

ESTTA Tracking number: **ESTTA1145823**

Filing date: **07/11/2021**

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	Valeo Service
Granted to Date of previous extension	07/11/2021
Address	70 RUE PLEYEL SAINT-DENIS, F-93200 FRANCE
Attorney information	BRYCE J. MAYNARD BUCHANAN INGERSOLL & ROONEY, PC 1737 KING STREET, SUITE 500 ALEXANDRIA, VA 22314 UNITED STATES Primary Email: bryce.maynard@bipc.com No phone number provided.
Docket Number	0086305-172

Applicant Information

Application No.	88804761	Publication date	01/12/2021
Opposition Filing Date	07/11/2021	Opposition Period Ends	07/11/2021
Applicant	Trico Products Corporation 3255 WEST HAMLIN ROAD ROCHESTER HILLS, MI 48309 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Providing an online computer database featuring information about pricing and specifications for vehicle parts; arranging and conducting incentive reward programs to promote the sale of automotive parts; providing an online computer database in the field of customer service; arranging and conducting incentive reward programs to promote the sale of automotive goods

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. Application/ Registra-	NONE	Application Date	NONE
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tion No.			
Registration Date	NONE		
Word Mark	FIRST		
Goods/Services	wiper blades; parts and accessories for wiper blades		

Attachments	Valeo FIRST Notice of Opposition Final.pdf(77864 bytes)
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Signature	/Bryce J. Maynard/
Name	BRYCE J. MAYNARD
Date	07/11/2021

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

RE: U.S. Trademark Application Serial No. 88/804,761
Published in the *Official Gazette* on January 12, 2021

Valeo Service	:	
	:	
Opposer,	:	
	:	Opposition No. _____
-v-	:	
	:	
Trico Products Corporation	:	
	:	
Applicant	:	
_____	:	

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Commissioner:

In the matter of U.S. Trademark Application Serial No. 88/804,761, filed on February 20, 2020 by Trico Products Corporation (“Applicant”) to register the mark FIRST BRANDS (“Applicant’s FIRST BRANDS Mark”) in connection with “Providing an online computer database featuring information about pricing and specifications for vehicle parts; arranging and conducting incentive reward programs to promote the sale of automotive parts; providing an online computer database in the field of customer service; arranging and conducting incentive reward programs to promote the sale of automotive goods” in International Class 35 (“Applicant’s Services”), and published in the *Official Gazette* on January 12, 2021, Valeo Service (“Opposer”) believes that it will be damaged by registration of Applicant’s FIRST BRANDS Mark and hereby opposes same.

The grounds for this opposition are as follows:

1. Applicant is the owner of Application Serial No. 88/804,761 for Applicant's FIRST BRANDS Mark in connection with Applicant's Services.
2. Applicant filed Application Serial No. 88/804,761 for Applicant's FIRST BRANDS Mark based upon intent to use under Section 1(b) of the Trademark Act.
3. Upon information and belief, Applicant did not use Applicant's FIRST BRANDS Mark in connection with Applicant's Services prior to February 20, 2020, the filing date of Application Serial No. 88/804,761.
4. Upon information and belief, Applicant did not use Applicant's FIRST BRANDS Mark in connection with Applicant's Services in interstate commerce in the United States prior to February 20, 2020, the filing date of Application Serial No. 88/804,761.
5. Opposer is a French société par actions simplifiée à associé unique located and doing business at 70 rue Pleyel, Saint-Denis, France, F-93200.
6. Opposer has used the mark FIRST ("Opposer's FIRST Mark") in interstate commerce in the United States in connection with wiper blades and parts and accessories for wiper blades ("Opposer's Goods") continuously and without interruption since at least as early as July 31, 2015.
12. Opposer's July 31, 2015 date of first use and first use in commerce of Opposer's FIRST Mark is well prior to the February 20, 2020 filing date of Applicant's FIRST BRANDS Mark, as alleged in Application Serial No. 88/804,761, as well as any use by Applicant of Applicant's FIRST BRANDS Mark in the United States.
14. Therefore, Opposer's rights in Opposer's FIRST Mark are superior to any rights that Applicant may have in Applicant's FIRST BRANDS Mark.

15. Applicant's FIRST BRANDS Mark is virtually identical to Opposer's FIRST Mark in appearance, pronunciation, and commercial impression. Applicant's FIRST BRANDS Mark is confusingly similar to Opposer's FIRST Mark given the similarities between the marks in their appearance, pronunciation, and commercial impression.

16. The dominant term in each party's mark is the word FIRST. The additional term BRANDS in Applicant's FIRST BRANDS Mark is merely descriptive and does not serve to distinguish Applicant's FIRST BRANDS Mark from Opposer's FIRST Mark. Applicant has also disclaimed any exclusive rights in the term BRANDS in Applicant's FIRST BRANDS Mark.

17. Applicant's Services are closely related to Opposer's Goods, and will be offered and promoted to the same classes of consumers through identical or virtually identical channels of trade.

18. Applicant adopted Applicant's FIRST BRANDS Mark with full knowledge of Opposer's prior rights in Opposer's FIRST Mark, and with the intent to trade off the goodwill associated with Opposer's FIRST Mark.

19. Applicant's FIRST BRANDS Mark in Application Serial No. 88/804,761 so resembles Opposer's previously used FIRST Mark, when applied to Applicant's Services, to be likely to cause confusion, to cause mistake, or to deceive, by creating the erroneous impression that Applicant's Services originate from or are associated with Opposer, or that Applicant's Services are authorized, endorsed or sponsored by Opposer.

20. Applicant's filing of Application Serial No. 88/804,761 for Applicant's FIRST BRANDS Mark was without license, authorization or permission from Opposer.

21. The granting of a trademark registration for Applicant's FIRST BRANDS Mark would violate and diminish the prior and superior rights of Opposer in Opposer's FIRST Mark and would be in violation of 15 U.S.C. § 1052(d).

22. Opposer will be damaged if Application Serial No. 88/804,761 is allowed to register because Applicant will obtain statutory rights in Applicant's FIRST BRANDS Mark in violation and derogation of the established prior rights of Opposer in Opposer's FIRST Mark.

WHEREFORE, Opposer requests that its Opposition be sustained, that Application Serial No. 88/804,761 be rejected, that the registration of Applicant's FIRST BRANDS Mark as a trademark to Applicant be refused, and for all such other relief as may be deemed just and proper.

Respectfully submitted,

VALEO SERVICE

Date: July 11, 2021

/Bryce J. Maynard/
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