

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

Atty. Ref. No.: 016756/0231

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BFS BRANDS, LLC and :  
: :  
BRIDGESTONE/FIRESTONE :  
NORTH AMERICAN TIRE, LLC :  
: :  
Opposers, :  
: :  
v. :  
: :  
JON SNYDER, INC. D/B/A :  
JBS TECHNOLOGIES CORP. :  
: :  
Applicant. :  
-----:

Opposition No. \_\_\_\_\_

Application Serial No. 76/512,134



02-17-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

**NOTICE OF OPPOSITION**

This is in the matter of an application for registration of the expression "FIREHAWK" for "on-road and off-road motorbikes," Serial No. 76/512,134, filed May 6, 2003 by Jon Snyder, Inc. d/b/a/ JBS Technologies Corp., having a business address at 225 Technology Way, Steubenville, Ohio 43952 (hereinafter "applicant"), and published for opposition in the Official Gazette of December 16, 2003.

BFS Brands, LLC, a limited liability company of Delaware, with a business address at 50 Century Boulevard, Nashville, Tennessee 37214, and Bridgestone/Firestone North American Tire, LLC, a Delaware limited liability company, having a business address at 1 Bridgestone

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Park, Nashville, Tennessee 37214, believe that they would be damaged by registration as sought in the foregoing application and hereby oppose the same.

The grounds for the opposition are as follows:

1. BFS Brands, LLC and Bridgestone/Firestone North American Tire, LLC (collectively “opposers”) are wholly owned subsidiaries of Bridgestone Americas Holding, Inc., and trace their ultimate origin to The Firestone Tire & Rubber Company (hereinafter called “Firestone”).

2. By the application herein opposed, applicant seeks to register “FIREHAWK” as a trademark for “on-road and off-road motorbikes,” basing such application for United States federal registration on a claim of a bona fide intent to use the proposed mark in commerce in connection with the identified goods.

3. Opposers, as the successors in interest to Firestone, are the owners of all right, title and interest in and to various FIREHAWK marks for vehicle tires. Opposer BFS Brands, LLC is the owner of many U.S. Trademark Registrations featuring the mark FIREHAWK. Among such U.S. registrations are Reg. No. 1,471,366, registered January 5, 1988, for the mark FIREHAWK for vehicle tires, which registration has attained incontestable status and remains in full force and effect. Other such U.S. registrations include Reg. No. 1,473,045; Reg. No. 1,475,837; Reg. No. 1,478,589; Reg. No. 1,626,958; Reg. No. 1,629,063; Reg. No. 1,875,903; Reg. No. 2,131,198; Reg. No. 2,173,839; Reg. No. 2,176,680; Reg. No. 2,181,398; Reg. No. 2,218,594; Reg. No. 2,274,940; Reg. No. 2,368,866;

Reg. No. 2,396,328; Reg. No. 2,418,297; and Reg. No. 2,541,273. Opposer Bridgestone/Firestone North American Tire LLC uses the registered FIREHAWK mark with the authorization of BFS Brands, LLC.

4. The term FIREHAWK was adopted as a mark and name by a predecessor of opposers almost twenty years ago, in October, 1984 and has been used continuously since then to the present in connection with the advertising, promotion, sale and offering of opposers' vehicle tires; and is still in such use by opposers.

5. Opposer BFS Brands, LLC is also the owner of many U.S. Trademark and Service Mark Registrations featuring the mark FIRESTONE. Among such U.S. registrations are Reg. No. 140,804, registered March 29, 1921, for the mark FIRESTONE in a stylized form for rubber tires and other products, which registration is still in full force and effect. Other such U.S. registrations include Reg. No. 378,189; Reg. No. 396,796; Reg. No. 401,421; Reg. No. 948,402; Reg. No. 1,178,631; Reg. 1,387,468; Reg. No. 1,445,182; Reg. No. 1,471,665; Reg. No. 2,223,630; Reg. No. 2,464,005; Reg. No. 2,507,769; Reg. No. 2,582,878; and Reg. No. 2,813,281. As used herein, "opposers' goods," "opposers' services," and "opposers' business," as well as expressions to a similar effect, mean the goods, the services and the business of Firestone, which is the predecessor in title of opposers. Opposer Bridgestone/Firestone North American Tire LLC uses the registered FIRESTONE mark and name with the authorization of BFS Brands, LLC.

6. The term FIRESTONE was adopted as a mark and name by a predecessor of opposers more than one hundred years ago, in January, 1896, and has been used continuously since then to the present in connection with the advertising, promotion, sale and offering of opposers' tires and other goods in interstate commerce; and is still in such use by opposers.

7. Opposers' FIREHAWK and FIRESTONE marks are of significant value to opposers as identifications of source in connection with the promotion, sale, rendering and offering of the goods of opposers and their affiliates, as well as in the conducting and identifying of the businesses of opposers and its affiliates; and such marks distinguish such goods and businesses from those of others.

8. Opposers and their affiliates have been using the FIREHAWK and FIRESTONE marks since prior to any date on which applicant may rely in this proceeding, and in particular, have been using such marks long prior to the filing date of the intent-to-use application herein opposed.

9. Opposers promote the FIREHAWK and FIRESTONE marks in a variety of ways, including through extensive participation in and sponsorship of open wheel racing competitions such as the FIREHAWK 500. Opposers' FIREHAWK tires are the exclusive tires of the Indianapolis 500, the most well-known automobile racing event in the United States. Such tires prominently display opposers' famous FIREHAWK marks, as well as opposers' separate mark FIRESTONE, which is also a famous mark and has been in use in commerce continuously for

over 100 years. As a result of such activities, opposer's FIREHAWK and FIRESTONE marks have been widely exposed to both racing fans and the general public.

10. The FIREHAWK mark for opposers' goods, and the "FIREHAWK" mark as sought to be registered by applicant for "on-road and off-road motorbikes," on the other hand, are identical in sound, spelling and appearance.

11. The FIRESTONE mark for opposers goods and services, and the "FIREHAWK" mark as sought to be registered by applicant for "on-road and off-road motorbikes," on the other hand, are confusingly similar in sound, spelling and appearance.

12. Applicant asserts a bona fide intent to use its mark in commerce in connection with "on-road and off-road motorbikes." Applicant's goods are similar and related to opposers' goods, and are likely to be marketed and sold in the same trade channels as opposers' vehicle tires, and other goods and services.

13. Through use and promotion by opposers and their affiliates of opposers' FIREHAWK and FIRESTONE marks for opposers' goods and businesses, purchasers and prospective purchasers of such goods and/or of goods and services of the same general kind, as well as customers and prospective customers of such businesses, associate such marks with the goods, services and businesses of opposers.

14. Purchasers and prospective purchasers familiar with opposers' goods and businesses identified by the FIREHAWK and FIRESTONE marks are likely to be misled into

believing, contrary to fact, that applicant's goods sold under the "FIREHAWK" mark opposed herein emanate from or are in some way sponsored by opposers or their affiliates, all to opposers' irreparable damage through loss and/or dilution of their good will as symbolized by opposers' marks and names.

15. Granting of a registration as sought by applicant through the application herein opposed would inhibit opposers in the free use of their registered FIREHAWK and FIRESTONE marks in selling their products and conducting their businesses, which would work manifest damage upon opposers. Such registration would constitute prima facie evidence of an exclusive right to use the designation "FIREHAWK" for the goods designated in the application herein opposed and for all confusingly similar uses, thereby enabling applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of opposers.

16. In view of extensive use and promotion of opposers' FIREHAWK mark for approximately twenty years, and of opposers' FIRESTONE mark and name for over one hundred years, and in view of the widespread renown and recognition thereby developed, opposers' FIREHAWK mark and FIRESTONE mark have long been famous marks. Such FIREHAWK and FIRESTONE marks have been famous since long before the date on which applicant has filed its intent-to-use application for its "FIREHAWK" mark and since long before any date on which applicant may rely for priority purposes in this proceeding. Applicant's "FIREHAWK" mark, which is the subject of the application opposed herein, causes and will

cause dilution of the distinctive quality of opposers' famous FIREHAWK and FIRESTONE marks, all to the further damage of opposers.

17. The application opposed herein was filed May 6, 2003, which was subsequent to January 16, 1996, the effective date of the federal anti-dilution statute embraced by Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Accordingly, the application herein opposed is subject to being opposed on the ground that the mark sought to be registered dilutes the distinctive quality of opposer's famous marks.

18. For at least the above reasons, registration of the application Serial No. 76/512,134 is herein opposed on the grounds that applicant's proposed "FIREHAWK" mark so resembles opposers' FIREHAWK mark and FIRESTONE mark and names as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and under state statutory law and common law.

19. Additionally, registration of applicant's "FIREHAWK" mark is opposed on the grounds that it will dilute the distinctive quality of opposers' FIREHAWK and FIRESTONE marks and names under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

WHEREFORE, opposers request that this opposition be sustained and the subject application Serial No. 76/512,134 to register the mark "FIREHAWK" be refused registration.

A check in the amount of \$600.00 is attached to cover the statutory filing fee.

Respectfully submitted,

BFS Brands, LLC and

Bridgestone/Firestone North American  
Tire, LLC

*February 17, 2004*

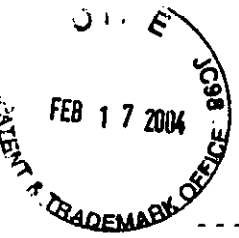
Date:

By:



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JON SNYDER, INC. D/B/A  
JBS TECHNOLOGIES CORP.  
Applicant.

Application No.: 76/512,134

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TRANSMITTAL LETTER

The Honorable Commissioner of  
Patents and Trademarks  
Washington, D.C. 20231



02-17-2004

U.S. Patent & TMO/TM Mail Report #22

Madam:

Please find attached hereto the following items:

1. Notice of Opposition (in duplicate)
2. Check (\$600.00) Covering Filing Fee

Please charge any additional fees due to Deposit Account No. 19-0741.

Respectfully submitted,

February 17, 2004

By: Geoffrey M. McNutt  
Peter G. Mack  
Geoffrey M. McNutt  
Counsel for Opposer

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