

ESTTA Tracking number: **ESTTA700661**

Filing date: **10/07/2015**

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	Lawrence Transportation Systems, Inc.		
Entity	Corporation	Citizenship	Virginia
Address	872 Lee Highway Roanoke, VA 24019 UNITED STATES		

Attorney information	Amy P. Wheeler CowanPerry PC 202 South Main Street Suite 202 Blacksburg, VA 24060 UNITED STATES trademarks@cowanperry.com, awheeler@cowanperry.com, spierce@cowanperry.com Phone:(540) 443-2857		
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Applicant Information

Application No	86607973	Publication date	09/08/2015
Opposition Filing Date	10/07/2015	Opposition Period Ends	10/08/2015
Applicant	Houlihan/Lawrence, Inc. 800 Westchester Avenue, Suite N-505 Rye Brook, NY 10573 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2001/00/00 First Use In Commerce: 2001/00/00 All goods and services in the class are opposed, namely: Moving and relocation services, namely, planning and project oversight of home moving for others

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.	1422279	Application Date	10/24/1985
Registration Date	12/23/1986	Foreign Priority Date	NONE
Word Mark	LAWRENCE TRANSPORTATION SYSTEMS		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 039. First use: First Use: 1985/01/01 First Use In Commerce: 1985/01/01 TRANSPORTATION OF GOODS BY LAND, NAMELY, TRANSPORTING HOUSEHOLD GOODS AND GENERAL COMMODITIES, EXCEPT CLASS A AND B EXPLOSIVES, AS A COMMON CARRIER AND A CONTRACT CARRIER, FOR OTHERS
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U.S. Application No.	86571322	Application Date	03/20/2015
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	LAWRENCE
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 039. First use: First Use: 1985/01/01 First Use In Commerce: 1985/01/01 Moving company services for household and commercial purposes, and transportation services which include the freight forwarding of the goods of others by truck, rail, air or ocean; freight transportation services by truck, airplane, train, ship or a combination thereof; supply chain logistics services, namely, storage, transportation and delivery of goods for others by rail, ship or truck or a combination thereof; freight transportation, brokerage and consultation in the field of transportation by truck, rail, air and ocean; rental of containers for storage and transportation of goods for others; relocation services, namely, labor assistance in packing, transportation and storage of goods; trash services, namely, rental of dumpsters
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Attachments	86571322#TMSN.png(bytes) 2015.10.07 Notice of Opposition by Lawrence Transportation Systems.pdf(3400077 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	/Amy P. Wheeler/
Name	Amy P. Wheeler
Date	10/07/2015

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

LAWRENCE TRANSPORTATION
SYSTEMS, INC.,

Opposer

V.

HOULIHAN/LAWRENCE, INC.

Applicant

In the Trademark application Serial
No. 86607973

For the mark HOULIHAN LAWRENCE

Published in the Official Gazette on
September 8, 2015

NOTICE OF OPPOSITION

Lawrence Transportation Systems, Inc. (“Lawrence” or “Opposer”), a Virginia Corporation, located and doing business at 872 Lee Highway, Roanoke, Virginia 24019, believes that it will be damaged by the registration by Houlihan/Lawrence Inc. (“Houlihan/Lawrence” or “Applicant”) of the mark HOULIHAN LAWRENCE shown in Application Serial No. 86607973, and hereby opposes the same.

The grounds for opposition are as follows:

1. Houlihan/Lawrence filed a trademark application assigned Serial No. 86607973 by the United States Patent and Trademark Office (“USPTO”) on April 23, 2015 (the “Application”) to register the mark HOULIHAN LAWRENCE (the “Applicant’s Mark”) for use in connection with “Moving and relocation services, namely, planning and project oversight of home moving for others” in International Class 035 and “Real estate acquisition services; real estate agencies; real estate appraisal; real estate brokerage; real estate consultation; real estate consultancy; real estate listing; real estate management providing real estate listings and real estate information via the Internet; real estate procurement for others; leasing of real estate; leasing of real estate; rental of apartments; rental of office space; mortgage procurement for others” in International Class 036 (the “Applicant’s Services”).
2. The Application filed by Houlihan/Lawrence on April 23, 2015 (the “Applicant’s Filing Date”) was based on Houlihan/Lawrence’s alleged use of

the Applicant's Mark with the Applicant's Services on or before 2001 (the "Applicant's First Use Date").

3. The Application for the Applicant's Mark was published for opposition in the Official Gazette on September 8, 2015.
4. The Opposer is a long-established provider of transportation services based in Roanoke, Virginia. Opposer's services include container services, data management, freight transportation, commercial and residential moving and warehousing (collectively "Opposer's Transportation Services"). The Opposer has been in operation since 1932, and specifically has been providing moving and storage services since 1942. Therefore, the Opposer's name, Lawrence, has been associated with these services for over 73 years. The Opposer is also a founder and agent of United Van Lines. As an agent, Lawrence has effectively been marketed throughout the U.S. since 1942 and has been providing moving and storage services countrywide.
5. The Opposer is the owner of U.S. Registration Number 1,422,279 for the mark LAWRENCE TRANSPORTATION SYSTEMS (the "Opposer's mark") filed with the USPTO on October 24, 1985 (the "Opposer's Filing Date") based on Opposer's use of the mark since January 1, 1985. The Opposer's Mark was registered on December 23, 1986. One copy of the TTAB record showing the current active status of the registration of the Opposer's Mark is attached as Exhibit A.
6. On the Registration Certificate, it is noted that no claim is made to the exclusive right to use "TRANSPORTATION SYSTEMS" and so the exclusive right to use is solely in respect of "LAWRENCE".
7. On September 23, 1992, a Combined Declaration of Use in Commerce and Incontestability under Sections 8 and 15 was filed by the Opposer for the Opposer's Registration. On December 29, 1992, the Declaration under Section 8 was accepted and the Declaration of Incontestability under Section 15 for the Opposer's Registration was acknowledged. The Opposer's Registration for LAWRENCE TRANSPORTATION SYSTEMS is incontestable.
8. On December 5, 2006, the Opposer timely filed a Combined Declaration of Use in Commerce and Application for Renewal Under Sections 8 and 9 for Opposer's Mark. On February 21, 2007, the Declaration of Use in Commerce was accepted and the Application for Renewal was granted.
9. The Opposer has used the Opposer's Mark in association with the Opposer's Transportation Services in commerce since at least as early as January 1, 1985, and the Opposer's Mark is currently in use in commerce with the Opposer's Transportation Services.

10. The Opposer's Filing Date and the Opposer's First Use Date for the Opposer's Mark is earlier than the Applicant's Filing Date for the Applicant's Mark.
11. Priority is not an issue in this case because both the Opposer's Filing Date and the Opposer's First Use Date for the Opposer's Mark precede the Applicant's Filing Date and the Applicant's Alleged First Use Date for the Applicant's Mark.
12. The Opposer has also filed an application to register an additional mark LAWRENCE ("Opposer's Application") on March 20, 2015 ("Opposer's Application Filing Date") for use in connection with "Moving company services for household and commercial purposes, and transportation services which include the freight forwarding of the goods of others by truck, rail, air or ocean; freight transportation services by truck, airplane, train, ship or a combination thereof; supply chain logistics services, namely, storage, transportation and delivery of goods for others by rail, ship or truck or a combination thereof; freight transportation, brokerage and consultation in the field of transportation by truck, rail, air and ocean; rental of containers for storage and transportation of goods for others; relocation services, namely, labor assistance in packing, transportation and storage of goods; trash services, namely, rental of dumpsters" in International Class 039. Opposer has submitted that the Mark applied for, has been in use since January 1, 1985 ("Opposer's Application First Use Date").
13. Opposer's application has initially been refused for likelihood of confusion with Applicant's earlier registered mark HOULIHAN/LAWRENCE.
14. Applicant's registered mark HOULIHAN/LAWRENCE was filed on June 15, 2009 by the Applicant and was registered on March 8, 2011. Even though Opposer had already registered LAWRENCE TRANSPORTATION SYSTEMS over 20 years previously, and had the exclusive right to use LAWRENCE, we respectfully submit that, erroneously, the Applicant's mark was not refused and a likelihood of confusion not considered.
15. The Opposer is currently filing a response to the USPTO's Office Action, arguing that HOULIHAN/LAWRENCE was erroneously registered by the USPTO even though the Applicant had the exclusive right to use LAWRENCE and their mark was filed first in 1986, some 25 years before HOULIHAN/LAWRENCE was registered.
16. Again, the Opposer's Application Filing Date and the Opposer's First Use Date for the Opposer's Application is earlier than the Applicant's Filing Date for the Applicant's Mark.
17. Priority is therefore not an issue in the case of Opposer's Application because both the Opposer's Filing Date and the Opposer's Application First Use Date

precede the Applicant's Filing Date and the Applicant's Alleged First Use Date for the Applicant's Mark.

18. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged thereby.
19. Applicant's Application should not be granted because it so closely resembles Opposer's Mark and Opposer's Application, and Opposer has had exclusive right to the use of LAWRENCE since 1986.
20. WHEREFORE, Opposer respectfully requests that registration of the mark shown in Application Serial No. 86607973 be refused and that this Opposition be sustained in favor of Opposer.

By: 
Peer Segelke, Vice President and
General Counsel

Date: 10/6/15