

ESTTA Tracking number: **ESTTA331518**

Filing date: **02/10/2010**

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	SiRF Technology, Inc.
Granted to Date of previous extension	02/10/2010
Address	217 Devcon Drive San Jose, CA 95112 UNITED STATES

Correspondence information	Jason M. Gonder Haynes and Boone, LLP 2033 Gateway Place, Suite 400 San Jose, CA 95110 UNITED STATES jason.gonder@haynesboone.com, jennifer.lantz@haynesboone.com, lisa.garono@haynesboone.com, andrea.robles@haynesboone.com, ipdocketing@haynesboone.com Phone:408-392-9250
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Applicant Information

Application No	77621833	Publication date	10/13/2009
Opposition Filing Date	02/10/2010	Opposition Period Ends	02/10/2010
International Registration No.	NONE	International Registration Date	NONE
Applicant	Carl Zeiss AG Carl-Zeiss-Strasse 22 Oberkochen, 73447 GERMANY		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Coordinate measuring machines and parts thereof
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1458133	Application Date	03/02/1987
Registration Date	09/22/1987	Foreign Priority	NONE

		Date	
Word Mark	SIRF		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1987/02/03 First Use In Commerce: 1987/02/03 COMPUTER PROGRAMS AND USER MANUALS SOLD AS A UNIT		

U.S. Registration No.	2520395	Application Date	11/26/1996
Registration Date	12/18/2001	Foreign Priority Date	NONE
Word Mark	SIRFSTAR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/09/10 First Use In Commerce: 1996/10/25 computer hardware and software for use in global positioning and wireless navigation and satellite communications		

U.S. Registration No.	2308177	Application Date	11/26/1996
Registration Date	01/18/2000	Foreign Priority Date	NONE
Word Mark	SIRF		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1995/03/31 First Use In Commerce: 1996/07/01 computer hardware and software for use in global positioning and wireless navigation and satellite communications		

U.S. Registration No.	2310171	Application Date	12/16/1996
Registration Date	01/25/2000	Foreign Priority Date	NONE
Word Mark	SIRF		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/04/15 First Use In Commerce: 1996/07/01 computer hardware and software for use in global positioning and wireless navigation and satellite communications		

U.S. Registration No.	2983543	Application Date	07/29/2002
Registration Date	08/09/2005	Foreign Priority Date	NONE
Word Mark	SIRFLOC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2001/05/31 First Use In Commerce: 2001/05/31 computer hardware and software for use in global positioning and wireless navigation and satellite communications		

U.S. Registration No.	2983544	Application Date	07/29/2002
Registration Date	08/09/2005	Foreign Priority Date	NONE
Word Mark	SIRFDRIVE		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1999/09/17 First Use In Commerce: 2003/09/08 computer hardware and software for use in global positioning and wireless navigation and satellite communications

U.S. Registration No.	3127269	Application Date	07/29/2002
Registration Date	08/08/2006	Foreign Priority Date	NONE

Word Mark	SIRFNAV
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2002/00/00 First Use In Commerce: 2002/00/00 computer hardware and software for use in global positioning and wireless navigation and satellite communications

U.S. Registration No.	2820359	Application Date	09/23/2002
Registration Date	03/02/2004	Foreign Priority Date	NONE

Word Mark	SIRFXTRAC
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2003/04/00 First Use In Commerce: 2003/04/00 computer hardware and software for use in global positioning and wireless navigation and satellite communications

U.S. Registration No.	3136177	Application Date	02/19/2003
Registration Date	08/29/2006	Foreign Priority Date	NONE

Word Mark	SIRFSOFT
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Design Mark	<h1>SIRFSOFT</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2005/07/14 First Use In Commerce: 2005/07/14 computer hardware and software for use in global positioning and wireless navigation and satellite communications

U.S. Registration No.	2906097	Application Date	12/04/2003
Registration Date	11/30/2004	Foreign Priority Date	NONE

Word Mark	SIRF
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Design Mark	
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Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1996/04/15 First Use In Commerce: 1996/07/01 Computer hardware and software for use in global positioning and wireless navigation and satellite communications

U.S. Registration No.	3586656	Application Date	07/31/2008
Registration Date	03/10/2009	Foreign Priority Date	NONE
Word Mark	SIRFPRIMA		

Design Mark	SIRFPRIMA		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2008/02/07 First Use In Commerce: 2008/04/00 semiconductor chips for use in global positioning and navigation		

U.S. Registration No.	3673862	Application Date	02/09/2008
Registration Date	08/25/2009	Foreign Priority Date	NONE
Word Mark	SIRFTITAN		
Design Mark	SiRFtitan		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2007/10/18 First Use In Commerce: 2007/12/01 semiconductor chips for use in global positioning and wireless navigation and satellite communications		

U.S. Registration No.	3673863	Application Date	02/09/2008
Registration Date	08/25/2009	Foreign Priority Date	NONE
Word Mark	SIRFATLAS		

Design Mark	<h1>SiRFatlas</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2007/10/18 First Use In Commerce: 2007/12/01 semiconductor chips for use in global positioning and wireless navigation and satellite communications

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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	/Jason M. Gonder/
Name	Jason M. Gonder
Date	02/10/2010

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

In the Matter of Trademark Application Serial No. 77/621,833
For the Mark SURFMAX
Published in the *Official Gazette* on October 13, 2009

SIRF TECHNOLOGY, INC.,

Opposer,

v.

CARL ZEISS AG,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

SiRF Technology, Inc. (“Opposer”), a California corporation located at 217 Devcon Drive, San Jose, California 95112, believes that it will be damaged by the registration of the mark SURFMAX shown in Application Serial No. 77/621,833 (the “Application”), filed November 25, 2008 by Carl Zeiss AG (“Applicant”) and published in the *Official Gazette* on October 13, 2009, and hereby opposes the same.

As grounds for this Opposition, Opposer alleges as follows:

1. Applicant seeks to register the mark SURFMAX for “[c]oordinate measuring machines and parts thereof” in Class 9.
2. For more than 10 years, Opposer has developed and sold hardware and software and related products and services under the trademark SIRF and several SIRF-formative marks.
3. Opposer owns several U.S. trademark registrations for the SIRF and SIRF-formative marks (collectively, the “SIRF and Family of SIRF Marks”). The SIRF and Family of SIRF Marks include, but are not necessarily limited to, the following:

Mark	Filing Date	Registration No.	Goods and Services
SIRF	3/2/1987	1,458,133	IC 009. G & S: computer programs and user manuals sold as a unit.
SIRFSTAR	11/26/1996	2,520,395	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.
SIRF	11/26/1996	2,308,177	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.
SIRF & Design	12/16/1996	2,310,171	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.
SIRFLOC	7/29/2002	2,983,543	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.
SIRFDRIVE	7/29/2002	2,983,544	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.
SIRFNAV	7/29/2002	3,127,269	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.
SIRFXTRAC	9/23/2002	2,820,359	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.
SIRFSOFT	2/19/2003	3,136,177	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.

Mark	Filing Date	Registration No.	Goods and Services
SIRF & Design	12/4/2003	2,906,097	IC 009. G & S: computer hardware and software for use in global positioning and wireless navigation and satellite communications.
SIRFPRIMA	7/31/2008	3,586,656	IC 009. G & S: semiconductor chips for use in global positioning and navigation.
SIRFTITAN	2/9/2008	3,673,862	IC 009. G & S: semiconductor chips for use in global positioning and wireless navigation and satellite communications.
SIRFATLAS	2/9/2008	3,673,863	IC 009. G & S: semiconductor chips for use in global positioning and wireless navigation and satellite communications.

4. At least Opposer's U.S. Registration Nos. 2,308,177 (SIRF), 2,520,395 (SIRFSTAR), and 2,310,171 (SIRF & Design) are incontestable under 15 U.S.C. § 1065 and provide conclusive evidence of Opposer's ownership of these marks, the validity of these marks, and Opposer's exclusive right to use these marks in connection with the goods and services identified therein.

5. Applicant's SURFMAX mark should be refused registration under 15 U.S.C. § 1052(d) because it so resembles Opposer's SIRF and Family of SIRF Marks that it is likely to cause consumer confusion given Opposer's prior use and registration of the SIRF and Family of SIRF Marks in the United States in connection with identical and/or closely related goods and services.

6. In view of the foregoing, registration of Applicant's SURFMAX mark would be damaging to Opposer within the meaning of 15 U.S.C. § 1063.

WHEREFORE, Opposer prays that this Opposition be sustained and that registration be denied to Applicant on Application Serial No. 77/621,833.

Dated: February 10, 2010

Respectfully submitted,

By:  _____

Jennifer M. Lantz

Jason M. Gonder

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Attorneys for Opposer,
SiRF Technology, Inc.

CERTIFICATE OF SERVICE

I, Andrea Robles, certify as follows:

I am employed in the offices of Haynes and Boone, LLP, attorneys for Opposer SiRF Technology, Inc., at whose direction the service was made. My business address is 2033 Gateway Place, Suite 400, San Jose, California 95110.

A copy of the foregoing Opposer's Notice of Opposition was served by First Class Mail on February 10, 2010 upon the following counsel of record for Carl Zeiss AG:

V.T. GIORDANO, ESQ.
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Andrea Robles