

ESTTA Tracking number: **ESTTA546683**

Filing date: **07/03/2013**

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	Nissan Jidosha Kabushiki Kaisha TA Nissan Motor Co., Ltd.
Granted to Date of previous extension	07/17/2013
Address	No. 2 Takaracho Kanagawa-ku Yokohama-shi, Kanagawa-ken, 220 8623 JAPAN

Attorney information	Gary Krugman Sughrue Mion, PLLC 2100 Pennsylvania Ave NW Suite 800 Washington, DC 20037 UNITED STATES gkrugman@sughrue.com, mwhite@sughrue.com Phone:2026637484
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**Applicant Information**

Application No	85741041	Publication date	03/19/2013
Opposition Filing Date	07/03/2013	Opposition Period Ends	07/17/2013
Applicant	Engineerix 1037 Murray Street Berkeley, CA 94710 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: An electronic device for scanning and diagnosing electric and hybrid vehicles used to provide data and information for all mechanical and electrical functions of the vehicle
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**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.	4119976	Application Date	09/25/2009
Registration Date	04/03/2012	Foreign Priority Date	06/03/2009
Word Mark	LEAF		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 012. First use: Automobiles and structural parts therefor; electric automobiles and structural parts therefor

Attachments	H00167 Notice of Opposition (July 3, 2013) As Filed.PDF(296263 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	/Gary D. Krugman/
Name	Gary Krugman
Date	07/03/2013

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

In re the Matter of: Application Serial No. 85741041  
Mark Opposed: LEAFSCAN

Nissan Jidosha Kabushiki Kaisha t/a  
Nissan Motor Co., Ltd.

Opposer,

v.

Engineerix,

Applicant.

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposer, Nissan Jidosha Kabushiki Kaisha t/a Nissan Motor Co., Ltd., hereby opposes registration of the mark LEAFSCAN which is the subject of application Serial No. 85741041.

As grounds in support of this opposition, Opposer alleges as follows:

1. Opposer Nissan Jidosha Kabushiki Kaisha t/a Nissan Motor Co., Ltd. is a Japanese corporation with a business address of No. 2 Takaracho, Kanagawa-ku, Yokohama-shi, Kanagawa-ken, 220-8623, Japan.

2. Opposer is one of the largest manufacturers and sellers of automobiles and related automotive parts and accessories, throughout the United States and the world.

3. Opposer has adopted, used, is using and is the owner of the trademark LEAF in connection with automobiles, specifically, electric automobiles and structural parts for those vehicles. This use has been ongoing and continuous since at least as early as December, 2010, up to and including the present time.

4. Opposer is the owner of Trademark Registration No. 4119976, issued April 3, 2012, for the mark LEAF, for goods described as "automobiles and structural parts therefor; electric automobiles and structural parts therefor." This registration is valid, subsisting, un-revoked and un-cancelled and a copy of the registration, taken from the TSDR database of the U.S. Patent and Trademark Office, is attached hereto as Exhibit 1.

5. Applicant, on September 28, 2012, filed an application to register the mark LEAFSCAN for goods described as "An electronic device for scanning and diagnosing electric and hybrid vehicles used to provide data and information for all mechanical and electrical functions of the vehicle." This LEAFSCAN application was assigned Serial No. 85741041 and was filed based on Applicant's asserted *bona fide* intention to use the mark in commerce.

6. Upon information and belief, Applicant's LEAFSCAN product is a device to be used in connection with the monitoring of battery functions, temperature, horsepower, etc. in connection with electric vehicles, including and specifically directed to owners of Opposer's LEAF vehicles.

7. Applicant's use and registration of LEAFSCAN for its product will confuse, deceive or otherwise mislead consumers into believing that Applicant's LEAFSCAN device originates with, is associated with, is endorsed by or is otherwise affiliated with Opposer when such is not the case.

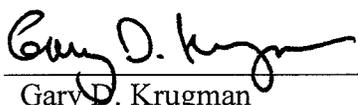
8. Applicant's mark LEAFSCAN so resembles Opposer's previously used and registered mark LEAF as to be likely, when used on or in connection with Applicant's goods, to result in confusion, mistake or deception for purposes of Section 2(d) of the Trademark.

WHEREFORE, it is respectfully requested that this opposition be sustained and that registration to Applicant be refused.

With this electronic submission, authorization is provided to debit a credit card of the undersigned in the amount of \$300 for the government filing fee in connection with this Notice of Opposition. Please charge any difference or credit any overpayment to the undersigned's Deposit Account No. 19-4880.

Respectfully submitted,

NISSAN JIDOSHA KABUSHIKI KAISHA t/a  
NISSAN MOTOR CO., LTD.

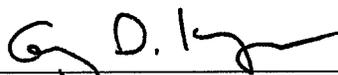
By:   
\_\_\_\_\_  
Gary D. Krugman  
Attorney for Opposer  
SUGHRUE MION, PLLC  
2100 Pennsylvania Avenue, N.W.  
Washington, DC 20037-3213  
T 202.293.7060  
F 202.293.7860

Enclosure: Certificate of Registration from TSDR Database

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** has been served on Applicant this 3<sup>rd</sup> day of July 2013 via first class mail, postage prepaid to:

Engineerix  
1037 Murray Street  
Berkeley, California 94710-2814



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Gary D. Krugman



## Attorney/Correspondence Information

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**Attorney of Record**  
**Docket Number:** W-09-0439  
**Attorney Email Authorized:** No

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**Correspondent e-mail Authorized:** No

**Domestic Representative - Not Found**

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## Prosecution History

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Date	Description	Proceeding Number
Apr. 03, 2012	REGISTERED-PRINCIPAL REGISTER	
Feb. 21, 2012	EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED	
Sep. 07, 2011	EXTENSION OF TIME TO OPPOSE RECEIVED	
Aug. 09, 2011	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 09, 2011	PUBLISHED FOR OPPOSITION	
Jul. 01, 2011	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
Jul. 01, 2011	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 28, 2011	TEAS/EMAIL CORRESPONDENCE ENTERED	77312
Jun. 28, 2011	CORRESPONDENCE RECEIVED IN LAW OFFICE	77312
Jun. 20, 2011	ASSIGNED TO LIE	77312
Jun. 15, 2011	TEAS RESPONSE TO SUSPENSION INQUIRY RECEIVED	
Dec. 15, 2010	NOTIFICATION OF INQUIRY AS TO SUSPENSION E-MAILED	
Dec. 15, 2010	INQUIRY TO SUSPENSION E-MAILED	
Dec. 15, 2010	SUSPENSION INQUIRY WRITTEN	86331
Aug. 04, 2010	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
Aug. 04, 2010	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Jun. 15, 2010	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Jun. 15, 2010	LETTER OF SUSPENSION E-MAILED	6332
Jun. 15, 2010	SUSPENSION LETTER WRITTEN	86331
Jan. 28, 2010	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jan. 28, 2010	NON-FINAL ACTION E-MAILED	6325
Jan. 28, 2010	NON-FINAL ACTION WRITTEN	86331
Jan. 22, 2010	ASSIGNED TO EXAMINER	86331
Jan. 11, 2010	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jan. 11, 2010	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jan. 11, 2010	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Dec. 01, 2009	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Dec. 01, 2009	NON-FINAL ACTION E-MAILED	6325
Dec. 01, 2009	NON-FINAL ACTION WRITTEN	75589
Dec. 01, 2009	ASSIGNED TO EXAMINER	75589
Sep. 29, 2009	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 29, 2009	NEW APPLICATION ENTERED IN TRAM	

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## TM Staff and Location Information

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TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Apr. 03, 2012

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## Proceedings

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**Summary**

Number of Proceedings: 1

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**Type of Proceeding: Extension of Time**

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Proceeding Number: 77834748

Filing Date: Sep 07, 2011

Status: Terminated

Status Date: Feb 21, 2012

Interlocutory Attorney:

**Defendant**

Name: Nissan Jidosha Kabushiki Kaisha

Correspondent Address: Micol Cecchi  
Nissan North America, Inc.  
P.O. Box 685001  
Franklin TN , 37068-5001

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
LEAF	Registered	<u>77834748</u>	<u>4119976</u>

**Potential Opposer(s)**

Name: Leaf Clean Energy Company

Correspondent Address: David L. May  
Nixon Peabody LLP  
401 Ninth Street NWSuite 900  
Washington DC , 20004  
UNITED STATES

Correspondent e-mail: [nptm@nixonpeabody.com](mailto:nptm@nixonpeabody.com), [was.managing.clerk@nixonpeabody.com](mailto:was.managing.clerk@nixonpeabody.com), [dmay@nixonpeabody.com](mailto:dmay@nixonpeabody.com), [jmolino@nixonpeabody.com](mailto:jmolino@nixonpeabody.com)

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Sep 07, 2011	
2	EXTENSION OF TIME GRANTED	Sep 07, 2011	
3	INCOMING - EXT TIME TO OPPOSE FILED	Nov 29, 2011	
4	EXTENSION OF TIME GRANTED	Nov 29, 2011	

**United States of America**  
United States Patent and Trademark Office

# LEAF

**Reg. No. 4,119,976**

**Registered Apr. 3, 2012**

**Int. Cl.: 12**

**TRADEMARK**

**PRINCIPAL REGISTER**

NISSAN JIDOSHA KABUSHIKI KAISHA (JAPAN CORPORATION), DBA NISSAN MOTOR CO., LTD.

NO. 2 TAKARACHO, KANAGAWA-KU  
YOKOHAMA-SHI, KANAGAWA, JAPAN 2208623

FOR: AUTOMOBILES AND STRUCTURAL PARTS THEREFOR; ELECTRIC AUTOMOBILES AND STRUCTURAL PARTS THEREFOR, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY CLAIMED UNDER SEC. 44(D) ON JAPAN APPLICATION NO. 2009-041096, FILED 6-3-2009, REG. NO. 5291843, DATED 1-8-2010, EXPIRES 1-8-2020.

SER. NO. 77-834,748, FILED 9-25-2009.

ANDREW LEASER, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***  
**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.\*  
See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***  
**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**