



11-06-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #73

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

In the Matter of Application Serial No. 76/002621  
Filed March 17, 2000  
For the mark FOXCOTM  
Published in the *Official Gazette* on July 10, 2001

<p style="text-align: center;">TWENTIETH CENTURY FOX FILM CORPORATION Opposer,</p> <p style="text-align: center;">v.</p> <p style="text-align: center;">HON HAI PRECISION INDUSTRY CO., LTD. Applicant.</p>	<p>)</p>	<p>Opposition No. _____</p>
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BOX TTAB  
FEE  
Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202

**NOTICE OF OPPOSITION**

Opposer TWENTIETH CENTURY FOX FILM CORPORATION, a corporation organized and existing under the laws of the State of Delaware, United States of America, with a principal place of business located at 10201 West Pico Boulevard, Los Angeles, California, 90035, ("Opposer") believes that it has or will be damaged by the registration of application Serial No. 76/002621 for FOXCOTM and hereby opposes such application.

As grounds for opposition, Opposer alleges as follows:

1. According to the records of the United States Patent and Trademark Office, Applicant HON HAI PRECISION INDUSTRY CO., LTD., a corporation organized and existing under the laws of the country of Taiwan, filed its application to register FOXCOM for “network and computer software programs designed for use as engagement management tools such as project, resource, budget and time tracking management that may be downloaded from a global computer network” in International Class 9; for “design of computers and computer peripherals for others; design of electric communication products for others; design of computer network components for other; computer services, namely, providing a site on a global computer network featuring information in the field of computers and e-commerce software and program production; computer services, namely, designing and maintaining web sites for others; computer services, namely, testing e-commerce computer software and programs for others; commercial art design and consultation in the field of commercial art design and application service provider services, namely, hosting network and computer software programs designed for use as engagement management tools such as project, resource, budget and time tracking management via a global computer network” in International Class 42. The Application was published in the July 10, 2001 edition of the *Official Gazette*.

2. On or about August 7, 2001, Opposer requested a sixty (60) day extension of time in which to file a Notice of Opposition to the registration of Applicant’s trademark, which was subsequently granted.

3. On or about October 3, 2001, Opposer requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant’s trademark, which

was subsequently granted.

4. On or about November 28, 2001, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

5. On or about December 14, 2001, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

6. On or about January 28, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

7. On or about March 4, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

8. On or about April 2, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

9. On or about April 29, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

10. On or about May 28, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

11. On or about June 26, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

12. On or about August 2, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

13. On or about August 23, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

14. On or about October 7, 2002, Opposer, with consent from Applicant's counsel, requested a thirty (30) day extension of time in which to file a Notice of Opposition to the registration of Applicant's trademark, which was subsequently granted.

15. Opposer is the owner of the several trademarks registered with the United States Patent and Trademark Office for a variety of goods and services which incorporate the word "fox" (hereinafter referred to the "FOX" Marks). Among these FOX Marks, Opposer has registered the trademark FOX.COM, Reg. No. 2529197 for "Providing on-line information in the field of television and motion picture film entertainment via a global communications network." Attached hereto as "Exhibit A" is a true and correct listing of Applicant's registered trademarks that incorporate the word "fox." These registrations are valid, in full force and effect and conclusive evidence of Opposer's rights to use the trademarks.

16. Opposer also has filed several applications for trademark registrations for trademarks incorporating the word "fox" with the United States Patent and Trademark Office for

the following goods and services. Attached hereto as "Exhibit B" is a true and correct listing of Applicant's pending trademark applications that incorporate the word "fox."

17. Opposer has used the trade name FOX , as part of TWENTIETH CENTURY FOX (Reg. No. 336090), since as early as 1936. It has also used the trademark FOX.COM (Reg. No. 2529197), to identify its services, since at least as early as 1997, more than three years before Applicant filed Application Serial No. 76/002621.

18. Opposer has extensively advertised, sold its goods and provided its services, including a Internet website at "www.fox.com," and has created widespread goodwill, under its FOX Marks throughout the United States and throughout the world. The FOX Marks have become extremely valuable assets of Opposer and are principal symbols of its extensive goodwill. By reason of such wide advertising and wide distribution of Opposer's goods and services bearing its FOX marks, consumers have come to recognize Opposer's marks as signifying Opposer and as identifying Opposer as the source of goods and services bearing the FOX Marks.

19. The products and services identified in Application Serial No. 76/002621 and the products and services offered by Opposer are closely related and are of the type which could be sold in the same channels of trade and to the same prospective customers.

20. If Application Serial No. 76/002621 is registered, the public will reasonably believe that Applicant's products and services are provided by Opposer, all to the detriment of the consumers and Opposer.

21. Applicant's proposed mark FOXCOM is confusingly similar to Opposer's FOX.COM trademarks, Opposer's "www.fox.com" Internet websites, and the FOX Marks and is

likely to be confused therewith. Applicant's proposed mark is deceptively similar to Opposer's trademarks so as to cause confusion, mistake or deception as to the origin of Applicant's goods and services, and it is likely to cause irreparable harm to Opposer and to consumers.

22. Opposer's famous FOX marks will be diluted by the registration and/or use by Applicant of its FOXCUM mark.

23. In addition to any rights arising from the registration of Opposer's mark, Opposer has, with respect to its products, valid common law rights in its FOX Marks set forth above. Applicant's proposed mark FOXCUM is in violation and derogation of those common law rights and is likely to cause confusion, mistake and deception among purchasers and users as to the source or origin of the products, thereby causing loss, damage and injury to Opposer and the consuming public.

24. If Serial No. 76/002621 proceeds to registration, Applicant would thereby obtain and prima facie right to use its FOXCUM mark. Such registration would be a source of damage and injury to Opposer.

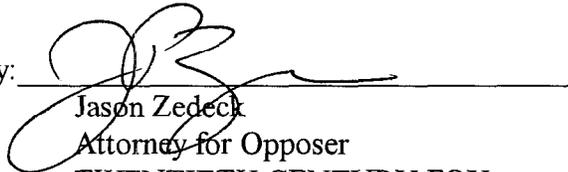
WHEREFORE Opposer requests that Serial No. 76/002621 be rejected and registration thereof be denied, and that this Opposition be sustained in favor of Opposer.

This notice is submitted in duplicate pursuant to 37 C.F.R. § 2.104(a). Please charge the statutory fee for filing a notice of opposition in the amount of \$600.00 (\$300.00 per class), pursuant to 37 C.F.R. § 2.6, to Deposit Account No. 06-1827.

Dated: November 6, 2002

Opposer TWENTIETH CENTURY FOX  
FILM CORPORATION,

by: \_\_\_\_\_

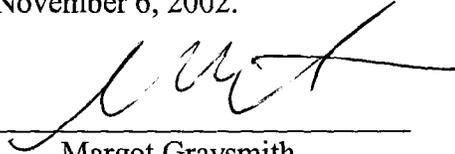


Jason Zedeck  
Attorney for Opposer  
TWENTIETH CENTURY FOX  
FILM CORPORATION

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"Express Mail" mailing label number EL 894949685

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on November 6, 2002.



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Margot Graysmith



**FOX GROUP**  
A UNIT OF NEWS CORPORATION



11-06-2002

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**Jason P. Zedeck**  
Counsel  
Intellectual Property

**EXPRESS MAIL**

November 6, 2002

Assistant Commissioner of Trademarks  
Attn: Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513  
BOX TTAB  
FEE

RE: Twentieth Century Fox Film Corporation opposition in the United States against:  
Trademark: **FOXCOM**  
Applicant: Hon Hai Precision Industry Co. Ltd.  
Serial No.: 76002621  
Date Filed: March 17, 2000

Dear Sir:

Enclosed find the Notice of Opposition, a copy thereof, and a confirmation post card.

Please sign and return the enclosed post card acknowledging receipt of this document.

Thank you for your courtesy and cooperation.

Very truly yours,  
Jason P. Zedeck

Enclosure  
JZ/mg