

ESTTA Tracking number: **ESTTA241742**

Filing date: **10/09/2008**

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	Trek Bicycle Corporation
Granted to Date of previous extension	11/01/2008
Address	801 West Madison Waterloo, WI 53594 UNITED STATES

Attorney information	Mary Catherine Merz Merz & Associates 1140 Lake Street, Suite 304 Oak Park, IL 60301 UNITED STATES doctet@merz-law.com Phone:708-383-8801
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Applicant Information

Application No	77446533	Publication date	09/02/2008
Opposition Filing Date	10/09/2008	Opposition Period Ends	11/01/2008
Applicants	Mark Forrest Newby, Scarborough 303 Scalby Rd. North Yorkshire, YO126TF UNITED KINGDOM Virginia Welford Newby, Scarborough 303 Scalby Rd. North Yorkshire, YO126TF UNITED KINGDOM		

Goods/Services Affected by Opposition

Class 012. First Use: 2007/06/01 First Use In Commerce: 2007/06/12 All goods and services in the class are opposed, namely: Scooters

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.	1168276	Application Date	04/21/1980
Registration Date	09/08/1981	Foreign Priority Date	NONE

Word Mark	TREK
Design Mark	
Description of Mark	NONE
Goods/Services	Class 012. First use: First Use: 1977/03/10 First Use In Commerce: 1977/03/10 Bicycles and Bicycle Frames

U.S. Registration No.	1989281	Application Date	11/29/1994
Registration Date	07/23/1996	Foreign Priority Date	NONE
Word Mark	TREKKING		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1996/01/00 First Use In Commerce: 1996/01/00 bicycles		

U.S. Registration No.	1994479	Application Date	10/03/1994
Registration Date	08/20/1996	Foreign Priority Date	NONE
Word Mark	TREK 100		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 039. First use: First Use: 1989/00/00 First Use In Commerce: 1989/00/00 providing ride support vehicles in competitive and recreational events, namely bicycle tours, bicycle races, and triathlons		

U.S. Registration No.	2060274	Application Date	10/06/1994
Registration Date	05/13/1997	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1990/09/00 First Use In Commerce: 1990/09/00 cycling computers and head protective helmets for bicycle users</p> <p>Class 012. First use: First Use: 1993/01/00 First Use In Commerce: 1993/01/00 bicycles, bicycle frames, and a full line of parts and accessories for bicycles, namely, handlebars, [handlebar end extensions, handlebar stems,] seats, seat posts, seat post clamps and binder bolts, [tires, tire innertubes, pedals,] forks for supporting bicycles upon bicycle wheels, [bicycle suspensions, wheels and wheel rims,] water bottles, water bottle cages, bicycle mounted racks, [bicycle carrying racks for motor vehicles,] tools and tire repair kits for bicycles, lock holders, [audible warning devices, namely, bells for bicycles,] lighting systems for bicycles [and bicycle fenders]</p> <p>Class 028. First use: First Use: 1993/10/00 First Use In Commerce: 1993/10/00</p>		

	exercise equipment, namely, stationary exercise cycles		
U.S. Registration No.	2580991	Application Date	06/19/2000
Registration Date	06/18/2002	Foreign Priority Date	NONE
Word Mark	TREKBIKES.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1999/07/00 First Use In Commerce: 1999/07/00 Bicycles, bicycle frames and parts		
U.S. Registration No.	2596471	Application Date	02/03/1998
Registration Date	07/23/2002	Foreign Priority Date	NONE
Word Mark	TREKKING		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1998/03/23 First Use In Commerce: 1998/03/23 EDUCATIONAL SERVICES, NAMELY, PROVIDING SEMINARS AND CLINICS RELATING TO THE USE OF EXERCISE EQUIPMENT		
U.S. Registration No.	2687012	Application Date	03/01/2000
Registration Date	02/11/2003	Foreign Priority Date	NONE
Word Mark	ETREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2002/09/30 First Use In Commerce: 2002/09/30 On-line retail and wholesale store services, featuring a wide range of consumer products, except footwear, all provided via the Internet		
U.S. Registration No.	2708232	Application Date	08/29/1997
Registration Date	04/22/2003	Foreign Priority Date	03/03/1997
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 2002/06/30 First Use In Commerce: 2002/06/30 Non-alcoholic beverages sold in liquid form, namely, non-carbonated fruit juices, either alone or flavored with any or all of the following - water, herbs and spices (Based on Use in Commerce); non-carbonated drinking waters either alone or flavored with any or all of the following - herbs, spices, and natural fruit flavors		

	(Based on Use in Commerce) and (Based on 44(e))		
U.S. Registration No.	2742116	Application Date	10/04/2002
Registration Date	07/29/2003	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1998/09/30 First Use In Commerce: 1998/09/30 bicycles and bicycle frames		
U.S. Registration No.	2745442	Application Date	01/05/1998
Registration Date	08/05/2003	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1988/06/00 First Use In Commerce: 1988/06/00 bicycling apparel, namely, bicycling jersey; form fitting and reinforced seat elastic shorts; ankle length socks; wind resistant jackets with enhanced visibility fabric, extra sleeve length, high collar and extended length back panel; vests with enhanced visibility fabric, high collar and extended length back panel Class 028. First use: First Use: 1988/06/00 First Use In Commerce: 1988/06/00 padded and reinforced fingerless bicycling gloves		
U.S. Registration No.	2876977	Application Date	09/27/2001
Registration Date	08/24/2004	Foreign Priority Date	NONE
Word Mark	TREKLITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1977/12/22 First Use In Commerce: 1979/07/17 orienteering equipment and clothing for outdoor sporting activities, namely, protective outer wear Class 025. First use: First Use: 1977/12/22 First Use In Commerce: 1979/07/17 orienteering equipment and clothing for outdoor sporting activities, namely, leggings, pants, gators, shirts, and jackets		
U.S. Registration No.	3031210	Application Date	06/28/2004
Registration Date	12/20/2005	Foreign Priority Date	NONE
Word Mark	TREK TRAVEL		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 039. First use: First Use: 2002/10/01 First Use In Commerce: 2002/10/01 Arranging travel tours featuring hiking, river rafting, whale watching, kayaking, and bicycling; cultural tours, namely, conducting sightseeing tours for others Class 041. First use: First Use: 2002/10/01 First Use In Commerce: 2002/10/01 Sporting and cultural activities related to bicycling, namely, wine tastings and cultural tours, namely, guided tours of wineries Class 043. First use: First Use: 2002/10/01 First Use In Commerce: 2002/10/01 Services for providing food and drinks and temporary lodging for those participating in bicycling activities and cultural activities related to bicycling, namely, hiking, river rafting, cultural tours, wine tastings, whale watching and kayaking

U.S. Registration No.	3042834	Application Date	07/08/2004
Registration Date	01/10/2006	Foreign Priority Date	NONE
Word Mark	TREK UNIVERSITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2004/10/01 First Use In Commerce: 2004/10/01 Instructional and training services in the field of retailing bicycles, bicycle clothing and bicycle accessories, and in the fields of bicycle safety, bicycle recreation, bicycle service and bicycle repair		

U.S. Registration No.	3053077	Application Date	10/21/2003
Registration Date	01/31/2006	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1993/01/31 First Use In Commerce: 1993/01/31 backpacks, fanny packs, textile tote bags, hip packs, messenger bags, rack trunks, saddle bags, bicycle seat packs, all purpose sports bags		

U.S. Registration No.	3066516	Application Date	11/06/2002
Registration Date	03/07/2006	Foreign Priority Date	NONE
Word Mark	TREKER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2002/11/00 First Use In Commerce: 2002/11/00 OFF-ROAD ALL-TERRAIN UTILITY VEHICLES		

U.S. Registration	3397739	Application Date	07/03/2007
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No.			
Registration Date	03/18/2008	Foreign Priority Date	NONE
Word Mark	TREK BICYCLE STORE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 retail stores featuring bicycles		

U.S. Application No.	77388493	Application Date	02/05/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TREK 100		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1989/05/01 First Use In Commerce: 1989/05/01 Charitable fundraising services featuring bicycle rides and related events		

U.S. Application No.	77388536	Application Date	02/05/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2000/04/28 First Use In Commerce: 2000/04/28 Exercise equipment namely stationary trainers for use with bicycles		

U.S. Application No.	77433264	Application Date	03/27/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TREK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2002/09/30 First Use In Commerce: 2002/09/30 On-line retail and wholesale store services featuring a wide range of consumer products except footwear all provided via the Internet		

U.S. Application No.	77476296	Application Date	05/16/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TREK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 032. First use: powders used in the preparation of sports drinks and energy drinks

U.S. Application No.	77536257	Application Date	07/31/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	TREK STOP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2008/06/30 First Use In Commerce: 2008/06/30 retail vending services in the field of automated vending machines that dispenses bicycle parts, bicycle accessories, energy bars, beverages and gels		

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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	/Mary Catherine Merz/
Name	Mary Catherine Merz
Date	10/09/2008

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

In the Matter of U.S. Application Serial No. 77/446,533
For: PAWTREKKER
Filed: April 11, 2008
Date of Publication: September 2, 2008

TREK BICYCLE CORPORATION)
)
 Opposer,)
)
 v.) Opposition No. _____
)
MARK FORREST and)
VIRGINIA WELFORD)
)
 Applicants.)

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 77/446,533 ("Serial No. 77/446,533") for the mark "PAWTREKKER" in International Class 12, filed in the name of Mark Forrest and Virginia Welford ("applicants"), which was published for opposition in the Official Gazette of September 2, 2008. Trek Bicycle Corporation ("Trek"), a Wisconsin corporation with its principal place of business at 801 West Madison, Waterloo, Wisconsin 53594, believes it will be damaged by the registration of the mark in Serial No. 77/446,533 in International Class 12 and hereby opposes the same, in accordance with Section 13 of The

Opposition against "PAWTREKKER"
In re U.S. Application Serial No. 77/446,533

Trademark (Lanham) Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Trek alleges as follows:

1. Upon information and belief, applicants, Mark Forrest and Virginia Welford, are individuals who are citizens of the United Kingdom, residing at 303 Scalby Road, Newby, Scarborough, North Yorkshire YO126TF, United Kingdom.

2. Applicants seek to register "PAWTREKKER" in connection with the following goods:

scooters

in International Class 12, as evidenced by the publication of Serial No. 77/446,533 in the Official Gazette of September 2, 2008.

3. Upon information and belief, applicants filed their application on April 11, 2008 under Section 1(a) of the Trademark Act [15 U.S.C. §1051(a)], claiming a first use date of June 1, 2007 and a first use in commerce date of June 12, 2007 of the mark "PAWTREKKER" for goods in Class 12.

4. Since at least 31 years prior to applicants' alleged first use in commerce date of the mark "PAWTREKKER", Trek adopted and has continuously used the trade name "TREK" in connection with its business activities.

5. Trek has invested substantial amounts of time, effort and money in protecting and policing its "TREK" trade name throughout the United States and the rest of the world. As such, Trek has extensive, non-registered statutory and common law rights in its "TREK" trade name, which Trek uses in connection with its business activities.

6. Since at least 30 years prior to applicants' alleged first use in commerce date of the mark "PAWTREKKER", Trek adopted and has continuously used its "TREK" mark in connection with bicycles, bicycle frames, bicycle parts and accessories; Trek also has expanded its trademark use of "TREK" to cover numerous additional products and services, and has licensed the use of "TREK" for motorized scooters among other goods.

7. Trek has invested substantial amounts of time, effort and money in registering, promoting and policing its famous "TREK" trademark throughout the United States and the rest of the world. As such, in addition to the protection afforded Trek by its federal trademark registrations, Trek has extensive, non-registered statutory and common law rights in its "TREK" mark for its products and services.

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8. Trek is the owner of U.S. Trademark Registration No. 1,168,276 for "TREK" for "bicycles and bicycle frames"; U.S. Trademark Registration No. 1,989,281 for "TREKKING" for "bicycles"; U.S. Trademark Registration No. 1,994,479 for "TREK 100" for "providing ride support vehicles in competitive and recreational events, namely, bicycle tours, bicycle races, and triathlons"; U.S. Trademark Registration No. 2,060,274 for "TREK" for "exercise equipment, namely, stationary exercise cycles," "bicycles," "cycling computers," and "head protective helmets for bicycle users," among other things; U.S. Trademark Registration No. 2,580,991 for "TREKBIKES.COM" for "bicycles, bicycle frames and parts"; U.S. Trademark Registration No. 2,596,471 for "TREKKING" for "educational services, namely, providing seminars and clinics relating to the use of exercise equipment"; U.S. Trademark Registration No. 2,687,012 for "ETREK" for "online retail and wholesale store services, featuring a wide range for consumer products, except footwear, all provided via the Internet"; U.S. Trademark Registration No. 2,708,232 for "TREK" for non-alcoholic beverages; U.S. Trademark Registration No. 2,742,116 for "TREK Stylized" for bicycles and bicycle frames; and U.S. Trademark Registration No. 2,745,442 for "TREK" for

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clothing and padded gloves; U.S. Trademark Registration No. 2,876,977 for "TREKLITE" for "orienteering equipment and clothing for outdoor sporting activities, namely protective outer wear; U.S. Trademark Registration No. 3,031,210 for "TREK TRAVEL" for travel arrangement of bicycling tours; sporting and cultural activities related to bicycling; services for providing food and drinks, temporary accommodation, all related to bicycling activities; U.S. Trademark Registration No. 3,042,834 for "TREK UNIVERSITY" for "instruction and training services, in the field of retailing bicycles, bicycle clothing and bicycle accessories; and in the fields of bicycle safety, bicycle recreation, bicycle service and bicycle repair"; U.S. Trademark Registration No. 3,053,077 for "TREK" for "backpacks, fanny packs, textile tote bags, hip packs, messenger bags, rack trunks, saddle bags, bicycle seat packs, and all purpose sports bags"; U.S. Trademark Registration No. 3,066,516 for "TREKER" for "off road all-terrain utility vehicles"; and U.S. Trademark Registration No. 3,397,739 for "TREK BICYCLE STORE" for "retail stores featuring bikes".

These registrations are valid, subsisting, uncancelled and are conclusive evidence of Trek's exclusive right to use the "TREK" mark and its other marks containing "TREK" as an element in

Opposition against "PAWTREKKER"
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commerce on the goods and in connection with the services specified in the registrations.

9. Trek is also the owner of U.S. Trademark Application Serial No. 77/388,493 for "TREK 100" for "charitable fund-raising events in the nature of bicycle races"; U.S. Trademark Application Serial No. 77/388,536 for "TREK" for "exercise equipment, namely trainers for use with bicycles"; U.S. Trademark Application Serial No. 77/433,264 for "TREK" for "on-line retail and wholesale store services featuring a wide range of consumer products except footwear all provided via the Internet"; U.S. Trademark Application Serial No. 77/476,296 for "TREK" for "powders used in the preparation of sports drinks and energy drinks"; and U.S. Trademark Application Serial No. 77/536,257 for "TREK STOP" for "retail vending services in the field of automated vending machines that dispenses bicycle parts, bicycle accessories, energy bars, beverages and gels".

10. Since at least as early as the respective dates of first use stated in its applications and registrations, Trek has used its marks in connection with the sale of its goods and services covered by those registrations. Such use has been valid and continuous, and has not been abandoned. The public has come to associate Trek with the "TREK" trademark and trade name.

Opposition against "PAWTREKKER"
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11. Prior to the applicants' filing date for the mark "PAWTREKKER", Trek's "TREK" mark had become famous for Trek's goods and services.

12. Applicants have no license, consent or permission from Trek to use or register "PAWTREKKER".

13. Applicants' mark "PAWTREKKER" so resembles Trek's "TREK" mark and trade name that it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of The Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(d); and more particularly, applicants' mark and use thereof are likely to cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that the goods in Serial No. 77/446,533 originate with Trek or otherwise are authorized, licensed or sponsored by Trek.

14. By reason of all the foregoing, Trek will be gravely damaged by the registration of applicants' "PAWTREKKER" mark for the goods covered by Serial No. 77/446,533, because registration of that mark would be in violation of Trek's trademark and trade name rights.

WHEREFORE, Trek prays that this Notice of Opposition be sustained in favor of Trek and that Serial No. 77/446,533 be

Opposition against "PAWTREKKER"
In re U.S. Application Serial No. 77/446,533

denied registration. Trek submits herewith a payment to cover
its filing fee of \$300.00, as required by 37 C.F.R. §2.6(a)(17).

Respectfully submitted,
TREK BICYCLE CORPORATION

Date: October 9, 2008

By:

Mary Catherine Merz

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served on
the applicants by First Class Mail this 9th day of October 2008, addressed to:

Michael Eisenberg
3263 Caminito East Bluff, Unit 198
La Jolla, California 92037-2840

Date:

10/9/08

By:

Mary Catherine Merz