

TAB

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

THE PEP BOYS MANNY, MOE & JACK)
OF CALIFORNIA,)
)
Opposer,)
)
v.)
)
JET-PEP, INC.,)
)
Applicant.)



01-23-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #70

Opposition No.

NOTICE OF OPPOSITION

In the matter of applications to register a trademark under the Trademark Act of 1946, Serial No. 76/158,291, filed November 2, 2000, in the name of Jet-Pep, Inc., published for opposition in the Trademark Official Gazette of September 25, 2001, Volume 1250, No. 4, at page TM 479, for the mark JET-PEP, the Opposer, The Pep Boys Manny, Moe & Jack of California, believes it will be damaged by registration of said alleged trademark, and hereby opposes same.

The grounds for opposition are as follows:

COUNT I - LIKELIHOOD OF CONFUSION

1. The Opposer, the Pep Boys Manny, Moe & Jack of California is a corporation duly organized and existing under the laws of the state of California, and having its place of business at 3111 West Allegheny Avenue, Philadelphia, Pennsylvania.

2. Commencing over three quarters of a century ago, and long prior to the date of first use alleged in the application opposed herein, Opposer, through its predecessor in interest and licensee, The Pep Boys Manny, Moe & Jack [said licensee and Opposer hereinafter sometimes collectively referred to as "Pep Boys"] has, and is now, engaged in the distribution, marketing, sale,

advertising and promotion of a variety of automotive maintenance, repair, parts, accessories and retail store services throughout the United States, including wholesale distribution services to retail gasoline stations and service providers. Pep Boys currently operates over 600 retail locations throughout the United States and Puerto Rico.

3. For over three quarters of a century, and long prior to the date of first use alleged in the application opposed herein, Pep Boys continuously has used the name(s) and mark(s) **PEP BOYS, THE PEP BOYS** and **THE PEP BOYS MANNY, MOE & JACK** [hereinafter collectively referred to as the "**PEP BOYS Mark(s)**"], as well as a fanciful design of Pep Boys' founders, "MANNY, MOE & JACK", as exemplified in the registrations for same pleaded herein [hereinafter referred to as the "**PEP BOYS Logo**"] to identify and designate Opposer, its business, Opposer's wide variety of automotive products, services and retail stores, and to distinguish those goods, services, business and stores from those of others. Since Opposer's initial use of its **PEP BOYS Mark(s)** and name, and **PEP BOYS Logo**, Opposer has made a substantial investment in advertising and promotion of its goods and services and retail stores under said name and marks. Opposer has extensively and continuously used, advertised, promoted and offered its goods and services and chain of retail stores under the **PEP BOYS Mark(s)** and name, and **PEP BOYS Logo**, to the public through various channels of trade in interstate commerce, with the result that customers have come to know and recognize Opposer's **PEP BOYS Mark(s)** and name, and Opposer's **PEP BOYS Logo**, and to associate same with Opposer and/or the goods and services advertised, marketed, distributed, and/or sold by or on behalf of Opposer Pep Boys. Opposer thus has built up extensive goodwill under its **PEP BOYS Mark(s)** and name, and the **PEP BOYS Logo**, with the

result that since long prior to the date of first use alleged in the application opposed herein, said distinctive names and marks have become so well recognized as to be "famous".

4. Opposer Pep Boys is the owner of, and will rely upon herein, the following U.S. trademark and service mark registrations:

REGISTRATION NO.	ISSUE DATE
310,199	February 13, 1934
1,288,346	July 31, 1984
1,395,353	May 27, 1986
1,420,631	December 9, 1986
1,472,747	January 19, 1988
1,562,597	October 24, 1989
1,562,598	October 24, 1989
1,562,599	October 24, 1989
1,665,248	November 19, 1991
1,699,427	July 7, 1992
1,883,212	March 11, 1995
1,997,613	August 27, 1996
2,001,610	September 17, 1996
2,026,793	December 31, 1996
2,036,750	February 11, 1997
2,120,813	December 16, 1997
2,130,799	January 20, 1998
2,226,116	February 23, 1999
2,228,755	March 2, 1999

REGISTRATION NO.	ISSUE DATE
2,345,076	April 25, 2000
2,408,968	November 28, 2000

Said registrations operate as *prima facie* and/or conclusive evidence of Opposer's ownership of the marks set forth therein and exclusive right to use same in connection with the goods and services listed in those registrations. *See* 15 U.S.C. §§1065 and 1115(b).

5. Notwithstanding Opposer Pep Boys' long and well-known prior rights in and to the said distinctive and famous **PEP BOYS** Mark(s) and name and **PEP BOYS** Logo, on November 2, 2000, Applicant filed an application for registration of the mark JET-PEP. Said application was assigned Serial No. 76/158,291, and was published for opposition in the Official Gazette of September 25, 2001, at page TM 479, identifying the services as "retail gasoline station services and wholesale distributorships featuring gasoline."

6. The mark sought to be registered by Applicant is a simulation and colorable imitation of, and is confusingly similar to, Opposer's aforesaid famous **PEP BOYS** Mark(s) and name and/or **PEP BOYS** Logo.

7. Upon information and belief, Applicant's services are similar and/or related to Opposer's goods and services, and/or those offered or sold in Opposer's Pep Boys' stores, and are advertised, promoted and/or sold through the same and/or similar channels of trade and to the same general class of purchasers as Opposer's goods and services offered and sold under Opposer's **PEP BOYS** Mark(s) and name and **PEP BOYS** Logo.

8. Upon information and belief, customers of Pep Boys, as well as the public in general, are likely to be confused, mistaken or deceived as to the origin or sponsorship of Applicant's aforesaid services which are marketed, promoted, and/or sold under, or in connection with, the opposed mark sought to be registered by Applicant herein, and further, said persons are likely to be misled into believing that Applicant and/or Applicant's aforesaid services are rendered by, emanate from, or in some way are, directly or indirectly, associated with or connected to Opposer Pep Boys and/or its stores, products and/or services, to the damage and detriment of Opposer, its goodwill and reputation.

9. Applicant had constructive knowledge, and on information and belief, actual knowledge, of Opposer and its famous **PEP BOYS** Mark(s) and name and **PEP BOYS** Logo, and the goodwill and public recognition of said Logo, Mark(s) and name in connection with automotive accessory products, stores and services, prior to adopting, and determining to use the mark opposed herein, and Applicant had actual knowledge and notice of Opposer's claim of rights prior to the filing of the application opposed herein.

COUNT II - DILUTION

10. Opposer restates and realleges ¶¶1-9, inclusive, above, of this Notice of opposition, and hereby incorporates same as if fully set forth herein.

11. On information and belief, the registration and/or commercial use of the opposed JET-PEP mark by Applicant, as aforesaid, will dilute the distinctive quality of Opposer's aforesaid famous and distinctive **PEP BOYS** Mark(s) and name, and/or **PEP BOYS** Logo.

COUNT III - FRAUD ON THE TRADEMARK OFFICE

12. Opposer restates and realleges ¶¶1-11, inclusive, above, of this Notice of opposition, and hereby incorporates same as if fully set forth herein.

13. On or about October 21, 2000, Applicant signed, and on or about November 2, 2000 submitted to the U.S. Patent and Trademark Office (“PTO”) with the opposed application, a declaration (hereafter referred to as the “Declaration”), attesting and representing “that to the best of [the declarant’s] knowledge and belief no other person firm, corporation, or association has the right to use the [opposed] mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when used in rendering the services of such other person, firm, corporation or association, to cause confusion, mistake or to deceive,” when, in fact, Applicant had received actual notice from Opposer of Opposer’s pleaded **PEP BOYS** Mark(s) and name, and/or **PEP BOYS** Logo, that Opposer owned federal registrations for said Mark(s) and Logo, and that the unrestricted use and/or registration of the opposed mark in commerce throughout the United States would infringe and violate those rights.

14. The opposed application and Declaration, as and when signed and filed by Applicant, represented, directly or indirectly, that Applicant had the unrestricted right to use the opposed mark on the services set forth in the opposed application throughout the United States, when, in fact, Applicant was aware at that time that it did not have such unrestricted rights.

15. The statements and representations as alleged in ¶¶13 through 14, above, of this Notice of Opposition were material, false and/or misleading, and/or constituted a false and material omission, thereby resulting in fraud on the PTO and rendering the opposed application void.

COUNT IV - RESTRICTED USE

16. Opposer restates and realleges ¶¶1-15, inclusive, above, of this Notice of opposition, and hereby incorporates same as if fully set forth herein.

17. Any rights Applicant may have to use the opposed mark are limited geographically.

18. Because Applicant is not entitled to an unrestricted registration of the opposed mark granting rights throughout the United States (as defined in 15 U.S.C. §1127), Applicant is not entitled to the registration it seeks and/or the opposed application is void and/or voidable.

19. Opposer believes that it will be damaged by the registration by Applicant of the JET-PEP mark, as set forth in Applicant's application Serial No. 76/158,291, and that if registration on the opposed application is granted, and the presumptions accorded to such registration is conferred under the Trademark Act of 1946, as amended, Applicant will receive benefits to which it is not entitled, to the damage and detriment of Opposer, its **PEP BOYS** Mark(s) and name, and **PEP BOYS** Logo, and business.

WHEREFORE, this Opposer, **THE PEP BOYS MANNY MOE & JACK OF CALIFORNIA**, prays that:

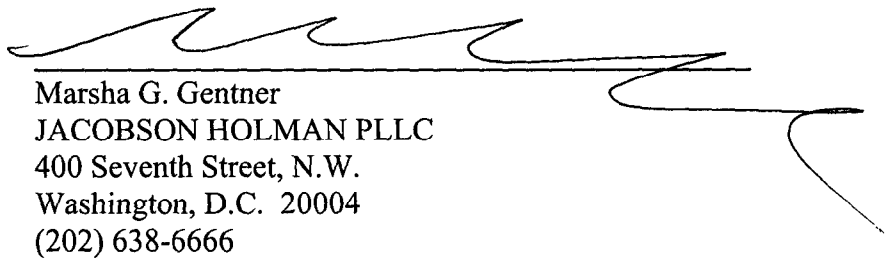
a. judgment for Opposer and against Applicant on each of Opposer's claims, Counts I through IV, inclusive, in the present Notice of Opposition be entered;

- b. the present opposition be sustained; and
- c. registration on application Serial No. 76/158,291 be rejected and refused.

Respectfully submitted,

THE PEP BOYS MANNY MOE & JACK
OF CALIFORNIA

By:



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Date: January 23, 2002

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January 23, 2002



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01-23-2002

U.S. Patent & TMOs/TM Mail Rpt Dt. #70



RE: New Opposition
The Pep Boys Manny, Moe & Jack of California v. Jet-Pep, Inc.
JET-PEP - Serial No. 76/158,291
Our Ref.: 3701/I-4565

We enclose the following for filing in the Patent and Trademark Office:

- Notice of Opposition (in duplicate)
- Notice of Appeal

Also enclosed is our check for the required filing fee in the amount of \$300.00. Should this check become detached, or the amount be insufficient, please charge our Deposit Account, No. 06-1358.

Respectfully submitted,

Marsha G. Gentner

MGG/tlb
Enclosures

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