

ESTTA Tracking number: **ESTTA77596**

Filing date: **04/24/2006**

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	ExxonMobil Oil Corporation
Granted to Date of previous extension	04/23/2006
Address	5959 Las Colinas Boulevard Irving, TX 75039 UNITED STATES

Attorney information	William G. Barber Fulbright & Jaworski LLP 600 Congress Ave., Suite 2400 Austin, TX 78701 UNITED STATES bbarber@fulbright.com, eolson@fulbright.com, mhernandez@fulbright.com, aotrademark@fulbright.com, trademarks@exxonmobil.com Phone:512.474.5201
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Applicant Information

Application No	78536222	Publication date	10/25/2005
Opposition Filing Date	04/24/2006	Opposition Period Ends	04/23/2006
Applicant	Hilton Hospitality, Inc. 9336 Civic Center Drive Beverly Hills, CA 90210 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: hotel and motel services, namely providing carry out meals for hotel guests; restaurant services

Related Proceedings	The parties are involved in Opposition No. 91170401 involving a similar mark.
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Attachments	NOO_023.pdf (5 pages)(140193 bytes)
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Signature	/William G. Barber/
Name	William G. Barber
Date	04/24/2006

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

In Re Serial No. 78/536,222	§	
filed December 21, 2004	§	
Mark: ON THE RUN BREAKFAST BAGS	§	
	§	
Published in the Official Gazette	§	Opposition No. _____
at TM 1885 on October 25, 2005	§	
	§	
EXXONMOBIL OIL CORPORATION,	§	
	§	
Opposer,	§	
v.	§	
	§	
HILTON HOSPITALITY, INC.,	§	
	§	
Applicant.	§	

NOTICE OF OPPOSITION

ExxonMobil Oil Corporation (“Opposer”), a New York corporation having a principal place of business at 5959 Las Colinas Boulevard, Irving, Texas, 75039-2298, believes that it will be damaged by registration of the mark identified above, and hereby opposes same under the provisions of 15 U.S.C. § 1063.

As grounds for opposition, Opposer asserts that:

1. Since at least as early as July 1994, Opposer, itself or through a related company and licensee, has continuously used the mark ON THE RUN (and related marks) in commerce in connection with the sale and promotion of convenience store services, including the provision of ready-to-eat and prepared foods and beverages.
2. Opposer owns the following U.S. Registrations for its ON THE RUN marks.

Mark	Reg. No.	Reg. Date	Goods and Services
ON THE RUN	2,110,223	11/4/97	Retail convenience store services
ON THE RUN & Design	2,627,037	10/1/02	Retail convenience store services
ON THE RUN	2,653,014	11/26/02	Plastic cups
MOBIL ON THE RUN	2,757,752	9/2/03	Retail convenience store services
ON THE RUN CAFÉ	2,869,888	8/3/04	Convenience store services
ON THE RUN & Design	2,893,415	10/12/04	Retail convenience store services
ON THE RUN	3,011,473	11/1/05	Retail convenience store services

Each of these registrations is valid and subsisting. These marks are collectively referred to as the “ON THE RUN Marks.”

3. Opposer’s ON THE RUN convenience store chain, now numbering over 1,000 stores, has been highly successful and well received. For example, it was named the “2003 Convenience Store Chain of the Year” by Convenience Store Decisions Magazine.

4. Opposer’s ON THE RUN Marks are inherently distinctive and have acquired distinctiveness through Opposer’s long use and promotion of the marks. Through Opposer’s use and promotion of its ON THE RUN Marks and the goods and services sold under those marks, the purchasing public has come to know, rely upon, and recognize the goods and services of Opposer by these marks. Opposer has established great and valuable goodwill in its ON THE RUN Marks, and its ON THE RUN Marks have become famous.

5. Applicant filed Application Serial No. 78/536,222 for the mark ON THE RUN BREAKFAST BAGS (“Applicant’s Mark”) on December 21, 2004 in International Class 43, for “hotel and motel services, namely providing carry out meals for hotel guests; restaurant services.” This application was published for opposition on October 25, 2005. Opposer has been granted extensions of time through April 23, 2006 within which to file a Notice of Opposition.

6. Opposer has priority, based on its use and registration of its ON THE RUN Marks long prior to Applicant’s application date. Applicant filed the Application on an intent-to-use basis, and did not claim a date of first use. Opposer used and registered its ON THE RUN Marks, and those marks became famous, long before Applicant filed its application.

7. Opposer is not connected in any way with the Applicant or Applicant’s use of Applicant’s Mark.

8. Opposer has not given Applicant permission or approval to use or register Applicant’s Mark.

9. The services covered by Applicant’s application are similar or related to Opposer’s goods and services provided under its ON THE RUN Marks.

10. Opposer’s distinctive ON THE RUN Marks are of sufficient fame and reputation among consumers such that when Applicant uses Applicant’s Mark for the services identified in the opposed application, a connection with Opposer would be presumed by consumers.

11. On information and belief, Applicant will offer its services under Applicant’s Mark to a variety of consumers, many of whom are likely to be familiar with, or actual purchasers of, Opposer’s goods and services offered under its ON THE RUN Marks.

12. Because Applicant's Mark is likely, when used on or in connection with the services of Applicant, to cause confusion, or to cause mistake, or to deceive, registration should be refused under 15 U.S.C. § 1052(d).

13. Applicant's Mark, when used in connection with the services specified in the application herein opposed, would cause dilution of Opposer's famous ON THE RUN Marks, and registration should be refused under 15 U.S.C. § 1125(c).

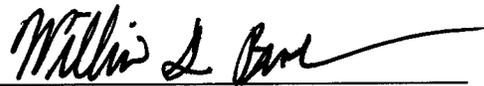
14. Registration of Applicant's Mark on the Principal Register would be inconsistent with Opposer's rights under the aforementioned registrations, and its common-law rights, and would be damaging to Opposer.

WHEREFORE, Opposer prays that Application Serial No. 78/536,222 be rejected, and that registration of the mark therein be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Fulbright & Jaworski L.L.P., Account No. 50-1212/ EXMO:023/10512423/WGB, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,

Date: 4/24/06

A handwritten signature in black ink, appearing to read "William G. Barber", written over a horizontal line.

William G. Barber
Martin G. Hernandez
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ATTORNEYS FOR OPPOSER