

Exhibits

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

MV AGUSTA MOTOR S.P.A.)	
Opposer,)	Opposition No. 119,317 (Parent)
)	Opposition No. 119,597
v.)	Opposition No. 119,598
)	
TEAM OBSOLETE PRODUCTS, LTD.)	
Applicant.)	Docket No.: 4014-2 (formerly 2865-284)

**OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT AND
SUSPENSION OF PROCEEDINGS PENDING RESOLUTION OF MOTION**

Opposer, MV Agusta Motor S.p.A., submits this memorandum in opposition to "Applicant's Motion for Summary Judgment and Suspension of Proceedings Pending Resolution of Motion." This motion must fail because there are material issues of fact in dispute, particularly, facts relating to Opposer's use of its MV and MV AGUSTA marks in the United States prior to the filing date of Applicant's intent to use applications and Applicant's knowledge of Opposer's earlier rights in those marks.

I. Opposer's Analogous Use Establishes Opposer's Priority

Opposer strongly denies that it has not shown any use of the MV AGUSTA mark in the United States that precedes the filing date of Applicant's intent to use applications as alleged in Applicant's brief. To the contrary, it has adopted the MV AGUSTA mark and used it in pre-sales activity to identify motorbikes and in commerce in the United States since prior to September 2, 1997. This use is sufficient to entitle Opposer to priority.

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It is well established that a party may base its opposition to an application on the prior use of a term in a manner analogous to trademark use.¹ Consequently, a party can show prior use of a mark without an actual sale of goods bearing the mark. See New West Corp. v. NYM Co. of California, Inc., 595 F.2d 1194, 1200, 202 USPQ 643 (9th Cir. 1979). If a party adopts a mark and uses it "in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind," the party may acquire rights superior to those a subsequent user may acquire through selling goods identified with a similar mark. Id.; See also National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 1578, 19 USPQ2d 1424, 1429 (Fed. Cir. 1991) ("Prior public identification of petitioner with the name ACE for awards from use analogous to service mark usage is sufficient ground for cancellation."); Malcolm Nicol & Co. v. Witco Corp., 881 F.2d 1063, 1065, 11 USPQ2d 1638, 1640 (Fed. Cir. 1989) (affirming the TTAB's determination that analogous use of the contested term created in the minds of people the necessary association between the contested term and the covered goods).

Examples of use analogous to trademark use to establish priority under §2(d) include prior use of a term: in advertising brochures, in catalogues and newspapers, and in press releases and trade publications. McCarthy on Trademarks and Unfair

¹ See e.g., Jimlar Corp. v. The Army and Air Force Exchange Service, 24 USPQ2d 1216, 1221 (TTAB 1992); Era Corp. v. Electronic Realty Associates, Inc., 211 USPQ 734, 745 (TTAB 1981); Steer Inn Sys., Inc. v. Laughner's Drive-In, Inc., 405 F.2d 1401, 1402, 160 USPQ 626 (CCPA 1969); In re Cedar Point, Inc., 220 USPQ 533, 536-537 (TTAB 1983); Wagner v. Ballantyne Instruments & Electronics, Inc., 139 USPQ 391, 393 (TTAB 1963); Cities Service Oil Co. v. Perfection American, Inc., 157 USPQ 209, 210 (TTAB); Knickerbocker Toy Company, Inc. v. Faultless Starch Company, 175 USPQ 417, 422 (CCPA 1972); Shalom Children's Wear, Inc. v. In-Wear A/S, 26 USPQ2d 1516, 1519 (TTAB 1993); KMC Semiconductor Corp. v. Kevlin Manufacturing Co., 153 USPQ 683, 684 (TTAB 1967); Sears, Roebuck & Co. v. Mannington Mills, Inc., 138 USPQ 261, 262 (TTAB 1963); Unisplay S.A. v. American Electronic Sign Co. Inc., 28 USPQ2d 1721, 1729, 1730 (E.D. Wa. 1993).

Competition, Fourth Ed., Vol. 3, §20:16, 20-36, 20-37 (footnotes omitted), Rel. No. 17, 3/2001 (Decl. of Frank P. Presta, Tab A); Malcolm Nicol, 11 USPQ2d at 1639.

The question of use adequate to establish appropriation is one to be decided on the facts of each case. New England Duplicating Co. v. Mendes, 190 F.2d 415, 418, 90 USPQ 151 (1st Cir. 1951). The Court should look to the totality of a party's actions to determine if it has established priority rights in the use of a trademark. McCarthy, Vol. 2, §16:13, 16-26 ("[T]he resolution of 'photo finish' priority disputes must turn on an investigation of the whole factual matrix.") (Decl. of Frank P. Presta, Tab B); New West, 595 F.2d at 1200 (citing Hotel Corp. of America v. Inn America, Inc., 153 U.S.P.Q. 574, 576 (TTAB 1967)).

In the present case, Opposer's evidence of its promotional activities establishes its priority in ownership of the MV AGUSTA mark. Opposer's testimony period is still open. Opposer intends to introduce testimony that in the United States, after 1992 and before September 1997, Opposer used the MV AGUSTA trademark to pre-announce its new motorbike, the MV AGUSTA F4; that such publication activity was directed to the relevant purchasers; and that such publication was sufficient to create an association in the public's mind of MV AGUSTA with Opposer's motorbike and related goods. Furthermore, Opposer's discovery responses and documents submitted to Applicant, if taken as fact, already demonstrate Opposer's analogous trademark use in the United States.

Applicant seriously mischaracterized Opposer's response to Applicant's Interrogatory No. 4 in its brief. In Opposer's answer to Interrogatory No. 4, Opposer replied in parts (a) and (b), which correspond to Interrogatory No. 3 part (a) "in the

United States" and part (b) "outside the United States." Substantively, in Answer 4(a), Opposer states that it "has distributed and released promotional materials and information worldwide since April, 1992." (Decl. of Frank P. Presta, Tab C, Answer to Interrogatory No. 4). Without doubt, in Opposer's Answer, "worldwide" includes the United States.

Moreover, Opposer submitted many responsive documents to "Applicant's First Request for Production of Documents and Things" that show Opposer's pre-sales use of the mark before the filing date of Applicant's intent to use applications.² These include a press release from 1992, and magazine, newspaper and trade journal articles prior to September 2, 1997.

In addition, Opposer's other verified interrogatory answers indicate that Opposer's MV AGUSTA products have been promoted in the United States to the relevant consumers prior to the filing date of Applicant's intent to use applications. Opposer's answers state³:

- "The mark [MV AGUSTA] has also been used after 1992 and before September 1997 in order to pre-announce the new motorbike MV AGUSTA F4." (Opposer's Answer to Interrogatory No. 6);
- "The MV AGUSTA products and the project of the new MV AGUSTA F4 motorbike were also advertised and promoted to the readers of motor magazines and press releases, to those who visited the exhibition of Milan of 1997, and to companies and persons interested in the new MV AGUSTA F4 motorcycles." (Opposer's Answer to Interrogatory No. 7(a));
- "Opposer did promote its MV AGUSTA mark worldwide before September 2, 1997 through interviews, press releases, magazine articles and other media." (Opposer's Answer to Interrogatory No. 14);

² See Tabs D, E and F to the Decl. of Frank P. Presta.

³ See Tab C to the Decl. of Frank P. Presta, Responses by Opposer to Applicant's First Set of Interrogatories, Requests for Admission, Production of Documents and Things to Opposer.

- Prior to September 2, 1997, Opposer advertised MV AGUSTA in several newspapers and trade journals including some that are distributed to the United States, e.g., MOTOCICLISMO (September, 1997, which is sold in the last week in August); La Gazzetta Dello Sport (March 11, and July 13, 1992; July 23, 24, and 29, 1997; and September, 1997). (Opposer's Answers to Interrogatory Nos. 16 and 17); and
- Opposer advertised through its web sites, including cagivausa.com, mvagusta.com and mvagusta.it.⁴ (Opposer's answer to Interrogatory No. 19);

Furthermore, in addition to Opposer's press coverage inside the United States, by virtue of Opposer's promotion of its reintroduction of the historically famous⁵ MV and MV AGUSTA marks outside the United States, it is certain that Opposer's reputation for MV AGUSTA products was known in the United States by September 2, 1997. Notably, Opposer debuted the much anticipated MV AGUSTA F4 motorbike at an internationally attended trade show in Milan in September 1997. See Opposer's Answers to Interrogatory Nos. 4, 6, 7(a), 14, 16-19 (Decl. of Frank P. Presta, Tab C), Press Release of March 9, 1992 (Decl. of Frank P. Presta, Tab D); Document Nos. 2-7c (Decl. of Frank P. Presta, Tab F); and Document Nos. 30-35 (Decl. of Frank P. Presta, Tab E). In such circumstances, the marks should be legally recognized in the United States. See McCarthy, §29:4, p. 29-9 ("Foreign mark known by fame in the United States") (Decl. of Frank P. Presta, Tab H); All England Lawn Tennis Club, Ltd. v. Creations Aromatiques, Inc., 220 USPQ 1069, 1071 (TTAB 1983) (the Board denied registration of WIMBLEDON COLOGNE because "U.S. consumers would be likely to believe that

⁴ Opposer registered the domain names mvagusta.com on August 11, 1997. See Tab G to the Decl. of Frank P. Presta, (Document No. 28 submitted to Applicant in response to Applicant's Request for Documents and Things).

⁵ The marks MV and MV AGUSTA were brought to prominence during the 1950's through the mid 1970's by Opposer's predecessor in interest. See, e.g., Decl. of Frank P. Presta, Tab I (Document No. 41, which notes that the MV Agusta is "the most legendary badge ever to adorn the side of fuel tank" and "the most illustrious name in motorcycle history"; Document No. 44, which states that MV AGUSTA is "one of the most famous and accomplished motorcycle marques ever"; and Document No. 45); and Decl. of Frank P. Presta, Tab C, Opposer's Answer to Interrogatory No. 8.

applicant's product is associated with, sponsored by or otherwise related to the annual tennis championships in England presented by opposer's licensee").

Clearly, there is significant factual dispute about Opposer's prior use analogous to trademark use to preclude summary judgment.

II. **Applicant's Discovery Responses Will Show that it Lacks Priority**

Summary judgment is also inappropriate because material facts remain in dispute regarding Applicant's knowledge of Opposer's prior use of MV and MV AGUSTA in the United States before Applicant filed its intent to use applications on September 2, 1997. Opposer served Applicant with "Opposer's First Set of Interrogatories To Applicant" and "Opposer's First Request to Applicant For the Production of Documents and Things" on December 12, 2001. (Decl. of Frank P. Presta, Tab J). Applicant has not yet answered these discovery requests, which were due January 16, 2002.⁶

Significantly, Opposer's discovery requests pertain to the circumstances surrounding visits by Applicant to the offices of Opposer in Italy in 1997 or earlier; and to the subject of any discussions between Opposer and Applicant.⁷ See Opposer's Interrogatory Nos. 13 and 14; and Opposer's Document Request Nos. 18 and 19. (Decl. of Frank P. Presta, Tab J). Applicant's responses to Opposer's discovery requests are expected to produce evidence that prior to September 2, 1997, Applicant knew of: Opposer's development of the MV AGUSTA F4 motorbike; Opposer's rights to the MV AGUSTA trademarks; Opposer's promotional use of the MV AGUSTA marks in

⁶ Applicant has informed Opposer that it refuses to answer the discovery requests.

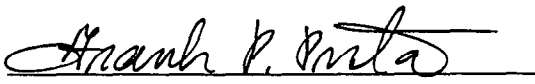
⁷ Upon information and belief, Applicant sought permission to be a licensed U.S. distributor of Opposer's MV and MV AGUSTA products.

trade publications that were circulated worldwide; and Opposer's entry in the United States market under the MV and MV AGUSTA marks. The responses will show that Applicant was fully aware of Opposer's reintroduction of MV AGUSTA motorbikes worldwide, that was occurring prior to Applicant's filing of its intent to use applications. The purpose of Applicant's visits is tantamount to an admission that Applicant did not have rights to the mark MV AGUSTA at the time it filed its intent to use applications.

III. Conclusion

Applicant is not entitled to a grant of summary judgment because material fact issues regarding Opposer's use of MV AGUSTA in the United States before September 2, 1997 remain to be determined. Therefore, Opposer respectfully requests that Applicant's motion for summary judgment and the corresponding request for suspension of proceeding be denied. Further, Opposer requests that it be permitted to take the necessary action to compel the responses by Applicant to its above-identified discovery requests, and thereafter to proceed with its testimony and other evidence in this opposition.

MV AGUSTA MOTOR S.P.A.

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Date: February 22, 2002

CERTIFICATE OF SERVICE

A copy of the foregoing OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT AND SUSPENSION OF PROCEEDINGS PENDING RESOLUTION OF MOTION was served on Robert T. Iannauci, President, Team Obsolete Products, Ltd., 139 Henry Street, Brooklyn, New York 11201, this 22 day of February, 2002, via the United States Postal Service, First Class Mail.



Frank P. Presta

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

MV AGUSTA MOTOR S.P.A.)	
Opposer,)	Opposition No. 119,317 (Parent)
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TEAM OBSOLETE PRODUCTS, LTD.)	
Applicant.)	Docket No.: 4014-2 (formerly 2865-284)

**DECLARATION OF FRANK P. PRESTA IN SUPPORT OF OPPOSITION TO
APPLICANT'S MOTION FOR SUMMARY JUDGMENT AND
SUSPENSION OF PROCEEDINGS PENDING RESOLUTION OF MOTION**

I, Frank P. Presta, declare and state as follows:

1. I am an attorney with Nixon & Vanderhye P.C., 1100 N. Glebe Road, 8th Floor, Arlington, VA 22201, and an attorney of record appearing on behalf of Opposer, MV Agusta Motor S.p.A in this proceeding.

2. Attached hereto as Tab A is a true and correct copy of McCarthy on Trademarks, Fourth Edition, Vol. 3, §20:16, Rel. No. 17, 3/2001.

3. Attached hereto as Tab B is a true and correct copy of McCarthy on Trademarks, Fourth Edition, Vol. 2, §16:13, Rel. No. 17, 3/2001.

4. Attached hereto as Tab C is a true and correct copy of "Responses by Opposer to Applicant's First Set of Interrogatories, Requests for Admission, Production of Documents and Things to Opposer."

5. Attached hereto as Tab D are true and correct copies of "Supplemental Responses by Opposer to Applicant's First Request for Production of Documents and Things"; Press Release, dated March 9, 1992, and English translation thereof, attached thereto, which were submitted to Applicant.

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6. Attached hereto as Tab E are true and correct copies of "Opposer's Supplemental Responses to Applicant's First Request for Production of Documents and Things"; and Document Nos. 30-35 attached thereto, which were submitted to Applicant.

7. Attached hereto as Tab F are true and correct copies of Documents Nos. 2-7c, which Opposer submitted to Applicant in response to "Applicant's Request for Production of Documents and Things."

8. Attached hereto as Tab G is a true and correct copy of Document No. 28, which Opposer submitted to Applicant in response to "Applicant's Request for Production of Documents and Things."

9. Attached hereto as Tab H is a true and correct copy of McCarthy on Trademarks, Fourth Edition, Vol. 4, §29:4, Rel. No. 18, 6/2001.

10. Attached hereto as Tab I are true and correct copies of Document Nos. 41, 44 and 45 submitted to Applicant with "Opposer's Supplemental Responses to Applicant's First Request for Production of Documents and Things."

11. Attached hereto as Tab J are true and correct copies of "Opposer's First Set of Interrogatories to Applicant" and "Opposer's First Request to Applicant for the Production of Documents and Things."

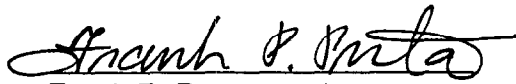
I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct to the best of my knowledge.

EXECUTED this 22 day of February, 2002 in Arlington, Virginia.


FRANK P. PRESTA

CERTIFICATE OF SERVICE

A copy of the foregoing DECLARATION OF FRANK P. PRESTA IN SUPPORT OF OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT AND SUSPENSION OF PROCEEDINGS PENDING RESOLUTION OF MOTION was served on Robert T. Iannauci, President, Team Obsolete Products, Ltd., 139 Henry Street, Brooklyn, New York 11201, this 22 day of February, 2002, via the United States Postal Service, First Class Mail.

A handwritten signature in black ink, appearing to read "Frank P. Presta", written in a cursive style with a horizontal line underneath.

Frank P. Presta