belief, a United States Company located at One Valero Way, San Antonio, Texas 78269-1112.

2. Applicant has filed an application, Serial No. 78-401,852, and seeks to register the "V" DESIGN mark consisting of a block "V" Design with a curved line through the "V" for the following class:

International Class 35 for retail gasoline station services as evidenced by publication of said mark in the Official Gazette on page TM 1186 of the July 5, 2005 issue.

3. Ashland Licensing and Intellectual Property LLC, ("Opposer"), is a Delaware limited liability company located at 5200 Blazer Parkway, Dublin, Ohio 43017.

4. Opposer has used and developed substantial good will in the design block "V"; as illustrated by the two attached registrations owned by Opposer before Applicant's use of the formative block "V" design.

5. Opposer has used and is using the block "V" design mark alone or in combination with the word "VALVOLINE" (including foreign translations of the word VALVOLINE), in thousands of service stations throughout the United States and in more than 100 countries worldwide and has enjoyed tens of millions in sales.

6. Opposer has used the block "V" trademark design for goods and services in the field of automotive applications, products, supplies, and related services, including but not limited to: oils and lubricants and additives therefore, fuels and fuel additives, antifreeze and other radiator chemicals and additives, automotive refrigerants, brake fluids, power steering fluids, sealers, and conditioners, deicers, starting fluids, tire sealants, rust or corrosion inhibitors, cleaning preparations, automotive mechanical components (including oil, air and fuel filters), clothing, sporting goods and other automotive accessories and advertising merchandise (including key tags, key holders, key rings, knives, money clips, hand tools, grease guns, fluid lubricant pumps, sunglasses, safety items, car covers, clocks and watches, travel bags, umbrellas, beverage containers, and printed publications), and other goods relating to automotive racing, advertisements and promotions

In addition to using the block "V" on the various goods listed above, the block "V" is prominently displayed at our Valvoline Instant Oil Change and Express Care service stations which perform vehicle preventative maintenance services, namely, lubricating chassis, changing motor oil, changing oil and air filters, refilling transmission, differential, brake, power steering, battery reservoirs to proper fluid levels, changing windshield wiper blades and inflating tires to proper air pressure.

7. Opposer believes it would be damaged by the registration of the mark Serial No. 78-401,852, within the meaning of Section 1063 of Title 15, United States Code in at least the following ways:

A) The use and registration by Applicant of the formative block "V" design with a line through it for goods sold in the classification of retail gasoline station services in light of Opposer's **prior use** of the block "V" design mark is likely to cause confusion in the minds of relevant consumers as to the source of Applicant's or Opposer's goods and services, and as to the origin of the goods and would cause mistake, or to deceive, within the meaning of Section 1052(d) of Title 15, United States Code.

B) The respective goods of Applicant and goods and goods of Opposer are related.

C) Applicant and Opposer market their respective goods under their respective marks in the same channels of trade.

D) The respective goods of Applicant and Opposer provided under their respective marks are marketed to the same customers.

E) The respective goods of Applicant and Opposer sold under their respective marks are advertised through many of the same mediums of advertising.

F) The respective goods of Applicant and Opposer sold under their respective marks are advertised in advertisements directed to many of the same customers.

G) Applicant had constructive and/or actual knowledge of Opposer's use of the mark

H) Applicant's use of the block "V" design may disparage or falsely suggest a connection with Opposer, in violation of Section 1052 (a) of Title 15, United States Code.

8. Applicant's block "V" design mark is similar in sight and meaning to Opposer's prior block "V" design mark and Applicant's mark is used to identify goods similar or related to goods provided by Opposer for retail gasoline station services, so Applicant's formative block "V" mark resembles Opposer's mark and likely to be confused therewith and/or mistaken therefor.

9. Applicant's mark is deceptively similar to Opposer's prior mark so as to cause confusion and lead to deception as to the origin of Applicant's goods and services.

10. Because of Opposer's prior use of its block "V" mark, Applicant's mark is unregistrable within the meaning of Section 1052 (d) of Title 15, United States Code.

11. If Applicant is permitted to register its mark for its goods, as specified in the application herein opposed, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between Applicant's mark and Opposer's marks. Persons familiar with Opposer's prior and prevalent use would be likely to use Applicant's goods believing they were using Opposer's goods. Such confusion in the trade inevitably would result in loss of sales to Opposer, further damaging Opposer. Furthermore, any defect, objection or fault found with Applicant's goods or services marketed under its word mark in combination with the formative block "V" design would likely reflect upon and injure the reputation and goodwill which Opposer has established for its services rendered under its prior marks.

12. If Applicant is granted the registration herein opposed, it would thereby obtain at least a **prima facie** exclusive right to the use of its mark. Such registration would be contrary to Opposer's prior use of the marks, establishing further damage and injury to Opposer.

WHEREFORE, Opposer prays that this opposition petition be sustained and that registration of Applicant's mark in application Serial No. 78-401,852 be refused registration.



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List At: OR to record: **Record 10 out of 10**

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)



Word Mark V
Goods and Services IC 002 001. US 006. G & S: ORGANIC RUST AND CORROSION INHIBITORS, AND RADIATOR ANTIFREEZE. FIRST USE: 19630410. FIRST USE IN COMMERCE: 19630410
 IC 004 001. US 015. G & S: MOTOR AND INDUSTRIAL LUBRICATING OILS, AUTOMOTIVE AND INDUSTRIAL GREASES, TRANSMISSION FLUIDS, AND LIQUID AND GASEOUS FUELS. FIRST USE: 19630410. FIRST USE IN COMMERCE: 19630410
Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number 72267482
Filing Date March 24, 1967
Current Filing Basis 1A
Original Filing Basis 1A
Registration Number 0867342
Registration Date April 1, 1969
Owner (REGISTRANT) ASHLAND OIL & REFINING COMPANY CORPORATION KENTUCKY 1409 WINCHESTER AVE. ASHLAND KENTUCKY 41101

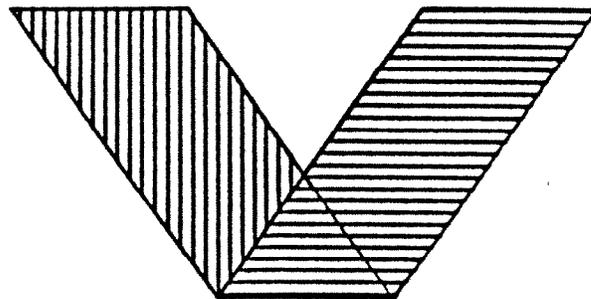
Int. Cls.: 1, 4, 6, 7, 8, 9, 14, 16, 18, 20, 21, 24, 25,
28 and 30

Prior U.S. Cls.: 1, 2, 3, 5, 6, 8, 9, 10, 12, 13, 14, 15,
17, 19, 21, 22, 23, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34,
35, 36, 37, 38, 39, 40, 41, 42, 44, 46 and 50

Reg. No. 1,955,557

United States Patent and Trademark Office Registered Feb. 13, 1996

**TRADEMARK
PRINCIPAL REGISTER**



ASHLAND OIL, INC. (KENTUCKY CORPORATION)
1000 ASHLAND DRIVE
RUSSELL, KY 41169

FOR: CHEMICAL GASOLINE, MACHINE AND MOTOR OIL ADDITIVES; AUTOMOBILE COOLING SYSTEM RUST INHIBITORS; ANTI-FREEZE; COOLANTS FOR VEHICLE ENGINES; BRAKE FLUID; POWER STEERING FLUID; WINDSHIELD DEICER FLUID; CHEMICAL ADDITIVES FOR DETECTING LEAKS IN AUTOMOTIVE AIR CONDITIONING SYSTEMS, IN CLASS 1 (U.S. CLS. 1, 5, 6, 10, 26 AND 46).

FIRST USE 1-1-1978; IN COMMERCE 1-1-1978.

FOR: FUEL, INDUSTRIAL AND MOTOR OILS AND GREASES; KEROSENE; GASOLINE AND DIESEL STARTING FLUID FOR INTERNAL COMBUSTION ENGINES, TRANSMISSION FLUID, IN CLASS 4 (U.S. CLS. 1, 6 AND 15).

FIRST USE 1-1-1978; IN COMMERCE 1-1-1978.

FOR: METAL KEY CHAINS, FOBS AND RINGS; METAL MONEY CLIPS, IN CLASS 6 (U.S. CLS. 2, 12, 13, 14, 23, 25 AND 50).

FIRST USE 1-1-1978; IN COMMERCE 1-1-1978.

FOR: OIL AIR AND FUEL FILTERS FOR ENGINES, MOTORS OR MACHINES; FUEL, OIL AND WATER PUMPS FOR MOTORS AND ENGINES, IN CLASS 7 (U.S. CLS. 13, 19, 21, 23, 31, 34 AND 35).

FIRST USE 1-1-1978; IN COMMERCE 1-1-1978.

FOR: POCKET AND SPORT KNIVES; HAND TOOLS, NAMELY COLLAPSIBLE RATCHET/SOCKET SCREWDRIVERS; MANUALLY OPERATED MINI GREASE GUNS AND GREASE GUN REFILLERS, IN CLASS 8 (U.S. CLS. 23, 28 AND 44).

FIRST USE 1-1-1978; IN COMMERCE 1-1-1978.

FOR: CALCULATORS, SUNGLASSES; GRADUATED RULERS; AUTOMOTIVE EMERGENCY/SAFETY KITS COMPRISED OF A FIRST AID KIT, DISTRESS FLAG, SPOT LIGHT, FLARES AND JUMPER CABLES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 1-1-1978; IN COMMERCE 1-1-1978.

nt. Cl.: 37

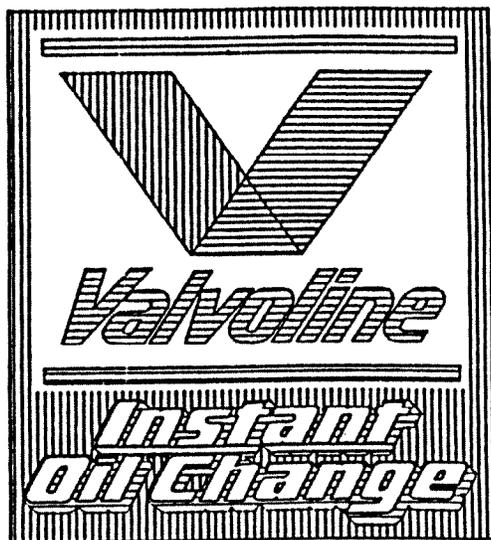
U.S. Cl.: 103

Reg. No. 2,118,621

United States Patent and Trademark Office

Registered Dec. 9, 1997

SERVICE MARK
PRINCIPAL REGISTER



ASHLAND OIL, INC. (KENTUCKY CORPORATION)
100 ASHLAND DRIVE
RUSSELL, KY 41169

FOR: AUTOMOBILE LUBRICATION SERVICES, IN CLASS 37 (U.S. CL. 103).

FIRST USE 10-16-1987; IN COMMERCE 10-16-1987.

OWNER OF U.S. REG. NOS. 1,480,007, 1,531,277, AND 1,687,316.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "OIL CHANGE", APART FROM THE MARK AS SHOWN.

THE DRAWING IS LINED FOR RED AND BLUE AND THE COLORS ARE CLAIMED AS A FEATURE OF THE MARK.

SER. NO. 74-477,479, FILED 1-7-1994.

J. TINGLEY, EXAMINING ATTORNEY