

ESTTA Tracking number: **ESTTA851364**

Filing date: **10/11/2017**

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 parties oppose registration of the indicated application.

Opposers Information

Name	VOLVO TRUCK CORPORATION
Granted to Date of previous extension	10/11/2017
Address	SE-405 08 Goteborg, 0 SWEDEN

Name	MACK TRUCKS, INC.
Granted to Date of previous extension	10/11/2017
Address	7900 National Service Road Greensboro, NC 27409 UNITED STATES

Attorney information	Leigh Ann Lindquist Sughrue Mion, PLLC 2100 Pennsylvania Avenue NW WASHINGTON, DC 20037 UNITED STATES Email: llindquist@sughrue.com, vmullineaux@sughrue.com, tm@sughrue.com Phone: 202.663.7409
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Applicant Information

Application No	87291368	Publication date	06/13/2017
Opposition Filing Date	10/11/2017	Opposition Period Ends	10/11/2017
Applicant	Macauto Industrial Co., Ltd. No. 6, Yongke 5th Rd., Yongkang Dist. Tainan City 710, R.O.C. TAIWAN		

Goods/Services Affected by Opposition

Class 012. First Use: 2016/05/23 First Use In Commerce: 2016/05/23

All goods and services in the class are opposed, namely: Automobile sunroofs; Automobile windshield sunshades; Luggage nets for vehicles; Motorized golf carts; Motorized golf trolleys; Powered wheel barrows; Sun blinds adapted for automobiles; Automotive windshield shade screens; Car window shades

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	946059	Application Date	01/19/1972
Registration Date	10/24/1972	Foreign Priority Date	NONE
Word Mark	MACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1911/00/00 First Use In Commerce: 1911/00/00 MAINTENANCE, REPAIR, AND PARTS REPLACEMENT SERVICES FOR TRUCKS AND TRUCK-TRACTORS		

U.S. Registration No.	946042	Application Date	03/09/1972
Registration Date	10/24/1972	Foreign Priority Date	NONE
Word Mark	MACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 FINANCING OF PURCHASES OF TRUCKS AND ARRANGING FOR INSURANCE COVERAGE IN CONNECTION WITH SUCH FINANCING		

U.S. Registration No.	1146847	Application Date	12/08/1978
Registration Date	02/10/1981	Foreign Priority Date	NONE
Word Mark	MACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1901/00/00 First Use In Commerce: 1901/00/00 Vehicles and Vehicles Parts and Accessories-Namely, Trucks, Truck-Tractors, Truck Engines, Engine Brakes, Engine Preheaters, Engine Supports, Accelerators, Axle Carriers, Front Axle Assemblies, FrontDrive Axles, Rear Axle Assemblies, V-Belts, Main Bearings, Brakes, Hand Brakes,Brake Controls, Air Brakes, Air Brake Coils, Brake Shoes, Air Brake Diaphragms,Brake Linings, Hydraulic Brake Master Cylinders, Tow Eye Bumpers, Truck Bumpers, Running Boards, Clutches, Clutch Assemblies, Crank Shafts, Super Chargers, CabTilt Mechanisms, Air Cleaners, Cab Steps, Differentials, Vibration Dampers, Frame Cross Members, Fenders, Fans, Fan Drive, Fuel Tanks, Vacuum Fuel Pumps, Oil Filters, Gasoline Filters, Fuel Filters, Coolant Filters, Breather Filters, Air Filters, Mud Flaps, Quarter Fenders, Differential Gears and Bearings, Bull Gears,Glider Kits, Glove Compartments, Gear Shirt Levers and Knobs, Splash Guards, Passenger Compartment Heaters for Vehicles, Hoods, Horns, Air Horns, Horn Buttons,Idler Shafts, Insect Screens, License Plate Holders, Starting Motors, Mufflers,Oil Coolers, Pogo Sticks, Injection Pumps, Vacuum Pumps, Oil Pumps,		

	Power Divider Assemblies, Power Take-Off Gear Drive Systems, Exhaust Pipes, Connecting Rods, Radiators, Radiator Shutters, Radiator Grills and Ornaments, Radiator Protectors, Steering Assemblies, Steering Wheels, Steering Gears, Truck Seats, Seat Cushions, Seat Belts, Sleeper Compartments, Air Intake Silencers, Silencers, Front Air Suspension Member, Rear Air Suspension Member, Springs, Shock Absorbers, Air Suspension Control Assemblies, Stabilizers, Automotive Transmissions, Automotive Transmission Gears and Pinions, Torque Converters, Tires, Tire Carriers, Pintle Hood Towing Systems, Tractor-Trailer Connectors, Fifth Wheel Trailer Connectors, Tread Plates, Valve Rocker Arm, Valve Lifter, Sun Visors, Wheels and Hubs, Flywheels, Windshields, Windshield Wipers, Windshield Wiper Motors, Windshield Washers, Windshield Defroster Fans, Truck Window Lift Kit
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U.S. Registration No.	4939157	Application Date	04/13/2015
Registration Date	04/19/2016	Foreign Priority Date	NONE
Word Mark	MACK		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 1922/00/00 First Use In Commerce: 1922/00/00 Metal spacer brackets; metal hardware, namely, nuts, studs, screws</p> <p>Class 007. First use: First Use: 1923/01/01 First Use In Commerce: 1923/01/01 Land vehicle parts, namely, hydraulic bottle jacks, cylinder heads for engines, exhaust pipes, fan belt drive kits, composed primarily of fan drive journal brackets being a structural component of fan belt drives, engine bearings, engine seals, o-rings being machine parts for engines, metal retaining rings being structural parts of machines, friction liners in the nature of anti-friction bearings for machines, pistons, piston rings, air cartridge in the nature of air filters for automotive engines; air filters for automobile engines, fuel injectors, fuel water separators, hydraulic pumps, radiators, vacuum pumps, water pumps; exhaust stacks for engines, engine overhaul kits comprising pistons, piston liners, connecting rods, engine bearings and engine seals, fuel injectors; electronic rotating alternators, generators and motor starters; gas coolers, ignition coils, engine fan electric generators; CACs for engines in the nature of charge air coolers; land vehicle parts, namely, parts for air conditioning systems, namely, compressors and condensers; all of the aforementioned goods being used as parts of land vehicles</p> <p>Class 008. First use: First Use: 1922/12/01 First Use In Commerce: 1922/12/01 Knives, namely, pocket knives, folding knives; knives for collectors; multiple function folding pocket tool comprised of a folding knife, screwdriver, and nail file; multiple function key tool comprised of a folding knife, screwdriver, and nail file</p> <p>Class 012. First use: First Use: 1922/00/00 First Use In Commerce: 1922/00/00 Diesel engines for land vehicles</p>		

	<p>Class 014. First use: First Use: 1922/12/01 First Use In Commerce: 1922/12/01 Jewelry, watches, keychains as jewelry;clocks</p> <p>Class 017. First use: First Use: 1962/01/01 First Use In Commerce: 1962/01/01 Connecting hoses for vehicle radiators;connecting hoses for vehicle fuel injectors; rubber hoses for vehicle heaters; land vehicle parts, namely, parts for air conditioning systems, namely, non-metal hoses, non-metal hose fittings</p> <p>Class 021. First use: First Use: 1991/01/01 First Use In Commerce: 1991/01/01 Mugs; beverage glassware; beverage ware; bottle openers and flasks</p> <p>Class 035. First use: First Use: 1939/06/01 First Use In Commerce: 1939/06/01 Vehicle dealership services</p> <p>Class 039. First use: First Use: 1992/01/01 First Use In Commerce: 1992/01/01 Leasing of motor vehicles</p>
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Attachments	86594980#TMSN.png(bytes) H00298NoticeofOpposition.pdf(516535 bytes)
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Signature	/Leigh Ann Lindquist/
Name	Leigh Ann Lindquist
Date	10/11/2017

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

In re Application Serial No.: 87291368
Mark: MACAUTO INNOVATION IN COMFORT

<hr/>		:	:
Mack Trucks, Inc. and Volvo Truck Corporation,	:	:	
	:	:	
Opposers,	:	:	
	:	:	Opposition No.:
v.	:	:	
	:	:	
Macauto Industrial Co., Ltd.,	:	:	
	:	:	
Applicant.	:	:	
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NOTICE OF OPPOSITION

Mack Trucks, Inc., a corporation of Pennsylvania, with an address at 7900 National Service Road, Greensboro, North Carolina 27409, United States, believes that it will be damaged by registration of the mark MACAUTO INNOVATION IN COMFORT shown in Application Serial No. 87291368 and hereby opposes same.

Volvo Truck Corporation, a corporation of Sweden, with an address of SE-405 08 Göteborg SWEDEN, believes that it will be damaged by registration of the mark MACAUTO INNOVATION IN COMFORT shown in Application Serial No. 87291368 and hereby opposes same.

Collectively Mack Trucks, Inc. and Volvo Truck Corporation are herein referred to as "Opposer."

As grounds for the opposition, it is alleged that:

1. Mack Trucks, Inc. (hereinafter "Mack") is now selling, and has for several years sold vehicles, including trucks, and related goods, and offered related services, in the United States.

2. Volvo Truck Corporation (hereafter "Volvo") is now selling, and has for several years sold vehicles, including trucks, and related goods, and offered related services, in the United States.

3. Mack and Volvo are related companies.

4. Opposer, for many years and since long prior to any date of first use upon which Applicant can rely, has adopted and used various trademarks which comprise or include the term MACK, either alone or combined with another word or words, to identify its vehicles and related goods and services.

5. Opposer is the owner of the following United States Principal Register registrations among others, which are valid, subsisting, unrevoked and unexpired. Attached are status copies of these registrations.

Mark	Reg. No.	Goods/Services
MACK	946059	Maintenance, Repair, And Parts Replacement Services For Trucks And Truck-Tractors, in International 37
MACK	946042	Financing Of Purchases Of Trucks And Arranging For Insurance Coverage In Connection With Such Financing, in International Class 36
MACK	1146847	Vehicles and Vehicles Parts and Accessories-Namely, Trucks, Truck-Tractors, Truck Engines, Engine Brakes, Engine Preheaters, Engine Supports, Accelerators, Axle Carriers, Front Axle Assemblies, Front Drive Axles, Rear Axle Assemblies, V-Belts, Main Bearings, Brakes, Hand Brakes, Brake Controls, Air Brakes, Air Brake Coils, Brake Shoes, Air Brake Diaphragms, Brake Linings, Hydraulic Brake Master Cylinders, Tow Eye Bumpers, Truck Bumpers, Running Boards, Clutches, Clutch Assemblies, Crank Shafts, Super Chargers, Cab Tilt Mechanisms, Air Cleaners, Cab Steps, Differentials, Vibration Dampers, Frame Cross Members, Fenders, Fans, Fan Drive, Fuel Tanks, Vacuum Fuel

Mark	Reg. No.	Goods/Services
		<p>Pumps, Oil Filters, Gasoline Filters, Fuel Filters, Coolant Filters, Breather Filters, Air Filters, Mud Flaps, Quarter Fenders, Differential Gears and Bearings, Bull Gears, Glider Kits, Glove Compartments, Gear Shift Levers and Knobs, Splash Guards, Passenger Compartment Heaters for Vehicles, Hoods, Horns, Air Horns, Horn Buttons, Idler Shafts, Insect Screens, License Plate Holders, Starting Motors, Mufflers, Oil Coolers, Pogo Sticks, Injection Pumps, Vacuum Pumps, Oil Pumps, Power Divider Assemblies, Power Take-Off Gear Drive Systems, Exhaust Pipes, Connecting Rods, Radiators, Radiator Shutters, Radiator Grills and Ornaments, Radiator Protectors, Steering Assemblies, Steering Wheels, Steering Gears, Truck Seats, Seat Cushions, Seat Belts, Sleeper Compartments, Air Intake Silencers, Silencers, Front Air Suspension Member, Rear Air Suspension Member, Springs, Shock Absorbers, Air Suspension Control Assemblies, Stabilizers, Automotive Transmissions, Automotive Transmission Gears and Pinions, Torque Converters, Tires, Tire Carriers, Pintle Hood Towing Systems, Tractor-Trailer Connectors, Fifth Wheel Trailer Connectors, Tread Plates, Valve Rocker Arm, Valve Lifter, Sun Visors, Wheels and Hubs, Fly Wheels, Windshields, Windshield Wipers. Windshield Wiper Motors, Windshield Washers, Windshield Defroster Fans, Truck Window Lift Kit, in International Class 12</p>
MACK	4939157	<p>Land vehicle parts, namely, hydraulic bottle jacks, cylinder heads for engines, exhaust pipes, fan belt drive kits, composed primarily of fan drive journal brackets being a structural component of fan belt drives, engine bearings, engine seals, o-rings being machine parts for engines, metal retaining rings being structural parts of machines, friction liners in the nature of anti-friction bearings for machines, pistons, piston rings, air cartridge in the nature of air filters for automotive engines; air filters for automobile engines, fuel injectors, fuelwater separators, hydraulic pumps, radiators, vacuum pumps, water pumps; exhaust stacks for engines, engine overhaul kits comprising pistons, piston liners, connecting rods, engine bearings and engine seals, fuel injectors; electronic rotating alternators, generators and motor starters; gas coolers, ignition coils, engine fan electric generators; CACs for engines in the nature of charge air coolers; land vehicle parts, namely, parts for air conditioning systems, namely, compressors and condensers; all of the aforementioned goods being used as parts of land vehicles, in International Class 7</p> <p style="text-align: center;">Among other goods and services</p>

These registrations and the common law use of the MACK mark are hereinafter collectively referred to as "the MACK mark."

6. Mack has also used the trade name MACK TRUCKS for many years and prior to May 23, 2016.

7. As a result of Opposer's long and extensive use and promotion of its MACK mark for vehicles and related goods and services, the term MACK, used both by itself and together with other words or a design, has become renowned, well known and famous designation for vehicles and related goods and services, indicating products and services that exclusively originate with and are exclusively associated with Opposer.

8. Opposer's MACK mark became famous prior to Applicant's filing date and prior to Applicant's claimed first use date.

9. In addition, as a result of Mack's long and extensive use and promotion of its MACK TRUCKS trade name, the MACK TRUCKS trade name has become a renowned, well known and famous trade name used in connection for vehicles and related goods and services, indicating products and services that exclusively originate with and are exclusively associated with Mack.

10. Applicant has applied to register the mark MACAUTO INNOVATION IN COMFORT for goods in Class 12 described as "Automobile sunroofs; Automobile windshield sunshades; Luggage nets for vehicles; Motorized golf carts; Motorized golf trolleys; Powered wheel barrows; Sun blinds adapted for automobiles; Automotive windshield shade screens; Car window shades." The application was filed on January 6, 2017, based on a claim of use in commerce of May 23, 2016 and claimed first use date of May 23, 2016. The application was published for opposition on June 13, 2017. Opposer timely filed and obtained an extension of

time to oppose the application, with the extension of time to oppose expiring on October 11, 2017.

11. Applicant was on constructive notice of Opposer's MACK federal trademark registrations at the time Applicant filed its application to register MACAUTO INNOVATION IN COMFORT as a trademark by virtue of Section 22 of The Lanham Act, 15 U.S.C. §1072.

12. The goods in Class 12 in the opposed application are identical and related to Opposer's goods and services sold under its famous MACK mark, and to the goods and services offered under Mack's MACK TRUCKS trade name. Applicant's goods would be likely to be thought to have emanated from the same source as Opposer's and Mack's goods and services, or to have been approved, endorsed or sponsored by Opposer and Mack, or to be related to Opposer's and Mack's goods and services.

13. The trademark in the opposed application, as applied to the Class 12 goods set forth in that application, is confusingly and deceptively similar to Opposer's previously used and registered MACK mark and Mack's previously used MACK TRUCKS trade name.

14. Opposer believes and therefore alleges that the use and registration of the alleged trademark MACAUTO INNOVATION IN COMFORT by Applicant will damage Opposer, for the reasons, among others:

a. That purchasers and persons in the trade will be deceived as to the source and origin of Applicant's goods sold and offered under the MACAUTO INNOVATION IN COMFORT mark; and

b. Purchasers, persons in the trade and others will assume, contrary to fact, that Applicant's goods are associated with, approved by, sponsored by or otherwise related to Opposer.

15. Registration of the mark sought by Applicant herein is barred by the provisions of Section 2(d) of the Trademark Act of 1946 for the reason that it consists of or comprises a mark which so resembles Opposer's previously used and registered trademark, and Mack's previously used trade name as to be likely, when applied to the goods of Applicant, to cause confusion, mistake or deception.

16. Registration of the mark sought by Applicant herein is barred by the provisions of The Trademark Act of 1946, as amended, for the reason that it consists of a mark which is so similar to Opposer's previously used, registered and famous mark, as to dilute the distinctive quality of Opposer's mark within the meaning of Section 43(c) of The Lanham Act.

WHEREFORE, Opposer respectfully prays that the registration sought by Applicant be refused and that this Opposition be sustained.

Respectfully submitted,

MACK TRUCKS, INC. and
VOLVO TRUCK CORPORATION



By:

Gary D. Krugman
Leigh Ann Lindquist
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3202
(202) 663-7484
Attorneys for Opposer

Date: October 11, 2017

Enclosures: TARR Status Printouts

Generated on: This page was generated by TSDR on 2017-10-11 10:34:29 EDT

Mark: MACK

US Serial Number: 72413158

Application Filing Date: Jan. 19, 1972

US Registration Number: 946059

Registration Date: Oct. 24, 1972

Register: Principal

Mark Type: Service Mark

Status: The registration has been renewed.

Status Date: Oct. 02, 2012

Mark Information

Mark Literal Elements: MACK

Standard Character Claim: No

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

Related Properties Information

Claimed Ownership of US Registrations: 0138761, 0881932 and others

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 incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: MAINTENANCE, REPAIR, AND PARTS REPLACEMENT SERVICES FOR TRUCKS AND TRUCK-TRACTORS

International Class(es): 037

U.S Class(es): 103 - Primary Class

Class Status: ACTIVE

Basis: 1(a)

First Use: 1911

Use in Commerce: 1911

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: MACK TRUCKS, INC.

Owner Address: 7900 National Service Road
Greensboro, NORTH CAROLINA 27409
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: GARY D. KRUGMAN

Docket Number: M8293

Attorney Primary Email Address: tm@sughrue.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: GARY D. KRUGMAN
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DISTRICT OF COLUMBIA 20037
UNITED STATES

Phone: 202.293.7060

Fax: 202.293.7860

Correspondent e-mail: tm@sughrue.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Oct. 02, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Oct. 02, 2012	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	64591
Oct. 02, 2012	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	64591
Oct. 01, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	64591
Sep. 21, 2012	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Sep. 21, 2012	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Sep. 21, 2012	TEAS SECTION 8 & 9 RECEIVED	
Sep. 03, 2008	CASE FILE IN TICRS	
Feb. 08, 2003	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	
Feb. 08, 2003	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Oct. 24, 2002	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Oct. 24, 2002	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Oct. 24, 2002	PAPER RECEIVED	
Mar. 02, 1993	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jan. 13, 1993	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Feb. 27, 1979	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Oct. 24, 2012

TM Staff and Location Information

TM Staff Information - None
File Location

Assignment Abstract Of Title Information

Summary

Total Assignments: 3

Registrant: MACK TRUCKS, INC.

Assignment 1 of 3

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Reel/Frame: [0264/0464](#)

Pages: 4

Date Recorded: Mar. 17, 1975

Supporting Documents: No Supporting Documents Available

Assignor

Name: [MACK TRUCKS, INC.](#)

Execution Date: Mar. 07, 1975

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: [MACK TRUCKS, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Address: 2100 MACK BLVD.
ALLENTOWN, PENNSYLVANIA 18105

Correspondent

Correspondent Name: DONALD W. CANADY

Correspondent Address: 9665 WILSHIRE BLVD.
BEVERLY HILLS, CA 90212

Domestic Representative - Not Found

Assignment 2 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: [0712/0721](#)

Pages: 0

Date Recorded: Apr. 27, 1990

Supporting Documents: No Supporting Documents Available

Assignor

Name: [MACK TRUCKS, INC.](#)

Execution Date: Apr. 27, 1990

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Assignee

Name: [CITIBANK, N.A.](#)

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Address: 399 PARK AVENUE
NEW YORK, NEW YORK 10043

Correspondent

Correspondent Name: CATHERINE H. STOCKELL

Correspondent Address: PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2711

Domestic Representative - Not Found

Assignment 3 of 3

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [0800/0427](#)

Pages: 12

Date Recorded: Jul. 10, 1991

Supporting Documents: No Supporting Documents Available

Documents:**Assignor**

Name: [CITIBANK N.A.](#)
Legal Entity Type: A NATIONAL BANKING ASSOCIATION

Execution Date: Jun. 28, 1991
State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [MACK TRUCKS, INC.](#)
Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Address: 2100 MACK BLVD.
 ALLENTOWN, PENNSYLVANIA 18103

Correspondent

Correspondent Name: PENNIE & EDMONDS

Correspondent Address: 1155 AVENUE OF THE AMERICAS
 NEW YORK, NY 10036-2711

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 6

Type of Proceeding: Opposition

Proceeding Number: [91230185](#)

Filing Date: Sep 21, 2016

Status: Pending

Status Date: Sep 21, 2016

Interlocutory Attorney: ELIZABETH WINTER

Defendant

Name: Jerry L. Mack dba Mack Transportation Service, LLC

Correspondent Address: MICHAEL D STEWART
 200 SE 1ST ST SUITE 701
 MIAMI FL , 33131
 UNITED STATES

Correspondent e-mail: ms@themiamilaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK TRANSPORTATION SERVICE	Opposition Pending	86854384	

Plaintiff(s)

Name: Mack Trucks, Inc. and Volvo Truck Corporation

Correspondent Address: LEIGH ANN LINDQUIST
 SUGHRUE MION PLLC
 2100 PENNSYLVANIA AVENUE NW
 WASHINGTON DC , 20037
 UNITED STATES

Correspondent e-mail: tm@sughrue.com , vmullineaux@sughrue.com , llindquist@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Registered	86594980	4939157
MACK	Renewed	72413158	946059
MACK	Renewed	73196165	1146847
MACK PUREBRED OVERHAUL	Registered	85592491	4355171

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 21, 2016	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 21, 2016	Oct 31, 2016
3	PENDING, INSTITUTED	Sep 21, 2016	
4	CHANGE OF CORRESP ADDRESS	Sep 21, 2016	
5	D APPEARANCE / POWER OF ATTORNEY	Sep 29, 2016	
6	ANSWER	Oct 04, 2016	
7	ANSWER	Oct 04, 2016	
8	TRIAL DATES REMAIN AS SET	Oct 19, 2016	
9	STIP FOR EXT	May 15, 2017	
10	EXTENSION OF TIME GRANTED	May 15, 2017	
11	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jul 26, 2017	
12	SUSPENDED	Jul 26, 2017	

Type of Proceeding: Opposition

Proceeding Number: [91224108](#) **Filing Date:** Sep 30, 2015
Status: Terminated **Status Date:** Apr 01, 2016
Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: Macauto Industrial Co., Ltd.
Correspondent Address: ALAN D KAMRATH
KAMRATH IP LAW FIRM PA
4825 OLSON MEMORIAL HWY STE 150
GOLDEN VALLEY MN , 55422
UNITED STATES
Correspondent e-mail: alan@thelawfirm.cc

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACAUTO	Abandoned - After Inter-Partes Decision	86501743	

Plaintiff(s)

Name: Mack Trucks, Inc.
Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037-3202
UNITED STATES
Correspondent e-mail: llindquist@sughrue.com , vmullineaux@sughrue.com , tm@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
MACK	Renewed	73196165	1146847

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 30, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 30, 2015	Nov 09, 2015
3	PENDING, INSTITUTED	Sep 30, 2015	
4	ANSWER	Nov 09, 2015	
5	W/DRAW OF APPLICATION	Mar 31, 2016	
6	BD DECISION: SUSTAINED	Apr 01, 2016	
7	TERMINATED	Apr 01, 2016	

Type of Proceeding: Opposition

Proceeding Number: [91214471](#) **Filing Date:** Jan 15, 2014

Number: _____

Status: Terminated

Status Date: Dec 07, 2016

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Mac Truck NYC Corp.

Correspondent Address: NATALIE G FURMAN
PAUL HASTINGS LLP
200 PARK AVENUE
NEW YORK NY , 10022
UNITED STATES

Correspondent e-mail: rls@paulhastings.com, nataliefurman@paulhastings.com, andrewkessel@paulhastings.com, shenadewalker@paulhastings.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MAC TRUCK	Registered	85895021	5116755

Plaintiff(s)

Name: Mack Trucks Inc.

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVE NW
WASHINGTON DC , 20037-3202
UNITED STATES

Correspondent e-mail: lindquist@sughrue.com , vmullineaux@sughrue.com , tm@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72199376	811932
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
MACK	Renewed	73359793	1236523
MACK TRUCKS	Renewed	73384112	1274413
MACK	Renewed	74639432	1941342
MACK	Renewed	74720114	2067827
MACK	Renewed	75319596	2171377
MACK	Renewed	75571846	2517896
MACK	Renewed	78376868	3110122
MACK	Section 8 and 15 - Accepted and Acknowledged	78870269	3438136
MACK	Registered	85474486	4325280
MACK	Section 8 and 15 - Accepted and Acknowledged	78376865	3308148
MACK	Renewed	73196165	1146847
MACK	Renewed	72199374	811931
MACK	Cancelled - Section 8	73388942	1278862

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 15, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 15, 2014	Feb 24, 2014
3	PENDING, INSTITUTED	Jan 15, 2014	
4	D APPEARANCE / POWER OF ATTORNEY	Jan 17, 2014	
5	D MOT FOR EXT W/ CONSENT	Feb 18, 2014	
6	EXTENSION OF TIME GRANTED	Feb 18, 2014	
7	D MOT FOR EXT W/ CONSENT	Mar 25, 2014	
8	EXTENSION OF TIME GRANTED	Mar 26, 2014	
9	D MOT FOR EXT W/ CONSENT	Apr 25, 2014	
10	EXTENSION OF TIME GRANTED	Apr 25, 2014	

11	D MOT FOR EXT W/ CONSENT	May 27, 2014	
12	EXTENSION OF TIME GRANTED	May 27, 2014	
13	D MOT FOR EXT W/ CONSENT	Jun 24, 2014	
14	EXTENSION OF TIME GRANTED	Jun 24, 2014	
15	D MOT FOR EXT W/ CONSENT	Jul 24, 2014	
16	EXTENSION OF TIME GRANTED	Jul 24, 2014	
17	D MOT FOR EXT W/ CONSENT	Sep 19, 2014	
18	EXTENSION OF TIME GRANTED	Sep 19, 2014	
19	D MOT FOR EXT W/ CONSENT	Nov 21, 2014	
20	EXTENSION OF TIME GRANTED	Nov 21, 2014	
21	D MOT FOR EXT W/ CONSENT	Jan 20, 2015	
22	EXTENSION OF TIME GRANTED	Feb 03, 2015	
23	D MOT FOR EXT W/ CONSENT	Feb 19, 2015	
24	EXTENSION OF TIME GRANTED	Mar 17, 2015	
25	D MOT FOR EXT W/ CONSENT	Apr 20, 2015	
26	RESPONSE DUE 30 DAYS (DUE DATE)	May 06, 2015	Jun 05, 2015
27	D OPP/RESP TO MOTION	Jun 05, 2015	
28	EXTENSION OF TIME GRANTED	Jun 09, 2015	
29	ANSWER	Jan 06, 2016	
30	CHANGE OF CORRESP ADDRESS	May 09, 2016	
31	D MOT FOR EXT W/ CONSENT	Jul 11, 2016	
32	EXTENSION OF TIME DENIED	Jul 19, 2016	
33	CHANGE OF CORRESP ADDRESS	Aug 03, 2016	
34	P MOT FOR EXT W/O CONSENT	Aug 03, 2016	
35	D MOT FOR EXT W/ CONSENT	Aug 05, 2016	
36	EXTENSION OF TIME GRANTED	Aug 22, 2016	
37	W/DRAW OF OPPOSITION	Dec 01, 2016	
38	BD DECISION: DISMISSED W/ PREJ	Dec 07, 2016	
39	TERMINATED	Dec 07, 2016	

Type of Proceeding: Opposition

Proceeding Number: [91204496](#)

Filing Date: Mar 28, 2012

Status: Terminated

Status Date: Dec 31, 2012

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Olde Granddad Industries, Inc.

Correspondent Address: ERNEST D BUFF
ERNEST D BUFF & ASSOCIATES LLC
231 SOMERVILLE RD
BEDMINSTER NJ , 07921-2615
UNITED STATES

Correspondent e-mail: EBuff@EDBuff.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Abandoned - After Inter-Partes Decision	76707166	

Plaintiff(s)

Name: Mack Trucks, Inc.

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037
UNITED STATES

Correspondent e-mail: llindquist@sughrue.com , mwhite@sughrue.com , sherrera-gill@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72199374	811931
MACK	Renewed	72199376	811932
MACK	Renewed	72269825	841376
MACK	Cancelled - Section 8	72413050	945459
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
BUILT LIKE A MACK TRUCK	Renewed	73036913	1033076
MACK	Renewed	73045152	1046406
MACK	Renewed	73196165	1146847
MACK	Renewed	73359793	1236523
MACK TRUCKS	Renewed	73384112	1274413
MACK TRUCKS	Renewed	73388938	1258633
MACK	Cancelled - Section 8	73388942	1278862
MACK	Renewed	73739029	1524119
MACK	Cancelled - Section 8	73196167	1174799

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 28, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 29, 2012	May 08, 2012
3	PENDING, INSTITUTED	Mar 29, 2012	
4	ANSWER	May 09, 2012	
5	P'S MOTION TO COMPEL DISCOVERY	Nov 05, 2012	
6	WITHDRAWAL OF APPLICATION	Nov 16, 2012	
7	BOARD'S DECISION: SUSTAINED	Dec 31, 2012	
8	TERMINATED	Dec 31, 2012	

Type of Proceeding: Opposition

Proceeding Number: [91199401](#)

Filing Date: Apr 11, 2011

Status: Terminated

Status Date: Apr 18, 2013

Interlocutory Attorney: YONG OH (RICHARD) KIM

Defendant

Name: Caterpillar Motoren GmbH & Co. KG

Correspondent Address: JONATHAN M GELCHINSKY
FINNEGAN HENDERSON FARABOW GARRETT ET AL
901 NEW YORK AVENUE NW
WASHINGTON DC , 20001
UNITED STATES

Correspondent e-mail: docketing@finnegan.com , jon.gelchinsky@finnegan.com , Cambridge-TTAB-Notifications@finnegan.com , Boston-TTAB-Notifications@finnegan.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MAK	Registered	79083363	4340366

Plaintiff(s)

Name: Mack Trucks, Inc.

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037
UNITED STATES

Correspondent e-mail: Lindquist@sughrue.com

Associated marks

Serial	Registration
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Mark	Application Status	Number	Number
MACK	Renewed	72199376	811932
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
MACK	Cancelled - Section 8	73196167	1174799
MACK	Renewed	73196165	1146847
MACK	Renewed	72199374	811931
MACK	Renewed	72269825	841376
MACK	Cancelled - Section 8	72413050	945459
MACK	Cancelled - Section 8	73388942	1278862
MACK	Renewed	73739029	1524119
MACK CENTRAL	Cancelled - Section 8	74242314	1806425

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 11, 2011	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 13, 2011	May 23, 2011
3	PENDING, INSTITUTED	Apr 13, 2011	
4	STIPULATION FOR AN EXTENSION OF TIME	May 12, 2011	
5	EXTENSION OF TIME GRANTED	May 12, 2011	
6	STIPULATION FOR AN EXTENSION OF TIME	Jun 14, 2011	
7	EXTENSION OF TIME GRANTED	Jun 14, 2011	
8	STIPULATION FOR AN EXTENSION OF TIME	Aug 15, 2011	
9	EXTENSION OF TIME GRANTED	Aug 16, 2011	
10	STIPULATION FOR AN EXTENSION OF TIME	Nov 17, 2011	
11	EXTENSION OF TIME GRANTED	Nov 17, 2011	
12	STIPULATION FOR AN EXTENSION OF TIME	Jan 13, 2012	
13	EXTENSION OF TIME GRANTED	Jan 13, 2012	
14	STIPULATION FOR AN EXTENSION OF TIME	Mar 12, 2012	
15	EXTENSION OF TIME GRANTED	Mar 12, 2012	
16	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Apr 10, 2012	
17	SUSPENDED	Apr 10, 2012	
18	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Jun 12, 2012	
19	SUSPENDED	Jun 12, 2012	
20	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Jul 10, 2012	
21	SUSPENDED	Jul 10, 2012	
22	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Sep 05, 2012	
23	SUSPENDED	Sep 05, 2012	
24	STIP AMDT TO APP AND WITHDRAWAL OF OP	Oct 23, 2012	
25	DEF'S CERTIFICATE OF SERVICE	Oct 23, 2012	
26	BD DECISION: DISMISSED W/ PREJ	Apr 18, 2013	
27	TERMINATED	Apr 18, 2013	

Type of Proceeding: Cancellation

Proceeding Number: [92053871](#)

Filing Date: Apr 11, 2011

Status: Terminated

Status Date: Jul 28, 2011

Interlocutory Attorney: MARY CATHERINE FAINT

Defendant

Name: MAK, S.r.l.

Correspondent Address: MAK SRL
85 VIA MANDOLOSSA, I 25064
GUSSAGO ITALY

Associated marks

Mark	Application Status	Serial Number	Registration Number
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Plaintiff(s)**Name:** Mack Trucks, Inc.**Correspondent Address:** LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037-3202
UNITED STATES**Correspondent e-mail:** llindquist@sughrue.com , gkrugman@sughrue.com , mwhite@sughrue.com**Associated marks**

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72199376	811932
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
MACK	Cancelled - Section 8	73196167	1174799
MACK	Renewed	73196165	1146847
MACK	Renewed	72199374	811931
MACK	Renewed	72269825	841376
MACK	Cancelled - Section 8	72413050	945459
MACK	Cancelled - Section 8	73388942	1278862
MACK	Renewed	73739029	1524119
MACK CENTRAL	Cancelled - Section 8	74242314	1806425

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 11, 2011	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 11, 2011	May 21, 2011
3	PENDING, INSTITUTED	Apr 11, 2011	
4	NOTICE OF DEFAULT	Jun 06, 2011	
5	BOARD'S DECISION: GRANTED	Jul 21, 2011	
6	COMMR'S ORDER CANCELLING REGISTRATION	Jul 27, 2011	
7	TERMINATED	Jul 28, 2011	

Generated on: This page was generated by TSDR on 2017-10-11 10:35:53 EDT

Mark: MACK

US Serial Number: 72417882

Application Filing Date: Mar. 09, 1972

US Registration Number: 946042

Registration Date: Oct. 24, 1972

Register: Principal

Mark Type: Service Mark

Status: The registration has been renewed.

Status Date: Oct. 25, 2012

Mark Information

Mark Literal Elements: MACK

Standard Character Claim: No

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

Related Properties Information

Claimed Ownership of US Registrations: 0138761, 0841376 and others

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 incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: FINANCING OF PURCHASES OF TRUCKS AND ARRANGING FOR INSURANCE COVERAGE IN CONNECTION WITH SUCH FINANCING

International Class(es): 036

U.S Class(es): 102 - Primary Class

Class Status: ACTIVE

Basis: 1(a)

First Use: 1924

Use in Commerce: 1924

Basis Information (Case Level)

Filed Use: Yes
 Filed ITU: No
 Filed 44D: No
 Filed 44E: No
 Filed 66A: No

Currently Use: Yes
 Currently ITU: No
 Currently 44D: No
 Currently 44E: No
 Currently 66A: No

Amended Use: No
 Amended ITU: No
 Amended 44D: No
 Amended 44E: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: MACK TRUCKS, INC.

Owner Address: 7900 National Service Road
Greensboro, NORTH CAROLINA 27409
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: GARY D. KRUGMAN

Docket Number: M8292

Attorney Primary Email Address: tm@sughrue.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: GARY D. KRUGMAN
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DISTRICT OF COLUMBIA 20037
UNITED STATES

Phone: 202.293.7060

Fax: 202.293.7860

Correspondent e-mail: tm@sughrue.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Oct. 25, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Oct. 25, 2012	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	71378
Oct. 25, 2012	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	71378
Sep. 20, 2012	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Sep. 30, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	71378
Sep. 20, 2012	TEAS SECTION 8 & 9 RECEIVED	
Sep. 20, 2012	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Sep. 20, 2012	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Aug. 28, 2008	CASE FILE IN TICRS	
Feb. 08, 2003	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	
Feb. 08, 2003	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Oct. 24, 2002	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Oct. 24, 2002	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Oct. 24, 2002	PAPER RECEIVED	
Feb. 25, 1993	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jan. 13, 1993	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Feb. 27, 1979	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Oct. 24, 2012

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Oct. 25, 2012

Assignment Abstract Of Title Information

Summary

Total Assignments: 3

Registrant: MACK TRUCKS, INC.

Assignment 1 of 3

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Reel/Frame: [0264/0464](#)

Pages: 4

Date Recorded: Mar. 17, 1975

Supporting Documents: No Supporting Documents Available

Assignor

Name: [MACK TRUCKS, INC.](#)

Execution Date: Mar. 07, 1975

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: [MACK TRUCKS, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Address: 2100 MACK BLVD.
ALLENTOWN, PENNSYLVANIA 18105

Correspondent

Correspondent Name: DONALD W. CANADY

Correspondent Address: 9665 WILSHIRE BLVD.
BEVERLY HILLS, CA 90212

Domestic Representative - Not Found

Assignment 2 of 3

Conveyance: SECURITY INTEREST

Reel/Frame: [0712/0721](#)

Pages: 0

Date Recorded: Apr. 27, 1990

Supporting Documents: No Supporting Documents Available

Assignor

Name: [MACK TRUCKS, INC.](#)

Execution Date: Apr. 27, 1990

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Assignee

Name: [CITIBANK, N.A.](#)

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Address: 399 PARK AVENUE
NEW YORK, NEW YORK 10043

Correspondent

Correspondent Name: CATHERINE H. STOCKELL

Correspondent Address: PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2711

Domestic Representative - Not Found

Assignment 3 of 3

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [0800/0427](#)

Pages: 12

Date Recorded: Jul. 10, 1991

Supporting Documents: No Supporting Documents Available

Assignor

Name: [CITIBANK N.A.](#)

Execution Date: Jun. 28, 1991

Legal Entity Type: A NATIONAL BANKING ASSOCIATION

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [MACK TRUCKS, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Address: 2100 MACK BLVD.
ALLENTOWN, PENNSYLVANIA 18103

Correspondent

Correspondent Name: PENNIE & EDMONDS

Correspondent Address: 1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2711

Domestic Representative - Not Found

Proceedings

Summary

Number of Proceedings: 5

Type of Proceeding: Opposition

Proceeding Number: [91224108](#)

Filing Date: Sep 30, 2015

Status: Terminated

Status Date: Apr 01, 2016

Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: Macauto Industrial Co., Ltd.

Correspondent Address: ALAN D KAMRATH
KAMRATH IP LAW FIRM PA
4825 OLSON MEMORIAL HWY STE 150
GOLDEN VALLEY MN , 55422
UNITED STATES

Correspondent e-mail: alan@thelawfirm.cc

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACAUTO	Abandoned - After Inter-Partes Decision	86501743	

Plaintiff(s)

Name: Mack Trucks, Inc.

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037-3202
UNITED STATES

Correspondent e-mail: llindquist@sughrue.com , vmullineaux@sughrue.com , tm@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
MACK	Renewed	73196165	1146847

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 30, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 30, 2015	Nov 09, 2015
3	PENDING, INSTITUTED	Sep 30, 2015	
4	ANSWER	Nov 09, 2015	
5	W/DRAW OF APPLICATION	Mar 31, 2016	
6	BD DECISION: SUSTAINED	Apr 01, 2016	
7	TERMINATED	Apr 01, 2016	

Type of Proceeding: Opposition

Proceeding Number: [91214471](#)

Filing Date: Jan 15, 2014

Status: Terminated

Status Date: Dec 07, 2016

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Mac Truck NYC Corp.

Correspondent Address: NATALIE G FURMAN
PAUL HASTINGS LLP
200 PARK AVENUE
NEW YORK NY , 10022
UNITED STATES

Correspondent e-mail: rls@paulhastings.com, nataliefurman@paulhastings.com, andrewkessel@paulhastings.com, shenadewalker@paulhastings.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MAC TRUCK	Registered	85895021	5116755

Plaintiff(s)

Name: Mack Trucks Inc.

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVE NW
WASHINGTON DC , 20037-3202
UNITED STATES

Correspondent e-mail: llindquist@sughrue.com , vmullineaux@sughrue.com , tm@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72199376	811932
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
MACK	Renewed	73359793	1236523
MACK TRUCKS	Renewed	73384112	1274413
MACK	Renewed	74639432	1941342
MACK	Renewed	74720114	2067827
MACK	Renewed	75319596	2171377
MACK	Renewed	75571846	2517896
MACK	Renewed	78376868	3110122
MACK	Section 8 and 15 - Accepted and Acknowledged	78870269	3438136
MACK	Registered	85474486	4325280
MACK	Section 8 and 15 - Accepted and Acknowledged	78376865	3308148
MACK	Renewed	73196165	1146847
MACK	Renewed	72199374	811931
MACK	Cancelled - Section 8	73388942	1278862

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 15, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 15, 2014	Feb 24, 2014
3	PENDING, INSTITUTED	Jan 15, 2014	
4	D APPEARANCE / POWER OF ATTORNEY	Jan 17, 2014	
5	D MOT FOR EXT W/ CONSENT	Feb 18, 2014	
6	EXTENSION OF TIME GRANTED	Feb 18, 2014	
7	D MOT FOR EXT W/ CONSENT	Mar 25, 2014	
8	EXTENSION OF TIME GRANTED	Mar 26, 2014	
9	D MOT FOR EXT W/ CONSENT	Apr 25, 2014	
10	EXTENSION OF TIME GRANTED	Apr 25, 2014	
11	D MOT FOR EXT W/ CONSENT	May 27, 2014	
12	EXTENSION OF TIME GRANTED	May 27, 2014	
13	D MOT FOR EXT W/ CONSENT	Jun 24, 2014	
14	EXTENSION OF TIME GRANTED	Jun 24, 2014	
15	D MOT FOR EXT W/ CONSENT	Jul 24, 2014	
16	EXTENSION OF TIME GRANTED	Jul 24, 2014	
17	D MOT FOR EXT W/ CONSENT	Sep 19, 2014	
18	EXTENSION OF TIME GRANTED	Sep 19, 2014	
19	D MOT FOR EXT W/ CONSENT	Nov 21, 2014	
20	EXTENSION OF TIME GRANTED	Nov 21, 2014	
21	D MOT FOR EXT W/ CONSENT	Jan 20, 2015	
22	EXTENSION OF TIME GRANTED	Feb 03, 2015	
23	D MOT FOR EXT W/ CONSENT	Feb 19, 2015	
24	EXTENSION OF TIME GRANTED	Mar 17, 2015	
25	D MOT FOR EXT W/ CONSENT	Apr 20, 2015	
26	RESPONSE DUE 30 DAYS (DUE DATE)	May 06, 2015	Jun 05, 2015
27	D OPP/RESP TO MOTION	Jun 05, 2015	
28	EXTENSION OF TIME GRANTED	Jun 09, 2015	
29	ANSWER	Jan 06, 2016	
30	CHANGE OF CORRESP ADDRESS	May 09, 2016	
31	D MOT FOR EXT W/ CONSENT	Jul 11, 2016	
32	EXTENSION OF TIME DENIED	Jul 19, 2016	
33	CHANGE OF CORRESP ADDRESS	Aug 03, 2016	
34	P MOT FOR EXT W/O CONSENT	Aug 03, 2016	
35	D MOT FOR EXT W/ CONSENT	Aug 05, 2016	
36	EXTENSION OF TIME GRANTED	Aug 22, 2016	
37	W/DRAW OF OPPOSITION	Dec 01, 2016	
38	BD DECISION: DISMISSED W/ PREJ	Dec 07, 2016	
39	TERMINATED	Dec 07, 2016	

Type of Proceeding: Opposition

Proceeding Number: [91204496](#)

Filing Date: Mar 28, 2012

Status: Terminated

Status Date: Dec 31, 2012

Interlocutory Attorney: ELIZABETH A DUNN

Defendant

Name: Olde Granddad Industries, Inc.

Correspondent Address: ERNEST D BUFF
ERNEST D BUFF & ASSOCIATES LLC
231 SOMERVILLE RD
BEDMINSTER NJ , 07921-2615
UNITED STATES

Correspondent e-mail: EBuff@EDBuff.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Abandoned - After Inter-Partes Decision	76707166	

Plaintiff(s)

Name: Mack Trucks, Inc.

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037
UNITED STATES

Correspondent e-mail: lindquist@sughrue.com , mwhite@sughrue.com , sherrera-gill@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72199374	811931
MACK	Renewed	72199376	811932
MACK	Renewed	72269825	841376
MACK	Cancelled - Section 8	72413050	945459
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
BUILT LIKE A MACK TRUCK	Renewed	73036913	1033076
MACK	Renewed	73045152	1046406
MACK	Renewed	73196165	1146847
MACK	Renewed	73359793	1236523
MACK TRUCKS	Renewed	73384112	1274413
MACK TRUCKS	Renewed	73388938	1258633
MACK	Cancelled - Section 8	73388942	1278862
MACK	Renewed	73739029	1524119
MACK	Cancelled - Section 8	73196167	1174799

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 28, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 29, 2012	May 08, 2012
3	PENDING, INSTITUTED	Mar 29, 2012	
4	ANSWER	May 09, 2012	
5	P'S MOTION TO COMPEL DISCOVERY	Nov 05, 2012	
6	WITHDRAWAL OF APPLICATION	Nov 16, 2012	
7	BOARD'S DECISION: SUSTAINED	Dec 31, 2012	
8	TERMINATED	Dec 31, 2012	

Type of Proceeding: Opposition

Proceeding Number: [91199401](#)

Filing Date: Apr 11, 2011

Status: Terminated

Status Date: Apr 18, 2013

Interlocutory Attorney: YONG OH (RICHARD) KIM

Defendant

Name: Caterpillar Motoren GmbH & Co. KG

Correspondent Address: JONATHAN M GELCHINSKY
FINNEGAN HENDERSON FARABOW GARRETT ET AL
901 NEW YORK AVENUE NW
WASHINGTON DC , 20001
UNITED STATES

Correspondent e-mail: docketing@finnegan.com , jon.gelchinsky@finnegan.com , Cambridge-TTAB-Notifications@finnegan.com , Boston-TTAB-Notifications@finnegan.com

Associated marks

Mark	Application Status	Serial Number	Registration
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MAK	Registered	79083363	Number 4340366
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Plaintiff(s)

Name: Mack Trucks, Inc.

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037
UNITED STATES

Correspondent e-mail: Lindquist@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72199376	811932
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
MACK	Cancelled - Section 8	73196167	1174799
MACK	Renewed	73196165	1146847
MACK	Renewed	72199374	811931
MACK	Renewed	72269825	841376
MACK	Cancelled - Section 8	72413050	945459
MACK	Cancelled - Section 8	73388942	1278862
MACK	Renewed	73739029	1524119
MACK CENTRAL	Cancelled - Section 8	74242314	1806425

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 11, 2011	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 13, 2011	May 23, 2011
3	PENDING, INSTITUTED	Apr 13, 2011	
4	STIPULATION FOR AN EXTENSION OF TIME	May 12, 2011	
5	EXTENSION OF TIME GRANTED	May 12, 2011	
6	STIPULATION FOR AN EXTENSION OF TIME	Jun 14, 2011	
7	EXTENSION OF TIME GRANTED	Jun 14, 2011	
8	STIPULATION FOR AN EXTENSION OF TIME	Aug 15, 2011	
9	EXTENSION OF TIME GRANTED	Aug 16, 2011	
10	STIPULATION FOR AN EXTENSION OF TIME	Nov 17, 2011	
11	EXTENSION OF TIME GRANTED	Nov 17, 2011	
12	STIPULATION FOR AN EXTENSION OF TIME	Jan 13, 2012	
13	EXTENSION OF TIME GRANTED	Jan 13, 2012	
14	STIPULATION FOR AN EXTENSION OF TIME	Mar 12, 2012	
15	EXTENSION OF TIME GRANTED	Mar 12, 2012	
16	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Apr 10, 2012	
17	SUSPENDED	Apr 10, 2012	
18	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Jun 12, 2012	
19	SUSPENDED	Jun 12, 2012	
20	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Jul 10, 2012	
21	SUSPENDED	Jul 10, 2012	
22	STIP TO SUSPEND PEND SETTLEMENT NEGOTNS	Sep 05, 2012	
23	SUSPENDED	Sep 05, 2012	
24	STIP AMDT TO APP AND WITHDRAWAL OF OP	Oct 23, 2012	
25	DEF'S CERTIFICATE OF SERVICE	Oct 23, 2012	
26	BD DECISION: DISMISSED W/ PREJ	Apr 18, 2013	
27	TERMINATED	Apr 18, 2013	

Type of Proceeding: Cancellation

Number: _____

Status: Terminated

Status Date: Jul 28, 2011

Interlocutory Attorney: MARY CATHERINE FAINT

Defendant

Name: MAK, S.r.l.

Correspondent Address: MAK SRL
85 VIA MANDOLOSSA, I 25064
GUSSAGO ITALY

Associated marks

Mark	Application Status	Serial Number	Registration Number
MAK	Cancelled - Section 18	79010226	3112204

Plaintiff(s)

Name: Mack Trucks, Inc.

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037-3202
UNITED STATES

Correspondent e-mail: llindquist@sughrue.com , gkrugman@sughrue.com , mwhite@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Renewed	72199376	811932
MACK	Renewed	72413158	946059
MACK	Renewed	72417882	946042
MACK	Cancelled - Section 8	73196167	1174799
MACK	Renewed	73196165	1146847
MACK	Renewed	72199374	811931
MACK	Renewed	72269825	841376
MACK	Cancelled - Section 8	72413050	945459
MACK	Cancelled - Section 8	73388942	1278862
MACK	Renewed	73739029	1524119
MACK CENTRAL	Cancelled - Section 8	74242314	1806425

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 11, 2011	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 11, 2011	May 21, 2011
3	PENDING, INSTITUTED	Apr 11, 2011	
4	NOTICE OF DEFAULT	Jun 06, 2011	
5	BOARD'S DECISION: GRANTED	Jul 21, 2011	
6	COMMR'S ORDER CANCELLING REGISTRATION	Jul 27, 2011	
7	TERMINATED	Jul 28, 2011	

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Mark: MACK

US Serial Number: 73196165

Application Filing Date: Dec. 08, 1978

US Registration Number: 1146847

Registration Date: Feb. 10, 1981

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Feb. 24, 2011

Publication Date: Oct. 28, 1980

Mark Information

Mark Literal Elements: MACK

Standard Character Claim: No

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

Related Properties Information

Claimed Ownership of US Registrations: 01387610, 10325220 and others

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 incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Vehicles and Vehicles Parts and Accessories-Namely, Trucks, Truck-Tractors, Truck Engines, Engine Brakes, Engine Preheaters, Engine Supports, Accelerators, Axle Carriers, Front Axle Assemblies, Front Drive Axles, Rear Axle Assemblies, V-Belts, Main Bearings, Brakes, Hand Brakes, Brake Controls, Air Brakes, Air Brake Coils, Brake Shoes, Air Brake Diaphragms, Brake Linings, Hydraulic Brake Master Cylinders, Tow Eye Bumpers, Truck Bumpers, Running Boards, Clutches, Clutch Assemblies, Crank Shafts, Super Chargers, Cab Tilt Mechanisms, Air Cleaners, Cab Steps, Differentials, Vibration Dampers, Frame Cross Members, Fenders, Fans, Fan Drive, Fuel Tanks, Vacuum Fuel Pumps, Oil Filters, Gasoline Filters, Fuel Filters, Coolant Filters, Breather Filters, Air Filters, Mud Flaps, Quarter Fenders, Differential Gears and Bearings, Bull Gears, Glider Kits, Glove Compartments, Gear Shift Levers and Knobs, Splash Guards, Passenger Compartment Heaters for Vehicles, Hoods, Horns, Air Horns, Horn Buttons, Idler Shafts, Insect Screens, License Plate Holders, Starting Motors, Mufflers, Oil Coolers, Pogo Sticks, Injection Pumps, Vacuum Pumps, Oil Pumps, Power Divider Assemblies, Power Take-Off Gear Drive Systems, Exhaust Pipes, Connecting Rods, Radiators, Radiator Shutters, Radiator Grills and Ornaments, Radiator Protectors, Steering Assemblies, Steering Wheels, Steering Gears, Truck Seats, Seat Cushions, Seat Belts, Sleeper Compartments, Air Intake Silencers, Silencers, Front Air Suspension Member, Rear Air Suspension Member, Springs, Shock Absorbers, Air Suspension Control Assemblies, Stabilizers, Automotive Transmissions, Automotive Transmission Gears and Pinions, Torque Converters, Tires, Tire Carriers, Pintle Hood Towing Systems, Tractor-Trailer Connectors, Fifth Wheel Trailer Connectors, Tread Plates, Valve Rocker Arm, Valve Lifter, Sun Visors, Wheels and Hubs, Fly Wheels, Windshields, Windshield Wipers, Windshield Wiper Motors, Windshield Washers, Windshield Defroster Fans, Truck Window Lift Kit

International Class(es): 012 - Primary Class

U.S Class(es): 019, 031, 035

Class Status: ACTIVE

Basis: 1(a)

First Use: 1901

Use in Commerce: 1901

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Mack Trucks, Inc.

Owner Address: 2900 North Service Road
Greensboro, NORTH CAROLINA 27409
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Gary D. Krugman

Docket Number: M8315

Attorney Primary Email Address: tm@sughrue.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Gary D. Krugman
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DISTRICT OF COLUMBIA 20037
UNITED STATES

Phone: 202.293.7060

Fax: 202.293.7860

Correspondent e-mail: tm@sughrue.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 24, 2011	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	75461
Feb. 24, 2011	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Feb. 22, 2011	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75461
Feb. 09, 2011	TEAS SECTION 8 & 9 RECEIVED	
Feb. 09, 2011	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Feb. 09, 2011	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Feb. 19, 2008	CASE FILE IN TICRS	
May 16, 2001	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
May 16, 2001	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jan. 26, 2001	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Jul. 09, 1987	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Feb. 06, 1987	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Feb. 10, 1981	REGISTERED-PRINCIPAL REGISTER	
Oct. 28, 1980	PUBLISHED FOR OPPOSITION	
Sep. 23, 1980	NOTICE OF PUBLICATION	
Jun. 23, 1980	APPROVED FOR PUB - PRINCIPAL REGISTER	

Sep. 11, 1979 NON-FINAL ACTION MAILED
Apr. 07, 1979 ASSIGNED TO EXAMINER

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Feb. 10, 2011

TM Staff and Location Information

TM Staff Information - None File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Feb. 24, 2011

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: Mack Trucks, Inc.

Assignment 1 of 2

Conveyance: SECURITY INTEREST

Reel/Frame: [0712/0721](#)

Pages: 0

Date Recorded: Apr. 27, 1990

Supporting Documents: No Supporting Documents Available

Assignor

Name: [MACK TRUCKS, INC.](#)

Execution Date: Apr. 27, 1990

Legal Entity Type: CORPORATION

State or Country Where Organized: PENNSYLVANIA

Assignee

Name: [CITIBANK, N.A.](#)

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Address: 399 PARK AVENUE
NEW YORK, NEW YORK 10043

Correspondent

Correspondent Name: CATHERINE H. STOCKELL

Correspondent Address: PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2711

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: RELEASE BY SECURED PARTY

Reel/Frame: [0800/0427](#)

Pages: 12

Date Recorded: Jul. 10, 1991

Supporting Documents: No Supporting Documents Available

Assignor

Name: [CITIBANK N.A.](#)

Execution Date: Jun. 28, 1991

Legal Entity Type: A NATIONAL BANKING ASSOCIATION

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: [MACK TRUCKS, INC.](#)

Legal Entity Type: CORPORATION

State or Country: PENNSYLVANIA

Where Organized:

Address: 2100 MACK BLVD.
ALLENTOWN, PENNSYLVANIA 18103

Correspondent

Correspondent Name: PENNIE & EDMONDS

Correspondent Address: 1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2711

Domestic Representative - Not Found

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Mark: MACK

MACK

US Serial Number: 86594980

Application Filing Date: Apr. 13, 2015

US Registration Number: 4939157

Registration Date: Apr. 19, 2016

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

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

Status Date: Apr. 19, 2016

Publication Date: Feb. 02, 2016

Mark Information

Mark Literal Elements: MACK

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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 incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: Metal spacer brackets; metal hardware, namely, nuts, studs, screws

International Class(es): 006 - Primary Class

U.S Class(es): 002, 012, 013, 014, 023, 025, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: 1922

Use in Commerce: 1922

For: Land vehicle parts, namely, hydraulic bottle jacks, cylinder heads for engines, exhaust pipes, fan belt drive kits, composed primarily of fan drive journal brackets being a structural component of fan belt drives, engine bearings, engine seals, o-rings being machine parts for engines, metal retaining rings being structural parts of machines, friction liners in the nature of anti-friction bearings for machines, pistons, piston rings, air cartridge in the nature of air filters for automotive engines; air filters for automobile engines, fuel injectors, fuelwater separators, hydraulic pumps, radiators, vacuum pumps, water pumps; exhaust stacks for engines, engine overhaul kits comprising pistons, piston liners, connecting rods, engine bearings and engine seals, fuel injectors; electronic rotating alternators, generators and motor starters; gas coolers, ignition coils, engine fan electric generators; CACs for engines in the nature of charge air coolers; land vehicle parts, namely, parts for air conditioning systems, namely, compressors and condensers; all of the aforementioned goods being used as parts of land vehicles

International Class(es): 007 - Primary Class

U.S Class(es): 013, 019, 021, 023, 031, 034, 035

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1923

Use in Commerce: Jan. 01, 1923

For: Knives, namely, pocket knives, folding knives; knives for collectors; multiple function folding pocket tool comprised of a folding knife, screwdriver, and nail file; multiple function key tool comprised of a folding knife, screwdriver, and nail file

International Class(es): 008 - Primary Class

U.S Class(es): 023, 028, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 01, 1922

Use in Commerce: Dec. 01, 1922

For: Diesel engines for land vehicles

International Class(es): 012 - Primary Class

U.S Class(es): 019, 021, 023, 031, 035, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: 1922

Use in Commerce: 1922

For: Jewelry, watches, keychains as jewelry; clocks

International Class(es): 014 - Primary Class

U.S Class(es): 002, 027, 028, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 01, 1922

Use in Commerce: Dec. 01, 1922

For: Connecting hoses for vehicle radiators; connecting hoses for vehicle fuel injectors; rubber hoses for vehicle heaters; land vehicle parts, namely, parts for air conditioning systems, namely, non-metal hoses, non-metal hose fittings

International Class(es): 017 - Primary Class

U.S Class(es): 001, 005, 012, 013, 035, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1962

Use in Commerce: Jan. 01, 1962

For: Mugs; beverage glassware; beverage ware; bottle openers and flasks

International Class(es): 021 - Primary Class

U.S Class(es): 002, 013, 023, 029, 030, 033, 040, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1991

Use in Commerce: Jan. 01, 1991

For: Vehicle dealership services

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Jun. 01, 1939

Use in Commerce: Jun. 01, 1939

For: Leasing of motor vehicles

International Class(es): 039 - Primary Class

U.S Class(es): 100, 105

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1992

Use in Commerce: Jan. 01, 1992

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: VOLVO TRUCK CORPORATION
Owner Address: SE-405
08 Göteborg
SWEDEN
Legal Entity Type: CORPORATION

State or Country SWEDEN
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: LEIGH ANN LINDQUIST
Attorney Primary Email Address: tm@sughrue.com
Docket Number: S21263
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: LEIGH ANN LINDQUIST
Sughrue Mion Pllc
2100 Pennsylvania Ave NW
Washington, DISTRICT OF COLUMBIA 20037-3202
UNITED STATES
Phone: 202.293.7060
Fax: 202.293.7860
Correspondent e-mail: tm@sughrue.com
Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: LEIGH ANN LINDQUIST
Phone: 202.293.7060
Fax: 202.293.7860
Domestic Representative e-mail: tm@sughrue.com
Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Apr. 19, 2016	REGISTERED-PRINCIPAL REGISTER	
Feb. 02, 2016	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Feb. 02, 2016	PUBLISHED FOR OPPOSITION	
Jan. 13, 2016	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Dec. 28, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	70633
Dec. 18, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Dec. 17, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Dec. 17, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Dec. 17, 2015	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jul. 22, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jul. 22, 2015	NON-FINAL ACTION E-MAILED	6325
Jul. 22, 2015	NON-FINAL ACTION WRITTEN	83696
Jul. 21, 2015	ASSIGNED TO EXAMINER	83696
May 06, 2015	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	70633
May 04, 2015	ASSIGNED TO LIE	70633
Apr. 30, 2015	TEAS VOLUNTARY AMENDMENT RECEIVED	
Apr. 18, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 16, 2015	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Apr. 19, 2016

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91230185](#)

Filing Date: Sep 21, 2016

Status: Pending

Status Date: Sep 21, 2016

Interlocutory Attorney: ELIZABETH WINTER

Defendant

Name: Jerry L. Mack dba Mack Transportation Service, LLC

Correspondent Address: MICHAEL D STEWART
200 SE 1ST ST SUITE 701
MIAMI FL , 33131
UNITED STATES

Correspondent e-mail: ms@themiamilaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK TRANSPORTATION SERVICE	Opposition Pending	86854384	

Plaintiff(s)

Name: Mack Trucks, Inc. and Volvo Truck Corporation

Correspondent Address: LEIGH ANN LINDQUIST
SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
WASHINGTON DC , 20037
UNITED STATES

Correspondent e-mail: tm@sughrue.com , vmullineaux@sughrue.com , llindquist@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
MACK	Registered	86594980	4939157
MACK	Renewed	72413158	946059
MACK	Renewed	73196165	1146847
MACK PUREBRED OVERHAUL	Registered	85592491	4355171

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 21, 2016	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 21, 2016	Oct 31, 2016
3	PENDING, INSTITUTED	Sep 21, 2016	
4	CHANGE OF CORRESP ADDRESS	Sep 21, 2016	
5	D APPEARANCE / POWER OF ATTORNEY	Sep 29, 2016	
6	ANSWER	Oct 04, 2016	
7	ANSWER	Oct 04, 2016	
8	TRIAL DATES REMAIN AS SET	Oct 19, 2016	
9	STIP FOR EXT	May 15, 2017	
10	EXTENSION OF TIME GRANTED	May 15, 2017	
11	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jul 26, 2017	
12	SUSPENDED	Jul 26, 2017	