

ESTTA Tracking number: **ESTTA226023**

Filing date: **07/23/2008**

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	Hewlett-Packard Development Company, L.P.
Granted to Date of previous extension	07/23/2008
Address	20555 State Highway 249 Houston, TX 77070 UNITED STATES

Attorney information	Jeffrey E. Faucette Howard, Rice, Nemerovski, Canady, Falk & Rabkin 3 Embarcadero Center, 7th Floor San Francisco, CA 94111 UNITED STATES trademark@howardrice.com, jfaucette@howardrice.com Phone:(415) 434-1600
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### Applicant Information

Application No	77112745	Publication date	03/25/2008
Opposition Filing Date	07/23/2008	Opposition Period Ends	07/23/2008
Applicant	Marquee, Inc. Suite 101 2901 Tasman Drive Santa Clara, CA 95054 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Set top boxes, peripherals and software for use in the transmission, storage and playback of audio and video content; computer software for use in computers for the transmission, storage and playback of audio and video content; software for use in televisions for the transmission, storage and playback of audio and video content
Class 035. All goods and services in the class are opposed, namely: providing consumer information used in the selection and purchase of audio and video content
Class 038. All goods and services in the class are opposed, namely: audio and video broadcasting services, broadcasting audio and video content over global computer networks, video-on-demand transmission services, pay-per-view video and audio transmission services
Class 041. All goods and services in the class are opposed, namely: providing information in the area of audio and video programming
Class 042. All goods and services in the class are opposed, namely: providing a website featuring temporary use

of non-downloadable software allowing website users to store and playback audio and video content for entertainment purposes
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## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2988445	Application Date	10/29/2001
Registration Date	08/30/2005	Foreign Priority Date	NONE
Word Mark	VOODOO		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1991/00/00 First Use In Commerce: 1994/01/00 COMPUTER SYSTEMS, NAMELY, PERSONAL AND GAMING COMPUTERS</p> <p>Class 040. First use: First Use: 1991/00/00 First Use In Commerce: 1994/01/00 CUSTOM MANUFACTURE OF COMPUTERS FOR OTHERS</p> <p>Class 042. First use: First Use: 1991/00/00 First Use In Commerce: 1994/01/00 CUSTOM DESIGN OF COMPUTERS FOR OTHERS; TECHNICAL SUPPORT SERVICES, NAMELY, PROVIDING INFORMATION AND ASSISTANCE CONCERNING THE USE AND FUNCTION OF COMPUTER HARDWARE AND SOFTWARE; AND, INFORMATION SERVICES, NAMELY, PROVIDING INFORMATION ON COMPUTER SYSTEMS, COMPUTER DESIGN, TECHNOLOGY AND THE INDUSTRY TO THE PUBLIC VIA CONNECTION TO THE GLOBAL COMPUTER NETWORK</p>		

U.S. Registration No.	3038749	Application Date	10/29/2001
Registration Date	01/10/2006	Foreign Priority Date	NONE
Word Mark	VOODOO		
Design Mark			
Description of Mark	The mark consists, in part, of a stylized design of a picture of a mask embedded in a diamond shape.		
Goods/Services	<p>Class 009. First use: First Use: 1991/00/00 First Use In Commerce: 1994/01/00 (Based on Use in Commerce) (Based on 44(d) Priority Application) COMPUTER SYSTEMS, NAMELY, PERSONAL AND GAMING COMPUTERS</p> <p>Class 040. First use: (Based on 44(d) Priority Application) CUSTOM MANUFACTURE OF COMPUTERS FOR OTHERS</p> <p>Class 042. First use: (Based on 44(d) Priority Application) CUSTOM DESIGN OF COMPUTERS FOR OTHERS; TECHNICAL SUPPORT SERVICES, NAMELY, PROVIDING INFORMATION AND ASSISTANCE CONCERNING THE USE AND FUNCTION OF COMPUTER HARDWARE AND SOFTWARE; AND, INFORMATION SERVICES, NAMELY, PROVIDING INFORMATION ON COMPUTER SYSTEMS, COMPUTER DESIGN, TECHNOLOGY AND THE INDUSTRY TO THE PUBLIC VIA CONNECTION TO THE GLOBAL COMPUTER NETWORK</p>		

Attachments	76331293#TMSN.gif ( 1 page )( bytes ) 76330778#TMSN.gif ( 1 page )( bytes ) VUDUNoticeofOpposition.pdf ( 10 pages )(522730 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JEF_jmb/
Name	Jeffrey E. Faucette
Date	07/23/2008

I hereby certify that this correspondence is being deposited electronically with the Trademark Trial and Appeal Board on the date shown below.

By and through Opposer's attorney, the Trademark office is authorized by Jeffrey E. Faucette, Attorney for Opposer, to charge the requisite filing fee of \$1500.00 to the Deposit Account of Howard Rice Nemerovski Canady Falk & Rabkin, Account No. 08-2792. Please deduct any additional fees that may be due, or credit any overpayment, to the same Deposit Account.

Jeffrey E. Faucette

Dated: July 23, 2008

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

HEWLETT-PACKARD DEVELOPMENT  
COMPANY, L.P.,

Opposer,

v.

VUDU, INC.,

Applicant.

Notice of Opposition

Mark: VUDU

Serial No. 77/112,745

Filed: February 21, 2007

Published: March 25, 2008

Opposition No.: \_\_\_\_\_

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

NOTICE OF OPPOSITION

The Hewlett-Packard Development Company, L.P. ("Opposer" or "HP"), a Texas limited partnership with its principal place of business at 20555 State Highway 249, Houston, Texas 77070, believes that it will be damaged by registration of the mark VUDU shown in Application Serial No. 77/112,745, and hereby opposes the same.

NOTICE OF OPPOSITION

As grounds for this opposition, Opposer alleges:

1. Vudu, Inc. (“Applicant”), formerly known as Marquee, Inc., a Delaware corporation with an address at 2901 Tasman Drive, Suite 101, Santa Clara, California 95054, filed Application Serial No. 77/112,745 (the “Opposed Application”), to register the mark VUDU (the “Proposed Mark”) for use in connection with “[s]et top boxes, peripherals and software for use in the transmission, storage and playback of audio and video content; computer software for use in computers for the transmission, storage and playback of audio and video content; software for use in televisions for the transmission, storage and playback of audio and video content” in Class 9; “providing consumer information used in the selection and purchase of audio and video content” in Class 35; “audio and video broadcasting services, broadcasting audio and video content over global computer networks, video-on-demand transmission services, pay-per-view video and audio transmission services” in Class 38; “providing information in the area of audio and video programming” in Class 41; and “providing a website featuring temporary use of non-downloadable software allowing website users to store and playback audio and video content for entertainment purposes” in Class 42 (“Applicant’s Intended Goods and Services”).

2. The Opposed Application was filed with the United States Patent and Trademark Office (“USPTO”) on February 21, 2007 (“Applicant’s Filing Date”) on the basis of Applicant’s bona fide intention to use the Proposed Mark in commerce under Section 1(b) of the Lanham Act, 15 U.S.C §1051(b).

3. The Opposed Application was assigned a Pseudo Mark of “VOODOO” by the USPTO on February 28, 2007.

4. Following amendments to the recitation of Applicant’s Goods and Services on November 13, 2007 and February 1, 2008, respectively, the Opposed Application was published for opposition in the *Official Gazette* on March 25, 2008. Opposer filed a request for extension of time to oppose on April 22, 2008. The USPTO granted the request on April 22, 2008 and extended the opposition period until July 23, 2008. This Notice of Opposition is timely filed.

5. Applicant has a second intent-to-use based application pending in the USPTO to register the stylized word mark VUDU, Serial No. 77/229,745 (Class 9, 38, 41 & 42) (the “Suspended Application”). The Suspended Application was filed on July 13, 2007. A refusal to register under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d) has been maintained against the application as of May 6, 2008, based on Opposer’s registered marks, U.S. Registration Nos.

2,988,445 and 3,038,749 (described in detail below), and the application is currently suspended pending the disposition of Opposer's earlier-filed application to register the word mark VOODOO, Serial No. 77/169,390 (Class 9), on the ground that Opposer's mark, if and when it registers, may be cited against Applicant's Suspended Application in a refusal to register under Section 2(d).

6. Opposer and its related company Hewlett-Packard Company (collectively "HP") are a leading provider of digital entertainment, computing, graphic arts, and technology products and services designed to meet the needs of all manner of consumers across the globe—from individuals to the largest businesses. HP's portfolio spans personal computers, data storage, software, online media services, digital photography services, televisions, digital media receivers and video game systems, among others. HP is among the world's largest companies, reporting revenue totaling \$110.4 billion for the four fiscal quarters ended April 30, 2008.

7. In 2006, HP acquired Voodoo Computers Ltd., a Canadian corporation operating under the tradename Voodoo Creative Computer Solutions, Ltd., or VoodooPC ("VoodooPC"). Founded in 1991, VoodooPC has been designing, building, customizing and distributing high performance personal computers ("PCs") for more than fifteen years. VoodooPC has long been considered a pioneer in the gaming industry and a premier provider of products and services for gaming and entertainment enthusiasts, and VoodooPC's products typically offer enhanced features for gaming and entertainment purposes, including for watching and listening to digital content. For example, VoodooPC's desktop PC "Voodoo Omen" features a DVD drive, quiet acoustics, an auxiliary LCD display, advanced video capabilities and software for improved playing of video files, to improve a user's entertainment experience (<http://www.voodoopc.com/#!/productsomen>), while a previously-offered product, VoodooPC's "Voodoo Aria" is a high end "media center" PC, designed for interoperating with home theater systems, and for storing and playing movie, music and gaming files (<http://www.pcmag.com/article2/0,1759,1874036,00.asp>).

8. Since the acquisition of VoodooPC, HP has continued to design, build, customize and distribute high performance desktop and notebook PCs under the brand developed by VoodooPC ("the VOODOO Brand"). HP has also expanded the scope of the VOODOO Brand through additional products and services and has associated the VOODOO Brand with other of HP's extensive line of digital entertainment products and services.

9. Opposer is the owner of U.S. Registration No. 2,988,445 issued on August 30, 2005, for the word mark VOODOO, which describes “computer systems, namely, personal and gaming computers,” in Class 9; “custom manufacture of computers for others,” in Class 40; and “custom design of computers for others; technical support services, namely, providing information and assistance concerning the use and function of computer hardware and software; and, information services, namely, providing information on computer systems, computer design, technology and the industry to the public via connection to the global computer network,” in Class 42 (“VOODOO Word Mark”).

10. Opposer is the owner of U.S. Registration No. 3,038,749 issued on January 10, 2006, for the design plus word mark VOODOO, which consists in part of a stylized design of a picture of a mask embedded in a diamond shape (“VOODOO Design Mark”), and describes the same goods and services as the VOODOO Word Mark referenced in the preceding paragraph.

11. Applications for Opposer’s registered VOODOO Word Mark and VOODOO Design Mark (collectively, the “VOODOO Marks”) were filed with the USPTO on October 29, 2001, and claimed priority based on previously filed home application nos. 1,100,959 and 1,100,960, filed in Canada on April 27, 2001. Opposer’s VOODOO Marks were first used in 1991, and used in commerce at least as early as January 1994.

12. Opposer has an intent-to-use based application pending in the USPTO to register the VOODOO mark, Serial No. 77/169,390 (Class 9), filed on April 30, 2007, which has been suspended pending the disposition of the earlier-filed Opposed Application.

13. HP and VoodooPC—Opposer’s predecessor in interest to the VOODOO Marks—have continuously offered products and services in connection with the VOODOO Marks in commerce since at least as early as 1994. In addition to the VOODOO product line of high performance PCs, HP has launched an expansion of the VOODOO Brand into other PCs and personal technology devices through the “Voodoo DNA” program. The HP Blackbird high performance desktop gaming PC thus incorporates “Voodoo DNA” and is sold in connection with the VOODOO Marks. The “Voodoo DNA” program is one of several ways in which the VOODOO Brand is integrated with HP’s other products and services.

14. HP and its predecessor in interest to the VOODOO Marks have allocated substantial resources to developing the VOODOO Brand and marketing the products and services sold in connection with the VOODOO Marks, including but not limited to tradeshow presentations,

press releases, and an extensive web-based marketing program.

15. Due to a number of factors, including the exceptional quality and innovative design of the goods and services sold under the VOODOO Marks, the extensive marketing campaigns supporting the VOODOO Brand, the VOODOO Brand's association and integration with HP, and the high volume of positive commentary among technology enthusiasts through weblogs and word-of-mouth, Opposer's VOODOO Marks have acquired extensive goodwill throughout the United States, are associated in the minds of the general public with HP, and constitute famous marks.

16. Applicant's Proposed Mark is similar in appearance, highly similar in connotation and commercial impression, and *identical* in sound to Opposer's VOODOO Marks. Indeed, the USPTO assigned "Voodoo" as a pseudo mark in each of Applicant's Opposed Application and Suspended Application. As the examiner reviewing Applicant's Suspended Application for a stylized VUDU word mark concluded, Applicant's registration and use of the VUDU Mark would likely create confusion, mistake, or deception in the minds of prospective purchasers as to the origin or source of Applicant's Goods and Services:

Applicant's VUDU and registrant's VOODOO share sound, meaning and commercial impression. Moreover, the goods and services of the applicant are extremely related to the registrant's goods and services and likely to be found in the same channels of trade. Upon encountering VUDU on applicant's various goods and services in the field of audio and video content, purchasers would likely mistakenly believe that the goods and services emanated from the same source as VOODOO's various goods and services in the field of gaming.

17. Applicant's Intended Goods and Services are identical or closely related to the goods and services covered by Opposer's registrations for Opposer's VOODOO Marks, as well as products advertised and sold by HP that are not specifically named in these registrations. Applicant's Intended Goods and Services are likely to be sold in the same channels of trade and to the same customers as the goods and services offered by HP under the VOODOO Marks.

18. Applicant's Intended Products and Services and HP's VOODOO Brand products and services both reach out to personal technology consumers seeking to maximize their entertainment experience, and both have been featured in the same web-based consumer resources. By way of example, VUDU and VOODOO Brand products have been reviewed by the editors of CNET.com. ([http://reviews.cnet.com/laptops/voodoo-envy-m-152/4505-3121\\_7-](http://reviews.cnet.com/laptops/voodoo-envy-m-152/4505-3121_7-)

32719383.html?tag=prod.txt.1 (Voodoo Envy notebook computer); [http://reviews.cnet.com/digital-media-receivers/vudu-digital-multimedia-receiver/4505-6739\\_7-32589079.html?tag=prod.txt.1](http://reviews.cnet.com/digital-media-receivers/vudu-digital-multimedia-receiver/4505-6739_7-32589079.html?tag=prod.txt.1) (Vudu multimedia receiver.) Likewise, VUDU and VOODOO Brand products have been written up on multiple occasions in the same technology weblogs, such as Gizmodo.com. (e.g., <http://gizmodo.com/341108/vudu-xl-hd-video-download-box-is-biggest-vudu-ever>; <http://gizmodo.com/gadgets/pcs/voodoo-pc-aria-media-center-133931.php>.)

19. Applicant's current VUDU product, namely a hardware box and remote control (the "Vudu Box"), is closely related to HP's VOODOO product line and other of HP's product lines. On information and belief, the "Vudu Box" uses an Internet connection to acquire digital movies, store those movies, and play them back on a connected television set. HP's PCs sold under the VOODOO Marks are, likewise, personal technology devices in Class 9 which are designed to deliver audio and video content, including digital movies, for entertainment purposes. In fact, one PC previously sold in connection with the VOODOO Marks, the "Voodoo Aria" media center, is equipped with a remote control, interoperates with a user's television or home theater system, and stores and plays movie files and other multimedia files. Additionally, HP's HP Digital Media Receiver connects with and provides digital audio and video files to home theater systems, televisions and stereos. It uses television-based menus, and allows users to experience on-demand video through an Internet connection on their home entertainment system. Likewise, HP's "MediaSmart" products and services use an Internet connection to acquire digital movies, store those movies, and play them back in High Definition format on a connected television set. (e.g., [http://h71036.www7.hp.com/hho/cache/366142-0-0-225-121.html?jumpid=reg\\_R1002\\_US](http://h71036.www7.hp.com/hho/cache/366142-0-0-225-121.html?jumpid=reg_R1002_US) EN). Thus, HP's "MediaSmart" products perform the same functions as Applicant's Vudu Box product. HP's "MediaSmart" products are marketed to the same consumers and in the same channels as its VOODOO Brand products.

20. Applicant's additional Intended Goods and Services, which include "computer software for use in computers for the transmission, storage and playback of audio and video content" in Class 9, are also closely related to HP's VOODOO product line. Opposer's recitation of goods and service in its registered VOODOO Marks describes "computer systems, namely, personal and gaming computers" in Class 9. As noted above, HP's VOODOO Brand products contain software for the transmission, storage and playback of audio and video content, as do other products distributed by HP.

21. To the extent that Applicant's existing and Intended Goods and Services are not identical to HP's products and services sold in connection with the VOODOO Marks, they fall squarely within HP's zone of natural expansion. Opposer's pending application, Serial No. 77/169,390, reflects HP's present intent to expand the VOODOO Brand to a series of additional personal technology devices—including television receivers, stand-alone DVD players and digital media players—which are identical to or very closely related to Applicant's existing and Intended Goods and Services. Moreover, it is the perception of consumers that HP's VOODOO Brand presently encompasses or is likely to encompass at a future time additional personal technology devices and related services, including those products and services described in the Opposed Application.

#### FIRST GROUND FOR RELIEF

##### LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. §1052(d)

22. Opposer incorporates by reference paragraphs 1 through 21, as if fully set forth herein.

23. HP and its predecessor in interest have used the VOODOO Marks in United States commerce since long before Applicant's Filing Date.

24. The Proposed Mark is identical to Opposer's registered VOODOO Marks in sound and meaning, and highly similar to Opposer's registered VOODOO Marks in connotation and commercial impression.

25. HP and its predecessor in interest to the VOODOO Marks have offered and continue to offer a range of goods and services in connection with the VOODOO Marks, including goods and services in Classes 9, 40, and 42. Additionally, HP offers services in Classes 35 and 41 under other marks and advertises them in proximity with the VOODOO Marks.

26. The use by Applicant of the Proposed Mark for Applicant's Intended Goods and Services, including for goods and services in Classes 9, 35, 38, 41, and 42, is likely to create the erroneous impression that Applicant's Goods and Services originate with, are sponsored or promoted by, or are otherwise associated with HP or the goods and services that HP or its predecessor in interest have produced. Therefore, Applicant's registration and use of the

Proposed Mark in connection with Applicant's Intended Goods and Services is likely to cause confusion, mistake, or deception in the minds of prospective consumers as to the origin, sponsorship, or approval of Applicant's Goods and Services, within the meaning of Section 2 of the Lanham Act, 15 U.S.C. §1052(d).

SECOND GROUND FOR RELIEF  
DILUTION UNDER 15 U.S.C. §1125(c)

27. Opposer incorporates by reference paragraphs 1 through 21, as if fully set forth herein.

28. The term VOODOO has come to be widely recognized among the consuming public of the United States as a designation of a source of the goods and services of HP and its predecessor in interest to the VOODOO Marks, and has been so recognized since long before Applicant's Filing Date.

29. The VOODOO Marks are famous, and have been famous since long before Applicant's Filing Date.

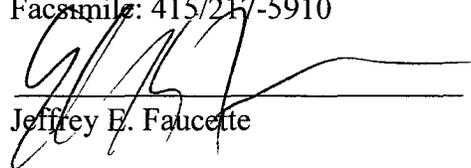
30. Applicant's use of the Proposed Mark is likely to dilute by blurring the strength and value of the VOODOO Marks, and by affecting the ability of these marks to serve as unique identifiers of HP's goods and services, thereby causing serious injury to the reputation and goodwill that Opposer has established in its VOODOO Marks, within the meaning of Section 43 of the Lanham Act, 15 U.S.C. §1125(c)(2)(B).

WHEREFORE, Opposer respectfully requests that registration of the mark shown in Application Serial No. 77/112,745 be refused, and that this Opposition be sustained in favor of Opposer.

By and through Opposer's attorney, the USPTO is authorized by Jeffrey E. Faucette, Attorney for Opposer, to charge the requisite filing fees of \$1500 to the Deposit Account of Howard Rice Nemerovski Canady Falk & Rabkin, Account No. 08-2792. Please deduct any additional fees that may be due, or credit any overpayment, to the same Deposit Account.

DATED: July 23, 2008.

HOWARD RICE NEMEROVSKI  
CANADY FALK & RABKIN  
A Professional Corporation  
Three Embarcadero Center, Seventh Floor  
San Francisco, California 94111  
Telephone: 415/434-1600  
Facsimile: 415/217-5910



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Jeffrey E. Faucette

Attorney for Opposer  
HEWLETT-PACKARD DEVELOPMENT  
COMPANY, L.P.

**PROOF OF SERVICE BY MAIL**

The undersigned declares and says as follows: my business address is Three Embarcadero Center, Seventh Floor, San Francisco, CA 94111-4024. I am employed in the City and County of San Francisco; I am over the age of 18 years, and I am not a party to this cause. I am readily familiar with this business' practices for collection and processing of correspondence for mailing with the United States Postal Services. On the same day that a sealed envelope is placed for collection and mailing, it is deposited in the ordinary course of business with the United States Postal Service with postage fully prepaid.

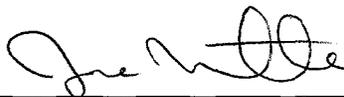
I served the within **NOTICE OF OPPOSITION TO APPLICATION SERIAL NO. 77/112,745** to Applicant at its address of record and to Applicant's attorney of record:

Vudu, Inc. / Marquee, Inc.  
Suite 101 2901 Tasman Drive  
Santa Clara, CA 95054  
United States

Harold J. Milstein  
Heller Ehrman LLP  
275 Middlefield Road  
Menlo Park, CA 94025-3506  
United States

by placing a true copy thereof, enclosed in a sealed envelope with postage thereon fully prepaid, for deposit in the United States mail for collection and mailing on this day following ordinary business practices of Howard, Rice, Nemerovski, Canady, Falk & Rabkin, PC.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct, and that this Declaration is executed in San Francisco, California, this 23 day of June, 2008.



By: Jane Mountcastle