

The grounds for the opposition are as follows:

OPPOSER AND ITS RIGHTS IN THE SWOOSH DESIGN

1. Since long prior to the filing date of the '121 Application, Opposer, either through itself or its predecessor in interest, has continuously used the design mark shown below in interstate commerce (hereinafter, the "SWOOSH DESIGN") in connection with a wide range of goods, including, without limitation, footwear, clothing, sporting goods, bags, and accessories.



2. Opposer's SWOOSH DESIGN mark is inherently distinctive. Opposer has extensively advertised and promoted the SWOOSH DESIGN mark and its goods sold thereunder. By reason of Opposer's extensive advertising, promotion and other use thereof, the SWOOSH DESIGN mark has acquired secondary meaning.

3. Opposer is the owner of various United States Trademark Registrations on the Principal Register for the SWOOSH DESIGN mark, including, but not limited to, the following registrations (hereinafter the "Opposer's Registrations"):

Reg. No. 1,145,473, registered January 6, 1981, filed on January 15, 1979, for all-purpose sport bags, travel bags, hand bags and shoulder bags, claiming first use since March 1972;

Reg. No. 977,190, registered January 22, 1974, filed on January 31, 1972, for athletic shoes with spikes and athletic uniforms for use with such shoes and athletic shoes without spikes and athletic uniforms for such shoes, claiming first use since June 18, 1971;

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Reg. No. 1,284,385, registered on July 3, 1984, filed on April 22, 1982, for athletic and casual clothing for men, women and children, namely, shirts, pants, shorts, jackets, warm-up suits, swimwear, tenniswear, skirts, sweaters, underwear, headwear, socks and wristbands, claiming first use since June 18, 1971;

Reg. No. 1,264,529, registered on January 17, 1984, filed on April 3, 1981, for retail footwear and apparel store services, claiming first use since February 1972;

Reg. No. 1,926,168, registered on October 10, 1995, filed on May 5, 1993, for binders, student planners, notebooks, portfolio covers, and pouches for carrying school materials, claiming first use since April 10, 1995;

Reg. No. 2,024,437, registered December 17, 1996, filed on December 2, 1994, for sports balls, claiming first use since July 26, 1995;

Reg. No. 2,239,078, registered April 13, 1999, filed on December 19, 1994, for ear plugs for swimming purposes, nose clips for swimming purposes, swim goggles, kickboards, and buoys for recreational and training use, claiming first use since January 9, 1998;

Reg. No. 2,107,521, registered October 21, 1997, filed on December 15, 1995, for eyewear (glasses); namely, sunglasses and parts and accessories for eyewear; namely, cases for eyewear, claiming first use since August 28, 1996;

Reg. No. 2,490,994, registered on September 18, 2001, filed on October 2, 1995, for jewelry and entertainment services in the nature of sporting events of all types, namely, contests, clinics, camps, tournaments and exhibitions, claiming first use on for jewelry since 1996 and first use for entertainment services since July 1997;

Reg. No. 2,522,877, registered December 25, 2001, filed August 30, 1996, for helmets of all types for the practice of sports, sports balls of all types; weights for exercise and for lifting; weight lifting belts; protective padding, guards and body protectors of all types for the practice of sports; golf bags; head covers for golf clubs; golf tees and ball markers; baseball and softball bats; mitts and gloves for the practice of all types of sports; ice hockey sticks; ice skates and goggles for swimming, claiming first use since July 26, 1995;

Reg. No. 2,237,852, registered April 6, 1999, filed October 2, 1995, for sunglasses (glasses, eyewear) and sunglass frames, watches, claiming use since August 26, 1997;

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Reg. No. 1,323,343, registered on March 5, 1985, filed on April 3, 1981, for footwear, claiming first use since June 18, 1971; and

Reg. No. 1,990,180, registered on July 30, 1996, filed on December 1, 1995, for a full line of sports clothing, claiming first use since June 18, 1971.

4. Opposer's Registrations are valid and subsisting and record title therein is in the name of Opposer. Reg. Nos. 977,190; 1,145,473; 1,284,385; 1,323,343 and 1,990,180 are incontestable.

5. Opposer has used and is using the SWOOSH DESIGN mark in interstate commerce in connection with all of the goods and services described in the Opposer's Registrations.

COUNT I

THERE IS A LIKELIHOOD OF CONFUSION WITH OPPOSER'S MARK

6. Opposer realleges paragraphs 1 through 5 as paragraph 6 of this Count I.

7. On March 19, 1998, Applicant filed the '121 Application for the mark

"Miscellaneous Design" for the following goods:

Chemicals for use in the manufacture and finishing of textile, leather, metal, pharmaceutical compounds and paper; unprocessed concentrates for use in the manufacture of thermoplastics containing additives and/or pigments in Intl. Class 1; and

Dyestuffs for use in the manufacture and finishing of textiles, leather, metal and paper; color pigments; mordants for use in the textile, leather, metal and paper industries; lacquers in the nature of a coating in Intl. Class 2.

8. Opposer's use and registration of its SWOOSH DESIGN mark long pre-dates the filing date of the '121 Application and Applicant's first use of Applicant's mark.

9. The grant of a registration to Applicant for its "Miscellaneous Design" mark as sought in the '121 Application, should be denied on the grounds of Opposer's prior use of its SWOOSH DESIGN mark. The mark sought to be registered by Applicant is confusingly similar to Opposer's SWOOSH DESIGN mark, and the use of the mark "Miscellaneous Design" by Applicant is likely to cause confusion or mistake in the minds of the public and to lead the public and prospective purchasers to believe that Applicant's goods are those of Opposer or are endorsed, sponsored or otherwise affiliated or connected with Opposer, or that Opposer's goods and services are associated with Applicant, all to the damage and injury of the purchasing public and to the damage and injury of Opposer.

COUNT II

THE '121 APPLICATION DILUTES OPPOSER'S MARKS

10. Opposer realleges paragraphs 1 through 9 as paragraph 10 of this Count II.

11. Through extensive advertising and promotion, Opposer's SWOOSH DESIGN mark has become and is a famous mark in the United States.

12. Applicant claims it has used the mark sought to be registered in the '121 Application since July 1995. Such alleged use began after Opposer's SWOOSH DESIGN mark became famous.

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13. Applicant's use of its "Miscellaneous Design" mark causes and is likely to cause dilution of Opposer's SWOOSH DESIGN mark to the injury of Opposer by lessening the capacity of the SWOOSH DESIGN mark to identify and distinguish Opposer's goods and services and by diluting the distinctive quality of Opposer's famous mark.

14. The grant of a registration to Applicant for its "Miscellaneous Design" mark as sought in the '121 Application, should be denied based on likelihood of confusion with Opposer's prior SWOOSH DESIGN mark and dilution of Opposer's famous SWOOSH DESIGN mark.

WHEREFORE, Opposer files this Notice of Opposition and prays that the aforesaid application of Clariant AG herein opposed, be rejected; that no registration be issued thereon to Applicant; and for such other and further relief as may be deemed just and proper.

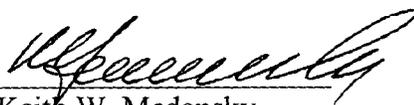
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Enclosed is a check in the amount of \$600.00 to cover the filing fees of this notice of opposition against the '121 Application in two classes. Please charge any additional fees to Deposit Account No. 18-2284, and address all correspondence regarding this opposition to:

Keith W. Medansky
PIPER RUDNICK
P.O. Box 64807
Chicago, Illinois 60664-0807
(312) 368-4000

Respectfully submitted,

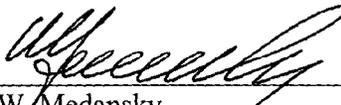
NIKE, INC.

By: 

Keith W. Medansky
PIPER RUDNICK
P.O. Box 64807
Chicago, Illinois 60664-0807
(312) 368-4000
Attorneys for Opposer

CERTIFICATE OF MAILING

I, one of the attorneys for Opposer, hereby certify that this correspondence, in duplicate, is being deposited with the United States Postal Services with sufficient postage as first class mail in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, BOX TTAB FEE, on May 1, 2002.


Keith W. Medansky
One of the Attorneys for Opposer

5/1/02