

ESTTA Tracking number: **ESTTA424146**

Filing date: **08/09/2011**

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	AUTOZONE PARTS, INC.		
Entity	Corporation	Citizenship	Nevada
Address	123 South Front Street Memphis, TN 38103 UNITED STATES		

Attorney information	Kathryn W. Bina ALSTON & BIRD LLP 1201 West Peachtree Street Atlanta, GA 30309 UNITED STATES kitty.bina@alston.com Phone:404-881-7000		
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Applicant Information

Application No	79093764	Publication date	07/12/2011
Opposition Filing Date	08/09/2011	Opposition Period Ends	08/11/2011
International Registration No.	1067669	International Registration Date	01/12/2011
Applicant	Federal-Mogul Burscheid GmbH BÄ¼rgermeister-Schmidt-Strasse 17 51399 Burscheid GERMANY		

Goods/Services Affected by Opposition

Class 006. All goods and services in the class are opposed, namely: Steel castings, steel alloys
Class 007. All goods and services in the class are opposed, namely: Piston rings, cylinder liners as parts for internal combustion engines, cylinders for motors

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.	1467999	Application Date	11/04/1986
Registration Date	12/08/1987	Foreign Priority Date	NONE

Word Mark	DURALAST
Design Mark	
Description of Mark	NONE
Goods/Services	Class 007. First use: First Use: 1986/07/09 First Use In Commerce: 1986/07/09 AUTOMOTIVE ALTERNATORS Class 012. First use: First Use: 1986/07/09 First Use In Commerce: 1986/07/09 AUTOMOTIVE STARTERS

U.S. Registration No.	1607305	Application Date	10/05/1989
Registration Date	07/24/1990	Foreign Priority Date	NONE
Word Mark	DURALAST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1989/07/15 First Use In Commerce: 1989/07/15 AUTOMOTIVE BATTERIES Class 012. First use: First Use: 1989/04/28 First Use In Commerce: 1989/04/28 BRAKE SHOES AND BRAKE PADS FOR VEHICLES		

U.S. Registration No.	3567993	Application Date	07/07/2003
Registration Date	01/27/2009	Foreign Priority Date	NONE
Word Mark	DURALAST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 008. First use: First Use: 2003/12/31 First Use In Commerce: 2003/12/31 HAND TOOLS, NAMELY, WRENCHES, RATCHET WRENCHES AND ATTACHMENTS THEREFOR, SOCKET WRENCHES, SOCKET SETS, PLIERS, SCREWDRIVERS, EXCEPT FOR THOSE SPECIFICALLY DESIGNED AND INTENDED FOR USE IN ROOFING APPLICATIONS		

U.S. Registration No.	3474541	Application Date	11/14/2006
Registration Date	07/29/2008	Foreign Priority Date	NONE
Word Mark	DURALAST		

Design Mark	<h1>DURALAST</h1>
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Description of Mark	NONE
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Goods/Services	<p>Class 006. First use: First Use: 2005/09/00 First Use In Commerce: 2005/09/00 Metal tool boxes except for those specifically designed and intended for use in roofing applications</p> <p>Class 007. First use: First Use: 2004/12/00 First Use In Commerce: 2004/12/00 Ignition components, namely, ignition wires and coil on spark plug insulators for land vehicles; distributor caps, water pumps, all for land vehicles; spark plugs, and timing belts for engines for land vehicles</p> <p>Class 008. First use: First Use: 2006/09/00 First Use In Commerce: 2006/09/00 Stands for hand jacks</p> <p>Class 009. First use: First Use: 2004/11/00 First Use In Commerce: 2004/11/00 Battery cables; battery terminal protectors; marine batteries; thermostats for motors and engines; oxygen sensors for motors and engines; Washers made of felt specially adapted for use with car batteries</p> <p>Class 012. First use: First Use: 2005/01/00 First Use In Commerce: 2005/01/00 Vehicle parts, namely, ball joints, idler arms, king pins, chassis, gears, universal joints, control arms, tie rods ends, bushings, drag links, CV axles, and master cylinders; brake drums; brake rotors for land vehicles; clutch discs for land vehicles, clutch sets for land vehicles composed of clutch disc, pressure plate, release bearing, pilot bushing/bearing and alignment tool; control arm shaft kits for suspensions for vehicles consisting of a control arm shaft, control arm bushings, and nuts; land vehicle suspension parts, namely, torsion/sway bars, coil springs, shock absorbers, and stabilizer links; V belts for land vehicle transmissions; multi V belts for land vehicle transmissions; universal joints for land vehicles; windshield wiper blades, all for land vehicles</p>
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U.S. Registration No.	2763813	Application Date	07/25/2002
Registration Date	09/16/2003	Foreign Priority Date	NONE

Word Mark	DURALAST GOLD
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Design Mark	<h2>DURALAST GOLD</h2>
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Description of Mark	NONE
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Goods/Services	Class 007. First use: First Use: 1996/01/00 First Use In Commerce: 1996/01/00 AUTOMOTIVE ALTERNATORS
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	Class 009. First use: First Use: 1996/01/00 First Use In Commerce: 1996/01/00 AUTOMOTIVE BATTERIES		
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U.S. Registration No.	3193473	Application Date	02/24/2006
Registration Date	01/02/2007	Foreign Priority Date	NONE
Word Mark	DURALAST GOLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 007. First use: First Use: 2004/12/00 First Use In Commerce: 2004/12/00 Starters for automotive motors and engines; land vehicle parts for internal combustion engines, namely, distributor caps and rotors</p> <p>Class 009. First use: First Use: 2004/12/00 First Use In Commerce: 2004/12/00 battery cables and battery terminal protectors</p> <p>Class 012. First use: First Use: 2004/11/00 First Use In Commerce: 2004/11/00 Brake pads for land vehicles</p>		

U.S. Registration No.	3165011	Application Date	10/10/2005
Registration Date	10/31/2006	Foreign Priority Date	NONE
Word Mark	DURALAST PROFESSIONAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/05/08 First Use In Commerce: 2005/05/08 automotive batteries		

U.S. Registration	3729117	Application Date	02/19/2008
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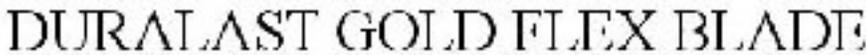
No.			
Registration Date	12/22/2009	Foreign Priority Date	NONE
Word Mark	DURALAST GOLD CMAX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2008/06/30 First Use In Commerce: 2008/06/30 Brake pads for land vehicles		

U.S. Registration No.	3899016	Application Date	01/27/2010
Registration Date	01/04/2011	Foreign Priority Date	NONE
Word Mark	DURALAST FLEX BLADE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2009/08/00 First Use In Commerce: 2009/08/00 windshield wiper blades		

U.S. Registration No.	3960460	Application Date	01/25/2010
Registration Date	05/17/2011	Foreign Priority Date	NONE
Word Mark	DURALAST PROVEN TOUGH		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 007. First use: First Use: 2009/11/00 First Use In Commerce: 2009/11/00 automotive cooling system parts, namely, water pumps Class 009. First use: First Use: 2008/10/00 First Use In Commerce: 2008/10/00 batteries; and automotive cooling system parts, namely, thermostats Class 012. First use: First Use: 2009/09/01 First Use In Commerce: 2009/09/01 automotive chassis and suspension parts, namely, ball joints, bushings, coil springs, control arms, idler arms, pitman arms, tie rod ends, king pins, center links, track bars, leaf springs, trailing arms, tie rod adjusting sleeves, sway bars and sway bar kits, comprised of rods and bushings

U.S. Application No.	85057394	Application Date	06/08/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DURALAST PLATINUM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2010/08/14 First Use In Commerce: 2010/08/14 automotive batteries		

U.S. Application No.	85347021	Application Date	06/15/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	DURALAST GOLD FLEX BLADE		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 012. First use: Windshield wiper blades
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Attachments	76527959#TMSN.gif (1 page)(bytes) 77043594#TMSN.jpeg (1 page)(bytes) 76435454#TMSN.gif (1 page)(bytes) 78822536#TMSN.jpeg (1 page)(bytes) 78729635#TMSN.jpeg (1 page)(bytes) 77400370#TMSN.jpeg (1 page)(bytes) 77921341#TMSN.jpeg (1 page)(bytes) 77919289#TMSN.jpeg (1 page)(bytes) 85057394#TMSN.jpeg (1 page)(bytes) 85347021#TMSN.jpeg (1 page)(bytes) Notice of Opposition DUROCAST.pdf (8 pages)(139243 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 Overnight Courier on this date.

Signature	/Kathryn W. Bina/
Name	Kathryn W. Bina
Date	08/09/2011

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

In the Matter of U.S. Application Serial No. 79/093,764
Mark: DUROCAST

AUTOZONE PARTS, INC.)	
)	
Opposer,)	Opposition No.
)	
vs.)	_____
)	
FEDERAL-MOGUL BURSCHEID GMBH)	
)	
Applicant.)	
)	
_____)	

NOTICE OF OPPOSITION

Opposer AutoZone Parts, Inc., a Nevada corporation, having its principal place of business at 123 S. Front Street, Memphis, Tennessee 38103, will be damaged by registration of Application Serial No. 79/093,764 (the “Application”) and hereby opposes such registration.

The grounds for the opposition are as follows:

AutoZone’s Business and DURALAST Marks

1. Opposer, through its affiliates (collectively “AutoZone”), is the leading retailer of automotive parts and accessories in the United States, with more than 4,600 retail stores in the United States, Puerto Rico and Mexico. AutoZone also provides online retail sales through a website located at the domain name <autozone.com>.
2. AutoZone sells its goods and services directly to general consumers, as well as to automotive repair professionals.
3. Since 1986, has used the trademark DURALAST in interstate commerce in connection with the sale of a wide variety of automotive parts and accessories.

4. AutoZone has for years also used a number of other marks that include the distinctive DURALAST mark in connection with the sale in interstate commerce of automotive parts and accessories, including the marks DURALAST GOLD, DURALAST PROFESSIONAL, DURALAST GOLD CMAX, DURALAST FLEX BLADE, DURALAST PROVEN TOUGH, and DURALAST PLATINUM (collectively the “DURALAST Marks”). AutoZone therefore owns a family of DURALAST marks.

5. AutoZone has spent millions of dollars over the years promoting and marketing its goods under the DURALAST Marks. As a result of these efforts, the DURALAST Marks are famous in the United States, and serve in the minds of consumers to identify AutoZone’s goods, services and goodwill alone.

6. In recognition of AutoZone’s exclusive rights, the U.S. Patent and Trademark Office has issued AutoZone ten registrations for its DURALAST Marks and has issued a notice of allowance for an eleventh mark. A complete list of AutoZone registrations and pending applications for the DURALAST Marks is set forth in Exhibit A hereto.

7. AutoZone’s registrations for its DURALAST Marks are valid and subsisting in law, were duly and legally issued, constitute *prima facie* evidence of the validity of the marks registered, and constitute constructive notice of ownership of the marks by AutoZone in accordance with Sections 7(b) and 22 of the Trademark Act of 1946, 15 U.S.C. §§ 1057(b) and 1072.

8. Registration Nos. 1,467,999 and 1,607,305 for the mark DURALAST, and Reg. No. 2,763,813 for the mark DURALAST GOLD, are incontestable pursuant to Section 15 of the Trademark Act of 1946, 15 U.S.C. §§ 1065, and, pursuant to Section 33(b) of the Act, 15, U.S.C.

§ 1115(b), constitute conclusive evidence of AutoZone's exclusive right to use the marks DURALAST and DURALAST GOLD in commerce in the United States.

Applicant's DUROCAST Application

9. On January 12, 2011, Federal-Mogul Burscheid GmbH ("Federal-Mogul") filed U.S. Trademark Application Serial No. 79/093,764, to register the mark DUROCAST for "Steel castings, steel alloys" in International Class 6 and "Piston rings, cylinder liners, cylinder for motors" in International Class 7 (the "Application").

10. On May 16, 2011, Federal-Mogul amended the description of goods in International Class 7 to specify the types of cylinder liners as "cylinder liners as parts for internal combustion engines."

11. Federal-Mogul's DUROCAST mark is confusingly similar to AutoZone's DURALAST Marks, and Federal-Mogul seeks registration for its mark in connection with goods that are closely related to goods for which AutoZone uses and has registered its DURALAST Marks.

12. Federal-Mogul's mark, when used in connection with the goods identified in the Application, is likely to mislead or deceive consumers into believing that Federal-Mogul's goods originate from AutoZone, that AutoZone and Federal-Mogul are associated or affiliated with one another, and/or that AutoZone sponsors or endorses Federal-Mogul or its goods. Federal-Mogul's mark thus infringes AutoZone's famous DURALAST Marks in violation of Sections 32(1) and 43(a) of the federal Lanham Act, 15 U.S.C. §§ 1114(1) and 43(a).

13. Applicant's DUROCAST mark is also likely to dilute the distinctive quality of AutoZone's famous DURALAST Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

14. For the reasons stated above, AutoZone will be damaged by the registration of the DUROCAST mark as sought in the Application.

WHEREFORE, AutoZone prays that Federal-Mogul's Application be denied and that this Opposition be sustained in AutoZone's favor.

Respectfully submitted, this 9th day of August, 2011.

By: /Kathryn Bina/
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Attorney for Opposer
AUTOZONE PARTS, INC.

CERTIFICATE OF ELECTRONIC FILING AND SERVICE

I hereby certify that this correspondence is being submitted to the Trademark Trial and Appeal Board via electronic means by filing with the Electronic Systems for Trademark Trial and Appeals on August 9, 2011. A true and correct copy was also mailed to the Applicant's attorney of record at the following address via U.P.S. International:

Becker Kurig Straus
Bavariastraße 7
80336 München
FED REP GERMANY

/Kathryn W. Bina/
Kathryn W. Bina, Esq.

EXHIBIT A

AUTOZONE'S U.S. DURALAST REGISTRATIONS AND PENDING APPLICATIONS

MARK	REG. NO/APP. NO	GOODS
DURALAST	1,467,999	IC 7: Automotive alternators. IC 12: Automotive starters.
DURALAST	1,607,305	IC 9: Automotive batteries. IC 12: Brake shoes and brake pads for vehicles.
DURALAST	3,567,993	IC 8: Hand tools, namely, wrenches, ratchet wrenches and attachment therefore, socket wrenches, socket sets, pliers, screwdrivers, except for those specifically designed and intended for use in roofing applications.
DURALAST	3,474,541	IC 6: Metal tool boxes except for those specifically designed and intended for use in roofing applications. IC 7: Ignition components, namely, ignition wires and coil on spark plug insulators for land vehicles; distributor caps, water pumps, all for land vehicles; spark plugs, and timing belts for engines for land vehicles. IC 8: Stands for hand jacks. IC 9: Batter cables, batter terminal protectors; marine batteries, thermostats for motors and engines, washers made of felt specially adapted for use with car batteries. IC 12: Vehicle parts, namely, ball joints, idler arms, king pins, chassis, gears, universal joints, control arms, tie rods ends, bushings, drag links, CV axles, and master cylinders, brake drums, brake rotors for land vehicles; clutch discs for land vehicles, clutch sets for land vehicles composed of clutch disc, pressure plate, release bearing, pilot bushing/bearing and alignment tool, control arm shaft kits for suspensions for vehicles consisting of a control arm shaft, control arm bushings, and nuts; land vehicle suspension parts, namely, torsion/sway bars, coil springs, shock absorbers, and stabilizer links; V belts for land vehicle transmissions; multi V belts for land vehicle transmissions, universal joints for land vehicles, windshield wiper blades, all for land vehicles.

DURALAST GOLD	2,763,813	IC 7: Automotive alternators. IC 9: Automotive batteries.
DURALAST GOLD	3,193,473	IC 7: Starters for automotive motors and engines, land vehicle parts for internal combustion engines, namely distributor caps and rotors. IC 9: Batter cables and battery terminal protectors. IC 12: Brake pads for land vehicles.
DURALAST PROFESSIONAL	3,165,011	IC 9: Automotive batteries.
DURALAST GOLD CMAX	3,729,117	IC 12: Brake pads for land vehicles.
DURALAST FLEX BLADE	3,899,016	IC 12: Windshield wiper blades.
DURALAST PROVEN TOUGH	3,960,460	IC 7: Automotive cooling system parts, namely, water pumps. IC 9: Batteries, and automotive cooling system parts, namely, thermostats. IC 12: Automotive chassis and suspension parts, namely, ball joints, bushings, coil springs, control arms, idler arms, pitman arms, tie rod ends, king pins, center links, track bars, leaf springs, trailing arms, tie rod adjusting sleeves, sway bars and sway bar kits, comprised of rods and bushings.
DURALAST PLATINUM	85/057,394	IC 9: Automotive batteries.
DURALAST GOLD FLEX BLADE	85/347,021	IC 12: Windshield wiper blades.