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U.S. Patent & TMO/c/TM Mail Rpt. Dt. #57  
08-20-2002

TRADE MARKS  
Attorney Docket 21229

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

In the Matter of U.S. Application Serial No 76/291,524  
For: TREKKING  
Filed: July 27, 2001  
Date of Publication: July 30, 2002

TRADEMARK TRIAL AND  
APPEAL BOARD  
02 AUG 30 AM 12:03

TREK BICYCLE CORPORATION )  
 )  
 Opposer, )  
 )  
 v. ) Opposition No. \_\_\_\_\_  
 )  
 PARFUMS PAROUR )  
 (LIMITED COMPANY) )  
 )  
 Applicant. )

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No 76/291,524 ("Serial No 76/330,143") for the mark "TREKKING" in International Class 3, filed in the name of Parfums Parour (Limited Company) ("applicant"), which has been published for opposition in the Official Gazette of July 30, 2002. Trek Bicycle Corporation ("Trek"), a Wisconsin corporation with its principal place of business at 801 West Madison, Waterloo, Wisconsin 53594, believes it will be damaged by the registration of the mark in Serial No. 76/291,524 and hereby opposes the same,

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in accordance with Section 13 of The Trademark (Lanham) Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Trek alleges as follows:

1. Upon information and belief, applicant is a corporation organized under the laws of France with a principal place of business at 8, Rue Henri Rochefort, 75017 Paris, France.

2. Applicant seeks to register "TREKKING" for "soaps, namely, skin and hand; perfumery; cosmetics; hair lotions," in International Class 3, as evidenced by the publication of the mark in the Official Gazette of July 30, 2002, that application having been filed based on an intent to use the mark in commerce.

3. Upon information and belief, applicant intends to use "TREKKING" in connection with "soaps, namely, skin and hand; perfumery; cosmetics; hair lotions."

4. Since at least 25 years prior to applicant's application, Trek adopted and has continuously used the trade name "TREK" in connection with its business activities.

5. Trek has invested substantial amounts of time, effort and money in protecting and policing its "TREK" trade name throughout the United States and the rest of the world. As such, Trek has extensive, non-registered statutory and common law

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rights in its "TREK" trade name, which Trek uses in connection with its business activities.

6. Since at least 24 years prior to applicant's application for "TREKKING," Trek has continuously used its "TREK" mark in connection with bicycles and bicycle frames; Trek also has expanded its trade name and trademark use of "TREK" to cover numerous products and services, including, among other things, degreasing agents and cleaning products.

7. Trek has invested substantial amounts of time, effort and money in registering, promoting and policing its famous "TREK" trademark throughout the United States and the rest of the world. As such, in addition to the protection afforded Trek by its federal trademark registrations, Trek has extensive, non-registered statutory and common law rights in its "TREK" mark for its products and services.

8. Trek is the owner of U.S. Trademark Registration No. 1,168,276 for "TREK" for "bicycles and bicycle frames,"; U.S. Trademark Registration No. 1,989,281 for "TREKKING" for "bicycles"; U.S. Trademark Registration No. 1,994,479 for "TREK 100" for "providing ride support vehicles in competitive and recreational events, namely, bicycle tours, bicycle races, and

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triathalons"; U.S. Trademark Registration No. 2,060,274 for "TREK" for "exercise equipment, namely, stationary exercise cycles," "bicycles," "cycling computers," and "head protective helmets for bicycle users," among other things; U.S. Trademark Registration No. 2,188,991 for "TREK BMX" for "bicycles, bicycle frames, and bicycle structural parts"; and U.S. Trademark Registration No. 2,246,695 for "ELEC TREK" for "bicycles, bicycle frames and structural parts therefor"; U.S. Trademark Registration No. 2,580,991 for "TREKBIKES.COM" for "bicycle frames and parts"; and U.S. Trademark Registration No. 2,596,471 for "TREKKING" for "educational services, namely, providing seminars and clinics relating to the use of exercise equipment"; these registrations are valid, subsisting, uncancelled and are conclusive evidence of Trek's exclusive right to use the "TREK" mark in commerce on the goods and in connection with the services specified in the registrations.

9. Trek is also the owner of U.S. Trademark Application Serial No. 75/414,082 for "TREK" for clothing; and U.S. Trademark Application Serial No. 75/933,601 for "ETREK" for "on-line retail and wholesale store services, featuring a wide range of consumer products, except footwear, all provided via the Internet."

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10. Since at least as early as the respective dates of first use stated in its registrations and applications, Trek has used its marks in connection with the sale of its goods and services covered by those registrations and applications. Such use has been valid and continuous, and has not been abandoned. The relevant class of the public has come to associate Trek with the "TREK" trademark and trade name.

11. Since at least as early as 1994, Trek has been using its "TREK" trademark and trade name for degreasing agents and cleaning products.

12. Trek's web site located at [www.trekbikes.com](http://www.trekbikes.com) includes an online store featuring degreasing agents and cleaning products.

13. Prior to applicant's application for "TREKKING," Trek's "TREK" mark had become famous for Trek's goods and services.

14. Applicant has no license, consent or permission from Trek to use or register the mark "TREKKING."

15. Applicant's mark "TREKKING" so resembles Trek's "TREK" mark and trade name that, when used on or in connection with applicant's goods or services, it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section

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2(d) of The Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(d); and more particularly, applicant's mark and use thereof are likely to cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that applicant's goods or services originate with Trek or otherwise are authorized, licensed or sponsored by Trek.

16. The use and registration of the mark in Serial No 76/291,524 will dilute the distinctive quality of Trek's famous "TREK" mark within the meaning of Section 43(c) of the Trademark (Lanham) Act of 1946, 15 U.S.C. §1125(c), and will lessen the ability of Trek's "TREK" mark to distinguish the products and services of Trek.

17. By reason of all the foregoing, Trek will be gravely damaged by the registration of applicant's "TREKKING" mark, because registration of that mark would be in violation of Trek's trademark and trade name rights.

WHEREFORE, Trek prays that this Notice of Opposition be sustained in favor of Trek and that Serial No 76/291,524 be denied registration. Trek submits herewith a duplicate copy of

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this Notice of Opposition, along with a check to cover its filing  
fee of \$300 as required by 37 C.F.R. §2.6(a)(17).

Respectfully submitted,

TREK BICYCLE CORPORATION

Date: 8/20/02

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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"Express Mail" mailing label number: EV 057958602 US

Date of Deposit: August 20, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, BOX TTAB - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

- (1) Notice of Opposition in duplicate
- (2) A check for \$300

Mary Catherine Merz  
Mary Catherine Merz

TRADEMARKS  
Attorney Docket No. 21229  
Date: August 20, 2002

COMMISSIONER FOR TRADEMARKS  
BOX TTAB - FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

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08-20-2002

Transmitted herewith is the:

- Trademark
- Service Mark
  
- Application
- Notice of Opposition
- Petition to Cancel
- Office Action Response
- Supplemental Response
- Combined Sections 8 and 15 Declaration
- Consented Motion to Extend Discovery  
and Testimony Periods
- Request to Lift Suspension

Of Opposer: Trek Bicycle Corporation

For: "TREKKING"

Also enclosed are:

- Notice of Opposition & Copy
- Check No. 5731 for \$300

In the unlikely event that insufficient funds are submitted herewith to cover the filing fee in this correspondence, please charge such funds against Deposit Account No. 50-0277.

Respectfully submitted,

Enclosures

By: Mary Catherine Merz

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