

ESTTA Tracking number: **ESTTA232767**

Filing date: **08/26/2008**

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	Ferrari S.p.A.
Granted to Date of previous extension	08/27/2008
Address	Via Emilia Est 1163 Modena, 41100 ITALY

Attorney information	Albert Robin Cowan, Liebowitz & Latman, P.C. 1133 Avenue of the Americas New York, NY 10036-6799 UNITED STATES trademark@cll.com Phone:2127909200
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**Applicant Information**

Application No	77327627	Publication date	04/29/2008
Opposition Filing Date	08/26/2008	Opposition Period Ends	08/27/2008
Applicant	Saroyan Lumber Company, Inc. 6230 So. Alameda St. Huntington Park, CA 90255 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 019. First Use: 2006/04/18 First Use In Commerce: 2006/04/18 All goods and services in the class are opposed, namely: Floor boards, Wooden flooring, Hardwood flooring; Non-metal architectural mouldings and finish trim
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2791072	Application Date	02/08/2002
Registration Date	12/09/2003	Foreign Priority Date	02/06/2002
Word Mark	575 M MARANELLO		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	<p>Class 012. First use: Land motor vehicles, namely, motor cars, automobiles and sport cars, and structural parts and accessories thereof sold as a unit; engines for land vehicles; transmissions for land vehicles, suspension systems for land vehicles; brakes for land vehicles; motor bikes</p> <p>Class 028. First use: Toy models and collection models reproducing automobiles and other vehicles; real size replicas of automobiles for entertainment and exhibition purposes; game puzzles; hand-held units for playing electronic games, stand alone videogame machines, coin or counter operated arcade game machines, none of the foregoing being for use with television receivers, and parts and fittings sold as a unit for the aforesaid games</p> <p>Class 037. First use: Automobile repair and maintenance, automobile body repair work for motor cars</p>

U.S. Registration No.	2248482	Application Date	09/03/1996
Registration Date	06/01/1999	Foreign Priority Date	07/26/1996
Word Mark	550 MARANELLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 012. First use: vehicles, apparatus for locomotion by land air or water, namely, automobiles and sport cars, and structural parts therefor</p> <p>Class 025. First use: T-shirts, pullovers, overalls, caps, wind resistant jackets, waterproof jackets, blazers, sweatshirts, polo shirts, ties, toweling robes, scarves, shoes, blousons, sweaters, shirts, trousers, belts, raincoats and waistcoats</p> <p>Class 028. First use: toy models and collection models reproducing automobiles</p>		

U.S. Registration No.	2005616	Application Date	02/21/1995
Registration Date	10/08/1996	Foreign Priority Date	NONE
Word Mark	MARANELLO		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 007. First use: [parts of motor vehicle engines, namely mufflers, alternators, belts, fans, filters, and cylinders]</p> <p>Class 012. First use: automobiles; [ structural parts therefor, namely bodies for vehicles and structural parts therefor, automobile hoods, automobile side-view mirrors and roof racks for attachment to automobiles; automobile engines; clutches and brakes for land motor vehicles, brake pads and brake hardware for land vehicles; seat belts for motor vehicles]</p>		

Attachments	78107628#TMSN.gif ( 1 page )( bytes ) 75159294#TMSN.gif ( 1 page )( bytes ) ferrari opposition.pdf ( 5 pages )(15091 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	/Albert Robin/
Name	Albert Robin
Date	08/26/2008

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

In the Matter of Application No. 77/327627  
Published in the Official Gazette of April 29, 2008

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FERRARI S.p.A., :  
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 Opposer, :  
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 v. : Opposition No.  
 :  
 SAROYAN LUMBER COMPANY, INC., :  
 :  
 Applicant. :  
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NOTICE OF OPPOSITION

Ferrari S.p.A., an Italian joint stock company, with offices at Via Emilia Est 1163, 41100 Modena, Italy (hereinafter referred to as “Opposer”) believes it is or will be damaged by registration of the mark shown in Application Serial No. 77/327627 and hereby opposes the same.

As grounds of opposition it is alleged that:

1. Opposer is informed and believes and therefore avers that Saroyan Lumber Company, Inc. (hereinafter referred to as “Applicant”) is a California corporation with a place of business at 6230 So. Alameda St., Huntington Park, California 90255.

2. Applicant is not now and never was entitled to appropriate or register as a trademark the designation MARANELLO for which it seeks registration in its Application Serial No. 77/327627 published in the Official Gazette of April 29, 2008.

3. Applicant was not entitled to use as a trademark the designation MARANELLO either on April 18, 2006, the claimed date of its first use thereof, or on November 12, 2007, the date of the filing of its application for registration thereof, or on April 29, 2008, the date of publication for opposition thereof in the Official Gazette.

4. Since long prior to April 18, 2006, Applicant's claimed date of first use, Opposer has been engaged in manufacturing, or having manufactured for it, offering for sale and selling high performance automobiles, including race cars, and parts and accessories for such automobiles, and licensees of Opposer have been manufacturing, offering for sale and selling items of various descriptions.

5. For over sixty years, Maranello, Italy has been the location of the factory at which Opposer's automobiles and parts are manufactured, and Maranello has become known as the home of Opposer and of its Scuderia Ferrari Formula One racing team.

6. Since long prior to April 18, 2006, Opposer has used MARANELLO as or as part of the trademark for several models of its FERRARI automobiles, including the 575 M MARANELLO and the 550 MARANELLO automobiles which have been offered for sale and sold in the United States, and for items collateral thereto.

7. Since long prior to April 18, 2006, licensees of Opposer have been manufacturing toy models of Opposer's MARANELLO automobiles and other items which have been sold in the United States under Opposer's MARANELLO trademark not only by said licensees but also by Opposer in various ways including from its online catalog and from its FERRARI retail shops, the first of which is located in Maranello, Italy.

8. While Opposer has its factory in Maranello, Italy, and many of the products which it sells and the services which it renders originate there, Opposer is informed and believes and

therefore avers that Applicant does not have a place of business in Maranello, Italy, and that the goods which Applicant sells under the designation MARANELLO do not emanate from or have any connection with Maranello, Italy.

9. Opposer is the owner of the following registrations, among others, issued by the United States Patent and Trademark Office:

<u>Reg. No.</u>	<u>Date of Issue</u>	<u>Mark</u>
2791072	December 9, 2003	575 M MARANELLO
2248482	June 1, 1999	550 MARANELLO
2005616	October 8, 1996	MARANELLO

10. In Application Serial No. 77/327627, Applicant seeks to register the designation MARANELLO as a trademark for floor boards, wooden flooring, hardwood flooring, non-metal architectural moldings and finish trim.

#### GROUND ONE

11. Opposer repeats and realleges the allegations of Paragraphs 1 through 10 of this Notice of Opposition.

12. The designation MARANELLO so resembles the name and mark MARANELLO, as previously used and registered by Opposer, as to be likely to cause confusion, or to cause mistake or to deceive.

#### GROUND TWO

13. Opposer repeats and realleges the allegations of paragraphs 1 through 10, inclusive, of this Notice of Opposition.

14. Opposer is informed and believes and therefore avers that MARANELLO is deceptively geographically misdescriptive of the goods for which Applicant seeks registration in

Application Serial No. 77/327627.

GROUND THREE

15. Opposer repeats and realleges the allegations of paragraphs 1 through 10, inclusive, of this Notice of Opposition.

16. Opposer is informed and believes and therefore avers that at the time of its filing of the application herein opposed, Applicant had not used the designation MARANELLO on each of the items of goods for which registration is sought in Application Serial No. 77/327627.

WHEREFORE, Opposer prays that its opposition be sustained and that registration of the designation MARANELLO as a trademark to Applicant be refused and denied.

Dated: New York, New York  
August 26, 2008

/s/ Albert Robin  
Albert Robin  
Attorney for Opposer  
Cowan, Liebowitz & Latman  
1133 Avenue of the Americas  
New York, New York 10036-6799  
(212) 790-9246

Certificate of Service

A copy of the foregoing Notice of Opposition was served upon Applicant by first-class mail, postage prepaid, addressed to Saroyan Lumber Company, Inc., 62320 So. Alameda St., Huntington Park, California 90255, this 26th day of August, 2008.

/s/ Albert Robin

Albert Robin