

ESTTA Tracking number: **ESTTA355684**

Filing date: **06/30/2010**

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	A.T.X. International, Inc.
Granted to Date of previous extension	06/30/2010
Address	One Albion Rhode Lincoln, RI 02865 UNITED STATES

Correspondence information	Frank J. Colucci Attorney 218 East 50th Street New York, NY 10022 UNITED STATES scarsdale@colucci-umans.com
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Applicant Information

Application No	77705607	Publication date	03/02/2010
Opposition Filing Date	06/30/2010	Opposition Period Ends	06/30/2010
Applicant	BLACK FOREST ORIGINALS - GRANDFATHER CLOCKS, LTD. 116 South Oak Street La Crescent, MN 55947 UNITED STATES		

Goods/Services Affected by Opposition

Class 014. First Use: 2001/10/19 First Use In Commerce: 2001/10/19 All goods and services in the class are opposed, namely: Clocks

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.	2309518	Application Date	10/26/1995
Registration Date	01/18/2000	Foreign Priority Date	NONE
Word Mark	CROSS		

Design Mark	CROSS		
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 1997/09/00 First Use In Commerce: 1997/09/00 watches, clocks, horological and other chronometric instruments, namely, chronometers and chronographs for use as watches		

U.S. Registration No.	3051258	Application Date	08/11/2000
Registration Date	01/24/2006	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2002/01/31 First Use In Commerce: 2002/01/31 watches Class 016. First use: First Use: 2002/01/31 First Use In Commerce: 2002/01/31 writing instruments		

U.S. Registration No.	526855	Application Date	07/26/1948
Registration Date	06/27/1950	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U037 (International Class 016). First use: First Use: 1868/00/00 First Use In Commerce: 1868/00/00 MECHANICAL PENCILS		

U.S. Registration No.	641038	Application Date	10/03/1955
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Registration Date	02/05/1957	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U037 (International Class 016). First use: First Use: 1868/00/00 First Use In Commerce: 1868/00/00 MECHANICAL PENCILS AND FOUNTAIN PENS		

U.S. Registration No.	925913	Application Date	02/18/1971
Registration Date	12/21/1971	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U037 (International Class 016). First use: First Use: 1868/00/00 First Use In Commerce: 1868/00/00 PENS, PENCILS, BALLPOINT PEN REFILLS, ERASERS, WRITING LEADS AND PEN AND PENCIL CASES, AND DESK SETS		

U.S. Registration No.	3581603	Application Date	03/04/2002
Registration Date	02/24/2009	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/02/28 First Use In Commerce: 2005/02/28 sunglasses and cellular telephone cases Class 018. First use: First Use: 2005/05/31 First Use In Commerce: 2005/05/31 leather goods, namely, leather wallets and leather billfolds Class 020. First use: First Use: 2006/09/30 First Use In Commerce: 2006/09/30 picture frames		

U.S. Registration No.	3083365	Application Date	03/11/2002
Registration Date	04/18/2006	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2003/01/31 First Use In Commerce: 2003/01/31 PERSONAL DIGITAL ASSISTANT COVERS, AND HANDBAGS		

U.S. Registration	3077290	Application Date	05/06/2002
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No.			
Registration Date	04/04/2006	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/01/31 First Use In Commerce: 1999/01/31 RETAIL STORE SERVICES, MAIL ORDER CATALOG SERVICES, ONLINE RETAIL STORE SERVICES, AND RETAIL KIOSKS ALL FEATURING WRITING INSTRUMENTS AND ACCESSORIES, STYLUS TIPS, WATCHES AND PERSONAL ACCESSORIES, NAMELY, PORTFOLIOS, PERSONAL DIGITAL ASSISTANT CASES, STATIONARY SETS, AGENDA COVERS, PEN CASES, BUSINESS CARD CASES, LETTER OPENERS, MONEY CLIPS AND KEY RINGS		

U.S. Registration No.	3252193	Application Date	05/28/2002
Registration Date	06/12/2007	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/07/31 First Use In Commerce: 2006/07/31 eyewear, namely, sunglasses		

U.S. Registration No.	2996114	Application Date	05/28/2002
Registration Date	09/13/2005	Foreign Priority Date	NONE
Word Mark	CROSS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2004/09/00 First Use In Commerce: 2004/09/00 eyewear, namely, eyeglasses and eyeglass frames		

U.S. Registration No.	2926508	Application Date	11/13/2000
Registration Date	02/15/2005	Foreign Priority Date	NONE
Word Mark	C CROSS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2004/02/29 First Use In Commerce: 2004/02/29 computer hardware; computer input devices and peripherals; electronic digitizer pads and styli; pen implements for recording information and launching applications on a global or local computer information network; accessories for all of the foregoing, namely, computer mouse pads, personal digital assistant pens and refills, holders for electronic styli, replaceable tips for electronic styli, , tuck-away styli for personal digital assistant devices

U.S. Registration No.	2983461	Application Date	02/15/2001
Registration Date	08/09/2005	Foreign Priority Date	NONE
Word Mark	CROSS SIGNATURE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2005/05/31 First Use In Commerce: 2005/05/31 writing instruments		

U.S. Registration No.	3521624	Application Date	05/25/2007
Registration Date	10/21/2008	Foreign Priority Date	NONE
Word Mark	CROSS TOWN COMPUTER BAG COLLECTION		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 018. First use: First Use: 2007/09/30 First Use In Commerce: 2007/09/30 business tote bags

U.S. Registration No.	1864260	Application Date	10/22/1992
Registration Date	11/22/1994	Foreign Priority Date	NONE

Word Mark	CROSS TOWNSEND
Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1993/12/00 First Use In Commerce: 1993/12/00 writing instruments; namely, pens and pencils; ink refills and ink cartridges for pens and writing lead refills; pen nibs; and desk sets

Attachments	75010685#TMSN.gif (1 page)(bytes) 76108018#TMSN.gif (1 page)(bytes) 76164452#TMSN.gif (1 page)(bytes) 76211581#TMSN.gif (1 page)(bytes) 77190655#TMSN.jpeg (1 page)(bytes) la_crosse.pdf (6 pages)(178623 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	/frank j. colucci/
Name	Frank J. Colucci
Date	06/30/2010

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

In the Matter of Application Serial No. 77,705,607
Trademark LA CROSSE
Published in the *Official Gazette* on March 2, 2010

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A.T.X. INTERNATIONAL, INC., :
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 Opposer, : Opposition No.
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 v. :
 :
BLACK FOREST ORIGINALS – :
GRANDFATHER CLOCKS, LTD., :
 :
 Applicant. :
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NOTICE OF OPPOSITION

Opposer, A.T.X. INTERNATIONAL, INC., a Rhode Island corporation, having its principal office and place of business at One Albion Road, Lincoln, Rhode Island 02865, (herein "Opposer") believes that it will be damaged by registration of the application of BLACK FOREST ORIGINALS – GRANDFATHER CLOCKS, LTD., a Minnesota corporation, located at 116 South Oak Street, La Crescent, Minnesota 55947, (herein "Applicant"), namely, United States Application Serial No. 77/705,607 to register the mark LA CROSSE for clocks (herein "Applicant's Goods"), which was filed on April 2, 2009, published at page TM 490 of the *Official Gazette* of March 2, 2010 (Vol. 1352, No. 1) and hereby opposes the same. As grounds of opposition, Opposer avers:

1. Applicant is not now and never was entitled to register as a trademark the designation LA CROSSE for which it seeks registration in its United States Application Serial No. 77/705,607, filed on April 2, 2009, published at page TM

490 of the *Official Gazette* of March 2, 2010 (Vol. 1352, No. 1) for the goods set forth therein, namely, clocks in International Class 14.

2. Applicant was not entitled to use or register as a trademark the designation LA CROSSE for which it seeks registration in its United States Application Serial No. 77/705,607, either on April 2, 2009, the date of filing of said application, or on March 2, 2010, the date of publication thereof in the *Official Gazette* or on October 19, 2001 the date of first use.

3. Opposer, A.T.X International, Inc., is the owner of the trademarks and service marks, which are the subject of the following registrations and applications:

- a. United States Registration No. 2,309,518 of the mark CROSS in International Class 14;
- b. United States Registration No. 3,051,258 of the mark CROSS and Design in International Classes 14 and 16;
- c. United States Registration No. 526,855 of the mark CROSS in International Class 16;
- d. United States Registration No. 641,038 of the mark CROSS in International Class 16;
- e. United States Registration No. 925,913 of the mark CROSS in International Class 16;
- f. United States Registration No. 3,581,603 of the mark CROSS in International Classes 9, 18 and 20;
- g. United States Registration No. 3,083,365 of the mark CROSS in International Class 18;
- h. United States Registration No. 3,077,290 of the mark CROSS in International Class 35;
- i. United States Registration No. 3,252,193 of the mark CROSS in International Class 9;

- j. United States Registration No. 2,996,114 of the mark CROSS in International Class 9;
- k. United States Registration No. 2,926,508 of the mark C CROSS (Stylized) in International Class 9;
- l. United States Registration No. 2,983,461 of the mark CROSS SIGNATURE in International Class 16;
- m. United States Registration No. 3,521,624 of the mark CROSS TOWN COMPUTER BAG COLLECTION in International Class 18; and
- n. United States Registration No. 1,864,260 of the mark CROSS TOWNSEND in International Class 16.

4. Opposer's ownership of United States Registration Nos. 2,309,518 and 3,051,258 in International Class 14 as well as many of the other above CROSS trademarks (herein the "CROSS Marks") pre-date Applicant's filing date of April 2, 2009 and date of first use of October 19, 2001. Therefore, Opposer's CROSS Marks have priority over Applicant's claim to the designation LA CROSSE.

5. Long prior to Applicant's filing date of April 2, 2009 and date of first use of October 19, 2001, Opposer has been and now is engaged in the manufacture, advertising, offering for sale and sale of a wide variety of quality products, including watches and clocks, fine quality writing instruments and accessories, computer hardware and accessories, handbags, briefcases, portfolios, backpacks and leather accessories, eyewear, key rings and key fobs in interstate commerce throughout the United States.

6. Long prior to Applicant's filing date of April 2, 2009 and date of first use of October 19, 2001, Opposer has also been continuously and now is advertising, offering for sale and selling in interstate commerce throughout the United States the

aforesaid goods bearing the CROSS Marks. In addition to catalog sales and in-store kiosk sales, Opposer is the owner of the Internet website www.cross.com, which also sells Opposer's Goods under the CROSS Marks.

7. Upon the introduction of Opposer's aforesaid goods bearing the CROSS Marks upon the market and continuously thereafter, said CROSS Marks became and are now widely known and recognized by the public and the trade as the means by which such goods are distinguished, and their source and origin identified.

8. Applicant's designation LA CROSSE incorporates Opposer's well-known and famous CROSS mark. See *A.T. Cross Company v Jonathan Bradley Pens, Inc., et al*, 365 F. Supp. 356, 175 U.S.P.Q. 630 and *A. T. Cross Company v. TPM Distributing, Inc.* 1985 WL 72660 (D.Minn.), 226 U.S.P.Q. 521 holding that CROSS is a famous and well-known mark and has gained secondary meaning and has been in continuous use since 1868.

9. Applicant's adoption and use of the designation LA CROSSE is without license, permission or authorization of Opposer.

Count I - Likelihood of Confusion

10. Opposer repeats and reavers the averments set forth in paragraphs 1 through 9 inclusive of this Notice of Opposition as if more fully set forth herein again.

11. There are no restrictions on Applicant's Goods and/or the trade channels through which they may be sold. Applicant's Goods are identical to Opposer's Goods, will be sold to the same class of purchasers and will be offered for sale through

the same or similar channels of trade.

12. The designation Applicant seeks to register, namely, LA CROSSE, so resembles Opposer's CROSS Marks, as to be likely, when applied to Applicant's Goods, to cause confusion or mistake or to deceive persons by creating the erroneous impression that Applicant's Goods originate with, or come from the same source as Opposer's Goods and/or services, or are endorsed by, or are sponsored by, or are connected in some way with Opposer, and the registration thereof would be injurious to Opposer.

Count II - Dilution

13. Opposer repeats and reavers the averments set forth in paragraphs 1 through 9 inclusive of this Notice of Opposition as if more fully set forth herein again.

14. As a result of the extensive sales, as well as the extensive advertising and promotion of CROSS merchandise nationwide and because of the superior quality of such merchandise, the trademark, trade name and service mark CROSS has become a well-known and famous mark, representing goodwill of inestimable value to Opposer.

15. Applicant's use and registration of the designation LA CROSSE is likely to, and will dilute, blur, erode and/or tarnish the distinctiveness of Opposer's famous CROSS Marks, and/or damage the goodwill associated with the CROSS Marks.

WHEREFORE, Opposer, A.T.X. International, Inc., prays that said Application Serial No. 77/705,607 be rejected and registration of the designation LA CROSSE as a trademark to applicant be refused and denied, and that its Opposition be sustained and/or the Board grant to Opposer such other and/or further relief as the

Board may deem just and proper under the circumstances.

Dated: New York, New York
June 30, 2010

Respectfully submitted,

COLUCCI & UMANS

By Frank J. Colucci / snc /

Frank J. Colucci
Attorneys for Opposer
218 East 50th Street
New York, New York 10022
(212) 935-5700

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing "Notice of Opposition" has been forwarded via First Class Mail, Postage Prepaid, to Applicant, Black Forest Originals – Grandfather Clocks, Ltd., 116 South Oak Street, La Crescent, Minnesota, 55947 and its attorney, Michael T. Olson, Esq., Winthrop & Weinstine, 225 S. 6th Street, Suite 3500, Minneapolis, MN 55402-4629 this 30th day of June 30, 2010.

Georgann M. Callaghan