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

Proceeding	91175892
Party	Plaintiff Microsoft Corporation Microsoft Corporation Microsoft Corporation One Microsoft Way Redmond, WA 98052-6399 UNITED STATES
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Attachments	SP-AmendedNoticeOfOpposition(ZuneGear).PDF (7 pages)(217198 bytes)

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

MICROSOFT CORPORATION,	)	
	)	
Opposer,	)	**Opposition No. 91175892**
	)	(Consolidated with
v.	)	Opposition No. 91175893)
	)	
MARK T. DANIEL,	)	Serial No. 78/930482 for
	)	ZUNEGEAR
Applicant.	)	
	)	Attorney Docket No. 664005.899

AMENDED NOTICE OF OPPOSITION
(U.S. TRADEMARK APPLICATION SERIAL NO. 78/930482)

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 ZUNEGEAR shown in United States Trademark Application Serial No. 78/930482 ("the '482 Application"), filed in International Class 9 by Mark T. Daniel ("Applicant") on July 16, 2006, and published for opposition on February 27, 2007.

The grounds for this Opposition are as follows:

1. Opposer is in the business of marketing a wide variety of computer, software and entertainment-related products and services, including entertainment devices and services.

2. Opposer has adopted the mark ZUNE for its portable music devices and related accessories and services.

3. Opposer owns U.S. Trademark Application No. 78/953571 (the '571 Application) with an effective priority date of May 29, 2006, for the mark ZUNE for the following goods and services:

multimedia player, entertainment and communications devices; peripherals and accessories for use with multimedia player entertainment and communications devices, namely, wired devices for use with multimedia players; battery packs; speakers; stereo amplifier and speaker base stations; audio recorders; radio receivers; software for connecting multimedia players to existing audiovisual systems in automobiles; memory devices for storing music, audio and other digital content; computer software for use with multimedia player, entertainment and communications devices for recording, organizing, transmitting, manipulating and reviewing text, data, audio, image and video files; a full line of computer application software for use on multimedia player, entertainment and communications devices; sacks, bags, straps, armbands and clips all for use with multimedia player, entertainment and communications devices; computer hardware for recording, playing and organizing music and video recordings; computer hardware and software for online accessing and purchasing of music, videos and other digital recordings; and cell phones; computer software for operating cell phones; peripherals and accessories for use with cell phones in International Class 9;

publications, namely, user manuals, magazines and newsletters all in the field of music, videos, entertainment, and multimedia player, entertainment and communications devices; pens, pencils, markers, stationery, stationery-type portfolios, clipboards, desk sets, pen and pencil holders, mounted and unmounted photographs, posters, magnetic boards, memo pads, binders, staplers, paperweights, paper coasters, calendars, notebooks, book covers, sticker books, greeting cards and note cards in International Class 16;

shins, vests, sweatshirts, sweaters, sweatpants, pants, overalls, shorts, rompers, jackets, caps, pajamas, robes, night shirts, suspenders, jumpsuits, coats, sweatbands, scarves, gloves, mittens, socks, hosiery, stockings, underwear, footwear, headwear, hats, ties, visors, wrist bands, cloth bibs, aprons and Halloween and masquerade costumes in International Class 25;

toys and games, namely, action figures and accessories therefor; balloons; bathtub toys; toy building blocks; dolls and accessories therefor; doll clothing; board games; card games; play cosmetics for children; costume masks; miniature die cast vehicles; toy airplanes and helicopters; battery operated remote controlled toy vehicles; flying discs; inflatable vinyl figures; jigsaw puzzles; kites; marbles; indoor slumber and play tents; plush toys; hand-held puppets; sit-in and ride-on toy vehicles; train sets; play shaving kits; skateboards; roller skates; toy banks; water squirting toys; toy pistols; Christmas tree ornaments; pinball and arcade game machines; hand-held units for playing electronic games; model craft kits of toy figures; playground balls; sport balls; basketballs; golf balls; golf ball markers; tennis balls; baseballs; rubber action balls; rubber sports balls; rubber playing balls; squeezable balls used to relieve stress; bags for carrying golf equipment; bags for carrying basketball equipment; bags for carrying baseball equipment; bags for carrying tennis equipment; manipulative puzzles and construction toys;

crib mobiles; mobiles for children; target sets consisting of a target, rubber suction darts and toy dart gun; and playing cards in International Class 28;

online retail store featuring multimedia players, entertainment and communications devices, cell phones and peripherals and accessories therefor, and digital recordings in International Class 35;

telecommunication services; electronic transmission of data files, documents, music and videos over the Internet and wireless networks; electronic mail services; web messaging services; text messaging services; paging services; streaming of audio and video material over the Internet and wireless networks; wireless voice mail services; voice-activated dialing services; providing wireless access to computer networks and the Internet; cellular telephone services; and audio, video and television broadcasting and transmission in International Class 38; and

entertainment services; providing information on the music, video and entertainment industries; providing website featuring downloadable music, videos and other digital content and allowing website users to interact with one another in International Class 41.

4. Opposer owns U.S. Trademark Application No. 78/977970 (the '970 Application), with an effective priority date of May 29, 2006, for the mark ZUNE for the following goods and services:

multimedia player and entertainment devices, namely portable video and MP3 players; peripherals and accessories for use with multimedia player entertainment and communications devices, namely, headphones; earphones; docking stations for use with multimedia players; wireless remote control devices for use with multimedia players; battery chargers; electrical connectors, wires, cables, and adaptors; automobile stereo adapters; radio transmitters; hardware for connecting multimedia players to existing audiovisual systems in homes and offices; carrying cases for use with multimedia player and entertainment devices; computer software for recording, playing and organizing music and video recordings in International Class 9;

online retail store featuring music and video in International Class 35; and

entertainment services, namely, providing website featuring information in the fields of music, video and entertainment in International Class 41.

5. Opposer adopted its ZUNE mark at least as early as May 2006 and filed its first trademark application for ZUNE on May 29, 2006.

6. Word of Opposer's selection of ZUNE as the mark for its new digital music/MP3 player began to leak to the public after May 2006, and became known to Applicant, users and the industry at least as early as July 11, 2006. Opposer made use of its ZUNE mark in preparation for and analogous to formal trademark use at least as early as July 11, 2006. Opposer's adoption and use of ZUNE had a substantial impact on the purchasing public, resulting in an identification in the mind of the consuming public between the ZUNE mark and Opposer's ZUNE goods and services since at least July 11, 2006. For example, throughout the month of July 2006, prior to the filing date of Applicant's intent-to-use application, Opposer's adoption and use of ZUNE resulted in a significant amount of third-party discussion and reporting on Internet blogs, discussion forums and on-line new magazines mentioning, referring to and discussing Opposer's new ZUNE digital music/MP3 player and Opposer's planned use of ZUNE for a family of products and services including, *inter alia*, an on-line music service and an Xbox-like portable video game machine. Opposer officially announced the adoption of its ZUNE mark to the public in July 2006, and since that time Opposer has continuously used the ZUNE mark in commerce to promote its digital media player, accessories therefor and online music and video sales and services.

7. Opposer's common law rights and trademark seniority extend back to at least July 11, 2006. Commencing as early as November 14, 2006, Opposer began offering its ZUNE brand digital media player, accessories therefor and online portable video and music sales and services to the general public.

8. Opposer's applications for ZUNE each claim priority based on German Registration 30634103.4, filed May 29, 2006 and registered July 11, 2006, and each predate Applicant's filing date.

9. Opposer's application 78/977970 includes carrying cases for MP3 players, goods identical to those claimed by Applicant.

10. Opposer has generated and continues to generate substantial revenue from the sale of goods and services in connection with the marks in the United States. Additionally, Opposer expended and Opposer continues to expend substantial sums of money, time, and effort in advertising, promoting and popularizing the ZUNE mark in the United States.

11. As a result of the use of the ZUNE mark as alleged above, and the advertising and promotion of products and services sold in connection with those, the ZUNE mark has become well known in the United States and is recognized as identifying Opposer's high-quality products and services. The ZUNE mark and the associated goodwill are valuable assets of Opposer.

12. On July 16, 2006, after the effective priority date of Opposer's '571 and '970 Applications and after learning of Opposer's ZUNE mark, Applicant applied to register the mark ZUNEGEAR for "cases for mobile phones; protective carrying cases for portable music players namely MP3 players" in International Class 9.

13. On information and belief, Applicant knew that Opposer had adopted the mark ZUNE at the time he filed his application to register ZUNEGEAR.

14. On information and belief, Applicant's ZUNEGEAR mark is intended to refer to Opposer's ZUNE products and services i.e., a sleeve for use with ZUNE products.

15. On information and belief, the goods described in Applicant's application are intended to be used with Opposer's ZUNE product.

16. Applicant's ZUNEGEAR application, filed with knowledge of Opposer's adoption of the ZUNE mark, is therefore a bad faith filing and is void *ab initio*.

17. Applicant's mark incorporates the ZUNE mark in its entirety.

18. The goods described in Applicant's application are so closely related to Opposer's MP3 players and accessories, including carrying cases, 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.

19. The mark ZUNEGEAR for the goods described in Applicant's application is confusingly and deceptively similar to Opposer's ZUNE mark 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.

20. Upon information and belief, Applicant has not made use, and is not currently using ZUNEGEAR as a trademark in connection with the goods listed in Applicant's 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 priority filing date of the ZUNE mark by Opposer.

21. By reason of the foregoing, Opposer would be greatly damaged by the registration of the ZUNEGEAR mark to Applicant.

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

Correspondence Address

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DATED this 11th day of May, 2007.

Respectfully submitted,
SEED IP Law Group PLLC

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Attorneys for Opposer MICROSOFT CORPORATION

CERTIFICATE OF SERVICE

I hereby certify that on this 11th day of May, 2007, the foregoing **AMENDED NOTICE OF OPPOSITION** was served on Applicant by depositing same with the U.S. Postal Service, first-class postage prepaid, addressed as follows:

Mark T. Daniel
2316 York Road SW
Roanoke, VA 24015-3906

and a copy to:

Patrick J. Stanzione, Esq.
Stanzione & Kim, LLP
919 18th Street N.W., Suite 440
Washington, DC 20006

Robyn Granger