

ESTTA Tracking number: **ESTTA650205**

Filing date: **01/15/2015**

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	Core Brands, LLC
Granted to Date of previous extension	01/18/2015
Address	1800 South McDowell Blvd. Petaluma, CA 94954 UNITED STATES
Attorney information	David D'Zurilla Schwegman Lundberg & Woessner, P.A. P.O. Box 2938 Minneapolis, MN 55402 UNITED STATES tmg@slwip.com Phone:612-371-2140

Applicant Information

Application No	78452049	Publication date	07/22/2014
Opposition Filing Date	01/15/2015	Opposition Period Ends	01/18/2015
International Registration No.	NONE	International Registration Date	NONE
Applicant	Elan Microelectronics Corp. No. 12 Innovation Road 1 Science-Based Hsinchu City, TAIWAN		

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: Integrated circuits for use in human machine interface, telecom related integrated circuits, consumer integrated circuits, microcontroller integrated circuits, microprocessor integrated circuits, computer peripheral integrated circuits, caller ID integrated circuits, RF (radio frequency) integrated circuits, speech synthesizer integrated circuits, home appliance integrated circuits
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Design for others in the field of integrated circuit

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.	2760926	Application Date	01/30/2002
Registration Date	09/09/2003	Foreign Priority Date	NONE
Word Mark	ELAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1990/06/19 First Use In Commerce: 1990/06/19 Residential communications system for coordinating [telephone,] intercom, video and electrical equipment, comprising [telephones,] video cameras, [televisions,] audio amplifiers, speakers and AM/FM radios		

U.S. Registration No.	2801799	Application Date	01/30/2002
Registration Date	01/06/2004	Foreign Priority Date	NONE
Word Mark	ELAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1995/09/01 First Use In Commerce: 1995/09/01 residential communications system for coordinating [telephone,] intercom, video and electrical equipment, comprising telephones, video cameras, [televisions,] audio amplifiers, speakers and AM/FM radios		

U.S. Application No.	78734782	Application Date	10/17/2005
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ELAN HOME SYSTEMS		

Design Mark	<h1 style="text-align: center;">ELAN Home Systems</h1>
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2005/10/17 First Use In Commerce: 2005/10/17</p> <p>Residential communications systems and devices namely-- control devices for telephone systems, intercom systems, lighting systems, security systems, heating and air conditioning systems, entertainment systems, and window treatment systems; control systems and equipment used for device control applications and for audio and video applications namely-- electric control panels, touch panels, volume controls, video controllers, DVD controllers, and multi-room/multi-product controllers; audio and video equipment namely-- video cameras, televisions, audio amplifiers, AM/FM radios, speakers, and voltage surge protectors; music source products namely-- digital music servers, satellite audio receivers, and digital tuners; and structured wiring</p>

Attachments	<p>76369114#TMSN.png(bytes) 76381443#TMSN.png(bytes) 78734782#TMSN.png(bytes) 5981_059USA_Notice_of_Opposition.pdf(142718 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	/David D'Zurilla/
Name	David D'Zurilla
Date	01/15/2015

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

Core Brands, LLC

v.

Opposition No. _____

Application No. 78/452,049

Mark: ELAN

Elan Microelectronics Corporation

NOTICE OF OPPOSITION

Opposer, Core Brands, LLC, a company whose business address is 1800 South McDowell Boulevard, Petaluma, California 95954, believes that it will be damaged by the registration of the ELAN mark shown in Application Serial No. 78/452,049, and hereby opposes the same pursuant to the provisions of 15 U.S.C. § 1063.

On July 16, 2004, Elan Microelectronics Corporation (“Applicant”), a company whose business address is No. 12 Innovation Road, Science-Based Industrial Park, Hsinchu City, Taiwan, filed an application to register the mark ELAN (“Applicant’s mark”) for “Integrated circuits, telecom related IC, consumer IC, microcontroller IC, microprocessor IC, computer peripheral IC, communication IC, LCD driver IC, one-time-program IC, AD/DA converter IC, CPU IC, digital signal processing IC, caller ID IC, email ID IC, RF (radio frequency) IC, memory IC, speech synthesizer IC, home

appliance IC, ASIC, mask ROM IC, flash memory IC, SRAM IC, embedded IC, linear IC, power IC, bipolar IC, MOS sensor, network relative products, communication relative products” and “Design service of integrated circuits.” Applicant’s mark was published on July 22, 2014. On August 6, 2014, Core Brands, LLC requested a 90 day extension of time to file a Notice of Opposition. On November 18, 2014, Core Brands, LLC requested a further 60 day extension of time to file a Notice of Opposition. The second extension request extended the time period for Core Brands, LLC to file a Notice of Opposition until January 18, 2015. Opposer herein timely files this Notice of Opposition on January 15, 2015.

As grounds for its opposition, Opposer alleges:

1. Opposer has been and is currently using its ELAN marks in connection with residential communications systems for coordinating intercom, video and electrical equipment for video cameras, audio amplifiers, speakers and AM/FM radios. Opposer’s use of its ELAN marks has been valid and continuous in the United States since at least as early as 1990 and its ELAN marks have not been abandoned.
2. Opposer is the owner of U.S. Trademark Registration No. 2760926 (“the ‘926 registration”), which issued on September 9, 2003, for residential communications systems for coordinating intercom, video and electrical equipment, comprising video cameras, audio amplifiers, speakers and AM/FM radios. The ‘926 registration is valid, subsisting, and incontestable under 15 U.S.C. § 1065, and

- therefore constitutes conclusive evidence of Opposer's exclusive right to use its ELAN mark in commerce with the goods specified in the registration.
3. Opposer is further the owner of U.S. Trademark Registration No. 2801799 ("the '799 registration") issued on January 6, 2004 for residential communications systems for coordinating intercom, video and electrical equipment, comprising telephones, video cameras, audio amplifiers, speakers and AM/FM radios. The '799 registration is valid, subsisting, and incontestable under 15 U.S.C. § 1065, and therefore constitutes conclusive evidence of Opposer's exclusive right to use its ELAN mark in commerce with the goods specified in the registration.
 4. Opposer has a well-recognized reputation for the excellence and superiority of the goods offered under its ELAN marks.
 5. As a result of Opposer's long-standing and extensive use of its ELAN marks in the United States since at least as early as 1990, Opposer's marks are symbolic of the extensive good will and customer recognition established by Opposer by virtue of the expenditure of substantial amounts of time and effort in advertising and promoting its goods under its ELAN marks. The ELAN marks thus identify Opposer and its goods.
 6. On July 16, 2004, Applicant, Elan Microelectronics Corporation ("Applicant") filed U.S. Serial Application No. 78/452,049 to register the mark ELAN for "Integrated circuits, telecom related IC, consumer IC, microcontroller IC, microprocessor IC, computer peripheral IC, communication IC, LCD driver IC, one-time-program IC, AD/DA converter IC, CPU IC, digital signal processing IC, caller ID IC, email ID IC, RF (radio frequency) IC, memory IC, speech

synthesizer IC, home appliance IC, ASIC, mask ROM IC, flash memory IC, SRAM IC, embedded IC, linear IC, power IC, bipolar IC, MOS sensor, network relative products, communication relative products” and “Design service of integrated circuits.”

7. On October 17, 2005, Opposer filed U.S. Serial Application No. 78/734,782 to register its mark ELAN HOME SYSTEMS for residential communications systems and devices, namely: telephone systems; intercom systems; lighting systems; security systems; heating and air conditioning systems; entertainment systems; structured wiring; control systems and equipment used for device control applications and for audio and/or video applications, including control panels, window treatment systems and multi-room/multi-product controllers; speakers; audio and/or video equipment systems including video cameras, televisions, audio amplifiers, AM/FM radios, and audio equipment; viewing devices; music source products; and telephones. Opposer’s ‘782 application was suspended on, and has been suspended since, December 7, 2006, based on Applicant’s 78/452,049 application for the mark ELAN.

GROUND

Likelihood of Confusion

8. Opposer hereby incorporates by reference the allegations of Paragraphs 1-7 hereof as if fully set forth herein.
9. Opposer’s ELAN marks are well-known, strong, and famous marks, deserving of a broad scope of legal protection because of the high degree of distinctiveness of

- its ELAN marks, the vast advertising and publicity its ELAN marks have received, the substantial trading area in which its ELAN marks are used, and the high degree of consumer recognition of its ELAN marks.
10. Applicant's ELAN mark is identical in sound and appearance to Opposer's ELAN marks.
 11. Applicant's ELAN mark, when used in connection with Applicant's goods, so resembles Opposer's previously used and registered ELAN marks as likely to cause confusion, mistake, and/or deceive consumers concerning an affiliation, connection, association, or sponsorship with the source of goods sold under Opposer's ELAN marks and/or Applicant's ELAN mark, in violation of 15 U.S.C. § 1052(d), with consequent injury to Opposer, the public, and the trade.
 12. Opposer will be damaged by the registration of Applicant's ELAN mark because the mark is identical to Opposer's ELAN marks previously used in the United States, and not abandoned, as to be likely to cause customer confusion, mistake, and deception, particularly in view of the identity of the respective marks and closely related nature of the respective parties' goods. Persons familiar with Opposer's ELAN marks and registrations would be likely to mistakenly believe that Applicant's goods are offered by Opposer or endorsed and sponsored by Opposer, and registration of Applicant's mark on the Principal Register would be damaging to Opposer's rights in its federally registered ELAN marks.
 13. Notwithstanding Opposer's prior use and prior registrations for its ELAN marks, Opposer's pending U.S. Serial Application No. 78/734,782 for its mark ELAN

HOME SYSTEMS has been suspended since December 7, 2006 based on Applicant's '049 application for the ELAN mark.

14. Opposer has therefore further been damaged and harmed by Applicant's attempts to register the ELAN mark.
15. Pursuant to 15 U.S.C. § 1063(a), Opposer believes that it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the use of the ELAN mark, and would give color and exclusive statutory right to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.
16. Opposer therefore requests that Application Serial No. 78/452,049 be refused registration, and that this opposition be sustained in favor of Opposer.

17. The Commissioner is authorized to charge Schwegman, Lundberg, and Woessner P.A.'s Deposit Account No. 19-0743 if there is a deficiency in the enclosed filing fee.

Dated: January 15, 2015

Respectfully submitted,

Core Brands, LLC
A California Corporation
1800 South McDowell Blvd
Petaluma, California 95954

By its Representatives:

/  /

David D'Zurilla
Registration No. 36,776
Minnesota Bar No. 0335137
Schwegman, Lundberg & Woessner, P.A.
Attorneys for Opposer
121 South Eighth Street
Suite 1600
Minneapolis, MN 55402
(612) 373-6900
ddzurilla@slwip.com
request@slwip.com

Certificate of Service

I hereby certify under penalty of perjury under the laws of the United States that on January 15, 2015 copies of the attached Notice Of Opposition were deposited in the U.S. Mail, first class postage prepaid, addressed to:

Jill M. Pietrini
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
1901 Avenue of the Stars
Suite 1600
Los Angeles, California 90067-6017

Susan Hwang
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 South Hope Street
43rd Floor
Los Angeles, California 90071-1422

Kathy Ginnell

Kathy Ginnell