

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

DNA Specialty, Inc.,
Opposer,

v.

Piaggio & C. S.p.A.,
Applicant.

) Opposition No.: _____
)
) Serial No.: 75/893,540
)
) Mark: DNA
)
)
)



04-05-2004

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

BOX TTAB
Commissioner for Trademarks
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22201-3513

NOTICE OF OPPOSITION

DNA Specialty, Inc., a corporation organized under the laws of California, having a place of business at 1415 West 178th Street, Gardena, California 90248, believes it will be damaged and injured by the registration of the mark DNA for "two wheeled motor vehicles, namely, motor scooters, motorcycles, mopeds, motor bicycles and bicycles" in International Class 12, as shown in Application Serial No. 75/893,540, filed on January 10, 2000 by Piaggio & C. S.p.A. (hereinafter "Applicant"), and published on November 11, 2003 at page TM 282 of the *Official Gazette for Trademarks*.

Opposer alleges, solely for the purpose of this proceeding, as grounds for opposition, the following:

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1. Opposer is the owner of common law rights in the marks **DNA** and **DNA SPECIALTY INC.** (hereinafter collectively as the “**DNA Marks**”) which it has continuously used in interstate commerce since March 1985.

2. Opposer manufactures and sells a wide range of equipment, parts and accessories for motorcycles, ATVs and other motor vehicles under the **DNA Marks** including, without limitation, helmets, headlights, wheels, wheel rims, wheel gauges, steering wheels, wheel rims, hydraulic kits, exhaust tips, mufflers, power pumps, high pressure pumps, pump heads torques hoses, ball bearing end caps, battery chargers, billet adapters, wheel locks, lug nuts, spacers shift knobs valves truck stems, wheel disc simulators and switch boxes.

3. Opposer has prominently, extensively and continuously used, promoted and advertised its **DNA Marks** for over 19 years throughout the United States. By virtue of Opposer’s efforts, the expenditure of considerable sums for promotional activities, and by virtue of the excellent quality of Opposer’s goods, Opposer has gained a most valuable reputation in its **DNA Marks**.

4. Opposer’s **DNA Marks** are famous, and became famous well prior to October 29, 1999, the priority filing date of Applicant’s application. Opposer’s **DNA Marks** are therefore entitled to a high degree and wide zone of protection. If Applicant’s alleged trademark captioned above is allowed to register, such registration will dilute the distinctive quality of Opposer’s famous **DNA Marks**.

5. Applicant filed Application Serial No. 75/893,540 for **DNA** for “two wheeled motor vehicles, namely, motor scooters, motorcycles, mopeds, motor bicycles and bicycles” in International Class 12, on January 10, 2000, based on an intent to use the mark in U.S. commerce

and a claim of priority based upon a European Community trademark application, which was filed on October 29, 1999. The application was amended on August 14, 2001 to assert reliance on a European Community trademark registration as a basis for registration. On November 11, 2003, the application was published for opposition at page TM 282 of the *Official Gazette for Trademarks*. According to the USPTO records, no amendment to allege use has been filed.

6. In light of the priority claim, the application at issue has an effective filing date of October 29, 1999; however, Opposer first used its **DNA** Marks in commerce in March 1985. Therefore, there is no issue as to priority as Opposer is the senior user.

7. Applicant's alleged mark is confusingly similar to Opposer's mark, which has been continuously used on or in connection with its products since at least as early as March 1985.

8. Applicant's use of its alleged mark is calculated to trade off Opposer's goodwill in its **DNA** Marks.

9. Upon information and belief, Opposer's and Applicant's goods are likely to be offered, sold and used by the same class of purchasers.

10. Upon information and belief, Opposer's and Applicant's goods are likely to be offered and/or promoted or sold in the same channels of commerce.

11. Opposer believes and alleges that Applicant's alleged mark, when applied to the goods in Application Serial No. 75/893,540, is likely to cause confusion or mistake or to deceive, and will deceive and mislead the trade and the purchasing public into believing that Applicant's goods are sponsored, approved or endorsed by Opposer, or that Applicant is authorized, licensed

or controlled by Opposer, or that Applicant is a division or subsidiary of, or in some way related to Opposer.

12. Applicant's alleged mark "so resembles a mark registered in the Patent and Trademark Office, or a mark . . . previously used in the United States and not abandoned, as to be likely, when applied to the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d).

13. If Applicant is permitted to use and register its alleged mark, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the confusingly similar nature of Applicant's alleged mark and Opposer's **DNA** Marks. Furthermore, any defect, misrepresentation, objection or fault found with Applicant's goods promoted under its alleged mark would necessarily reflect on and seriously injure the reputation that Opposer has established through use of its **DNA** Marks.

14. If Applicant is granted the registration of its alleged mark herein opposed, it would thereby obtain at least a *prima facie* exclusive right to use of its alleged mark. Such registration would be a source of further damage and injury to Opposer.

15. For the reasons set forth in the foregoing paragraphs, Applicant is not entitled to register its alleged mark and the application should be denied in accordance with Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer prays that Application Serial No. 75/893,540 be rejected, and that registration of Applicant's alleged mark shown and specified therein be refused and denied, and that this Opposition be sustained in favor of Opposer.

A duplicate copy of this Notice of Opposition and a check for \$300 for the requisite government filing fee are enclosed herewith. Please deduct any additional fees due from Deposit Account 03-3370.

Respectfully submitted,

By: *Lisa W. Rosaya*

Pamela T. Church

Jon E. Hokanson

Lisa W. Rosaya

COUDERT BROTHERS LLP

1627 I Street, N.W.

Washington, D.C. 20006-4007

Tel: (202) 775-5100

Fax: (202) 775-1168

Attorneys for Opposer

Date: April 5, 2004

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COUDERT BROTHERS LLP

ATTORNEYS AT LAW

1627 I STREET, N.W.
WASHINGTON, D.C. 20006-4007
TEL: (202) 775-5100
FAX: (202) 775-1168
WWW.COUDERT.COM



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April 5, 2004

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



04-05-2004

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Attn: **BOX TTAB -- FEE**

Re: **NOTICE OF OPPOSITION**

Opposer: DNA Specialty, Inc.

Applicant: Piaggio & C.S.p.A.

Mark: DNA

Serial No. 75/893,540

Dear Sir/Madam:

Submitted herewith is:

Notice of Opposition, copy,

Check # 8213 in the amount of \$300.00 to cover the requisite government filing fee.
If any additional fees are required, please deduct these fees from Deposit Account 03-3370.

Respectfully submitted,

Maria V. Fry
Legal Assistant

Enclosures
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