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



03-11-2002

U.S. Patent & TMO's/TM Mail Rcpt Dt. #57

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Speedway SuperAmerica LLC :
 :
 Petitioner, :
 :
 v. :
 :
 Speedway Motors, Inc., :
 :
 Registrant. :
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Cancellation No. _____

Registration No. 2,469,462

PETITION FOR CANCELLATION
OF REGISTRATION NO. 2,469,462

Petitioner, Speedway SuperAmerica LLC, a Delaware Limited Liability Company, having its principal place of business at 500 Speedway Drive, Enon, Ohio 45323, believes that it is, and will continue to be, damaged by the registration of SPEEDWAY MOTORS and Design (Reg. No. 2,469,462) for "mail order catalog services featuring automobile supplies and equipment, namely, race, performance and "hot rod" parts and accessories." Registrant has disclaimed the exclusive rights to use "MOTORS" apart from the mark. This registration issued July 17, 2001 and the owner of record is Registrant, Speedway Motors, Inc., a Nebraska Corporation with an address of 300 Speedway Circle, Lincoln, Nebraska 68502. Petitioner hereby requests cancellation of Reg. No. 2,469,462 for the reasons set forth herein.

Petitioner alleges as follows:

1. Petitioner has adopted and, at all times pertinent hereto, has used the mark SPEEDWAY and variations thereof in commerce in connection with a wide variety of goods and services related to automobile servicing, automobile maintenance and retail store services

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associated with the offering of these goods and services.

2. Petitioner, through its predecessors-interests, claims a first use date for the mark in 1935 and a first use date in commerce in 1952, which, upon information and belief, predates any use of any SPEEDWAY mark by Registrant.
3. Petitioner owns the following relevant trademark registrations: SPEEDWAY FUEL CARD (Reg. No. 1,987,536) for “credit card services” (registered: July 16, 1996); THE CONVENIENCE STORES OF SPEEDWAY (Reg. No. 1,867,322) for “retail grocery store services” (registered: December 13, 1994); SPEEDWAY (Reg. No. 1,592,374) for “automobile and truck service station services” (registered: April 17, 1990); SPEEDWAY and Design (Reg. No. 1,530,103) for “automobile and truck service station services” (registered: March 14, 1989); S SPEEDWAY (Reg. No. 1,530,104) for “automobile and truck service station services” (registered: March 14, 1989); S SPEEDWAY and Design (Reg. No. 1,527,706) for “gasoline” (registered: March 7, 1989); SPEEDWAY (Reg. No. 1,168,689) for “gasoline station services” (registered: Sept. 8, 1981); SPEEDWAY (Reg. No. 1,167,946) for “motor oil, automatic transmission oils, multipurpose grease and gasoline” (registered: Sept. 8, 1981); and SPEEDWAY (Reg. No. 816,870) for “gasoline and lubricating oil” (registered: Oct. 18, 1966). These registrations are prima facie evidence of Petitioner's ownership of the trademark shown in the registrations are prima facie evidence of Petitioner's exclusive right to use the trademark

shown in the registration in commerce in connection with the goods/services listed in the registrations. Further, several of these registrations have achieved incontestable status and thus, the registrations are conclusive evidence of the validity of the trademarks listed therein and Petitioner's exclusive right to use those trademarks in commerce, in the advertising, marketing, manufacturing and sale of the goods and services identified therein and for related goods and services.

4. Further, Petitioner owns the following relevant trademark application: S SPEEDWAY SPEEDY WASH and Design (Ser. No. 78/088,344) for "vehicle service station services; vehicle cleaning and washing services" filed October 15, 2001.
5. Petitioner's SPEEDWAY trademarks are of significant value to Petitioner as an identification of source in connection with the promotion and offering of its goods and services. Further, Petitioner's trademarks operate to distinguish Petitioner's goods and services from the goods and/or services of others.
6. The SPEEDWAY trademarks used by Petitioner for its goods and services, and the designation SPEEDWAY MOTORS and Design as registered by Registrant for its goods and services, are identical in wording, pronunciation, sound and spelling, and appearance, except as to MOTORS which has been disclaimed. Thus, it is clear that the mark for which cancellation is sought so resembles Petitioner's mark as to be likely to cause confusion, or to cause mistake, or to deceive.

7. On information and belief, the goods and services of the type recited in Registrant's SPEEDWAY MOTORS and Design registration are closely related to the goods and services offered by Petitioner. Further, Registrant's and Petitioner's goods may be offered to the same classes of purchasers through the same channels of trade.
8. Purchasers and prospective purchasers familiar with Petitioner's goods and services identified by its SPEEDWAY marks are likely to be misled into believing, contrary to fact, that Registrant's goods sold under the very similar mark emanate from or are in some way sponsored by Petitioner, all to Petitioner's irreparable damage through loss and/or dilution of its good will as symbolized by Petitioner's trademark.
9. Petitioner has been and will continue to be damaged by the continued existence on the Register of Registration No. 2,469,462, in light of Petitioner's current and future intentions to use the designation, SPEEDWAY, alone and with other terms or phrases and/or design elements, in connection with a wide variety of goods and services related to gasoline stations, retail stores and other goods and services. Moreover, such registration inhibits Petitioner in its free use of, and natural expansion of, the SPEEDWAY marks in identifying and promoting its goods and services, which would work damage upon Petitioner.

A check in the amount of \$300.00 to cover the official filing fee and a duplicate copy of this petition is attached hereto.

Petition to Cancel Reg. No. 2,469,462

WHEREFORE PETITIONER PRAYS that this petition be sustained and that U. S. Registration No. 2,469,462 for the mark SPEEDWAY MOTORS and Design be canceled.

Date: March 11, 2002

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U.S. Patent & TMO/TM Mail Rept Dt. #57

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Cancellation No. (not yet assigned)

Reg. No. 2,469,462

Speedway SuperAmerica LLC v. Speedway Motors, Inc.

Mark: SPEEDWAY MOTORS and Design

Box TTAB



COVER SHEET

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202

Madam:

Enclosed for filing in connection with the above-referenced matter, please find the following:

- (1) Petition for Cancellation of Registration No. 2,469,462 (in duplicate); and
- (2) Check for \$300.

Respectfully submitted,

Date: March 11, 2002

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