

ESTTA Tracking number: **ESTTA228795**

Filing date: **08/06/2008**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Zhaoyuan Leo Rubber Co. Ltd.
Granted to Date of previous extension	08/06/2008
Address	No. 170 Jincheng Road Zhaoyuan City, Shandong, CHINA
Party who filed Extension of time to oppose	Zhaoyuan Leao Rubber Co. Ltd.
Relationship to party who filed Extension of time to oppose	Opposer's attorney has deleted the "a" from the word "Leo" in the Opposer's name to correct a typographical error.

Name	Shandong Linglong Rubber Co., Ltd.
Granted to Date of previous extension	08/06/2008
Address	170 Jincheng Road Zhaoyuan City, Shandong, CHINA

Attorney information	Marie Anne Mastrovito Abelman Frayne & Schwab 666 Third Avenue New York, NY 10017 UNITED STATES mamastrovito@lawabel.com Phone:212 949 9022
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Applicant Information

Application No	77308830	Publication date	04/08/2008
Opposition Filing Date	08/06/2008	Opposition Period Ends	08/06/2008
Applicant	Omni United (S) Pte Ltd 5 Shenton Way, #28-03 UIC Building Singapore, SINGAPORE		

Goods/Services Affected by Opposition

Class 012. First Use: 2005/10/30 First Use In Commerce: 2005/10/30 All goods and services in the class are opposed, namely: Truck and bus radial tires, light truck radial

tires, passenger car radial tires, off the road radial tires
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant is not the rightful owner of the mark and application should be denied registration under Section 1 of the Trademark Act.

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	LEAO and LEOI		
Goods/Services	Tires		

Related Proceedings	Opposition No. 91178908, Cancellation No. 92048386
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Attachments	20080806155617382.pdf (5 pages)(385031 bytes)
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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	/mam/
Name	Marie Anne Mastrovito
Date	08/06/2008

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

IN THE MATTER OF Trademark Application No. 77/308830

Shandong Linglong Rubber Co. Ltd, and :
Zhaoyuan Leo Rubber Co. Ltd :
 :
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 Joint Opposers, :
 :
 :
 v. : Opposition No. _____
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 :
 Omni United (S) Pte Ltd. :
 :
 Applicant. :
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NOTICE OF OPPOSITION

Shandong Linglong Rubber Co. Ltd., a Chinese corporation with a place of business at 170 Jincheng Road, Zhaoyuan City, Shandong, CHINA and Zhaoyuan Leo Rubber Co. Ltd., a Chinese corporation, with a place of business at 170 Jincheng Road, Zhaoyuan City, Shandong, CHINA, believe that they will be damaged by the registration of the above identified trademark and therefore oppose same.

As grounds for the opposition it is alleged that:

1. Shandong Linglong Rubber Co. Ltd. (hereinafter "Shandong") is the owner of the mark LEAO as well as a stylized form of the mark LEAO which has the appearance similar to the word LEOI (Opposers' Marks), in the United States in connection with tires (hereinafter "Opposers' Goods").
2. Shandong is the majority owner of Opposer Zhaoyuan Leo Co. Ltd. (hereinafter "Zhaoyuan"), and Shandong has licensed Zhaoyuan to use the Opposers' Marks. Through this license Zhaoyuan has shipped goods to distributors in the United States.

3. Shandong and Zhaoyuan have the same President and share three of the same directors.

4. Shandong, as owner of the trademarks LEAO and LEOI has a real interest in this proceeding. Zhaoyuan has a real interest in this proceeding by virtue of its license to use Opposers' Marks in the United States and in view of its relationship with and majority ownership by Shandong.

5. On October 19, 2007, Omni United (S) Pte Ltd (hereinafter, "Applicant") filed an application to register the mark LEOI (hereinafter, "Applicant's Mark") and said application has been assigned Serial No. 77/308830 (hereinafter, "the application"). The application is based on Applicant's alleged use of Applicant's Mark in commerce under Section 1(a) of the Trademark Act and covers "truck and bus radial tires, light truck radial tires, passenger car radial tires, off the road radial tires" (hereinafter, "Applicant's Goods").

6. The mark shown in the Applicant's application is highly similar to Opposers' Marks and the Applicant's goods are the same as, or are closely related to, Opposers' Goods.

7. Applicant is not the proper owner of the mark shown in the application because Applicant did not control the nature and quality of the goods covered by the application, and was not the actual source of the goods, at the time the application was filed.

8. Applicant acknowledged that it is not the owner of the mark in an Agreement dated July 6, 2005 between Applicant and Shandong.

9. The July 6, 2005 Agreement between Shandong and Applicant provides that both parties agree "to jointly establish the market for [Shandong's] proprietary brand 'LEAO' in the markets agreed on jointly."

10. In the July 6, 2005 Agreement between Shandong and Applicant, Applicant agrees to represent Shandong's "proprietary brand 'LEAO' in the territory of North America (US, Canada and Mexico).

11. Applicant's Mark should be denied registration under Section 1 of the Trademark

Act, 15 U.S.C. Section 1051, because Applicant was not the rightful owner of the mark at the time the application was filed.

12. On information and belief any use of the Applicant's Mark which has previously been made by Applicant has inured to the benefit of the Opposers because Applicant was merely acting as a distributor of the tires.

13. Opposers have used Opposers' Marks in the United States and Opposers' rights to Opposers' Marks are senior to, and superior to, any rights which Applicant may have to Applicant's Mark..

14. On information and belief, Applicant's claimed first use of the Applicant's Mark was actually made for the benefit of, and as the distributor of the Opposers.

15. Applicant's Mark should be denied registration under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), because it so resembles the mark previously used in commerce by the Opposers' and not abandoned as to be likely when used on or in connection with goods identified in the application as to cause confusion or to cause mistake or to deceive.

16. In the declaration accompanying the application Applicant stated its belief that it was the owner of the mark shown in the application, and that to the best of its knowledge and belief no other person had the right to use the mark in commerce. These statements were false in that the Applicant knew or should have known it was not the owner of the mark at the time the declaration was executed and submitted to the Trademark Office and also knew or should have known that Opposers had the right to use the mark in commerce.

17. On information and belief, upon reasonable reliance on the truth of Applicant's misrepresentations and false statements that it was the owner of the mark and that no other parties had the right to use the mark in commerce, the Examiner allowed the mark for publication.

18. On information and belief, had the Examiner been aware of the misrepresentations and false statements regarding the ownership of the Applicant's Mark mark and Opposers' superior rights to the use of the mark, the application would have been refused.

19. Applicant's registration of Applicant's Mark will create a cloud on Opposers' rights to use and register their marks and causes damage to the goodwill associated with Opposers' Marks. .

WHEREFORE, Opposers believe that they have a real interest in this proceeding and will be irreparably damaged by the registration of the Applicant's Mark, and respectfully requests that the Board sustain this action and refuse registration to the mark shown in Applicant's application.

Respectfully submitted,



MARIE-ANNE MASTROVITO

**ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE
NEW YORK, NEW YORK 10017
(212) 949-9022**

Date: August 6, 2008

*Attorneys for Opposers,
Shandong Linglong Rubber Co. Ltd. and
Zhaoyuan Leo Rubber Co. Ltd.*

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid this 6th day of August, 2008 upon the following:

Thomas W. Cook, Esq.
Thomas Cook Intellectual Property Attorneys
P.O. Box 1989
3030 Bridgeway , Suite 425
Sausalito, California 94965



MARIE-ANNE MASTROVITO