

ESTTA Tracking number: **ESTTA634979**

Filing date: **10/24/2014**

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	Avnet, Inc.		
Entity	Corporation	Citizenship	New York
Address	2211 South 47th Street Phoenix, AZ 85034 UNITED STATES		

Attorney information	Kathy Tsai Fish & Richardson, P.C. P.O. Box 1022 Minneapolis, MN 55440-1022 UNITED STATES tmdoctc@fr.com, tsai@fr.com, ly@fr.com, kgray@fr.com Phone:650-839-5070		
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Applicant Information

Application No	86134370	Publication date	09/30/2014
Opposition Filing Date	10/24/2014	Opposition Period Ends	10/30/2014
Applicant	Shenzhen Anya Technology Co.,Ltd No.606Building B,No.30 SanweihangkongRd. Shenzhen City, CHINA		

Goods/Services Affected by Opposition

Class 009. First Use: 2013/04/17 First Use In Commerce: 2013/04/17 All goods and services in the class are opposed, namely: Alarm central units; Batteries, electric; Clickers for training dogs; Clothing for protection against accidents; Dog whistles; Electric cables and wires; Garments and clothes for protection against fire; Level indicators; Measuring rules; Photographic cameras; Remote control telemetering machines and apparatus
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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.	1700991	Application Date	03/22/1991
Registration Date	07/14/1992	Foreign Priority Date	NONE
Word Mark	AV		

Design Mark	
Description of Mark	The mark consists of the letters, "AV".
Goods/Services	Class 042. First use: First Use: 1988/11/00 First Use In Commerce: 1988/11/00 distributorship services for electrical, electronic and computer equipment and for motors and machinery

U.S. Registration No.	2705815	Application Date	02/24/2000
Registration Date	04/15/2003	Foreign Priority Date	NONE
Word Mark	AV		
Design Mark			
Description of Mark	The mark consists of the letters, "AV".		
Goods/Services	Class 009. First use: First Use: 1999/02/19 First Use In Commerce: 1999/02/19 electrical, electronic and computer components and equipment, namely, micro-processors, semiconductors, microchips, circuit boards, servers, display panels,		

	data storage software and hardware, interconnect, passive and electromechanical software and hardware for linking communications and data networks, embedded operating software and hardware, radio frequency and microwave software and hardware for linking communications and data networks; and point-of-sale systems, namely, bar-code scanners, automatic identification software and hardware, and wireless computing software and hardware
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U.S. Registration No.	4276289	Application Date	12/23/2010
Registration Date	01/15/2013	Foreign Priority Date	NONE

Word Mark	AV
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Design Mark	
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Description of Mark	The mark consists of stylized letter "A" interlocking with a stylized letter "V".
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Goods/Services	Class 041. First use: First Use: 2003/01/01 First Use In Commerce: 2003/01/01 Education, namely, providing of training through classroom, on-site, and seminar instruction, arranging and conducting conferences, discussion forums, exhibitions, programs, seminars, symposiums and workshops, all with respect to computer hardware and software, and information and advice regarding the aforementioned services
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Attachments	74151622#TMSN.png(bytes) 75929634#TMSN.png(bytes) 85205466#TMSN.png(bytes) AYANYAO Notice of Opp - final.pdf(192691 bytes) Notice of Opp - Exh A.pdf(802901 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	/kathy tsai/
Name	Kathy Tsai
Date	10/24/2014

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

In the matter of Application Serial No. 86/134,370
Filed on December 3, 2013
For the mark **AYANYAO & Design**



Published in the *Official Gazette* on September 30, 2014

AVNET, INC.,

Opposer,

v.

SHENZHEN ANYA TECHNOLOGY CO.,
LTD.,

Applicant.

NOTICE OF OPPOSITION

NOTICE OF OPPOSITION

Opposer Avnet, Inc. believes that it will be damaged by registration of the mark shown in the above-identified application and hereby opposes the same pursuant to the provisions of 15 U.S.C. § 1063.

The grounds for opposition are as follows:

THE PARTIES

1. Opposer Avnet, Inc. (“Avnet”) is a New York corporation with a place of business at 2211 South 47th Street, Phoenix, AZ 85034.
2. Upon information and belief, Applicant Shenzhen Anya Technology Co., Ltd. (“Applicant”) is a Chinese corporation with a place of business at No. 606 Building B, No. 30 Sanweihangkong Rd., Xixiang Street, Baoan District, Shenzhen City, China.

FACTUAL BACKGROUND

3. Avnet distributes electronic components, computer products, and embedded technology to customers globally. Beginning in as early as November 1988, Avnet introduced electronic goods and services under the AV Logo, as depicted below (“Avnet Mark”).



AV Logo or Avnet Mark

Since that time, Avnet has consistently and prominently used the Avnet Mark on and in connection with its electronic products and services.

4. In addition to its common law rights in the Avnet Mark, Avnet owns U.S. Registration Nos. 1,700,991; 2,705,815; and 4,276,289 for the AV Logo for various goods and services in Classes 9, 41, and 42, including the following:

Class 9: *Electrical, electronic and computer components and equipment, namely, micro-processors, semiconductors, microchips, circuit boards, servers, display panels, data storage software and hardware, interconnect, passive and electromechanical software and hardware for linking communications and data networks, embedded operating software and hardware, radio frequency and microwave software and hardware for linking communications and data networks; and point-of-sale systems, namely, bar-code scanners and automatic identification software and hardware, and wireless computing software and hardware*

Class 41: *Education, namely providing of training through classroom, on-site, and seminar instruction, arranging and conducting conferences, discussion forums, exhibitions, programs, seminars, symposiums and workshops, all with respect to computer hardware and software, and information and advice regarding the aforementioned services*

Class 42: *Distributorship services for electrical, electronic and computer equipment and for motors and machinery*

U.S. Registration No. 1,700,991 in Class 42 issued on July 14, 1992, with a first use and first use in commerce date of November 1988; U.S. Registration No. 2,705,815 in Class 9 issued on April 15, 2003, with a first use and first use in commerce date of February 19, 1999; and U.S. Registration No. 4,276,289 in Class 41 issued on January 15, 2013, with a first use and first use in commerce date of January 1, 2003. A copy of the certificates for each of the aforementioned registrations is attached at **Exhibit A**.

5. On December 3, 2013, Applicant filed an application to register the mark AYANYAO & Design in connection with “Alarm central units; Batteries, electric; Clickers for training dogs; Clothing for protection against accidents; Dog whistles; Electric cables and wires; Garments and clothes for protection against fire; Level indicators; Measuring rules; Photographic cameras; Remote control telemetering machines and apparatus” in Class 9 (“Applicant’s Goods”), based on an alleged first use and first use in commerce date of April 17, 2013, which was designated Application Serial No. 86/134,370 (the “Application”) (the mark that is the subject of the Application is referred to as “Applicant’s Mark”).

6. The Application was published for opposition in the *Official Gazette* on September 30, 2014, such that the deadline to oppose the Application is October 30, 2014. Consequently, this Notice of Opposition is timely filed.

GROUND FOR OPPOSITION

Priority and Likelihood of Confusion

7. There is no issue as to priority. Avnet has been using the Avnet Mark in commerce since at least as early as November 1988, whereas Applicant’s priority dates back to

its alleged use starting on April 17, 2013. By virtue of its federal registrations, Avnet enjoys nationwide rights in the Avnet Mark dating back to November 1988. Avnet’s common law and statutory priority dates precede the priority date of the Application by nearly 25 years and, upon information and belief, any priority date on which Applicant may rely.

8. The Avnet Mark is distinctive of the electronic products and services offered by Avnet, and the Avnet Mark enjoys a high degree of distinctiveness in the field of electronic products and services.

9. Applicant’s Mark wholly incorporates a design element that is near-identical to the interlocking AV Logo of the Avnet Mark. The “AY Design” portion of Applicant’s Mark contains an interlocking “letter A” and “letter Y” in blocky typeface, with the bottom “letter Y” resembling the “letter V” off-set to the right of the “letter A” and featured in a slightly darker shade than the “letter A.” This is near-identical to the interlocking AV Logo of the Avnet Mark, which features an interlocking “letter A” and “letter V” in blocky typeface, with the bottom “letter V” off-set to the right of the “letter A” and featured in a slightly darker shade than the “letter A.” The overall commercial impression of the “AY Design” portion of Applicant’s Mark is near-identical to that of the Avnet Mark, as depicted below.



The Avnet Mark



Applicant's Mark

10. Applicant allegedly uses Applicant’s Mark in connection with various goods, including electronic components such as alarm central units, electric batteries, electric cables and wires, photographic cameras, and remote control machines and apparatuses. Applicant’s Goods,

which Applicant allegedly offers under Applicant's Mark, are similar and related to the goods and services Avnet offers under its Avnet Mark.

11. Consumers are likely to believe that Applicant's Goods offered in connection with Applicant's Mark originate from Avnet or are somehow affiliated with Avnet and its Avnet Mark, as the "AY Design" portion of Applicant's Mark is near-identical to Avnet's distinctive Avnet Mark. As such, Applicant's Mark so resembles Avnet's previously used and previously registered mark, as to be likely, when used in connection with Applicant's Goods, to cause confusion, to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that Applicant's Goods are produced, sponsored, endorsed, or approved by Avnet, or are in some way affiliated, connected, or associated with Avnet, all to the detriment of Avnet. Registration of Applicant's mark, therefore, should be refused under 15 U.S.C. §§ 1052(d) and 1063.

12. Registration of Applicant's proposed AYANYAO & Design would be a further source of damage to Avnet because it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Avnet's prior adoption, use, and registration of its marks.

WHEREFORE, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, Opposer Avnet, Inc. respectfully requests that its Notice of Opposition be sustained and that the registration of the mark shown in Application Serial No. 86/134,370 be refused.

Please direct all correspondence with respect to this Opposition to Kathy Tsai and Nancy Ly at the address below. Please charge the Notice of Opposition fee to the Deposit Account of Fish & Richardson P.C., Account No. 06-1050.

Respectfully Submitted,



Date October 24, 2014

Kathy Tsai
Nancy Ly
FISH & RICHARDSON P.C.
500 Arguello Street, Suite 500
Redwood City, CA 94063
Telephone: (650) 839-5070
Facsimile: (877) 769-7945

Counsel for Avnet, Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served this 24 day of October, 2014, by First Class U.S. Mail, postage prepaid, upon Applicant Shenzhen Anya Technology Co., Ltd.'s attorney of record at the following address:

Guo Kai
Suite 150, PMB 227
2723 South State Street
Ann Arbor, MICHIGAN 48104
UNITED STATES



Kathy Tsai

EXHIBIT A

Int. Cl.: 42

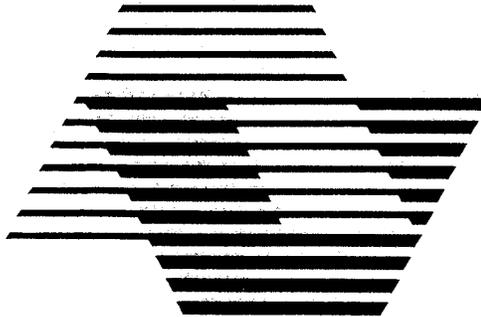
Prior U.S. Cl.: 101

United States Patent and Trademark Office

Reg. No. 1,700,991

Registered July 14, 1992

**SERVICE MARK
PRINCIPAL REGISTER**



AVNET, INC. (NEW YORK CORPORATION)
80 CUTTER MILL ROAD
GREAT NECK, NY 11021

FOR: DISTRIBUTORSHIP SERVICES FOR
ELECTRICAL, ELECTRONIC AND COMPUT-
ER EQUIPMENT AND FOR MOTORS AND MA-
CHINERY, IN CLASS 42 (U.S. CL. 101).

FIRST USE 11-0-1988; IN COMMERCE
11-0-1988.

OWNER OF U.S. REG. NO. 1,444,560.

THE LINING IN THE DRAWING IS A FEAT-
URE OF THE MARK AND DOES NOT INDI-
CATE COLOR.

THE MARK CONSISTS OF THE LETTERS,
"AV".

SER. NO. 74-151,622, FILED 3-22-1991.

CONNIE M. JUDGE, EXAMINING ATTORNEY

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

United States Patent and Trademark Office

Reg. No. 2,705,815

Registered Apr. 15, 2003

**TRADEMARK
PRINCIPAL REGISTER**



AVNET, INC. (NEW YORK CORPORATION)
2211 SOUTH 47TH STREET
PHOENIX, AZ 85034

FOR: ELECTRICAL, ELECTRONIC AND COMPUTER COMPONENTS AND EQUIPMENT, NAMELY, MICRO-PROCESSORS, SEMICONDUCTORS, MICROCHIPS, CIRCUIT BOARDS, SERVERS, DISPLAY PANELS, DATA STORAGE SOFTWARE AND HARDWARE, INTERCONNECT, PASSIVE AND ELECTROMECHANICAL SOFTWARE AND HARDWARE FOR LINKING COMMUNICATIONS AND DATA NETWORKS, EMBEDDED OPERATING SOFTWARE AND HARDWARE, RADIO FREQUENCY AND MICROWAVE SOFTWARE AND HARDWARE FOR LINKING COMMUNICATIONS AND DATA NETWORKS; AND POINT-OF-SALE SYSTEMS, NAMELY, BAR-CODE SCANNERS, AUTOMATIC IDENTIFICATION SOFTWARE AND

HARDWARE, AND WIRELESS COMPUTING SOFTWARE AND HARDWARE, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 2-19-1999; IN COMMERCE 2-19-1999.

OWNER OF U.S. REG. NOS. 1,444,560 AND 1,700,991.

THE LINING IN THE DRAWING IS A FEATURE OF THE MARK AND DOES NOT INDICATE COLOR.

THE MARK CONSISTS OF THE LETTERS, "AV".

SER. NO. 75-929,634, FILED 2-24-2000.

TRICIA THOMPCKINS, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office



Reg. No. 4,276,289

AVNET, INC. (NEW YORK CORPORATION)
2211 SOUTH 47TH STREET
PHOENIX, AZ 85034

Registered Jan. 15, 2013

Int. Cl.: 41

FOR: EDUCATION, NAMELY, PROVIDING OF TRAINING THROUGH CLASSROOM, ON-SITE, AND SEMINAR INSTRUCTION, ARRANGING AND CONDUCTING CONFERENCES, DISCUSSION FORUMS, EXHIBITIONS, PROGRAMS, SEMINARS, SYMPOSIUMS AND WORKSHOPS, ALL WITH RESPECT TO COMPUTER HARDWARE AND SOFTWARE, AND INFORMATION AND ADVICE REGARDING THE AFOREMENTIONED SERVICES, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

SERVICE MARK

PRINCIPAL REGISTER

FIRST USE 1-1-2003; IN COMMERCE 1-1-2003.

OWNER OF U.S. REG. NOS. 1,700,991 AND 2,705,815.

THE MARK CONSISTS OF STYLIZED LETTER "A" INTERLOCKING WITH A STYLIZED LETTER "V".

SN 85-205,466, FILED 12-23-2010.

BARBARA BROWN, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office