

ESTTA Tracking number: **ESTTA385128**

Filing date: **12/22/2010**

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	TOMTOM INTERNATIONAL BV
Granted to Date of previous extension	12/22/2010
Address	Rembrandt 35 Amsterdam, 1017CT NETHERLANDS

Attorney information	David R Haarz Harness Dickey & Pierce 11730 Plaza America Dr Suite 600 Reston, VA 20190 UNITED STATES tjcomparoni@hdp.com,dhaarz@hdp.com
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Applicant Information

Application No	85004578	Publication date	08/24/2010
Opposition Filing Date	12/22/2010	Opposition Period Ends	12/22/2010
Applicant	TOM TOM MAGAZINE, INC PMB 85 302 Bedford Avenue Brooklyn, NY 11211 UNITED STATES		

Goods/Services Affected by Opposition


Class 016. First Use: 2009/11/01 First Use In Commerce: 2009/11/01 All goods and services in the class are opposed, namely: print magazine for female drummers
Class 041. First Use: 2008/12/12 First Use In Commerce: 2008/12/12 All goods and services in the class are opposed, namely: Providing an internet website portal featuring information about female drummers

Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3409331	Application Date	05/04/2006
Registration Date	04/08/2008	Foreign Priority Date	04/06/2006

Word Mark	TOMTOM
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: Computer hardware; computer software for use with satellite and for use with satellite and/or GPS navigation systems for navigation, route and trip planning, and electronic mapping; computer software for travel information systems for the provision or rendering of travel advice and/or information concerning service stations, car parks, multi-storey car parks, restaurants, car dealers and other information regarding travel and transport; hardware and software for information management for the transport and traffic industries; computer software to be used for viewing and downloading electronic maps; software for operating route planners; route planners in the nature of hand-held personal computers; software for operating digital dictionaries; electronic digital dictionaries; location, orientation, and navigation sensors, transmitters, actuators, cameras and global positioning systems, namely, GPS comprising computers, computer software, transmitters, GPS and satellite receivers, network interface devices, connecting cables, and parts and fittings thereof; holders for pocket personal computers, namely, protective carrying cases specially adapted for personal digital assistants (PDA); satellite and radio transmission processors and receivers; telecommunication installations, networks and apparatus, namely, mounting racks for telecommunications hardware, telecommunications switches; computer terminals to be used with navigation systems, route planners and digital maps; blank magnetic data carriers and blank recording discs; audio and video apparatus, namely, audio and video receivers and processors; hand-held personal computers; personal digital assistants; electric and electronic instruments for providing information regarding maps, navigation, traffic, weather and interesting locations; alarm apparatus and instruments to be used for tracking and tracing vehicles, namely, vehicle locating and tracking systems comprised of computers, computer software, transceivers, transponders, global positioning satellite receivers and antennas</p> <p>Class 038. First use: Secured or not secured telecommunication services, namely, transmission and delivery of digital data, light files, sound files, data, information and image signals, by means of computer, cable, radio and satellite networks, all in particular for navigation systems, route planners and the use of electronic maps; wireless transmission of data by means of videotext, the Internet, GSM and WAP; wireless transmission of digital data; communication by way of computer terminals; telecommunication services for the communication with means of transport, namely, transmission of digital data, light files, sound files, data, information and image signals, by means of wireless and satellite networks; rental of telecommunication equipment; technical telecommunications consultation concerning all services mentioned above</p> <p>Class 039. First use: Navigational services, namely, providing navigational information for use in piloting land vehicles, providing global positioning and navigation information via mobile telephone, wireless and satellite networks; information services regarding traffic and traffic congestion; provision of information regarding travel; provision of information to travellers regarding fares, time tables and means of public transport; services of a travel agency, namely booking of rental cars, boats and</p>

	<p>other vehicles; all of the aforesaid services also provided via a communications network or a mobile telephone or a wireless navigation device</p> <p>Class 041. First use: Education services, namely, providing classes and seminars regarding the use of navigation systems; training services in the field of navigation systems; entertainment, namely, the production of radio programs and television programs; organizing community cultural activities and sporting activities</p> <p>Class 042. First use: Development and design of navigation systems, route planners, electronic maps and digital dictionaries for others; computer software and hardware design; development and design of software for use with navigation systems, route planners, electronic maps and digital dictionaries; development and design of telecommunication and data communication networks; providing temporary use of non-downloadable software for tracking and tracing goods and vehicles via computer networks, intranets and the internet</p> <p>Class 045. First use: Security services for the protection of property and individuals, namely, the tracking and tracing of goods and individuals in the context of security</p>
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U.S. Registration No.	3606082	Application Date	03/28/2003
Registration Date	04/14/2009	Foreign Priority Date	02/14/2003
Word Mark	TOMTOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Computer hardware and software for use with navigation systems, route planners and the use of electronic maps and digital dictionaries; software for use with satellite and GPS navigation systems; software for travel information systems for the provision and rendering of travel advice and information concerning service stations, car parks, restaurants, car dealers and other travel and transport related information; software for information management for the transport and traffic industries; software to be used for viewing electronic maps; downloadable electronic maps; software for operating route planners; route planners in the nature of hand-held personal computers; software for operating electronic digital dictionaries; electronic digital dictionaries; location, orientation, and navigation sensors, transmitters, actuators, cameras and global positioning systems, namely, GPS consisting of computers, computer software, transmitters, GPS and satellite receivers, network interface devices, connection cables and parts and fittings thereof, holders for pocket personal computers; satellite and radio transmission processors and receivers; telecommunications installations, networks and apparatus, namely, mounting racks for telecommunications hardware, telecommunications switches; computer terminals, all in particular to be used with navigation systems, route planners and digital maps; blank magnetic and disc shaped data carriers; audio and video apparatus, namely, audio and video receivers and processors; hand personal computers; personal digital assistants</p> <p>Class 038. First use: Secured or unsecured telecommunications services, namely, transmission and delivery of digital data, light files, sound files, data, information and image signals by means of computer, cable, radio and satellite transmissions, all in particular for navigation systems, route planners, and the use of electronic maps; wireless transmission of data by means of video text, the internet, GSM</p>		

	<p>and WAP; wireless transmission of digital data; electronic transmission of data and documents via computer terminals; rental of telecommunications equipment; technical consultation in connection with all of the above</p> <p>Class 039. First use: Secured and unsecured telecommunications services, namely, electronic storage of digital data, light files, sound files, data, information and image signals all in particular for navigation systems, route planners and the use of electronic maps</p> <p>Class 042. First use: Consultation in the field of computer software design; providing temporary use of non-downloadable software which provides geographical, map image, and trip routing data obtained with the aid of a global positioning system, GPS, in order to enable third parties to come to an accurate location or orientation; development and design of navigation systems, route planners, electronic maps and digital dictionaries; computer software and hardware design; development and design of software for use with navigation systems, route planners and the use of electronic maps and digital dictionaries; development and design of telecommunications and data communication services and networks</p>
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Attachments	79031570#TMSN.jpeg (1 page)(bytes) Notice of Opposition TOM TOM MAGAZINE.PDF (4 pages)(157698 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	/david r haarz/
Name	David R Haarz
Date	12/22/2010

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

TOMTOM INTERNATIONAL B.V.,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	Application No. 85004578
TOM TOM MAGAZINE, INC.,)	TOM TOM MAGAZINE
)	Published: August 24, 2010
Applicant.)	

NOTICE OF OPPOSITION

TomTom International B.V., believing that it will be damaged by the registration of the mark shown in Application Serial No. 85004578 in Classes 16 and 41 filed by Tom Tom Magazine, Inc. ("Applicant") on April 1, 2010, hereby opposes Application Serial No. 85004578.

The grounds of Opposition are as follows:

1. TomTom International B.V. ("Opposer"), is a Besloten Vennootschap duly organized and existing under the laws of the Netherlands, having its corporate address at Rembrandtplein 35, NL-1017 CT Amsterdam, the Netherlands.
2. Opposer is the owner of the mark TOMTOM.
3. Since at least as early as 2001, and long prior to the December 12, 2008 date of first use of TOM TOM MAGAZINE claimed in Applicant's application, Opposer and/or its predecessor in interest has engaged in, and is now engaged in, the advertising, sale and promotion in interstate commerce of goods and services under the TOMTOM mark.

4. Opposer and/or its predecessor in interest has used its TOMTOM mark in connection with products and services related to navigation systems for use by consumers and businesses.

5. Opposer owns United States Trademark Registration No. 3409331 issued April 8, 2008 for the mark TOMTOM for goods in Class 9 and services in Classes 38, 39, 31, 42 and 45 and United States Trademark Registration No. 3606082 issued April 14, 2009 for the mark TOMTOM for goods in Class 9 and services in Classes 38, 39 and 42. Each of those registrations is valid and subsisting and is prima facie evidence of the validity of the TOMTOM mark, the registration of the TOMTOM mark, of Opposer's ownership of the TOMTOM mark, and of the Opposer's exclusive right to use the TOMTOM mark in commerce on or in connection with the goods and services specified in the registrations.

6. In addition to its rights under its federal registrations as set forth above, Opposer relies herein upon its common law rights in the TOMTOM mark.

7. Since its initial adoption and use, Opposer has made a substantial investment in promoting its goods and services in connection with its TOMTOM mark. As a result of Opposer's long and continuous use of its TOMTOM mark in connection with products and services and as a result of the substantial sales and advertising of products and services using its TOMTOM mark, the TOMTOM mark is famous in that it is widely recognized by the general consuming public of the United States as a designation of source of the goods and services of Opposer.

8. Upon information and belief, notwithstanding Opposer's rights in and to its TOMTOM mark, Applicant adopted the TOM TOM MAGAZINE mark and on April 7, 2010 filed an application for registration of TOM TOM MAGAZINE in Classes 16 and 41. That application was assigned Serial No. 85004578 and was published for Opposition in the Official Gazette of August 24, 2010.

9. Applicant's mark, TOM TOM MAGAZINE, for the goods in Class 16 and the services in Class 41, so resembles Opposer's TOMTOM mark as to be likely, when applied to the goods and services of Applicant to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

10. Opposer avers that its customers and the public in general are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's goods and services marketed under Applicant's mark, TOM TOM MAGAZINE, and would be misled into believing that such goods and services are sponsored by, emanate from, or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer's reputation.

11. Applicant's mark, TOM TOM MAGAZINE, for the goods in Class 16 and the services in Class 41, so resembles Opposer's TOMTOM mark as to be likely to cause dilution by blurring of the famous TOMTOM mark.

12. Opposer avers that it will be damaged by the use and registration by Applicant of the TOM TOM MAGAZINE mark in Classes 16 and 41 as set forth in Applicant's Trademark Application Serial No. 85004578 in that the mark is substantially similar to Opposer's TOMTOM mark and is to be used in connection with goods and

services identical to or closely related to the goods and services of Opposer and is likely to cause dilution by blurring of the famous TOMTOM mark.

WHEREFORE, Opposer believes and avers that it will be damaged by registration of TOM TOM MAGAZINE Classes 16 and 41 and requests that Application No. 85004578 be rejected and that this Opposition be sustained in favor of Opposer.

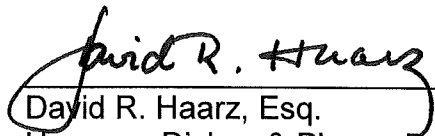
Please charge any fee deficiency in connection with this proceeding to Deposit Account No. 08-0750 with the reference number 15081-500108.

Respectfully submitted,

HARNES, DICKEY & PIERCE, P.L.C.

Date: December 22, 2010

By:

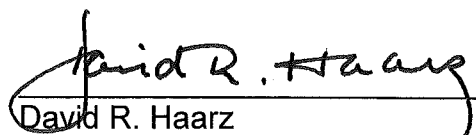


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Attorneys for TomTom International B.V.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Notice of Opposition has been served upon the applicant's designated representative, at his address of record set forth below by First Class Mail, postage prepaid, on this 22nd day of December, 2010.

Natalie Sulimani
Sulimani Law Firm PC
116 W 23RD ST STE 500
NEW YORK, NY 10011-2599



David R. Haarz