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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 No. 78/416,092
Filed on May 10, 2004
For the Mark ACCUTRAC
Published in the *Official Gazette* on February 9, 2005

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Bulova Corporation,	:	
	:	Opposition No. _____
Opposer,	:	
	:	Serial No. 78/416,092
-v-	:	Published: February 9, 2005
	:	Trademark: ACCUTRAC
Hyperion Concepts LLC,	:	
	:	
Applicant.	:	
-----	X	

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

04/07/2005 ZCLIFT01 00000035 78416092

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300.00 (P)

NOTICE OF OPPOSITION

Opposer, Bulova Corporation, a corporation organized and existing under the laws of New York, having an address at One Bulova Avenue, Woodside, NY 11377-7874, believes that it will be damaged by the registration of the mark ACCUTRAC in the name of Hyperion Concepts LLC ("Hyperion" or "Applicant"), published in the *Official Gazette* on February 9, 2005 (the "Applied-for Mark") and hereby opposes the same.

As grounds for this Opposition, Bulova Corporation relies upon the rights developed by it and related companies (hereinafter referred to as "Bulova" or "Opposer") and alleges on knowledge as to itself and otherwise upon information and belief, as follows:

1. Bulova has been engaged in the sale in the United States of watches under the mark ACCUTRON since March 31, 1960.



2. Prior to Applicant's filing of its applications, Opposer obtained the following registrations (hereinafter the "ACCUTRON Registrations," "ACCUTRON Marks" or "Opposer's Marks"):

<u>Trademark</u>	<u>Registration No.</u>	<u>Registration Date</u>	<u>Goods</u>
ACCUTRON	709,055	December 27, 1960	(IC 014) Watches
ACCUTRON	807,251	April 19, 1966	(IC 014) Electronic cycle timers, electronic five-year switches, and electronic calendar clocks for industrial use
BULOVA ACCUTRON	996,116	October 22, 1974	(IC 014) Watches and parts thereof

Copies of these registrations are attached hereto as Exhibit A.

3. The ACCUTRON Registrations are valid and subsisting, unrevoked and uncanceled, and are prima facie evidence of the validity of Opposer's exclusive right to use the ACCUTRON Marks in commerce in connection with watches, without condition or limitation, and constitute constructive notice of Opposer's ownership of the ACCUTRON Marks for the goods described in the registrations, namely watches, as provided for by §§ 7(b) and 22 of the Lanham Act, 15 U.S.C.A. §§ 1057(b) and 1072 (2005).

4. The ACCUTRON Registrations are incontestable under § 15 of the Lanham Act, 15 U.S.C.A. §1065.

5. Opposer has expended substantial amounts of time and effort in advertising and promoting its watches under the ACCUTRON Marks. As a result of such advertising and promotional activities, the ACCUTRON Marks have become famous, the relevant public has come to associate and identify ACCUTRON with Opposer and Opposer derives substantial goodwill from such identification by consumers.

6. On May 10, 2005, Applicant filed a trademark application for the mark ACCUTRAC for use in connection with “clocks” in International Class 14.

Count: Likelihood of Confusion

7. Opposer hereby incorporates by reference the allegations in Paragraphs 1 through 6 hereof as if fully set forth herein.

8. Applicant’s mark ACCUTRAC, as set forth in the application opposed herein, is substantially similar in commercial impression to Opposer’s ACCUTRON Marks. The term “accutrac” is nearly identical in sound and appearance to the term “accutron.” The marks differ by only two letters.

9. The Applied-for Mark covers clocks in International Class 14 and the ACCUTRON Marks cover watches in International Class 14. These goods are closely related.

10. Due to the high degree of inherent distinctiveness, the duration and extent of use, the duration and extent of advertising and publicity, the geographical extent of the trading area, and the degree of recognition, Opposer’s ACCUTRON Marks are “famous” pursuant to Section 43 (c) of the Lanham Act, 15 U.S.C.A. § 1125(c).

11. The fame of the ACCUTRON Marks makes confusion more likely between marks which contain the prefix “accutr-” and which cover related goods, on the one hand, and the ACCUTRON Marks, on the other.

12. Further, there are no third-party registrations for marks which begin with the prefix “accutr-” for watches or related goods, which indicates that the ACCUTRON Marks are strong in relation to the covered goods.

13. Accordingly, the Applied-for Mark is likely to cause confusion, mistake, or to deceive the public into believing that Applicant's goods are somehow affiliated or associated with, connected to or sponsored by Opposer, in violation of Section 2(d) of the Lanham Act.

14. If Applicant is permitted to register or use the mark herein opposed, confusion would be likely as to the sponsorship of the goods, resulting in damage and injury to Opposer by reason of the similarity between the Applied-for Mark and Opposer's Marks. Persons familiar with Opposer's ACCUTRON Marks will be likely to purchase Applicant's goods, believing them to be affiliated or associated with, connected to or sponsored by Opposer. Likewise, persons exposed to the Applied-for Mark who subsequently become acquainted with Opposer's ACCUTRON Marks are likely to conclude that the goods offered by Opposer under its marks are in some manner affiliated or associated with, connected to or sponsored by Applicant. Any such confusion as to sponsorship inevitably would result in damage and injury to Opposer.

15. Opposer will be damaged by registration of the mark shown in the application opposed herein because such registration will support and assist Applicant in the confusing and misleading use of the Applied-for Mark, and will give color of rights to Applicant in violation of Opposer's prior and superior statutory and common-law rights in the ACCUTRON Marks.

WHEREFORE, Bulova requests that this Opposition be sustained and that the application for registration of the mark ACCUTRAC be in all respects denied.

Dated: New York, New York
March 30, 2005

Respectfully submitted,

HUGHES HUBBARD & REED LLP

By: Perla M. Kuhn
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Attorneys for Opposer

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451

on March 30, 2005

HUGHES HUBBARD & REED LLP

Dated: 3/30/05 By: Cecelia Rabena

CECELIA

Name: CELIA RABENA
RABENA

RECYCLED

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-03-29 17:00:59 ET

Serial Number: 72095054 Assignment Information

Registration Number: 709055 Assignment Information

Mark (words only): ACCUTRON

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2001-01-24

Filing Date: 1960-04-14

Transformed into a National Application: No

Registration Date: 1960-12-27

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2001-01-24

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BULOVA CORPORATION

Address:

BULOVA CORPORATION
ONE BULOVA AVENUE
WOODSIDE, NY 113777874
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

U.S. Class: 027 (International Class 014)

Watches

First Use Date: 1960-03-31

First Use in Commerce Date: 1960-03-31

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2001-01-24 - Second renewal 10 year

2001-01-24 - Section 8 (10-year) accepted/ Section 9 granted

2000-06-12 - Combined Section 8 (10-year)/Section 9 filed

1984-10-25 - Section 8 (6-year) accepted & Section 15 acknowledged

1980-12-27 - First renewal

CORRESPONDENCE INFORMATION

Correspondent

PERLA M. KUHN (Attorney of record)

PERLA M. KUHN
HUGHES HUBBARD & REED LLP
ONE BATTERY PARK PLAZA
NEW YORK, N. Y. 10004-1482

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-03-29 17:00:40 ET

Serial Number: 72218384 Assignment Information

Registration Number: 807251 Assignment Information

Mark (words only): ACCUTRON

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 1986-03-11

Filing Date: 1965-05-10

Transformed into a National Application: No

Registration Date: 1966-04-19

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 2001-10-25

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BULOVA WATCH COMPANY, INC.

Address:

BULOVA WATCH COMPANY, INC.

BULOVA PARK

FLUSHING, NY

United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

U.S. Class: 026 (International Class 009)

ELECTRONIC CYCLE TIMERS, ELECTRONIC FIVE-YEAR SWITCHES, AND ELECTRONIC CALENDAR CLOCKS FOR INDUSTRIAL USE

First Use Date: 1961-05-17

First Use in Commerce Date: 1961-05-17

Basis: 1(a)

ADDITIONAL INFORMATION

Prior Registration Number(s):

709055
782828
785768

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1986-04-19 - First renewal

1985-12-27 - Section 9 filed/check record for Section 8

CORRESPONDENCE INFORMATION

Correspondent

KUHN & MULLER
THE CHRYSLER BUILDING, 32ND FLOOR
405 LEXINGTON AVENUE
NEW YORK, NY 10174

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2005-03-29 16:59:28 ET

Serial Number: 73008521 Assignment Information

Registration Number: 996116 Assignment Information

Mark (words only): BULOVA ACCUTRON

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 1995-05-10

Filing Date: 1973-12-07

Transformed into a National Application: No

Registration Date: 1974-10-22

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 900 -File Repository (Franconia)

Date In Location: 1995-06-28

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. BULOVA CORPORATION

Address:

BULOVA CORPORATION
ONE BULOVA AVENUE
NEW YORK, NY 11377

United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 014

WATCHES AND PARTS THEREOF

First Use Date: 1971-12-31

First Use in Commerce Date: 1971-12-31

Basis: 1(a)

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=73008521>

3/29/2005

ADDITIONAL INFORMATION

Prior Registration Number(s):

226889

938614

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1995-05-10 - First renewal 10 year

1995-04-18 - Response received for Post Registration action

1994-12-01 - Post Registration action mailed - Section 9

1994-10-17 - Section 9 filed/check record for Section 8

1994-10-11 - Section 9 filed/check record for Section 8

1980-04-01 - Section 8 (6-year) accepted & Section 15 acknowledged

CORRESPONDENCE INFORMATION

Correspondent

BARBARA H. LOEWENTHAL (Attorney of record)

BARBARA H. LOEWENTHAL
KUHNS AND MULLER
THE CHRYSLER BUILDING
405 LEXINGTON AVENUE
NEW YORK, NY 10174**Domestic Representative**

KUHNS AND MULLER