

ESTTA Tracking number: **ESTTA682025**

Filing date: **07/06/2015**

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	DAVID ESCAMILLA
Granted to Date of previous extension	07/08/2015
Address	500 N. MICHIGAN AVE., SUITE 600 CHICAGO, IL 60611 UNITED STATES

Correspondence information	DAVID ESCAMILLA 500 N. MICHIGAN AVE., SUITE 600 CHICAGO, IL 60611 UNITED STATES info@m2software.com
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Applicant Information

Application No	86412820	Publication date	03/10/2015
Opposition Filing Date	07/06/2015	Opposition Period Ends	07/08/2015
Applicant	JW ELECTRONICS CO., LTD. 3A17, NO. 5, SEC.5, HSIN-YI RD. TAIPEI, TAIWAN		

Goods/Services Affected by Opposition

Class 009. First Use: 2014/03/13 First Use In Commerce: 2014/03/13 All goods and services in the class are opposed, namely: COMPUTER MEMORIES; COMPUTER PERIPHERAL DEVICES; RECORDED COMPUTER PROGRAMS, DOWNLOADABLE COMPUTER PROGRAMS AND RECORDED COMPUTER SOFTWARE, ALL FOR CONTROLLING PROCESS OR OPERATION IN THE CONNECTION OF A REMOTE DATA STORAGE DEVICE TO A COMPUTER NETWORK; CALCULATING MACHINES, DATA PROCESSING EQUIPMENT AND COMPUTERS; DISK DRIVES FOR COMPUTERS; INTERFACES FOR COMPUTERS
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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. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	M2		

Goods/Services	trade name use, general computer software		
U.S. Registration No.	4128151	Application Date	06/08/2011
Registration Date	04/17/2012	Foreign Priority Date	NONE
Word Mark	M2		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1991/10/23 First Use In Commerce: 1992/01/10 Development, updating and maintenance of software and data bases; Technical support services, namely, troubleshooting of computer software problems		

U.S. Registration No.	1931182	Application Date	08/30/1994
Registration Date	10/31/1995	Foreign Priority Date	NONE
Word Mark	M2		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1991/10/23 First Use In Commerce: 1992/01/10 computer software featuring business management applications for the film and music industries; and interactive multimedia applications for entertainment, education and information, in the nature of artists' performances and biographical information from the film and music industries; and instructions and information for playing musical instruments		

Attachments	85341646#TMSN.png(bytes) TTAB-NOT-OPP 86412820 20150706.pdf(451424 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	/de/
Name	DAVID ESCAMILLA
Date	07/06/2015

I hereby certify that this correspondence is being transmitted over ESTTA to the U.S. Patent and Trademark Office, via the Internet at <http://www.uspto.gov>, on the date indicated below.

By: /s David Escamilla Date: July 6, 2015
David Escamilla

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

DAVID ESCAMILLA

Opposer,

v.

JW ELECTRONICS CO., LTD.

Applicant.

Opposition No. _____

For:



Serial No.: 86/412,820

Published: 3/10/2015

NOTICE OF OPPOSITION

DAVID ESCAMILLA (“Opposer”), senior owner and user of the federally-registered **M2**[®] trademark and service mark for the same or similar field of the new application, believes he will be damaged by registration of Application Serial No. 86/412,820 of JW ELECTRONICS CO., LTD. (“Applicant”) for the mark “M2 Enabler” (design), and hereby opposes the same.

1.) Opposer is the senior user, owner, and licensor of the **M2**[®] trademark and service mark, used throughout the United States and the world since at least as early as 1991 and since long prior to Applicant’s new application. The primary business of Opposer’s licensee M2 Software, Inc. includes provision of enterprise solutions and related services in the information technology (“IT”) industry, in the same, related, and/or complementary field to that of the new application.

2.) This Opposition arises following publication after a trademark examination that conducted a search of the term “**ENABLER**” but *did not* conduct a search of the term “**M2**.” On information and belief, this incomplete examination occurred after Applicant submitted a false statement describing the pseudo-mark as “**MEMORIES TWO ENABLER**” rather than “**M2 ENABLER**.”

3.) The mark identified on the application is actually comprised of, as its dominant element, a mark identical to Opposer’s federally-registered “**M2**” mark. Applicant presents the “M2” mark together with a generic industry term that merely describes a function of the applied-for goods (“M2 ENABLER”), in design form. Applicant describes its usage as “computer memories, computer peripheral de-

vices, recorded computer programs, downloadable computer programs and recorded computer software, all for controlling process or operation in the connection of a remote data storage device to a computer network; calculating machines, data processing equipment and computers; disk drives for computers; interfaces for computers.” This encompasses a field of goods and services for which Opposer has long used the **M2**[®] mark and a field which is already protected by senior federal registrations.

4.) The **M2**[®] mark is a registered trademark and service mark of Opposer, registered on the Principal Register in standard character form, protecting all manners of display including the applied-for design. TMEP § 1207.01(c)(iii). The marks cited as basis for this Opposition are **U.S. Reg. No. 4,128,151** in Class 042 for **M2**[®] for services described as “development, updating, and maintenance of software and data bases; technical support services, namely, troubleshooting of computer software problems” across all customer markets, and **U.S. Reg. No. 1,931,182** for **M2**[®] for goods described as, *inter alia*, “computer software featuring business management applications * * *” that comprise pre-developed solutions in a variety of vertical markets. Attached hereto as Exhibits Opp-1 and Opp-2 are true and correct copies of the cited registrations.

5.) Opposer’s **M2**[®] commercial symbol is a technical trademark, a fanciful symbol created for trademark purposes with no senior registrant in any remotely related field. The applied-for mark **“M2 ENABLER”** is likely to cause confusion of source, sponsorship, affiliation, or other connection with the senior mark.

6.) By applying for the same dominant trademark, Applicant is capitalizing on Opposer’s reputation, goodwill, advertising, and development costs, at little to no expense to Applicant. No authorization, approval, or permission has been granted by Opposer to Applicant for use of Opposer’s established **M2**[®] mark.

7.) Applicant uses and has available the non-infringing mark **“AOE ENABLER”** (Reg. No. 3,955,314) with the same general design and for the same identified goods for which it now seeks **“M2 ENABLER,”** and no legitimate need to convert its branding to the **“M2”** mark and name owned by Opposer. No authorization or license has been granted Applicant for use of Opposer’s mark.

8.) An application must be rejected under Section 2(d) if it “consists of or comprises” a mark that “so resembles” a senior owner’s mark as to be likely to cause confusion. 15 U.S.C. § 1052(d). The new application fits this criteria.

9.) As further grounds for opposition, the applications must be declared void *ab initio* because Applicant willfully submitted false information on its application, including but not limited to providing false information that the pseudo-mark was “MEMORIES ENABLER” rather “M2 ENABLER” (underlines added) and declaring that “no other person has the right to use the mark in commerce.” Applicant has acknowledged that “willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom * * *.”

10.) Applicant’s failure to disclose that “M2 ENABLER” was the actual pseudo-mark resulted in an ineffectual X-Search query, wherein the trademark examination focused on the term “ENABLER” rather than a query on the true mark “M2” that would have identified Opposer’s senior federally-registered **M2**[®] mark.

11.) Opposer believes Application Serial No. 86/412,820, if allowed to pass to registration, will cause injury and damage to Opposer in causing substantial confusion as to source, sponsorship, or affiliation between “M2 ENABLER” and Opposer’s senior federally-registered **M2**[®] trademark.

WHEREFORE, Opposer respectfully requests that Application Ser. No. 86/412,820 be refused and that this Opposition be sustained.

Dated: July 6, 2015

Respectfully submitted,

DAVID ESCAMILLA

s/David Escamilla/

OPPOSER

EXHIBIT Opp-1

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Mark: M2

M2

US Serial Number: 85341646	Application Filing Date: Jun. 08, 2011
US Registration Number: 4128151	Registration Date: Apr. 17, 2012
Filed as TEAS Plus: Yes	Currently TEAS Plus: Yes
Register: Principal	
Mark Type: Service Mark	
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.	
Status Date: Apr. 17, 2012	
Publication Date: Oct. 25, 2011	

▼ Mark Information [Expand All](#)

Mark Literal Elements: M2
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.
Mark Drawing Type: 4 - STANDARD CHARACTER MARK
Acquired Distinctiveness Claim: In whole

▲ Related Properties Information

▼ Goods and Services

Note:
 The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Development, updating and maintenance of software and data bases; Technical support services, namely, troubleshooting of computer software problems	U.S Class(es): 100, 101
International Class(es): 042 - Primary Class	
Class Status: ACTIVE	
Basis: 1(a)	
First Use: Oct. 23, 1991	Use in Commerce: Jan. 10, 1992

▲ Basis Information (Case Level)

▼ Current Owner(s) Information

Owner Name: ESCAMILLA, DAVID	
DBA, AKA, Formerly: AKA M2 INTELLECTUAL PROPERTY ASSETS	
Owner Address: 500 N. MICHIGAN AVE., SUITE 600 CHICAGO, ILLINOIS 60611 UNITED STATES	
Legal Entity Type: INDIVIDUAL	Citizenship: UNITED STATES

▲ Attorney/Correspondence Information

▲ Prosecution History

▲ TM Staff and Location Information

EXHIBIT Opp-2

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Mark: M2

No image exists for this case.

US Serial Number: 74567603	Application Filing Date: Aug. 30, 1994
US Registration Number: 1931182	Registration Date: Oct. 31, 1995
Register: Principal	
Mark Type: Trademark	
Status: The registration has been renewed.	
Status Date: Feb. 22, 2005	
Publication Date: Aug. 08, 1995	

▼ Mark Information [Expand All](#)

Mark Literal Elements: M2
Standard Character Claim: No
Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

▼ Goods and Services

Note:
 The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: computer software featuring business management applications for the film and music industries; and interactive multimedia applications for entertainment, education and information, in the nature of artists' performances and biographical information from the film and music industries; and instructions and information for playing musical instruments	
International Class(es): 009 - Primary Class	U.S Class(es): 021, 023, 026, 036, 038
Class Status: ACTIVE	
Basis: 1(a)	
First Use: Oct. 23, 1991	Use in Commerce: Jan. 10, 1992

▲ Basis Information (Case Level)

▼ Current Owner(s) Information

Owner Name: ESCAMILLA, DAVID	
DBA, AKA, Formerly: AKA M2 INTELLECTUAL PROPERTY ASSETS	
Owner Address: 500 N. MICHIGAN AVE., SUITE 600 CHICAGO, ILLINOIS 60611 UNITED STATES	
Legal Entity Type: INDIVIDUAL	Citizenship: UNITED STATES

▲ Attorney/Correspondence Information

▲ Prosecution History

▲ Maintenance Filings or Post Registration Information

▲ TM Staff and Location Information

▲ Assignment Abstract Of Title Information

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION is being served on July 6, 2015, by first class mail, postage prepaid, upon the defendant / Applicant by its attorney of record at the following address:

MORTON J. ROSENBERG
ROSENBERG, KLEIN & LEE
3458 ELLICOTT CENTER DR. STE 101
ELLICOTT CITY, MD 21043-4178

s/David Escamilla/
David Escamilla