

ESTTA Tracking number: **ESTTA364229**

Filing date: **08/20/2010**

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	Oracle America, Inc.
Granted to Date of previous extension	08/22/2010
Address	500 Oracle Parkway Redwood Shores, CA 94065 UNITED STATES
Correspondence information	Oracle America, Inc. 500 Oracle Parkway Redwood Shores, CA 94065 UNITED STATES docket@hollandhart.com, aanderson@hollandhart.com, ncbosch@hollandhart.com Phone:303-473-2861

Applicant Information

Application No	79069089	Publication date	02/23/2010
Opposition Filing Date	08/20/2010	Opposition Period Ends	08/22/2010
International Registration No.	1003418	International Registration Date	03/16/2009
Applicant	Skytron energy GmbH Ernst-Augustin-Str. 12 12489 Berlin GERMANY		

Goods/Services Affected by Opposition

<p>Class 009. All goods and services in the class are opposed, namely: Electronic and electrical apparatus and instruments, for use in generating or distributing energy; digital data buses with a specific physical topology and data exchange protocol, for the capture and processing of measurement data, all for use in photovoltaic energy generating installations; apparatus and instruments for the supply, distribution, transformation, accumulation, regulation or control of electric current; generator connector boxes; computer hardware, namely, computer peripheral devices; computer software for use in local area networks; electrical and electronic circuits; apparatus for protection against surges or electrical interference in electricity supplies; apparatus for the supply, regulation, transmission, control, storage and distribution of electricity; battery boxes, electric batteries, cables, plugs and connectors, and battery installations for the accumulation of electrical energy, generated through renewable photo voltaic, wind and fuel cell installations; inverters for photovoltaic installations; inverters; electric wires and wire connection fittings therefor; electrical and electronic connectors, terminals, conductors, and adapters; junction sleeves for electric cables; solar modules, namely, apparatus for converting electronic radiation to electrical energy, namely, photovoltaic solar modules; transformers; transformer stations</p>
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Class 037.

All goods and services in the class are opposed, namely: Repair, installation and maintenance of equipment and apparatus for energy generating installations and parts therefor, for the energy generating sector, and for use in energy generating installations; repair, installation and maintenance of photovoltaic energy generating installations, solar modules and/or apparatus and instruments for the capture, processing and forwarding of measurement data in connection with photovoltaic energy generating installations

Class 038.

All goods and services in the class are opposed, namely: Telecommunication services, namely, transmission of voice, audio, visual images and data by telecommunications networks, wireless communication networks, the Internet, information services networks and data networks; consultancy and information, including online, in the field of telecommunications; providing access to global computer networks and/or computer programs on data networks, including via telecommunications connections; providing access to information on the Internet; electronic mail; transfer of data by telecommunications; radio telecommunications; communications by optical fiber networks; communication by computer terminals or telephone; telecommunication routing and junction services; leasing of telecommunications lines; telecommunication routing and junction services; wireless mobile phone services; computer-aided transmission of messages and images; telecommunication gateway services; paging services by radio, telephone or other electronic communications systems; satellite transmission; voice transmission services via broadband power lines or wireless networks or wireless electronic transmission of voice by telecommunication networks, wireless communications networks and the internet; telephone voice messaging services; fax services; telephone services; telecommunications by means of platforms and portals on the Internet; teleconferencing services; telecommunications by computer terminals, via telematics, satellites, radios, telegraphs, telephones; delivery of digital audio and/or video by telecommunications; rental of devices and equipment for telecommunications and/or for sending and retrieving data and messages; rental of modems; telephone rental services; rental of telecommunications apparatus; leasing of access time to global computer networks; providing access to databases; web messaging; telecommunication access services; rental of fax machines

Class 042.

All goods and services in the class are opposed, namely: Engineering; engineering services in the field of electrical power and natural gas production; engineering services for applications on large and medium-sized computer systems, and for energy generating installations; repair, installation and maintenance of software, in the field of energy, and in energy generating installations; providing of scientific and technical analyses and expertise, namely, technical measuring and testing of energy products in the field of energy engineering, technical consultation in the field of power plant engineering, namely, testing and evaluation of power plant equipment to improve performance and efficiency of such equipment; technical measuring; computer programming; capacity monitoring and analysis of network operations, in particular within energy generating installations

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.	1384991	Application Date	05/24/1983
Registration Date	03/04/1986	Foreign Priority Date	NONE
Word Mark	SUN		

Design Mark	
Description of Mark	The mark consists of the capital letter "U" so arranged in a design as to give the impression of the word "Sun" written both forwards and backwards, regardless of which way the design is turned.
Goods/Services	Class 009. First use: First Use: 1982/03/00 First Use In Commerce: 1982/03/00 Computer Hardware-Namely, Processor and Memory, Video Displays, Keyboard, Mouse Pointing Device, and Cables; and ComputER Software-Namely, Programs Recorded oN Magnetic Disks and Tapes

U.S. Registration No.	1731627	Application Date	06/14/1990
Registration Date	11/10/1992	Foreign Priority Date	NONE
Word Mark	SUNSTART		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1988/07/00 First Use In Commerce: 1988/07/00 computer hardware, software, and network installation services Class 042. First use: First Use: 1988/07/00 First Use In Commerce: 1988/07/00 [computer consulting services and computer software and network design services]		

U.S. Registration No.	1776322	Application Date	06/29/1992
Registration Date	06/15/1993	Foreign Priority Date	NONE
Word Mark	SUN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1982/03/00 First Use In Commerce: 1982/03/00 computers, computer workstations composed of processors and memory, video displays, keyboard, mouse pointing device and computer operating systems software and computer software for use in the field of computer networking and graphics applications and computer hardware; namely, processors and memory, video displays, keyboard, mouse pointing device and cables		

U.S. Registration No.	1794747	Application Date	06/29/1992
Registration Date	09/28/1993	Foreign Priority Date	NONE

Word Mark	SUN
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1982/03/00 First Use In Commerce: 1982/03/00 computers, computer workstations composed of processors and memory, video displays, keyboard, mouse pointing device and computer operating systems software and computer software for use in the field of computer networking and graphics applications and computer hardware; namely, processors and memory, video displays, keyboard, mouse pointing device and cables

U.S. Registration No.	1867206	Application Date	04/29/1993
Registration Date	12/13/1994	Foreign Priority Date	NONE
Word Mark	SUNSPECTRUM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1993/04/12 First Use In Commerce: 1993/04/12 computer hardware and software installation, maintenance and repair services Class 042. First use: First Use: 1993/04/12 First Use In Commerce: 1993/04/12 computer related consulting services		

U.S. Registration No.	1938422	Application Date	11/14/1994
Registration Date	11/28/1995	Foreign Priority Date	NONE
Word Mark	SUN SITE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1992/09/00 First Use In Commerce: 1992/09/00 providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information		

U.S. Registration No.	2530320	Application Date	04/30/1999
Registration Date	01/15/2002	Foreign Priority Date	NONE
Word Mark	SUN RAY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1999/06/00 First Use In Commerce: 1999/06/00 computer hardware; computer software, namely, computer software for use in connection with computer servers, computer networks, and global communications networks; computer peripherals; network computers; other electronic devices, namely, enterprise appliances, network appliances, appliances for use in connection with a global computer network, smart cards, and smart card readers; and instructional manuals in association with the foregoing goods

U.S. Registration No.	3228271	Application Date	01/06/2000
Registration Date	04/10/2007	Foreign Priority Date	NONE

Word Mark	SUNTONE CERTIFIED
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 041. First use: First Use: 2000/03/08 First Use In Commerce: 2000/03/08 technology training services Class 042. First use: First Use: 2000/10/25 First Use In Commerce: 2001/02/11 computer hardware consulting services; computer software consulting services; and systems integration services
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Attachments	73427303#TMSN.gif (1 page)(bytes) 74289666#TMSN.gif (1 page)(bytes) 75888972#TMSN.gif (1 page)(bytes) Notice of Opposition Against SUNOPEN.pdf (5 pages)(313429 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	/Andrea Anderson/
Name	Oracle America, Inc.
Date	08/20/2010

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

Oracle America, Inc. Opposer, v. Skytron energy GmbH, Applicant.	Opposition No.: Mark: SUNOPEN Serial No.: 79/069,089
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NOTICE OF OPPOSITION

Oracle America, Inc. (“Opposer”), a Delaware corporation, having a principal place of business at 500 Oracle Parkway, Redwood Shores, California 94065, believes it will be damaged by registration of the mark SUNOPEN shown in U.S. Trademark Application Serial No. 79/069,089 covering various goods in International Class 9, 37, 38 and 42 (“the Application”) and hereby opposes it. As grounds for its opposition, Opposer alleges that, upon actual knowledge with respect to itself and its own actions, and upon information and belief as to other matters:

1. Opposer is the owner of a large family of SUN and SUN-formative trademarks (“SUN Marks”) that are registered in the U.S. for computer hardware, software, and related goods and services, including but not limited to the following registrations:

<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
SUN	1384991	03/04/86	9: computer hardware-namely, processor and memory, video displays, keyboard, mouse pointing device, and cables; and computer software-namely, programs recorded on magnetic disks and tapes
SUNSTART	1731627	11/10/92	37: computer hardware, software, and network installation services
SUN	1776322	06/15/93	9: computers, computer workstations composed of processors and memory, video displays, keyboard, mouse pointing device and computer operating systems software and computer software for use in the field of computer networking and graphics applications and computer hardware; namely, processors and memory, video displays, keyboard, mouse pointing device and cables
	1794747	09/28/93	9: computers, computer workstations composed of processors and memory, video displays, keyboard, mouse pointing devices and cables
SUNSPECTRUM	1867206	12/13/94	37: computer hardware and software installation, maintenance and repair services 42: computer related consulting services
SUN SITE	1938422	11/28/95	35: providing multiple-user access to a global computer information network for the transfer and dissemination of wide range of information
SUN RAY	2530320	01/15/02	9: computer hardware; computer software, namely, computer software for use in connection with computer servers, computer networks, and global communications networks; computer peripherals; network computers; other electronic devices, namely, enterprise appliances, network appliances, appliances for use in connection with a global computer network, smart cards, and smart card readers; and instructional manuals in association with the foregoing goods
SUNTONE CERTIFIED	3228271	04/10/07	41: technology training services

<u>MARK</u>	<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS/SERVICES</u>
			42: computer hardware consulting services; computer software consulting services; and systems integration services

2. The foregoing registrations are valid and subsisting and therefore constitute prima facie evidence of the validity of the SUN Marks and of Opposer's exclusive rights to use the marks in connection with the goods and services set forth in the registrations.

3. Registration Nos. 1384991, 1776322, 1794747, 1867206, 1938422, 2530320, and 2463402 are incontestable and therefore, these registrations constitute conclusive evidence of the validity of the marks and of Opposer's exclusive right to use the marks in connection with the goods and services set forth in the respective registrations.

4. The registrations also provide constructive notice of Opposer's ownership of its SUN Marks.

5. Since well prior to the filing date of the Application, Opposer and its predecessors have used the SUN Marks in connection with providing computer-related goods and services. Moreover, Opposer's first registration of its SUN Mark issued more than twenty-four (24) years before the filing date of the Application.

6. In view of the similarity of the respective marks and the related nature of the goods and services of the respective parties, Applicant's SUNOPEN mark so resembles Opposer's prior used and registered SUN Marks as to be likely, when used in connection with the services set forth in the Application, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

7. In addition, the SUN Marks have become well-known and famous as a designator of Opposer's goods and services.

8. Opposer's SUN Marks became famous well prior to the filing date of the Application.

9. In view of the striking similarity of the respective marks, Applicant's SUNOPEN mark so resembles Opposer's prior used and registered SUN Marks as to dilute the distinctive quality of Opposer's marks.

WHEREFORE, Opposer believes that it will be damaged by registration of the mark shown in Application Serial No. 79/069,089 and respectfully requests that the opposition be sustained, and that registration to Applicant be refused.

The filing fee in the amount of \$300 is being transmitted electronically with this submission. Any deficiency in the fee should be charged to Deposit Account No. 08-2623.

Dated: August 20, 2010

Respectfully submitted,

s/Andrea Anderson
Andrea Anderson
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**Attorneys for Opposer
Oracle America, Inc.**

CERTIFICATE OF SERVICE

I certify that on August 20, 2010 I served a copy of the above **NOTICE OF OPPOSITION** to the following by U.S. Mail, postage prepaid:

Ursula B. Day
708 Third Avenue, Suite 1501
New York, NY 10017

s/Debbie Rickers _____
Debbie Rickers
for Holland & Hart LLP

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