

ESTTA Tracking number: **ESTTA244805**

Filing date: **10/24/2008**

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	Excel Tire & Wheel Corp.
Granted to Date of previous extension	10/29/2008
Address	P.O. Box 1044 Walnut, CA 91788 UNITED STATES

Attorney information	Michael R. Adele Allen Matkins 12348 High Bluff Drive Suite 210 San Diego, CA 92130 UNITED STATES madele@allenmatkins.com Phone:(619) 235-1534
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Applicant Information

Application No	77331126	Publication date	07/01/2008
Opposition Filing Date	10/24/2008	Opposition Period Ends	10/29/2008
Applicant	Balkrishna Industries Limited 305 Creative Ind Estate 72, N M Joshi Marg MUMBAI 400011, INDIA		

Goods/Services Affected by Opposition

Class 012. All goods and services in the class are opposed, namely: Tires, inner tubes, mud flaps, wheels and parts and fittings therefore

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3412142	Application Date	10/19/2006
Registration Date	04/15/2008	Foreign Priority Date	NONE
Word Mark	EXCEL TIRE & WHEEL		

Design Mark	EXCEL TIRE & WHEEL
Description of Mark	NONE
Goods/Services	Class 012. First use: First Use: 2002/05/22 First Use In Commerce: 2002/05/22 Tires especially designed for all terrain vehicles

U.S. Application No.	77265139	Application Date	08/27/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EXCEL		
Design Mark	EXCEL		
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2002/11/01 First Use In Commerce: 2002/11/01 Tires; Land vehicle parts, namely, wheels; Wheels		

U.S. Application No.	77265152	Application Date	08/27/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EXCELLA		

Design Mark	<h1>EXCELLA</h1>
Description of Mark	NONE
Goods/Services	Class 012. First use: First Use: 2002/11/01 First Use In Commerce: 2002/11/01 Tires; Land vehicle parts, namely, wheels; Wheels

Attachments	77024957#TMSN.jpeg (1 page)(bytes) 77265139#TMSN.jpeg (1 page)(bytes) 77265152#TMSN.jpeg (1 page)(bytes) Excel_Ntc_Opp (final filed).pdf (7 pages)(211489 bytes) ExcelTireAndWheelRegCert.pdf (1 page)(17978 bytes) EXCELapplic.pdf (4 pages)(22745 bytes) ExcellaApp.pdf (4 pages)(25331 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	/Michael R. Adele/
Name	Michael R. Adele
Date	10/24/2008

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

In the Matter of Application Serial No. 77/331126 KRONUS TYRES CRAFTED TO EXCEL
Filed: November 16, 2007
International Class: 12
Published in the *Official Gazette* of July 1, 2008
Extension of Time to Oppose Granted Opposer to: October 29, 2008

EXCEL TIRE AND WHEEL CORP.,)	
)	
Opposer,)	
)	
vs.)	Opposition No. _____
)	
BALKRISHNA INDUSTRIES LIMITED,)	
)	
Applicant.)	
_____)	

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer, EXCEL TIRE AND WHEEL CORP. (“Opposer”), a California Corporation with a principal place of business at 21003 Commerce Pointe Drive, Walnut, California 91788, believes that it will be damaged by the registration of the trademark shown in Application Serial No. 77/331126, and hereby opposes the same.

Upon information and belief, BALKRISHNA INDUSTRIES LIMITED (“Applicant”) is a foreign company located at 305 Creative Ind Estate 72,N M Joshi Marg, MUMBAI 400011, India.

Applicant filed Application Serial No. 77/331126 (the “Applicant’s Mark”) for the “KRONUS TYRES CRAFTED TO EXCEL” trademark on November 16, 2007, in connection with “Tires, inner tubes, mud flaps, wheels and parts and fittings therefore” in International Class

12. Applicant's trademark was published for opposition in the Official Gazette on July 1, 2008. Opposer filed a ninety-day request for extension of time to file a Notice of Opposition on July 31, 2008, which was granted, and Opposer now has until October 29, 2008 to file this Notice of Opposition.

STATUTORY AND COMMON LAW GROUNDS FOR OPPOSITION

1. Registration and Applications. Opposer has standing to oppose the Applicant's Mark based on Opposer's statutory rights in its EXCEL TIRE AND WHEEL federal trademark. Opposer is the owner of the following EXCEL TIRE AND WHEEL registration, EXCEL and EXCELLA applications (copies annexed as Exhibit A), including:

a. EXCEL TIRE AND WHEEL: U.S. Registration No. 3,412,142 in connection with "tires especially designed for all terrain vehicles" in International Class 12, which recites a date of first use in commerce of May 22, 2002; this trademark Registration No. 3,412,142 is valid and subsisting;

b. EXCEL: U.S. Application Serial No. 77/265,139 in connection with "Tires; Land vehicle parts, namely, wheels; Wheels" in International Class 12, which recites a date of first use in commerce of November 1, 2002; and

c. EXCELLA: U.S. Application Serial No. 77/265,152 in connection with "Tires; Land vehicle parts, namely, wheels; Wheels" in Class 12, which recites a date of first use in commerce of November 1, 2002.

2. Common Law Rights. Opposer also has standing to oppose the Applicant's Mark based on Opposer's common law rights in its trademarks. These include the trademarks EXCEL TIRE AND WHEEL, EXCEL and EXCELLA ("the EXCEL Marks") for use in connection with tires, wheels and related products, including, but not limited to, Tires, inner tubes, mud flaps,

wheels and parts and fittings therefore. Opposer has used the EXCEL Marks since at least as early as November 1, 2002. Opposer has continued to use the EXCEL Marks and build fame throughout the U.S. in the EXCEL Marks. This use has been valid and continuous and has not been abandoned. Opposer's EXCEL Marks have been popular and well known for 6 years and the products sold and offered in connection therewith have been the subject of substantial advertising and promotional activities. Trademarks containing the term "EXCEL" are distinctive and have acquired secondary meaning through Opposer's use. These trademarks are therefore entitled to strong protection under trademark law and would be damaged by the registration of the trademark "KRONUS TYRES CRAFTED TO EXCEL" shown in the Applicant's Mark.

3. Opposer's use in commerce of its EXCEL Marks in connection with its goods is 5 years' prior to November 16, 2007, the filing date of the Applicant's Mark.

4. Opposer's trademarks and trade names are symbolic of the extensive goodwill and consumer recognition built up by Opposer in the EXCEL Marks through substantial amounts of time and effort in the advertising and promotion of its goods. Opposer has offered goods in association with the EXCEL Marks extensively and continuously in commerce in the United States since as early as November 1, 2002. This use has been valid and continuous and has not been abandoned.

5. Opposer is the owner of all rights in and to the EXCEL Marks for the goods set forth above.

6. Upon information and belief, Applicant was aware of the Opposer's EXCEL Marks when Applicant selected its claimed trademark KRONUS TYRES CRAFTED TO EXCEL shown in the Applicant's Mark, and intended and intends to use the same in such a manner as to trade on the goodwill of the Opposer's EXCEL Marks in the United States.

8. The goods covered under the Applicant's Mark are for "Tires, inner tubes, mud flaps, wheels and parts and fittings therefore" in International Class 12. Opposer's registration and applications cover the following goods: "Tires; Land vehicle parts, namely, wheels; Wheels" and "tires especially designed for all terrain vehicles" in International Class 12. The goods provided by Opposer under its EXCEL Marks and the goods to be provided by Applicant under the Applicant's Mark are so related that Applicant's Mark will likely cause confusion or mistake, or will deceive or falsely suggest an association with Opposer.

9. Because of the very similar nature of the trademarks and the closely related and overlapping nature of the goods of the respective parties, Applicant's Mark so resembles the Opposer's EXCEL Marks in spelling, pronunciation, usage, goods, channels of trade and consumers, that Applicant's Mark will likely cause confusion or mistake, or will deceive or falsely suggest an association with Opposer.

10. If Applicant is permitted to use and register Applicant's Mark for its goods, as specified in the Applicant's Mark, the resulting likelihood of confusion, mistake, deception, or false association will cause irreparable damage to the goodwill and consumer recognition that Opposer has built up in its EXCEL Marks.

11. Opposer's use of its EXCEL Marks extends outside the scope of its description of goods contained within its pending applications and registered U.S. trademark to include goods for "tires, inner tubes, mud flaps, wheels and/or parts and fittings therefor" as proposed by Applicant under Applicant's Mark. Thus, the goods used by Opposer for many years and as proposed by Applicant in Applicant's Mark are nearly identical. Furthermore, Opposer has established common law rights in its EXCEL Marks in connection with tires, wheels and parts and related products therefor.

12. Applicant's proposed use of Applicant's Mark interferes with the Opposer's use of its EXCEL Marks and will cause confusion in connection with and may negatively impact Opposer's goodwill and free use of its trademarks. Registration of Applicant's Mark by Applicant will seriously damage Opposer under Section 2(d) of the United States Trademark Act, 15 U.S.C. §1052(d).

WHEREFORE, Opposer prays that said Applicant's Mark Serial No. No. 77/331126 be rejected, that no registration be issued thereon to Applicant and that this opposition be sustained in favor of Opposer. Please charge the filing fee for one Class of \$300 to our Deposit Account No. 504183 (Allen Matkins).

Please address all correspondence to Michael R. Adele, Esq., ALLEN MATKINS, 12348 High Bluff Drive, Suite 210, San Diego, California 92130.

Respectfully submitted,

Date: October 24, 2008

By: _____
Michael R. Adele
Randall K. Broberg
Allen Matkins Leck Gamble Mallory & Natsis LLP
12348 High Bluff Drive, Suite 210
San Diego, California 92130

Attorneys for Opposer

CERTIFICATE OF SERVICE

A true and correct copy of the foregoing Opposer EXCEL TIRE AND WHEEL CORP's Notice of Opposition was served by First Class Mail, Postage Prepaid, to the following:

HENRI MISRAHI
4000 WILLIAMS ISLAND BCH APT 1804
AVENTURA, FL 33160-5252

on this 24th day of October, 2008.

Michael R. Adele

EXHIBIT A

Int. Cl.: 12

Prior U.S. Cls.: 19, 21, 23, 31, 35, and 44

United States Patent and Trademark Office

Reg. No. 3,412,142

Registered Apr. 15, 2008

**TRADEMARK
PRINCIPAL REGISTER**

EXCEL TIRE & WHEEL

EXCEL TIRE & WHEEL CORP. (CALIFORNIA CORPORATION)

P.O. BOX 1044

WALNUT, CA 91788

FOR: TIRES ESPECIALLY DESIGNED FOR ALL TERRAIN VEHICLES, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FIRST USE 5-22-2002; IN COMMERCE 5-22-2002.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TIRE & WHEEL", APART FROM THE MARK AS SHOWN.

SN 77-024,957, FILED 10-19-2006.

LAURA KOVALSKY, EXAMINING ATTORNEY

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 77265139

Filing Date: 08/27/2007

NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	EXCEL
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	EXCEL
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
APPLICANT INFORMATION	
*OWNER OF MARK	Excel Tire & Wheel Corp.
*STREET	P.O. Box 1044
*CITY	Walnut
*STATE (Required for U.S. applicants)	California
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	91788
LEGAL ENTITY INFORMATION	
*TYPE	CORPORATION
*STATE/COUNTRY OF INCORPORATION	California
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	012
*IDENTIFICATION	Tires; Land vehicle parts, namely, wheels; Wheels
*FILING BASIS	SECTION 1(b)
ATTORNEY INFORMATION	
NAME	Randall K. Broberg
ATTORNEY DOCKET NUMBER	E3403-003
FIRM NAME	Allen Matkins
STREET	12348 High Bluff Drive
INTERNAL ADDRESS	Suite 220
CITY	San Diego
STATE	California
COUNTRY	United States

ZIP/POSTAL CODE	92130-3545
PHONE	858-481-5055
FAX	858-481-5028
EMAIL ADDRESS	cwithycombe@allenmatkins.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Cheryl A. Withycombe
CORRESPONDENCE INFORMATION	
*NAME	Randall K. Broberg
FIRM NAME	Allen Matkins
*STREET	12348 High Bluff Drive
INTERNAL ADDRESS	Suite 220
*CITY	San Diego
*STATE (Required for U.S. applicants)	California
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*EMAIL ADDRESS	cwithycombe@allenmatkins.com
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	275
*TOTAL FEE PAID	275
SIGNATURE INFORMATION	
* SIGNATURE	/Randy Broberg/
* SIGNATORY'S NAME	Randall K. Broberg
* SIGNATORY'S POSITION	Attorney of record
* DATE SIGNED	08/27/2007

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 77265139

Filing Date: 08/27/2007

To the Commissioner for Trademarks:

MARK: EXCEL (Standard Characters, see mark)

The literal element of the mark consists of EXCEL.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Excel Tire & Wheel Corp., a corporation of California, having an address of P.O. Box 1044, Walnut, California, United States, 91788, requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal

Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 012: Tires; Land vehicle parts, namely, wheels; Wheels

Intent to Use: The applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services. (15 U.S.C. Section 1051(b)).

The applicant hereby appoints Randall K. Broberg and Cheryl A. Withycombe of Allen Matkins, Suite 220, 12348 High Bluff Drive, San Diego, California, United States, 92130-3545 to submit this application on behalf of the applicant. The attorney docket/reference number is E3403-003.

Correspondence Information: Randall K. Broberg

Suite 220

12348 High Bluff Drive

San Diego, California 92130-3545

858-481-5055(phone)

858-481-5028(fax)

cwithycombe@allenmatkins.com (authorized)

A fee payment in the amount of \$275 has been submitted with the application, representing payment for 1 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Signature: /Randy Broberg/ Date Signed: 08/27/2007

Signatory's Name: Randall K. Broberg

Signatory's Position: Attorney of record

RAM Sale Number: 617

RAM Accounting Date: 08/28/2007

Serial Number: 77265139

Internet Transmission Date: Mon Aug 27 15:25:15 EDT 2007

TEAS Stamp: USPTO/FTK-76.88.100.112-2007082715251538

3723-77265139-3801cf22c4ffd852f936cda9cb

f494e77c7-DA-617-20070827151901706758

EXCEL

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 77265152

Filing Date: 08/27/2007

NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.

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USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	EXCELLA
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* SIGNATURE	/Randy Broberg/
* SIGNATORY'S NAME	Randall K. Broberg
* SIGNATORY'S POSITION	Attorney of record
* DATE SIGNED	08/27/2007

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 77265152

Filing Date: 08/27/2007

To the Commissioner for Trademarks:

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The literal element of the mark consists of EXCELLA.

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Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended.

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Signature: /Randy Broberg/ Date Signed: 08/27/2007

Signatory's Name: Randall K. Broberg

Signatory's Position: Attorney of record

RAM Sale Number: 706

RAM Accounting Date: 08/28/2007

Serial Number: 77265152

Internet Transmission Date: Mon Aug 27 15:30:10 EDT 2007

TEAS Stamp: USPTO/FTK-76.88.100.112-2007082715301091

1097-77265152-380fcc29e91deab1bac3ab694c

49e46a97-DA-706-20070827152618614872

EXCELLA