03-31-2003
U.S. Patent & TMOfc/TM Mail Rcpt. Dt. #40

BOX TTAB – NO FEE
Docket No. 18607.0440

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application:

Serial No.: 76/378,718
Filed: March 6, 2002
Applicant: Robert J. Statho
Mark: LEXUS MATTRESS
For: Mattresses; box springs, pillows, and bed frames
Class: 20

Published in the *Official Gazette* of December 3, 2002

TOYOTA JIDOSHA KABUSHIKI KAISHA, ALSO DOING BUSINESS AS TOYOTA MOTOR CORPORATION and TOYOTA MOTOR SALES, U.S.A., INC. Opposers v. ROBERT J. STATHO Applicant	)	Opposition No. _____

NOTICE OF OPPOSITION

Toyota Jidosha Kabushiki Kaisha, also doing business as Toyota Motor Corporation, a Japanese corporation having its principal offices at 1, Toyota-cho, Toyota Aichi 471-8571, Japan ("TMC"), and Toyota Motor Sales, U.S.A., Inc., a California corporation having its principal offices at 19001 South Western Avenue, Torrance, California 90509 ("TMS"), believe that they will be damaged by registration of the mark shown in Application Serial No. 76/378,718 and hereby oppose same.

The grounds for the opposition are as follows:

(1) Application Serial No. 76/378,718 (the "opposed application") seeks to register the mark LEXUS MATTRESS for mattresses, box springs, pillows, and bed frames.

(2) The opposed application was filed on March 6, 2002 based on Applicant's claim of a bona fide intent to use the mark in commerce.

(3) Long prior to the filing date of March 6, 2002 of the opposed application, Opposers adopted, used and are still using the trade name LEXUS and the trademarks and service marks LEXUS and LEXUS & Design (collectively "LEXUS") in interstate commerce for automobiles, repair and maintenance services for automotive vehicles, automotive vehicle leasing services, financing the purchasing and leasing of automobiles, and a variety of automotive products and accessories.

(4) Opposer TMC is the owner of the trade name, trademark and service mark LEXUS. Opposer TMS is a wholly-owned subsidiary of TMC and is the exclusive importer and distributor of LEXUS automobiles throughout the United States except the State of Hawaii.

(5) Opposers are related companies within the meaning of § 5 of the Federal Trademark Act, 15 U.S.C. § 1055. Consequently, all use of the trade name, trademark and service mark LEXUS by Opposer TMS inures to the benefit of Opposer TMC.

(6) Opposers have continuously used said name and mark for automobiles and structural parts and accessories therefor and related automotive services, and in the advertising and sale thereof, in interstate commerce since long prior to the filing date of the opposed application and/or any use of the mark LEXUS MATTRESS by Applicant for the goods described in the opposed application.

(7) By virtue of the prior, continuous and substantial advertising and sales of automobiles and structural parts and accessories therefor and related automotive services

under the trade name and mark LEXUS, the maintenance of premium quality standards relating thereto, purchasers of such goods and services and others have come to recognize the name and mark LEXUS as an indication of origin in Opposers, as a consequence of which Opposers have established valuable goodwill and exclusive rights in this mark.

(8) The mark LEXUS had become exceedingly well-known and a famous mark within the meaning of § 43(c) of the Federal Trademark Act long prior to the filing date of the opposed application and/or any use of the mark LEXUS MATTRESS by Applicant for the goods described in the opposed application.

(9) The mark LEXUS has a particular and singular meaning identifying Opposers and acquired such particular and singular significance well prior to the filing date of the opposed application and/or any use of the mark LEXUS MATTRESS by Applicant for the goods described in the opposed application.

(10) Opposer TMC duly registered LEXUS as a trademark for automobiles in the United States Patent and Trademark Office under Registration No. 1,574,718 which issued January 2, 1990.

(11) Opposer TMC duly registered LEXUS as a service mark for repair and maintenance services for automotive vehicles and automotive vehicle leasing services in the United States Patent and Trademark Office under Registration No. 1,675,339 which issued February 11, 1992.

(12) Opposer TMC duly registered LEXUS as a service mark for financing the purchasing and leasing of automobiles in the United States Patent and Trademark Office under Registration No. 1,739,201 which issued December 8, 1992.

(13) Opposer TMC duly registered LEXUS & Design as a trademark for cellular telephones in the United States Patent and Trademark Office under Registration No. 1,814,753 which issued January 4, 1994.

(14) Opposer TMC duly registered LEXUS & Design as a trademark for key rings; sunglasses, binoculars, and compact disc holders; clocks and world time clocks; ballpoint pens; umbrellas and attaché cases; non-metal key rings and key chains; drinking cups; jackets, sweat shirts, caps, sweaters, polo shirts, sport shirts, pullovers, windbreakers, visors, golf shirts, and crewnecks; and, golf balls, golf bags, golf bag travel covers, head covers for golf clubs, and golf ball spotters in the United States Patent and Trademark Office under Registration No. 1,834,147 which issued May 3, 1994.

(15) Opposer TMC duly registered LEXUS CUSTOM TAILORED LEASE as a service mark for vehicle renting and leasing services under Registration No. 2,016,803 which issued November 19, 1996.

(16) Opposer TMC duly registered LEXUS EXTRA CARE as a service mark for administration of financial and insurance service agreements providing for repairs of automotive vehicles, towing, gas delivery, and flat tire service for disabled vehicles; reimbursement for substitute transportation, lodging, and meals; and motor vehicle insurance underwriting under Registration No. 1,871,549 which issued January 3, 1995.

(17) Registration Nos. 1,574,718, 1,675,339, 1,739,201, 1,814,753, 1,834,147, 2,016,803 and 1,871,549 are each *prima facie* evidence of the validity and exclusive right to use of mark LEXUS and are constructive notice of ownership thereof, all as provided by §§ 7(b) and 22 of the Federal Trademark Act, 15 U.S.C. §§ 1057(b) and 1072. As the right to use the mark LEXUS has become incontestable, Registration Nos. 1,574,718, 1,675,339, 1,739,201, 1,814,753, 1,834,147, 2,016,803 and 1,871,549 are conclusive evidence of the exclusive right to use the marks shown therein in commerce as provided by §§ 15 and 33(b) of the Federal Trademark Act, 15 U.S.C. §§ 1065 and 1115(b).

(18) The use of the mark LEXUS MATTRESS in connection with the goods described in the opposed application dilutes the distinctive qualities of the famous mark

LEXUS within the meaning of § 43(c) of the Federal Trademark Act thereby damaging Opposers. Accordingly, Applicant is not lawfully entitled to the registration which it seeks for the mark LEXUS MATTRESS.

(19) The goods and services described in Opposer TMC's Registration Nos. 1,574,718, 1,675,339, 1,739,201, 1,814,753, 1,834,147, 2,016,803 and 1,871,549 and the goods described in the opposed application are commercially related in that they are likely to be sold to the same or overlapping classes of purchasers. Accordingly, purchasers, prospective purchasers and others are likely to be confused, mistaken or deceived into the belief, contrary to fact, that the mattresses, box springs, pillows, and bed frames sold under the mark LEXUS MATTRESS emanate from and/or are in some way sponsored or approved by Opposers and/or that Applicant is somehow affiliated with Opposers, thereby damaging Opposers.

(20) Members of the consuming public and others who come into contact with Applicant's goods sold under the mark LEXUS MATTRESS will mistakenly associate such products with Opposers and, as a consequence of Opposers' continuous and substantial advertising and sales under the mark LEXUS, will mistakenly assume a connection between Applicant and Opposers.

(21) Applicant is not lawfully entitled to the registration which it seeks for the reason, *inter alia*, that Applicant's mark LEXUS MATTRESS, as used in connection with goods described in the opposed application, so resembles Opposers' previously used and registered mark LEXUS as to be likely to cause confusion, to cause mistake or to deceive within the meaning of § 2(d) of The Federal Trademark Act, thereby damaging Opposers.

WHEREFORE, Opposers believe that the present opposition should be sustained and the registration of Applicant's mark refused.

The requisite filing fee of $300 is submitted herewith.

TOYOTA JIDOSHA KABUSHIKI KAISHA, ALSO DOING BUSINESS AS TOYOTA MOTOR CORPORATION, and TOYOTA MOTOR SALES, U.S.A., INC.,

Dated: March 31, 2003

By: _____

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Document #: 1314608 v.1

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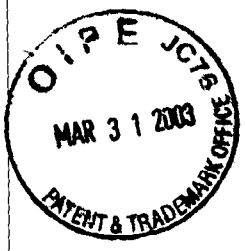

March 31, 2003

[redacted]
03-31-2003
U.S. Patent & TMOfc/TM Mail Rcpt. Dt. #40

The Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Notice of Opposition
Toyota Motor Corporation and Toyota Motor Sales, U.S.A., Inc.
v. Robert J. Stathos
Our File No. 18607.0440

Dear Madam:

Attached hereto is the following document:

NOTICE OF OPPOSITION
(original and 1 copy)

The Director of the U.S. Trademark Office is authorized to charge the filing fee in the amount of THREE HUNDRED DOLLARS ($300.00) to our Deposit Account No. 19-1565. We believe that this amount is accurate but if it is insufficient for this filing, please also charge any additional fee required to our Deposit Account No. 19-1565.

If there are any questions, please contact the undersigned.

Sincerely,

Alan S. Cooper

ASC/lnf
Attachments

Document #: 1315844 v.1