

ESTTA Tracking number: **ESTTA258867**

Filing date: **01/06/2009**

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	Association of Automotive Service Providers of New Jersey		
Entity	Corporation	Citizenship	New Jersey
Address	3633 Route 33 Neptune, NJ 07753 UNITED STATES		

Attorney information	Lawrence D. Mandel Mandel & Peslak, LLC 80 Scenic Drive, Suite 5 Freehold, NJ 07728 UNITED STATES lmandel@mandelpeslak.com Phone:732-761-1610		
----------------------	--	--	--

Applicant Information

Application No	77510597	Publication date	12/09/2008
Opposition Filing Date	01/06/2009	Opposition Period Ends	01/08/2009
Applicant	Rockland Exposition, Inc. 388 E. Main Street Middletown, NY 10940 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 1982/09/15 First Use In Commerce: 1982/09/15 All goods and services in the class are opposed, namely: Promoting and conducting automotive trade shows
--

Applicant Information

Application No	77510599	Publication date	12/09/2008
Opposition Filing Date	01/06/2009	Opposition Period Ends	01/08/2009
Applicant	Rockland Exposition, Inc. 388 E. Main Street Middletown, NY 10940 UNITED STATES		


Goods/Services Affected by Opposition

Class 035. First Use: 2001/03/13 First Use In Commerce: 2001/03/13 All goods and services in the class are opposed, namely: Promoting and conducting automotive trade shows
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77631779	Application Date	12/12/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NORTHEAST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1985/12/31 First Use In Commerce: 1985/12/31 promoting and conducting trade shows for the automotive collision and repair industry		

Related Proceedings	United States District Court for the Southern District of New York, Docket No. 7:08-cv-11107
---------------------	--

Attachments	77631779#TMSN.jpeg (1 page)(bytes) Notice of Opposition 122908.pdf (4 pages)(27099 bytes)
-------------	---

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/ Lawrence D. Mandel
Name	Lawrence D. Mandel
Date	01/06/2009

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

In The Matter of Trademark Application Serial Nos. 77/510,597 and 77/510,599
Filed June 28, 2008 for the marks NORTHEAST and NORTHEAST REGIONAL
Published in the Official Gazette on December 9, 2008

ASSOCIATION OF AUTOMOTIVE SERVICE PROVIDERS OF NEW JERSEY,;	:	
	:	
Opposer,	:	Opposition No. _____
	:	
v.	:	
	:	
ROCKLAND EXPOSITION, INC.,	:	
	:	
Applicant.	:	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
ATTN.: Trademark Trial and Appeal Board

NOTICE OF OPPOSITION

Association of Automotive Service Providers of New Jersey, a New Jersey Corporation, having a business address at 3633 Route 33, Neptune, New Jersey 07753, believes that it will be damaged by registration of Application Serial No. 77/510,597 for the mark NORTHEAST and Application Serial No. 77/510,599 for the mark NORTHEAST REGIONAL. As grounds for opposition, Opposer alleges as follows:

COUNT I

1. Opposer has adopted and continuously used the trademark NORTHEAST since at least as early as 1985 to the present, to distinguish its services.

2. Through its extensive sales and advertising, Opposer has developed extensive goodwill throughout the United States with respect to the mark NORTHEAST.

3. Opposer filed an Application for registration of the mark NORTHEAST in respect of “promoting and conducting trade shows for the automotive collision and repair industry” on December 12, 2008 and received U.S. Trademark Application Serial No. 77/631,779.

4. Upon information and belief, Rockland Exposition, Inc., a New York corporation, with an address at 388 East Main Street, Middletown, New York 10940, has filed Application Serial No. 77/510,597 on June 28, 2008 for the mark NORTHEAST in respect of “promoting and conducting automotive trade shows” in International Class 35.

5. Upon information and belief, Rockland Exposition, Inc., a New York corporation, with an address at 388 East Main Street, Middletown, New York 10940, has filed Application Serial No. 77/510,599 on June 28, 2008 for the mark NORTHEAST REGIONAL in respect of “promoting and conducting automotive trade shows” in International Class 35.

6. The applications, which are the subject of this notice of opposition, were filed by Applicant claiming a date of first use of September 15, 1982 for the mark NORTHEAST and a date of first use of March 13, 2001 for the mark NORTHEAST REGIONAL. Upon information and belief, Applicant has no rights to use of the marks in connection with promoting and conducting tradeshow for the automotive collision and repair industry. Opposer’s use of its

mark NORTHEAST in connection with promoting and conducting trade shows for the automotive collision and repair industry predates any attempt by Applicant to establish rights in the mark for such services, thereby entitling Opposer to priority in rights over Applicant.

7. The recitation of services as recited in Applicant's application is overbroad and, therefore, may be deemed to include services which are similar or closely related, if not identical, to the services offered by Opposer so that the use of Applicant's marks NORTHEAST and NORTHEAST REGIONAL in connection with certain of such services is likely to cause confusion, or to cause mistake or to deceive.

8. NORTHEAST and NORTHEAST REGIONAL for "promoting and conducting automobile trade shows" is confusingly and deceptively similar to Opposer's mark, such that the trade and purchasing public will be confused and deceived by believing that Applicant's services originate with or are otherwise authorized, sponsored, licensed or associated with Opposer.

9. Based on the foregoing, registration of Application Serial No. 77/510,597 and Application Serial No. 77/510,599 will cause damage to Opposer, and registration should, therefore, be denied.

10. The Requisite Fee of \$600.00 is submitted herewith for the two applications subject to this Notice of Opposition.

WHEREFORE, it is respectfully requested that the Trademark Trial and Appeal Board refuse registration to Application Serial No. 77/510,597 and Application Serial No. 77,510,599.

COUNT II

11. Opposer repeats and realleges the allegations contained in Paragraphs 1 through 10 of the Notice of Opposition as if fully set forth herein.

