

TTAB

TRADEMARK TRIAL AND APPEAL BOARD

03 AUG 27 09:32

06-23-2003

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

UNITED STATES DEPARTMENT OF
COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: June 13, 2003

Opposition No 91156634
Serial No. 76026687

JAMES D. HALSEY JR.
STAAS & HALSEY LLP
SUITE 700 1201 NEW YORK AVE., NW
WASHINGTON, DC 20005

TREK BICYCLE CORPORATION

v.

FUJITSU LIMITED

AMY FELTZ
MERZ & ASSOCIATES, P.C.
1140 LAKE STREET, SUITE 304
OAK PARK, IL 60301-1051

Juan M. Porter, Legal Assistant

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

ANSWER IS DUE FORTY DAYS after the mailing date hereof.
(See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday or a holiday).

Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations. The parties are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64.

Opposition No. 91 156,634

A copy of the recent amendments to the Trademark Rules, as well as the *Trademark Trial and Appeal Board Manual of Procedure* (TBMP), is available at <http://www.uspto.gov>.

Discovery and testimony periods are set as follows:

Discovery period to open: **July 03, 2003**

Discovery period to close: **December 30, 2003**

30-day testimony period for party
in position of plaintiff to close: **March 29, 2004**

30-day testimony period for party
in position of defendant to close: **May 28, 2004**

15-day rebuttal testimony period
for plaintiff to close: **July 12, 2004**

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

Opposition No. 91 156,634

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

Mermelstein

TRADEMARKS
Attorney Docket 21347

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

In the Matter of U.S. Application Serial No. 76/026,687
For: SURETREK
Filed: April 14, 2000
Date of Publication: June 3, 2003



TREK BICYCLE CORPORATION)
)
Opposer,)
)
v.)
)
FUJITSU LIMITED)
)
Applicant.)

Opposition No. _____

06-04-2003

U.S. Patent & TMO/TM Mail Room Dt. #39

06 JUN 13 PM 9:31

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 76/026,687 ("Serial No. 76/026,687") for the mark "SURETREK" in International Class 9, filed by Fujitsu Limited ("applicant"), which was published for opposition in the Official Gazette of June 3, 2003. 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. 76/026,687 and hereby opposes the same, in accordance with Section 13 of The Trademark (Lanham) Act of 1946, 15 U.S.C. §1063.

06/09/2003 EPINRI 00000036 76026687

01 FC:6402

300.00 OP

21347.opp

Opposition Against "SURETREK"
Serial No. 76/026,687

As grounds for the opposition, Trek alleges as follows:

1. Upon information and belief, applicant is a Japanese corporation with a mailing address of 1-1, Kamikodanaka 4-Chome, Nakahara-Ku, Kawasaki-shi Kanagawa-Ken, Japan.

2. Applicant seeks to register "SURETREK" in connection with the following goods:

"Computer software for use in designing integrated circuits where two digital circuits are compared and checked to determine if they are functionally equivalent," in International Class 9;

as evidenced by the publication of Serial No. 76/026,687 in the Official Gazette of June 3, 2003.

3. Upon information and belief, applicant filed its application on April 14, 2000, under Section 44(e) of the Trademark Act [15 U.S.C. §1126(e)], claiming an intent to use the mark in commerce in the United States, as well as priority based on the corresponding Japanese application (which has since issued to registration).

4. Since at least 24 years prior to applicant's filing of the trademark application for "SURETREK", 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

Opposition Against "SURETREK"
Serial No. 76/026,687

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 with its business activities.

6. Since at least 23 years prior to applicant's filing of the trademark application for "SURETREK", 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, computer games, video games, cycling computers, lights, bags and packs, stationary exercise cycles, a variety of accessories for indoor and outdoor activities; furthermore, Trek uses its mark for educational services, namely, providing seminars and clinics relating to the use of exercise equipment.

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,

Opposition Against "SURETREK"
Serial No. 76/026,687

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 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"; 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"; and U.S. Trademark Registration No. 2,687,012 for

Opposition Against "SURETREK"
Serial No. 76/026,687

"ETREK" for "on-line retail and wholesale store services, featuring a wide range of consumer products, except footwear, all provided via the Internet"; 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.

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 the filing of applicant's trademark application for "SURETREK", 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 "SURETREK".

Opposition Against "SURETREK"
Serial No. 76/026,687

13. Applicant's mark "SURETREK" 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, 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. By reason of all the foregoing, Trek will be gravely damaged by the registration of applicant's "SURETREK" 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. 76/026,687 be denied registration. Trek submits herewith a copy of this Notice


TRADEMARKS
Attorney Docket No. 21347
Date: June 4, 2003

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

Transmitted herewith is the:

- Trademark
- Service Mark

- Application
- Notice of Opposition
- Office Action Response
- Petition to Cancel
- Combined Sections 8 and 15 Declaration
- Statement of Use
- Request to Lift Suspension


06-04-2003
U.S. Patent & TMO/TM Mail Rpt Dt. #39

In the matter of U.S. Application Serial No. 76/026,687

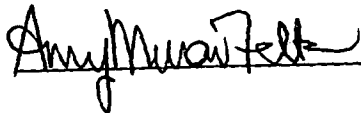
For: SURETREK

Also enclosed are:

- Notice of Opposition, in duplicate
- Check No. 6253 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,

By: 

Enclosures

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)

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Assistant Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513

If Undeliverable Return in Ten Days

OFFICIAL BUSINESS

PENALTY FOR PRIVATE USE, \$300

AN EQUAL OPPORTUNITY EMPLOYER

91156634
JAMES D. HALSEY JR.
STAAS & HALSEY LLP
SUITE 700 1201 NEW YORK AVE.
NW
WASHINGTON, DC 20005

Handwritten signature and initials

FIRST CLASS

