

ESTTA Tracking number: **ESTTA649179**

Filing date: **01/09/2015**

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	Blount, Inc.
Granted to Date of previous extension	02/18/2015
Address	4909 SE International Way Portland, OR 97222 UNITED STATES

Correspondence information	Thomas L. Holt Steptoe & Johnson LLP 1330 CONNECTICUT AVE NW Washington, DC 20036 UNITED STATES tholt@steptoe.com, ipdocketing@steptoe.com Phone:312-577-1256
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Applicant Information

Application No	86265975	Publication date	10/21/2014
Opposition Filing Date	01/09/2015	Opposition Period Ends	02/18/2015
Applicant	TBC Trademarks, LLC 2215-B Renaissance Dr., Suite 5 Las Vegas, NV 89119 UNITED STATES		

Goods/Services Affected by Opposition

Class 012. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Tires, excluding tires for outdoor power equipment

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.	602338	Application Date	02/01/1954
Registration Date	02/22/1955	Foreign Priority Date	NONE
Word Mark	OREGON		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 007. First use: First Use: 1948/11/15 First Use In Commerce: 1948/11/15 SAW CHAINS, SAW CHAIN DEPTH GAUGE JOINTERS, [SAW CHAIN FILING VISES,] SAW CHAIN FILES AND HOLDERS THEREOF, SAW CHAIN BREAKERS, [SAW CHAIN GUIDE PLATES,] SAW BARS, [SAW BAR HANDLES, SAW BAR TIGHTENERS, SPROCKETS, WEDGE PLATES, WEDGES, AND PARTS THEREOF]

U.S. Registration No.	2630993	Application Date	06/18/2001
Registration Date	10/08/2002	Foreign Priority Date	NONE

Word Mark	OREGON
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Description of Mark	NONE
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Goods/Services	Class 008. First use: First Use: 1948/11/15 First Use In Commerce: 1948/11/15 Chain saw hand tools, namely, sharpeners, files, chain breakers, breaker anvil, grease guns and filing guides
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U.S. Registration No.	2889236	Application Date	09/16/2003
Registration Date	09/28/2004	Foreign Priority Date	NONE

Word Mark	OREGON
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Description of Mark	NONE
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Goods/Services	Class 007. First use: First Use: 2002/02/01 First Use In Commerce: 2002/02/01 Parts for outdoor power equipment, namely, parts for motors and engines, namely, air filters, oil filters, fuel lines, fuel filters, carburetors, throttle controls, lines, starters, and sparkplugs; machine parts, namely, bearings, bushings, plugs and clips; belts for machines; clutches for machines; drive chains for machines; drive parts for machines, namely, sprockets, gears, drive pins, drive
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	discs, rings, rollers, spindle assemblies and jackshafts; structural parts for power operated edgers, namely, shafts; lawn mower parts, namely blades, grass bags, and decks; machine parts, namely, idlers and pulleys; engine mufflers Class 012. First use: First Use: 2002/02/01 First Use In Commerce: 2002/02/01 Parts for outdoor power equipment, namely, clutches for land vehicles, inner tubes for vehicle tires
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U.S. Registration No.	3789762	Application Date	08/25/2009
Registration Date	05/18/2010	Foreign Priority Date	NONE
Word Mark	OREGON		
Design Mark			
Description of Mark	The mark consists of the word "Oregon" inside an oval racetrack design.		
Goods/Services	Class 007. First use: First Use: 1948/11/15 First Use In Commerce: 1948/11/15 Chains for saw chain and chain saw guide bars		

U.S. Registration No.	4376750	Application Date	01/19/2010
Registration Date	07/30/2013	Foreign Priority Date	NONE
Word Mark	OREGON		
Design Mark			
Description of Mark	The mark consists of the word "Oregon" inside an oval racetrack design.		
Goods/Services	Class 007. First use: First Use: 2011/04/00 First Use In Commerce: 2011/08/00 Outdoor power equipment, namely, chain saws, hedge trimmers, line trimmers, edgers; structural parts and fittings for all of the aforementioned goods		

Attachments	76273733#TMSN.png(bytes) 78300820#TMSN.png(bytes) 77812175#TMSN.png(bytes) 77914656#TMSN.png(bytes) Notice of Opposition to OREGONIAN - FINAL.pdf(18076 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	/Thomas L. Holt/
Name	Thomas L. Holt
Date	01/09/2015

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

BLOUNT, INC.,)	
)	
Opposer,)	Opposition No. _____
)	
v.)	Serial No. 86/265,975
)	
TBC TRADEMARKS, LLC)	Mark: OREGONIAN
)	
)	Filing Date: April 29, 2014
)	
Applicant.)	NOTICE OF OPPOSITION
)	

Blount, Inc., a Delaware corporation with its place of business at 4909 SE International Way, Portland, Oregon 97222 (“Blount”), believes that it will be damaged by registration of the mark OREGONIAN, Serial No. 86/265,975, filed on April 29, 2014 by TBC Trademarks, LLC a Delaware limited liability company with a principal place of business at 2215-B Renaissance Dr., Suite 5 Las Vegas NEVADA 89119 (“TBC Trademarks”). Blount hereby opposes registration of the OREGONIAN mark on the following grounds:

1. Blount is a world leader in providing high-quality outdoor power equipment and related parts, accessories and tools.

2. Since as early as 1948, and long prior to the acts of TBC Trademarks complained of herein, Blount has used the OREGON mark on and in connection with outdoor power equipment and related parts, accessories and tools, including a wide array of vehicle tires and inner tubes for tires. Blount has expended significant resources in advertising and promoting its products and has sold billions of dollars of such products in the United States under its OREGON mark. By reason of extensive advertising, promotion and sale, the OREGON mark has

become, through widespread and favorable public acceptance and recognition, an asset of incalculable value as a symbol of Blount, its quality products and its goodwill.

3. Blount has invested significant resources in developing, advertising, promoting, and marketing its products under the OREGON trademark and in establishing the OREGON products in the minds of consumers as high quality products offered by Blount.

4. By reason of extensive use and promotion, Blount's OREGON trademark has become favorably known among consumers as used in connection with Blount's products and has become a valuable asset as a symbol of Blount, its quality products and its goodwill.

5. Blount has taken steps to protect the OREGON trademark in connection with its products and owns the federal registration set forth below.

Trademark	Reg. No.	Reg. Date
OREGON	602,338	February 22, 1955
	2,630,993	October 8, 2002
	2,889,236	September 28, 2004
	3,789,762	May 18, 2010
	4,376,750	July 30, 2013
OREGON	4,459,489	December 31, 2013

6. Pursuant to Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b), Blount's federal registration certificates are prima facie evidence of the validity of this mark as well as Blount's ownership and exclusive right to use the mark in connection with the identified goods. In fact, Blount's exclusive right to use the OREGON mark for the goods recited in Registration

Nos. 602,338, 2,630,993 and 2,889,236 has achieved incontestable status under 15 U.S.C. § 1065.

7. Notwithstanding Blount's prior rights in the OREGON mark, TBC Trademarks filed U.S. Federal Trademark Application Serial No. 86/265,975 for the OREGONIAN mark in International Class 12 covering tires, excluding those for outdoor power equipment.

8. TBC Trademarks had constructive knowledge of the OREGON mark before filing Application Serial No. 86/265,975.

9. Blount did not authorize TBC Trademarks' adoption or registration of the OREGONIAN trademark.

10. TBC Trademarks' OREGONIAN mark is confusingly similar in sight, sound, and commercial impression to Blount's OREGON mark.

11. TBC Trademarks' OREGONIAN mark so closely resembles Blount's OREGON mark that, if used in connection with the applied for goods, it would be likely to cause confusion, mistake or deception of the relevant trade and public under Section 2(d) of the Trademark Act. Consumers will likely believe that TBC Trademarks' products are in some way associated with or connected with, or approved or authorized by, Blount, or that TBC Trademarks' products otherwise originate from the same source as do Blount's products, when this is not the case.

12. By reason of the foregoing, Blount believes that it will be damaged by registration of TBC Trademarks' OREGONIAN mark in connection with the applied for goods.

WHEREFORE, Blount prays that this Opposition be sustained and that Application
Serial No. 86/265,975 be refused registration.

Respectfully submitted,

BLOUNT, INC.

Dated: January 9, 2015

By: /s/ Thomas L. Holt
Thomas L. Holt
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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on January 9, 2015 I served a true and correct copy of the foregoing
NOTICE OF OPPOSITION on counsel for Applicant by U.S. mail at the following address:

Roger H. Bora
Thompson Hine LLP
10050 Innovation Dr., Suite 400
Dayton, Ohio 45342

/s/ Thomas L. Holt
Attorneys for Opposer
Blount, Inc.