

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

-- APPLICATION SERIAL No. 78/829,187 --

TTAB

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VALENTINO ROSSI,

Opposer :

vs. :

1C JOINT STOCK VENTURE,

Applicant. :

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NOTICE OF OPPOSITION

Asst. Commissioner for Trademarks
P.O. Box 1451
Alexandra, VA 22313-1451
Attn: BOX TTAB

SIR :

VALENTINO ROSSI, a citizen of Italy residing at Flat 4, Down Street 23, London, United Kingdom ("Opposer"), believes that he will be damaged by registration of the trademark shown in **U.S. Application Serial No. 78/829,187**, published for opposition in the Official Gazette on August 22, 2006, and hereby opposes registration of the same.

3259-31L



02-12-2007

As grounds for the opposition, it is respectfully alleged that:

1. Opposer VALENTINO ROSSI is a world famous Italian professional motorcycle racer and multiple MotoGP world champion. Forbes magazine has listed Opposer at the 63rd position in its list of the world's best known personalities. At the very beginning of his motorcycle racing career in the early 1990's, Opposer adopted the number "46" as his racing number - the same number that had been worn by Opposer's father, Graziano Rossi, who had also been a Grand Prix motorcycle road racer - and Opposer has continued to use that racing number "46" throughout his long and successful career. To participants in and fans and enthusiasts of motorcycle racing and motorcycling, the number "46" has through its long and exclusive use by Opposer as Opposer's racing number and his widespread fame come to be identified with Mr. Rossi and his personality and activities. Indeed, among those even casually interested in motorcycles and motorcycle riding and racing, the number "46" has come to evoke an immediate association with Opposer, and has thus acquired a secondary meaning with Mr. Rossi and with goods and services offered by and through Opposer. Opposer has registered the number "46" as a trademark in, *inter alia*, the European Community, is seeking registration of the number "46" as a trademark in additional countries, and Opposer's authorized goods bearing the number "46" as a trademark are and have long been available in the European Community and elsewhere, including the United States.

2. Opposer is the owner of pending U.S. Trademark Application No. 78/883,763, filed May 15, 2006, which seeks registration of the stylized mark "46" ("Opposer's Mark") in connection with goods and services in International Classes 009, 012, 014, 016, 018, 025 and 038, based on Opposer's *bona fide* intention to use the said mark in commerce. Among the goods recited in International Class 009 are "computer software, namely, ... computer games".

3. On information and belief Applicant **1C JOINT STOCK VENTURE** filed, on or about March 3, 2006, an application to register the numeral "46" ("Applicant's Mark") as a trademark for "computer software game programs", based on Applicant's purported *bona fide* intention to use said mark in commerce. Said application bears Serial No. 78/829,187 and was published for opposition in the Official Gazette on August 22, 2006.

4. Upon information and belief, Applicant cannot rely on a date of actual or constructive first use of Applicant's mark earlier than the March 3, 2006 filing date of its application, a date long subsequent to the time that Opposer has been identified by the public as the exclusive source or origin of goods and services associated with, *inter alia*, motorcycle racing.

5. Applicant's use of Applicant's Mark, as applied to computer software game programs related to motorcycle racing, is likely to be confused with Opposer's mark "46" and with Opposer and to engender misrepresentation to the public that Applicant's said goods originate or are associated with or are authorized by Opposer.

6. In an Office Action issued from the U.S. Patent and Trademark Office on or about October 24, 2006, Applicant's said application was cited by the Examining Attorney as a potential bar to the registration of Opposer's Mark.

7. Opposer's undersigned attorney, on behalf of Opposer, has sought a signed stipulation from Applicant that Applicant will not use Applicant's Mark in connection with computer software game programs relating to motorcycle racing. Notwithstanding Opposer's request, Applicant has not to date provided Opposer with the signed stipulation that it has sought.

8. Opposer believes that it will be damaged by the registration of Applicant's mark.

WHEREFORE, it is respectfully prayed that the opposition be granted and that U.S. Application Serial No. 78/829,187, seeking registration of Applicant's Mark, be refused.

The statutory fee of \$300.00 for this Notice of Opposition, and a duplicate copy of this Notice of Opposition, are enclosed. Any additional fees or charges required at this time in connection with this Notice of Opposition may be charged to our Patent and Trademark Office Deposit Account No. 03-2412.

Opposer, VALENTINO ROSSI, hereby appoints the following attorneys and/or agents at *Cohen, Pontani, Lieberman & Pavane*, with full power of substitution and revocation, to prosecute this Opposition and to transact all business in the Patent and Trademark Office connected therewith:

Customer Number 27799.

Kindly direct all telephone calls in respect of this Notice of Opposition to Lance J. Lieberman at telephone No. 212-687-2770.

All correspondence in connection with this Notice of Opposition and the Opposition proceeding should be addressed to:

Lance J. Lieberman, Esq.
Cohen, Pontani, Lieberman & Pavane
551 Fifth Avenue - Suite 1210
New York, New York 10176-0091

LANCE J. LIEBERMAN declares that he is an attorney for Opposer VALENTINO ROSSI and is authorized to execute this Notice of Opposition and Declaration on its behalf; that he has read the foregoing Notice of Opposition and knows the contents thereof; that the facts and allegations set forth therein are, to the best of his knowledge, true and correct except as to matters stated therein to be upon information and belief and that as to those matters he believes them to be true; and, further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine, or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the Opposition.

VALENTINO ROSSI



Dated: February 13, 2007

By

Lance J. Lieberman
Attorney for Opposer
USPTO Reg. No. 28,437

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