



TTAB

08-26-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

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

In re Serial No. 75-898,707

Filed: 1-21-2000

KAREN SHINODA,

Opposer,

Opposition No.

vs.

AMERICAN EAGLE WHEEL CORPORATION,

Applicant.

TRADEMARK TRIAL AND
APPEAL BOARD
02 AUG 30 PM 8:44

NOTICE OF OPPOSITION

Box TTAB
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

Karen Shinoda, having an address at 500 East 85th St. Apt 17d, New York, NY 10028, believes that she will be damaged by registration of the mark shown in Serial No. 75/898,707, in International Class 12 (US Classes 19, 21, 23, 31, 35 and 44) and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. The Applicant, American Eagle Wheel Corporation, seeks to register the term BOSS MOTOR SPORTS in International Class 12 as a trademark for wheel rims and parts thereof, namely, fasteners and hub caps for use with automobiles and motorcycles as evidenced by the publication of said mark in the Official Gazette of the United States Patent and Trademark Office on page 389 of the April 30, 2002 issue (Exhibit A). Applicant's trademark application was filed on January 21, 2000 based on intent to use.

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OFFICE OF THE ASSISTANT COMMISSIONER FOR TRADEMARKS, 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

2. The Opposer has used the mark BOSS SHINODA for automotive accessories, in interstate commerce since 1994, more than six years prior to the filing of Applicant's intent-to-use application.

3. Opposer has developed exceedingly valuable goodwill and consumer recognition with respect to its use of the mark BOSS SHINODA. By virtue of its efforts, and the expenditure of considerable sums for promotional activities, and by virtue of the excellent quality of its goods the Opposer has gained a most valuable reputation for its goods in conjunction with the term BOSS SHINODA.

4. The Applicant's mark is so closely similar to Opposer's mark so as to cause confusion and lead to deception as to the origin of Applicant's goods identified with the Applicant's mark. This confusion will be exacerbated by the closely similar nature of the goods and by the common channels of trade through which the products of both Applicant and Opposer will travel.

5. If the Applicant is permitted to use and register its mark for its goods, as specified in the application herein opposed, confusion in trade resulting in damage and injury to the Opposer would be caused and would result by reason of use of the closely similar mark on closely related goods by both Applicant and Opposer. Persons familiar with Opposer's use of the mark would be likely to buy Applicant's goods as and for goods offered by the Opposer. Any such confusion in trade inevitably would result in loss of sales to the Opposer. Furthermore, any defect, objection or fault found with Applicant's goods marketed under its mark would necessarily reflect upon and seriously injure the reputation which the Opposer has established for its goods merchandised under its mark.

6. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark, in direct conflict with Opposer's exclusive rights deriving from its own use of the BOSS SHINODA mark for similar, closely related goods. Such a conflicting registration would be a source of damage and injury to the Opposer.

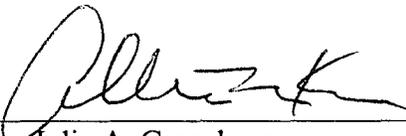
WHEREFORE, the Opposer prays that the application Serial No. 75-898,707 be rejected, that no notice of allowance or registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer. Opposer hereby gives notice that after hearing and in any appeal on this opposition proceeding, it will rely on its exhibits annexed to this notice of opposition as evidence in support of this notice of opposition.

A check in the amount of \$300 is enclosed to cover the filing fee for this opposition.

Opposer hereby appoints the attorneys of Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C., a law firm having a place of business at 280 N. Old Woodward, Suite 400, Birmingham, MI 48009, to act as attorneys for Opposer herein, with full power to prosecute said opposition, to transact all relative business in the United States Patent and Trademark Office and in the United States courts, and to receive all official communications in connection with this opposition.

Respectfully submitted,

KAREN SHINDOA

By: 

Julie A. Greenberg

Allen M. Krass

GIFFORD, KRASS, GROH, SPRINKLE,
ANDERSON & CITKOWSKI, P.C.

280 N. Old Woodward, Suite 400

Birmingham, MI 48009

(248) 647-6000

Attorneys for Opposer

Dated: August 22, 2002

APRIL 30, 2002

APRIL 30, 2002

U.S. PATENT AND TRADEMARK OFFICE

TM 389

LAYMONT, DE. FILED

CLASS 12—(Continued).

SN 75-656,367. HALIBRAND ENGINEERING, WELLINGTON, K.S. FILED 3-8-1999.

CLASS 12—(Continued).

SN 75-898,707. AMERICAN EAGLE WHEEL CORPORATION, CHINO, CA. FILED 1-21-2000.

RD

KIDNEY BEAN

BOSS
MOTOR SPORTS

ELECTRIC LIGHTING (1 AND 34).

SEC. 2(F).
FOR AUTOMOBILE WHEELS AND REPLACEMENT PARTS THEREFOR (U.S. CLS. 19, 21, 23, 31, 35 AND 44).
FIRST USE 0-0-1953; IN COMMERCE 0-0-1953.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MOTOR SPORTS", APART FROM THE MARK AS SHOWN.
FOR WHEEL RIMS AND PARTS THEREOF, NAMELY, FASTENERS AND HUB CAPS FOR USE WITH AUTOMOBILES AND MOTORCYCLES (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

PANY, DEARBORN, MI.

SN 75-766,238. CEAT LIMITED, WORLI, MUMBAI 400025, INDIA. FILED 8-2-1999.

SN 75-913,121. CADILLAC PRODUCTS AUTOMOTIVE COMPANY, TROY, MI. FILED 2-3-2000.

UNTAINEER

ALтура

2,001,735, 2,257,429 AND

MELY, AUTOMOBILES, CITY VEHICLES, AND AND ENGINES (U.S.



SoundLucent

PANY, DEARBORN, MI.

THE ENGLISH TRANSLATION OF "ALтура" IS "HEIGHT, ALTITUDE AND LATITUDE".
FOR PNEUMATIC TIRES; INNER TUBES FOR VEHICLE TIRES; AND MUD GUARDS FOR LAND VEHICLES (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FOR TRANSLUCENT SOUND DEADENING/ABSORBING INSULATING MATERIAL, NAMELY, WATER SHIELDS AND ACOUSTIC PANELS USED WITHIN OR PART OF THE CONSTRUCTION OF MOTOR VEHICLES (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

MONTEREY

SN 75-793,557. DAIMLERCHRYSLER AG, 70567 STUTTGART, FED REP GERMANY, FILED 9-7-1999.

SN 76-069,389. KONIG S.P.A., 23847 MOLTENO, ITALY. FILED 6-13-2000.

2,001,735, 2,257,429 AND

MELY, AUTOMOBILES, CITY VEHICLES, AND AND ENGINES (U.S.

ST



& RUBBER COMPANY.

PRIORITY CLAIMED UNDER SEC. 44(D) ON FED REP GERMANY APPLICATION NO. 39929132.6/1, FILED 5-20-1999, REG. NO. 39929132, DATED 8-23-1999, EXPIRES 5-31-2009.
FOR AUTOMOBILES AND STRUCTURAL PARTS THEREFOR (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

OWNER OF U.S. REG. NO. 1,357,929.
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE THE GENERALLY CIRCULAR CHAIN, APART FROM THE MARK AS SHOWN.
THE ENGLISH TRANSLATION OF THE WORD "KONIG" IN THE MARK IS "KING".
FOR ANTI-SKID TIRE CHAINS (U.S. CLS. 19, 21, 23, 31, 35 AND 44).



SN 75-870,847. GRANDBANKS YACHTS PTE LTD, SINGAPORE, FILED 12-10-1999.

SN 76-074,676. AUSTAL LIMITED, WESTERN AUSTRALIA 6166, AUSTRALIA, FILED 6-21-2000.

EUROPA

OCEANFAST

1,476,767 AND 1,224,145.
THE EXCLUSIVE RIGHT TO THE MARK AS SHOWN.
THE ITALIAN WORD MEANS "OR ROUTE".
FOR PLEASURE BOATS (U.S. CLS. 19, 21, 23, 31, 35 AND 44).
MERCER 2-26-1997.

OWNER OF U.S. REG. NO. 1,142,443.
THE ENGLISH TRANSLATION OF THE WORD "EUROPA" IN THE MARK IS "EUROPE".
SEC. 2(F).
FOR PLEASURE BOATS (U.S. CLS. 19, 21, 23, 31, 35 AND 44).
FIRST USE 3-10-1979; IN COMMERCE 3-10-1979.

PRIORITY CLAIMED UNDER SEC. 44(D) ON AUSTRALIA APPLICATION NO. 818273, FILED 12-22-1999, REG. NO. 818273, DATED 12-22-1999, EXPIRES 12-22-2009.
FOR SHIPS AND BOATS (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

EXHIBIT

tabbles

A

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

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08-26-2002

U.S. Patent & TMOtc/TM Mail Rpt Dt. #11

TRANSMITTAL

BOX TTAB
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir:

Enclosed for filing with the Trademark Trial and Appeal Board is a Notice of Opposition, in duplicate, opposing registration of the mark "BOSS MOTOR SPORTS" of U.S. Serial No. 78-898,707, filed January 21, 2000.

Enclosed is a check in the amount of \$300 to cover the Opposition filing fee. The Commissioner is hereby authorized to charge any deficiencies in fees during the Opposition

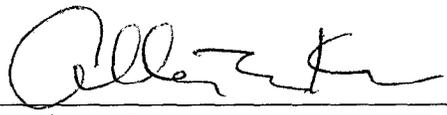
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TRADEMARK TRIAL AND APPEAL BOARD

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

proceeding to Deposit Account No. 07-1180. A duplicate of this Transmittal is enclosed for that purpose.

Respectfully submitted,

KAREN SHINODA

By: 

Julie A. Greenberg
Allen M. Krass
GIFFORD, KRASS, GROH, SPRINKLE,
ANDERSON & CITKOWSKI, P.C.
280 N. Old Woodward, Suite 400
Birmingham, MI 48009
(248) 647-6000

Attorneys for Opposer

Dated: August 22, 2002

GIFFORD, KRASS, GROH, SPRINKLE, ANDERSON & CITKOWSKI, P.C. 280 N. OLD WOODWARD AVENUE, STE. 400, BIRMINGHAM, MICHIGAN 48009-5394 (248) 647-6000

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Applicant.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that the attached correspondence comprising:

Transmittal (in duplicate)
Notice of Opposition (in duplicate)
\$300 filing fee
postcard

is being deposited with the United States Postal Service as first class mail on August 22, 2002 in an envelope addressed to:

Box TTAB
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513



Teresa L. Tomayko