

ESTTA Tracking number: **ESTTA589592**

Filing date: **02/26/2014**

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	TiVo Brands, LLC
Granted to Date of previous extension	02/26/2014
Address	2160 Gold Street Alviso, CA 95002 UNITED STATES

Attorney information	Lori F Mayall Cooley LLP 1299 Pennsylvania Ave., NW, Suite 700 Washington, DE 20004 UNITED STATES trademarks@cooley.com, lmayall@cooley.com Phone:650-843-5000
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Applicant Information

Application No	85863495	Publication date	10/29/2013
Opposition Filing Date	02/26/2014	Opposition Period Ends	02/26/2014
Applicant	Glory Great Wall (HK) AV-TECH CO., LTD Unit 1001 10th Floor Fourseas Building Kowloon, HKX HKX		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Televisions, namely, flat panel LCD TVs, LED TVs, and combo TV/DVD players; DVD/CD players; Optical disc Players; PC Monitors; Portable Video/Optical Disc players; Home Theater equipment namely, Audio Speakers, Audio Sound Speakers, Audio Receivers, Audio Amplifiers, Audio Subwoofers

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.	2423757	Application Date	05/29/1998
Registration Date	01/23/2001	Foreign Priority Date	NONE

Word Mark	TIVO
Design Mark	TIVO
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 1999/01/00 First Use In Commerce: 1999/01/00 Computer hardware, computer software for use in connection with personalized, interactive, television programming; computer peripherals,[televisions]; television peripheral remote controls, and controls, namely, video game interactive remote control units and computer game software for use therewith and accompanying manuals sold as a unit</p> <p>Class 035. First use: First Use: 1999/03/00 First Use In Commerce: 1999/03/00 Promoting the sale of goods and services of others through the distribution of on-line promotional material and promotional contests</p> <p>Class 038. First use: First Use: 1999/03/00 First Use In Commerce: 1999/03/00 Subscription television broadcasting services; transmission of cable television and interactive audio and video services; and cable television transmission of personalized and interactive television programming</p> <p>Class 041. First use: First Use: 1999/01/00 First Use In Commerce: 1999/01/00 Entertainment services, namely, personalized and interactive entertainment services in the nature of providing personalized television programming, and interactive television programming and games, and entertainment information, namely, an online guide to personalized and interactive television programming</p>

U.S. Registration No.	2566471	Application Date	11/04/1999
Registration Date	05/07/2002	Foreign Priority Date	NONE
Word Mark	TIVO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1999/01/07 First Use In Commerce: 1999/01/07		

	<p>Computer hardware, software and peripherals for personalized, interactive television programming; [televisions;] television remote controls; communication devices, namely, transmitters for television [, radio, and wireless telephone] ;receivers for [telephone,] audio, andvideo; and software for use therewith; and accompanying manuals sold as a unit</p> <p>Class 035. First use: First Use: 1999/01/07 First Use In Commerce: 1999/01/07 Promotion of goods and services of others through the distribution of on-line promotional material and promotional contests; data processing services</p> <p>Class 038. First use: First Use: 1999/01/07 First Use In Commerce: 1999/01/07 Subscription television broadcasting services; transmission of cable televisionand interactive audio and video services; personalized and interactive television transmission services</p> <p>Class 041. First use: First Use: 1999/01/07 First Use In Commerce: 1999/01/07 Entertainment services, namely interactive entertainment services in the natureof providing personalized television programming; and entertainment information, namely an on-line guide to guide to personalized and interactive television programming</p>
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U.S. Registration No.	3650220	Application Date	11/17/2008
Registration Date	07/07/2009	Foreign Priority Date	NONE
Word Mark	TIVO		
Design Mark			
Description of Mark	The mark consists of the word "TIVO" in a stylized font, underneath which is a smile shape. The entire design is enclosed in a circle.		
Goods/Services	Class 041. First use: First Use: 1999/03/00 First Use In Commerce: 1999/03/00 entertainment services, namely, providing personalized television programming, interactive television programming, and entertainment information in the nature of an online guide to personalized and interactive television programming; entertainment services, namely, providing on-line computer games		

U.S. Registration No.	2436483	Application Date	08/12/1999
Registration Date	03/20/2001	Foreign Priority Date	NONE
Word Mark	TIVO CENTRAL		

Design Mark	TIVO CENTRAL		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1999/03/31 First Use In Commerce: 1999/03/31 Entertainment services, providing on screen, interactive guide for selecting, administering and maintaining personalized television programming		

U.S. Registration No.	3821425	Application Date	12/08/2009
Registration Date	07/20/2010	Foreign Priority Date	NONE
Word Mark	TIVO		
Design Mark	TIVO		
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1999/03/00 First Use In Commerce: 1999/03/00 Television broadcasting services; Transmission of network and satellite television programming; Digital and electronic transmission of voice, data, sound, music, graphics, images, audio, video, information, and messages		

U.S. Registration No.	2642755	Application Date	01/15/2002
Registration Date	10/29/2002	Foreign Priority Date	NONE
Word Mark	TIVO		

Design Mark	<h1>TIVO</h1>
Description of Mark	NONE
Goods/Services	<p>Class 025. First use: First Use: 1998/08/00 First Use In Commerce: 1998/08/00 Shirts, sweatshirts, t-shirts, jerseys,[jackets, vests,] baseball caps, [and visors]</p> <p>Class 028. First use: First Use: 1998/08/00 First Use In Commerce: 1998/08/00 Plush toys, [bean bag dolls, bath toys, beach balls, board games, flying discs, hand puppets, head covers for golf clubs, inflatable toys, sport balls] and collectable toy figures</p> <p>Class 035. First use: First Use: 2001/04/13 First Use In Commerce: 2001/04/13 Retail store services and telephone, [catalog, mail] and online ordering services featuring digital video recorders and related accessories, installation and viewer guides, shirts, sweatshirts, t-shirts, jerseys, [jackets, vests,] baseball caps, [visors,] plush toys, [bean bag dolls, bath toys,] [beach balls,] [board games, flying discs, hand puppets, head covers for golf clubs, inflatable toys, sport balls,] collectable toy figures, [lunch boxes,] mugs, antenna covers and blankets</p>

Attachments	<p>75493408#TMSN.gif(bytes) 75841174#TMSN.gif(bytes) 77616084#TMSN.jpeg(bytes) 75774400#TMSN.gif(bytes) 77888610#TMSN.jpeg(bytes) 76359394#TMSN.gif(bytes) TiVo Opposition re TIV.pdf(307563 bytes)</p>
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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	/lfm/
Name	Lori F Mayall
Date	02/26/2014

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

In the matter of application Serial No. 85/863,495
For the Trademark TIV And Design
Published in the *Official Gazette* on October 29, 2013

TIVO BRANDS LLC,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
GLORY GREAT WALL (HK) AV-TECH CO.,)	
LTD.)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Opposer TiVo Brands LLC (“TiVo”), a Delaware limited liability company having its principal place of business at 2160 Gold Street, Alviso, California 95002, believes that it will be damaged by the issuance of registration for the mark TIV And Design (the “TIV Mark” or “Applicant’s Mark”), as applied for in Application Serial No. 85/863,495, filed on February 28, 2013 by Applicant Glory Great Wall (HK) Av-Tech Co., Ltd (“Applicant”), a Hong Kong corporation, with a mailing address of 1001 10th Floor Fourseas Building 208-212 Nathan Road, Kowloon Hong Kong.

As grounds for opposition, TiVo alleges that:

1. TiVo is a pioneer and leading retailer in the home entertainment market. TiVo developed the first digital video recorder (“DVR”), and offers a range of home entertainment products and services associated with its DVRs, which include television viewing, broadband

internet services enabling movie and TV show downloads, advanced search, personal photo viewing, music offerings, and online scheduling, among many other features. TiVo DVRs consist of hardware and operating system software that support the TiVo user interface and enable the scheduling, recording, and viewing of television programs, in addition to the internet access services noted above. TiVo has offered these products and services to consumers nationwide under its TIVO and TIVO variant and design marks (referred to collectively herein as the “TIVO Marks”) in the United States for over ten years.

2. TiVo is the owner of the following United States trademark registrations, among others:

a. Reg. No. 2,423,757 for TIVO in Classes 9, 35, 38, and 41, which is valid, subsisting, incontestable, and registered in connection with the following:

- Cl. 9: Computer hardware, computer software for use in connection with personalized, interactive, television programming; computer peripherals; television peripheral remote controls, and controls, namely, video game interactive remote control units and computer game software for use therewith and accompanying manuals sold as a unit;
- Cl. 35: Promoting the sale of goods and services of others through the distribution of on-line promotional material and promotional contests;
- Cl. 38: Subscription television broadcasting services; transmission of cable television and interactive audio and video services; and cable television transmission of personalized and interactive television programming; and
- Cl. 41: Entertainment services, namely, personalized and interactive

entertainment services in the nature of providing personalized television programming, and interactive television programming and games, and entertainment information, namely, an online guide to personalized and interactive television programming.

b. Reg. No. 2,566,471 for TIVO & Design in Classes 9, 35, 38, and 41, which is valid, subsisting, incontestable, and registered in connection with the following:

- Cl. 9: Computer hardware, software and peripherals for personalized, interactive television programming; television remote controls; communication devices, namely, transmitters for television; receivers for audio, and video; and software for use therewith; and accompanying manuals sold as a unit;
- Cl. 35: Promotion of goods and services of others through the distribution of on-line promotional material and promotional contests; data processing services;
- Cl. 38: Subscription television broadcasting services; transmission of cable television and interactive audio and video services; personalized and interactive television transmission services; and
- Cl. 41: Entertainment services, namely interactive entertainment services in the nature of providing personalized television programming; and entertainment information, namely an on-line guide to guide to personalized and interactive television programming.

c. Reg. No. 3,650,220 for TIVO & Design in Class 41, which is valid, subsisting, and registered in connection with “entertainment services, namely, providing

personalized television programming, interactive television programming, and entertainment information in the nature of an online guide to personalized and interactive television programming; entertainment services, namely, providing on-line computer games.”

d. Reg. No. 2,436,483 for TIVO CENTRAL in Class 41, which is valid, subsisting, incontestable, and registered in connection with “[e]ntertainment services, providing on screen, interactive guide for selecting, administering and maintaining personalized television programming.”

e. Reg. No. 3,821,425 for TIVO in Class 38 which is valid, subsisting and registered in connection with “[t]elevision broadcasting services; transmission of network and satellite television programming; digital and electronic transmission of voice, data, sound, music, graphics, images, audio, video, information, and messages.”

f. Reg. No. 2,642,755 for TIVO which is valid, subsisting and registered in connection with “[r]etail store services and telephone, and online ordering services featuring digital video recorders and related accessories ...” in Class 35, among other goods in Classes 25 and 28.

3. The TIVO Marks are fanciful, inherently distinctive, and entitled to a broad scope of protection.

4. TiVo’s products and services have been the subject of thousands of stories in television, radio, and print media, highlighting TiVo’s innovation and success in the entertainment and content delivery fields. TiVo also has received numerous awards for its products and services, including, among many others, the 2012 Consumer Electronics Show Innovations Video Components Award, the 2011 and 2009 Consumer Electronics Show Design and Engineering Award, the 2009 CNET Best 5 Home Video Products Award, the 2008 PC

World 100 Best Products Award, the 2007 Engadget Home Entertainment Device of the Year Award, the 2007 *Wired Magazine* Best in Test Award, and a 2007 Technology and Engineering Emmy Award, issued by the United States National Television Academy.

5. As a result of the nature and quality of TiVo's products and services, its widespread use of the TIVO Marks, the extensive and continuous media coverage it has received, the high degree of consumer recognition of the TIVO Marks, the loyalty of its user base, and its numerous trademark registrations and pending applications, among other factors, the TIVO Marks are famous within the meaning of Section 43(c) of the United States Trademark Act, 15 U.S.C. § 1125(c).

6. On February 28, 2013, Applicant filed an application to register the TIV And Design mark (the "TIV Application") on an intent-to-use basis, for "Televisions, namely, flat panel LCD TVs, LED TVs, and combo TV/DVD players; DVD/CD players; Optical disc Players; PC Monitors; Portable Video/Optical Disc players; Home Theater equipment namely, Audio Speakers, Audio Sound Speakers, Audio Receivers, Audio Amplifiers, Audio Subwoofers" in Class 9.

7. The TIV Application published in the *Official Gazette* on October 29, 2013.

**FIRST GROUND FOR OPPOSITION:
LIKELIHOOD OF CONFUSION**

8. TiVo incorporates by reference Paragraphs 1 through 7, inclusive, as if fully set forth herein.

9. TiVo began using its TIVO Marks at least as early as 1999, and filed applications resulting in federal registrations well prior to Applicant's application to register the TIV Mark, or, on information and belief, any actual use of the TIV Mark in commerce.

10. Applicant's Mark is similar to the TIVO Marks in appearance, sound, and commercial impression.

11. The goods described in the TIV Application are the same as and/or highly related to the goods and services offered by TiVo under the TIVO Marks and identified in TiVo's trademark registrations and applications.

12. The goods identified in the TIV Application and the goods and services offered by TiVo under the TIVO Marks are normally offered through the same channels of trade.

13. Applicant's TIV Mark suggests an affiliation or connection between Applicant and TiVo, where none exists.

14. TiVo is not affiliated or connected with Applicant or its goods; nor has TiVo endorsed or sponsored Applicant or its goods.

15. TiVo has no control over the nature and quality of the goods or services that will be offered under the TIV Mark and the value of TiVo's TIVO Marks would be jeopardized by the registration of the TIV Mark. Because of the likelihood of confusion between the parties' marks, any defects, improprieties, or faults found with Applicant's goods marketed under the TIV Mark would negatively reflect upon and injure the reputation that TiVo has established for the goods and services it offers in connection with the TIVO Marks.

16. Registration of the mark herein opposed will damage TiVo because Applicant's TIV Mark is likely, when used on or in connection with the goods described in the opposed application, to cause confusion, or to cause mistake or to deceive. Thus, the TIV Mark is unregistrable under 15 U.S.C. §§1052, 1053, 1063 and 1125 and should be refused registration.

**SECOND GROUND FOR OPPOSITION:
DILUTION OF A FAMOUS MARK**

17. TiVo incorporates by reference Paragraphs 1 through 16, inclusive, as if fully set forth herein.

18. TIVO is inherently distinctive in relation to TiVo's goods and services.

19. TiVo has used the TIVO mark since at least as early as 1999 for digital video recorders and related home entertainment services, and has expanded use of the TIVO Marks to additional goods and services since that time.

20. TiVo is the owner of numerous U.S. registrations and applications for the TIVO Marks.

21. TiVo and the TIVO Marks have been the subject of extensive and continuous media attention.

22. TiVo has continuously used the TIVO Marks throughout the United States since at least as early as 1999.

23. As a result of the considerable publicity afforded the TIVO Marks and the sizeable and loyal base of customers that TiVo has for its services, the TIVO Marks have extensive consumer recognition.

24. The TIVO Marks became famous well before Applicant filed to register the TIV Mark, or, on information and belief, any use of the TIV Mark in commerce.

25. The TIV Mark and TIVO Marks are highly similar, and Applicant's use of the TIV Mark is likely to cause association between the TIV Mark and the TIVO Marks that impairs the distinctiveness of the TIVO Marks and weakens the connection in the public's mind between the TIVO Marks and TiVo's goods and services.

26. Applicant's TIV Mark is likely to cause dilution by blurring based on a number of relevant considerations, including:

- (a) Applicant's Mark is similar to the TIVO Marks;
- (b) The TIVO Marks are inherently distinctive in relation to home entertainment goods and services;
- (c) TiVo has made substantially exclusive use of the TIVO Marks in connection with home entertainment goods and services;
- (d) The TIVO Marks are widely recognized by the general consuming public;
- (e) On information and belief, Applicant's Mark was selected with the intention to create an association with the TIVO Marks.

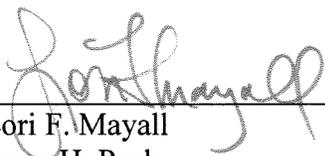
27. Accordingly, Applicant's Mark is unregistrable under 15 U.S.C. §§ 1052, 1053, 1063, and 1125, and should be refused registration.

Wherefore, TiVo prays that this Opposition be sustained, and that Application Serial No. 85/863,495 be refused.

Respectfully submitted,

COOLEY LLP

Date: February 26, 2014

By: 
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CERTIFICATE OF TRANSMITTAL AND SERVICE

I hereby certify that this Notice of Opposition is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below.

I hereby further certify that on the date indicated below, a true and correct copy of this Notice of Opposition was placed in the United States Mail, postage prepaid, addressed to the applicant and the correspondent for the subject application listed in the USPTO's online database, as follows:

Glory Great Wall (HK) AV-TECH CO., LTD
Unit 1001 10th Floor Fourseas Building
208-212 Nathan Road
Kowloon
HONG KONG

and

Bin Li
LAW OFFICES OF BIN LI AND ASSOCIATES
730 N. Diamond Bar Blvd
CITY OF INDUSTRY, CALIFORNIA 91765

Date: February 26, 2014



Lori F. Mayall