

ESTTA Tracking number: **ESTTA902732**

Filing date: **06/12/2018**

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	The Pep Boys Manny, Moe & Jack of California
Granted to Date of previous extension	06/13/2018
Address	3111 West Allegheny Avenue Philadelphia, PA 19132 UNITED STATES

Attorney information	Marsha G. Gentner Dykema Gossett PLLc 1301 K Street, NW, Suite 1100 West Washington, DC 20005 UNITED STATES Email: tm@dykema.com, mgentner@dykema.com, swilliams@dykema.com
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Applicant Information

Application No	87131646	Publication date	02/13/2018
Opposition Filing Date	06/12/2018	Opposition Period Ends	06/13/2018
Applicant	Interstate Muffler LLC 16869 Oviedo Drive Elkton, VA 22827 UNITED STATES		

Goods/Services Affected by Opposition


Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Mufflers

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2179083	Application Date	06/07/1996
Registration Date	08/04/1998	Foreign Priority Date	NONE

Word Mark	PROLINE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 [chemical motor oil additives, chemical gasoline additives, fuel injection cleaner chemical additive, brake fluid and power steering fluid] Class 003. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 carburetor and choke cleaning preparations, and hand cleaning preparations Class 004. First use: First Use: 1996/09/01 First Use In Commerce: 1996/09/01 motor oil, non-chemical motor oil additives, non-chemical gasoline additives, transmission fluid, lubrication grease for vehicles, and belt dressings

U.S. Registration No.	2356875	Application Date	11/04/1998
Registration Date	06/13/2000	Foreign Priority Date	NONE

Word Mark	PROLINE
Design Mark	
Description of Mark	NONE
Goods/Services	Class 007. First use: First Use: 1997/12/08 First Use In Commerce: 1997/12/08 OIL AND AIR FILTERS FOR MOTORS AND ENGINES

U.S. Registration No.	2474353	Application Date	09/30/1999
Registration Date	07/31/2001	Foreign Priority Date	NONE
Word Mark	PROLINE		

Design Mark	PROLINE		
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 1999/11/00 First Use In Commerce: 1999/11/00 WINDSHIELD WIPER BLADES		

U.S. Registration No.	2491066	Application Date	06/18/1998
Registration Date	09/18/2001	Foreign Priority Date	NONE
Word Mark	PROLINE		
Design Mark	PROLINE		
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1999/08/00 First Use In Commerce: 1999/08/00 ANTIFREEZE		

U.S. Registration No.	2764884	Application Date	01/04/2001
Registration Date	09/16/2003	Foreign Priority Date	NONE
Word Mark	PROLINE		
Design Mark	PROLINE		
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2003/02/17 First Use In Commerce: 2003/02/17 Automotive parts, namely, wheels		

Attachments	75116157#TMSN.png(bytes) 75582822#TMSN.png(bytes) 75811118#TMSN.png(bytes) 75504397#TMSN.png(bytes) 76189675#TMSN.png(bytes) Notice of Opposition 067154-000472.pdf(497870 bytes)
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Signature	/Marsha G. Gentner/
Name	Marsha G. Gentner
Date	06/12/2018

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

THE PEP BOYS MANNY, MOE & JACK)
OF CALIFORNIA,)
)
Opposer,)
)
v.) Opposition No.
)
INTERSTATE MUFFLER LLC,)
)
)
Applicant.)

NOTICE OF OPPOSITION

In the matter of an application to register a trademark under the Trademark Act of 1946, Serial No. 87131646, filed August 9, 2016, in the name of Interstate Muffler LLC, published for opposition on February 13, 2018, for the mark PROLINE XTREME PERFORMANCE, PXP SERIES PROFESSIONAL LINE OF PERFORMANCE MUFFLERS AND EXHAUST SYSTEMS FOR CAR, TRUCK AND SUV, the Opposer, The Pep Boys Manny, Moe & Jack of California, believes it will be damaged by registration of said alleged trademark, and hereby opposes same. The grounds for opposition are as follows:

1. The Opposer is a corporation duly organized and existing under the laws of the state of California, and having its place of business at 3111 West Allegheny, Philadelphia, Pennsylvania.
2. For nearly a century, Opposer's related company, The Pep Boys Manny, Moe & Jack [said related company and Opposer hereinafter sometimes collectively referred to as "Pep Boys"] has, and is now, engaged in the distribution, marketing, sale, advertising and promotion of a variety of vehicle products, as well as retail and wholesale store and vehicle maintenance and repair services, throughout the United States.

3. Since prior to the filing date of the application opposed herein, Pep Boys has used the mark **PROLINE** to identify and designate a variety of vehicle parts, products and accessories and to distinguish those goods from those of others. Since Pep Boys' initial use of its **PROLINE** mark, Pep Boys continuously has used, advertised, promoted, offered for sale and sold its goods under the **PROLINE** mark to the public through various channels of trade in interstate commerce, with the result that customers have come to know and recognize Opposer's **PROLINE** mark and to associate same with Pep Boys and/or the goods advertised, marketed, distributed, and/or sold by or on behalf of Opposer Pep Boys.

4. Opposer is the owner of, and will rely upon herein, the following U.S. trademark registrations (hereafter collectively, Opposer's "**PROLINE Registrations**):

REGISTRATION NO.	ISSUE DATE
2,179,083	August 4, 1998
2,356,875	June 13, 2000
2,474,353	July 31, 2001
2,491,066	September 18, 2001
2,764,884	September 16, 2003

Each of the registrations listed above operate as conclusive evidence of Opposer's ownership of the **PROLINE** mark set forth therein and exclusive right to use same in connection with the goods listed in those registrations. *See 15 U.S.C. §§1065 and 1115(b)*. Attached hereto is a current printout of information from the electronic database records of the U.S. Patent and Trademark Office showing the current status and title of the aforementioned registrations in Opposer.

5. On August 9, 2016, Applicant filed an application for registration of the mark:

Proline Xtreme
Performance, PXP Series
Professional line of
Performance Mufflers and
Exhaust Systems for Car,
Truck and SUV

The application, which was accorded Serial No. 87131646 (hereafter, the “opposed Application”), identified the following goods: “engine exhaust tips”, in International Class 7, and “mufflers” in International Class 25, and was based on an asserted bona fide intent to use the applied for mark in commerce with the identified goods.

6. On November 9, 2016, the U.S. Patent and Trademark Office (“USPTO”) issued an Office Action, refusing registration of the mark of the opposed Application with respect to the Class 7 goods pursuant to § 2d of the Trademark Act, on the basis of a likelihood of confusion with the mark(s) of Opposer’s **PROLINE Registrations**. That Office Action expressly stated that: “*This refusal is limited to Class 007 goods ONLY and does not relate to the clothing items of mufflers (neck scarves) as in applicant’s applied-for goods in International Class 025*”(emphasis in original).By Office Action dated June 5, 2017, the USPTO made the refusal to register based on Opposer’s **PROLINE Registrations** final. On January 2, 2018, the USPTO issued an Office Action in the opposed Application, declaring the application, insofar as the Class 7 goods were concerned, abandoned, and amending the Class 25 goods to: “Mufflers; which are for clothing.” The Office Action further amended the disclaimer previously entered in the application by Applicant, of “the exclusive right to use SERIES for International Classes 007 and 025 and PERFORMANCE and PROFESSIONAL LINE OF PERFORMANCE MUFFLERS AND EXHAUST SYSTEMS FOR CAR, TRUCK, AND SUV in International Class 007” to “No claim is made to the exclusive right to use “SERIES” apart from the mark as shown.”

7. On February 13, 2018, the opposed Application was published for opposition, but identified the goods only as “mufflers”, in International Class 25.

COUNT I – NO BONA FIDE INTENT TO USE THE OPPOSED MARK

8. Opposer restates and realleges ¶¶ 1 through 7, above of this Notice of Opposition, and hereby incorporates same as if fully set forth herein.

9. On information and belief, as of the August 9, 2016 filing date of the opposed Application, Applicant did not have a bona fide intent to use the opposed mark in connection with “Mufflers; which are for clothing.” and/or mufflers in International Class 25.

10. By reason of the foregoing, ¶¶8-9, the opposed Application is *void ab initio*.

COUNT II – FRAUD ON THE TRADEMARK OFFICE

11. Opposer restates and realleges ¶¶ 1 through 10, above of this Notice of Opposition, and hereby incorporates same as if fully set forth herein.

12. On information and belief, when Applicant filed the opposed Application, designating the “mufflers” as in Class 25 (clothing), Applicant knew that its goods were not clothing, and/or at least as of Applicant’s receipt of the November 9, 2016 Office Action, as of Applicant’s receipt of the June 5, 2017 Office Action, and/or as of Applicant’s receipt of the January 2, 2018 Office Action, Applicant knew that the USPTO Examining Attorney reviewing the opposed Application believed Applicant’s Class 25 goods to be “Mufflers; which are for clothing” and/or “neck-scarves”, but Applicant knowingly omitted and/or failed to advise the USPTO Examining Attorney that such goods, in fact, were “mufflers” for vehicles (vehicle parts), in International Class 7, and further, that if Applicant advised the USPTO Examining Attorney of this fact, the opposed Application for “mufflers” would be finally refused registration under § 2(d) of the Trademark Act on the basis of Opposer’s **PROLINE Registrations**.

13. By reason of the foregoing, ¶¶5 through 7, 9 and 12, Applicant has committed fraud on the USPTO, rendering the opposed Application invalid.

COUNT III – LIKELIHOOD OF CONFUSION

14. Opposer restates and realleges ¶¶ 1 through 13, above of this Notice of Opposition, and hereby incorporates same as if fully set forth herein.

15. The trademark sought to be registered by Applicant is a simulation and colorable imitation of, and confusingly similar to, Opposer's **PROLINE** mark.

16. “Mufflers” are the same, similar and/or related to, Pep Boys' goods, and are and/or will be advertised, promoted and/or sold through the same and/or similar channels of trade and/or to the same general class of purchasers as, Pep Boys' goods, advertised, marketed, offered for sale and/or sold under Opposer's **PROLINE** mark.

17. Customers of Pep Boys, as well as the public in general, are likely to be confused, mistaken or deceived as to the origin or sponsorship of Applicant's mufflers marketed, promoted, and/or sold under, or in connection with, the opposed **PROLINE XTREME PERFORMANCE, PXP SERIES PROFESSIONAL LINE OF PERFORMANCE MUFFLERS AND EXHAUST SYSTEMS FOR CAR, TRUCK AND SUV** trademark sought to be registered by Applicant herein, and further, said persons are likely to be misled into believing that Applicant and/or Applicant's goods are sold by, emanate from, or in some way are, directly or indirectly, associated with or connected to Pep Boys, its products and/or **PROLINE** mark, to the damage and detriment of Opposer.

18. Opposer believes that it will be damaged by the registration by Applicant of the **PROLINE XTREME PERFORMANCE, PXP SERIES PROFESSIONAL LINE OF PERFORMANCE MUFFLERS AND EXHAUST SYSTEMS FOR CAR, TRUCK AND SUV** trademark, as set forth in Applicant's application Serial No. 87131646, and that if registration on the opposed application is granted, and the presumptions accorded to such registration are conferred under the Trademark Act of 1946, as amended, Applicant will receive benefits to which it is not entitled, to the damage and harm of Opposer/

WHEREFORE, this Opposer, The Pep Boys Manny, Moe & Jack of California, prays that:

- a) judgment for Opposer and against Applicant in the present opposition, on each of Counts I through III, inclusive, be entered;
- b) registration of application Serial No. 87131646 be rejected and refused; and
- c) the present opposition be sustained.

Respectfully submitted,

THE PEP BOYS MANNY, MOE & JACK OF CALIFORNIA

Date: June 12, 2018

By: /Marsha G. Gentner/
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Word Mark	PROLINE
Goods and Services	(CANCELLED) IC 001. US 001 005 006 010 026 046. G & S: [chemical motor oil additives, chemical gasoline additives, fuel injection cleaner chemical additive, brake fluid and power steering fluid]. FIRST USE: 19960901. FIRST USE IN COMMERCE: 19960901
	IC 003. US 001 004 006 050 051 052. G & S: carburetor and choke cleaning preparations, and hand cleaning preparations. FIRST USE: 19960901. FIRST USE IN COMMERCE: 19960901
	IC 004. US 001 006 015. G & S: motor oil, non-chemical motor oil additives, non-chemical gasoline additives, transmission fluid, lubrication grease for vehicles, and belt dressings. FIRST USE: 19960901. FIRST USE IN COMMERCE: 19960901
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	26.11.21 - Rectangles that are completely or partially shaded
Serial Number	75116157
Filing Date	June 7, 1996
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	August 5, 1997
Change In Registration	CHANGE IN REGISTRATION HAS OCCURRED
Registration Number	2179083
Registration Date	August 4, 1998

Owner (REGISTRANT) PEP BOYS MANNY, MOE & JACK OF CALIFORNIA, THE CORPORATION CALIFORNIA
3111 WEST ALLEGHENY AVENUE PHILADELPHIA PENNSYLVANIA 19132

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Marsha G. Gentner

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). PARTIAL SECTION 8(10-YR) 20080414.

Renewal 1ST RENEWAL 20080414

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PROLINE

Word Mark PROLINE

Goods and Services IC 007. US 013 019 021 023 031 034 035. G & S: OIL AND AIR FILTERS FOR MOTORS AND ENGINES. FIRST USE: 19971208. FIRST USE IN COMMERCE: 19971208

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75582822

Filing Date November 4, 1998

Current Basis 1A

Original Filing Basis 1A

Published for Opposition March 21, 2000

Registration Number **2356875**

Registration Date June 13, 2000

Owner (REGISTRANT) PEP BOYS MANNY, MOE & JACK OF CALIFORNIA, THE CORPORATION
CALIFORNIA 3111 West Allegheny Avenue Philadelphia PENNSYLVANIA 19132

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Marsha G. Gentner

Prior Registrations 1725416;2179083

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20100127.

Renewal 1ST RENEWAL 20100127

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PROLINE

Word Mark PROLINE

Goods and Services IC 012. US 019 021 023 031 035 044. G & S: WINDSHIELD WIPER BLADES. FIRST USE: 19991100. FIRST USE IN COMMERCE: 19991100

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75811118

Filing Date September 30, 1999

Current Basis 1A

Original Filing Basis 1B

Published for Opposition May 9, 2000

Registration Number **2474353**

Registration Date July 31, 2001

Owner (REGISTRANT) Pep Boys Manny, Moe & Jack of California, The CORPORATION CALIFORNIA 3111 West Allegheny Avenue Philadelphia PENNSYLVANIA 19132

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Marsha G. Gentner

Prior Registrations 1725416;2179083

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110210.

Renewal 1ST RENEWAL 20110210

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PROLINE

Word Mark	PROLINE
Goods and Services	IC 001. US 001 005 006 010 026 046. G & S: ANTIFREEZE. FIRST USE: 19990800. FIRST USE IN COMMERCE: 19990800
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75504397
Filing Date	June 18, 1998
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	March 21, 2000
Registration Number	2491066
Registration Date	September 18, 2001
Owner	(REGISTRANT) PEP BOYS MANNY, MOE & JACK OF CALIFORNIA, THE CORPORATION CALIFORNIA 3111 West Allegheny Avenue Philadelphia PENNSYLVANIA 19132
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Marsha G. Gentner
Prior Registrations	1725416;2179083
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20101021.
Renewal	1ST RENEWAL 20101021
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PROLINE

Word Mark	PROLINE
Goods and Services	IC 012. US 019 021 023 031 035 044. G & S: Automotive parts, namely, wheels. FIRST USE: 20030217. FIRST USE IN COMMERCE: 20030217
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76189675
Filing Date	January 4, 2001
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	December 4, 2001
Registration Number	2764884
Registration Date	September 16, 2003
Owner	(REGISTRANT) Pep Boys Manny, Moe & Jack of California, The CORPORATION CALIFORNIA 3111 West Allegheny Avenue Philadelphia PENNSYLVANIA 19132
Attorney of Record	Marsha G. Gentner
Prior Registrations	1725416;2179083;2356875
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130326.
Renewal	1ST RENEWAL 20130326
Live/Dead Indicator	LIVE

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