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Filing date: **12/01/2023**

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	Neal Technologies, Inc.
Granted to date of previous extension	12/02/2023
Address	4245 E. PALM STREET MESA, AZ 85215 UNITED STATES
Attorney information	PHILIP VICKERS CANTEY HANGER LLP 600 WEST 6TH STREET, SUITE 300 FORT WORTH, TX 76102 UNITED STATES Primary email: pvickers@canteyhanger.com Secondary email(s): sfredricks@canteyhanger.com, mackerman@canteyhanger.com 817-877-2849
Docket no.	

### Applicant information

Application no.	97230460	Publication date	10/03/2023
Opposition filing date	12/01/2023	Opposition period ends	12/02/2023
Applicant	Baxter Auto LLC 1722 N. BANNING, SUITE 105 MESA, AZ 85205 UNITED STATES		

### Goods/services affected by opposition

Class 037. First Use: Apr 1, 2016 First Use In Commerce: Apr 1, 2016  
All goods and services in the class are opposed, namely: Automotive maintenance and repair services, but excluding work on diesel engines and diesel engine components

### Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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.	4235578	Application date	12/17/2010
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Register	Principal		
Registration date	11/06/2012	Foreign priority date	NONE
Word mark	BULLETPROOFDIESEL.COM		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 007. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Automotive components, namely, oil coolers and exhaust gas re-circulation coolers for diesel engines; oil filtration systems comprised of filters for motors and engines and light bars for sport utility vehicles</p> <p>Class 009. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Vehicle engine parts, namely, engine oil thermostats</p> <p>Class 037. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Vehicle services, namely, repair and maintenance of diesel engines; repair and re-manufacture of diesel engine components, namely, engine oil coolers and exhaust gas re-circulation coolers</p>		

U.S. registration no.	5130772	Application date	09/29/2015
Register	Principal		
Registration date	01/31/2017	Foreign priority date	NONE
Word mark	BULLET PROOF		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 035. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Retail store services featuring diesel engine parts; on-line retail store services featuring diesel engine parts; wholesale store services featuring diesel engine parts</p>		

U.S. registration no.	4262825	Application date	12/17/2010
Register	Principal		
Registration date	12/25/2012	Foreign priority date	NONE
Word mark	BULLETPROOFDIESEL.COM		
Design mark			
Description of mark	<p>The mark consists of the wording "BULLETPROOFDIESEL", ".COM" and design. The design consists of two concentric circles with eight rivets encircling the space between the two circles. Superimposed on the background is a stylized depiction of the State of Arizona with a rivet at each angle and a stylized star appears in the center. Below the design is the wording "BULLETPROOF-DIESEL". The term ".COM" appears below the letters "SEL" in "DIESEL".</p>		
Goods/services	<p>Class 007. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Automotive components, namely, oil coolers and exhaust gas re-circulation coolers for diesel engines; oil filtration systems comprised of filters for motors and engines and light bars for sport utility vehicles</p> <p>Class 009. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009</p>		

	Vehicle engine parts, namely, engine oil thermostats Class 037. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Vehicle services, namely, repair and maintenance of diesel engines; repair and re-manufacture of diesel engine components, namely, engine oil coolers and exhaust gas re-circulation coolers		
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U.S. registration no.	5220129	Application date	10/19/2015
Register	Principal		
Registration date	06/13/2017	Foreign priority date	NONE
Word mark	BULLET PROOF		
Design mark			
Description of mark	NONE		
Goods/services	Class 037. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Automotive repair and maintenance services, namely, repair and maintenance of diesel engines, and repair and installation of diesel engine components		

U.S. registration no.	5220127	Application date	09/29/2015
Register	Principal		
Registration date	06/13/2017	Foreign priority date	NONE
Word mark	BULLETPROOFDIESEL		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Retail store services featuring diesel engine parts; on-line retail store services featuring diesel engine parts; wholesale store services featuring diesel engine parts		

U.S. registration no.	5220128	Application date	10/19/2015
Register	Principal		
Registration date	06/13/2017	Foreign priority date	NONE
Word mark	BULLET PROOF DIESEL		
Design mark			
Description of mark	NONE		
Goods/services	Class 037. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 1, 2009 Automotive repair and maintenance services, namely, repair and maintenance of diesel engines, and repair and installation of diesel engine components Class 040. First use: First Use: Jun 1, 2009 First Use In Commerce: Jun 2, 2009 Custom remanufacture of diesel engine components		

U.S. registration no.	5900034	Application date	09/15/2017
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Register	Principal		
Registration date	11/05/2019	Foreign priority date	NONE
Word mark	DARN-NEAR BULLET PROOF		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Aug 1, 2017 First Use In Commerce: Aug 1, 2017 Retail store services featuring diesel engine parts; on-line retail store services featuring diesel engine parts; wholesale store services featuring diesel engine parts		

Attachments	2023.12.01 Notice of Opposition.pdf(169070 bytes )
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Signature	/Philip Vickers/
Name	PHILIP VICKERS
Date	12/01/2023

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

NEAL TECHNOLOGIES, INC.,	§	
	§	
Opposer,	§	
	§	Opp. No. _____
v.	§	
	§	Application Serial No. 97230460
BAXTER AUTO LLC,	§	
	§	
Applicant.	§	

**Notice of Opposition**

Neal Technologies, Inc. (“NTI”) is a corporation organized and existing under the laws of the State of Arizona. NTI will be damaged by the registration of the mark BULLET PROOF OFF-ROAD (“Applicant’s Mark”), which is the subject of Application Serial No. 97230460 (the “Application”) filed by Baxter Auto, LLC, a limited liability company organized under the laws of the State of Arizona. NTI hereby opposes registration of Applicant’s Mark pursuant to the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

On October 24, 2023, NTI timely filed a request for 30 days’ extension of time to oppose the subject Application. On that same date, the Trademark Trial and Appeal Board granted NTI’s request and extended NTI’s time to file its opposition through December 2, 2023.

As grounds for opposition, NTI alleges as follows:

1. NTI is located and does business at 4245 East Palm Street, Mesa, Arizona 85215. Applicant is located and does business at 1722 N. Banning, Suite 105, Mesa, Arizona 85205, less than three miles away from NTI’s principal place of business.

2. NTI is in the business of selling automotive engine parts, components, and services. In connection with its goods and services, NTI has used a family of trademarks derived from the term “BULLET PROOF,” alone and in combination with other word and/or design elements

(collectively, the “BULLET PROOF Marks”). NTI has acquired common law rights in these marks. NTI also holds the following U.S. trademark registrations for the BULLET PROOF Marks, which registrations are valid, subsisting, and (except for one) incontestable (collectively, the “BULLET PROOF Registrations”):

<b>Reg. No.</b>	<b>Mark</b>	<b>Reg. Date</b>	<b>Goods &amp; Services</b>
4,235,578	BulletProofDiesel.com	Nov. 6, 2012	<p><u>Class 7</u>: Automotive components, namely, oil coolers and exhaust gas re-circulation coolers for diesel engines; oil filtration systems comprised of filters for motors and engines and light bars for sport utility vehicles.</p> <p><u>Class 9</u>: Vehicle engine parts, namely, engine oil thermostats.</p> <p><u>Class 37</u>: Vehicle services, namely, repair and maintenance of diesel engines; repair and re-manufacture of diesel engine components, namely, engine oil coolers and exhaust gas re-circulation coolers.</p>
4,262,825	BulletProofDiesel.com design mark	Dec. 25, 2012	<p><u>Class 7</u>: Automotive components, namely, oil coolers and exhaust gas re-circulation coolers for diesel engines; oil filtration systems comprised of filters for motors and engines and light bars for sport utility vehicles.</p> <p><u>Class 9</u>: Vehicle engine parts, namely, engine oil thermostats.</p> <p><u>Class 37</u>: Vehicle services, namely, repair and maintenance of diesel engines; repair and re-manufacture of diesel engine components, namely, engine oil coolers and exhaust gas re-circulation coolers.</p>
5,130,772	BULLET PROOF	Jan. 31, 2017	<p><u>Class 35</u>: Retail store services featuring diesel engine parts; on-line retail store services featuring diesel engine parts; wholesale store services featuring diesel engine parts.</p>

Reg. No.	Mark	Reg. Date	Goods & Services
5,220,127	BULLETPROOFDIESEL	Jun. 13, 2017	<u>Class 35</u> : Retail store services featuring diesel engine parts; on-line retail store services featuring diesel engine parts; wholesale store services featuring diesel engine parts.
5,220,128	BULLET PROOF DIESEL	Jun. 13, 2017	<u>Class 37</u> : Automotive repair and maintenance services, namely, repair and maintenance of diesel engines, and repair and installation of diesel engine components. <u>Class 40</u> : Custom remanufacture of diesel engine components.
5,220,129	BULLET PROOF	Jun. 13, 2017	<u>Class 37</u> : Automotive repair and maintenance services, namely, repair and maintenance of diesel engines, and repair and installation of diesel engine components.
5,900,034	DARN-NEAR BULLET PROOF	Nov. 5, 2019	<u>Class 35</u> : Retail store services featuring diesel engine parts; on-line retail store services featuring diesel engine parts; wholesale store services featuring diesel engine parts.

3. NTI first used, advertised, and promoted most of its BULLET PROOF Marks in interstate commerce in connection with automotive engine parts, components, and/or services, starting in 2009, several years before Applicant allegedly began using Applicant's Mark.<sup>1</sup>

4. As a result of NTI's widespread use, advertising, and promotion of its BULLET PROOF Marks, such marks have become distinctive indicators of the origin of NTI's goods and

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<sup>1</sup> NTI first used the DARN-NEAR BULLET PROOF mark in August 2017. Applicant alleges it started using Applicant's Mark in interstate commerce as early as April 2016.

services, and NTI's BULLET PROOF Marks have acquired a favorable reputation among relevant members of the purchasing public and have become valuable symbols of NTI's goodwill.

5. On January 20, 2022, Applicant filed the Application, which described the class as "Auto body repair services; Automotive maintenance and repair."

6. On November 4, 2022, the United States Patent and Trademark Office ("USPTO") issued a Nonfinal Office Action refusing registration of Applicant's Mark because of a likelihood of confusion with three of NTI's BULLET PROOF Marks.

7. On April 28, 2023, in an attempt to salvage its Application, Applicant amended its class description to explicitly exclude "work on diesel engines and diesel engine components" and filed a Response to the USPTO's Nonfinal Action. In its Response, Applicant argued, "Since the Applicant's services do not include any services related to diesel engines the Applicant and [NTI] are in differing businesses." The declaration in support of the Response—signed by Applicant's owner and principal Paul Baxter—states, "Baxter Auto LLC does not do any work on diesel engines or diesel engine parts or components."

8. However, Applicant has been using—and continues to use—Applicant's Mark in connection with the sale of diesel engine parts, components, and installation services. Applicant operates an online store in which Applicant sells, among other things, a variety of diesel engine parts and components. Applicant also uses its website to advertise installation services of its parts and components. Applicant's website and online store prominently feature Applicant's Mark in connection with diesel engine parts and services.

## COUNT I

### **Fraud in Prosecution of Application**

9. NTI realleges the preceding paragraphs as though fully set forth herein.



10. Pursuant to TBMP § 309.03(c)(1)(19), grounds for opposition exist when the “defendant committed fraud in the procurement of its registration or during the prosecution of its application for registration.”

11. In its April 2023 Response and declaration in support thereof, Applicant attempted to downplay the likelihood of confusion between Applicant’s Mark and NTI’s BULLET PROOF Marks by representing that Applicant does not sell diesel engine parts, components, or services.

12. Baxter Auto does sell diesel engine parts, components, and services, as explained above. Applicant’s representations to the contrary are false.

13. Applicant made these misrepresentations in an attempt to induce the USPTO to grant its Application despite the likelihood of confusion which would inevitably result. This constitutes fraud in the prosecution of an application for registration, and registration of Applicant’s Mark should be refused.

## COUNT II

### Likelihood of Confusion

14. NTI realleges the preceding paragraphs as though fully set forth herein.

15. Pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), grounds for opposition exist where a registration is likely to cause confusion, cause mistake, or to deceive.

16. As initially noted by the USPTO, Applicant’s Mark (BULLET PROOF OFF-ROAD) so closely resembles NTI’s BULLET PROOF Marks in sound and meaning that the use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant’s goods and services and injure and damage NTI and the goodwill and reputation symbolized by NTI’s BULLET PROOF Marks.

17. Applicant's goods and services are so closely related to the goods and services provided by NTI under the BULLET PROOF Marks that customers and others are likely to be confused, to be deceived, and to erroneously assume that Applicant's goods and services are those of NTI or that Applicant is in some way connected with, sponsored by, or affiliated with NTI, all to NTI's irreparable damage and injury. This is particularly true given Applicant's actual use of Applicant's Mark to sell diesel engine parts, components and services, and the close geographic proximity between NTI's and Applicant's places of business.

18. Under the circumstances, registration of Applicant's Mark is likely to cause NTI to lose control over the good and valuable reputation derived from the BULLET PROOF Marks and their use in relation to closely related goods and services.

19. Thus, registration of Applicant's Mark is likely to cause confusion, mistake, and/or deception among members of the purchasing public. Registration should be refused.

The required fee has been paid. *See* 37 CFR 2.6(a)(17).

WHEREFORE, NTI prays that this Opposition be sustained, that registration of Applicant's Mark be refused, and for any additional relief to which NTI may show itself entitled.

/s/ Scott A. Fredricks  
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**ATTORNEYS FOR OPPOSER  
NEAL TECHNOLOGIES, INC.**

**CERTIFICATE OF SERVICE**

I hereby certify that, on December 1, 2023, the foregoing document was served on counsel for Applicant, Baxter Auto LLC via email:

Ira M. Schwartz  
[ISchwartz@psazlaw.com](mailto:ISchwartz@psazlaw.com)

/s/ Michael Ackerman  
Michael Ackerman