

ESTTA Tracking number: **ESTTA36147**

Filing date: **06/20/2005**

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	06/22/2005
Address	26750 23 Mile Road Chesterfield, MI 48051 UNITED STATES
Party who filed Extension of time to oppose	Lionel, LLC
Relationship to party who filed Extension of time to oppose	Missing comma (typographical error)

Attorney information	Cory Bragar O'Melveny & Myers 7 Times Square New York, NY 10036 UNITED STATES cbragar@omm.com, tmaher@omm.com, slax@omm.com, nKhachatryan@omm.com
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Applicant Information

Application No	78342371	Publication date	02/22/2005
Opposition Filing Date	06/20/2005	Opposition Period Ends	06/22/2005
Applicant	RUOCCHIO, ALBERT C 429 Chadwick Drive Raleigh, NC 27609 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 19890201 First Use In Commerce: 19890201
All goods and services in the class are opposed, namely: Toys, Namely, Model Toy Trains and Model Toy Train Layout Accessories

Applicant Information

Application No	78322908	Publication date	03/01/2005
Opposition Filing Date	06/20/2005	Opposition Period Ends	
Applicant	RUOCCHIO, ALBERT C. 429 Chadwick Drive Raleigh, NC 27609 UNITED STATES		

Goods/Services Affected by Opposition

Class 028.
All goods and services in the class are opposed, namely: Electric toy model trains and accessories, namely, train sets, train engines, train cars, train track and transformers, train motors, train layout figures, train layout vehicles, and train layout buildings

Applicant Information

Application No	78339250	Publication date	03/01/2005
Opposition Filing Date	06/20/2005	Opposition Period Ends	

Applicant	RUOCCHIO, ALBERT C. 429 Chadwick Drive Raleigh, NC 27609 UNITED STATES
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Goods/Services Affected by Opposition

Class 028. First Use: 19880215 First Use In Commerce: 19880215 All goods and services in the class are opposed, namely: Toys, namely, model toy trains and model toy train layout accessories, namely, train layout figures, train layout vehicles, and train layout buildings

Applicant Information

Application No	78322915	Publication date	03/01/2005
Opposition Filing Date	06/20/2005	Opposition Period Ends	
Applicant	RUOCCHIO, ALBERT C. 429 Chadwick Drive Raleigh, NC 27609 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. All goods and services in the class are opposed, namely: Electric toy model trains and accessories, namely, train sets, train engines, train cars, train track and transformers, train motors, train layout figures, train layout vehicles, and train layout buildings
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Attachments	Ruocchio Opp- CNJ.pdf (4 pages) Ruocchio Opp- NY Central.pdf (4 pages) Ruocchio Opp- Penn RR.pdf (4 pages) Ruocchio Opp- PRR.pdf (4 pages)
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Signature	/chb/
Name	Cory Bragar
Date	06/20/2005

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:

CNJ

Serial Number: 78339250

Filed: December 11, 2003

By Albert Ruocchio
429 Chadwick Drive
Raleigh, NC 27609

Published: March 1, 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. 78339250 filed on December 11, 2003, namely CNJ 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 CNJ for the model train sets which are set forth in Application Serial No. 78339250.
4. Use of CNJ, by Applicant, or anyone else, on model trains is not trademark use. When used on model trains to replicate actual trains, CNJ is aesthetically functional and as such cannot denote source.
5. Lionel will be damaged by the use and registration of CNJ 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 CNJ. 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 CNJ to Applicant is barred by the provision of §2(e) of the Lanham Act, 15 U.S.C. §1052(e), because Applicant's mark is functional. There are no alternate ways to create an accurate replica of a CNJ train, other than using CNJ. The use of CNJ does not denote source. Therefore, when used on model toy train sets CNJ is aesthetically functional.

WHEREBY, Lionel respectfully requests, under §13(a) of the Lanham Act, 15 U.S.C. §1063(a), that Application Serial No. 78339250 for CNJ 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.

June 20, 2005

Respectfully submitted:

/s/ DMC

Dale M. Cendali
Cory Bragar
O'MELVENY & MYERS LLP
Times Square Tower
7 Times Square
New York, New York 10036
(212) 326-2000

Attorneys for Opposer

NY1:1587357.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
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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:

NEW YORK CENTRAL

Serial Number: 78342371

Filed: December 17, 2003

By Albert Ruocchio

429 Chadwick Drive

Raleigh, NC 27609

Published: February 22, 2005

Lionel LLC,

Opposer,

-against-

Albert Ruocchio,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

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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. 78342371 filed on December 17, 2003, namely NEW YORK CENTRAL 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 NEW YORK CENTRAL for the model train sets which are set forth in Application Serial No. 78342371.
4. Use of NEW YORK CENTRAL, by Applicant, or anyone else, on model trains is not trademark use. When used on model trains to replicate actual trains, NEW YORK CENTRAL is aesthetically functional and as such cannot denote source.
5. Lionel will be damaged by the use and registration of NEW YORK CENTRAL 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 NEW YORK CENTRAL. 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 NEW YORK CENTRAL to Applicant is barred by the provision of §2(e) of the Lanham Act, 15 U.S.C. §1052(e), because Applicant's mark is functional. There are no alternate ways to create an accurate replica of a NEW YORK CENTRAL train, other than using NEW YORK CENTRAL. The use of NEW YORK CENTRAL does not denote source. Therefore, when used on model toy train sets NEW YORK CENTRAL is aesthetically functional.

WHEREBY, Lionel respectfully requests, under §13(a) of the Lanham Act, 15 U.S.C. §1063(a), that Application Serial No. 78342371 for NEW YORK CENTRAL 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.

June 20, 2005

Respectfully submitted:

/s/ DMC

Dale M. Cendali
Cory Bragar
O'MELVENY & MYERS LLP
Times Square Tower
7 Times Square
New York, New York 10036
(212) 326-2000

Attorneys for Opposer

NY1:1587347.1

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:

PENNSYLVANIA RAILROAD

Serial Number: 78322908

Filed: November 4, 2003

By Albert Ruocchio
429 Chadwick Drive
Raleigh, NC 27609

Published: March 1, 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. 78322908 filed on November 4, 2003, namely PENNSYLVANIA RAILROAD 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 PENNSYLVANIA RAILROAD for the model train sets which are set forth in Application Serial No. 78322908.
4. Use of PENNSYLVANIA RAILROAD, by Applicant, or anyone else, on model trains is not trademark use. When used on model trains to replicate actual trains, PENNSYLVANIA RAILROAD is aesthetically functional and as such cannot denote source.
5. Lionel will be damaged by the use and registration of PENNSYLVANIA RAILROAD 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 PENNSYLVANIA RAILROAD. 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 PENNSYLVANIA RAILROAD to Applicant is barred by the provision of §2(e) of the Lanham Act, 15 U.S.C. §1052(e), because Applicant's mark is functional. There are no alternate ways to create an accurate replica of a PENNSYLVANIA RAILROAD train, other than using PENNSYLVANIA RAILROAD. The use of PENNSYLVANIA RAILROAD does not denote source. Therefore, when used on model toy train sets PENNSYLVANIA RAILROAD is aesthetically functional.

WHEREBY, Lionel respectfully requests, under §13(a) of the Lanham Act, 15 U.S.C. §1063(a), that Application Serial No. 78322908 for PENNSYLVANIA RAILROAD 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.

June 20, 2005

Respectfully submitted:

/s/ DMC

Dale M. Cendali
Cory Bragar
O'MELVENY & MYERS LLP
Times Square Tower
7 Times Square
New York, New York 10036
(212) 326-2000

Attorneys for Opposer

NY1:1587356.1

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:

PRR

Serial Number: 78322915

Filed: November 4, 2003

By Albert Ruocchio
429 Chadwick Drive
Raleigh, NC 27609

Published: March 1, 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. 78322915 filed on November 4, 2003, namely PRR 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 PRR for the model train sets which are set forth in Application Serial No. 78322915.
4. Use of PRR, by Applicant, or anyone else, on model trains is not trademark use. When used on model trains to replicate actual trains, PRR is aesthetically functional and as such cannot denote source.
5. Lionel will be damaged by the use and registration of PRR 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 PRR. 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 PRR to Applicant is barred by the provision of §2(e) of the Lanham Act, 15 U.S.C. §1052(e), because Applicant's mark is functional. There are no alternate ways to create an accurate replica of a PRR train, other than using PRR. The use of PRR does not denote source. Therefore, when used on model toy train sets PRR is aesthetically functional.

WHEREBY, Lionel respectfully requests, under §13(a) of the Lanham Act, 15 U.S.C. §1063(a), that Application Serial No. 78322915 for PRR 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.

June 20, 2005

Respectfully submitted:

/s/ DMC

Dale M. Cendali
Cory Bragar
O'MELVENY & MYERS LLP
Times Square Tower
7 Times Square
New York, New York 10036
(212) 326-2000

Attorneys for Opposer

NY1:1587352.1