

ESTTA Tracking number: **ESTTA529116**

Filing date: **03/27/2013**

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	Columbia Insurance Company
Granted to Date of previous extension	03/27/2013
Address	3024 Harney Street Omaha, NE 68131 UNITED STATES
Correspondence information	Jeffrey S. Standley Attorney of Record Standley Law Group LLP 6300 Riverside Dr. Dublin, OH 43017 UNITED STATES trademarks@standleyllp.com Phone:6147925555

Applicant Information

Application No	85639248	Publication date	11/27/2012
Opposition Filing Date	03/27/2013	Opposition Period Ends	03/27/2013
Applicant	IntelliJet Group, LLC 14600 Whirlwind Avenue Jacksonville, FL 32218 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2005/09/30 First Use In Commerce: 2005/09/30 All goods and services in the class are opposed, namely: Aircraft brokerage
Class 039. First Use: 2005/09/30 First Use In Commerce: 2005/09/30 All goods and services in the class are opposed, namely: Leasing of aircraft

Grounds for Opposition

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

U.S. Registration No.	2025410	Application Date	12/01/1995
Registration Date	12/24/1996	Foreign Priority Date	NONE
Word Mark	INTELLIJET		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1995/07/00 First Use In Commerce: 1995/07/00 computer software for managing aircraft leasing and sales

Related Proceedings	Case No. 12-cv-59 pending Southern District of Ohio, Eastern Division
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Attachments	Final Notice of Opposition.pdf (6 pages)(34315 bytes) Exhibit_A_75028764.pdf (3 pages)(82217 bytes) Exhibit_B_tsdr_uspto_pages.pdf (3 pages)(43293 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	/Beverly A. Marsh/
Name	Beverly A. Marsh
Date	03/27/2013

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

IN THE MATTER OF APPLICATION SERIAL NO.: 85/639248

MARK: INTELLIJET INTERNATIONAL

PUBLISHED IN THE OFFICIAL GAZETTE ON: November 27, 2012

Columbia Insurance Company

Opposer,

v.

IntelliJet Group, LLC

Applicant.

OPPOSITION NO. _____

NOTICE OF OPPOSITION

Columbia Insurance Company (“Columbia”), a corporation formed and existing under the laws of the State of Nebraska, having its principal place of business at 3024 Harney Street, Omaha, Nebraska 68131 believes that it will be damaged by the registration of the mark shown in U.S. Application Serial No. 85/639,248 (“the ’248 Application”), and hereby opposes the same. The time to oppose has been extended to March, 27th 2013, so this filing is timely. As grounds for opposition, Columbia alleges:

COLUMBIA'S TRADEMARK RIGHTS

The '410 Registration and Use of INTELLIJET in Commerce

1. On December 1, 1995, Executive Jet, Inc. applied for a U.S. Registration of the INTELLIJET mark as associated with computer software for managing aircraft leasing and sales in International Class 9.
2. The application was given U.S. Trademark Application Serial No. 75/028,764.
3. On December 24, 1996, the U.S. Patent and Trademark Office ("USPTO") issued U.S. Registration No. 2,025,410 ("the '410 Registration") for the INTELLIJET mark.
4. Registration of the INTELLIJET mark was based on use in commerce by Executive Jet since at least as early as July of 1995.
5. On April 15, 2002, Executive Jet, Inc. changed its name to NetJets Inc. ("NetJets"). The assignment of the INTELLIJET mark from Executive Jet, Inc. to NetJets was subsequently recorded with the USPTO.
6. A Combined Declaration of Use & Incontestability for the '410 Registration was filed by NetJets with the USPTO on September 23, 2002.
7. On December 19, 2002, the INTELLIJET mark was assigned to Columbia who is the current owner of the INTELLIJET mark.
8. NetJets licenses the INTELLIJET mark from Columbia Insurance Company and is the sole licensee of the INTELLIJET mark.
9. Exhibit A shows the '410 Registration as issued. The Registration is incontestable, in effect, and owned by Columbia according to records of the US Trademark Office. *See Exhibit B (TSDR pages showing Columbia as current owner of the '410 Registration).*
10. Including use of the mark that was made by its predecessor in interest Executive Jet, Inc., NetJets has made continuous use in commerce of the INTELLIJET mark as associated with computer software for managing aircraft leasing and sales since at least as early as 1995. That use has inured to the benefit of Columbia since Columbia became the owner of the INTELLIJET mark in 2002.
11. Including use of the mark that was made by its predecessor in interest Executive Jet, Inc., NetJets has similarly made continuous use in commerce of the INTELLIJET mark as associated with the services of managing aircraft, leasing aircraft, selling aircraft, selling

fractional shares in aircraft, selling time in aircraft through the use of jet cards, aircraft crew scheduling and flight planning, and aircraft chartering since at least as early as 1995.

APPLICANT

12. On information and belief, IntelliJet Group, LLC is a Florida Limited Liability Company with an address of 14600 Whirlwind Avenue, Suite 211, Jacksonville, Florida 32218.
13. Applicant filed the '248 Application on May 31, 2012, for the mark INTELLIJET INTERNATIONAL.
14. The '248 Application was filed in International Class 36 as associated with "Aircraft brokerage" and in International Class 39 as associated with "Leasing of aircraft."
15. Applicant filed the '248 Application based upon use in commerce at least as early as September 30, 2005.
16. The '248 Application was published in the Official Gazette of November 27, 2012.
17. On January 19, 2012, Columbia and NetJets jointly filed a Complaint in the United States District Court for the Southern District of Ohio Eastern Division against Applicant alleging, amongst other things, trademark infringement under the Lanham Act based on Applicant's use of the INTELLIJET mark in commerce.

Likelihood of Confusion

18. The mark represented by the '248 Application and Columbia's INTELLIJET mark are similar as to appearance, sound, connotation and commercial impression.
19. The dominant feature of the mark represented by the '248 Application and of Columbia's INTELLIJET mark is identical: INTELLIJET.
20. The goods and services on/in association with which Columbia's INTELLIJET mark are and have been utilized are substantially similar to the aviation-related goods and services recited by the '248 Application.
21. Upon information and belief, the marketing channels which are utilized by Columbia's licensee of the INTELLIJET mark, NetJets, to sell goods and services under the INTELLIJET mark, are substantially the same as are utilized by Applicant to offer the services recited by the '248 Application under the INTELLIJET INTERNATIONAL mark.

22. Columbia's rights in the INTELLIJET mark, which arise out of use of the INTELLIJET mark in commerce that was made by Executive Jet Inc. and NetJets at least as early as 1995, predate Applicant's alleged first dates of use by approximately ten years.
23. The Applicant has neither sought, nor has Columbia given, any consent as to the Applicant's use of the mark represented by the '248 Application.
24. Columbia's INTELLIJET Mark has become well-known in the industry through the extensive length of use, the amount of sales revenue achieved, and recognition by consumers of INTELLIJET goods and services as emanating from NetJets.
25. The extent of potential confusion is substantial if the Applicant is permitted to register the mark represented by the '248 Application.

Conclusions

26. Registration of the '248 Application to Applicant in association with the recited services would cause an impermissible dilution of the goodwill associated with the marks represented by Columbia's '410 Registration.
27. Registration of the '248 Application to Applicant and use of a mark substantially similar to Columbia's INTELLIJET mark is likely to cause confusion, or to cause mistake, or to deceive, particularly as to the source or origin of the goods and services with which Applicant uses its mark, or to induce purchasers to believe that the goods and services of Applicant are those of NetJets, or are endorsed by, or are in some way affiliated or associated with NetJets.
28. Registration of the '248 application to Applicant would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the mark represented by the '248 Application and would cause confusion among consumers of the relevant goods and services as to the source of the goods and services.

WHEREFORE, Columbia prays that this Opposition be sustained and that the Applicant be denied registration of Application Serial No. 85/639248 for "INTELLIJET INTERNATIONAL" in all applicable classes, specifically in:

International Class 36 as associated with “Aircraft brokerage” and in International Class 39 as associated with “Leasing of aircraft.”

The Commissioner is also authorized to charge any additional fees which may be required to Deposit Account 19-4076.

Respectfully submitted,

Columbia Insurance Company

Date: 3/27/2013

By: /Beverly A. Marsh/
Jeffrey S. Standley
Beverly A. Marsh
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Our Docket: NET2559-105B

CERTIFICATE OF SERVICE

I hereby certify that I have caused a true and correct copy of the foregoing NOTICE OF OPPOSITION to be served, via first class mail, postage prepaid, on this 27th day of March 2013, to counsel for Applicant at the address identified on the Patent and Trademark Office's TARR database as follows:

Joseph R. Dreitler
Dreitler True, LLC
137 E. State St.
Columbus, Ohio 43215

/Beverly A. Marsh/
Beverley A. Marsh

EXHIBIT A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,025,410

United States Patent and Trademark Office

Registered Dec. 24, 1996

**TRADEMARK
PRINCIPAL REGISTER**

INTELLIJET

EXECUTIVE JET, INC. (DELAWARE CORPORATION)
85 CHESTNUT RIDGE ROAD
MONTVALE, NJ 07645

FIRST USE 7-0-1995; IN COMMERCE
7-0-1995.

SER. NO. 75-028,764, FILED 12-1-1995.

FOR: COMPUTER SOFTWARE FOR MANAGING AIRCRAFT LEASING AND SALES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

STANLEY OSBORNE, EXAMINING ATTORNEY

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STANLEY OSBORNE, EXAMINING ATTORNEY

EXHIBIT B

Attention users! The Assignment section in TSDR will not be operational on March 22nd from 1:00 a.m. to 4:00 p.m. Other TSDR functionality will work without interruption. This includes all status sections (other than Assignment) document searches, multi-searches and the document viewer.

STATUS

DOCUMENTS

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Mark: INTELLIJET

US Serial Number: 75028764

Application Filing Date: Dec. 01, 1995

US Registration Number: 2025410

Registration Date: Dec. 24, 1996

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Aug. 08, 2007

Publication Date: Oct. 01, 1996

Mark Information

Mark Literal Elements: INTELLIJET

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *.* identify additional (new) wording in the goods/services.

For: computer software for managing aircraft leasing and sales

International Class: 009 - Primary Class

U.S Class: 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 1995

Use in Commerce: Jul. 1995

Basis Information (Case Level)

Current Owner(s) Information

Owner Name: COLUMBIA INSURANCE COMPANY

Owner Address: 3024 HARNEY STREET
OMAHA, NEBRASKA 68131
UNITED STATES

Legal Entity Type: CORPORATION

State or Country NEBRASKA
Where Organized:

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

TM Staff and Location Information

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load
