

ESTTA Tracking number: **ESTTA95601**

Filing date: **08/21/2006**

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	FORD MOTOR COMPANY
Granted to Date of previous extension	08/20/2006
Address	ONE AMERICAN ROAD DEARBORN, MI 48126 UNITED STATES

Correspondence information	ELIZABETH F. JANDA Attorney BROOKS KUSHMAN PC 1000 TOWN CENTER 22ND FLOOR SOUTHFIELD, MI 48075 UNITED STATES ejanda@brookskushman.com, smgibbons@brookskushman.com Phone:248-358-4400
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Applicant Information

Application No	78693352	Publication date	02/21/2006
Opposition Filing Date	08/21/2006	Opposition Period Ends	08/20/2006
Applicant	Bayerische Motoren Werke Aktiengesellschaft Petuelring 130 D-80809 Munich, GERMANY		

Goods/Services Affected by Opposition

Class 012. First Use: 1978/00/00 First Use In Commerce: 1986/00/00
All goods and services in the class are opposed, namely: Motor vehicles and structural parts therefor

Attachments	BMW.pdf (11 pages)(579228 bytes)
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Signature	/elizabeth f janda/
Name	ELIZABETH F. JANDA
Date	08/21/2006

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

In re Trademark Application Serial No. 78/693,352

Filed: August 16, 2005

Trademark: M

Published in the *Official Gazette* on February 21, 2006

FORD MOTOR COMPANY)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
BAYERISCHE MOTOREN WERKE)	
AKTIENGESELLSCHAFT)	
Applicant.)	

NOTICE OF OPPOSITION

FILED ELECTRONICALLY
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Sir:

FORD MOTOR COMPANY (“FORD”), a Delaware corporation with a place of business at The American Road, Dearborn, Michigan 48121, believes that it is and will continue to be damaged by Applicant BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT’s (“BMW”) registration of the mark shown in Application Serial No. 78/693,352 for use in connection with “motor vehicles and structural parts therefor” in International Class 12, and hereby opposes registration of this mark.

As grounds for opposition, the Opposer alleges as follows:

1. The Opposer FORD is a world-famous manufacturer and provider of vehicles, parts and accessories for vehicles.
2. In 1938, FORD founded its MERCURY division and line of vehicles.
3. FORD is the owner of the trademark MERCURY in the United States and around the world for a variety of goods and services, including land vehicles, parts and accessories for vehicles, repair services, clothing, bags, and a variety of other goods and services. MERCURY is the name of one the Opposer FORD's vehicle brands.
4. FORD owns several U.S. registrations for the MERCURY trademark, including U.S. Trademark Registration No. 365,585 for "passenger and commercial automobiles" and U.S. Trademark Registration No. 2,153,903 for "vehicle license plate frames," both in International Class 12. The MERCURY mark is recognized as a famous mark and source identifier for FORD and its Mercury brand.
5. FORD's use of "M" goes back more than fifty years.
6. In the 1950's, FORD used an M logo and featured "THE BIG M" in advertising in print and television advertising and on company materials. Over the years, the letter "M" has been strongly associated in the marketplace with Ford's MERCURY and LINCOLN-MERCURY divisions. See John Gunnell, 55 Years of Mercury: The Complete History of the Big "M" (Krause Publications 1994).
7. FORD and its subsidiaries own many alphabetical and alphanumeric trademark registrations and applications for vehicles which contain the letter M.

8. FORD is the owner of the Stylized M design trademark reproduced below:



(hereinafter the “Stylized M design mark”). FORD owns United States trademark registrations for this mark for a variety of goods and services, including land vehicles, parts and accessories for vehicles, repair services, clothing, bags, and a variety of other goods and services. All authorized dealers prominently display the Stylized M design mark in connection with Mercury products and their related services.

9. FORD has used the Stylized M design mark in commerce from a date at least as early as 1983 in connection with its vehicles and related goods and services.

10. FORD owns several U.S. registrations for the Stylized M design mark, including U.S. Trademark Registration No. 1,274,255 for “automobiles and structural parts thereof” and U.S. Trademark Registration No. 2,153,905 for “automobile parts and accessories, namely, license plate frames,” both in International Class 12. The Stylized M design mark is recognized as a famous mark and source identifier for FORD and its Mercury brand.

11. The foregoing registrations are valid, subsisting and incontestable and constitute prima facie evidence of the validity of the MERCURY trademark and Stylized M

design mark, of FORD's ownership of and exclusive right to use the marks in commerce, and provides constructive notice of ownership thereof by FORD.

12. Most of FORD's Mercury division vehicles have M-formative names, and all feature the Stylized M design mark.

13. FORD has expended considerable effort and expense in promoting the Stylized M design mark, the MERCURY trademark, and other M formative trademarks, and the goods associated with these marks, with the result that the purchasing public has come to know and recognize the products of FORD by these marks. FORD has exceedingly valuable good will established in these marks.

14. Through extensive use of FORD's Stylized M design mark and the MERCURY trademark in the automotive field, both marks have become distinctive and famous as defined under Section 43(c)(1) of the Lanham Act, as amended, 15 U.S.C. §1125(c)(1), and were famous prior to any use of Applicant's unstylized M mark in commerce.

15. FORD's use of the letter M in connection with its goods and services was well known prior to use of Applicant's M mark.



16. Over the years, other manufacturers have utilized marks incorporating the letter M in distinctive design marks and other marks to identify a vehicle brand with the letter "M," such as Mazda, Maserati, MG-Morris Garages, MINI, Mercedes-Benz, and Mitsubishi.

17. Many other automotive manufacturers have used M-formative marks in connection with their vehicles. Below is a non-exhaustive list of third party auto manufacturer applications and registrations for alphabetical and alphanumeric marks containing the letter M:

Mark	Owner	Reg./Ser. No.	Reg. Date/First Use	Status
MDX	Honda Motor Co.	2,702,859	Registered 04/01/2003 First Use 04/00/2000	Registered
M80	DaimlerChrysler Corporation	78/079,341	N/A	Notice of Allowance issued 2/7/06.
MR 2	Toyota Jidosha	1,478,608	Registered 3/01/1988 First Use 12/01/84	Section 8 & 15 accepted
MC12	New Business Quattordici S.P.A.	3,015,026	Registered 11/15/2005 Foreign Priority date 3/5/2004	Registered
ML 270	Daimler-Benz Aktiengesellschaft	2,301,239	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 220	Daimler-Benz Aktiengesellschaft	2,320,014	Registered 02/22/2000 Foreign Priority date 9/26/1996	Registered
ML 230	Daimler-Benz Aktiengesellschaft	2,306,801	Registered 01/11/2000 Foreign Priority date 9/26/1996	Registered
ML 240	Daimler-Benz Aktiengesellschaft	2,301,240	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered

Mark	Owner	Reg./Ser. No.	Reg. Date/First Use	Status
ML 290	Daimler-Benz Aktiengesellschaft	2,301,238	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 300	Daimler-Benz Aktiengesellschaft	2,301,241	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 400	Daimler-Benz Aktiengesellschaft	2,301,243	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 43	Daimler-Benz Aktiengesellschaft	2,301,237	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 50	Daimler-Benz Aktiengesellschaft	2,301,236	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 550	Daimler-Benz Aktiengesellschaft	2,301,232	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 56	Daimler-Benz Aktiengesellschaft	2,301,234	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 300	DaimlerChrysler AG	78/887,752	Foreign Priority date 12/12/96	Pending
ML 320	DaimlerChrysler	2,301,242	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 40	Daimler-Benz Aktiengesellschaft	2,301,231	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered

Mark	Owner	Reg./Ser. No.	Reg. Date/First Use	Status
ML 400	Daimler-Benz Aktiengesellschaft	2,301,243	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 430	DaimlerChrysler AG	2,301,233	Registered 12/21/1999 Foreign Priority date 9/26/1996	Registered
ML 500	DaimlerChrysler AG	2,299,177	Registered 12/14/1999 Foreign Priority date 9/26/1996	Registered
ML 55	DaimlerChrysler AG	2,301,235	Registered 12/21/1999 9/26/1996	Registered
ML 550	DaimlerChrysler AG	78/887,756	Foreign Priority date 12/13/1996	Pending
ML 63	DaimlerChrysler AG	2,876,636	Registered 8/24/2004 Foreign Priority date 1/22/2003	Registered
ML 65	DaimlerChrysler AG	3,022,515	Registered 12/06/2005 Foreign Priority date 12/11/2003	Registered
ML 280	DaimlerChrysler AG	2,715,271	Registered 5/13/2003 Foreign Priority date 7/18/2001	Registered
ML 350	DaimlerChrysler AG	2,723,484	Registered 1/10/2003 Foreign Priority date 7/18/2001	Registered
ML 450	DaimlerChrysler AG	2,723,483	Registered 01/10/2003 Foreign Priority date 7/18/2001	Registered

Mark	Owner	Reg./Ser. No.	Reg. Date/First Use	Status
MLK 400	Daimler-Benz Aktiengesellschaft	2,414,896	Registered 12/26/2000 9/26/1996	Registered
MLK 300	Daimler-Benz Aktiengesellschaft	2,339,506	Registered 4/11/2000 9/26/1996	Registered
MLK 50	DaimlerChrysler AG	2,407,546	Registered 11/28/2000 9/26/1996	Registered
300M 	Daimler Chrysler Corporation	2,362,025	Registered 6/27/2000 First use 5/14/1998	Registered - Sections 8 & 15 accepted and acknowledged.
M and Design 	DaimlerChrysler AG	2,820,586	Registered 3/9/2004	Registered
MLG	DaimlerChrysler AG	3,113,465	Registered 7/11/2006 Foreign Priority date 4/29/2004	Registered
MXU	Kwang Yang Motor Co., Ltd.	76/590,450	Filing Date 05/05/2004 First Use 10/27/2004	Non-Final Office Action Pending

18. While FORD owns substantial rights in M design logos and M formative marks, it has not sought to stop third parties or competitors from fair use of the letter M from the alphabet.

19. The non-stylized letter "M," standing alone, is not distinctive as a source for any one automobile manufacturer.

20. The letter M is a common element of alphabetical and alphanumeric automobile designations and has been for many years.

21. BMW itself uses M alphanumerics for vehicles. BMW owns trademark registrations and applications for alphanumeric designations containing the letter M for vehicles, including M2, M3, M4, M5 and M6.

22. BMW currently is using the stylized M design (“BMW M Design”) shown below as a designation on some vehicles.



23. Upon information and belief, Applicant BMW filed a use based application on August 16, 2005 for the unstylized letter M standing alone, claiming first use in U.S. commerce in 1986. As published, this Application Serial No. 78/693,352 covers “motor vehicles and structural parts therefor” in International Class 12 (hereinafter “Applicant’s M mark”).

24. Upon information and belief, BMW submitted a brochure as its only specimen of use for the opposed application. The brochure pictures a BMW vehicle bearing the BMW M Design mark shown in Paragraph 22 above. The brochure does not show a vehicle badged with the non-stylized letter M standing alone.

25. Upon information and belief, BMW does not badge its vehicles with the non-stylized letter M. On information and belief, BMW typically uses either the BMW M Design shown in Paragraph 22 above on vehicles or a designation featuring an alphanumeric including the letter M.

26. Upon information and belief, the non-stylized letter M does not create a separate commercial impression apart from BMW's M alphanumeric marks and the BMW M Design mark.

27. Upon information and belief, consumers do not perceive the non-stylized letter M standing alone as being distinctive of any one automobile manufacturer.

28. The non-stylized letter M standing alone does not function as a trademark for BMW's vehicles.

29. Upon information and belief, the non-stylized letter M standing alone has not acquired secondary meaning symbolizing BMW.

30. If BMW were granted the registration herein opposed, FORD is concerned that BMW would claim at least a *prima facie* exclusive right to remove the letter M from the alphabet and from use in connection with automobile goods in a manner inconsistent with FORD's right to continue to use the letter M in connection with its goods and services. Such registration would be a source of injury and damage to FORD.

31. If BMW were granted the registration herein opposed, BMW could also misuse this registration to block any additional M component marks FORD would adopt in the future to add to FORD's long established M family of marks.

32. BMW is not entitled to registration of the unstylized letter M, because the claimed mark is a common term and letter used throughout the industry, and that the FORD has a valid, prior and legal right to use the term sought to be registered by BMW. FORD is likely to be damaged by registration of the single letter M, unrestricted by any design or other distinctive elements, in that the *prima facie* effect of such registration will tend to impair FORD's right to the use of that non-distinctive term.

33. BMW is not entitled to federal registration of its alleged mark, because BMW is not entitled to exclusive use of the letter M in commerce on the designated goods or in the automotive field. Further, BMW's alleged mark, an unstylized M, does not function to identify BMW's goods and distinguish them from those offered by FORD and others.

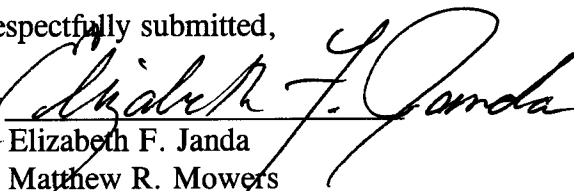
34. For the foregoing reasons, Opposer FORD will be damaged by the registration of Applicant's M mark.

WHEREFORE, FORD requests that registration of Application Serial No. 78/693,352, be refused and this opposition be sustained.

The Commissioner is hereby authorized to charge the fee to the Deposit Account of Ford Global Technologies, LLC, No. 06-1505.

Respectfully submitted,

By



Elizabeth F. Janda
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Attorneys for Opposer

Date: August 21, 2006

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Our File: FMCT 19339 OC/81140818