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A T T O R N E Y S A T L A W

A Limited Liability Law Partnership

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November 22, 2006

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Re: Notice of Opposition

Mark : XTERRA
Applicant : Nissan Jidosha Kabushihki Kaisha Ta Nissan Motor Co., Ltd.
Serial No. : 76/653,806; Class 16

Dear Commissioner:

Attached hereto for filing please find two (2) copies of a Notice of Opposition in the mater captioned above, and Check No. 7674 in the amount of \$300. The Commissioner is hereby authorized to charge any excess fees to our Deposit Account No. 501198.

Also attached is a stamped, self-addressed return receipt post card. Please indicate the date of receipt of the Notice of Opposition. Please address all correspondence regarding this matter to the undersigned at the address on the letterhead above.

Sincerely,



Chad M. Iida


Enclosures

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

on November 22, 2006.


Chad M. Iida

11-27-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #30

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/653,806

Filed: January 23, 2006

Mark: XTERRA

Published on October 24, 2006

Television Events and Marketing, Inc.,

Opposer,

vs.

Nissan Jidosha Kabushihki Kaisha Ta
Nissan Motor Co., Ltd.,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

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NOTICE OF OPPOSITION

Opposer Television Events and Marketing, Inc. (“TEAM” or “Opposer”), a Hawaii corporation having a principle place of business at 720 Iwilei Road, Suite 290, Honolulu, Hawaii 96817, hereby opposes registration of the mark XTERRA that is the subject of application Serial No. 76/653,806, published in the Official Gazette of October 24, 2006, and requests that registration to Nissan Jidosha Kabushihki Kaisha Ta Nissan Motor Co., Ltd., (“Applicant”) be refused.

As grounds in support of its opposition, Opposer asserts as follows:

1. Opposer has used and is the owner of various trademarks incorporating the mark XTERRA for use on a wide variety of goods and services, including for general merchandise and printed matter such as clothing, calendars, programs, posters, web sites, flyers, brochures and catalogues, since at least as early as 1997 (hereinafter, the “XTERRA Marks”).

2. Opposer is the owner of multiple U.S. Registrations for the mark XTERRA, and all of the business and goodwill represented thereby, for its XTERRA branded goods and services. Those registrations are valid, subsisting, unrevoked, and uncanceled, and are more particularly described as follows:

<u>Mark</u>	<u>Registration/ Application No.</u>	<u>Registration/ Application Date</u>	<u>Goods/Services</u>
XTERRA (Class 3)	2,911,500 76/507901	12/14/2004 4/21/2003	Skin and hair care products, namely, hand washes and moisturizers, face cleansers and moisturizers, body cleansers and moisturizers, shampoos, conditioners, shaving gels and lotions for face and body, aftershave gels and lotions, sunscreen, lip balm, and lip moisturizers
XTERRA (Class 5)	2,568,232 76/030115	5/07/2002 4/19/2000	energy bar, namely, nutritional supplements, herbal supplements, vitamin and mineral supplement, dietary supplement, dietary food supplement and food supplements, all in bar form.
XTERRA (Class 9)	3,068,544 76/314251	3/14/2006 9/18/2002	Bicycle helmets
XTERRA (Class 9)	2,503,156 76/030116	10/30/2001 4/19/2000	Sunglasses
XTERRA (Class 12)	2,540,692 75/275325	2/19/2002 4/15/1997	Vehicles, namely, bicycles
XTERRA (Class 12)	2,769,865 76/314250	9/30/2003 9/18/2002	Bicycles
XTERRA	2,886,946	9/21/2004	Boats and boating

(Class 12)	76/271962	6/15/2001	equipment, namely, kayaks, kayak paddles, canoes, canoe paddles, row boats, oars, single and two rider jet boats, power boats
XTERRA (Class 14)	3,001,417 78/437358	9/27/2005 6/17/2004	Watches
XTERRA (Class 14)	2,478,276 75/275322	8/14/2001 4/15/1997	Watches
XTERRA (Class 18)	2,509,404 76/110602	11/20/2001 8/14/2000	backpacks and sport bags
X TERRA (Class 25)	2,478,277 75/275342	8/14/2001 4/15/1997	Men's, women's, and children's swimming, athletic, and bicycle attire, namely, bathing suits, swim trunks, T-shirts, shorts, hats, jackets, pants, and sweatshirts.
XTERRA (Class 25)	2,451,200 75/275324	5/15/2001 4/15/1997	Men's, women's and children's swimming, athletic, and bicycle attire, namely, bathing suits, swim trunks, t-shirts, shorts, hats, jackets, pants, and sweatshirts.
XTERRA (Class 25)	2,680,131 76/312272	1/28/2003 9/10/2002	Men's, women's and children's swimming, athletic, and bicycle attire, namely, bathing suits, swim trunks, t-shirts, jackets, pants, sweatshirts and shoes.
X TERRA (Class 25)	2,670,109 76/271963	12/31/2002 6/15/2001	Wetsuits
X XTERRA (Class 25)	3,082,123 78/572225	4/18/2006 2/22/2005	Men's, women's and children's casual and athletic apparel, namely, shirts, shorts, pants, jackets, sweatshirts, hats, underwear, wetsuits, swimsuits, bikinis,

			swim trunks, running shorts, jerseys, socks and shoes
XTERRA (Class 28)	2,891,502 76/091089	10/4/2004 7/18/2000	Fishing rods and fishing reels
XTERRA (Class 28)	2,759,732 76/278658	9/02/2003 6/24/2001	Fishing equipment, namely, fishing rods, fishing reels, fishing lures, fishing lure boxes, hooks, fishing flies, fly boxes, fishing buoys, fishing lure boxes, handheld fishing nets, fishing rod handles, fishing rod holders, fishing rods, fishing sinkers, fishing spinners, fishing tackle boxes, fishing floats, lure boxes, reels, fishing safety harnesses, sportsman's fishing bags, tackle boxes, tackle containers, artificial fishing worms, fishing lines.
XTERRA (Class 28)	2,927,265 76/506577	2/22/2005 4/16/2003	Golf equipment, namely, golf clubs, golf bags and golf gloves.
XTERRA (Class 30)	2,779,890 76/030114	11/04/2003 4/19/2000	Energy bars, namely, grain-based food bars.
XTERRA (Class 32)	2,528,577 76/030491	1/08/2002 4/19/2000	Beverages, namely, sports drinks.
X TERRA (Class 41)	2,985,485 78/437359	8/16/2005 6/17/2004	Entertainment in the nature of athletic competitions, namely, organizing and conducting sports events.
X TERRA (Class 41)	2,293,155 75/275321	11/16/1999 4/15/1997	Entertainment in the nature of athletic competitions, namely, organizing and

conducting triathlons.

X XTERRA (Class 41)	3,079,156 78/572236	4/11/2006 2/22/2005	Entertainment services in the nature of athletic competitions, namely, organizing and conducting sporting events
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3. Opposer is also the owner of other U.S. Registrations for marks incorporating the term XTERRA and all of the business and goodwill represented thereby. These registrations are valid, subsisting, unrevoked, and uncanceled, and are more particularly described as follows:

<u>Mark</u>	<u>Registration/ Application No.</u>	<u>Registration/ Application Date</u>	<u>Goods/Services</u>
XTERRA GEAR (Class 35)	3,067,883 78/572213	3/14/2006 2/22/2005	Retail store services for general merchandise, food, beverages and nutritional supplements.
XTERRAPLANET.COM (Class 35)	2,716,180 76/094683	5/13/2003 7/20/2000	Online retail store for athletic apparel.
XTERRAPLANET.COM (Class 41)	2,629,025 76/094682	10/01/2002 7/20/2000	Entertainment services in the form of providing online information and registration services for the organization and conducting of athletic competitions.
XTERRA SCRAMBLE (Class 41)	3,113,040 78/543498	7/4/2006 1/6/2005	Entertainment services in the nature of athletic competitions, namely, organizing and conducting sporting events.
XTERRA TRAVEL (Class 39 & 43)	3,118,228 78/499368	7/16/2006 10/13/2004	Arranging travel tours and making

reservations and
bookings for
transportation;
Making reservations
and bookings for
lodging

4. Opposer is the owner of various U.S. Applications for marks incorporating the word XTERRA, and all of the business and goodwill represented thereby. These applications are valid, subsisting, unrevoked, and uncanceled, and are more particularly described as follows:

<u>Mark</u>	<u>Application No.</u>	<u>Filing Date</u>	<u>Goods or Services</u>
XTERRA (Class 9)	76/554553	10/27/2003	Satellite navigational system, namely, a global positioning system
XTERRA (Class 41)	78/861203	4/13/2006	Entertainment in the nature of on-going television programs in the field of sports and lifestyle activities; Entertainment namely, production of television programs featuring sports and lifestyle activities
XTERRA PLANET (Class 41)	78/861209	4/13/2006	Entertainment in the nature of on-going television programs in the field of sports and lifestyle activities; Entertainment namely, production of television programs featuring sports and lifestyle activities.

5. For many years, and well prior to Applicant's filing date, Opposer has used the XTERRA Marks in interstate commerce throughout the United States and foreign commerce throughout the world in connection with its various goods and services, including for general merchandise and printed matter.

6. By reason of the extensive promotion, advertising, and provision of high-quality goods and services manufactured, produced, distributed and sold by Opposer in conjunction with the XTERRA Marks, the public and trade have come to recognize products offered in conjunction with these marks as signifying TEAM and its various goods and services. Opposer derives substantial goodwill and value from such identification by the consuming public and trade.

7. Notwithstanding TEAM's long prior rights and goodwill in the XTERRA Marks, Applicant has filed an application, Serial No. 76/653,806, based on an intent-to-use, for registration of XTERRA for "Printed matter, namely, writing portfolios, ball point and fountain pens, calendars and diaries" in Class 16 (the "Applicant's Application"). That Application was filed on January 23, 2006.

8. There is no issue as to priority. The Applicant has not yet claimed use of the XTERRA mark for "Printed matter, namely, writing portfolios, ball point and fountain pens, calendars and diaries" and the Applicant's intent to use filing date, January 23, 2006, for these goods was long after the dates when TEAM first used and registered the XTERRA Marks for its goods and services, including for general merchandise and printed matter.

9. In addition, Applicant has recognized TEAM's prior and superior rights in an agreement the parties entered into dated March 23, 1998, and amended June 8, 2001 (collectively, the "Agreement") wherein Nissan North America, Inc., - upon information and belief a parent, subsidiary, affiliate, or other related company to Applicant - through its predecessor Nissan Motor Corporation U.S.A., negotiated for the right to use the XTERRA mark for "motorized land vehicles, motorized land vehicle parts, motorized land vehicle equipment and motorized land vehicle accessories".

10. Pursuant to the Agreement, Nissan North America, Inc. recognized TEAM's prior and superior rights in the XTERRA Marks when it agreed to only distribute promotional items bearing the XTERRA mark with its NISSAN mark.

11. Pursuant to the 1998 agreement, Nissan North America, Inc. recognized TEAM's prior and superior rights in the XTERRA Marks when it negotiated for TEAM not to object to the adoption, use and registration by Nissan North America, Inc. of the XTERRA mark for "motorized land vehicles, motorized land vehicle parts, motorized land vehicle equipment and motorized land vehicle accessories" and related motor vehicle products or services, such as motor vehicle dealerships services, motor vehicle financing and leasing services, or associated promotional motor vehicle goods and services, such as motor vehicle racing and toy vehicles.

12. Pursuant to the 1998 agreement, Nissan North America, Inc. recognized TEAM's prior and superior rights in the XTERRA Marks when it negotiated for TEAM not to promote its products through motor vehicle racing, or by using or depicting motor vehicles bearing the XTERRA mark or by using the XTERRA mark on any other products or services typically associated with automotive marketing or retailing, such as key fobs, license plate holders and toy vehicles.

13. By entering into the 1998 Agreement with TEAM, Applicant and its parent, subsidiaries, affiliates, and other related companies, have acknowledged that TEAM's rights in the XTERRA mark are far superior to Applicant's rights.

14. Upon information and belief, Applicant is attempting to circumvent its concessions under the Agreement by filing the Applicant's Application using Nissan Jidosha Kabushihki Kaisha Ta Nissan Motor Co., Ltd., as the owner of the application rather than Nissan North America, Inc. However, in the Applicant's Application, Applicant has listed U.S.

Registration No. 2,565,478 for the mark XTERRA, registered to Nissan North America, Inc., as a prior registration to the Applicant's Application which establishes that Nissan Jidosha Kabushihki Kaisha Ta Nissan Motor Co., Ltd. and Nissan North America, Inc. are the same entity. Consequently, both Nissan Jidosha Kabushihki Kaisha Ta Nissan Motor Co., Ltd. and Nissan North America, Inc. are bound by the provisions of the Agreement.

15. Applicant's XTERRA mark is identical to Opposer's XTERRA Marks, and is applied to goods very similar, if not identical, to those offered by Opposer. The Applicant's mark so closely resembles Opposer's previously used and registered XTERRA Marks as to be likely, when applied to the goods set forth in Applicant's Application, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act.

16. If Applicant is permitted to use and register its XTERRA mark for its goods, as specified in the Application herein opposed, confusion in the trade resulting in damage and injury to TEAM would be caused and would result by reason of the similarity between the XTERRA mark and the Opposer's XTERRA Marks. Persons familiar with Opposer's XTERRA Marks would be likely to buy Applicant's goods as and for a product made and sold by, or sponsored or approved by, the Opposer. Any such confusion in trade would result in loss of sales to Opposer. Furthermore, any defect, objection or fault found with Applicant's products marketed under its mark would necessarily reflect upon and injure the reputation that Opposer has established for its goods and services merchandised under its XTERRA Marks.

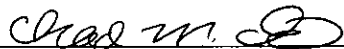
17. If Applicant were granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer in violation and derogation of the prior and superior

statutory and common law rights of Opposer, and in violation of the agreement entered into by Nissan North America.

WHEREFORE, Opposer prays that this Opposition be sustained and that the application Serial No. 76/653,806, for the mark XTERRA, for the goods therein specified, be refused registration, and for such other relief as may be deemed just and proper.

A duplicate copy of this Notice of Opposition and the fee required in §2.6(1) are enclosed herewith.

DATED: Honolulu, Hawaii, November 22, 2006.

By: 

Robert Carson Godbey
Jess H. Griffiths
Chad M. Iida
GODBEY GRIFFITHS REISS CHONG
A Limited Liability Law Partnership
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Attorneys for Opposer

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a)

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on November 22, 2006.


Chad M. Iida