

ESTTA Tracking number: **ESTTA535037**

Filing date: **04/29/2013**

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	MOON EYES USA, INC.		
Entity	Corporation	Citizenship	California
Address	10820 S. Norwalk Blvd. Santa Fe Springs, CA 90670 UNITED STATES		

Attorney information	Shaun P. Lee Christie, Parker & Hale, LLP P.O. Box 29001 Glendale, CA 91209 UNITED STATES pto@cph.com Phone:626 795-9900		
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### Applicant Information

Application No	85778645	Publication date	04/02/2013
Opposition Filing Date	04/29/2013	Opposition Period Ends	05/02/2013
Applicant	Marocco, R. Andrew 1440 Beaumont Ave. Suite A2, PMB # 122 Beaumont, CA 92223 UNITED STATES		

### Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Automobile and car wax preparations; Automobile carpet and upholstery cleaning preparations; Automobile cleaners; Automobile polishes; Automobile tire cleaning and polishing preparations; Automobile wax; Automobile, tire, glass and wheel cleaning preparations; Kits for removing scratches from automotive finishes and metal trims comprised of buffing compound for automobiles and also including wool buffing pads; Leather cleaning preparations; Rubber dressings; Tire dressings
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### Grounds for Opposition

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

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	871228	Application Date	03/27/1967
Registration Date	06/17/1969	Foreign Priority Date	NONE

Word Mark	MOON EQUIPPED
Design Mark	
Description of Mark	NONE
Goods/Services	Class U023 (International Class 006, 007, 008, 009, 011, 012, 016, 021, 028). First use: First Use: 1951/00/00 First Use In Commerce: 1951/00/00 PARTS FOR AUTOMOBILES AND BOATS-NAMELY, FUEL TANK CAP AND PRESSURE PUMP ASSEMBLIES; CARBURETOR AIR SCOOPS; BREATHERS; ENGINE COVERS; GEAR SHIFT MOUNTS; CAMS; CARBURETOR LINKAGES; FLY WHEEL SCATTER SHIELDS; INTAKE MANIFOLDS AND SUPERCHARGER KITS

U.S. Registration No.	1819742	Application Date	03/29/1993
Registration Date	02/08/1994	Foreign Priority Date	NONE
Word Mark	MOON EQUIPPED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1992/05/29 First Use In Commerce: 1992/05/29 gauges, meters and tachometers for motor vehicle instrument panels		

U.S. Registration No.	1808948	Application Date	03/01/1993
Registration Date	12/07/1993	Foreign Priority Date	NONE
Word Mark	MOON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1992/05/29 First Use In Commerce: 1992/05/29 dashboard gauges and meters for automobiles and motorcycles, and tachometers		

U.S. Registration No.	2069997	Application Date	08/19/1996
Registration Date	06/10/1997	Foreign Priority Date	NONE
Word Mark	MOONEYES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1994/01/00 First Use In Commerce: 1994/01/00 gauges, meters, and tachometers for motor vehicle instrument panels; protective or safety helmets		

Attachments	M829-110-2-3_NTC-OF-OPPOSITION.PDF ( 7 pages )(179810 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	/Shaun Lee/
Name	Shaun P. Lee
Date	04/29/2013

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

In the matter of trademark application **Serial No. 85778645**  
For the mark MOON  
Published in the Trademark *Official Gazette* on April 2, 2013

MOON EYES USA, Inc.	Opposer,	Opposition No.
v.		NOTICE OF OPPOSITION
R. Andrew Marocco	Applicant.	

MOON EYES USA, Inc., a California corporation whose address is 10820 S. Norwalk Blvd., Santa Fe Springs, California 90670, believes that it will be damaged by registration of the mark shown in application Serial No. **85778645** in International Class 003 and hereby opposes its registration.

As grounds for opposition, Opposer alleges that:

1. Applicant R. Andrew Marocco seeks to register MOON as a trademark for Automobile and car wax preparations; Automobile carpet and upholstery cleaning preparations; Automobile cleaners; Automobile polishes; Automobile tire cleaning and polishing preparations; Automobile wax; Automobile, tire, glass and wheel cleaning preparations; Kits for removing scratches from automotive finishes and metal trims comprised of buffing compound for automobiles and also including wool buffing pads; Leather cleaning preparations; Rubber dressings; Tire dressings, in International Class 003, claiming a bona fide intention to use the

mark, as evidenced by the publication of Serial No. 85778645 in the April 2, 2013 issue of the *Official Gazette*.

2. Opposer, through predecessors and related companies (hereinafter “Opposer”), has been in and is now engaged in the manufacture and sale of automobile and motorcycle parts and accessories, including clothing, stickers, and decals.

3. Since prior to Applicant’s priority date, Opposer has been and remains the owner of U.S. Registration No. 0871228 of the mark MOON EQUIPPED and Design, issued June 17, 1969 in Classes 6, 7, 8, 9, 11, 12, 16, 21, and 28 for parts for automobiles and boats-namely, fuel tank cap and pressure pump assemblies; carburetor air scoops; breathers; engine covers; gear shift mounts; cams; carburetor linkages; fly wheel scatter shields; intake manifolds and supercharger kits. Said registration of the mark MOON EQUIPPED is valid, subsisting, and incontestable.

4. Since prior to Applicant’s priority date, Opposer has been and remains the owner of U.S. Registration No. 1819742 of the mark MOON EQUIPPED and Design, issued February 8, 1994 in Class 9 for gauges, meters and tachometers for motor vehicle instrument panels. Said registration of the mark MOON EQUIPPED is valid, subsisting, and incontestable.

5. Since prior to Applicant’s priority date, Opposer has been and remains the owner of U.S. Registration No. 1808948 of the mark MOON and Design, issued December 7, 1993 in Class 9 for dashboard gauges and meters for automobiles and motorcycles, and tachometers. Said registration of the mark MOON is valid, subsisting, and incontestable.

6. Since prior to Applicant’s priority date, Opposer has been and remains the owner of U.S. Registration No. 2069997 of the mark MOONEYES, issued June 10, 1997 in Class 9 for gauges, meters, and tachometers for motor vehicle instrument panels; protective or safety helmets. Said registration of the mark MOONEYES is valid, subsisting, and incontestable.

7. Since prior to the Applicant’s priority date, Opposer has continuously and extensively used in commerce the trade names and/or marks MOON, MOONEYES, and MOON EQUIPPED (“the MOON Marks”), alone and in combination with other terms and designs, in

connection with automobile and motorcycle parts and accessories, including clothing, stickers, and decals. As a result of such use and the advertising and promotion of such goods, the MOON Marks have acquired valuable goodwill and reputation in the United states identifying Opposer as the source of such goods and has developed federal common law rights in the mark, which would be jeopardized by Applicant's use and registration of MOON.

8. The goods for which Applicant seeks to register the mark MOON are closely related to Opposer's goods sold under the MOON Marks since before Applicant's priority date.

9. The mark MOON, which Applicant seeks to register, so resembles Opposer's MOON Marks previously used and registered by Opposer and not abandoned, as to be likely, when used in connection with the goods of Applicant, to cause confusion, or to cause mistake, or to deceive.

10. Applicant is aware of the MOON Marks and Applicant understands that the relevant consuming public would likely believe that automotive car care products labeled or sold in connection with the MOON Marks originated from the Opposer and/or the Opposer's authorized licensee(s). This is evidenced by Applicant's November 20, 2012 letter to Opposer (Exhibit A) in which Applicant proposes licensing the MOON Marks from the Opposer for use with "automotive car care products." Opposer has not granted a license to Applicant.

11. Opposer would be damaged by the issuance to Applicant of a registration of the mark MOON for the goods set forth in Applicant's application Serial No. 85778645.

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**Docket No. 110.2\*3/M829**

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THEREFORE, Opposer requests that this opposition be sustained and that application Serial No. **85778645** be refused registration.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

Date 4/29/13

By Shaun Lee  
Shaun P. Lee  
Attorneys for Opposer  
P.O. Box 29001  
Glendale, California 91209-9001  
626/795-9900

**CERTIFICATE OF TRANSMISSION AND SERVICE**

I certify that on April 29, 2013, the foregoing **NOTICE OF OPPOSITION** is being electronically transmitted for filing to the:

Commissioner for Trademarks  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

I certify that on April 29, 2013, the foregoing **NOTICE OF OPPOSITION** is being served by mailing a copy thereof by first-class mail addressed to:

R. Andrew Marocco  
1440 Beaumont Ave., Suite A2  
PMB #122  
Beaumont, CA 92223

By   
\_\_\_\_\_  
Marti Carrillo  
Christie, Parker & Hale, LLP  
P.O. Box 29001  
Glendale, California 91209-9001  
626/795-9900

AW/spl

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# **EXHIBIT A**



**November 20, 2012**

MOONEYES USA, Inc.  
Att: Chico Kodama, President  
10820 S Norwalk Blvd.  
Santa Fe Springs, CA 90670

Dear Mr. Kodama,

Thank you for taking the time to speak to me the other day, via the telephone. During that conversation, I asked what the protocol was in attaining the use of the Mooneyes' logo for a product line that I would like to bring to market. You stated that I needed to send in a proposal of what I wanted to use the Mooneyes' logo for, so that you could forward my proposal to the decision makers in Japan.

Here is my proposal;

**Brand Licensing of MOONEYES' logo for Car Care Product Line**

My company, known as *Route 66 Speed Shop (Marocco Motorsport, LLC)* would like to attain a "License" to use the Mooneyes logo for a new product line of automotive car care products under the "MOON" brand name. The proposed product line ranges from the creation of waxes, detailers, and polishes to octane boosters and fuel injection cleaners.

With MOON's 60+ year history in hot rodding, drag racing, and custom car culture, it would only be natural to expand the "MOON" brand into the Car Wax and the Chemical Performance Industries.

We are very excited about the potential of "MOON" expanding its brand and we would like to play a key part in its creation, development, and marketing.

Please let me know when we could meet and discuss my proposal in more detail. I look forward to your interest and reply.

Sincerely,  
Andy Marocco, President  
Route 66 Speed Shop/ Marocco Motorsport, LLC

Cell: (909) 374-2219  
Office: (406) 551-4371  
Email: route66speed@yahoo.com