

ESTTA Tracking number: **ESTTA185054**

Filing date: **01/07/2008**

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	Audi A.G.
Granted to Date of previous extension	01/06/2008
Address	Ingolstadt 85045 Ingolstadt, 85045 GERMANY

Correspondence information	Susan B. Flohr Attorney Blank Rome, LLP 600 New Hampshire Ave, N.W. Washington, DC 22036 UNITED STATES flohr@blankrome.com, perry@blankrome.com, stefanski@blankrome.com
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Applicant Information

Application No	77008372	Publication date	07/10/2007
Opposition Filing Date	01/07/2008	Opposition Period Ends	01/06/2008
Applicant	DIGIANA CO., LTD. No. 401 KG Building, 324-4 Yangjae 2-dong Seocho-gu, Seoul, KOREA, REPUBLIC OF		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Portable communications apparatus, namely, radio pagers, radio transmitters, audio and video receivers, audio and video transmitters, MP3 players, compact disc players, computer file transmitter

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2912419	Application Date	10/30/2003
Registration Date	12/21/2004	Foreign Priority Date	NONE

Word Mark	AUDI
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1994/12/31 First Use In Commerce: 1994/12/31 automobile sound system, namely CD changer

U.S. Registration No.	1079063	Application Date	09/08/1975
Registration Date	12/06/1977	Foreign Priority Date	NONE
Word Mark	AUDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1969/11/01 First Use In Commerce: 1969/11/00 REPAIRING AUTOMOBILES Class 042. First use: First Use: 1969/11/01 First Use In Commerce: 1969/11/00 RETAIL SALES OUTLET SERVICES FOR AUTOMOTIVE PARTS		

U.S. Registration No.	1416584	Application Date	09/17/1985
Registration Date	11/11/1986	Foreign Priority Date	NONE
Word Mark	AUDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00 [PENCILS,] PENS, [PEN AND PENCIL HOLDERS, CARD AND PAD HOLDERS AND PAPER FOLDERS] Class 018. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00 BILLFOLDS, WALLETS, AND KEY FOBS Class 021. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00 MUGS, DRINKING GLASSES [AND VASES] Class 025. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00 [SWEATERS,] JACKETS, HATS, [SKIRTS, TIES, BELTS AND BELT BUCKLES] Class 034. First use: First Use: 1982/09/00 First Use In Commerce: 1982/09/00 CIGARETTE LIGHTERS		

U.S. Registration No.	2987328	Application Date	01/13/2004
Registration Date	08/23/2005	Foreign Priority Date	NONE
Word Mark	AUDI		
Design Mark			
Description of Mark	The mark consists of The mark consists of four interlocking rings.		

Goods/Services	<p>Class 006. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 Metal key rings</p> <p>Class 009. First use: First Use: 2000/12/31 First Use In Commerce: 2000/12/31 Automobile tire pressure gauges</p> <p>Class 012. First use: First Use: 2000/12/31 First Use In Commerce: 2000/12/31 Automotive windshield sun shades; automobile covers</p> <p>Class 016. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 Pens</p> <p>Class 018. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 Canvas tote bags; golf shoe bags for travel</p> <p>Class 020. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 Picture frames</p> <p>Class 021. First use: First Use: 2000/12/31 First Use In Commerce: 2000/12/31 Automotive maintenance products namely synthetic drying cloths, plastic water bottles sold empty; portable canvas cooler bags</p> <p>Class 024. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 Golf towels</p> <p>Class 025. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 Apparel namely, knit shirts, golf shirts, polo shirts, jackets</p> <p>Class 028. First use: First Use: 1997/12/31 First Use In Commerce: 1997/12/31 Golf balls</p>
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Attachments	<p>76555604#TMSN.gif (1 page)(bytes)</p> <p>78351424#TMSN.jpeg (1 page)(bytes)</p> <p>AUDI Notice of Opposition.pdf (9 pages)(75946 bytes)</p>
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Susan B. Flohr/
Name	Susan B. Flohr
Date	01/07/2008

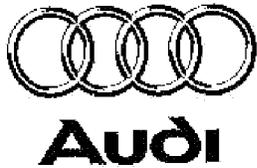
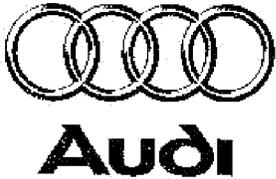
3. Audi has used its distinctive and famous mark AUDI on or in connection with a variety of automotive parts including automobile wheels, valve stem caps and fabric tire covers since on or about 1970.

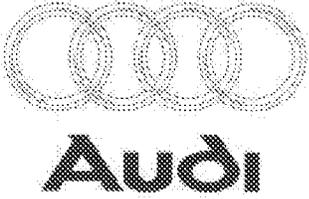
4. Audi has used its distinctive and famous mark AUDI on or in connection with non-automobile related goods such as pens, wallets, mugs, and clothing since on or about 1982.

5. Since at least as early as 1994, Audi has used its famous and distinctive mark AUDI on or in connection with automobile sound systems, namely CD changers.

6. Audi is the exclusive owner of all rights, title and interest in and to the mark AUDI and is the owner of various U.S. registrations for the same, including without limitation:

Mark	Reg. No.	Reg. Date	Class(es)	Goods/Services
AUDI	708,352	12/13/1960	6, 11 & 12	automobiles, including motor cars for personal use and trucks, and structural parts thereof, including automobile heaters and ventilators, locks and closures for automobile coolers, and automobile safety locks
AUDI	1,079,063	12/6/1977	37 & 42	37: repairing automobiles 42: retail sales outlet services for automotive parts
AUDI	1,416,584	11/11/1986	16, 18, 21 & 25	16: [pencils,] pens, [pen and pencil holders, card and pad holders and paper folders]. 18: billfolds, wallets, and key fobs 21: mugs, drinking glasses [and vases]. 25: [sweaters,] jackets, hats, [skirts, ties, belts and belt buckles].
AUDI	1,793,869	9/21/1993	36	automotive financing services; namely, loan services for the lease and/or purchase of automobiles
AUDI	1,928,291	10/17/1995	36	consumer credit card services

Mark	Reg. No.	Reg. Date	Class(es)	Goods/Services
AUDI	2,912,419	12/21/2004	9	automobile sound system, namely cd changer
AUDI (Stylized) 	1,416,583	11/11/1986	16, 18 & 25	16: [pencils,] pens, [pen and pencil holders, card and pad holders and paper folders]. 18: billfolds, wallets and key fobs 25: [sweaters,] jackets, hats, [skirts, ties, belts and belt buckles]
AUDI and Design 	2,073,484	6/24/1997	37	repair and maintenance of vehicles
AUDI and Design 	2,083,439	7/29/1997	12 & 42	12: automobiles and structural parts therefore 42: automobile dealership services, namely, retail sales of automobiles and structural parts therefore`

Mark	Reg. No.	Reg. Date	Class(es)	Goods/Services
<p>AUDI and Design</p> 	2,987,328	8/23/2005	6, 9, 12, 16, 18, 20, 21, 24, 25, & 28	<p>6: metal key rings</p> <p>9: automobile tire pressure gauges</p> <p>12: automotive windshield sun shades; automobile covers</p> <p>16: pens</p> <p>18: canvas tote bags; golf shoe bags for travel</p> <p>20: picture frames</p> <p>21: automotive maintenance products namely synthetic drying cloths, plastic water bottles sold empty; portable canvas cooler bags</p> <p>24: golf towels</p> <p>25: apparel namely, knit shirts, golf shirts, polo shirts, jackets</p> <p>28: golf balls</p>
AUDI BANK USA	2,949,441	5/10/2005	36	banking services

Mark	Reg. No.	Reg. Date	Class(es)	Goods/Services
AUDI DESIGN Audi design	3,154,244	10/10/2006	14, 18, & 25	14: precious metals and their alloys, namely gold, silver, platinum; precious metal goods or goods coated with precious metals, namely, brooches, buttons, collar pins, tie pins, stick pins, jewelry, precious stones; horological and chronometric instruments 18: unworked and semi-worked leather and imitations of leather, leather goods, namely, jackets, pants, skirts, dresses, bags and briefcases, pouches, wallets, boxes of leather, shopping bags, keyholders, straps, collars, valises, travelling bags, rucksacks, handbags, umbrellas, tool bags, athletic bags, tote bags, beach bags, backpacks, cosmetic cases, change purses, handbags, luggage, waist packs, pocketbooks, purses, school bags, pencil cases, belts, gloves, manicure cases; animal skins and hides; luggage trunks and travelling bags; umbrellas, parasols and walking sticks; whips, animal harnesses and saddlery 25: clothing, namely, t-shirts, pullovers, jackets, blousons, vests, scarves, ties, underwear, hats, caps, headbands, shoes, boots and sandals; outerclothing, namely, coats, jackets, vests, hats, caps, scarves, gloves and blousons
AUDI FINANCIAL SERVICES and Design 	2,303,986	12/28/1999	36	automotive financing services, namely credit consulting and loan services for retail purchase and/or lease of automobiles
AUDI RSQ	3,042,002	1/10/2006	12 & 28	12: automobiles 28: games and playthings, namely, toy cars, scale model cars

Mark	Reg. No.	Reg. Date	Class(es)	Goods/Services
<p>AUDI SPORT and Design</p> 	3,029,413	12/13/2005	9, 12, 14, 16, 18, 25, 28, & 37	<p>9: optical instruments, namely, sunglasses</p> <p>12: automobiles</p> <p>14: jewelry; precious metals and their alloys and goods of precious metals or coated therewith, namely, money clips, tie-pins, key rings, key holders, belt buckles; watches</p> <p>16: books and magazines featuring topics relating to automobiles; stationery</p> <p>18: leather bags, leather purses, leather handbags, leather key chains, purses, wallets, brief cases, billfolds, leather key cases; suitcases, trunks and traveling bags; umbrellas</p> <p>25: clothing, namely, shirts, t-shirts, knit shirts, shawls, pants, ties, dresses, pants, sweaters, jackets, skirts, belts; footwear; headgear, namely, hats, caps, baseball caps</p> <p>28: games and playthings, namely, toy cars, scale model cars</p> <p>37: repair and maintenance of motor vehicles</p>

(collectively, hereinafter, “the AUDI Mark”).

7. Audi’s famous and distinctive AUDI Mark has been extensively used, advertised and promoted throughout the United States since as early as the aforementioned dates on or in connection with automobiles, automotive related products, and other goods.

8. As a result of such long term and widespread use and promotion of the AUDI Mark, the AUDI Mark has developed valuable goodwill and substantial recognition by the relevant public as an indication or origin of the goods so identified by the AUDI Mark, acquired secondary meaning and become famous, all prior to the filing date of the application hereto opposed.

9. Audi has priority based on its issued registrations for its AUDI Mark, some of which have become incontestable, and by virtue of having adopted and used its AUDI Mark for many years prior to the Applicant's filing of its application.

10. The mark, AUDIAX (Stylized), is confusingly similar to Audi's registered AUDI Mark, in appearance, meaning and sound, among other factors.

11. The AUDIAX (Stylized) mark is likely to cause confusion, mistake or to deceive relevant prospective purchasers because of the public association already attached to the AUDI Mark, due to similarities in appearances of the marks and in the goods sold in connection with the marks.

12. Applicant's AUDIAX (Stylized) mark is essentially identical to and thus likely to cause confusion with the aforementioned previously registered mark.

13. The mark proposed for registration by Applicant is ostensibly intended to be used on or in connection with portable communications apparatus, such as compact disc players.

14. Automobiles are routinely sold with installed sound systems including compact disc players. Audi automobiles commonly come equipped with sound systems bearing the AUDI Mark. Consequently, Applicant's use and registration of the mark herein opposed, AUDIAX (Stylized), would be likely to cause source confusion to such consumers.

15. Such concurrent use and registration of Audi's and Applicant's marks is therefore likely to cause confusion, mistake or to deceive the public, causing them to believe that Applicant's goods emanate from or are somehow endorsed, sponsored, licensed by or are in some other way associated with Audi. This would result in deception of the public as to the source or origin of Applicant's goods identified by its mark. The application herein opposed should therefore be refused under Section 2(d) of the Lanham Act.

16. Audi's famous and incontestable AUDI Mark for automobiles and related goods is so famous that use of Applicant's mark on Class 009 goods will erode the distinctiveness of Audi's AUDI Mark, which will dilute or be likely to dilute Audi's distinctive AUDI Mark, by blurring, tarnishment, or both.

17. The fame and high degree of recognition afforded to the AUDI Mark is evident in the significant duration, extent and geographic reach of advertising and publicity bearing the AUDI Mark; widespread and extraordinary sales of the goods bearing the AUDI Mark; widespread recognition of the AUDI Mark among the general consuming public; and the registrations of the AUDI Mark accorded on the Principal Register.

18. That Applicant's mark is likely to cause dilution by blurring is evident in the high degree of similarity or identicalness between Applicant's mark and the AUDI Mark; the high degree of inherent and acquired distinctiveness of the AUDI Mark; the substantially exclusive use of the AUDI Mark on Class 009 goods; the extraordinary degree of recognition accorded to the AUDI Mark by the general consuming public; the apparent intent of Applicant to create an association with the AUDI Mark; and any actual association between Applicant's mark and the AUDI Mark that would be established during discovery.

19. If the Application is granted, Applicant would thereby obtain, at least, a *prima facie* exclusive right to the use of the mark applied for, thus casting a cloud over Audi's rights in the AUDI Mark, and would be a source of damage and injury to Audi.

20. Any defects, objections or faults found with the services sold and rendered by Applicant under Applicant's mark, because of the false association with Audi, would inflict upon and seriously injure the reputation of Audi.

WHEREFORE, Audi prays that application Serial No. 77/008,372 for the goods herein specified in International Class 009 be denied and refused.

The filing fee for this Notice of Opposition has been charged to Deposit Account No. 02-2555. The Commissioner is hereby authorized to charge any additional fees or credit any overpayment of fees in connection with this communication to such Deposit Account.

Respectfully submitted,

BLANK ROME LLP

Date: January 7, 2008

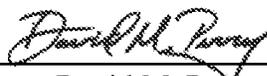
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Attorneys for Opposer
Audi A.G.

CERTIFICATE OF SERVICE

I, David M. Perry, do hereby certify that I have on this 7th day of January, 2008, mailed by U.S. First Class mail, the foregoing **NOTICE OF OPPOSITION** to the following:

Daniel F. Zendel, Esquire
Ladas & Parry LLP
26 W 61st St.
New York, NY 10023-7604



David M. Perry