

ESTTA Tracking number: **ESTTA379836**

Filing date: **11/22/2010**

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	Direct Line Insurance plc
Granted to Date of previous extension	11/21/2010
Address	3 Edridge Road Croydon, Surrey, CR9 1AG UNITED KINGDOM
Attorney information	James A. Thomas Troutman Sanders LLP 434 Fayetteville Street, Suite 1900 Raleigh, NC 27601 UNITED STATES trademarks@troutmansanders.com,james.thomas@troutmansanders.com Phone:919-835-4181

**Applicant Information**

Application No	77934856	Publication date	05/25/2010
Opposition Filing Date	11/22/2010	Opposition Period Ends	11/21/2010
Applicant	Nationwide Mutual Insurance Company Office of General Counsel 1-35-204 One Nationwide Plaza Columbus, OH 43215 UNITED STATES		

**Goods/Services Affected by Opposition**

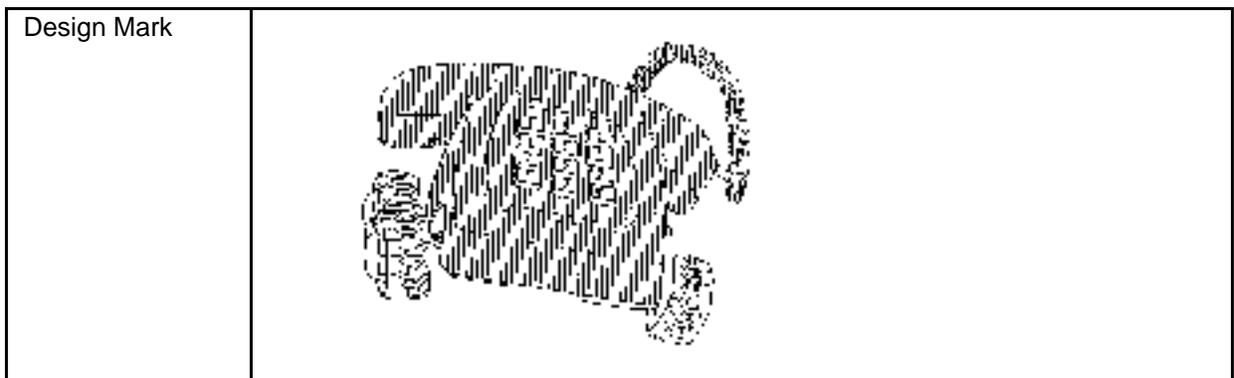
Class 036. First Use: 2009/08/17 First Use In Commerce: 2009/08/17 All goods and services in the class are opposed, namely: Insurance services, namely, administration, brokerage, and underwriting for all types of insurance; insurance claims administration and claims processing services; insurance agency services
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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.	2374626	Application Date	02/11/1999
Registration Date	08/08/2000	Foreign Priority Date	NONE
Word Mark	NONE		



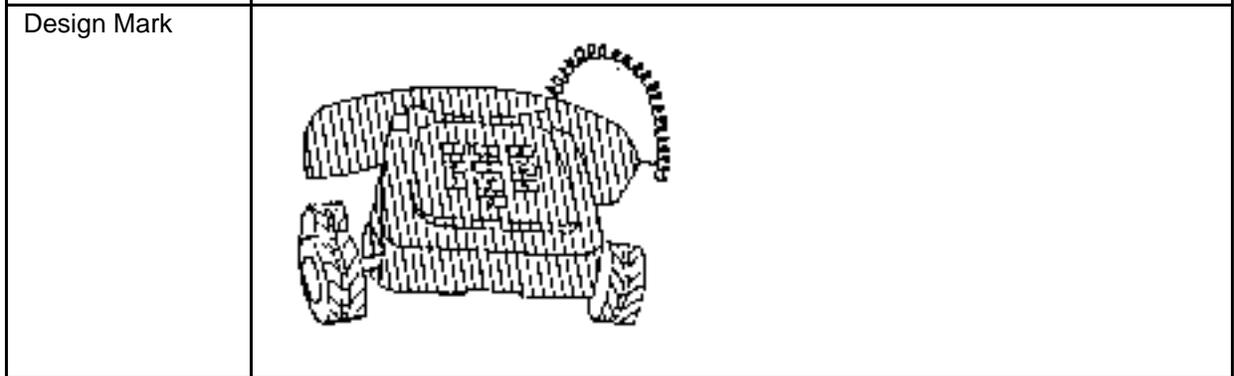
Description of Mark	NONE
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Goods/Services	<p>Class 036. First use: First Use: 1997/10/15 First Use In Commerce: 1997/10/15 SERVICES RELATING TO INSURANCE, NAMELY, ADMINISTRATION, CLAIMS PROCESSING AND UNDERWRITING AUTOMOTIVE, [LIFE, FIRE, HOMEOWNER;] [TRAVEL] [AND HEALTH][ INSURANCE; FOR FINANCIAL SERVICES, NAMELY,] [CHARGE CARDS AND CREDIT CARD SERVICES, CORPORATE FINANCING; CREDIT SERVICES, NAMELY, CREDIT INQUIRY AND CONSULTATION; DEBIT CARD SERVICES, DEBT COLLECTION AND DEBT RECOVERY SERVICES, FINANCIAL EXCHANGE SERVICES, MUTUAL FUND INVESTMENT, HIRE PURCHASE FINANCING, INSTALLMENT LOAN FINANCING; INVESTMENT SERVICES, NAMELY, INVESTMENT ADVICE, INVESTMENT CONSULTATION, INVESTMENT MANAGEMENT AND INVESTMENT FUNDS; LEASE PURCHASE FINANCING, LOAN SERVICES, NAMELY, LOAN ADVICE AND LOAN FINANCING SERVICES; FINANCIAL MANAGEMENT SERVICES, MERCHANT BANKING SERVICES, MORTGAGE SERVICES, NAMELY, MORTGAGE BANKING AND LENDING; MUTUAL FUND SERVICES NAMELY, INVESTMENT AND DISTRIBUTION; FINANCIAL PORTFOLIO MANAGEMENT SERVICES, REAL ESTATE MANAGEMENT, SAFETY DEPOSIT BOX SERVICES, SAVINGS ACCOUNT SERVICES, namely, PROVISION OF SAVINGS ACCOUNTS AND SAVING ADVICE; SAVING BANK SERVICES, SHARE DEALING AND SHARE UNDERWRITING SERVICES, NAMELY, SHARE BROKERAGE SERVICES; ISSUING TRAVELERS CHECKS]</p>
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U.S. Registration No.	2206353	Application Date	07/15/1996
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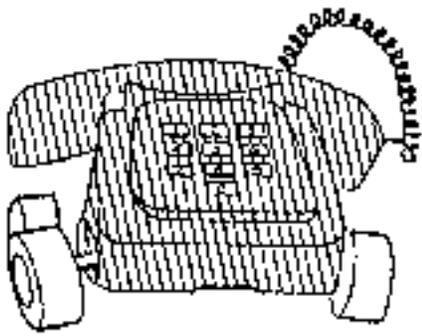
Registration Date	12/01/1998	Foreign Priority Date	NONE
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Word Mark	NONE
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Description of Mark	NONE
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Goods/Services	Class 036. First use: financial services relating to insurance, namely, administration, claims processing and underwriting automotive, life, fire, homeowners and health insurance[]; banking services, charge cards and credit card services, corporate financing, credit services, namely, credit inquiry and consultation; debit card services, debt collection and debt recovery services, financial exchange services, mutual fund investment, hire purchase financing, installment loan financing, investment services, namely, investment advice, investment consultation, investment management and investment funds; lease purchase financing, loan services, namely, loan advice and loan financing services; financial management services, merchant banking services, mortgage services, namely, mortgage banking and lending; mutual fund services, namely, investment and distribution; financial portfolio management services, real estate management, safety deposit box services, savings account services, namely, provision of savings accounts and saving advice; saving bank services, share dealing and share underwriting services, namely, share brokerage services; issuing travelers checks; life insurance services, namely, underwriting life insurance policies; foreign currency services, namely, foreign currency exchange services; automated teller machine services]
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U.S. Registration No.	2151775	Application Date	07/15/1996
Registration Date	04/21/1998	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: [ non-encoded bank cards; ] stationery; paper, namely, note paper and computer paper; publications and other printed matter, namely, pamphlets, brochures, newsletters, [ journals, magazines ] in the insurance/risk-management field [ and denominated travelers checks for sale to the public ]		

Attachments	75639627#TMSN.gif ( 1 page )( bytes ) 75134042#TMSN.gif ( 1 page )( bytes ) 75133658#TMSN.gif ( 1 page )( bytes ) Notice of Opposition_Nationwide.pdf ( 15 pages )(234692 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	/James A. Thomas/
Name	James A. Thomas
Date	11/22/2010

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

In the matter of Application Serial Number 77934856

Published: May 25, 2010

DIRECT LINE INSURANCE PLC	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. _____
	)	
NATIONWIDE MUTUAL INSURANCE COMPANY	)	
	)	
Applicant.	)	
	)	

**NOTICE OF OPPOSITION**

DIRECT LINE INSURANCE PLC (hereinafter “Opposer”), a corporation organized and existing under the laws of United Kingdom and having a principal place of business at 3 Edridge Road Croydon, Surrey, CR9 1AG, United Kingdom, believes that it is and will be damaged by registration of the mark shown in application Serial No. 77934856 in International Class 36 and hereby opposes such registration.

The Opposition is based on 15 U.S.C. § 1063(a) and the grounds for the Petition are as follows:

1. Applicant Nationwide Mutual Insurance Company (hereinafter “Applicant”), a corporation organized and existing under the laws of the State of Ohio and having a principal place of business at One Nationwide Plaza, Columbus, OH 43215, seeks to register the following mark:



(hereinafter referred to as “the Opposed Mark”) as a service mark for “insurance services, namely, administration, brokerage, and underwriting for all types of insurance; insurance claims administration and claims processing services; insurance agency services” in International Class 36 (hereinafter “Applicant’s Services”) as evidenced by publication of the Opposed Mark on May 25, 2010.

2. There is no issue as to priority. Upon information and belief, Applicant acquired no rights in the Opposed Mark in the United States prior to August 17, 2009, the date of first use claimed by Applicant in its application for the Opposed Mark filed in the U.S. Patent and Trademark Office (“USPTO”).

3. Direct Line Insurance plc owns the following registrations with the USPTO (hereinafter “Opposer’s Marks”):

Mark	Ser/Reg. Nos.	Filing/Reg. Dates	Goods and Services
	Ser. No. 75639627 Reg. No. 2374626	Filed: Feb. 11, 1999 Reg.: Aug. 8, 2000	Int’l Class 36: services relating to insurance, namely, administration, claims processing and underwriting automotive
	Ser. No. 75134042 Reg. No. 2206353	Filed: July 15, 1996 Reg.: Dec. 1, 1998	Int’l Class 36: financial services relating to insurance, namely, administration, claims processing and underwriting automotive, life, fire, homeowners and health insurance
	Ser. No. 75133658 Reg. No. 2151775	Filed: July 15, 1996 Reg.: 2151775	Int’l Class 16: stationery; paper, namely, note paper and computer paper; publications and other printed matter, namely, pamphlets, brochures,

			newsletters, in the insurance/risk-management field
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(The drawings of the marks are lined for the color red.) (copies attached.)

4. Use of Opposer’s Marks is in commerce on or in connection with their respective goods and/or services as identified above (“Opposer’s Goods and/or Services”). Use of Opposer’s Mark is current and has been valid and continuous since the date of first use of Opposer’s Mark.

5. Opposer may have pre-registration rights in Opposer’s Mark that will be damaged if registration of Applicant’s Mark is allowed.

6. The Opposed Mark and Opposer’s Marks are used in connection with goods and/or services that are the same and/or related.

7. The Opposed Mark is very similar to Opposer’s Marks in that the Opposed Mark and Opposer’s Marks all consist of the drawing of a telephone.

8. On information and belief, Applicant’s Services will be marketed to overlapping potential purchasers in both the insurance community and the general public as Opposer’s Goods and/or Services. Additionally, upon information and belief, Applicant’s Services marketed under the Opposed Mark will be distributed through the same channels of distribution.

9. If Applicant were permitted to register the Opposed Mark for Applicant’s Services, confusion among insurance providers and members of the general public would result by reason of the following: (a) the substantial visual and conceptual similarity of the Opposed Mark and Opposer’s Marks, (b) the overlapping nature of Applicant’s Services and Opposer’s Goods and/or Services marketed and sold under such marks, and (c) the common channels of trade and distribution and classes of customers for Applicant’s Services under the Opposed Mark and Opposer’s Goods and/or Services under Opposer’s Marks.

10. Insurance providers and members of the general public who are familiar with Opposer's Goods and/or Services sold under Opposer's Marks would believe that Applicant's Services available under the Opposed Mark were, contrary to fact, associated with, endorsed by, related to, or actually the services of Opposer. Any fault or defect in Applicant's Services would reflect upon and seriously injure Opposer's reputation. Furthermore, insurance providers and members of the general public who are familiar with Opposer's Marks would confuse the same with the Opposed Mark and might purchase Applicant's Services in the mistaken belief that they are purchasing the services of Opposer. This confusion would damage Opposer's revenue and income.

11. If registration of the Opposed Mark were granted, Applicant would be placed in a position to harass and cause annoyance to the public as the registration would give the Applicant *prima facie* exclusive rights to the Opposed Mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

12. As a result of the substantial similarity in appearance between the Opposed Mark and Opposer's Marks, the overlapping and related nature of the services of Applicant and the goods and services of Opposer, and the fact that such goods and/or services are or are intended to be sold in common channels of commerce and directed to similar or common classes of customers, registration of the Opposed Mark is causing and will cause damage and injury to Opposer.

13. The Opposed Mark consists of a mark that so resembles Opposer's Marks that it is likely, when used in connection with the services of Applicant, to cause confusion, to cause a mistake, or to deceive. Registration of the Opposed Mark is, therefore, barred under 15 U.S.C. § 1052(d).

14. Opposer prays that said Application Serial No. 77934856 be rejected and that the registration of the mark therein shown for the services therein specified be refused and denied. In addition, Opposer prays for such further or alternative relief as the Board may find appropriate.

This Notice of Opposition is herewith submitted together with the filing fee in the amount of \$300.00

Respectfully submitted this 22<sup>nd</sup> the day of November, 2010.

**TROUTMAN SANDERS LLP**

By: /James A. Thomas/  
James A. Thomas  
N.C. Bar No. 14333  
Attorney for Opposer Direct Line Insurance plc  
Troutman Sanders LLP  
434 Fayetteville Street, Suite 1900  
P.O. Drawer 1389  
Raleigh, North Carolina 27601  
Telephone: 919-835-4184  
Facsimile: 919-829-8741

**CERTIFICATE OF SERVICE**

I hereby certify that on this 22<sup>nd</sup> day of November 2010, a true and correct copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on Applicant at the below listed address:

Scott W. Linek  
Nationwide Mutual Insurance Company  
1 Nationwide Plaza  
Office of General Counsel 1 35 204  
Colombus, OH 43215

/James A. Thomas/  
\_\_\_\_\_  
James A. Thomas  
Attorney for Opposer

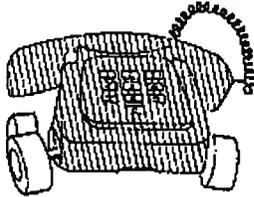
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-11-22 14:30:00 ET

Serial Number: 75133658 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2151775

**Mark**



**Standard Character claim:** No

**Current Status:** This registration has been renewed.

**Date of Status:** 2008-05-13

**Filing Date:** 1996-07-15

**Transformed into a National Application:** No

**Registration Date:** 1998-04-21

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

**Current Location:** 830 -Post Registration

**Date In Location:** 2008-05-13

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Direct Line Insurance Plc

**Address:**

Direct Line Insurance Plc  
3 Edridge Road  
Croydon, Surrey, CR9 1AG  
United Kingdom

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** United Kingdom

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**GOODS AND/OR SERVICES**

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**International Class:** 016

**Class Status:** Active

stationery; paper, namely, note paper and computer paper; publications and other printed matter, namely, pamphlets, brochures, newsletters, in the insurance/risk-management field

**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION**

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**Lining and Stippling:** The drawing is lined for the color red and red is claimed as a feature of the telephone design.

**Design Search Code(s):**

16.01.08 - Telephones

**Foreign Registration Number:** 2000702**Foreign Registration Date:** 1994-10-31**Country:** United Kingdom**Foreign Expiration Date:** 2004-10-31

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2008-05-13 - First renewal 10 year  
2008-05-13 - Section 8 (10-year) accepted/ Section 9 granted  
2008-05-06 - Assigned To Paralegal  
2008-04-21 - TEAS Section 8 & 9 Received  
2007-11-07 - TEAS Change Of Correspondence Received  
2007-05-08 - Case File In TICRS  
2006-05-23 - TEAS Change Of Correspondence Received  
2004-06-15 - Section 8 (6-year) accepted & Section 15 acknowledged  
2004-05-06 - Section 8 (6-year) and Section 15 Filed  
2002-08-20 - TEAS Change Of Correspondence Received  
1998-04-21 - Registered - Principal Register  
1998-01-27 - Published for opposition  
1997-12-26 - Notice of publication  
1997-09-27 - Approved for Pub - Principal Register (Initial exam)  
1997-09-08 - Communication received from applicant

1997-03-03 - Non-final action mailed

1997-01-27 - Assigned To Examiner

1997-01-07 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

James A. Thomas

**Correspondent**

James A. Thomas

Troutman Sanders LLP

434 Fayetteville Street

Two Hannover Square, Suite 1900

Raleigh NC 27601

Phone Number: (919) 835.4100

Fax Number: (919) 835.4101

**Domestic Representative**

James A. Thomas

Phone Number: (919) 835.4100

Fax Number: (919) 835.4101

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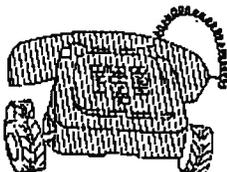
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-11-22 14:30:25 ET

Serial Number: 75134042 Assignment Information      Trademark Document Retrieval

Registration Number: 2206353

Mark



Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2008-12-06

Filing Date: 1996-07-15

Transformed into a National Application: No

Registration Date: 1998-12-01

Register: Principal

Law Office Assigned: LAW OFFICE 102

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2008-12-06

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. Direct Line Insurance Plc

**Address:**

Direct Line Insurance Plc  
3 Edridge Road  
Croydon, Surrey, CR9 1AG  
United Kingdom

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** United Kingdom

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**GOODS AND/OR SERVICES**

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**International Class:** 036

**Class Status:** Active

financial services relating to insurance, namely, administration, claims processing and underwriting automotive, life, fire, homeowners and health insurance

**Basis:** 44(e)**First Use Date:** (DATE NOT AVAILABLE)**First Use in Commerce Date:** (DATE NOT AVAILABLE)

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**ADDITIONAL INFORMATION**

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**Lining and Stippling:** The telephone design in the drawing is lined for the color red as indicated.

**Design Search Code(s):**

16.01.08 - Telephones

18.11.01 - Inner tubes; Tire marks; Tires; Tubes, tire

**Foreign Registration Number:** 1528859**Foreign Registration Date:** 1994-12-02**Country:** United Kingdom**Foreign Expiration Date:** 2000-03-05

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-12-06 - First renewal 10 year

2008-12-06 - Section 8 (10-year) accepted/ Section 9 granted

2008-12-06 - Assigned To Paralegal

2008-11-25 - TEAS Section 8 &amp; 9 Received

2007-11-07 - TEAS Change Of Correspondence Received

2005-06-06 - Section 8 (6-year) accepted &amp; Section 15 acknowledged

2005-04-29 - Section 8 (6-year) and Section 15 Filed

2005-04-29 - TEAS Section 8 &amp; 15 Received

2002-08-20 - TEAS Change Of Correspondence Received

1998-12-01 - Registered - Principal Register

1998-09-08 - Published for opposition

1998-08-07 - Notice of publication

1998-05-26 - Approved for Pub - Principal Register (Initial exam)

1998-02-23 - Communication received from applicant

1997-08-22 - Final refusal mailed

1997-07-03 - Communication received from applicant

1997-01-06 - Non-final action mailed

1996-10-30 - Assigned To Examiner

1996-10-10 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

JAMES A. THOMAS

**Correspondent**

JAMES A. THOMAS

Troutman Sanders LLP

Two Hannover Square, Suite 1900

434 Fayetteville Street

Raleigh NC 27601

Phone Number: (919) 835.4100

Fax Number: (919) 829.8741

**Domestic Representative**

JAMES A THOMAS

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-11-22 14:30:49 ET

Serial Number: 75639627 [Assignment Information](#)      [Trademark Document Retrieval](#)

Registration Number: 2374626

Mark



Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2010-07-30

Filing Date: 1999-02-11

Transformed into a National Application: No

Registration Date: 2000-08-08

Register: Principal

Law Office Assigned: LAW OFFICE 113

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: (NOT AVAILABLE)

Date In Location: 2010-07-30

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. Direct Line Insurance plc

**Address:**

Direct Line Insurance plc  
3 Edridge Road  
Croydon, Surrey, CR9 1AG  
United Kingdom

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** United Kingdom

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**GOODS AND/OR SERVICES**

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**International Class:** 036

**Class Status:** Active

SERVICES RELATING TO INSURANCE, NAMELY, ADMINISTRATION, CLAIMS PROCESSING AND UNDERWRITING AUTOMOTIVE

**Basis:** 1(a)**First Use Date:** 1997-10-15**First Use in Commerce Date:** 1997-10-15

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**ADDITIONAL INFORMATION**

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**Lining and Stippling:** The lines of the mark in the drawing are a feature of the mark and are intended to indicate the color red.

**Design Search Code(s):**

15.07.25 - Casters, wheels; Hubcaps; Wheels (without spokes); Wheels with tires

16.01.08 - Telephones

**Prior Registration Number(s):**

2151775

2176035

2206353

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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**NOTE:** To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-07-30 - First renewal 10 year

2010-07-30 - Section 8 (10-year) accepted/ Section 9 granted

2010-07-29 - Case Assigned To Post Registration Paralegal

2010-07-28 - TEAS Section 8 &amp; 9 Received

2008-11-11 - Notice Of Design Search Code Mailed

2007-11-07 - TEAS Change Of Correspondence Received

2006-11-26 - Section 8 (6-year) accepted &amp; Section 15 acknowledged

2006-10-11 - Assigned To Paralegal

2006-08-04 - Section 8 (6-year) and Section 15 Filed

2006-08-04 - TEAS Section 8 &amp; 15 Received

2006-05-23 - TEAS Change Of Correspondence Received

2006-02-28 - Case File In TICRS

2005-06-28 - Attorney Revoked And/Or Appointed

2005-06-28 - TEAS Revoke/Appoint Attorney Received

2002-08-20 - TEAS Change Of Correspondence Received  
2000-08-08 - Registered - Principal Register  
2000-05-16 - Published for opposition  
2000-04-14 - Notice of publication  
2000-03-01 - Approved for Pub - Principal Register (Initial exam)  
2000-01-31 - Communication received from applicant  
1999-08-10 - Non-final action mailed  
1999-07-30 - Assigned To Examiner  
1999-07-28 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**  
JAMES A. THOMAS

**Correspondent**  
James A. Thomas  
Troutman Sanders LLP  
Suite 1900  
434 Fayetteville Street  
Raleigh NC 27601  
Phone Number: (919) 835.4100  
Fax Number: (919) 829.8741

**Domestic Representative**  
JAMES A. THOMAS  
Phone Number: (212) 850-6220  
Fax Number: (212) 850-6221

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