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Filing date: **10/25/2006**

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	Microsoft Corporation
Granted to Date of previous extension	10/25/2006
Address	One Microsoft Way Redmond, WA 98052-6399 UNITED STATES
Attorney information	William O. Ferron, Jr. Seed Intellectual Property Law Group PLLC 701 Fifth Avenue, Suite 5400 Seattle, WA 98104 UNITED STATES BillF.docketing@SeedIP.com, litcal@SeedIP.com Phone:206-622-4900

Applicant Information

Application No	78579177	Publication date	06/27/2006
Opposition Filing Date	10/25/2006	Opposition Period Ends	10/25/2006
Applicant	GROOVE MOBILE, INC. 3 RIVERSIDE DRIVE ANDOVER, MA 01810 UNITED STATES		

Goods/Services Affected by Opposition

Class 038. All goods and services in the class are opposed, namely: Electronic telecommunication services, namely, the transmission of music, videos, ring tones and games over a wireless communication network	
Related Proceedings	Opposition No. 91173572, Microsoft Corporation v. Groove Mobile, Inc.
Attachments	MS-GrooveNotOpp.pdf (7 pages)(217851 bytes)
Signature	/William O. Ferron, Jr./
Name	William O. Ferron, Jr.
Date	10/25/2006

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

MICROSOFT CORPORATION,)
)
) Opposer,) Opposition No. _____
)
 v.) Serial No. 78/574202
) Serial No. 78/579177
GROOVE MOBILE, INC.,)
)
) Applicant.)
 _____) Attorney Docket No. 669005.881

NOTICE OF OPPOSITION

Opposer Microsoft Corporation, which has a place of business at One Microsoft Way, Redmond, Washington 98052-6399, believes that it will be damaged by registration of the mark GROOVE MOBILE shown in United States Trademark Application Serial No. 78/574202 (“the ’202 Application”) and the mark GROOVE MOBILE & DESIGN shown in United States Trademark Application Serial No. 78/579177 (“the ’177 Application”), both filed in International Class 38 by Groove Mobile, Inc. (“Applicant”) on February 24, 2005 and March 3, 2005, respectively, and published for opposition on June 27, 2006.

Opposer has requested and received an extension of time until October 25, 2006 in which to oppose the application.

The grounds for this Opposition are as follows:

1. Opposer is in the business of marketing a wide variety of computer-related products and services including products and services related to telecommunications software and transmission of information.

2. Commencing as early as October 24, 2000, Opposer and its wholly-owned subsidiary and predecessor-in-interest Groove Networks, Inc. (hereafter “Predecessor”) adopted and have continuously used the mark GROOVE and variants thereof in interstate commerce in

the United States as trademarks in connection with providing telecommunications connections to computer networks, wireless networks, and the Internet, electronic transmission of information via computer networks, wireless networks, the Internet, electronic communications networks and digital networks, telecommunications gateway services, consulting services in the field of telecommunications; providing online chat rooms and electronic bulletin boards for computer users in the field of project management and shared workgroup projects and documents, web messaging services, and network conferencing services.

3. Opposer and its Predecessor have obtained and own U.S. Trademark Registration No. 2,532,924 for the mark GROOVE for “computer software used to facilitate and coordinate asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information; downloadable electronic publications in the nature of reports and manuals about computer software, computer technology or electronic information” in International Class 9; “printed publications in the nature of reports and manuals about computer software, computer technology or electronic information” in International Class 16; “computer and user directory listings of the development, deployment, use and distribution of software used to facilitate and coordinate asynchronous interpersonal communications and collaboration among third-party software programs” in International Class 35; “providing electronic storage, namely, a database containing user communications messages intended for third-parties” in International Class 39; “training in the use and operation of computer software used to facilitate and coordinate asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information” in International Class 41; and “support services, namely, software maintenance, help desk services, and; providing electronic databases containing information in the field of development, deployment, use and distribution of software used to facilitate and coordinate asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information; computer consultation in the fields of software, networks, information systems, and high technology;

documentation and development services in the fields of software, networks, information systems, and high technology” in International Class 42. The registration is valid and subsisting.

4. Opposer and its Predecessor have obtained and own U.S. Trademark Registration No. 2,830,702 for the mark GROOVE for “computer software used to facilitate and coordinate synchronous and asynchronous communications and collaboration among users, third-party software programs, computer servers or processors; downloadable electronic publications in the nature of magazines, reports, business plans, and manuals about computer software, computer technology or electronic information” in International Class 9; “printed publications in the nature of magazines, reports, business plans, and manuals about computer software, computer technology or electronic information” in International Class 16; “providing computer and user directory listings in the fields of development, deployment, use and distribution of software used to facilitate and coordinate synchronous and asynchronous interpersonal communications and collaboration among third-party software programs” in International Class 35; “provision of telecommunications connections to a global computer network” in International Class 38; “providing electronic storage, namely, a database containing user communications messages intended for third-parties” in International 39; “Training in the use and operation of computer software used to facilitate and coordinate synchronous and asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information; and of hardware containing a microprocessor or microcontroller and controllable by software or firmware” in International Class 41; and “support services, namely, software maintenance; technical help desk support services, namely, troubleshooting and maintenance of computer software problems via telephone and online; providing electronic databases containing information in the field of development, deployment, use and distribution of software used to facilitate and coordinate synchronous and asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information; computer consultation in the fields of software, networks, information systems, and computer high technology; computer development

services in the field of software, networks, information systems and computer high technology; computer services, namely, consultation, development, modification and design of computer programs for others” in International Class 42. The registration is valid and subsisting.

5. Opposer and its Predecessor have obtained and own U.S. Trademark Registration No. 2,489,347 for the mark GROOVE for “computer services, namely, consultation, development, modification and design of computer programs for others; providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information” in International Class 42. The registration is valid and subsisting.

6. Opposer and its Predecessor have applied for registration of the mark GROOVE for “electronic transmission of software, messages, data, text, sound, graphics and video via computer networks, wireless networks and the Internet; information transmission via electronic communications networks and digital networks; providing telecommunications connections to computer networks, wireless networks and the Internet; telecommunications gateway services; consulting services in the field of telecommunications; providing information in the field of web access via computer networks, wireless networks and the Internet; providing online chat rooms and electronic bulletin boards for transmission of messages among computer users in the field of project management and shared workgroup projects and documents; web messaging services; and network conferencing services” in International Class 38, claiming a first-use date of October 24, 2000. The application is presently pending as Serial No. 78/724604. Applicant’s ’202 and ’177 Applications have been cited against that application.

7. Opposer and its Predecessor have used and own common law rights in the mark “GROOVE MOBILE WORKSPACE” which pre-date Applicant’s applications for and first use of its marks.

8. Opposer and Predecessor have used and continue to use the mark GROOVE in combination with other terms to form composite marks, including, but not limited to, the composite marks GROOVE NETWORKS and GROOVE WORKSPACE. Opposer and its Predecessor have obtained and own U.S. Trademark Registration No. 2,547,606 for the mark

GROOVE NETWORKS and U.S. Trademark Registration No. 2,854,380 for the mark GROOVE WORKSPACE.

9. Since commencing use of the mark GROOVE and its variants as described above (“GROOVE Marks”), Opposer and its Predecessor have generated and continue to generate substantial revenue from the sale of goods in connection with the marks in the United States. Additionally, Opposer and its Predecessor have expended and Opposer continues to expend substantial sums of money, time, and effort in advertising, promoting and popularizing the GROOVE Marks in the United States.

10. As a result of the use of the GROOVE Marks as alleged above, and the advertising and promotion of products and services sold in connection with those, the GROOVE Marks have become well known in the United States and are recognized as identifying Opposer’s high-quality products and services. Thus, the GROOVE Marks and the associated goodwill are valuable assets of Opposer.

11. In the ’202 Application, Applicant has applied to register the mark GROOVE MOBILE for electronic telecommunications services, namely, the transmission of music, video, ring tones and games over a wireless communication network in International Class 38. In the ’177 Application, Applicant has applied to register the mark GROOVE MOBILE & Design for electronic telecommunications services, namely, the transmission of music, video, ring tones and games over a wireless communication network in International Class 38.

12. The appearance of Applicant’s GROOVE MOBILE and Design mark shown above and in the ’177 application is dominated by the word “groove” in the mark.

13. The term “MOBILE” is descriptive of the services for which Applicant seeks registration, in the ’202 and ’177 applications.

14. Applicant has disclaimed “MOBILE” in the ’202 and ’177 applications.

15. Applicant’s GROOVE MOBILE and Design mark for which it seeks registration in the ’177 application appears as follows:



16. The goods described in Applicant's applications are so closely related to Opposer's telecommunication and information-transmission products and services that confusion is likely to result if the parties' respective products and services are marketed and sold under the same or confusingly similar marks.

17. The marks GROOVE MOBILE and GROOVE MOBILE & Design for the goods described in Applicant's applications are confusingly and deceptively similar to Opposer's GROOVE Marks for Opposer's above-described products and services, such that the trade and purchasing public will be confused by and deceived into believing that Applicant's goods originate with Opposer, or are otherwise authorized by, sponsored by, licensed by, affiliated with, or associated with Opposer.

18. Upon information and belief, Applicant has not made use of GROOVE MOBILE or GROOVE MOBILE & Design as a trademark in connection with the goods listed in either application, or in connection with any other goods or services, in interstate commerce in the United States or in commerce between the United States and any foreign country, prior to the first use of the GROOVE Marks by Opposer and its Predecessor.

19. Upon information and belief, Applicant has not made use of GROOVE MOBILE or GROOVE MOBILE & Design as a trademark in connection with the goods listed in either application, or in connection with any other goods or services, in interstate commerce in the United States or in commerce between the United States and any foreign country, prior to the February 24, 2005 and March 3, 2005 filing dates of the '202 Application and the '177 Application, respectively.

20. By reason of the foregoing, Opposer would be greatly damaged by the registration of the GROOVE MOBILE and GROOVE MOBILE and Design marks, or either of them, to Applicant.

WHEREFORE, Opposer prays that this Opposition be sustained, Applicant's application denied and the mark refused registration.

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DATED this 26th day of October, 2006.

Respectfully submitted,

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