

TTAB



09-23-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #58

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

IN THE MATTER OF:  
Application Serial No. 76/364414  
Filed: January 30, 2002  
Published: July 2, 2002  
Trademark: MISCELLANEOUS DESIGN

Chevron U.S.A. Inc.

Opposer

v.

Nissan Chemical Industries, Ltd.

Applicant

NOTICE OF OPPOSITION

P. O. Box 6006  
San Ramon, CA 94583

02 OCT -3 AM 12:21  
TRADEMARK TRIAL AND  
APPEAL BOARD

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

Dear Sir or Madam:

Chevron U.S.A. Inc., a Pennsylvania corporation located and doing business at 575 Market Street, San Francisco, California 94105, believes it will be damaged by the registration of the MISCELLANEOUS DESIGN mark, Application Serial No. 76/364414 and opposes the same.

As grounds for opposition, it is alleged that:

1. For many years, Opposer continuously has used in interstate commerce its trademark "Star Design" as well as a family of marks incorporating the word STAR and/or a "star" image (collectively the "Star Marks") in

connection with the advertising, promotion, distribution and sale of a wide variety of chemicals for industrial use.

2. Opposer has obtained and owns the following registrations for the Star Marks, in International Class 1, in the United States Patent and Trademark Office, which registrations are valid, subsisting, and incontestable pursuant to 15 U.S.C. Sections 1065 and 1115(b):

<b>Trademark</b>	<b>Registration No.</b>	<b>Goods</b>
STAR T DESIGN III	1,844,002	Chemicals used in industry; namely, additives for petroleum products, amines, aromatics and derivatives, carbonates, glycols, intermediates, olefins, oxides, solvents, surface active agents and urethane chemicals.
T HAVOLINE (STAR T DESIGN III)	2,046,651	Antifreeze; coolants for vehicle engines
STARGUARD	1,889,103	Anti-freeze
STARTEX	694,092	Anti-freeze liquid

Applicant encloses herewith a USPTO TARR system printout for each of the above-listed trademarks.

3. Opposer has expended substantial amounts of money and resources in advertising and promoting the Star Marks in interstate commerce.
4. By virtue of Opposer's aforesaid extensive advertising, promotion and sales, Opposer's Star Marks have acquired substantial and valuable goodwill, which is owned by Opposer.

5. By virtue of the distinctiveness of Opposer's Star Marks, the duration and extent of use of the Star Marks in connection with Opposer's goods and services, the duration and extent of advertising and publicity of the Star Marks, the geographical extent of the trading area in which the Star Marks are used, the channels of trade for the goods and services with which the Star Marks are used, the degree of recognition of the Star Marks in the trading areas and channels of trade, and the nature and extent of use of the same or similar marks by third parties, Opposer's Star Marks are famous.
6. Use of the trademark for which registration is sought in the Application Serial No. 76/364414 opposed herein for the stated goods is likely to cause confusion, mistake or deception as to the source of origin, sponsorship or approval of Applicant's products in that purchasers or others are likely to believe that Applicant's products are Opposer's products or are in some way legitimately connected with, licensed or approved by Opposer.
7. Use of the trademark for which registration is sought in the Application Serial No. 76/364414 opposed herein for the stated goods is likely to and will dilute the distinctive quality of the Star Marks.
8. Opposer has not consented to any use by Applicant of the trademark for which registration is sought in the Application Serial No. 76/364414.

WHEREFORE, Opposer requests that this Notice of Opposition be sustained and that Applicant be denied registration.

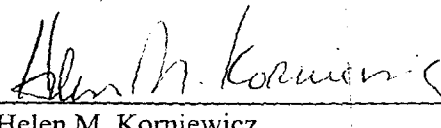
Please charge Opposer's USPTO Deposit Account No. 03-1627 (said account is in the name of ChevronTexaco Corporation) for the requisite fees for filing a Notice of Opposition in one class.

This Notice of Opposition is being filed in triplicate.

Please address all correspondence regarding this opposition to:

Helen M. Korniewicz,  
Attorney for Opposer  
ChevronTexaco Corporation  
Law Department  
P. O. Box 6006  
San Ramon, California 94583  
email: [helenkorniewicz@chevrontexaco.com](mailto:helenkorniewicz@chevrontexaco.com)  
Tel: (925) 973-4565  
Fax: (925) 973-4510

September 18, 2002

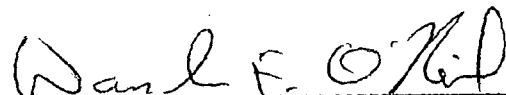
  
\_\_\_\_\_  
Helen M. Korniewicz  
Attorney for Opposer

CHEVRON U.S.A. INC.

CERTIFICATE OF MAILING

I certify that this correspondence is being deposited in triplicate with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on September 18, 2002.

September 18, 2002



Wanda F. O'Neil

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 09/16/2002 16:32:31 ET**

**Serial Number: 74402858**

**Registration Number: 1844002**

**Mark**



**(words only): T**

**Current Status:** Section 8 and 15 affidavits have been accepted and acknowledged.

**Date of Status:** 2000-10-11

**Filing Date:** 1993-06-18

**Registration Date:** 1994-07-12

**Law Office Assigned:** TMEO Law Office #13

**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](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 900 -Warehouse (Newington)

**Date In Location:** 2000-10-31

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**CURRENT APPLICANT(S)/OWNER(S)**

---

1. TEXACO INC.

**Address:**

TEXACO INC.  
2000 Westchester Avenue  
White Plains, NY 10650  
United States

**State or Country of Incorporation:** Delaware

**Legal Entity Type:** Corporation

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**GOODS AND/OR SERVICES**

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chemicals used in industry; namely, additives for petroleum products, amines, aromatics and derivatives, carbonates, glycols, intermediates, olefins, oxides, solvents, surface active agents and urethane chemicals

**International Class:** 001

**First Use Date:** 19811001

**First Use in Commerce Date:** 19811001

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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**Prior Registration Number(s):**

1361337

1506381

1604076

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**PROSECUTION HISTORY**

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2000-10-11 - Section 8 (6-year) accepted & Section 15 acknowledged

2000-07-10 - Section 8 (6-year) and Section 15 Filed

1994-07-12 - Registered - Principal Register

1994-04-19 - Published for opposition

1994-03-18 - Notice of publication

1994-01-25 - Approved for Pub - Principal Register (Initial exam)

1993-12-20 - Communication received from applicant

1993-11-03 - Non-final action mailed

1993-09-26 - Case file assigned to examining attorney

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**CONTACT INFORMATION**

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**Correspondent (Owner)**

MORRIS REINISCH (Attorney of record)

MORRIS REINISCH

TEXACO INC.

2000 WESTCHESTER AVENUE

WHITE PLAINS, NY 10650

United States





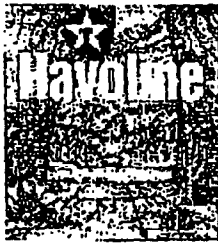
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 09/16/2002 16:33:49 ET

Serial Number: 75007424

Registration Number: 2046651

Mark



(words only): T HAVOLINE

Current Status: Registered.

Date of Status: 1997-03-18

Filing Date: 1995-10-18

Registration Date: 1997-03-18

Law Office Assigned: TMEG Law Office 105

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](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 900 -Warehouse (Newington)

Date In Location: 1999-06-30

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**CURRENT APPLICANT(S)/OWNER(S)**

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1. TEXACO INC.

**Address:**

TEXACO INC.  
2000 Westchester Avenue  
White Plains, NY 10650  
United States

**State or Country of Incorporation:** Delaware

**Legal Entity Type:** Corporation

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**GOODS AND/OR SERVICES**

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antifreeze; coolants for vehicle engines

**International Class:** 001~~25~~

**First Use Date:** 19951100

**First Use in Commerce Date:** 19951100

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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**Lining and Stippling:** The lining and stippling is for shading purposes only and does not indicate color.

**Prior Registration Number(s):**

61806

1222303

1222305

1315019

1316872

1844002

1865727

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**PROSECUTION HISTORY**

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1997-03-18 - Registered - Principal Register

1997-01-17 - Allowed for Registration - Principal Register (SOU accepted)

1997-01-17 - Case file assigned to examining attorney

1997-01-13 - Statement of use processing complete

1996-11-12 - Amendment to Use filed

1996-10-15 - Notice of allowance - mailed

1996-07-23 - Published for opposition

1996-06-21 - Notice of publication

1996-04-23 - Approved for Pub - Principal Register (Initial exam)

1996-04-16 - Case file assigned to examining attorney

1996-04-08 - Case file assigned to examining attorney

1996-04-05 - Case file assigned to examining attorney

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**CONTACT INFORMATION**

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**Correspondent (Owner)**  
Terri J. Frank (Attorney of record)

TERRI J. FRANK  
TEXACO INC  
2000 WESTCHESTER AVENUE  
WHITE PLAINS, NY 10650  
United States

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**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 09/16/2002 16:34:30 ET**

**Serial Number: 74395317**

**Registration Number: 1889103**

**Mark (words only): STAR GUARD**

**Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.**

**Date of Status: 2001-06-14**

**Filing Date: 1993-05-27**

**Registration Date: 1995-04-11**

**Law Office Assigned: TMEO Law Office #14**

**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: 900 -Warehouse (Newington)**

**Date In Location: 2001-06-18**

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**CURRENT APPLICANT(S)/OWNER(S)**

---

1. TEXACO INC.

**Address:**

TEXACO INC.  
2000 Westchester Avenue  
White Plains, NY 10650  
United States

**State or Country of Incorporation: Delaware**

**Legal Entity Type: Corporation**

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**GOODS AND/OR SERVICES**

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anti-freeze

**International Class: 001**

**First Use Date: 19930801**

**First Use in Commerce Date: 19930801**

**Basis: 1(a)**

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2001-06-14 - Section 8 (6-year) accepted & Section 15 acknowledged

2001-04-02 - Section 8 (6-year) and Section 15 Filed

1995-04-11 - Registered - Principal Register

1994-11-23 - Allowed for Registration - Principal Register (SOU accepted)

1994-10-19 - Case file assigned to examining attorney

1994-10-03 - Statement of use processing complete

1994-10-03 - Extension 1 granted

1994-08-15 - Amendment to Use filed

1994-08-15 - Extension 1 filed

1994-02-22 - Notice of allowance - mailed

1993-11-30 - Published for opposition

1993-10-29 - Notice of publication

1993-09-14 - Approved for Pub - Principal Register (Initial exam)

1993-09-07 - Case file assigned to examining attorney

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**CONTACT INFORMATION**

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**Correspondent (Owner)**

Terri J. Frank (Attorney of record)

TERRI J. FRANK  
TEXACO INC.  
2000 WESTCHESTER AVENUE  
WHITE PLAINS, NY 10650  
United States

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**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 09/16/2002 16:35:15 ET**

**Serial Number:** 72073160

**Registration Number:** 694092

**Mark (words only):** STARTEX

**Current Status:** This registration has been renewed.

**Date of Status:** 2000-11-09

**Filing Date:** 1959-05-07

**Registration Date:** 1960-03-08

**Law Office Assigned:** (NOT AVAILABLE)

**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](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 900 -Warehouse (Newington)

**Date In Location:** 2000-11-13

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**CURRENT APPLICANT(S)/OWNER(S)**

---

1. TEXACO INC.

**Address:**

TEXACO INC.  
2000 WESTCHESTER AVE  
WHITE PLAINS, NY 10650  
United States

**State or Country of Incorporation:** Delaware

**Legal Entity Type:** Corporation

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**GOODS AND/OR SERVICES**

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ANTI-FREEZE LIQUID

**U.S. Class:** 006 (International Class 001)

**First Use Date:** 19590317

**First Use in Commerce Date:** 19590403

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2000-11-09 - Registration renewed - 10 year

2000-11-09 - Section 8 (10-year) accepted/ Section 9 granted

2000-03-07 - Combined Section 8 (10-year)/Section 9 filed

1980-03-08 - Registration renewed - 20 year

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**CONTACT INFORMATION**

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**Correspondent (Owner)**

TERRI J FRANK (Attorney of record)

TERRI J FRANK  
TEXACO INC  
2000 WESTCHESTER AVE  
PURCHASE NY 10577-2530  
United States

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