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

In the matter of application Serial Number 76/208230

Published in the *Official Gazette* on March 19, 2002

FIRST AMENDED NOTICE OF OPPOSITION

PIONEER KABUSHIKI KAISHA dba PIONEER CORPORATION,

Opposer,

v.

NISSEI SANGYO AMERICA, LTD.,

Applicant.

) Opposition No: 125,458
) Name In Dispute: SuperScan Elite
)
)
)

FIRST AMENDED NOTICE OF OPPOSITION



01-28-2004

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

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Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

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I hereby certify that the foregoing **FIRST AMENDED NOTICE OF OPPOSITION** is being deposited with the United States Postal Service, "Express Mail Post Office to addressee" service in an envelope addressed to the to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on January 28, 2004.

Marlene Barnes
Marlene Barnes

FIRST AMENDED NOTICE OF OPPOSITION

1. Opposer Pioneer Kabushiki Kaisha dba Pioneer Corporation (“Pioneer” or “Opposer”), a Japanese corporation located at 4-1, Meguro, 1-Chome, Meguro-Ku, Tokyo 153-8654 and doing business in the United States and throughout the world, will be damaged by registration of the mark shown in Serial Number 76/208230, and hereby opposes this application.

Description of Applicant’s Application

2. The application was filed on February 9, 2001, by Nissei Sangyo America, Ltd. (hereafter “Applicant”) located at 10 Martingale, Suite 500, Schaumburg, IL 60173. The application was published for Opposition in the *Official Gazette* on March 19, 2002. The mark and goods identification are as follows: “SUPERSCAN ELITE” in International Class 009 for video and audio products and systems, namely, televisions, projection televisions, plasma display televisions, video cassette recorders, DVD players, DVD players with built-in DVD recorders, televisions with built-in video cassette recorders, televisions with built-in DVD players, televisions with built-in video cassette recorder and DVD player, audio receivers, audio speakers and home theater systems consisting of any combination of stereo amplifiers, DVD players, video cassette recorders and audio speakers.

Grounds For Opposition

Identification Of Pioneer’s Trademark Rights

3. Pioneer is the owner of United States Trademark Number 1,591,868 for the mark “ELITE” in International Class 009 for the following goods and services: audio and video products, namely, amplifiers; video disc players; compact disc players; combination video disc and compact disc players; monitor televisions; loudspeakers; tuners; and stereo radio/audio

cassette players. Pioneer's ELITE mark was registered on the Principal Register on April 17, 1990, which is a date prior to the date of Applicant's application and prior to the date of Applicant's claimed date of first use. Pioneer's registered mark is valid and subsisting, and is conclusive evidence of Pioneer's exclusive right to use the ELITE mark in commerce on the goods specified in registration number 1,591,868. A true and correct copy of a current status report is attached hereto and incorporated herein by reference as Exhibit "A".

4. Since at least September 9, 1989, Pioneer has been and now is using the mark ELITE in connection with the sale of the goods noted in paragraph 3. Pioneer's use has been valid and continuous since the date of first use and has not been abandoned. Pioneer's ELITE mark is symbolic of extensive good will and consumer recognition built up by Pioneer through substantial amounts of time and effort in advertising and promotion such that Pioneer's ELITE mark is famous within the meaning of *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973) and section 43(c) of the Lanham Act.

5. Applicant seeks to register the word mark "SUPERSCAN ELITE" as a trademark in International Class 009 as a trademark for the goods noted in paragraph 2, as evidenced by the publication of the SUPERSCAN ELITE mark in the *Official Gazette* on March 19, 2002. In its application, Applicant specifically relies on a prior registration, for the mark "SUPERSCAN ELITE," which was for use in connection with computer monitors.

Lanham Act § 2(d) Likelihood Of Confusion

6. In view of the similarity of the respective marks and the related nature of the goods of the respective parties, it is alleged that Applicant's mark so resembles Pioneer's mark previously used in the United States, and not abandoned, as to be likely to cause confusion,

or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act.

7. Pioneer is informed and believes and based thereon alleges that Applicant is the owner of United States Trademark Number 1,888,264 for the mark "SUPERSCAN ELITE" in International Class 009 for goods designated as computer monitors. Applicant's prior registered mark was claimed to be first used in commerce on July 22, 1993 and was registered as a trademark on April 11, 1995.

8. As such, Pioneer has superior rights in and to the ELITE mark because its usage of the mark predates Applicant's usage; there is, therefore, no issue as to priority.

9. If Applicant is granted the registration herein opposed, it would be thereby obtain at least a *prima facie* exclusive right to use of its mark. Such registration would be a source of damage and injury to the Pioneer.

Lanham Act § 2(d) Confusing Similarity

10. Pioneer has sold the ELITE products identified in the paragraph 3 throughout the United States and worldwide.

11. Pioneer alleges that Applicant's most recent application to register SUPERSCAN ELITE in connection with a broader range of goods (audio and video products, namely, amplifiers; video disc players; compact disc players; combination video disc and compact disc players; plasma displays, monitor televisions; loudspeakers; tuners; and stereo radio/audio cassette players), attempts to market Applicant's goods in the same channels of trade as those used by Pioneer.

12. When the SUPERSCAN ELITE mark as currently submitted before the United States Patent and Trademark Office, is applied to goods traveling in the same channels of

trade as those sold by Pioneer, it so nearly resembles Pioneer's mark as to be likely to be confused therewith and mistaken therefor, and will lead to deception or mistakes as to the origin of Applicant's goods bearing the Applicant's mark.

13. If the Applicant is permitted to use and register its mark for its goods, as specified by the application opposed, confusion in trade resulting in damages and injury to Pioneer would be caused and would result by reason of the similarity between the Applicant's mark and Pioneer's mark. Persons familiar with Pioneer's marks would be likely to buy Applicant's goods as and for a product made and sold by Pioneer. Any such confusion in trade inevitably would result in loss of sales to Pioneer. Furthermore, any defect, objection or fault found with Applicant's products marketed under its mark would necessarily reflect upon and seriously injure the reputation which Pioneer has established for its products merchandised under its mark.

14. If Applicant is granted the registration herein opposed, it would be thereby obtain at least a *prima facie* exclusive right to use of its mark. Such registration would be a source of damage and injury to Pioneer.

Lanham Act § 1(b) Failure Of Bona Fide Intention To Use Mark

15. In submitting its application for registration of SUPERSCAN ELITE, Applicant filed its application under Section 1(b) of the Lanham Act as an Intent To Use application.

16. As such, Applicant is required to allege a bona fide intention to use the mark on the goods listed in the application as of the time the application is filed.

17. Pioneer is informed and believes and based thereon alleges, based upon

discovery responses received from Applicant, that at the time Applicant submitted its SUPERSCAN ELITE application to the Patent & Trademark Office, Applicant had no bona fide intention to use the mark and that this lack of bona fide intention violates section 1(b) of the Lanham Act. Accordingly, on this ground registration should be denied.

Lanham Act § 43(c) Dilution Of A Famous Mark

18. Since September 9, 1989, Pioneer has been and now is using the mark ELITE in connection with the sale of the goods identified in paragraph 3 of this Opposition. Pioneer's use has been valid and continuous since the date of first use and has not been abandoned. Pioneer's ELITE mark is symbolic of extensive good will and consumer recognition built up by Pioneer through substantial amounts of time and effort in advertising and promotion such that Pioneer's ELITE mark is famous within the meaning of *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357 (CCPA 1973) and section 43(c) of the Lanham Act.

19. Pioneer's ELITE mark became famous prior to Applicant's constructive use date of February 9, 2001 through hundreds of millions of dollars in sales and millions of dollars in advertising over the course of 14 years.

20. Pioneer's use of the ELITE mark consists of the manufacturing and marketing of consumer electronics products of the highest quality.

21. Consequently, Pioneer's ELITE mark is distinctive because of the extent of recognition that the ELITE mark has earned in the marketplace as a designator of Pioneer's goods.

22. Pioneer is informed and believes and based thereon alleges that Applicant may intend to commercially use the SUPERSCAN ELITE mark on lower quality, mass-produced

consumer electronics products in interstate commerce such that Pioneer's mark would be tarnished by Applicant's use.

23. In view of the famousness of Pioneer's ELITE mark, it is alleged that if Applicant is granted the registration herein opposed, then Pioneer's mark would thereby be lessened in its capacity as a famous mark to identify and distinguish the goods upon which the ELITE mark is used.

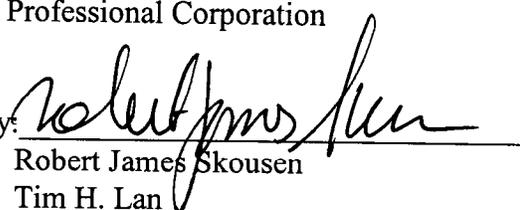
WHEREFORE, Pioneer prays that application Serial Number 76/208230 be rejected, that no registration be issued thereon to applicant, and that this opposition be sustained in favor of Pioneer.

Pioneer hereby appoints Skousen & Skousen, a law firm, all attorneys of which are members of the bar of the State of California, to act as attorneys for Pioneer in this matter, with full power to prosecute this opposition, to transact all relevant business with the Patent and Trademark Office and the United States Courts and to receive all official communication in connection with this opposition.

A duplicate copy of this First Amended Notice of Opposition is enclosed.

January 28, 2004

Skousen & Skousen
A Professional Corporation

By: 

Robert James Skousen

Tim H. Lan

Attorneys for Opposer Pioneer Kabushiki
Kaisha dba Pioneer Corporation
12400 Wilshire Blvd., Suite 900
Los Angeles, CA 90025-1060
Telephone: (310) 277-0444
Facsimile: (310) 782-9579

CERTIFICATE OF MAILING

I hereby certify that the foregoing **FIRST AMENDED NOTICE OF OPPOSITION** is being deposited with the United States Postal Service, first class postage prepaid, in an envelope addressed to William T. McGrath, Esq., Davis, Mannix & McGrath, 125 South Wacker Drive, Suite 1700, Chicago, Illinois 60606, on January 28, 2004.

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