

ESTTA Tracking number: **ESTTA235202**

Filing date: **09/08/2008**

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 | Enterprise Rent-A-Car Company |
| Granted to Date of previous extension | 09/07/2008 |
| Address | 600 Corporate Park Drive St. Louis, MO 63105 UNITED STATES |

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|----------------------|---|
| Attorney information | Hadi S. Al-Shathir Thompson Coburn LLP One US Bank Plaza St. Louis, MO 63101 UNITED STATES ipdocket@thompsoncoburn.com, hal-shathir@thompsoncoburn.com |
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Applicant Information

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|--------------------------------|---|---------------------------------|------------|
| Application No | 79036907 | Publication date | 03/11/2008 |
| Opposition Filing Date | 09/08/2008 | Opposition Period Ends | 09/07/2008 |
| International Registration No. | 0920019 | International Registration Date | 09/19/2006 |
| Applicant | BOLLORE Odet F-29500 ERGUE GABERIC FRANCE | | |

Goods/Services Affected by Opposition

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| Class 039. All goods and services in the class are opposed, namely: Bus, tramway, trucks, scooters, rail, air, boat and ferry transportation services and warehousing services; rental of motor vehicles; vehicle parking garage services and rental of garage space; vehicle breakdown assistance in the nature of vehicle towing services; information with respect to air, land and water transport services, and with respect to vehicle rental |
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Grounds for Opposition

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|--------------------------------------|-----------------------------|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

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|-------------------|--------|------------------|------------|
| U.S. Registration | 925251 | Application Date | 03/16/1970 |
|-------------------|--------|------------------|------------|

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|---------------------|---|-----------------------|------|
| No. | | | |
| Registration Date | 12/07/1971 | Foreign Priority Date | NONE |
| Word Mark | E | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class U100 (International Class 042). First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 AUTOMOBILE LEASING SERVICES Class U101 (International Class 035). First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 RETAIL AUTOMOBILE SALES SERVICES | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1045085 | Application Date | 10/02/1974 |
| Registration Date | 07/27/1976 | Foreign Priority Date | NONE |
| Word Mark | E | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 039. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 SHORT-TERM RENTAL SERVICES OF AUTOMOBILES AND TRUCKS | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1234835 | Application Date | 01/21/1982 |
| Registration Date | 04/12/1983 | Foreign Priority Date | NONE |
| Word Mark | E | | |
| Design Mark | | | |
| Description of Mark | The mark consists in part of the stylized letter "E". | | |
| Goods/Services | Class 035. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 Automotive Fleet Management Services Class 037. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 Automotive Repair Services | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1864905 | Application Date | 12/06/1993 |
| Registration Date | 11/29/1994 | Foreign Priority Date | NONE |
| Word Mark | E | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 035. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 automotive fleet management services Class 037. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 | | |

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|--|--|
| | <p>automotive repair services [and telephone installation and repair services] Class 038. First use: First Use: 1988/02/01 First Use In Commerce: 1988/02/01 [telephone leasing services] Class 039. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 rental and leasing services of automobiles and trucks Class 042. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 [retail outlet services in the field of telephones, and] automotive dealership services</p> |
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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1875518 | Application Date | 12/06/1993 |
| Registration Date | 01/24/1995 | Foreign Priority Date | NONE |
| Word Mark | E | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 035. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 automotive fleet management services Class 037. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 [automotive repair services and telephone installation and repair services] Class 038. First use: First Use: 1988/02/01 First Use In Commerce: 1988/02/01 [telephone leasing services] Class 039. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 rental and leasing services of automobiles and trucks Class 042. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 [retail outlet services in the field of telephones, automotive dealership services]</p> | | |

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|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2136409 | Application Date | 10/01/1990 |
| Registration Date | 02/17/1998 | Foreign Priority Date | NONE |
| Word Mark | E | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | <p>Class 035. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 automobile fleet management services Class 037. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 [telephone installation and repair services;] automobile repair services Class 038. First use: First Use: 1988/02/01 First Use In Commerce: 1988/02/01 [telephone leasing services] Class 039. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 short term rental services of automobiles and trucks; automobile leasing services Class 042. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 [retail outlet services in the field of telephones;] automobile dealership services</p> | | |

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|-------------------|---------|------------------|------------|
| U.S. Registration | 2255679 | Application Date | 06/11/1998 |
|-------------------|---------|------------------|------------|

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|---------------------|--|-----------------------|------|
| No. | | | |
| Registration Date | 06/22/1999 | Foreign Priority Date | NONE |
| Word Mark | E | | |
| Design Mark | | | |
| Description of Mark | The mark consists of the combination of the colors green and black used in connection with the services set forth in the application. | | |
| Goods/Services | Class 035. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 AUTOMOBILE DEALERSHIP SERVICES Class 037. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 AUTOMOBILE REPAIR SERVICES Class 039. First use: First Use: 1967/02/15 First Use In Commerce: 1967/02/15 VEHICLE RENTAL AND LEASING SERVICES | | |

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| Attachments | 72354153#TMSN.gif (1 page)(bytes) 73033536#TMSN.gif (1 page)(bytes) 73346544#TMSN.gif (1 page)(bytes) 74465251#TMSN.gif (1 page)(bytes) 74465260#TMSN.gif (1 page)(bytes) 75500184#TMSN.gif (1 page)(bytes) Notice of Opposition.pdf (5 pages)(17469 bytes) |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|------------------------|
| Signature | /s/ Hadi S. Al-Shathir |
| Name | Hadi S. Al-Shathir |
| Date | 09/08/2008 |

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

| | | |
|-----------------------|---|---------------------------------|
| ENTERPRISE RENT-A-CAR |) | |
| COMPANY, |) | |
| |) | |
| Opposer, |) | |
| |) | Opposition No. _____ |
| v. |) | |
| |) | Directed to App. No. 79/036,907 |
| BOLLORE, S.A., |) | |
| |) | |
| Applicant. |) | |

NOTICE OF OPPOSITION

COMES NOW, Enterprise Rent-A-Car Company (“Opposer”), and pursuant to 15 U.S.C. §§ 1063 and 1068, 37 CFR § 2.101, hereby files its Notice of Opposition to U.S. Trademark Application Serial No. 79/036,907, filed by Bollore, S.A. (“Applicant”). In support of its Notice of Opposition, Opposer states as follows:

BACKGROUND

1. Opposer is a corporation organized and existing under the laws of Missouri with offices at 600 Corporate Park Drive, Saint Louis, Missouri 63105.
2. On information and belief, Applicant is a Societe Anonyme of France with a place of business at Odet F-29500 Ergue Gaberic, France.
3. On information and belief, Applicant is the owner of U.S. Trademark Application Serial No. 79/036,907 (“Application”) for the design mark BLUE(E)CAR in International Class 039 for *bus, tramway, trucks, scooters, rail, air, boat and ferry transportation services and warehousing services; rental of motor vehicles; vehicle parking garage services and rental of garage space; vehicle breakdown assistance in the nature of vehicle towing services;*

information with respect to air, land and water transport services, and with respect to vehicle rental (“Applicant’s Services”).

4. The Application was published for opposition on March 11, 2008. Opposer has been granted extensions of up to and including September 7, 2008 (a Sunday), within which to file a Notice of Opposition.

5. Since at least as early as 1967, Opposer has continuously used in interstate commerce trademarks comprising solely or in part the letter “E” in connection with the renting and leasing of motor vehicles, among other things.

6. Opposer owns numerous United States trademark registrations for its “E” marks, including: (1) U.S. Registration No. 925251; (2) U.S. Registration No. 1045085; (3) U.S. Registration No. 1234835; (4) U.S. Registration No. 1864905; (5) U.S. Registration No. 1875518; (6) U.S. Registration No. 2136409; and (7) U.S. Registration No. 2255679. These registrations are valid and in good standing.

7. Opposer has promoted and sold its services in interstate and intrastate commerce under its “E” marks since long prior to any alleged use by Applicant of the mark shown in the Application. As a result of the use, promotion, and advertising of Opposer’s “E” marks, the marks have become well known to the trade and to the public, and have therefore acquired significant goodwill. Opposer’s “E” marks identify and distinguish its services from the services of others, and identify the source and origin of Opposer’s services to both the trade and the public.

COUNT I
(Likelihood of Confusion)

8. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1 through 7.

9. On information and belief, Applicant has made no use of the mark shown in the Application, nor of any word, letter or design confusingly similar thereto, as a trademark or service mark, prior to the date of first use of Opposer's "E" marks.

10. Applicant's registration and use of the mark shown in the Application is likely to cause confusion in the minds of the trade and of the public that Applicant's Services emanate from or are licensed, sponsored, or otherwise authorized by Opposer, when in fact they are not.

11. The mark shown in the Application so resembles Opposer's "E" marks previously used in the United States by Opposer, and not abandoned, as to be likely, when applied to Applicant's Services, to cause confusion or to cause mistake or to deceive, and is an attempt to deceive the trade and the public and to benefit from the reputation and goodwill developed by Opposer.

12. Opposer will be injured and damaged by the registration of the mark shown in the Application because the mark, when applied to Applicant's Services:

- a) is likely to cause confusion, or to cause mistake, or to deceive;
- b) falsely suggests a connection with Opposer; and
- c) will damage Opposer's valuable goodwill in its "E" marks.

13. For these reasons, Applicant is not entitled to registration of the mark shown in the Application.

COUNT II
(Dilution)

14. Opposer re-alleges and incorporates by reference the allegations of paragraphs 1-13.

15. Opposer's "E" marks became famous as that term is defined in 15 U.S.C. § 1125 prior to any alleged use by Applicant of the mark shown in the Application.

16. Opposer will be injured and damaged by the registration of the mark shown in the Application because the mark, when applied to Applicant's Services:

- (a) will damage Opposer's valuable goodwill in its "E" marks; and
- (b) will dilute the distinctive quality of Opposer's famous "E" marks.

17. For these reasons, Applicant is not entitled to registration of the mark shown in the Application.

ACCORDINGLY, Opposer requests that the Opposition be sustained and that registration of the mark shown in the Application be refused.

Opposer authorizes the Commissioner for Trademarks to charge the fee of \$300 to Deposit Account 20-0823 for filing this Notice of Opposition. Opposer believes that no additional fees are due; however, the Commissioner for Trademarks is authorized to debit our Account 20-0823 for any additional fees.

Respectfully submitted,

THOMPSON COBURN LLP

By: /s/ Hadi S. Al-Shathir
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Matthew J. Himich
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One US Bank Plaza
St. Louis, Missouri 63101
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(314) 552-7000 (Facsimile)

Attorneys for Opposer,
Enterprise Rent-A-Car Company

CERTIFICATE OF SERVICE

I hereby certify that a copy of this Notice of Opposition was sent via First Class Mail, postage prepaid, this 8th day of September, 2008, to the following attorney of record for applicant:

Lynn A. Sullivan
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
Chicago, IL 60601-6731

/s/ Hadi S. Al-Shathir