

ESTTA Tracking number: **ESTTA497063**

Filing date: **09/27/2012**

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	Navistar, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	2701 Navistar Dr. Lisle, IL 60532 UNITED STATES		

Attorney information	Jeffrey A. Wakolbinger Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP 311 S. Wacker Drive Suite 5000 Chicago, IL 60606 UNITED STATES jwakolbinger@pattishall.com, baugust@pattishall.com Phone:(312) 554-8000		
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Applicant Information

Application No	85508517	Publication date	08/28/2012
Opposition Filing Date	09/27/2012	Opposition Period Ends	09/27/2012
Applicant	SONG, ZHILAN 5081 CHESAPEAKE STREET CHINO, CA 91710 UNITED STATES		

Goods/Services Affected by Opposition

Class 012. All goods and services in the class are opposed, namely: Tires for vehicles, namely, OTR (off-the-road) tires, skid tires, and tires for industrial applications, for agricultural implements, tractors, forklifts, and trailers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3446636	Application Date	09/26/2005
Registration Date	06/10/2008	Foreign Priority Date	NONE
Word Mark	PROSTAR		

Design Mark	<h1>PROSTAR</h1>
Description of Mark	NONE
Goods/Services	Class 012. First use: First Use: 2006/03/31 First Use In Commerce: 2006/03/31 Mobile vehicles, namely, highway trucks over 33,001 pounds by Gross Vehicle Weight (GVW)

Attachments	78720159#TMSN.jpeg (1 page)(bytes) Notice of Opposition.PDF (10 pages)(95431 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	<i>/Jeffrey A. Wakolbinger/</i>
Name	Jeffrey A. Wakolbinger
Date	09/27/2012

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

In the Matter of Application Serial No. 85/508517
Filing Date: January 4, 2012
Published in the *Official Gazette* August 28, 2012

NAVISTAR, INC.,)	
)	
Opposer,)	
)	Opposition No. _____
v.)	
)	
ZHILAN SONG,)	
)	
Applicant.)	
)	
)	
)	

NOTICE OF OPPOSITION

Opposer, Navistar, Inc. (“Navistar”) believes that it will be damaged by registration of the mark shown in Application Serial No. 85/508517 for all goods identified therein and hereby opposes the same. As grounds for its opposition, Navistar, through its attorneys Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP, alleges as follows:

1. Navistar, a Delaware corporation with its principal place of business in Illinois, manufactures and sells trucks, buses, recreational vehicles, defense vehicles, engines, chassis and related parts and accessories throughout the world.
2. Under its INTERNATIONAL TRUCKS brand, Navistar sells tractor trailer trucks under the marks PROSTAR and PROSTAR+.
3. Navistar’s wholly owned subsidiary, International Truck Co. LLC (“International Truck”), is the owner of Registration No. 3,446,636, for the standard character mark PROSTAR (the “PROSTAR Mark”), and licenses the PROSTAR Mark to Navistar. A true and correct copy

of a printout from the TSDR database of the United States Patent and Trademark Office showing the current status and title of the PROSTAR Mark is attached hereto as **Exhibit A**.

4. The PROSTAR Mark is registered for the following goods in Class 12: “Mobile vehicles, namely, highway trucks over 33,001 pounds by Gross Vehicle Weight (GVW).” All such trucks are sold with a complete set of tires.

5. Commercial trucks in the United States are classified by GVW on a scale of 1 to 8. Class 8 is for vehicles over 33,000 pounds GVW and includes all tractor-trailer trucks. Opposer’s PROSTAR tractor-trailer trucks are among the best selling tractor-trailer trucks in North America.

6. Navistar currently uses the PROSTAR Mark in U.S. commerce and has used the PROSTAR Mark in U.S. commerce since at least as early as March 31, 2006.

7. Registration No. 3,446,636 is valid and subsisting and has a priority date that precedes the filing date of Application Serial No. 85/508517 and, on information and belief, precedes all use of Applicant’s “PROSTAR” mark in U.S. commerce by Applicant or any of Applicant’s related companies.

8. Additionally and alternatively, Navistar has established common-law rights in the PROSTAR Mark through use in United States commerce of the PROSTAR Mark on and for trucks. On information and belief, these common-law rights predate any common law rights Applicant may have in its applied-for trademark.

9. Upon information and belief, Applicant Zhilan Song is an individual who resides at 5081 Chesapeake Street, Chino, California 91710.

10. On information and belief Zhilan Song is employed by or affiliated with LGL Industries, LLC, a limited liability company organized under the laws of California with a

principal place of business at 13888 Magnolia Ave, Chino, California 91710, which, on information and belief, uses the mark PROSTAR for tires.

11. On January 4, 2012, Applicant filed Application Serial No. 85/508517 to register the mark PROSTAR (the “Opposed Mark”).

12. Applicant has applied to register the Opposed Mark for “Tires for vehicles, namely, OTR (off-the-road) tires, skid tires, and tires for industrial applications, for agricultural implements, tractors, forklifts, and trailers” in Class 12. According to the USPTO’s online records, the original application covered all tires for vehicles and did not limit the types of vehicles for which such tires are intended.

13. Applicant did not initially indicate a filing basis for the 85/508517 application, but the current filing basis is identified as 1B (*i.e.*, under 15 U.S.C. § 1051(b)), based on an alleged intent to use the Opposed Mark on the identified goods.

14. On information and belief, the earliest date on which Applicant or any related company has used the Opposed Mark in United States commerce on the identified goods is April 18, 2012, well after Navistar first began using the PROSTAR Mark in U.S. commerce and well after the PROSTAR Mark was registered.

15. As a result of registration of the PROSTAR Mark, as well as Navistar’s use of the PROSTAR Mark in commerce, Applicant and any related companies were on constructive notice of Navistar’s rights in the PROSTAR Mark at the time Applicant filed Application Serial No. 85/508517 and at the time of Applicant’s first use of such mark (or first use of such mark by a company related to Applicant), if any.

16. The mark shown in Application Serial No. 85/508517 is identical to the PROSTAR Mark in sight, sound and commercial impression, and the goods identified in

Application Serial No. 85/508517 are similar and closely related to the goods identified in Registration No. 3,446,636, such that use of the Opposed Mark is likely to cause confusion, to cause mistake or to deceive.

17. Registration of the Opposed Mark would be inconsistent with Navistar's exclusive right to use the PROSTAR Mark for trucks and related goods, and it would be injurious to Navistar's investment and goodwill in this mark.

18. Accordingly, the Board should refuse registration of Applicant's PROSTAR mark under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Navistar prays that this opposition be sustained and that Application Serial No. 85/508517 be denied.

Respectfully submitted,

PATTISHALL, McAULIFFE, NEWBURY,
HILLIARD & GERALDSON LLP

Dated: September 27, 2012

By: /Jeffrey A. Wakolbinger/

Brett A. August
Jeffrey A. Wakolbinger
311 South Wacker Drive, Suite 5000
Chicago, Illinois 60606
(312) 554-8000

Attorneys for Opposer, Navistar, Inc.

CERTIFICATE OF ELECTRONIC TRANSMISSION

I, Jeffrey A. Wakolbinger, certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** is being electronically transmitted to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, this 27th day of September, 2012.

/Jeffrey A. Wakolbinger/

CERTIFICATE OF SERVICE

I, Jeffrey A. Wakolbinger, certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** was served on Applicant, via first class mail, postage prepaid, addressed to Zhilan Song, 5081 Chesapeake Street, Chino, California 91710, this 27th day of September, 2012.

/Jeffrey A. Wakolbinger/

Exhibit A

[STATUS](#) [DOCUMENTS](#)[Back to Search](#)[Print](#)**Generated on:** This page was generated by TSDR on 2012-09-27 16:04:24 EST**Mark:** PROSTAR**PROSTAR****US Serial Number:** 78720159**Application Filing Date:** Sep. 26, 2005**US Registration Number:** 3446636**Registration Date:** Jun. 10, 2008**Register:** Principal**Mark Type:** Trademark**Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.**Status Date:** Jun. 10, 2008**Publication Date:** Oct. 02, 2007**Notice of Allowance Date:** Apr. 01, 2008

Mark Information

Mark Literal Elements: PROSTAR**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Mobile vehicles, namely, highway trucks over 33,001 pounds by Gross Vehicle Weight (GVW)**International Class:** 012 - Primary Class**U.S Class:** 019, 021, 023, 031, 035, 044**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** Mar. 31, 2006**Use in Commerce:** Mar. 31, 2006

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: International Truck Intellectual Property Company, LLC

Owner Address: Law Department
4201 Winfield Road
Warrenville, ILLINOIS 60555
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY**State or Country Where Organized:** ILLINOIS

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jeffrey P. Calfa**Docket Number:** T10697**Correspondent**

Correspondent JEFFREY P CALFA
Name/Address: INTERNATIONAL TRUCK & ENGINE CORP.
 LAW DEPT
 4201 WINFIELD RD
 WARRENVILLE, ILLINOIS 60555
 UNITED STATES

Phone: 630-753-3023**Fax:** 630-753-3982**Correspondent e-mail:** ptinfo@nav-international.com

Correspondent e-mail No
Authorized:

Domestic Representative - Not Found**Prosecution History**

Date	Description	Proceeding Number
Sep. 19, 2012	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Sep. 19, 2012	ASSIGNMENT OF OWNERSHIP NOT UPDATED AUTOMATICALLY	
Jun. 10, 2008	REGISTERED-PRINCIPAL REGISTER	
May 02, 2008	LAW OFFICE REGISTRATION REVIEW COMPLETED	70884
May 02, 2008	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 24, 2008	STATEMENT OF USE PROCESSING COMPLETE	70565
Apr. 24, 2008	EXTENSION 1 GRANTED	70565
Apr. 08, 2008	USE AMENDMENT FILED	70565
Apr. 08, 2008	EXTENSION 1 FILED	70565
Apr. 08, 2008	TEAS EXTENSION RECEIVED	
Apr. 08, 2008	TEAS STATEMENT OF USE RECEIVED	
Apr. 01, 2008	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Feb. 15, 2008	EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED	
Nov. 01, 2007	EXTENSION OF TIME TO OPPOSE RECEIVED	
Oct. 02, 2007	PUBLISHED FOR OPPOSITION	
Sep. 12, 2007	NOTICE OF PUBLICATION	
Aug. 24, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Aug. 24, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 01, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Aug. 01, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
Jul. 27, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Feb. 08, 2007	LETTER OF SUSPENSION E-MAILED	6332
Feb. 08, 2007	SUSPENSION LETTER WRITTEN	76613
Feb. 07, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	70884
Feb. 07, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	70884
Feb. 02, 2007	ASSIGNED TO LIE	70884
Jan. 09, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 27, 2006	FINAL REFUSAL E-MAILED	
Oct. 27, 2006	FINAL REFUSAL WRITTEN	76613
Oct. 05, 2006	TEAS/EMAIL CORRESPONDENCE ENTERED	72067
Sep. 18, 2006	CORRESPONDENCE RECEIVED IN LAW OFFICE	72067
Sep. 18, 2006	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 31, 2006	NON-FINAL ACTION E-MAILED	6325
Mar. 31, 2006	NON-FINAL ACTION WRITTEN	76613
Mar. 30, 2006	ASSIGNED TO EXAMINER	76613
Sep. 30, 2005	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: May 02, 2008

Assignment Abstract of Title Information

Summary

Total Assignments: 1

Registrant: International Truck Intellectual Property Company, LLC

[Conveyance Filter](#)

Assignment 1 of 1

Conveyance: SECURITY AGREEMENT

Reel/Frame: [4859/0294](#)

Pages: 13

Date Recorded: Sep. 12, 2012

Supporting Documents: [assignment-tm-4859-0294.pdf](#)

Assignor

Name: [IC BUS, LLC](#)

Execution Date: Aug. 17, 2012

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: ARKANSAS

Name: [INTERNATIONAL ENGINE INTELLECTUAL PROPERTY COMPANY, LLC](#)

Execution Date: Aug. 17, 2012

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: ILLINOIS

Name: [INTERNATIONAL TRUCK INTELLECTUAL PROPERTY COMPANY, LLC](#)

Execution Date: Aug. 17, 2012

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: ILLINOIS

Name: [NAVISTAR INTERNATIONAL CORPORATION](#)

Execution Date: Aug. 17, 2012

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Name: [NAVISTAR, INC.](#)

Execution Date: Aug. 17, 2012

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: [JPMORGAN CHASE BANK, N.A., AS COLLATERAL AGENT](#)

Legal Entity Type: ASSOCIATION

State or Country Where Organized: UNITED STATES

Address: 270 PARK AVENUE
NEW YORK, NEW YORK 10017

Correspondent

Correspondent Name: IP RESEARCH PLUS, INC.

Correspondent Address: 21 TADCASTER CIRCLE
ATTN: PENELOPE J.A. AGODOA
WALDORF, MD 20602

Domestic Representative - Not Found
