

ESTTA Tracking number: **ESTTA154828**

Filing date: **08/03/2007**

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 | Getty Petroleum Marketing Inc. |
| Granted to Date of previous extension | 08/05/2007 |
| Address | 1500 Hempstead Turnpike East Meadow, NY 11554 UNITED STATES |
| Attorney information | David C. Lee Akin Gump Strauss Hauer & Feld LLP 1333 New Hampshire Ave., N.W. Washington, DC 20036 UNITED STATES dlee@akingump.com Phone:202.887.4000 |

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 76666502 | Publication date | 02/06/2007 |
| Opposition Filing Date | 08/03/2007 | Opposition Period Ends | 08/05/2007 |
| Applicant | Lucas Oil Products, Inc. 302 North Sheridan Street Corona, CA 92880 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 037. All goods and services in the class are opposed, namely: VEHICLE LUBRICATION AND OIL CHANGE SERVICES |
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Grounds for Opposition

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| The mark is primarily merely a surname | Trademark Act section 2(e)(4) |
| Other | If, as alleged by Applicant in its complaint, there is likelihood of confusion between the parties# marks at issue, the mark of the Opposed Application and the services covered thereunder conflicts with Opposer#s LUKOIL Marks. |

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| Related Proceedings | 911757791 |
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|-------------|---|
| Attachments | Opposition.pdf (4 pages)(202081 bytes) |
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|-----------|----------------|
| Signature | /David C. Lee/ |
| Name | David C. Lee |
| Date | 08/03/2007 |

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

| | | |
|---------------------------------|---|----------------------|
| GETTY PETROLEUM MARKETING INC., | : | |
| | : | |
| Opposer, | : | |
| | : | |
| v. | : | Opposition No. _____ |
| | : | |
| LUCAS OIL PRODUCTS, INC., | : | |
| | : | |
| Applicant. | : | |

NOTICE OF OPPOSITION

In the matter of Application Serial No. 76/666,502, in Class 37, for the mark LUCAS OIL, filed September 25, 2006, and published for opposition in the *Official Gazette* of February 6, 2007 (“Opposed Application”):

Opposer, Getty Petroleum Marketing Inc., a Maryland corporation, having an address at 1500 Hempstead Turnpike, East Meadow, New York 10036-6524 (“Opposer”), believes that it will be damaged if registration for the above mark is issued, and hereby opposes registration of said mark.*

The grounds for the present opposition are as follows:

1. OAO Lukoil, a Russian Federation open joint stock company (Opposer’s affiliate and licensor), is one of the world’s leading integrated oil and gas producers and distributors. OAO Lukoil, through numerous subsidiaries, related companies, and/or affiliates including Opposer, produces, refines, and/or sells oil and oil products, and sells such products and operates gas stations under the LUKOIL mark and name around the world.

* Opposer has been granted an extension of time to file a Notice of Opposition against Application Serial No. 76/666,502 until August 5, 2007.

2. OAO Lukoil owns federal applications for LUKOIL and LUKOIL and Design marks in the United States for a wide range of automobile oil and fluids and services related thereto, namely: LUKOIL, Application Serial No. 75/475,106 filed on April 27, 1998; LUKOIL and Design, Application Serial No. 75/475,100 filed on April 27, 1998; LUKOIL, Application Serial No. 76/388,904 filed on March 29, 2002; and LUKOIL and Design, Application Serial No. 76/388,903 filed on March 29, 2002 (“LUKOIL Marks”).

3. Opposer is the exclusive licensee under the LUKOIL Marks in the United States. Under the terms of its license agreement with OAO Lukoil, Opposer holds the exclusive right to use the LUKOIL and LUKOIL and Design marks in the United States in connection with, among other goods and services, gas stations, motor oils and additives.

4. Opposer directly or through its sublicensees, operates gas stations and provides related goods and services under the LUKOIL mark and name in the United States. Opposer operates over 2,000 facilities in the U.S., which generate over two billion gallons of gasoline sales annually through its service bay and convenience store operations.

5. Opposer has promoted and continues to promote the LUKOIL Marks and the goods and services provided thereunder in the United States through extensive advertising and other promotional efforts in connection with the LUKOIL gas stations and oil products. Opposer has spent over tens of millions of dollars in capital expenditures for the LUKOIL rebranding program, and additional tens of millions of dollars in supporting, promoting and advertising the LUKOIL motor fuel brand for sale to the motoring public at retail service stations in the United States.

6. As a result of the continuous and substantially exclusive and extensive use of the LUKOIL mark and name in United States commerce for gas station services and related

consumer products/services sold through such gas stations, and the quality and success of the services and products provided thereunder, the LUKOIL Marks have come to be well-known by the relevant trade and public as an indicator of products and services originating with, sponsored by or otherwise associated with Opposer, exclusively.

7. Applicant, Lucas Oil Products Inc. (“Applicant”), seeks to register the mark LUCAS OIL for the following services: “vehicle lubrication and oil change services” (“Applicant’s Services”).

8. Applicant bases its application to register the LUCAS OIL mark on an alleged intent to use the mark in commerce under Section 1(b) of the Trademark Act.

9. On June 16, 2006, Applicant filed a complaint (“Complaint”) in the United States District Court for the Southern District of New York against, *inter alia*, Opposer, alleging trademark infringement, unfair competition, and dilution under federal and state laws pertaining to the LUKOIL marks. In particular, Applicant has alleged that the marks LUKOIL and LUKOIL and Design, among others, are confusingly similar to LUCAS, LUCAS OIL, and HI-PERFORMANCE LUCAS OIL PRODUCTS INC. and Design.

10. If, as alleged by Applicant in its Complaint, there is likelihood of confusion between the parties’ marks at issue, the mark of the Opposed Application and the services covered thereunder conflicts with Opposer’s LUKOIL Marks.

11. In addition, LUCAS OIL is a primarily merely a surname mark, which is not inherently distinctive. According to the application information available through the on-line records of the United States Patent and Trademark Office, Applicant has not established secondary meaning in said marks in the Opposed Application. Accordingly, the surname mark opposed herein is not entitled to registration on the Principal Register, under Section 2(e)(4).

12. If Applicant were to be granted a registration for the LUCAS OIL mark, it would obtain thereby at least a *prima facie* exclusive, unrestricted right to use the mark for Applicant's Services. Such registration would be a source of damage and injury to Opposer by providing Applicant with a basis to seek to (i) interfere with Opposer's sublicensees and claim superior rights over Opposer's use of the LUKOIL Marks, (ii) prevent further rebranding under the LUKOIL Marks, and (iii) restrict Opposer's rights under its trademark license in and to the LUKOIL marks.

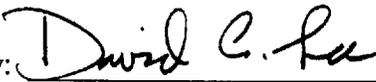
WHEREFORE, Opposer prays that this opposition be sustained and the registration of the mark of Application No. 76/666,502, be refused.

The Trademark Office is hereby authorized to charge the required fee in connection with this submission to Attorney Deposit Account No. 50-2310.

Respectfully submitted,

AKIN GUMP STRAUSS HAUER & FELD LLP

Date: August 3, 2007

By: 
Elaine M. Laflamme
David C. Lee
1333 New Hampshire Ave., N.W.
Washington, DC 20036-1564
Tel.: 202.887.4000
Fax: 202.887.4282
Email: dlee@akingump.com

ATTORNEYS FOR OPPOSER