

ESTTA Tracking number: **ESTTA464122**

Filing date: **03/27/2012**

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	Kia Motors America, Inc.		
Entity	Corporation	Citizenship	California
Address	111 Peters Canyon Road Irvine, CA 92606 UNITED STATES		

Attorney information	David N. Makous Lewis Brisbois Bisgaard & Smith LLP Suite 1200 221 North Figueroa Street Los Angeles, CA 90012 UNITED STATES makous@lbbslaw.com, rcollins@lbbslaw.com, tespinoza@lbbslaw.com Phone:213 250 1800
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Applicant Information

Application No	85246618	Publication date	03/06/2012
Opposition Filing Date	03/27/2012	Opposition Period Ends	04/05/2012
Applicant	Textron Inc. 40 Westminster Street Providence, RI 02903 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 007. All goods and services in the class are opposed, namely: After market parts and accessories for land vehicles, namely, high-performance replacement and upgrade-level power train components, namely, engine parts, namely, air filters, oil filters, spark plugs, head gaskets, intake and exhaust valves, pistons, spark plug wires, crankshafts, piston rings, cams, carburetors, fuel pumps, fuel filters and timing belts</p>
<p>Class 009. All goods and services in the class are opposed, namely: Aftermarket parts and accessories for vehicles, namely, high-performance replacement and upgrade-level radios for land vehicles, MP3 players for land vehicles, Global positioning systems (GPS) for land vehicles, and electronic speed controllers</p>
<p>Class 012. All goods and services in the class are opposed, namely: After market parts and accessories for vehicles, namely, motors, high-performance replacement and upgrade-level wheels, tires, steering wheels, cabs, enclosures, namely, soft fabric tops with metal frames for vehicles, axles, differentials and suspension components, namely, shock absorbers, springs and lift kits primarily consisting of leaf springs, shackle mounts, axles and spindles, all for increasing vehicle ground clearance, brush guards, step bars for facilitating vehicle access, and light kits primarily consisting of headlights, taillights, auxiliary decorative lighting and wire harnesses; all for gasoline and electric-powered on-</p>

road and off-road land vehicles, light-transportation vehicles and low-speed vehicles used as personal residential and neighborhood vehicles, plant personnel carriers, general utility and maintenance cars, motel and resort cars, baggage carriers, golf cars, turf maintenance vehicles and trailers, sold through specialty power sports equipment retailers for such vehicles, parts and accessories; Structural parts for gasoline and electric-powered automobiles

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3289296	Application Date	02/17/2004
Registration Date	09/11/2007	Foreign Priority Date	NONE
Word Mark	KIA OPTIMA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 012. First use: First Use: 2000/11/00 First Use In Commerce: 2000/11/00 Land motor vehicles, namely, automobiles sold through an authorized KIA dealer		

Attachments	76575486#TMSN.gif (1 page)(bytes) KIA Motors Opposition to Textron Application.pdf (4 pages)(703300 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	/David N. Makous/
Name	David N. Makous
Date	03/27/2012

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

Serial No.: 85-246618
Mark: OPTIMA
Filed: February 18, 2011
Classes: 7, 9, 12
Published: March 6, 2012
Applicant: Textron, Inc.

KIA MOTORS AMERICA, INC.
NOTICE OF OPPOSITION

- A. TEXTRON, Inc. has applied for registration for the mark OPTIMA in connection with after market parts and accessories for vehicles in International Class Nos. 7, 9, and 12, Serial No. 85-246618 published in the Official Gazette for opposition on March 6, 2012.
- B. Kia Motors America, Inc. ("KMA") is a California corporation, with its principal place of business in Irvine, California and believes that it will be damaged by registration of the above designated mark and hereby opposes it.
- C. KMA is the exclusive distributor for products manufactured by or for Kia Motors Corporation ("KMC") or under license from KMC for sale and distribution in the United States including the KIA branded vehicles and parts which are widely advertised and sold in association with the KIA brand through the authorized KIA dealership network.
- D. KMA has distributed for sale through its United States dealership network Kia branded vehicles and parts since at least 1994, and OPTIMA branded vehicles since at least 2000 in the United States. For 16 consecutive years Kia's overall market share has increased in the USA, and throughout this period, KMA and its authorized dealers have sold over three million new KIA vehicles totaling in excess of seventy billion dollars in retail sales. The OPTIMA brand has accounted for more than 450,000 of the new KIA vehicles sold, totaling more than ten billion in retail sales since 2000.
- E. KMA has widely promoted and advertised OPTIMA branded vehicles since 2000. KMA's dealers also have conducted their own advertisements in traditional and online environments in association with their own local markets since 2000.
- F. In 2010, Kia vehicle production commenced in the United States at the new Kia Motors Manufacturing Georgia (KMMG) assembly plant in West Point, Georgia. Since 2011,

OPTIMA vehicles have been produced by the KMMG plant and distributed and sold by KMA through its authorized Kia dealer network.

- G. KMA has been the official partner of the NBA for many years and has advertised Kia products, including OPTIMA, on selected national and regional broadcasts of NBA games. In 2011 and 2012, KMA featured the Kia OPTIMA in its commercials on the widely watched annual NFL Super Bowl broadcast. KMA has won multiple awards for the quality and effectiveness of its advertising including the Gold Effie (short for 'effective') award in 2002 and 2011 and the Silver Effie Award in 2010 given by Effie Worldwide, Inc. for the most effective marketing communications in the US. KMA also received the Nielsen Most Effective Auto Ad of the Year Award for 2010 and 2011, as rated by Nielsen's panel of 2.5 million viewers.
- H. OPTIMA is among KMA's most widely acclaimed and successful brands. Examples of awards recently received by the OPTIMA brand include: Autobyte's "2012 Sedan of the Year"; Insurance Institute for Highway Safety (IIHS) "2012 Top Safety Pick"; Consumers Digest "2012 Best Buy"; Kiplinger's Personal Finance "2012 Best New Car Value Award"; The Boston Globe "Top Drives for 2012" list; Cars.com "Best of 2011" Award; iF "Product Design Award 2011"; and Auto A Fondo "Top 10 Best Car Buys for 2011".
- I. KMA is the owner of the U.S. Trademark Registration No. 3289296 for KIA OPTIMA, registered September 11, 2007 for passenger land motor vehicles, namely automobiles sold through an authorized KIA dealer, in International Classes 12 in the United States Patent and Trademark Office.
- J. The Opposer's trademarks KIA OPTIMA and OPTIMA are distinctive and famous and were distinctive and famous at the time of Applicant's filing of its application.
- K. Applicant is not entitled to registration of the OPTIMA mark because:
 - 1. Applicant's OPTIMA mark consists of or comprises a mark which so resembles Opposers' marks KIA OPTIMA and OPTIMA as to be likely to cause confusion, mistake, or to deceive (15 U.S.C. § 1052 (d)); and
 - 2. Applicant's OPTIMA mark is likely to cause dilution by blurring or tarnishment under 15 U.S.C. 1052(f), 1063(a) and 1125(c).

Therefore, Opposers request that registration of the subject mark be refused.

Respectfully submitted,
LEWIS BRISBOIS BISGAARD & SMITH LLP

Dated: March 27, 2012

By: 
David N. Makous
Robert M. Collins
Attorneys for Opposers

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CALIFORNIA STATE COURT PROOF OF SERVICE

Opposition to OPTIMA – S/N 85/246,618 - File No. 21762-836

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

At the time of service, I was over 18 years of age and not a party to the action. My business address is 221 North Figueroa Street, Suite 1200, Los Angeles, CA 90012.

On March 27, 2012, I served the following document(s): **NOTICE OF OPPOSITION BY KIA MOTORS AMERICA, INC.** on all interested parties in this action by placing [X] a true copy [] the original thereof enclosed in sealed envelopes addressed as follows:

the documents on the following persons at the following addresses (including fax numbers and e-mail addresses, if applicable):

Garret C. Donley
Harness, Dickey & Pierce, P.L.C.
5445 Corporate Drive, Suite 200
Troy, MI 48098-2683

The documents were served by the following means:

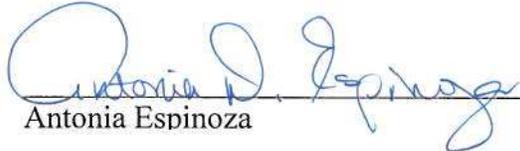
(BY U.S. MAIL) I enclosed the documents in a sealed envelope or package addressed to the persons at the addresses listed above and (specify one):

Deposited the sealed envelope or package with the U.S. Postal Service, with the postage fully prepaid.

Placed the envelope or package for collection and mailing, following our ordinary business practices. I am readily familiar with the firm's practice for collection and processing correspondence for mailing. Under that practice, on the same day that correspondence is placed for collection and mailing, it is deposited in the ordinary course of business with the U.S. Postal Service, in a sealed envelope of package with the postage fully prepaid.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Executed on March 27, 2012, at Los Angeles, California.



Antonia Espinoza