

TTAB

12-10-2002

U.S. Patent & TMOs/TM Mail Rpt. Dt. #40

TRADEMARKS
Attorney Docket 21142

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

In the Matter of U.S. Application Serial No. 76/331,540
For: GLOBE TREKKER and Design
Filed: October 26, 2001
Date of Publication: November 12, 2002

TREK BICYCLE CORPORATION)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
PILOT FILM & TELEVISION)	
PRODUCTIONS LTD.)	
)	
Applicant.)	

02 DEC 24 AM 9:30

TTAB - TRADE TRIAL AND APPEAL BOARD

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 76/331,540 ("Serial No. 76/331,540") for the mark "GLOBE TREKKER and Design" in International Class 16, filed in the name of PILOT FILM & TELEVISION PRODUCTIONS LTD. ("applicant"), which was published for opposition in the Official Gazette of November 12, 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. 76/331,540 and hereby

12/20/2002 KGIBBONS 00000121 76331540

01 FC:6402

300.00 OP

Opposition Against "GLOBE TREKKER and Design"
Serial No. 76/331,540

opposes the same, 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 United Kingdom corporation with a principal place of business at 18 Middle Row, London W10 5AT, United Kingdom.

2. Applicant seeks to register "GLOBE TREKKER and Design" in connection with "books in the fields of food and cultures of various regions of the world," in International Class 16, as evidenced by the publication of Serial No. 76/331,540 in the Official Gazette of November 12, 2002.

3. Upon information and belief, applicant has filed its application under Section 1(b) of the Trademark Act, [15 U.S.C. §1051(b)], claiming an intent to use the mark on the goods.

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 rights in its "TREK" trade name, which Trek uses in connection

Opposition Against "GLOBE TREKKER and Design"
Serial No. 76/331,540

with its business activities.

6. Since at least 24 years prior to applicant's application for "GLOBE TREKKER and Design," Trek has continuously used its "TREK" mark in connection with bicycles, bicycle frames, bicycle parts and accessories; Trek also has expanded its trademark use of "TREK" to cover numerous products and services, including, among other things, apparel, exercise equipment, cycling computers, computer games and video games, lights, bags and packs, and a variety of accessories for indoor and outdoor activities; furthermore, Trek sponsors a variety of outdoor sporting events.

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

Opposition Against "GLOBE TREKKER and Design"
Serial No. 76/331,540

100" for "providing ride support vehicles in competitive and recreational events; namely, bicycle tours, bicycle races, and triathlons"; U.S. Trademark Registration No. 2,060,274 for "TREK" for "cycling computers and head protective helmets for bicycle users," "bicycles," "bicycle frames," "bicycle suspensions," "bicycle carrying racks for motor vehicles," and "exercise equipment, namely stationary exercise cycles," among other things; U.S. Trademark Registration No. 2,188,991 for "TREK BMX" for "bicycles, bicycle frames, and bicycle structural parts"; 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 "bicycles, 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

Opposition Against "GLOBE TREKKER and Design"
Serial No. 76/331,540

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".

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 public has come to associate Trek with the "TREK" trademark and trade name.

11. Prior to applicant's application for "GLOBE TREKKER and Design," Trek's "TREK" mark had become famous for Trek's goods and services.

12. Applicant has no license, consent or permission from Trek to use or register "GLOBE TREKKER and Design".

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

Opposition Against "GLOBE TREKKER and Design"
Serial No. 76/331,540

or to deceive the trade and purchasing public into believing that applicant's goods originate with Trek or otherwise are authorized, licensed or sponsored by Trek.

14. The use and registration of the mark in Serial No. 76/331,540 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.

15. By reason of all the foregoing, Trek will be gravely damaged by the registration of applicant's "GLOBE TREKKER and Design" 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. 76/331,540 be denied registration. Trek submits a copy of

Opposition Against "GLOBE TREKKER and Design"
Serial No. 76/331,540

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: 12/10/02

By: Amy Muran Felton
Mary Catherine Merz, Esq.
Amy Muran Felton, Esq.
MERZ & ASSOCIATES, P.C.
1140 Lake Street, Suite 304
Oak Park, Illinois 60301-1051
(708) 383-8801 (phone)
(708) 383-8897 (fax)
mcmmerz_law@msn.com (e-mail)

Attorneys for Opposer

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"Express Mail" mailing label number: EV057959191 US
Date of Deposit: December 10, 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.

Amy Muran Felton

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

12-10-2002

U.S. Patent & TMO/c/TM Mail Rpt. Dt. #40

Transmitted herewith is the:

- Trademark
- Service Mark

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

In the Matter of U.S. Application Serial No. 76/331,540

For: "GLOBE TREKKER and Design"

Also enclosed are:

- Notice of Opposition in duplicate
- Check No. 5927 for \$300.00

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: Amy M. Merz

MERZ & ASSOCIATES, P.C.
Attorneys at Law
1140 Lake Street, Suite 304
Oak Park, Illinois 60301-1051
(708) 383-8801 (phone)
(708) 383-8897 (fax)
mcmmerz_law@msn.com (E-mail)

02 DEC 24 AM 9:36