

ESTTA Tracking number: **ESTTA862866**

Filing date: **12/06/2017**

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	Kabushiki Kaisha Hitachi Seisakusho, DBA Hitachi, Ltd.
Granted to Date of previous extension	12/06/2017
Address	6-6, Marunouchi 1-chome, Chiyoda-ku Tokyo, 1008220 JAPAN

Correspondence information	Robert Zelnick McDermott Will & Emery LLP The McDermott Building 500 North Capitol St NW Washington, DC 20001 UNITED STATES Email: kbukrinsky@mwe.com, rzelnick@mwe.com, jmikulina@mwe.com, dciplit@mwe.com, ksandacz@mwe.com Phone: 2027568000
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Applicant Information

Application No	87401829	Publication date	08/08/2017
Opposition Filing Date	12/06/2017	Opposition Period Ends	12/06/2017
Applicant	Absolute Machine Tools, Inc. 7420 Industrial Parkway Lorain, OH 44053 UNITED STATES		

Goods/Services Affected by Opposition

Class 007. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Metalworking machine tools, namely, vertical machining centers, multi-axis vertical machining centers, compound machining centers, horizontal machining centers, grinding centers, computer numerically controlled (CNC) machine tools, drilling and tapping centers, lathes, computer numerically controlled (CNC) lathes, high speed precision lathes, turning centers, multitasking turning centers, multitasking lathes, and 3-D printers, ultrasonic assisted CNC machine tools, additive manufacturing machines for manufacturing three-dimensional objects in the field of industrial and commercial use
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	701266	Application Date	01/09/1959
Registration Date	07/19/1960	Foreign Priority Date	NONE
Word Mark	HITACHI		
Design Mark	HITACHI		
Description of Mark	NONE		
Goods/Services	<p>Class U021 (International Class 007, 009, 011). First use: First Use: 0 First Use In Commerce: 0</p> <p>Electric Generators; Electric Motors; Synchronous Frequency Modifiers; Phase Shift Condensers; Electric Converters; Electric Transformers; Voltage, Current and Motor Speed Controlling Apparatus; Electric Controls for Automotion Processes; Electrical Power Distribution Equipment; Electric Precipitators; Air Cleaners and Sterilizers; Electric Painting Equipment; Electric Welders; Electric Hand Operated Portable Tools; Household Electric Appliances-Namely, Kitchen, Laundry and Lighting; Telephone Sets and Equipment for Telephone Systems; Radio and Television Broadcasting Equipment; Radio and Television Receiving Sets; Electron Discharge Tubes and Parts</p>		

U.S. Registration No.	809784	Application Date	04/01/1964
Registration Date	06/14/1966	Foreign Priority Date	NONE
Word Mark	HITACHI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 006. First use: First Use: 0 First Use In Commerce: 0</p> <p>METALS, METAL CASTINGS, AND FORGINGS-NAMELY, SPECIAL STEEL BARS AND SHEETS, STAINLESS STEELS, DIE STEELS, STRUCTURAL STEELS, HEAT RESISTING STEELS, SPECIAL STEEL FOR TOOLS, CAST STEELS, FORGED STEELS, AND HIGH SPEED METALS</p> <p>Class 007. First use: First Use: 0 First Use In Commerce: 0</p> <p>ROLLING STOCK-NAMELY, DIESEL ELECTRIC LOCOMOTIVES AND FUNICULAR RAILWAY OR CABLE CARS, AND PARTS OF SAME; ELEVATORS AND MOVING STAIRWAYS; MINING MACHINES-NAMELY, WINDING MACHINES, LOADING EQUIPMENT, CONVEYORS, HYDRAULIC HOISTS, ROCK DRILLS, AND PARTS OF SAME; CIVIL ENGINEERING MACHINES-NAMELY, EXCAVATORS, POWER CRANES, TOWER CRANES, TRACTORS, CABLE CRANES, AND PARTS THEREOF; WINCHES, DRAG SCRAPERS, BUCKET ELEVATORS, AND PNEUMATIC CONVEYORS; STEAM TURBINES, GAS TURBINES, INTERNAL COMBUSTION ENGINES, BOILERS, WATER WHEELS AND TURBINES, PUMPS, HYDROCOUPLING AND HYDRO-TORQUE CONVERTERS, COMPRESSORS, AND VACUUM PUMPS; MACHINE TOOLS-NAMELY, MILLING MACHINES, NUMERICALLY CON-</p>		

	<p>TROLLED MACHINE TOOLS, BORING MILLING MACHINES, GEAR HOB-BING MACHINES, SURFACE GRINDERS, AND TRANSFER MACHINES, AND PARTS THEREOF; ROLLING MILLS, PRESSES, HAMMERS, CRUSHERS, AND PAPER-MAKING MACHINES; EQUIPMENT FOR THE CHEMICAL INDUSTRIES-NAMELY, MANUFACTURING PLANTS FOR SYNTHETIC FIBERS OR SYNTHETIC RESINS, PETROCHEMICAL PLANTS, PURIFICATION PLANTS FOR PETROLEUM, SYNTHETIC PLANTS FOR AMMONIA, INDUSTRIAL OXYGEN PRODUCING OR TONNAGE OXYGEN PLANTS, GAS SEPARATING EQUIPMENT, AND PARTS THEREOF; CENTRIFUGAL SEPARATORS, PRINTING MACHINES, CARBURETTORS, CAN OPENERS, SEWING MACHINES, AND ROLLS FOR ROLLINGMILLS AND PRINTING MACHINES</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0</p> <p>CAST MAGNETS, FORGED MAGNETS, ELECTRIC LOCOMOTIVES, BATTERY LOCOMOTIVES, SPARK PLUGS, STARTER DYNAMOS, CHARGING GENERATORS, AND ELECTRIC STARTING MOTORS; POWERDRIVEN HAND TOOLS-NAMELY, PORTABLE ELECTRIC DRILLS, ELECTRIC GRINDERS, AND ELECTRIC TOOLS FOR WOODWORKING; VACUUM CLEANERS; AND PARTS THEREOFELECTRIC AND MAGNETIC METERS-NAMELY, AMPERE METERS, VOLTMETERS, WATTMETERS, WATT-HOUR METERS, AND INSULATION RESISTANCEMETERS; INDUSTRIAL MEASURING INSTRUMENTS-NAMELY, THERMOMETERS, PRESSURE-METERS, FLOWMETERS, AND DYNAMOMETERS; ELECTRONIC APPLIED APPARATUSES-NAMELY, ELECTRONIC COMPUTERS, DATA PROCESSING APPARATUSES, AUTOMATIC CONTROLLING APPARATUSES, ELECTRON MICROSCOPES, PARTICLE ACCELERATORS, RADAR APPARATUSES, LORAN APPARATUSES, AND RADIO BEACON APPARATUSES; SCIENTIFIC MEASURING INSTRUMENTS-NAMELY, MASS SPECTROMETERS, MAGNETIC RESONANCE SPECTROMETERS, SPECTROPHOTOMETERS, PHOTOMETERS, PH METERS, TISELIUS ELECTROPHORESIS APPARATUSES, AND GEIGER COUNTERS</p> <p>Class 011. First use: First Use: 0 First Use In Commerce: 0</p> <p>STATIONARY BOILERSFEED WATER PURIFIERS CONSISTING OF APPARATUS WHICH PURIFIES WATER FOR USE IN BOILERS, AND ELECTRIC DUST COLLECTORS CONSISTING OF APPARATUS WHICH REMOVES FLOATING DUST FROM FOUL AIR BY THE CORONA DISCHARGE OF HIGH-VOLTAGE ELECTRICITY</p> <p>Class 012. First use: First Use: 0 First Use In Commerce: 0</p> <p>ROLLING STOCK-NAMELY, ELECTRIC CARS, DIESEL CARS, PASSENGER CARS, FREIGHT CARS, TANK CARS, AND MONORAIL CARS; AND DUMP TRUCKS</p>
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U.S. Registration No.	3328528	Application Date	01/24/2007
Registration Date	11/06/2007	Foreign Priority Date	NONE
Word Mark	HITACHI		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 1963/00/00 First Use In Commerce: 1963/00/00 full line of computer hardware and computer software for communications, data processing, information technology, industry, and manufacturing; a full line of data storage devices; automated teller machines; backup drives for computers; biometric finger vein recognition and verification scanners; blank smart cards; cameras; CD players; CD recorders; CD-ROM drives; central processing units (CPUs) for computers; computer hardware; computer memory hardware; computer monitors; computer network adaptors; computer network hubs, switches and routers; computer networking hardware; computer peripherals; computer servers; data processors; digital signal processors; digital video recorders; DRAM cards; DVD camcorders; DVDdrives; DVD players; DVD recorders; DVD-RAM drives; DVD-RAM recorders; electricand electronic video surveillance installations; electrical controllers; electron microscopes; electronic computers; flash card readers; flash memory cards; flexible service bandwidth manager for high bandwidth networks; hard disk drives; HDTV broadcast cameras; infrared LEDs; insulated Gate Bipolar Transistors; integrated circuits; inverters; LAN (local area network) operating software; LAN (local area network) hardware; laptop computers; laser diodes; LCD monitors; LCD projection televisions; liquid crystal displays; memory boards; memory card writers; memory cards; micro-controllers; microprocessors; mobile computing and operating platforms consisting of data transceivers, wireless networks and gateways for collection and management of data; multiplexers; network access server hardware;optical disk drives; optical line terminals; optical network terminals; opticalsemiconductor amplifiers; photocopiers;plasma display panels; plasma televisions; power controllers; printers; projection television tubes; radio frequency identification (RFID) tags; RAID (redundant array of independent disks) controllers; rectifiers; RFID readers; robots for personal, home, and industrial use; scanners; semiconductors; sensors, namely, digital compasses, position indicating magnetic encoders, giant magneto-resistive(GMR) sensors, digital magnetic compasssensors and accelerometers; smart card authentication hardware and software; smart card readers; televisions; transponders; TV cameras; video encoders and decoders; WAN (wide area network) hardware; WAN (wide area network) operating software</p>

Attachments	72065558#TMSN.png(bytes) 77089857#TMSN.png(bytes) Notice of Opposition - HITACHI SEIKI - FINAL.pdf(51174 bytes)
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Signature	/s/ Katie Bukrinsky
Name	Katie Bukrinsky
Date	12/06/2017

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

KABUSHIKI KAISHA HITACHI
SEISAKUSHO, d/b/a HITACHI, LTD.,

Opposer,

v.

ABSOLUTE MACHINE TOOLS, INC.,

Applicant.

Opposition No. _____

Serial No: 87/401829

Mark: HITACHI SEIKI

NOTICE OF OPPOSITION

Kabushiki Kaisha Hitachi Seisakusho, d/b/a Hitachi, Ltd., a foreign corporation registered in Japan and located at 6-6, Marunouchi1-chome, Chiyoda-ku, Tokyo, Japan (“Opposer”), will be damaged by registration of the mark HITACHI SEIKI in Application Serial No. 87/401829, filed by Absolute Machine Tools, Inc., an Ohio corporation located at 7420 Industrial Parkway, Lorain, Ohio 44053 (“Applicant”), and opposes registration of same.

1. Opposer is a leading manufacturer and seller of, *inter alia*, commercial and industrial machinery, tools, and electronic systems, and is the owner of the famous HITACHI mark.

2. For almost 100 years, Opposer has used its HITACHI mark in the United States and throughout the world for, *inter alia*, metals, machinery, tooling, electronic and computer systems that operate machinery, and a variety of other goods and services. Opposer has invested millions of dollars advertising and promoting its HITACHI brand and has earned hundreds of millions of dollars in revenue from the sale of HITACHI-branded products in the United States alone.

3. Opposer serves diverse market segments in the U.S. with a broad range of infrastructure, business and consumer products, services and solutions aimed at benefiting customers and society under the HITACHI brand, including information and control systems, telecommunications systems, automotive systems, power systems, electronic systems, healthcare equipment, digital media products, transportation systems, construction machinery, financial services, industrial plant-related equipment, water environment systems, energy management systems, power plants, solar power generation systems, wind turbines, refrigeration equipment, metal products, chemical products, communications products, business consulting services, and home appliances.

4. Opposer's HITACHI marks are famous in the United States. Opposer's HITACHI-branded tools, metals, machinery, and electronic and computer systems are widely used every day by the general consuming public in the United states, including thousands of industries, businesses, and consumers throughout the United States. Hitachi's presence and commitment to the U.S. economy includes about 100 Hitachi group companies and about 20,000 employees.

5. Throughout the decades, Opposer's HITACHI-branded goods and services have been the subject of (or referred to in) thousands of articles in the mainstream press, including in the major newspapers in the United States.

6. The HITACHI brand is regularly ranked in the top 100 strongest brands in the world by leading brand-ranking publications, including *Fortune* and *Forbes*.

7. Opposer's HITACHI-branded goods and services are widely available to the general consuming public throughout the United States, and are utilized by, *inter alia*, consumers, businesses, and industry.

8. In addition to its nationwide common law rights in and to the HITACHI marks for goods and services in the fields of information technology, electronic devices, industrial and

automotive systems, tooling machinery, biomedicine, transportation and logistics, financial services and audiovisual and consumer products, Opposer also owns numerous federal trademark registrations for HITACHI. (Hereafter these registered and common law marks are collectively referred to as Opposer’s “HITACHI Marks.”) Among Opposer’s HITACHI Marks that are perhaps most relevant to this Opposition are the following:

Trademark	Reg. No.	Reg. Date	Selected Goods
HITACHI	0701266 (Incontestable)	July 19, 1960	(Int’l Class: 07) Electric Generators; Electric Motors; Synchronous Frequency Modifiers; Phase Shift Condensers; Electric Converters; Electric Transformers; Voltage, Current and Motor Speed Controlling Apparatus; Electric Controls for Automotion Processes; Electrical Power Distribution Equipment; Electric Precipitators; Air Cleaners and Sterilizers; Electric Painting Equipment; Electric Welders; Electric Hand Operated Portable Tools;
HITACHI	0809784	Jun. 14, 1966	(Int’l Class: 006) Metals, metal castings, and forgings-namely, special steel bars and sheets, stainless steels, die steels, structural steels, heat resisting steels, special steel for tools, cast steels, forged steels, and high speed metals (Int’l Class: 007) Mining machines-namely, winding machines, loading equipment, conveyors, hydraulic hoists, rock drills, and parts of same; civil engineering machines-namely, excavators, power cranes, tower cranes, tractors, cable cranes, and parts thereof; winches, drag scrapers, bucket elevators, and pneumatic conveyors; steam turbines, gas turbines, internal combustion engines, boilers, water wheels and turbines, pumps, hydrocoupling and hydrotorque converters, compressors, and vacuum pumps; machine tools-namely, milling machines, numerically controlled machine tools, boring milling machines, gear hobbing machines, surface grinders, and transfer machines, and parts

Trademark	Reg. No.	Reg. Date	Selected Goods
			thereof; rolling mills, presses, hammers, crushers, and paper-making machines; equipment for the chemical industries- namely, manufacturing plants for synthetic fibers or synthetic resins, petrochemical plants, purification plants for petroleum, synthetic plants for ammonia, industrial oxygen producing or tonnage oxygen plants, gas separating equipment, and parts thereof; centrifugal separators, printing machines, carburettors, can openers, sewing machines, and rolls for rolling mills and printing machines
HITACHI	3328528 (Incontestable)	November 6, 2007	(Int'l Class 009): Printers; scanners

9. Opposer's registrations are valid and subsisting and in full force and effect. Two of the registrations above have achieved incontestable status under 15 U.S.C. §§ 1065 and 1115(b).

10. Opposer's HITACHI Marks are unique and distinctive in the marketplace. Other than Opposer, no party owns a registration containing "HITACHI" on the federal trademark register.

11. Opposer's HITACHI Marks are inherently distinctive because they do not describe an attribute of Opposer's goods.

12. For decades, the public has associated the HITACHI Marks as identifying goods and services emanating exclusively from Opposer.

13. For decades, Opposer's HITACHI Marks have been famous in the United States among the general consuming public.

14. On April 6, 2017, many years after Opposer's HITACHI Marks became famous, Applicant filed intent-to-use application serial no. 87/401829 for HITACHI SEIKI for "[m]etalworking machine tools, namely, vertical machining centers, multi-axis vertical machining centers, compound machining centers, horizontal machining centers, grinding centers,

computer numerically controlled (CNC) machine tools, drilling and tapping centers, lathes, computer numerically controlled (CNC) lathes, high speed precision lathes, turning centers, multitasking turning centers, multitasking lathes, and 3-D printers, ultrasonic assisted CNC machine tools, additive manufacturing machines for manufacturing three-dimensional objects in the field of industrial and commercial use[.]”

15. Applicant’s mark HITACHI SEIKI is substantially similar to Opposer’s HITACHI Marks in sight, sound, meaning and overall commercial impression. Applicant’s mark wholly incorporates Opposer’s famous mark HITACHI, merely adding the descriptive word “seiki,” which Applicant admits means “precision machine tool.”

16. Applicant’s applied-for goods and Opposer’s goods and services are identical and/or related.

17. Applicant’s applied-for goods and Opposer’s goods and services are likely to be sold in the same channels of trade to the same customers.

18. Applicant’s use of HITACHI SEIKI for the applied-for goods is likely to cause confusion, deception, and/or mistake with Opposer and Opposer’s HITACHI Marks.

19. Applicant’s use of HITACHI SEIKI is likely to dilute Opposer’s famous HITACHI Marks.

20. Applicant’s use of HITACHI SEIKI will damage Opposer, its business and its goodwill.

WHEREFORE, Opposer prays that registration of Applicant's mark be denied.

Respectfully submitted,

HITACHI, LTD.

Dated: December 6, 2017

By: /Katie Bukrinsky/
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Attorneys for Opposer

CERTIFICATE OF SERVICE

Opposer Hitachi, Ltd., by and through its attorneys, hereby certifies that a copy of this NOTICE OF OPPOSITION has been served upon Applicant on this 6th day of December, 2017, by First Class U.S. Mail at the following address:

CLARE SMITH LONG
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/ Katie Bukrinsky/_____

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Attorney for Opposer