

ESTTA Tracking number: **ESTTA774145**

Filing date: **10/02/2016**

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	Sony Corporation
Granted to Date of previous extension	10/02/2016
Address	1-7-1 Konan, Minato-ku Tokyo, 108-0075 JAPAN

Attorney information	Gina M. McCreddie Nixon Peabody LLP 100 Summer Street Boston, MA 02110 UNITED STATES gmccreadie@nixonpeabody.com, dcheng@nixonpeabody.com, was.managing.clerk@nixonpeabody.com Phone:617-345-1000
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Applicant Information

Application No	86801656	Publication date	04/05/2016
Opposition Filing Date	10/02/2016	Opposition Period Ends	10/02/2016
Applicant	SONIFI Solutions, Inc. General Counsel Sioux Falls, SD 57107 UNITED STATES		

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: Interoperable communication system designed to provide radio, streaming video, wireless internet, and VOIP phone
Class 038. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Streaming of video material on the Internet

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3243454	Application Date	10/27/2006
Registration Date	05/22/2007	Foreign Priority	NONE

		Date	
Word Mark	SONY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1996/05/31 First Use In Commerce: 1996/05/31 Cellular telephones, batteries for cellular telephones, battery chargers for cellular telephones, cases for cellular telephones, devices for hands-free use of cellular telephones, cellular telephone straps, holsters for carrying cellular telephones, cradles for cellular telephones, [PC cards, styli for use with cellular telephones that have touch screens, flash units for cellular telephones with cameras, media viewers, gameboards, integrated circuit recording media readers, audio speakers, audio systems comprised of an amplifier and speakers for use with cellular telephones, FM radio transmitters for use with cellular telephones, USB cables, plastic covers for cellular telephones]</p> <p>Class 014. First use: First Use: 2005/12/31 First Use In Commerce: 2005/12/31 watches * in the nature of smart watches *</p>		

U.S. Registration No.	770275	Application Date	06/19/1963
Registration Date	05/26/1964	Foreign Priority Date	NONE
Word Mark	SONY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1961/03/30 First Use In Commerce: 1961/03/30 Television Cameras		

U.S. Registration No.	777400	Application Date	06/21/1963
Registration Date	09/22/1964	Foreign Priority Date	NONE
Word Mark	SONY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1963/03/23 First Use In Commerce: 1963/03/23 Lighting Apparatus		

U.S. Registration No.	785967	Application Date	06/21/1963
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Registration Date	03/02/1965	Foreign Priority Date	NONE
Word Mark	SONY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U026 (International Class 001, 009, 010). First use: First Use: 1962/01/27 First Use In Commerce: 1962/01/27 ANALYSIS APPARATUS AND EQUIPMENT-NAMELY, [AUTOMATIC ANALOG CORRELATORS, AUTOMATIC TRANSIENT WAVEFORM RECORDERS] AND DATA RECORDERS, [CORRELATORS AND METERS]		

U.S. Registration No.	801885	Application Date	10/14/1964
Registration Date	01/11/1966	Foreign Priority Date	NONE
Word Mark	SONY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 015. First use: First Use: 1964/05/30 First Use In Commerce: 1964/06/10 ELECTRICAL SOUND RECORDING APPARATUS, INCLUDING ELECTRIC RECORD PLAYERS, ELECTRICALLY DRIVEN RECORD CHANGERS, AND AUTOMATIC PHONOGRAPH RECORD CHANGERS		

U.S. Registration No.	886119	Application Date	08/09/1968
Registration Date	02/17/1970	Foreign Priority Date	NONE
Word Mark	SONY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1967/07/20 First Use In Commerce: 1967/07/20 TRAVELING BAGS, UTILITY BAGS (DRAWSTRING TYPE) AND WALLETS		

Attachments	77030850#TMSN.png(bytes) Sony Notice of Opposition_SONICAST 656_FINAL.pdf(245596 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	/Gina M. McCreadie/
Name	Gina M. McCreadie
Date	10/02/2016

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

In the Matter of:
Application Serial No. 86/801,656
Mark: SONICAST
Published in the *Official Gazette*: April 5, 2016

SONY CORPORATION,

Opposer,

v.

SONIFI SOLUTIONS, INC.,

Applicant.

Opposition No.: _____

NOTICE OF OPPOSITION

1. Opposer Sony Corporation (“Opposer”), a corporation organized under the laws of Japan with a principal place of business at 1-7-1 Konan, Minato-ku, Tokyo, 108-0075, Japan, hereby opposes the application of SONIFI Solutions, Inc. (“Applicant”), a corporation located at 3900 W. Innovation Street, Sioux Falls, South Dakota 57107, for registration of the trademark SONICAST, App. Serial No. 86/801,656 (the “’656 Application”), for “[i]nteroperable communication system designed to provide radio, streaming video, wireless internet, and VOIP phone,” in International Class 9 and “[s]treaming of video material on the Internet,” in International Class 38, published for opposition on April 5, 2016.

2. Founded in 1946, Opposer is one of the world’s leading developers of electronic products and services for consumer and professional markets, motion pictures, music, entertainment, and financial services. In 1958, Opposer adopted SONY as a mark and the name of its company by combining “Sonus,” the original Latin for “Sonic,” meaning sound, with

“Sonny,” denoting a small size, or youthful boy. Opposer selected the SONY mark for its simple pronunciation that is the same in any language. Opposer’s principal business operations include Sony Corporation (Sony Corporation of America in the United States), Sony Pictures Entertainment, Sony Interactive Entertainment, Sony Music Entertainment, Sony Mobile Communications, and Sony Financial Holdings.

3. Opposer is an established international business enterprise present in diverse fields related to electronics, media and entertainment. It is a leading manufacturer of audio, video, communications and information technology products for the consumer and professional market. Opposer continues to develop and offer innovative products, such as BRAVIA[®] LCD televisions, WALKMAN[®] digital music players, Handycam[®] camcorders, Cyber-shot[®] compact cameras, α [™] digital single-lens reflex cameras, PlayStation[®] computer games, XPERIA[™] smartphones and tablets etc. Opposer is also the co-developer of the CD, the DVD, and the Blu-ray Disk format, and a leading manufacturer of audio, video products, electronic components, professional solutions and medical related equipment.

4. Opposer’s motion picture, television, computer entertainment, music and online businesses make Opposer one of the most comprehensive entertainment and technology companies in the world. Opposer’s global operations in the pictures segment encompass motion picture production and distribution; television production and distribution; digital content creation and distribution; worldwide channel investments; home entertainment acquisition and distribution; operation of studio facilities; development of new entertainment products, services and technologies; and distribution of film entertainment in more than 130 countries. Opposer has released critically acclaimed movies, such as “Spectre,” “Hotel Transylvania 2,” “Pixels,” “The Amazing Spider-Man 2,” and “22 Jump Street,” and produces hit television shows, such as

“The Blacklist,” “Shark Tank,” “Breaking Bad,” “Jeopardy!” and “Wheel of Fortune.” Sony Music artists include Adele, One Direction, Sia, David Bowie, Bruce Springsteen, Michael Jackson and Beyoncé, while The Sony Entertainment Network has become an ultimate destination for digital music, movies, television programs and games delivered through the PlayStation Network and the PlayStation Music and PlayStation Video services. With approximately 900 million of Opposer’s devices in hands and homes worldwide, a wide array of Opposer’s movies, television shows and music, and Playstation Network and the Sony Entertainment Network, Opposer creates and delivers entertainment experiences that touch the lives of millions of people each day.

5. Opposer recorded consolidated annual sales of approximately 8,106 billion Yen for the fiscal year ended March 31, 2016, and employs approximately 125,300 people worldwide. Over the years, Opposer has spent millions of dollars to advertise and promote its SONY goods and services.

6. Opposer is the owner of all right, title, and interest in and to the SONY and SONY-formative marks, and owns hundreds of registrations for the SONY mark in the United States and countries throughout the world for use in connection with a wide variety of goods and services, including without limitation consumer electronics products.

7. For example, in the United States, Opposer is the owner of U.S. Registration No. 3,243,454 for SONY for “Cellular telephones, batteries for cellular telephones, battery chargers for cellular telephones, cases for cellular telephones, devices for hands-free use of cellular telephones, cellular telephone straps, holsters for carrying cellular telephones, cradles for cellular telephones” in International Class 9, with a date of first use and first use in commerce of May 31, 1996.

8. Opposer is also the owner of U.S. Registration No. 770,275 for SONY for “television cameras” in International Class 9, with a date of first use and first use in commerce of March 30, 1961.

9. Opposer is also the owner of U.S. Registration No. 777,400 for SONY for “lighting apparatus” in International Class 11, with a date of first use and first use in commerce of March 23, 1963.

10. Opposer is also the owner of U.S. Registration No. 785,967 for SONY for “analysis apparatus and equipment-namely data recorders” in International Classes 1, 9, and 10, with a date of first use and first use in commerce of January 27, 1962.

11. Opposer is also the owner of U.S. Registration No. 801,885 for SONY for “electrical sound recordings apparatus, including electric record players, electrically driven record changers, and automatic phonograph record changers” in International Class 15, with a date of first use on about May 30, 1964, and a date of first use in commerce on about June 10, 1964.

12. Opposer is also the owner of U.S. Registraiton No. 886,119 for SONY for “traveling bags, utility bags (drawstring type) and wallets” in International Class 18 with a date of first use and first use in commerce of July 20, 1967.

13. Each of the aforementioned registrations is valid, subsisting, in full force and effect, and provide *prima facie* evidence of Opposer’s ownership of, and exclusive rights in, the SONY mark in connection with a variety of goods and services (collectively, the “SONY Marks”). True and correct copies of the aforementioned registrations are attached hereto as Exhibit 1.

14. Opposer also uses the SONY mark in connection with other words, such as SONY CARD, SONY CLASSICAL, SONY INTERACTIVE ENTERTAINMENT (formerly SONY COMPUTER ENTERTAINMENT), SONY MUSIC, SONY PICTURES, SONY FINANCIAL SERVICES, SONY STYLE, SONY TABLET, and SONY WONDER.

Consumers have come to recognize and understand that Opposer provides a wide variety of products and services under its SONY and SONY-formative marks, and continues to develop and create new products and services.

15. The SONY mark is a unique and arbitrary mark that has no meaning in the English language.

16. Over the years, and long before the '656 Application was filed or any asserted date of first use of Applicant's mark, Opposer has spent millions of dollars in the United States to advertise and promote its SONY goods and services. Advertisements for SONY products and services in the United States have appeared in print, and on television, radio, and online and social media, as well as on billboards, and at sporting, music, and entertainment events through sponsorships and other advertisement activities. Prominent use of Opposer's famous SONY mark as part of these advertisements and sponsorships has further enhanced the strength and fame of the SONY Marks.

17. Opposer promotes, advertises, and sells Opposer's high-quality products and services under the SONY Marks in retail stores, department stores, specialty stores, boutiques, and through the online retailers in the United States and throughout the world. Prominent use of Opposer's famous SONY Marks in these retailers has, again, further enhanced the strength and fame of this mark.

18. Opposer has also committed substantial amounts of time, money, and resources to develop a worldwide reputation as one of the premier manufacturers of its products and services offered under the SONY and SONY-formative marks.

19. As a result of Opposer's long standing, continuous, and exclusive use of the SONY Marks in the United States, and throughout the world, as well as its extensive advertisement and promotion of its high-quality goods and services, SONY is a strong, highly distinctive, and famous mark that has come to signify Opposer and its high quality and innovative products and services. Consumers have come to associate products and services offered under the SONY Marks as originating exclusively from Opposer, and Opposer has generated substantial goodwill in, and is entitled to a wide scope of protection for, its SONY Marks.

20. On or about October 28, 2015, Applicant filed the '656 Application under Section 1(b) of the Lanham Act for the mark SONICAST for "[i]nteroperable communication system designed to provide radio, streaming video, wireless internet, and VOIP phone," in International Class 9 and "[s]treaming of video material on the Internet," in International Class 38.

21. In the '656 Application, Applicant claims an intent to use the SONICAST mark.

22. Opposer has established rights in the SONY Marks prior to any date on which Applicant can rely on for use of its mark SONICAST in connection with the goods and services listed in the '656 Application.

23. Upon information and belief, Opposer was aware of the SONY marks prior to its adoption of SONICAST.

24. Applicant's SONICAST mark is similar in sound to the SONY Marks. The "SONI" portion of Applicant's mark is capable of being pronounced like, or similar to, the SONY Marks. Similar to Opposer's mark, SONI has no meaning in the English language.

25. Upon information and belief, Applicant's goods offered – or to be offered – under the SONICAST mark will be advertised, promoted, offered for sale, and sold to the same groups of consumers who use and enjoy products and services offered under the SONY and SONY-formative marks through the same or similar channels of trade.

COUNT I – LIKELIHOOD OF CONFUSION
(Section 2(d) of the Lanham Act)

26. Opposer repeats and incorporates herein by reference paragraphs 1 through 25 above.

27. If Applicant is permitted to register its SONICAST mark, confusion, deception, and/or mistake among consumers is likely because of the similarity between Opposer's SONY Marks and Applicant's SONICAST mark, all to the detriment of Opposer.

28. Applicant's use or anticipated use, if any, of the SONICAST mark in connection with the goods and services listed in the '656 Application are sufficiently related to goods and services offered by or associated with Opposer so that confusion, mistake, and/or deception among consumers as to source and/or sponsorship of the goods and services offered under the two marks is likely, all to the detriment of Opposer.

29. Based on the foregoing, Opposer believes that it will be damaged, and will continued to be damaged by, Applicant's attempted registration of the SONICAST mark, as set forth in the '656 Application.

30. For the reasons set forth in the preceding paragraphs, Applicant is not entitled to register its SONICAST mark as set forth in the '656 Application, and the '656 Application should be denied in accordance with Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

COUNT II – LIKELIHOOD OF DILUTION
(Section 43(c) of the Lanham Act)

31. Opposer repeats and incorporates herein by reference paragraphs 1 through 30 above.

32. The SONY Marks are famous marks.

33. Opposer's SONY Marks were famous prior to the filing date of the '656 Application and prior to any use or anticipated use, if any, of the SONICAST mark in connection with the goods and services listed in the '656 Application.

34. Applicant's use, or anticipated use, if any, of the SONICAST mark is likely to cause dilution by blurring by creating a likelihood of association with Opposer arising from the similarity to Opposer's famous SONY Marks and is likely to impair the distinctiveness of the SONY Marks and injure Opposer's goodwill and reputation as symbolized by the SONY Marks.

35. Based on the foregoing, Opposer believes that it will be damaged, and will continued to be damaged, by Applicant's attempted registration of the SONICAST mark, as set forth in the '656 Application.

36. For the reasons set forth in the preceding paragraphs, Applicant is not entitled to register its SONICAST mark as set forth in the '656 Application, and the '656 Application should be denied in accordance with Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

WHEREFORE, Opposer respectfully requests that the Board sustain this Opposition to U.S. Application Serial No. 86/801,656 and deny registration of the SONICAST mark.

Dated: October 2, 2016

Respectfully submitted,

NIXON PEABODY LLP

By its attorneys,

/Gina M. McCreadie/

Gina M. McCreadie

Troy K. Lieberman

NIXON PEABODY LLP

100 Summer Street

Boston, MA 02110

Tel: (617) 345-1000

Fax: (617) 345-1300

gmccreadie@nixonpeabody.com

tlieberman@nixonpeabody.com

Attorneys for Sony Corporation

CERTIFICATE OF SERVICE

I, Gina M. McCreadie, hereby caused a true and correct copy of the foregoing document and all exhibits, to be served on October 2, 2016, by first class mail and electronic email on the following:

James L. Young
Westman, Champlin & Koehler, P.A.
900 2nd Avenue South, Suite 1400
Minneapolis, Minnesota 55402
Email: jyoung@wck.com

Attorney of Record for Applicant

/Gina M. McCreadie/

Gina M. McCreadie

EXHIBIT 1

Int. Cls.: 9 and 14

Prior U.S. Cls.: 2, 21, 23, 26, 27, 28, 36, 38 and 50

Reg. No. 3,243,454

United States Patent and Trademark Office

Registered May 22, 2007

**TRADEMARK
PRINCIPAL REGISTER**

SONY

SONY KABUSHIKI KAISHA (JAPAN CORPORATION), TA SONY CORPORATION
6-7-35 KITASHINAGAWA
SHINAGAWA-KU
TOKYO, JAPAN

FOR: CELLULAR TELEPHONES, BATTERIES FOR CELLULAR TELEPHONES, BATTERY CHARGERS FOR CELLULAR TELEPHONES, CASES FOR CELLULAR TELEPHONES, DEVICES FOR HANDS-FREE USE OF CELLULAR TELEPHONES, CELLULAR TELEPHONE STRAPS, HOLSTERS FOR CARRYING CELLULAR TELEPHONES, CRADLES FOR CELLULAR TELEPHONES, PC CARDS, STYLI FOR USE WITH CELLULAR TELEPHONES THAT HAVE TOUCH SCREENS, FLASH UNITS FOR CELLULAR TELEPHONES WITH CAMERAS, MEDIA VIEWERS, GAMEBOARDS, INTEGRATED CIRCUIT RECORDING MEDIA READERS, AUDIO SPEAKERS, AUDIO SYSTEMS COMPRISED OF AN AMPLIFIER AND SPEAKERS FOR USE WITH CELLULAR TELEPHONES, FM RADIO TRANSMITTERS FOR USE

WITH CELLULAR TELEPHONES, USB CABLES, PLASTIC COVERS FOR CELLULAR TELEPHONES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 5-31-1996; IN COMMERCE 5-31-1996.

FOR: WATCHES, IN CLASS 14 (U.S. CLS. 2, 27, 28 AND 50).

FIRST USE 12-31-2005; IN COMMERCE 12-31-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 770,275, 1,258,436 AND OTHERS.

SER. NO. 77-030,850, FILED 10-27-2006.

RAUL CORDOVA, EXAMINING ATTORNEY

United States Patent Office

770,275
Registered May 26, 1964

PRINCIPAL REGISTER Trademark

Ser. No. 171,393, filed June 19, 1963

SONY

Sony Corporation (Japanese corporation)
351 Kitashinagawa-6
Shinagawa-ku, Tokyo, Japan

For: TELEVISION CAMERAS, in CLASS 21.
First use Mar. 30, 1961; in commerce Mar. 30, 1961.
Owner of Reg. Nos. 691,940, 692,023 and 705,902.

United States Patent Office

777,400
Registered Sept. 22, 1964

PRINCIPAL REGISTER Trademark

Ser. No. 171,579, filed June 21, 1963

SONY

Sony Corporation (Japanese corporation)
351 Kitashinagawa-6
Shinagawa-ku, Tokyo, Japan

For: LIGHTING APPARATUS, in CLASS 34.
First use Mar. 23, 1963; in commerce Mar. 23, 1963.
Owner of U.S. Reg. Nos. 691,940, 692,023 and 705,902.

United States Patent Office

785,967
Registered Mar. 2, 1965

PRINCIPAL REGISTER Trademark

Ser. No. 171,578, filed June 21, 1963

SONY

Sony Corporation (Japanese corporation)
351 Kitashinagawa-6
Shinagawa-ku, Tokyo, Japan

For: ANALYSIS APPARATUS AND EQUIPMENT—NAMELY, AUTOMATIC ANALOG CORRELATORS, AUTOMATIC TRANSIENT WAVEFORM RECORDERS AND DATA RECORDERS, CORRELATORS AND METERS—in CLASS 26.

First use Jan. 27, 1962; in commerce Jan. 27, 1962.
Owner of U.S. Reg. Nos. 691,940, 692,023, and 705,902.

United States Patent Office

801,885

Registered Jan. 11, 1966

PRINCIPAL REGISTER Trademark

Ser. No. 204,017, filed Oct. 14, 1964

SONY

Sony Corporation (Japanese corporation)
351 Kitashinagawa-6
Shinagawa-ku, Tokyo, Japan

For: ELECTRICAL SOUND RECORDING AP-
PARATUS, INCLUDING ELECTRIC RECORD PLAY-
ERS, ELECTRICALLY DRIVEN RECORD
CHANGERS, AND AUTOMATIC PHONOGRAPH
RECORD CHANGERS, in CLASS 36.

First use on about May 30, 1964; in commerce on about
June 10, 1964.

Owner of U.S. Reg. Nos. 691,940, 770,275, and others.

B. C. WASHINGTON, *Examiner.*

Int. Cl.: 18

Prior U.S. Cl.: 3

United States Patent and Trademark Office
10 Year Renewal

Reg. No. 886,119
Registered Feb. 17, 1970
Renewal Approved Nov. 21, 1989

**TRADEMARK
PRINCIPAL REGISTER**

SONY

SONY CORPORATION (JAPAN CORPORATION)
6-7-35 KITASHINAGAWA
SHINAGAWA-KU, TOKYO, JAPAN 141

OWNER OF U.S. REG. NOS. 705,902,
801,885 AND OTHERS.

FOR: TRAVELING BAGS, UTILITY BAGS (DRAWSTRING TYPE) AND WALLETS, IN CLASS 3 (INT. CL. 18).
FIRST USE 7-20-1967; IN COMMERCE 7-20-1967.

SER. NO. 72-304,827, FILED 8-9-1968.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Jan. 2, 1990.*

COMMISSIONER OF PATENTS AND TRADEMARKS

United States Patent Office

886,119
Registered Feb. 17, 1970

PRINCIPAL REGISTER Trademark

Ser. No. 304,827, filed Aug. 9, 1968

SONY

Sony Corporation (Japanese corporation)
7-35 Kitashinagawa 6-chome
Shinagawa-ku, Tokyo, Japan

For: TRAVELING BAGS, UTILITY BAGS (DRAW-
STRING TYPE) AND WALLETS, in CLASS 3 (INT.
CL. 18).

First use July 20, 1967; in commerce July 20, 1967.
Owner of Reg. Nos. 705,902, 801,885, and others.