

ESTTA Tracking number: **ESTTA8412**

Filing date: **05/05/2004**

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

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Exel Oy
<b>Granted to Date of previous extension</b>	05/26/2004
<b>Address</b>	Exel Oy PL 29 SF-52701 Mantylharju, FINLAND

<b>Attorney information</b>	Norbert F. Kugele Warner Norcross & Judd LLP 900 Fifth Third Center 111 Lyon Street, N.W. Grand Rapids, MI 49503-2487 UNITED STATES trademarks@wnj.com Phone:616-752-2186
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#### Applicant Information

<b>Application No</b>	76272356	<b>Publication date</b>	01/27/2004
<b>Opposition Filing Date</b>	05/05/2004	<b>Opposition Period Ends</b>	05/26/2004
<b>Applicant</b>	D'ASCOLI, EDMONT P., Trustee of the Edmont P. D' Ascoli Revocable Living Trust dated May 24, 1996		

## Goods/Services Affected by Opposition

Class 018. First Use: First Use In Commerce:

All goods and services in the class are opposed, namely: Duffel Bags; Beach Bags; Backpacks

Class 028. First Use: First Use In Commerce:

All goods and services in the class are opposed, namely: Diving Bags

<b>Attachments</b>	Exel.pdf ( 6 pages )
<b>Signature</b>	/NFK2275/
<b>Name</b>	Norbert F. Kugele
<b>Date</b>	05/05/2004

**In the United States Patent and Trademark Office  
Before the Trademark Trial and Appeal Board**

In the matter of application Serial No. 76/272,356  
Published in the Official Gazette on January 27, 2004.

EXEL OYJ

Opposer,

v.

EDMONT P. D'ASCOLI, TRUSTEE OF  
THE EDMONT P. D'ASCOLI REVOCABLE  
LIVING TRUST DATED MAY 24, 1996

Applicant.

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

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Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Va. 22202-3514

**NOTICE OF OPPOSITION**

Exel Oyj, a corporation organized and existing under the laws of Finland, whose mailing address is P.O. Box 29, FIN-52701, Mantyharju, Finland ("**Opposer**"), believes that it will be damaged by registration of the mark "XCEL" in Application Serial No. 76/272,356 in International Class 18 for duffel bags, beach bags, and backpacks and International Class 28 for diving bags (the "**Application**") and hereby opposes the Application.

As grounds of opposition, it is alleged that:

1. Edmont P. D'Ascoli, Trustee Of The Edmont P. D'Ascoli Revocable Living Trust Dated May 24, 1996 (the "**Applicant**") seeks to register XCEL as a trademark for use in connection with "duffel bags, beach bags, and backpacks" in International Class 18 and "diving

bags” in International Class 28, on the basis of an intent to use the mark in association with those goods.

2. The Application was filed on June 13, 2001.

3. Opposer is and has for many years manufactured, advertised, sold and distributed goods under the mark EXEL associated with a number of outdoor and indoor sports, including Nordic walking, Nordic blading, stretching, floorball, Alpine skiing, Telemark skiing, cross-country skiing, mountaineering, snowshoeing, and hockey. The mark EXEL is also the house mark for Opposer, and goods bearing the mark EXEL are thus recognized as Opposer’s products.

4. Opposer owns U.S. Registration No. 2,394,384, for the mark EXEL for use in association with ski poles, ski pole straps, ski pole handles, ski pole grips, and ski pole tips (“**Opposer’s Registration**”). A true copy of the registration is attached as Exhibit A. Opposer also sells a variety of other goods in the United States using the mark EXEL, including, without limitation, stretching sticks, cross-country skis, accessories for cross-country skiing and alpine skiing, floorball clubs, floorball goalie equipment, and other floorball accessories.

5. Opposer began using the mark EXEL in connection with the goods described in Opposer’s Registration in 1968 and began using the mark EXEL in interstate commerce in the United States in 1974.

6. Opposer established its use and rights in the mark EXEL long prior to Applicant filing the Application.

7. Opposer’s products including the mark EXEL have been extensively and continuously offered to the public through various channels of trade. Opposer has also

advertised and distributed products bearing the mark EXEL throughout the United States. Further, Opposer is the sponsor of the United States Biathlon Team.

8. By reason of Opposer's advertising and distribution of products with the mark EXEL, the public has come to recognize the mark EXEL as signifying Opposer and its products.

9. The goods listed in the Application and sporting bags in general are within the natural zone of expansion of Opposer's current and established product lines. By way of example, Opposer makes reference to Registration No. 1,736,575 and related registrations owned by the winter sports company K-2 Corporation for the mark K2 for use in association with luggage, all purpose sport bags and knapsacks; Registration No. 1,407,514 owned by the winter sports company Rossignol Ski Company, Inc. for the mark ROSSIGNOL for use in association with general tote bags and ski bags; Registration No. 1,373,801 owned by the winter sports company Skis Dynastar, S.A. for the mark DYNASTAR for use in association with all-purpose sports bags; and Registration No. 2,649,179 owned by the sporting equipment manufacturer Jas D. Easton, Inc. for the mark EASTON for use in association with sport bags, namely, duffel bags, tote bags, garment bags, back packs and knapsacks.

10. Opposer has developed an exceedingly valuable goodwill with respect to the mark EXEL in connection with the sale of products under Opposer's Registration and the activities listed in Paragraph 3.

11. The mark XCEL, by itself, is confusingly similar and substantially identical to Opposer's mark EXEL when used in connection with the goods associated with the Application in the United States, and its registration and continued use by Applicant on the goods described in the Application in the United States, is likely to cause confusion, deception, and mistake.

12. Applicant's use of the mark XCEL in association with the goods described in the Application interferes with Opposer's use of its mark EXEL, and continued use or registration of Applicant's mark XCEL in association with the goods described in the Application will seriously damage Opposer.

13. Applicant has admitted that its mark XCEL and Opposer's mark EXEL are confusingly similar. Applicant admitted to confusion between the marks XCEL and EXEL when it filed an opposition to Opposer's application to register the mark EXEL in connection with clothing, Application Serial No. 76/301,162 and Opposition No. 91155174. In addition, in a letter dated February 12, 2004, Applicant asserted that any use by Exel Oyj of the mark EXEL in skiing, snowboarding, crossover and other channels of trade including Nordic activities created a likelihood of confusion with, and dilution of, Applicant's mark.

14. The goods set forth in the Application are closely related to the goods covered by Opposer's Registration and those listed in Paragraph 3, and persons familiar with and who purchase Opposer's goods may also purchase goods described in the Application. For example, a person who purchased cross country ski equipment manufactured and distributed by Opposer with the mark EXEL may also purchase a backpack or duffel bag. Such a purchaser may purchase Applicant's products based on confusion that Applicant's products and Opposer's products are somehow related.

15. The use and registration of Applicant's mark XCEL, as indicated above, would result in confusion, mistake, and/or deception as to the source or origin of the Applicant's goods, leading consumers to believe that they are somehow affiliated with, approved, sponsored, or licensed by Opposer.

16. In addition, any defect, problem, concern, or fault discovered with goods marketed under Applicant's mark XCEL in the United States in association with those goods listed in the Application would necessarily reflect upon and seriously injure the reputation which Opposer has established for its products that are manufactured and distributed under its marks.

17. Furthermore, if Applicant is granted registration for its Application, Applicant will obtain prima facie right to use the mark XCEL in the United States as set forth in the Application. The grant of this right would damage and injure Opposer through the generation of confusion, mistake and/or deception, the dilution of Opposer's Registration, and the diminution of Opposer's ability to control the quality of goods and services sold under the mark.

18. Applicant's use of the mark as described in the Application would dilute the distinctiveness of Opposer's mark EXEL.

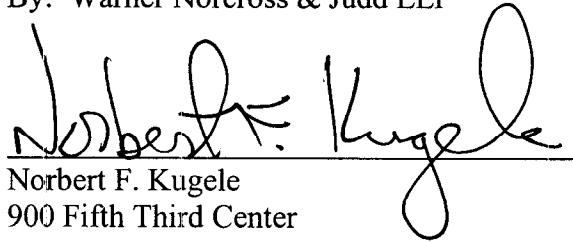
19. If the Applicant is permitted to use and register its mark for its goods, as specified in the Application, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the Applicant's mark and Opposer's mark EXEL, by reason of the proximity of the goods described in the Application to those sold by Opposer under the mark EXEL, and by reason that Applicant's and Opposer's goods are likely to be distributed in the same channels of trade. Moreover, it would be contrary to the requirement that all doubts as to the likelihood of confusion be resolved in favor of Opposer. Persons familiar with Opposer's mark EXEL would likely buy Applicant's goods as a product made and sold by Opposer.

WHEREFORE, Opposer believes that it will be damaged by Applicant's registration and prays that the application Serial No. 76/272,356 be rejected, and that the mark therein sought for the goods therein specified in International Class 18 and International Class 28 be denied and refused.

A duplicate copy of this Notice of Opposition and the fee required by §2.6(a)(17) are enclosed.

Respectfully submitted,  
EXEL OYJ

By: Warner Norcross & Judd LLP

A handwritten signature in black ink, reading "Norbert F. Kugele". The signature is written in a cursive style with a large, looping "K" and "G". A horizontal line is drawn across the signature.

Norbert F. Kugele  
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616-752-2000  
Attorneys for Opposer

Date: May 5, 2004

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