

Opposition Against "TREKER"
Serial No. 78/182,435

As grounds for the opposition, Trek alleges as follows:

1. Upon information and belief, applicant is a Kansas corporation with a principal place of business at 1525 E. North Street, Salina, Kansas 67416.

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

"Off-road all-terrain utility vehicles," in International Class 12;

as evidenced by the publication of Serial No. 78/182,435 in the Official Gazette of November 18, 2003.

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 "TREKER" for Class 12 goods.

4. Since at least 26 years prior to the filing of applicant's application for the mark "TREKER," 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 25 years prior to the filing of applicant's application for the mark "TREKER," 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.

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 triathlons"; U.S. Trademark Registration No. 2,060,274 for "TREK"

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for cycling computers, water bottles, water bottle cages, exercise equipment, and head protective helmets (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"; U.S. Trademark Registration No. 2,687,012 for "ETREK" for "on-line retail and wholesale store services, featuring a wide range of consumer products, except footwear, all provided via the Internet"; U.S. Trademark Registration No. 2,708,232 for "TREK" for non-alcoholic beverages and non-carbonated drinking waters; U.S. Trademark Registration No. 2,742,116 for "TREK Stylized" for "bicycles and bicycle frames;" and U.S. Trademark Registration No. 2,745,442 for "TREK" for clothing and padded gloves; 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

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services specified in the registrations.

9. Trek is also the owner of U.S. Trademark Application Serial No. 78/316,205 for "TREK" for "backpacks, cell phone packs, fanny packs, frame packs, grocery bags, handlebar bags, hip packs, messenger bags, panniers, rack trunks, saddle bags, seat packs, and sports bags."

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 application for the mark "TREKER," 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 "TREKER."

13. Applicant's mark "TREKER" 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

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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 "TREKER" 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. 78/182,435 be denied registration. Trek submits herewith a copy of this Notice

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of Opposition, along with a check to cover its filing fee of
\$300.00, as required by 37 C.F.R. §2.6(a)(17).

Respectfully submitted,

TREK BICYCLE CORPORATION

Date: November 21, 2003 By: Mary Catherine Merz
Mary Catherine Merz, 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: EL 987790511 US

Date of Deposit: November 21, 2003

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.

November 21, 2003

TTAB

TRADEMARKS
Attorney Docket No. 21411
Date: November 21, 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
- Sections 8 and 15 Declaration
- Express Withdrawal of Application



11-21-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

In the matter of U.S. Application Serial No. 78/182,435

For: TREKER

Also enclosed are:

- Notice of Opposition in duplicate
- Check No. 6582 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

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)