

ESTTA Tracking number: **ESTTA430678**

Filing date: **09/15/2011**

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

Proceeding	91201617
Party	Plaintiff TBC RETAIL GROUP, INC.
Correspondence Address	Marsha G. Gentner Jacobson Holman PLLC 400 - 7th Street, N.W.6th Floor Washington, DC 20004 UNITED STATES trademark@jhip.com, mgentner@jhip.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Marsha G. Gentner
Filer's e-mail	trademark@jhip.com,mgentner@jhip.com
Signature	/Marsha G. Gentner/
Date	09/15/2011
Attachments	I6454 amended opp_20110915154805.pdf (21 pages)(789669 bytes)

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

TBC RETAIL GROUP, INC.,)
)
Opposer,)
)
v.) **CONSOLIDATED OPPOSITION**
) **No. 91201617**
ENTERTAINMENT PUBLICATIONS, LLC,)
)
Applicant.)

AMENDED NOTICE OF OPPOSITION

In the matter of applications to register trademarks under the Trademark Act of 1946, Serial Nos. 85/104,744 and 85/104,793, filed August 11, 2012, published for opposition in the Trademark Official Gazette of May 17, 2011, Vol. 1366, No. 3, at pages TM 260-261, for the mark CROWN DESIGN, in the name of Entertainment Publications, LLC, the Opposer, TBC Retail Group, Inc., believes it may be damaged by registration of said alleged trademarks and hereby opposes same. The grounds for opposition are as follows:

1. The Opposer, TBC Retail Group, Inc. (“TBC”), is a corporation organized and existing under the laws of the State of Florida and having its place of business at 823 Donald Ross Road, Juno Beach, Florida 33408. TBC markets, distributes and sells, throughout the world and in commerce, a variety of vehicle products, provides retail store and online services, and provides maintenance and repair services.

3. Commencing prior to the filing date of each of the applications opposed herein, TBC has, and is now, engaged in the advertising, marketing, distribution and sale of vehicle products and services, retail store and other services – including through distribution of coupons, discount offers,

and electronic consumer coupons – in commerce in the United States, under and in connection with fanciful crown designs (alone and with other words, designs, and/or symbols), as exemplified by Opposer’s U.S. trademark registrations, attached hereto (hereafter referred to as “TBC’s **CROWN DESIGN** marks). TBC continuously has used TBC’s **CROWN DESIGN** marks, in commerce in connection with the products, services and stores of TBC, and to identify and designate same, and to distinguish those goods, services, stores and business from those of others.

4. Opposer is the owner of, and will rely on herein, the following U.S. registrations:

REGISTRATION NUMBER	ISSUE DATE
2,362,324	June 27, 2000
2,850,390	June 8, 2004
2,864,332	July 20, 2004
3,227,224	April 10, 2007

Attached hereto are printouts of information from the electronic database records of the U.S. Patent and Trademark Office showing the current status and title of each of these registrations. Said registrations operate as conclusive and/or *prima facie* evidence of Opposer’s ownership of the marks set forth therein and exclusive right to use same in commerce in connection with the goods and services listed in those registrations. See 15 U.S.C. §1065.

5. On August 11, 2010, Applicant filed applications to register certain CROWN DESIGN marks. Said applications were accorded serial nos. 85/104,744 and 85/104,793, and were published for opposition in the Official Gazette of May 17, 2011, at pages 260-261, identifying the goods and services as follows:

downloadable software in the nature of a mobile application for management and retrieval of merchant lists and merchant information including discount offers and electronic consumer coupons for immediate or future use by consumers, in Class 9; books, booklets, and non-magnetically encoded printed coupon and discount cards all which entitle the holder to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater, and other leisure activities sold separately or as part of a unit, in Class 16;

advertising and promotional services, namely, promoting the goods and services of others through the distribution of coupons, and discount offers which entitle the holder to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater and other leisure activities; providing advertising service through the distribution of advertisements, coupons and discount offers for display on internet, namely, in websites, e-mails and multimedia messages; providing via on-line computer services a membership program entitling the participants to receive discounts on dining, hotel accommodations, consumer merchandise, travel, movies, sports, theater and other leisure activities, and providing in connection therewith an on-line directory of information about the discount program and participating businesses, in Class 35; and

charitable fundraising services effected through a membership program which entitles the participants to distribute coupons and discount offers which allows the

holder to receive discounts on dining, hotel accommodation, consumer merchandise, travel, movies, sports, theater and other leisure activities, in Class 36.

6. On information and belief, Applicant's CROWN DESIGN marks sought to be registered by Applicant are a colorable imitation of, and/or are confusingly similar to, TBC's **CROWN DESIGN** marks as used by TBC.

7. The goods and services set forth in the applications opposed herein are similar and/or related to the manner in which TBC has used TBC's **CROWN DESIGN** marks to advertise and/or promote TBC's goods, services and/or business, and on information and belief, the goods and services set forth in the opposed applications are and/or will be sold through the same and/or similar channels of trade, and/or to the same general class of purchasers, in and to which Opposers' products and services are marketed and/or sold.

8. On information and belief, the registration and/or use of the CROWN DESIGN marks, as set forth in the opposed applications, is likely to cause confusion, mistake, and/or to deceive as to origin, sponsorship, and/or association of Applicant's goods and services to be sold under the opposed mark sought to be registered by Applicant vis-a-vis TBC's **CROWN DESIGN** marks as used by TBC to advertise and promote TBC's goods, services and/or business, and/or to mislead purchasers of Applicant's and/or Opposer's goods and/or services, and/or the public in general, into believing that Applicant's goods and services and/or those of Applicant's customers, are sold by, emanate from, and/or in some way, directly or indirectly, are associated with TBC, and/or TBC's **CROWN DESIGN** marks, products, services and/or business, or vice versa, to the damage and detriment of Opposer.

CERTIFICATE OF SERVICE

I hereby certify that on this 15th day of September, 2011, the foregoing Amended Notice of Opposition was served, by mailing same first class and postage prepaid, on the following correspondent as set forth in the records of the U.S. Patent and Trademark Office:

Julie E. Kretzschmer
Honigman Miller Schwartz and Cohn LLP
39400 Woodward Avenue
Suite 101
Bloomfield Hills, Michigan 48304-5151

/Marsha G. Gentner/

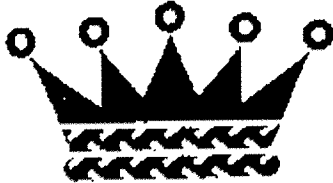
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-09-15 15:38:12 ET

Serial Number: 75791760 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2362324

Mark



Standard Character claim: No

Current Status: The registration has been renewed.

Date of Status: 2010-01-29

Filing Date: 1999-09-01

Transformed into a National Application: No

Registration Date: 2000-06-27

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: (NOT AVAILABLE)

Date In Location: 2010-01-29

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. TBC RETAIL GROUP, INC.

Address:

TBC RETAIL GROUP, INC.
823 DONALD ROSS ROAD
JUNO BEACH, FL 33408
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Florida

GOODS AND/OR SERVICES

International Class: 035**Class Status:** Active

retail store services in the field of automotive tires

Basis: 1(a)**First Use Date:** 1995-00-00**First Use in Commerce Date:** 1995-00-00

ADDITIONAL INFORMATION

Design Search Code(s):

24.11.02 - Crowns open at the top

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-01-29 - First renewal 10 year

2010-01-29 - Section 8 (10-year) accepted/ Section 9 granted

2010-01-29 - Case Assigned To Post Registration Paralegal

2010-01-22 - TEAS Section 8 & 9 Received

2009-05-06 - Automatic Update Of Assignment Of Ownership
2006-09-06 - Section 8 (6-year) accepted & Section 15 acknowledged
2006-09-06 - Assigned To Paralegal
2006-06-15 - Section 8 (6-year) and Section 15 Filed
2006-06-15 - PAPER RECEIVED
2006-03-17 - Case File In TICRS
2003-11-18 - TEAS Change Of Correspondence Received
2000-06-27 - Registered - Principal Register
2000-04-04 - Published for opposition
2000-03-03 - Notice of publication
2000-01-04 - Approved for Pub - Principal Register (Initial exam)
1999-12-14 - Examiner's amendment mailed
1999-12-10 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

MARSHA G. GENTNER

Correspondent

MARSHA G. GENTNER

JACOBSON HOLMAN

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WASHINGTON DC 20004

Phone Number: 202-638-6666

Fax Number: 202-393-5350

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-09-15 15:38:37 ET

Serial Number: 76487769 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2850390

Mark



(words only): TIRE KINGDOM

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2010-04-03

Filing Date: 2003-02-05

Transformed into a National Application: No

Registration Date: 2004-06-08

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: M50 -TMO Law Office 114

Date In Location: 2010-04-03

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. TBC RETAIL GROUP, INC.

Address:

TBC RETAIL GROUP, INC.
823 DONALD ROSS ROAD
JUNO BEACH, FL 33408
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Florida

GOODS AND/OR SERVICES

International Class: 035**Class Status:** Active

Retail store services in the field of automotive tires

Basis: 1(a)**First Use Date:** 1995-00-00**First Use in Commerce Date:** 1995-00-00

ADDITIONAL INFORMATION

Disclaimer: "TIRE"

Description of Mark: The mark consists of color is a part of the mark, consisting of a yellow rectangular background upon which is depicted a crown design having a crown base in the form of a black tire-track, red crown points and crown tips outlined in black open circles resembling tires with the word "TIRE KINGDOM" in black lettering.

Design Search Code(s):**18.11.01** - Inner tubes; Tire marks; Tires; Tubes, tire**24.11.02** - Crowns open at the top**26.01.21** - Circles that are totally or partially shaded.**Prior Registration Number(s):**

1838215

2362324

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-04-03 - Section 8 (6-year) accepted & Section 15 acknowledged

2010-04-03 - Case Assigned To Post Registration Paralegal

2010-03-22 - TEAS Section 8 & 15 Received

2009-05-06 - Automatic Update Of Assignment Of Ownership

2004-06-08 - Registered - Principal Register

2004-03-16 - Published for opposition

2004-02-25 - Notice of publication

2004-01-15 - Approved for Pub - Principal Register (Initial exam)

2003-12-15 - Communication received from applicant

2003-12-15 - PAPER RECEIVED

2003-11-18 - TEAS Change Of Correspondence Received

2003-08-04 - Non-final action mailed

2003-07-25 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Marsha G. Gentner

Correspondent

Marsha G. Gentner

Jacobson Holman PLLC

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-09-15 15:39:19 ET

Serial Number: 76487604 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 2864332

Mark



(words only): TIRE KINGDOM

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2010-04-03

Filing Date: 2003-02-05

Transformed into a National Application: No

Registration Date: 2004-07-20

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: M50 -TMO Law Office 114

Date In Location: 2010-04-03

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. TBC RETAIL GROUP, INC.

Address:

TBC RETAIL GROUP, INC.
823 DONALD ROSS ROAD
JUNO BEACH, FL 33408
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Florida

GOODS AND/OR SERVICES

International Class: 035**Class Status:** Active

Retail store services in the field of automotive tires

Basis: 1(a)**First Use Date:** 1995-00-00**First Use in Commerce Date:** 1995-00-00

ADDITIONAL INFORMATION

Disclaimer: "TIRE"

Lining and Stippling: Color is part of the mark, consisting of a crown design outlined in black, a crown base having a yellow background and a black tire-track, red crown points and crown tips outlined in black circles filled with yellow depicting tires and the word "TIRE KINGDOM" in red lettering adjacent the crown design.

Design Search Code(s):**18.11.01** - Inner tubes; Tire marks; Tires; Tubes, tire**24.11.02** - Crowns open at the top**Prior Registration Number(s):**

1838215

2362324

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-04-03 - Section 8 (6-year) accepted & Section 15 acknowledged

2010-04-03 - Case Assigned To Post Registration Paralegal

2010-03-22 - TEAS Section 8 & 15 Received

2009-05-06 - Automatic Update Of Assignment Of Ownership

2004-07-20 - Registered - Principal Register

2004-04-27 - Published for opposition

2004-04-07 - Notice of publication

2004-02-06 - Approved for Pub - Principal Register (Initial exam)

2004-01-08 - Communication received from applicant

2004-01-08 - PAPER RECEIVED

2003-11-18 - TEAS Change Of Correspondence Received

2003-07-30 - Non-final action mailed

2003-07-25 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2011-09-15 15:40:16 ET

Serial Number: 78796229 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3227224

Mark



(words only): TIRE KINGDOM TIRES IN AN HOUR OR LESS...

Standard Character claim: No

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2007-04-10

Filing Date: 2006-01-20

Filed as TEAS Plus Application: Yes

Currently TEAS Plus Application: Yes

Transformed into a National Application: No

Registration Date: 2007-04-10

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2007-04-10

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. TBC RETAIL GROUP, INC.

Address:

TBC RETAIL GROUP, INC.
823 DONALD ROSS ROAD
JUNO BEACH, FL 33408
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Florida

GOODS AND/OR SERVICES

International Class: 012

Class Status: Active

Tires; Tires

Basis: 1(a)

First Use Date: 2006-01-05

First Use in Commerce Date: 2006-01-05

International Class: 035

Class Status: Active

Retail tire stores

Basis: 1(a)

First Use Date: 2006-01-05

First Use in Commerce Date: 2006-01-05

International Class: 037

Class Status: Active

Tire balancing; Tire rotating and balancing

Basis: 1(a)

First Use Date: 2006-01-05

First Use in Commerce Date: 2006-01-05

ADDITIONAL INFORMATION

Color(s) Claimed: The color(s) red, black, yellow, white and gray is/are claimed as a feature of the

mark.

Description of Mark and Any Color Part(s): The mark consists of the color red appearing on part of the crown, clock, the words "Or Less" and in the contour of the words "Tires In An Hour"; the color black appearing on the tire, clock and contour of all the letters; the color yellow appearing in the terms "Tire Kingdom Tires In An Hour"; the color white appearing on the clock face and tire tread; and the color gray appearing in block shapes in the background of the logo.

Disclaimer: "Tire", "Tires In An Hour Or Less" and descriptive design of a tire

Design Search Code(s):

17.01.02 - Clock faces (alone); Clock radios; Clocks; Radios with clock; Watch faces (alone)

18.11.01 - Inner tubes; Tire marks; Tires; Tubes, tire

24.11.02 - Crowns open at the top

25.03.25 - Backgrounds covered with other figurative elements or repetitive designs, words or letters; Repetitive designs, words, or letters as a background

Prior Registration Number(s):

1838215

2850390

2864332

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2009-05-06 - Automatic Update Of Assignment Of Ownership

2007-04-10 - Registered - Principal Register

2007-01-23 - Published for opposition

2007-01-03 - Notice of publication

2006-12-07 - Law Office Publication Review Completed

2006-12-07 - Assigned To LIE

2006-11-20 - Approved for Pub - Principal Register (Initial exam)

2006-11-17 - Teas/Email Correspondence Entered

2006-11-16 - Communication received from applicant

2006-11-16 - TEAS Response to Office Action Received

2006-07-16 - Non-final action e-mailed

2006-07-16 - Non-Final Action Written

2006-07-10 - Assigned To Examiner

2006-01-27 - Notice Of Design Search Code Mailed

2006-01-26 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

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