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

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

and,

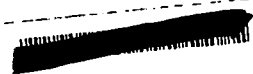
NISSAN NORTH AMERICA, INC.

Opposers,

v.

NISSAN CHEMICAL INDUSTRIES, LTD.

Applicant.



12-09-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #74

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

Application No. 76/352,396

**NOTICE OF OPPOSITION**

This is in the matter of an application for registration of the expression "NISSAN CHEMICAL INDUSTRIES, LTD. and Design" for use with:

Chemical products and raw chemicals for use in chemical industry, paper industry, construction industry, steel industry, electronics industry and pharmaceutical industry; silica sol for use in the manufacture of fiber, paper, paints and adhesives, batteries, waxes, polishes, ceramics, films, and as a catalyst; oxides for polishing semiconductor wafers, electronic chips or hard disks; hardner for powder coating, epoxy resin for encapsulation of semiconductor device; unprocessed melamin resin for furniture; fertilizers and plant growth regulating preparations for agriculture; superplasticizer for construction industry; unprocessed sythetic resins for semiconductor device and

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liquid crystal display; photoresists for the production of microchips and chemicals used in the production of liquid crystal displays; organic solvents; basic chemical materials for the manufacture of plastics, pharmaceuticals and crop protection agents; chemical toxicants for use in the manufacture of insecticides, fungicides and herbicides; insect-resistant genes and herbicide tolerant genes for use in the manufacture of agricultural seed; waste water treatment chemicals for commercial and industrial use preservatives for use in brickwork, cement, concrete and masonry; alcohol for use in industry; synthetic polymers for use in industry; synthetic polymers for pharmaceutical and medical use, in International Class 1;

Inorganic chemicals for polishing semiconductors wafers and residue-remover for semiconductor device, in International Class 3;

Pharmaceutical preparations for the treatment of dermatological, cardiovascular, hematological, bone, respiratory, central nervous system, endocrinological, circulatory, gastroenterological, hormonal and diabetic disorders, coughs, colds, influenza, headaches, stomach and digestive disorders, muscular and/or rheumatic disorders, anti-inflammatory agents, immune system disorders and related diseases, allergic reactions, metabolic disorders, anti-infectives, ocular disorders, and for use in oncology; diagnostic preparations and/or reagents for clinical or medical laboratory use; contact lens and eyecare solutions and preparations, namely, disinfectants, cleaning solutions, saline solutions and wetting solutions; nicotine for medicinal purposes in liquid, pill, tablet, caplet, powder or transdermal patch form; hormones; dietetic substances for medical purposes, namely, nutritional, vitamin, herbal and mineral supplements and preparations, nutritional drink mix for use as a meal replacement, nutritional supplements in snack bar form for use as a meal replacement; food and beverages for babies, infants and invalids, namely, baby food, infant formula, food for enteral administration and food for medically restricted diets; and

pesticides, fungicides, herbicides and insecticides, all for commercial, agricultural and/or domestic use, in International Class 5;

as shown in U.S. Application Serial No. 76/352,396, filed on December 27, 2001 by Nissan Chemical Industries, Ltd., 7-1, 3-Chome, Kanda-Nishiki-Cho Chiyoda-Ku, Tokyo, Japan (hereinafter called "Nissan Chemical" or "Applicant"), and published for opposition in the Official Gazette of December 10, 2002.

Nissan Jidosha Kabushiki Kaisha, also trading as Nissan Motor Co., Ltd., a Japanese corporation with a place of business at No. 2 Takaracho, Kanagawa-ku, Yokohama-shi, Kenawaga-ken, Japan and Nissan North America, Inc., a California corporation with place of business at 18501 South Figueroa Street, Gardena, California 90248-4500 (hereinafter referred to collectively as "Opposers"), believe that they would be damaged by registration as sought in the foregoing application and hereby oppose the same.

The grounds for the opposition are as follows:

1. Nissan Jidosha Kabushiki Kaisha, also trading as Nissan Motor Co., Ltd. is the parent company of Nissan North America, Inc. (hereinafter referred to collectively as "Opposers").
2. By the application herein opposed, applicant Nissan Chemical seeks to register "NISSAN CHEMICAL INDUSTRIES, LTD. and Design" as a trademark for various chemical products and pharmaceutical preparations, listed above, basing such application for United States federal registration on an asserted bona fide intent to use the mark in U.S. commerce in

connection with the identified goods. The constructive date of first use of Applicant's mark is the filing date of Applicant's intent-to-use application, specifically, December 27, 2001.

3. Opposers, Nissan Jidosha Kabushiki Kaisha, also trading as Nissan Motor Co., Ltd. and Nissan North America, Inc. are the owners of all right, title and interest in and to various NISSAN® marks and names for motor vehicles, chemical products for vehicles, and a wide variety of other goods and services of Opposers. As used herein, "Opposers' goods," "Opposers' services," and "Opposers' business," as well as expressions to a similar effect, mean the goods, the services and the business of Nissan Jidosha Kabushiki Kaisha, also trading as Nissan Motor Co., Ltd. and Nissan North America, Inc. and their predecessors.

4. Opposer Nissan Jidosha Kabushiki Kaisha, also trading as Nissan Motor Co., Ltd., is the owner of many U.S. Trademark and Service Mark Registrations featuring the mark NISSAN. Among such U.S. registrations is Reg. No. 1,421,618, registered December 23, 1986, for the mark NISSAN in a stylized form for chemical products for vehicles and other products, which registration is still in full force and effect. Other such U.S. registrations include Reg. No. 2,063,104; Reg. No. 2,098,787; Reg. No. 1,743,903; Reg. No. 1,448,362; Reg. No. 2,444,813; Reg. No. 2,043,780; Reg. No. 2,128,205; Reg. No. 2,779,066; Reg. No. 2,779,063; Reg. No. 2,203,744; Reg. No. 2,047,855; Reg. No. 2,047,840; Reg. No. 2,039,146; Reg. No. 2,055,094; Reg. No. 2,047,845; Reg. No. 2,047,839; Reg. No. 2,777,378; Reg. No. 2,697,209; Reg. No. 2,047,851; Reg. No. 2,050,895; Reg. No. 2,039,145; Reg. No. 2,052,638; Reg. No. 1,914,770; Reg. No. 686,587; Reg. No. 2,779,064; Reg. No. 2,043,779; Reg. No. 2,047,850; Reg. No. 2,061,150; Reg. No. 2,047,843; Reg. No. 2,047,835; Reg. No. 2,047,834; Reg. No. 2,247,920; Reg. No.

2,083,517; Reg. No. 2,073,651; Reg. No. 2,042,081; Reg. No. 689,796; Reg. No. 2,063,105; Reg. No. 2,057,276; Reg. No. 1,531,247; Reg. No. 2,396,153; Reg. No. 2,043,776; Reg. No. 1,531,246 and Reg. No. 1,518,829.

5. Opposer Nissan North America, Inc. uses the registered NISSAN marks and names owned by Opposer Nissan Jidosha Kabushiki Kaisha, also trading as Nissan Motor Co., Ltd., with the authorization of the latter entity.

6. The term NISSAN was adopted as a mark and name in the U.S. by Opposers and/or their predecessors in interest more than forty years ago, at least as early as 1958 (see Reg. No. 686,587). The NISSAN mark and name has been used continuously since then to the present in connection with the advertising, promotion, sale and offering of Opposers' motor vehicles, chemical products for vehicles, and a wide variety of other goods and services in interstate commerce; and is still in such use by Opposers.

7. The NISSAN names and marks are of significant value to Opposers as identifications of source in connection with the promotion, sale, rendering and offering of the goods and services of Opposers and their affiliates, as well as in the conducting and identifying of the businesses of Opposers and their affiliates; and such marks and names distinguish such goods, such services and such businesses from those of others.

8. Opposers and their affiliates have been using the NISSAN marks and names in connection with their goods, services, and business since prior to any date on which Applicant may rely in this proceeding, and in particular, have been using such names and marks long prior to the filing date of the application herein opposed.

9. The NISSAN marks and names for motor vehicles, chemical products for vehicles and a wide variety of other goods and services, on the one hand, and the "NISSAN" formative mark as sought to be registered by Applicant for various chemical products and pharmaceutical preparations, on the other hand, are similar in sound, spelling and appearance. Thus, the mark sought to be registered by Applicant so resembles the marks and names of Opposer as to be likely to cause confusion, or to cause mistake, or to deceive.

10. Through use and promotion by Opposers and their affiliates of Opposers' NISSAN marks and names for Opposers' goods, services and businesses, purchasers and prospective purchasers of such goods and services and/or of goods and services of the same general kind, as well as customers and prospective customers of such businesses, associate such marks with the goods, services and businesses of Opposers.

11. Purchasers and prospective purchasers familiar with Opposers' goods, services and businesses identified by the NISSAN marks and names are likely to be misled into believing, contrary to fact, that Applicant's goods sold under the mark opposed herein emanate from or are in some way sponsored by Opposers or their affiliates, all to Opposers' irreparable damage through loss and/or dilution of their good will as symbolized by Opposers' marks and names.

12. Granting of a registration as sought by Applicant through the Application herein opposed would inhibit Opposers their free use of their marks and names in selling their products, promoting their services, and conducting their businesses, which would work manifest damage upon Opposers. Such registration would constitute prima facie evidence of an exclusive right to use the designation "NISSAN" for the goods designated in the application herein opposed and

for all confusingly similar uses, thereby enabling Applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of Opposers.

13. In view of extensive promotion and use thereof for more than forty years and in view of the widespread renown and recognition thereby developed, Opposers' NISSAN marks and names have long been famous marks and names. Such marks and names have been famous since long before any date on which Applicant may rely for priority purposes in this proceeding. Applicant's "NISSAN CHEMICAL INDUSTRIES, LTD. and Design" mark, which is the subject of the application opposed herein, causes and will cause dilution of the distinctive quality of Opposers' famous NISSAN marks and name, all to the further damage of Opposers.

14. The application opposed herein was filed on filed December 27, 2001, which was subsequent to January 16, 1996, the effective date of the federal anti-dilution statute reflected in Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Accordingly, the application herein opposed is subject to being opposed on the ground that the mark sought to be registered dilutes the distinctive quality of Opposers' famous marks and names.

15. For at least the above reasons, registration of Applicant's Serial No. 76/352,396 is herein opposed on the grounds that Applicant's proposed mark "NISSAN CHEMICAL INDUSTRIES, LTD. and Design" so resembles Opposers' NISSAN marks as to be likely to cause confusion, to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and under state statutory and common law.

16. Additionally, registration of Applicant's mark "NISSAN CHEMICAL INDUSTRIES, LTD. and Design" is opposed on the grounds that it will dilute the distinctive quality of Opposers' NISSAN marks and names under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and under state anti-dilution statutes.

WHEREFORE, Opposers request that this opposition be sustained and the subject application Serial No. 76/352,396 to register the mark "NISSAN CHEMICAL INDUSTRIES, LTD. and Design" be refused registration.

A check in the amount of \$600.00 is attached to cover the statutory filing fee.


Respectfully submitted,

Nissan Jidosha Kabushiki Kaisha,  
also trading as Nissan Motor Co., Ltd.

Nissan North America, Inc.

December 9, 2003  
Date:

By:

  
Peter G. Mack, Esq.  
Norm J. Rich, Esq.  
Counsel for Opposers

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**FOLEY & LARDNER**  
ATTORNEYS AT LAW



January 21, 2004

**DELIVERY**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514



01-21-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Re: Nissan Jidosha Kabushiki Kaisha, a/t/a Nissan Motor Co., Ltd. and  
Nissan North America, Inc.  
Opposers

v.

Nissan Chemical Industries, Ltd.  
Applicant

Application No. 76/352,396  
Opposition No. \_\_\_\_\_  
Our Ref. No.: 035516-0105

Dear Sir:

This in response to the PTO communication dated December 29, 2003, requesting additional payment of the filing fees for the above-referenced Notice of Opposition filed on December 9, 2003.

Enclosed are the following:

Additional filing fee of \$1200; Check No. 33641.

Copy of stamped post-card dated 12/09/03 showing original filing fee of \$600.

Foley & Lardner,

Norm J. Rich

NR/cma  
Enclosure(s)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NISSAN JIDOSHA KABUSHIKI KAISHA, :  
a/t/a NISSAN MOTOR CO., LTD. and :  
NISSAN NORTH AMERICA, INC. :  
Opposers, :  
: :  
: :  
: :

v. : Opposition No.

Nissan Chemical Industries, : :  
Ltd., : : Application No. 76/352,396  
Applicant. : :

RECEIPT IS HEREBY ACKNOWLEDGED OF THE FOLLOWING:

NOTICE OF OPPOSITION (in duplicate); Check # 22912 for \$200.00

DATE FILED: 12/09/83

DATE DUE: 12/09/83

FILE # 76/352,396



PGMA/NR/ca  
CLT/MTR: 035516/0105  
RECEIVED BY: MR