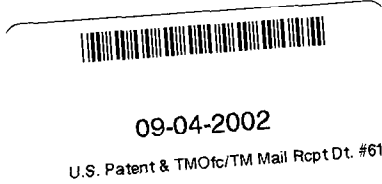


Service mark

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. |) | Opposition No. |
| |) | |
| ACTION AUTO ACCESSORIES, INC. |) | |
| |) | |
| Applicant. |) | |



NOTICE OF OPPOSITION

In the matter of an application to register a service mark under the Service mark Act of 1946, Serial No. 76/340,342, filed November 19, 2001, in the name of Action Auto Accessories, Inc., published for opposition in the Service mark Official Gazette of May 7, 2002, Volume 1258, No. 1, at page TM 533, for the mark PRO CAR PARTS (Stylized) and Banner Design, the Opposer, The Pep Boys Manny, Moe & Jack of California, believes it will be damaged by registration of said alleged service mark, and hereby opposes same. The grounds for opposition are as follows:

1. The Opposer 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, Philadelphia, Pennsylvania.
2. Commencing nearly three quarters of a century ago, and 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

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and promotion of a variety of vehicle parts and accessories, as well as retail and wholesale store and automotive maintenance and repair services, throughout the United States.

3. Prior to the date of first use alleged in the application opposed herein, Pep Boys continuously has used the name(s) and mark(s) **PRO START** (with and without a hyphen, and as one word and two words), **PRO COOL, PRO STOP, PROLINE, PROLIFT, PROSOURCE, PROTEMP, PROTESTER,** and **PRO RYDER** [said marks and the **PROSTEER** mark identified below hereinafter collectively referred to as Opposer's "**PRO Mark(s)**"], as well as a logo comprised of a banner design [as shown in U.S. Registration No. 2,168,933 and hereafter referred to as Opposer's "**BANNER Design**"] to identify and designate a wide variety of auto parts, accessories, and services, including the services set forth in the opposed application, and to distinguish those goods and services from those of others. Since Opposer's initial use of its **PRO Mark(s)** and **BANNER Design**, Opposer has continuously used, advertised, promoted and offered its goods and services under the **PRO Mark(s)**, and under the **BANNER Design**, to the public through various channels of trade in interstate commerce, with the result that customers have come to know and recognize Opposer's **PRO Mark(s)** and Opposer's **BANNER Design**, 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.

4. Opposer also claims ownership of, and a right of priority vis-a-vis Applicant, in the mark **PROSTEER**, as used for automotive products.

5. 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 |
|-------------------------|--------------------|
| 1,160,742 | July 14, 1981 |
| 1,762,699 | April 6, 1993 |
| 1,796,948 | October 5, 1993 |
| 1,835,366 | May 10, 1994 |
| 1,883,212 | December 20, 1993 |
| 1,891,550 | April 25, 1995 |
| 1,898,072 | June 6, 1995 |
| 1,918,786 | September 12, 1995 |
| 1,994,367 | August 20, 1996 |
| 1,995,918 | August 20, 1996 |
| 2,014,042 | November 5, 1996 |
| 2,026,793 | December 31, 1996 |
| 2,059,747 | May 6, 1997 |
| 2,121,550 | December 16, 1997 |
| 2,168,933 | June 30, 1998 |
| 2,179,083 | August 4, 1998 |
| 2,393,467 | October 10, 2000 |
| 2,408,433 | November 28, 2000 |
| 2,474,353 | July 31, 2001 |
| 2,356,875 | June 13, 2000 |
| 2,491,066 | September 18, 2001 |
| 2,583,003 | June 18, 2002 |

Each of the registrations listed above 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). Opposer also is the owner of applications Serial Nos. 76/050,341 (Notice of Allowance issued May 7, 2002) and 76/189,675 (Notice of Allowance issued February 26, 2002), and will rely herein on the registrations which issue on such applications.

6. Upon information and belief, on November 19, 2001, Applicant filed an application for registration of the mark PRO CAR PARTS (Stylized) and Banner Design. Said application was assigned Serial No. Serial No. 76/340,342, and was published for opposition in the Official Gazette of May 7, 2002, at page TM 533, covering "online computer internet services and retail and wholesale store services by means of an online global network in the field of auto parts and accessories".

7. The service mark sought to be registered by Applicant is a simulation and colorable imitation of, and is confusingly similar to, Opposer's aforesaid **PRO** Mark(s).

8. The service mark sought to be registered by Applicant is virtually identical to, a simulation and colorable imitation of, and is confusingly similar to, Opposer's aforesaid **BANNER Design**.

9. Upon information and belief, Applicant's services are the same, similar and/or related to, Opposer's goods and services, and are and/or will be 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 **PRO** Mark(s) and Opposer's **BANNER Design**.

10. Upon information and belief, customers of Opposer 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 services and stores which are marketed, promoted, and/or sold under, or in connection with, the opposed PRO CAR PARTS (Stylized) and Banner Design service 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 stores and/or services are rendered by, emanate from, or in some way are, directly or indirectly, associated with or connected to Opposer Pep Boys, its stores and/or products and/or services, to the damage and detriment of Opposer.

11. Opposer believes that it will be damaged by the registration by Applicant of the PRO CAR PARTS (Stylized) and Banner Design service mark, as set forth in Applicant's application Serial No. 76/340,342, and that if registration on the opposed application is granted, and the presumptions accorded to such registration are 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 **PRO** Mark(s), its **BANNER Design**, and Opposer's business.


WHEREFORE, this Opposer, The Pep Boys Manny, Moe & Jack prays that:

- a. judgment for Opposer and against Applicant in the present opposition be entered;
- b. registration of application Serial No. 76/340,342 of Action Auto Accessories, Inc. be rejected and refused; and
- c. the present opposition be sustained.

Respectfully submitted,

THE PEP BOYS MANNY, MOE & JACK
OF CALIFORNIA

By:


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Date: September 4, 2002



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September 4, 2002



09-04-2002
 U.S. Patent & TMO/TM Mail Rcpt Dt. #61

Assistant Commissioner for Trademarks
 2900 Crystal Drive
 Arlington, Virginia 22202-3513

RE: New Opposition
 The Pep Boys Manny, Moe & Jack of California
 v. Action Auto Accessories, Inc.
 PRO CAR PARTS (Stylized) and Banner Design
 - Serial No. 76/340,342
 Our Ref.: 3701/I-4679

TRADEMARK TRIAL AND
 APPEAL
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Sir:

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