

ESTTA Tracking number: **ESTTA33136**

Filing date: **05/16/2005**

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

Name	Lionel LLC
Granted to Date of previous extension	05/25/2005
Address	26750 23 Mile Road Chesterfield, MI 48051 UNITED STATES

Attorney information	Cory Bragar O'Melveny & Myers 7 Times Square New York, NY 10036 UNITED STATES cbragar@omm.com,slax@omm.com,nkhachatryan@omm.com Phone:212-326-2000
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Applicant Information

Application No	78325094	Publication date	01/25/2005
Opposition Filing Date	05/16/2005	Opposition Period Ends	05/25/2005
Applicant	RUOCCHIO, ALBERT C. 429 Chadwick Drive		

Raleigh, NC 27609 UNITED STATES

Goods/Services Affected by Opposition

Class 028. First Use: 19860215 First Use In Commerce: 19860215 All goods and services in the class are opposed, namely: Toys, namely, model toy trains and model toy train layout accessories sold as units
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Attachments	Ruocchio Opp- Southern Railway.pdf (4 pages)
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Signature	/chb/
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Name	Cory Bragar
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Date	05/16/2005
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD

O'MELVENY & MYERS LLP

Dale M. Cendali

Cory Bragar

Times Square Tower

7 Times Square

New York, New York 10036

(212) 326-2000

Attorneys for Plaintiff

In the matter of the Application for Registration
of:

Trademark:

SOUTHERN RAILWAY

Serial Number: 78325094

Filed: November 7, 2003

By Albert Ruocchio

429 Chadwick Drive

Raleigh, NC 27609

Published: January 25, 2005

Lionel LLC,

Opposer,

-against-

Albert Ruocchio,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

NOTICE OF OPPOSITION

Lionel LLC, a New York limited liability company, located at 26750 23 Mile Road, Chesterfield, Michigan 48051 (“Lionel” or “Opposer”) believes that it is or will be damaged by the registration of the mark shown in Application Serial No. 78325094 filed on November 7, 2003, namely SOUTHERN RAILWAY for “model toy trains” and “model toy train layout accessories” in International Class 28, and hereby opposes the same.

The specific grounds for opposition are as follows:

1. Lionel is now and has been for many years engaged in the manufacture, marketing, selling and promoting of toy model train sets (hereinafter “Lionel’s Goods”) in interstate commerce.
2. Lionel’s Goods are detailed model replicas of actual trains. Any emblems or logos on Lionel’s Goods are used exactly as they are used on the actual trains and are therefore replicate reality. Using the emblems or logos in this manner is the only way to accurately replicate reality and does not denote source.
3. Applicant is not now and never was entitled to appropriate or register as a trademark the designation SOUTHERN RAILWAY for the model train sets which are set forth in Application Serial No. 78325094.
4. Use of SOUTHERN RAILWAY, by Applicant, or anyone else, on model trains is not trademark use. When used on model trains to replicate actual trains, SOUTHERN RAILWAY is aesthetically functional and as such cannot denote source.
5. Lionel will be damaged by the use and registration of SOUTHERN RAILWAY upon the principal register by Applicant for use on train cars and accessories in Applicant’s toy model train sets to the extent Applicant would use such registration to prevent Lionel from

making functional, non-trademark, use of SOUTHERN RAILWAY. Such registration and use would change the historic practice that has allowed model train manufacturers, such as Lionel, to produce replica model trains with the appropriate logos and emblems for over 100 years.

6. Registration of SOUTHERN RAILWAY to Applicant is barred by the provision of §2(c) of the Lanham Act, 15 U.S.C. §1052(c), because Applicant's mark is functional. There are no alternate ways to create an accurate replica of a SOUTHERN RAILWAY train, other than using SOUTHERN RAILWAY. The use of SOUTHERN RAILWAY does not denote source. Therefore, when used on model toy train sets SOUTHERN RAILWAY is aesthetically functional.

WHEREBY, Lionel respectfully requests, under §13(a) of the Lanham Act, 15 U.S.C. §1063(a), that Application Serial No. 78325094 for SOUTHERN RAILWAY be rejected and denied with respect to toy model train sets and that this opposition be granted.

This Notice of Opposition is submitted electronically. The Office is authorized to charge Deposit Account No. 50-0639 for the statutory filing fee of \$300.00 to cover the single class in the application for which registration is opposed and for any deficiency of fees in connection with the filing of this Notice of Opposition.

May 16, 2005

Respectfully submitted:

/s/ DMC

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