

ESTTA Tracking number: **ESTTA653870**

Filing date: **02/03/2015**

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	CHENG SHIN RUBBER IND. CO., LTD
Granted to Date of previous extension	02/04/2015
Address	215 MEEI-KONG ROAD TA-TSUN, CHANG-HWA, TAIWAN

Attorney information	Kenneth L. Wilton Seyfarth Shaw LLP 2029 Century Park East, Suite 3500 Los Angeles, CA 90067-3021 UNITED STATES kwilton@seyfarth.com, tmatlanta@seyfarth.com, jmyers@seyfarth.com, kelko@seyfarth.com Phone:(310) 277-7200
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Applicant Information

Application No	86237869	Publication date	10/07/2014
Opposition Filing Date	02/03/2015	Opposition Period Ends	02/04/2015
Applicant	Quality Merchandising S.r.l. Corso Vittorio Emanuele II, 74 Torino, 10121 ITALY		

Goods/Services Affected by Opposition

Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Leather and imitations of leather and goods made of these materials, namely, briefcases, pouches, handbags; trunks and traveling bags; umbrellas and parasols; walking sticks; bags, namely, shoulder bags, beach bags, traveling bags, handbags, and sports bags; casual bags, namely, messenger bags, duffle bags; handbags provided with inflatable walls; hold-alls, namely, carry-all bags, carry-on bags; beauty cases sold empty
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1712661	Application Date	12/27/1989
Registration Date	09/01/1992	Foreign Priority Date	NONE

Word Mark	MAXXIS
Design Mark	
Description of Mark	NONE
Goods/Services	Class 012. First use: First Use: 1992/02/28 First Use In Commerce: 1992/02/28 tires for vehicles; namely, passenger car tires, motorcycle tires and boat trailer tires

U.S. Registration No.	2724454	Application Date	09/18/1997
Registration Date	06/10/2003	Foreign Priority Date	NONE

Word Mark	MAXXIS
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2002/10/00 First Use In Commerce: 2002/10/00 [PRERECORDED AUDIO AND VIDEO TAPES FEATURING TIRES, LAND VEHICLES, SPORTING EVENTS, AND ENTERTAINMENT]</p> <p>Class 014. First use: First Use: 2001/00/00 First Use In Commerce: 2001/00/00 CLOCKS</p> <p>Class 016. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 DECALS, PAPER BANNERS; BOOKLETS, [BROCHURES]</p> <p>Class 019. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 [NON-LUMINOUS, NON-MECHANICAL SIGNS NOT OF METAL OR PAPER]</p> <p>Class 020. First use: First Use: 2001/00/00 First Use In Commerce: 2001/00/00 [NON-METAL MARQUEES FOR RETAIL STORES;] SPORTS WATER BOTTLES SOLD EMPTY</p> <p>Class 025. First use: First Use: 1992/00/00 First Use In Commerce: 1992/00/00 CLOTHING AND APPAREL, NAMELY, BASEBALL-STYLE CAPS, SHIRTS, JACKETS, EACH SOLD THROUGH DISTRIBUTION CHANNELS EXCEPT DEPARTMENT STORES</p> <p>Class 041. First use: First Use: 1996/00/00 First Use In Commerce: 1996/00/00 PROVIDING ENTERTAINMENT FEATURING RACESAND RACE RESULTS ON A GLOBAL COMPUTER NETWORK; PROVIDING EDUCATION ABOUT TIRES AND INNER TUBES FOR LAND VEHICLES ON A GLOBAL COMPUTER NETWORK</p>

Attachments	Notice of Opposition.pdf(758940 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	/Kenneth L. Wilton/
Name	Kenneth L. Wilton
Date	02/03/2015

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

In the Matter of Application Serial No. 86/237,869
Published in the Official Gazette of October 7, 2014

CHENG SHIN RUBBER IND. CO., LTD. d/b/a
MAXXIS INTERNATIONAL,

Opposer,

v.

QUALITY MERCHANDISING S.R.L.,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

Opposer Cheng Shin Rubber Ind. Co., Ltd. d/b/a Maxxis International (“Opposer”) believes that it will be damaged by registration of the mark shown in Application Serial No. 86/237,869, and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:

1. Opposer is a corporation organized and existing under the laws of the State of Taiwan, with a principal place of business at 215 Meei-Kong Road, Ta-Tsun, Chang-Hwa, Taiwan.
2. Opposer is, and since at least as early as 1992, has been engaged in the manufacture, development, sale and advertising of tires and various other products.
3. Since 1992, Opposer has marketed tires and related goods under the trademark MAXXIS[®] (the “MAXXIS[®] Mark”) in the United States and globally.

4. Opposer owns all right, title and interest in and to the MAXXIS[®] Mark, as well as the following United States registrations of its MAXXIS[®] Mark on the Principal Register:

- a. Registration No. 1,712,661 granted September 1, 1992, for the mark MAXXIS in International Class 12 for “tires for vehicles; namely, passenger car tires, motorcycle tires and boat trailer tires”; and
- b. Registration No. 2,724,454 granted June 10, 2003, for the mark MAXXIS in International Class 14 for “clocks”; International Class 16 for “decals, paper banners, booklets”; International Class 20 for “sports water bottles sold empty”; International Class 25 for “clothing and apparel, namely, baseball-style caps, shirts, jackets, each sold through distribution channels except department stores”; and International Class 41 for “providing entertainment featuring races and race results on a global computer network; providing education about tires and inner tubes for land vehicles on a global computer network.”

Both of these registrations are valid and subsisting, and both have become incontestable. Copies of current printouts of information from the electronic database records of the USPTO showing the current status and title of these registrations are attached hereto as Exhibit 1 and are incorporated by reference herein as if set forth in full.

5. Opposer also uses the MAXXIS[®] Mark on and in connection with products not identified in its registrations, including backpacks, messenger bags, umbrellas, and related goods. Examples of such use are attached hereto as Exhibit 2 and are incorporated by reference herein as set forth in full.

6. From a time long prior to the filing of the Application at issue, Opposer has used the MAXXIS[®] Mark in commerce in the United States on and in connection with the foregoing

goods, for which the mark has become famous. Moreover, by virtue of the excellence of the products sold under the MAXXIS[®] Mark, the mark has a valuable reputation.

7. Notwithstanding Opposer's long prior rights in and to the MAXXIS[®] Mark, Applicant, on information and belief, on March 31, 2014, filed an application for registration of the trademark IMAXIS for "leather and imitations of leather and goods made of these materials, namely, briefcases, pouches, handbags; trunks and traveling bags; umbrellas and parasols; walking sticks; bags, namely, shoulder bags, beach bags, traveling bags, handbags, and sports bags; casual bags, namely, messenger bags, duffle bags; handbags provided with inflatable walls; hold-alls, namely, carry-all bags, carry-on bags; beauty cases sold empty" in International Class 18 ("Applicant's Mark").

8. Applicant's Mark was published for opposition in the Trademark Official Gazette of October 7, 2014 (the "Opposed Application").

FIRST CLAIM FOR RELIEF
(Likelihood of Confusion With Registered Mark)

9. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 8, inclusive, as if fully set forth herein.

10. The IMAXIS mark shown in the Opposed Application so resembles Opposer's registered MAXXIS[®] Mark as to be likely, when used on or in connection with the goods and services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's Mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

11. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant *prima facie* evidence of its ownership of,

and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer's MAXXIS® Mark.

SECOND CLAIM FOR RELIEF
(Likelihood of Confusion With Previously Used Mark)

12. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 11, inclusive, as if fully set forth herein.

13. The IMAXIS mark shown in the Opposed Application so resembles Opposer's previously used and not abandoned MAXXIS® Mark as to be likely, when used on or in connection with the goods and services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's Mark is thus unregistrable under Section 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d).

14. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration will give Applicant *prima facie* evidence of its ownership of, and its exclusive nationwide right to use, a mark that is confusingly similar to Opposer's previously used and not abandoned MAXXIS® Mark.

WHEREFORE, Opposer prays for judgment sustaining this opposition and refusing registration to Applicant of the mark shown in the Opposed Application.

EXHIBIT 1

STATUS	DOCUMENTS	Back to Search	Print
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Generated on: This page was generated by TSDR on 2015-02-02 12:41:41 EST

Mark: MAXXIS No Image exists for this case.

US Serial Number: 74014430 **Application Filing Date:** Dec. 27, 1989

US Registration Number: 1712661 **Registration Date:** Sep. 01, 1992

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Aug. 30, 2012

Publication Date: Jun. 05, 1990 **Notice of Allowance Date:** Oct. 30, 1990

▲ **Mark Information**

▼ [Expand All](#)

▣ **Goods and Services**

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: tires for vehicles; namely, passenger car tires, motorcycle tires and boat trailer tires

International Class(es): 012 - Primary Class **U.S Class(es):** 019, 035

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 28, 1992 **Use in Commerce:** Feb. 28, 1992

▲ **Basis Information (Case Level)**

▣ **Current Owner(s) Information**

Owner Name: CHENG SHIN RUBBER IND. CO., LTD.

Owner Address: NO. 215, MEEI-KONG RD.
TA-TSUN, CHANG-HWA
TAIWAN

Legal Entity Type: CORPORATION

State or Country Where Organized: TAIWAN

▲ [Attorney/Correspondence Information](#)

▲ [Prosecution History](#)

▲ [Maintenance Filings or Post Registration Information](#)

▲ [TM Staff and Location Information](#)

▲ [Assignment Abstract Of Title Information - Click to Load](#)

▲ [Proceedings - Click to Load](#)

STATUS	DOCUMENTS	Back to Search	Print
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Generated on: This page was generated by TSDR on 2015-02-02 12:43:25 EST

Mark: MAXXIS No Image exists for this case.

US Serial Number: 75359340 **Application Filing Date:** Sep. 18, 1997

US Registration Number: 2724454 **Registration Date:** Jun. 10, 2003

Register: Principal

Mark Type: Trademark, Service Mark

Status: The registration has been renewed.

Status Date: Jun. 11, 2013

Publication Date: Jan. 30, 2001 **Notice of Allowance Date:** May 28, 2002

▲ **Mark Information**

▼ [Expand All](#)

▲ **Related Properties Information**

▼ **Goods and Services**

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: [PRERECORDED AUDIO AND VIDEO TAPES FEATURING TIRES, LAND VEHICLES, SPORTING EV ENTERTAINMENT]

International Class(es): 009 - Primary Class **U.S Class(es):** 021, 023, 026, 036,

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Oct. 2002 **Use in Commerce:** Oct. 2002

For: CLOCKS

International Class(es): 014 - Primary Class **U.S Class(es):** 002, 027, 028, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: 2001 **Use in Commerce:** 2001

For:	DECALS, PAPER BANNERS; BOOKLETS, [BROCHURES]	
International Class(es):	016 - Primary Class	U.S Class(es): 002, 005, 022, 023,
Class Status:	ACTIVE	
Basis:	1(a)	
First Use:	1997	Use in Commerce: 1997
For:	[NON-LUMINOUS, NON-MECHANICAL SIGNS NOT OF METAL OR PAPER]	
International Class(es):	019 - Primary Class	U.S Class(es): 001, 012, 033, 050
Class Status:	SECTION 8 - CANCELLED	
Basis:	1(a)	
First Use:	1997	Use in Commerce: 1997
For:	[NON-METAL MARQUEES FOR RETAIL STORES;] SPORTS WATER BOTTLES SOLD EMPTY	
International Class(es):	020 - Primary Class	U.S Class(es): 002, 013, 022, 025,
Class Status:	ACTIVE	
Basis:	1(a)	
First Use:	2001	Use in Commerce: 2001
For:	CLOTHING AND APPAREL, NAMELY, BASEBALL-STYLE CAPS, SHIRTS, JACKETS, EACH SOLD THROUGH CHANNELS EXCEPT DEPARTMENT STORES	
International Class(es):	025 - Primary Class	U.S Class(es): 022, 039
Class Status:	ACTIVE	
Basis:	1(a)	
First Use:	1992	Use in Commerce: 1992
For:	PROVIDING ENTERTAINMENT FEATURING RACES AND RACE RESULTS ON A GLOBAL COMPUTER EDUCATION ABOUT TIRES AND INNER TUBES FOR LAND VEHICLES ON A GLOBAL COMPUTER	
International Class(es):	041 - Primary Class	U.S Class(es): 100, 101, 107
Class Status:	ACTIVE	
Basis:	1(a)	
First Use:	1996	Use in Commerce: 1996
▲ Basis Information (Case Level)		
▼ Current Owner(s) Information		
Owner Name:	CHENG SHIN RUBBER IND. CO., LTD.	
Owner Address:	NO. 215, MEEI-KONG RD.	

Legal Entity Type:	TA-TSUN, CHANG-HWA TAIWAN CORPORATION	State or Country Where Organized:	TAIWAN
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▲ **Attorney/Correspondence Information**

▲ **Prosecution History**

▲ **Maintenance Filings or Post Registration Information**

▲ **TM Staff and Location Information**

▲ **Assignment Abstract Of Title Information - Click to Load**

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EXHIBIT 2

SHOPPING CART | MY ACCOUNT | CONTACT US



MAXXIS

FACTORY GEAR

ATV / MOTO

AUTOMOTIVE

BICYCLE

TRAILER



STORE HOME » FACTORY GEAR » APPAREL » ACCESSORIES » EXCELSIOR BACKPACK BY OGIO

0

Like

0

0

Tweet

0

8+1



Excelsior Backpack by OGIO

USD\$ 65.00

ITEM IS AVAILABLE.

ITEM # ZM31030602

- US Shipping Only
- Shipping restrictions prohibit shipment to an APO or APE address

QUANTITY

ADD TO CART

This casual style Maxxis backpack is perfect for school or work.

With dual main compartments and an ultra-padded air mesh back, this backpack will keep you stylish and organized while on the go. Main compartment features padded laptop and tablet/e-reader sleeves for all-in-one carrying ability. An easy access front sleeve pocket and a large secondary compartment provide plenty of space for belongings and essentials. This grey and black backpack has it all - a front zippered pocket with organization panel and key clip, fleece-lined valuables pocket, and ergonomic padded straps with adjustable sternum strap. Showcases the stitched orange Maxxis logo on the front pocket.

Dimensions 19.5"h x 13.5"w

Capacity 2,400 cu.in/39.3L

Weight 2 lbs./0.9kg

MAXXIS.COM | STORE HOME | SITE MAP | ORDERING INFO | PRIVACY | POLICIES | SAFETY AND SECURITY
©2015 MAXXIS INTERNATIONAL - USA.

SHOPPING CART | MY ACCOUNT | CONTACT US



MAXXIS

FACTORY GEAR

ATV / MOTO

AUTOMOTIVE

BICYCLE

TRAILER



STORE HOME » FACTORY GEAR » APPAREL » ACCESSORIES » MESSENGER BAG BY OGIO

0

Like

0

0

Tweet

0

8+1



Corp. City Messenger Bag by OGIO

USD\$ 65.00

ITEM IS AVAILABLE.

ITEM # ZM31050100

- US Shipping Only
- Shipping restrictions prohibit shipment to an APO or APE address

QUANTITY

1

ADD TO CART

Carry your laptop, books, or files without adding bulk or weight.

Made of nylon with wide straps to ensure comfort, plenty of pockets and heavy duty zippers, this bag provides comfort along with versatility. Maxxis logo displayed on front zippered pocket.

Dimensions: 13" h x 18" w x 6" d

Weight: 3.50 lbs

SHOPPING CART | MY ACCOUNT | CONTACT US



MAXXIS

FACTORY GEAR

ATV / MOTO

AUTOMOTIVE

BICYCLE

TRAILER



STORE HOME » FACTORY GEAR » RECREATION

0

Like

0

0

Tweet

0

8+1



Golf Umbrella 62" Arc

USD\$ 34.00

ITEM IS AVAILABLE.

ITEM # ZU20000001

- US Shipping Only
- Shipping restrictions prohibit shipment to an APO or APE address

QUANTITY

ADD TO CART

Stay dry beneath this 62-inch arc umbrella! Its large size keeps you covered, and the durable functionality stands up to strong winds. The orange Maxxis logo is found on a single black panel, and other panels alternate between solid black, and black and white checkered. Stay protected from the storm, and order your Maxxis umbrella today!

1.9 lbs

CERTIFICATE OF SERVICE

I hereby certify that on February 3, 2015, I served this Notice of Opposition on the applicant by mailing a copy thereof by First Class Mail, postage prepaid, addressed to applicant's correspondence address of record as follows:

Norman P. Soloway, Esq.
Hayes Soloway P.C.
4640 E. Skyline Drive
Tucson, AZ 85718-1631

s/ Eleanor Elko

Eleanor Elko