

ESTTA Tracking number: **ESTTA394705**

Filing date: **02/23/2011**

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	BASF Corporation
Granted to Date of previous extension	02/23/2011
Address	100 Campus Drive Florham Park, NJ 07932 UNITED STATES
Attorney information	James D. Weinberger Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza 6th Floor New York, NY 10017 UNITED STATES jweinberger@frosszelnick.com, gwoo@frosszelnick.com Phone:(212) 813-5900

Applicant Information

Application No	76695694	Publication date	10/26/2010
Opposition Filing Date	02/23/2011	Opposition Period Ends	02/23/2011
Applicant	Hi-Gear Products, Inc. 14 Brent Drive Hudson, MA 01749 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 001. All goods and services in the class are opposed, namely: Automotive products and accessories for the automotive after market industry, namely, brake fluid, transmission fluid, power steering fluid, chemical additives to motor fuel, chemical additives for gas treatment, radiator flush preparation, automobile cooling system rust inhibitor, automobile engine cooling system leak sealant, antifreeze coolant for vehicle engines, adhesives for use in the automobile industry, lock de-icing fluid, anti-knock substances for internal combustion engines</p>
<p>Class 003. All goods and services in the class are opposed, namely: Surface care products for land and marine vehicles, namely, preparations for cleaning, conditioning, polishing, stain removing, waxing, protecting and preserving vehicle surfaces; cleaning preparations for engines and carburetors; windshield washer fluids</p>
<p>Class 004. All goods and services in the class are opposed, namely: Automotive products and accessories for the automotive after market industry, namely, industrial oils and greases, motor oil, non-chemical additives to motor-fuel, lubricating grease, all purpose lubricants</p>
<p>Class 021.</p>

All goods and services in the class are opposed, namely: Cleaning products for household use and for use on the interior and exterior surfaces of land and marine vehicles, namely, cleaning, drying, dusting and polishing cloths, wiping cloths, namely, chamois made from natural and synthetic materials, pads for applying waxes and polishes to vehicles, cleaning pads, polishing cloth for buffing and polishing vehicles, cleaning sponges, squeegees, hose nozzle sprayers, and scrubbing brushes

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. Registration No.	3373712	Application Date	04/02/2007
Registration Date	01/22/2008	Foreign Priority Date	NONE
Word Mark	ONYX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 002. First use: First Use: 1994/00/00 First Use In Commerce: 2007/07/00 Automotive refinish paints		

Attachments	77146264#TMSN.jpeg (1 page)(bytes) F0756077.pdf (9 pages)(55792 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/s/ James D. Weinberger
Name	James D. Weinberger
Date	02/23/2011

4. As a result of Opposer's investment of time, money and effort, the ONYX mark has come to be recognized as identifying goods finding their origin exclusively in or otherwise associated with Opposer, and represents a substantial goodwill of Opposer.

5. Opposer owns U.S. Registration No. 3,373,712, registered on January 22, 2008 for ONYX for "Automotive refinish paints" in International Class 2 based on the aforementioned first use date of July 2007. A true and correct TARR printout reflecting Registration No. 3,373,712 is attached hereto as **Exhibit A**.

6. Upon information and belief, Applicant is a Delaware corporation with an address at 14 Brent Drive, Hudson, Massachusetts 01749.

7. On or about February 9, 2009, Applicant filed an application to register the mark ONYX for the following goods:

- "Automotive products and accessories for the automotive after market industry, namely, brake fluid, transmission fluid, power steering fluid, chemical additives to motor fuel, chemical additives for gas treatment, radiator flush preparation, automobile cooling system rust inhibitor, automobile engine cooling system leak sealant, antifreeze coolant for vehicle engines, adhesives for use in the automobile industry, lock de-icing fluid, anti-knock substances for internal combustion engines" in Int. Cl. 1;
- "Surface care products for land and marine vehicles, namely, preparations for cleaning, conditioning, polishing, stain removing, waxing, protecting and preserving vehicle surfaces; cleaning preparations for engines and carburetors; windshield washer fluids" in Int. Cl. 3;
- "Automotive products and accessories for the automotive after market industry, namely, industrial oils and greases, motor oil, non-chemical additives to motor-fuel, lubricating grease, all purpose lubricants" in Int. Cl. 4; and
- "Cleaning products for household use and for use on the interior and exterior surfaces of land and marine vehicles, namely, cleaning, drying, dusting and polishing cloths, wiping cloths, namely, chamois made from natural and synthetic materials, pads for applying waxes and polishes to vehicles, cleaning pads, polishing cloth for buffing and polishing vehicles, cleaning sponges, squeegees, hose nozzle sprayers, and scrubbing brushes" in Int. Cl. 21,

all based on an intent to use under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b).

8. The application filing date, the earliest date upon which Applicant can rely, is subsequent to Opposer's first use and registration of ONYX for automotive paints in the United States.

9. Applicant's ONYX mark is identical to Opposer's ONYX mark in appearance, sound and meaning.

10. The goods set forth in the Application are identical or closely related to the goods in connection with which Opposer uses and has registered its ONYX mark.

11. On information and belief, Applicant targets the same type of consumers that purchase Opposer's ONYX automotive products or to whom Opposer markets and promotes such products.

12. Based on the similarities of the parties' respective marks and goods, the public is likely to falsely associate the goods of Applicant under the ONYX mark with Opposer or with Opposer's goods; or to falsely believe that Applicant's products emanate from or are sponsored, endorsed or licensed by Opposer; or to falsely believe that there is some relationship between Applicant and Opposer.

13. Applicant's Application and the presumption of exclusivity that would arise from a registration to Applicant of the ONYX mark are inconsistent with the prior rights of Opposer in the ONYX mark and the rights of Opposer flowing from its own federal trademark registration.

14. Use and registration of the ONYX mark by Applicant is likely to cause confusion, cause mistake or deceive consumers, and cause them to believe that the goods offered under Applicant's ONYX mark emanate from, or are sponsored by, endorsed by or otherwise connected with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

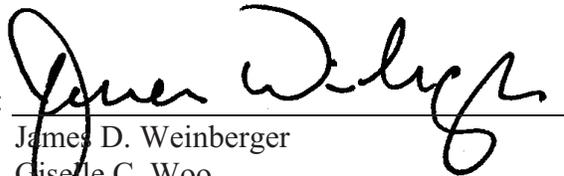
15. Opposer will be damaged by the registration of Applicant's ONYX mark by reason of the foregoing, and because it would give color of right therein to Applicant inconsistent with Opposer's prior rights.

WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 76/695,694 be denied.

Respectfully submitted,

Dated: New York, New York
February 23, 2011

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
James D. Weinberger
Giselle C. Woo

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Attorneys for Opposer

EXHIBIT A

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2011-02-23 14:17:09 ET

Serial Number: 77146264 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3373712

Mark

ONYX

(words only): [ONYX](#)

Standard Character claim: [Yes](#)

Current Status: [Registered](#). The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: [2008-01-22](#)

Filing Date: [2007-04-02](#)

Transformed into a National Application: [No](#)

Registration Date: [2008-01-22](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 114](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [650 -Publication And Issue Section](#)

Date In Location: [2007-12-14](#)

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [BASF Corporation](#)

Address:

BASF Corporation
100 Campus Drive
Florham Park, NJ 07932
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 002

Class Status: Active

Automotive refinish paints

Basis: 1(a)

First Use Date: 1994-00-00

First Use in Commerce Date: 2007-07-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2008-01-22 - Registered - Principal Register

2007-12-14 - Law Office Registration Review Completed

2007-12-10 - Allowed for Registration - Principal Register (SOU accepted)

2007-12-10 - Statement Of Use Processing Complete

2007-11-20 - Use Amendment Filed

2007-11-20 - TEAS Statement of Use Received

2007-11-13 - NOA Mailed - SOU Required From Applicant

2007-08-21 - Published for opposition

2007-08-01 - Notice of publication

2007-07-17 - Law Office Publication Review Completed

2007-07-17 - Assigned To LIE

2007-07-16 - Approved For Pub - Principal Register

2007-07-16 - Assigned To Examiner

2007-05-10 - Applicant amendment prior to exam entered

2007-05-10 - Assigned To LIE

2007-04-18 - TEAS Voluntary Amendment Received

2007-04-05 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Joyce M. Ferraro

Correspondent

JOYCE M. FERRARO

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

866 UNITED NATIONS PLZ

NEW YORK, NY 10017-1822

Phone Number: (212) 813-5900

CERTIFICATE OF SERVICE

I hereby certify that I have caused a copy of the foregoing Notice of Opposition to be sent by prepaid first-class mail to counsel for Applicant, LAWRENCE G. FRIDMAN, SILBER & FRIDMAN, 1037 ROUTE 46, CLIFTON, NJ 07013-2451 on this 23rd day of February, 2011.


James D. Weinberger