

ESTTA Tracking number: **ESTTA259951**

Filing date: **01/12/2009**

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	01/11/2009
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:212-790-9200
----------------------	--

Applicant Information

Application No	77269247	Publication date	07/15/2008
Opposition Filing Date	01/12/2009	Opposition Period Ends	01/11/2009
Applicant	UFirst Merchant Services, LLC 150 Broadway, 3rd Floor New York, NY 10038 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 036. First Use: 2007/08/01 First Use In Commerce: 2007/08/01 All goods and services in the class are opposed, namely: Financial services, namely, electronic payment, namely, electronic processing and transmission of bill payment and Financial services, namely, data credit and debit card transaction processing services; check verification, Financial guarantee and surety, and Foreign exchange transactions, electronic funds transfer services; Pre-paid purchase card services, namely, processing electronic payments made through prepaid cards; providing electronic processing of credit card transaction and electronic transmissions of bill payments via global computer network; accounts receivables financing; Consumer lending services; Financial services in the field of money lending; Financial services, namely, money lending; credit and cash card services; electronic credit card transactions; loan financing; loans financing and discount of bills; providing temporary loans; providing loans by commercial paper; business finance procurement services</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	863434	Application Date	12/05/1967
Registration Date	01/14/1969	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U019 (International Class 012). First use: First Use: 1965/11/14 First Use In Commerce: 1965/11/25 AUTOMOBILES		

U.S. Registration No.	2217612	Application Date	07/26/1996
Registration Date	01/12/1999	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1975/00/00 First Use In Commerce: 1979/00/00 T-shirts, overalls, caps, waterproof jackets, blazers, polo shirts, ties, scarves, shoes, blousons, sweaters		

U.S. Registration No.	2294171	Application Date	05/15/1998
Registration Date	11/23/1999	Foreign Priority Date	NONE
Word Mark	NONE		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 003. First use: skin soaps, [shaving soaps]; perfume and [essential oils for personal use; hair lotions, hair shampoos,] eau de toilette, after-shave lotion, personal deodorants, [dentifrices]</p> <p>Class 006. First use: metal key rings [key cases and pill boxes; pins, badges, tags and table trophies made of common metal]</p> <p>Class 009. First use: [eyeglasses, magnifying glasses, sunglasses, anti-glare eyeglasses, protective eyeglasses, and safety goggles; eyeglasses cases, eyeglasses frames, and eyeglasses lenses; safety helmets for use by automobile drivers and motorcycles riders; computer game cartridges; compact disc players; CD-ROMs and pre-recorded videocassettes featuring cars races and history of the applicant; pre-recorded magnetic and optical supports featuring video games; telephones and cellular telephones; chronographs for use as specialized time recording apparatus; electric cigarette lighters for land vehicles]</p> <p>Class 014. First use: watches, wrist watches, chronometers and chronographs for use as watches; [cases for timepiece made of precious metal; jewelry; pen holders, pen cases, letter openers, purses, ashtrays, bottle openers, cork screws, cigar cutters, cigarettes cases, snuff boxes, cigar cases, pen wipers, and slides for pens, all made of precious metal; electric cigarette lighters not for land vehicles of precious metal; tie pins and cuff links, pins being jewelry and precious metal key rings]</p> <p>Class 016. First use: [playing cards, postcards, printed label not of textiles,] stickers, [paper flags, calendars and catalogs;] pens, [fountain pens, roller ball pens, felt tip pens and pencils;] desk sets; [pen holders and paper cutters not of precious metal; file folders; scrapbook albums; newspapers, books and magazines featuring car races and history of the applicant; paperweights of common metal]</p> <p>Class 018. First use: trunks, suitcases, traveling bags, ticket carrying cases; leather key cases; umbrellas, attache cases, leather suit carriers, wallets, purses, card holders, all of skin or leather; rucksacks, saddlery</p> <p>Class 024. First use: [cloth flags; textile table clothes and napkins; beach towels]</p> <p>Class 027. First use: [rugs and carpets for automobiles]</p> <p>Class 028. First use: [jigsaw puzzles,] toy models reproducing automobiles, [sport cars and racing</p>

	cars; tennis equipment, namely, tennis bags and tennis rackets; golf equipment, namely, golf bags, golf clubs and golf pouches; athletic bags, namely, tennis bags] Class 037. First use: [automobile maintenance and repair]
--	---

U.S. Registration No.	2655307	Application Date	09/07/1999
Registration Date	12/03/2002	Foreign Priority Date	06/30/1999

Word Mark	NONE
-----------	------

Design Mark	
-------------	---

Description of Mark	NONE
---------------------	------

Goods/Services	<p>Class 035. First use:</p> <p>Assistance in the operation of retail stores featuring perfume, eau de toilette, eau de cologne, essential oils for personal use, aftershave lotions, personal deodorants, hair lotions, hair shampoos, skin soaps, shower gel, dentifrices; metal key rings and metal pill boxes; cotter, pins, name badges, key tags and table trophies all made of common metal; eyewear, namely eyeglasses, sunglasses, anti-glare glasses, protective glasses, safety eyeglasses; safety helmets for motorists and motorcyclists; prerecorded videocassettes and CD-ROMs featuring car races and history of the applicant; telephones and cellular phones, interactive video games adapted for use with television receivers only; computer game cartridges; video game cartridges; computer game cassettes; computer game equipment containing memory devices, namely discs; computer game programs, interactive amusement machines adapted for use with television receivers only; software for video games to be used in connection with automatic and coin-operated machines; electrical circuits for use in amusement game machines for reproducing music, speech and special effects; automatic and coin operation parts and fittings for video and computer game apparatus, screen savers and mouse pads; graduated rules, protective suits for automobile racing; clocks, watches, chronometric instruments, namely, chronometers and chronographs for use as watches, pins being jewelry, tie pins, cufflinks; jewelry; adhesive labels, stickers, flags made from papers, calendars, catalogs, booklets featuring cars, pens, fountain pens, rolling pens, pencils, felt pens, writing pens, pen-holders not of precious metal, paper cutters, file folders for cards, business visit cards and business documents, albums; newspapers, periodicals and books featuring car racing competitions and history of the applicant, stamps for collectors, photographic prints, posters, ticket holders, postcards, rubber erasers, drafting squares, drafting rulers, cardboard boxes, index and greeting cards, agendas, playing cards, note paper, gift wrapping paper, pencil sharpeners, small blackboards and notepads; leather document holders; luggage, namely trunks, suitcases and traveling bags, key cases and key fobs made of leather; umbrellas, attache cases, briefcases, leather suit bags, wallets, purses, business card cases all made of skin or leather; rucksacks, belt bags</p>
----------------	--

	<p>and saddlery; metal key cases; flags made from fabrics, textile tableclothes and napkins; beach towels; T-shirts, sweatshirts, polo shirts, ties, caps, overalls, wind-resistant jackets, waterproof jackets, blazers, pullovers, coats, robes, scarves, shoes, boots, sweaters, shirts, trousers, belts, raincoats, track suits, shorts, gloves, pajamas, slippers, swimming costumes; ornamental novelty pins and buttons; jigsaw puzzles, hand-held units for playing electronic games, electronic dart games, pinball games, coin-operated and stand-alone video game machines, arcade games, parts and fittings for all the aforesaid goods; toy models and collection models reproducing automobiles and other vehicles, real size non-working replicas of automobiles for entertainment and exhibition purposes; and tennis bags, golf bags, golf pouches and golf clubs</p> <p>Class 042. First use: Restaurants, cafes, cafeterias, snack bars, coffee bars, and catering services; interior design for others</p>
--	--

U.S. Registration No.	3008525	Application Date	07/08/2003
Registration Date	10/25/2005	Foreign Priority Date	06/26/2003
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Eyewear, namely eyeglasses, sun-glasses, anti-glare glasses, protective glasses, safety glasses, safety helmets for motorists and motorcyclists, pre-recorded video cassettes featuring car races and the history of automobile manufacturers, pre-recorded CD-Roms featuring high-performance cars and automobiles, amusement apparatus and games adapted for use with television receivers only, namely video output game machines for use with television, computer game cartridges, video game cartridges, computer game cassettes, computer game equipment containing memory devices, namely discs; computer game programs, computer software for video games to be used in connection with automatic and coin operated machines; computer screen savers software, mouse pads, computer mice, desktop computers, notebook computers, laptop computers, memory, fax and modem cards for portable computers, personal computers, computer keyboards, tablet PCs, computer monitors, printers, bags and cases for computer batteries for notebook computers, personal digital assistants, electronic personal organizers, digital voice recorders, cameras, digital cameras, digital video cameras, digital projectors, zoom camera lenses, scanners, photo printers, hi-fi stereo systems comprised of CD players and audio speakers, TV sets, liquid crystal display TV, CD players, digital video discs players; barometers, barometers with projection devices, electronic language translators, wireless weather stations with weather forecasting, barometric, indoor and outdoor temperature and humidity functions, thermometers not for medical use, humidity and atmospheric pressure monitors with liquid crystal</p>		

	displays, cordless phones, telephones, cellular phones, cellular phone covers, cellular phone hands-free kits comprised of mobile phone accessories in the nature of hands-free holders, hands-free microphones, headsets, microphones and speakers for mobile phone car-kits for the adaptation of mobile phones for vehicular use, calculators, fireproof automobile racing suits for safety purposes
--	---

U.S. Registration No.	3083368	Application Date	04/01/2002
Registration Date	04/18/2006	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1993/00/00 First Use In Commerce: 1993/00/00 Organizing automobile racing exhibitions for sporting purposes, entertainment in the nature of automobile races; organizing workshops [and] in the field of automobiles; lottery services; providing information in the field of sports, recreation and amusements, namely, automobile races and exhibitions and locations of theme parks featuring automobile races and exhibitions; sporting training services in the nature of driving automobiles and sports automobiles; organizing and operating clubs of enthusiasts of automobiles [and] and furnishing information on the subject of such automobiles to club members		

U.S. Registration No.	3084537	Application Date	07/30/2004
Registration Date	04/25/2006	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a representation of a prancing horse.		
Goods/Services	Class 012. First use:		

	Land motor vehicles and structural parts and accessories thereof sold as a unit; engines, transmissions, suspensions and brakes for land vehicles; motor car bodies; motorbikes; bicycles
--	---

U.S. Registration No.	3334822	Application Date	05/05/2006
Registration Date	11/13/2007	Foreign Priority Date	NONE
Word Mark	FINANCIAL SERVICES FERRARI		
Design Mark			
Description of Mark	The mark consists of the words "Financial Services" in stylized letters. Between the words there is a rectangular border having three stripes at the top and containing the Prancing Horse Design above the word "Ferrari" in stylized lettering.		
Goods/Services	Class 036. First use: INSURANCE SERVICES, NAMELY, INSURANCE UNDERWRITING OF ALL TYPES, INSURANCE ADMINISTRATION, INSURANCE BROKERAGE, INSURANCE CLAIMS ADMINISTRATION AND PROCESSING; BANKING SERVICES; CREDIT SERVICES, NAMELY, CREDIT CARDS, CREDIT AGENCIES, CREDIT BUREAUS AND CREDIT UNION; FINANCIAL SERVICES, NAMELY, MONEY LENDING; FINANCING RELATING TO AUTOMOBILES; FINANCING SERVICES; ISSUANCE OF LETTERS OF CREDIT		

U.S. Registration No.	3335166	Application Date	08/04/2006
Registration Date	11/13/2007	Foreign Priority Date	07/31/2006
Word Mark	FERRARI FINANCIAL SERVICES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: Insurance services, namely, insurance underwriting of all types, insurance administration, insurance brokerage, insurance claims administration and processing; banking services; credit services, namely, credit card services,		

	credit agencies, credit bureaux and credit union; financial services, namely, money lending, financing relating to automobiles; financing services; issuance of letters of credit
--	---

U.S. Registration No.	3084412	Application Date	10/13/2003
Registration Date	04/25/2006	Foreign Priority Date	07/18/2003
Word Mark	PRANCING HORSE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 012. First use: Land motor vehicles, namely, motor cars, automobiles, sports cars and convertible cars, structural parts, components and accessories thereof, namely, engines, transmissions, suspensions and brakes, motorbikes, bicycles</p> <p>Class 025. First use: Automobile racing suits, T-shirts, sweat shirts, polo-shirts, ties, caps, hats, overalls, wind resistant jackets, waterproof jackets, blazers, pullovers, coats, robes, scarves, footwear, sweaters, shirts, trousers, belts, vests raincoats, truck suits, shorts, gloves, pajamas, slippers, swimming costumes, socks, Bermuda shorts</p> <p>Class 028. First use: Playing cards; model cars for sale in an assembly kit form, toy model vehicles, toy collection models reproducing automobiles and other vehicles; toy building structures, dolls, doll's clothing, accessories for dolls, soft felt toys, namely soft toys, toy vehicle tracks, toy real size non-operating replicas of automobiles for ornament, entertainment and exhibition purposes; board games, puzzles, stand alone video games and amusement apparatus in the nature of amusement game machines other than for use with television receivers, hand held units for playing video games; tennis bags, golf bags, golf pouches, golf clubs</p> <p>Class 037. First use: Repair and maintenance services of vehicles, namely, motor cars, automobiles, sports cars and convertible cars, motorbikes and bicycles</p> <p>Class 041. First use: Organizing automobile racing exhibitions for sporting purposes entertainment in the nature of automobile races; arranging and conducting workshops and congresses in the field of automobiles; arranging and conducting athletic contests for others; lottery services; providing information in the field of sports, recreation and amusements, namely, automobile races and exhibitions and locations of theme parks featuring automobile races and exhibitions; sporting training services in the nature of driving automobiles and sports automobiles; fan clubs of enthusiasts of automobiles manufactured by applicant; and racing teams sponsored by applicant; and furnishing information on the subject of such automobiles and racing teams to club members</p> <p>Class 043. First use: food and drink preparation services; restaurants, cafes, cafeterias, snack bars, coffee bars, refreshment and catering services, fast foods and take away food outlets</p>		

Attachments	72286258#TMSN.gif (1 page)(bytes) 75140399#TMSN.gif (1 page)(bytes) 75485748#TMSN.gif (1 page)(bytes)
-------------	---

	75792988#TMSN.gif (1 page)(bytes) 78271334#TMSN.jpeg (1 page)(bytes) 78118658#TMSN.gif (1 page)(bytes) 78459836#TMSN.jpeg (1 page)(bytes) 78877171#TMSN.jpeg (1 page)(bytes) 78945024#TMSN.jpeg (1 page)(bytes) ufirst merchant opposition.pdf (6 pages)(27224 bytes)
--	--

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	01/12/2009

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

In The Matter of Application Serial No. 77/269,247
Published in the Official Gazette of July 15, 2008

FERRARI S.p.A.,

Opposer,

v.

Opposition No.

UFIRST MERCHANT SERVICES LLC,

Applicant.

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. 77/269,247 and hereby opposes the same.

As grounds of opposition it is alleged that:

1. Opposer is informed and believes and therefore avers that UFirst Merchant Services LLC (hereinafter referred to as “Applicant”) is a New York limited liability company with an address of 150 Broadway, 3rd Floor, New York, NY 10038.

2. Applicant is not now and never was entitled to appropriate or register as a trademark the design of a Prancing Unicorn for which it seeks registration in Application Serial

No. 77/269,247, published in the Official Gazette of July 15, 2008 for the services set forth therein.

3. Applicant was not entitled to appropriate or register as a trademark a design of a Prancing Unicorn either on August 1, 2007, the claimed date of first use thereof, or on August 31, 2007, the date of the filing of its application for registration thereof, or on July 15, 2008, the date of the publication for opposition thereof in the Official Gazette.

4. Since long prior to August 1, 2007, Applicant's claimed date of first use, Opposer has been and now is engaged in the manufacture, or having manufactured for it, of high performance automobiles, parts and accessories therefor and the rendering of services which are advertised, offered for sale and sold in the United States under Opposer's trademarks and service marks including the design of a Prancing Horse (hereinafter Opposer's "Prancing Horse Design Mark") and the words PRANCING HORSE.

5. Since long prior to August 1, 2007, licensees of Opposer have been and now are engaged in production of items of various descriptions and the rendering of various services which are advertised, offered for sale and sold in the United States under its trademarks and services marks including the Prancing Horse Design Mark and the words PRANCING HORSE.

6. Opposer is the owner of the following registrations, among others, of its Prancing Horse Design Mark issued by the United States Patent and Trademark Office:

Reg. No.	Date of Issue	International Class
863434	January 14, 1969	Class 12
2,217,612	January 12, 1999	Class 25
2,294,171	November 23, 1999	Classes 3, 6; 14, 16, 18; and 28
2,655,307	December 3, 2002	Classes 35, 42

Reg. No.	Date of Issue	International Class
3,008,525	October 25, 2005	Class 9
3,083,368	April 18, 2006	Class 41
3,084,537	April 25, 2006	Class 12
3,334,822	November 13, 2007	Class 36
3,335,166	November 13, 2007	Class 36

7. Opposer is the owner of the following registration of the words PRANCING HORSE:

Reg. No.	Date of Issue	International Class
3,084,412	April 25, 2006	Classes 12, 25, 28, 37, 41, and 43

8. In Application Serial No. 77/269,247 Applicant seeks to register the design of a Prancing Unicorn as a service mark for “financial services, namely, electronic payment, electronic processing and transmission of bill payment and Financial services, namely, data credit and debit card transaction processing services; check verification, Financial guarantee and surety, and Foreign exchange transactions, electronic funds transfer services; Pre-paid purchase card services, namely, processing electronic payments made through prepaid cards; providing electronic processing of credit card transaction and electronic transmissions of bill payments via global computer network; accounts receivables financing; Consumer lending services; Financial services in the field of money lending; Financial services, namely, money lending; credit and cash card services; electronic credit card transactions; loan financing; loans financing and discount of bills; providing temporary loans; providing loans by commercial paper; business finance procurement services.”

GROUND I

9. Opposer repeats and reavers the averments of Paragraphs 1 through 8, inclusive, of this Notice of Opposition.

10. The design of a Prancing Unicorn as sought to be registered by Applicant so resembles Opposer's previously used and registered Prancing Horse Design Mark and PRANCING HORSE (words) marks as to be likely, when applied to the services of applicant, to cause confusion, or to cause mistake or to deceive.

GROUND TWO

11. Opposer repeats and reavers the averments of Paragraphs 1 through 8, inclusive, of this Notice of Opposition.

12. Opposer has used its Prancing Horse Design Mark as a trademark and service mark for more than forty years.

13. Opposer has widely advertised and promoted its Prancing Horse Design Mark as a trademark, and service mark.

14. As a result of the matters alleged in paragraphs 12 and 13 above, Opposer's Prancing Horse Design Mark had become, prior to the claimed first use date in Application Serial No. 77/269,247, and now is famous.

15. Use of the design of a Prancing Unicorn by Applicant in connection with the services covered by Application Serial No. 77/269,247 is likely to cause dilution by blurring.

WHEREFORE, Opposer prays that Application Serial No. 77/269,247 be rejected, and that registration of a design of a Prancing Unicorn as a service mark to Applicant be refused and denied.

Applicant hereby appoints Albert Robin and all other attorneys of Cowan, Liebowitz and Latman, P.C., 1133 Avenue of the Americas, New York, NY 10036, attorneys at law, to act as its

attorneys in the above-identified opposition, to prosecute this opposition, to transact all business in the United States Patent and Trademark Office and the United States Courts in connection with said opposition, and to sign their names to all documents which may hereinafter be filed in connection with said opposition and to receive all official communications relating to the same.

Please direct all correspondence to Albert Robin.

Dated: January 12, 2009

COWAN, LIEBOWITZ & LATMAN, P.C.

By: /s/ Albert Robin

Albert Robin

1133 Avenue of the Americas

New York, NY 10036-6799

(212) 790-9200

Attorneys for Opposer

CERTIFICATE OF SERVICE

A copy of the foregoing Notice of Opposition was served upon Applicant by sending copies by first class mail, postage prepaid, to Daniel B. Faizakoff,, attorney for Applicant, at Daniel B. Fazikoff, P.C., 150 Broadway, Floor 14, New York, NY 10038-4369 this 12th day of January, 2009.

/s/ Albert Robin

Albert Robin