

ESTTA Tracking number: **ESTTA672151**

Filing date: **05/13/2015**

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	Consolidated Rail Corp.
Granted to Date of previous extension	05/20/2015
Address	1717 Arch Street Philadelphia, PA 19103 UNITED STATES

Attorney information	Kevin M. Bovard Baker & Hostetler LLP 2929 Arch St., 12th Floor Philadelphia, PA 19104 UNITED STATES kbovard@bakerlaw.com, trademarksp@bakerlaw.com Phone:215-564-2727
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**Applicant Information**

Application No	86021658	Publication date	01/20/2015
Opposition Filing Date	05/13/2015	Opposition Period Ends	05/20/2015
Applicant	Perrong, Andrew R 3551 Post Rd. Huntingdon Valley, PA 19006 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Vending in the field of train memorabilia, models, souvenirs, curios, and collectables
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**Grounds for Opposition**

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Applicant is not the rightful owner of the applied-for mark.

**Mark Cited by Opposer as Basis for Opposition**

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Design Mark	
Goods/Services	freight transportation services by rail and all those goods and services within the zone of natural expansion thereof. Opposer has a bona fide intent to use the PRR & Design mark in connection with train memorabilia.

Attachments	PRR.jpg PRR Opposition.pdf(142486 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	/Kevin M. Bovard/
Name	Kevin M. Bovard
Date	05/13/2015

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

CONSOLIDATED RAIL CORP.,

Opposer,

v.

ANDREW R. PERRONG.

Applicant

Opposition No.

Serial No. 86021658

Filed: July 27, 2013

Published: January 20, 2015

Mark: PRR & Design

**NOTICE OF OPPOSITION**

Opposer, Consolidated Rail Corporation (“Conrail” or “Opposer”) a corporation organized under the laws of the Commonwealth of Pennsylvania, having a principle place of business at 1717 Arch Street, Suite 1310, Philadelphia, PA 19103, represents that it will be damaged by the registration of the mark PRR & Design, as shown on Application Serial No. 86021658, and hereby opposes the same.

As grounds for opposition, Conrail alleges as follows:

1. Opposer Conrail is a major railroad operator in the United States, with rail lines and operations in five states.
2. By virtue of major railroad bankruptcies in the Northeast and Midwest, resulting federal legislation, and a series of corporate transactions over the course of many years, Conrail now owns and operates significant assets once owned and operated by the Pennsylvania

Railroad. To this day, Conrail operates—along with its corporate parents—substantial portions of former Pennsylvania Railroad lines.

3. Opposer, beginning with the Pennsylvania Railroad, and through the aforementioned bankruptcies and conveyances, , and as a subsequent rail operator of the Pennsylvania Railroad rail lines, equipment, and associated good will, has used the mark PRR & Design, shown below, in interstate commerce in connection with freight transportation services by rail, since 1846:



4. Opposer is entitled to use its PRR & Design mark in connection with freight transportation services by rail and all those goods and services within the zone of natural expansion thereof. Opposer has a bona fide intent to use the PRR & Design mark in connection with train memorabilia, as it has done with other of its railroad-related marks.
5. As a result of the widespread use of the PRR & Design mark by Opposer and its predecessors in connection with a variety of railroad-related goods and services, the mark has acquired extensive goodwill, has developed a high degree of distinctiveness, and is well known and famous as identifying high quality railroad-related goods and services which have their origin with, or association with, Opposer.
6. On July 27, 2013, Applicant Andrew R. Perrong filed an application for registration for the mark, PRR & Design, serial no. 86,021/658 (hereinafter “Applicant’s Mark”). This application is presently pending on an intent-to-use basis pursuant to §1(b) of the Lanham Act, and covers: “vending in the field of train memorabilia, models, souvenirs, curios,

and collectables.” (Int. Cl. 35). Applicant’s Mark was published for opposition on January 20, 2015.

**COUNT ONE**

**Use of Applicant’s Mark is Likely to Cause Confusion, Mistake, and Deception**

7. Opposer incorporates the foregoing paragraphs by reference as though fully set forth herein.
8. Opposer’s use of its PRR & Design mark and the acquisition of fame and distinctiveness embodied therein precede Applicant’s filing date.
9. Upon information and belief, Applicant has never used Applicant’s Mark. Applicant is in no way affiliated with Conrail or the former Pennsylvania Railroad.
10. Applicant’s Mark is a virtually identical replica of Opposer’s well-known, historic PRR & Design trademark, rendering the same commercial impression as Opposer’s mark.
11. Applicant’s Mark is to be used in connection with services that are closely related to and aligned with the products and services offered by Opposer, and are likely to travel through the same channels of trade and offered to many of the same consumers who purchase Opposer’s products and services.
12. The use and registration of Applicant’s Mark to identify its train memorabilia, models, souvenirs, curios, and collectables is likely to cause confusion, mistake, and deception as to the source, origin, sponsorship or association of the goods, and will injure Opposer.
13. Any defects or faults found with the goods sold by Applicant under Applicant’s Mark, because of the false association with Opposer, would inflict upon and seriously injure the reputation of Opposer.

14. The grant of a Certificate of Registration to Applicant for Applicant's Mark would be inconsistent with and in derogation of Opposer's prior rights, and would therefore cause damage and injury.

**COUNT TWO**

**Applicant is Not (and Was Never) the Rightful Owner of the Applied-for Mark**

15. Opposer incorporates the foregoing paragraphs by reference as though fully set forth herein.

16. Applicant is not, and was not, at the time of filing its application, the rightful owner of the PRR & Design mark represented in serial no. 86,021/658.

17. The grant of a Certificate of Registration to Applicant for Applicant's Mark would be inconsistent with and in derogation of Opposer's prior rights, and would therefore cause damage and injury.

**COUNT THREE**

**Dilution**

18. Opposer incorporates the foregoing paragraphs by reference as though fully set forth herein.

19. Registration and use of Applicant's Mark would dilute the distinctive quality of Opposer's famous PRR & Design mark.

**COUNT FOUR**

**False Association**

20. Opposer incorporates the foregoing paragraphs by reference as though fully set forth herein.

21. Applicant's Mark is the same as, or a close approximation of, Opposer's predecessor name and identity, i.e., the "Pennsylvania Railroad" or "PRR." Applicant's Mark

therefore points unmistakably to Opposer. The grant of a Certificate of Registration to Applicant for Applicant's Mark would therefore cause damage and injury to Opposer.

WHEREFORE, Consolidated Rail Corp. prays that this Opposition be sustained and that Application Serial No. 86,021/658 be refused in its entirety.

Respectfully submitted,

Dated: May 13, 2015

**BAKER & HOSTETLER LLP**  
2929 Arch Street  
Cira Centre, 12th Floor  
Philadelphia, PA 19104-2891

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*Attorneys for Opposer  
Consolidated Rail Corp.*

**CERTIFICATE OF SERVICE**

I hereby certify that on May 13, 2015, a true and correct copy of the foregoing NOTICE OF OPPOSITION was placed in the United States Mail, addressed to:

Andrew R. Perrong  
3551 Post Rd.  
Huntingdon Valley, PA 19006

/s/ Kevin M. Bovard  
Kevin M. Bovard