

ESTTA Tracking number: **ESTTA682524**

Filing date: **07/08/2015**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Spansion LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	198 Champion Court San Jose, CA 95134-1709 UNITED STATES		

Attorney information	Belinda J. Scrimenti Pattishall, McAuliffe, Newbury, Hilliard & Geraldson LLP 200 South Wacker Drive, Suite 2900 Chicago, IL 60606 UNITED STATES bscrimenti@pattishall.com, and@pattishall.com, pab@pattishall.com, kep@pattishall.com, sm@pattishall.com Phone:312-554-8000
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Registration Subject to Cancellation

Registration No	4721431	Registration date	04/14/2015
Registrant	Kingston Technology Corporation 17600 Newhope Street Fountain Valley, CA 92708 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2014/06/02 First Use In Commerce: 2014/09/12 All goods and services in the class are cancelled, namely: Computer accessories, namely, mouse pads for use with electronic and online gaming

Grounds for Cancellation

The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	Restriction of registration pursuant to 15 USC Section 1068 to require a disclaimer of "HYPERX"

Related Proceedings	Kingston Technology Corporation v. Spansion LLC, (claims and counterclaims), Opposition No. 91218100; and new Opposition, filed simultaneously herewith, ESTTA receipt no. ESTTA682513, opposing 86/462,159 HYPERX and 86/418,063 HYPERX BLITZ
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Attachments	Spansion LLC v. Kingston Technology Corporation Petition for Cancellation R re 4721431.pdf(27238 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	/Belinda J. Scrimenti/
Name	Belinda J. Scrimenti
Date	07/08/2015

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

US Trademark Registration No. 4,721,431 for HYPERX SKYN
Registered: November 22, 2014

Spansion LLC,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. _____
)	
Kingston Technology Corporation)	
)	
Registrant)	
_____)	

PETITION FOR PARTIAL CANCELLATION/LIMITATION

Petitioner, Spansion LLC, a Delaware limited liability company located and doing business at 198 Champion Court, San Jose, CA 95134-1709 (formerly located at 915 DeGuigne Drive, Sunnyvale, California 94085) (“Spansion”), believes it is damaged and will continue to be damaged by Registration No. 4,721,431 for the mark HYPERX SKYN owned by Registrant, Kingston Technology Corporation (“Kingston”), and hereby petitions to cancel and/or seeks to modify such registration as set forth herein.

The grounds for the petition are as follows:

1. Spansion is one of the leading manufacturers of computer memory products and embedded systems solutions, including a broad portfolio of flash memory, microcontrollers, mixed-signal and analog products, and system-on-chip solutions. Such products have a wide variety of applications, including in connection with consumer electronics, industrial and automotive applications.

2. Spansion has applied to register the mark HYPERRAM in connection with “volatile memory devices, namely, random-access memory semiconductor chips; applications and utility software for functions associated with random-access volatile memory devices, namely, code and data management software and random-access memory semiconductor chip drivers,” (App. Serial No. 86/189,104).

3. Spansion's HYPERRAM application was published on July 1, 2014.

4. On August 28, 2014, Kingston filed its initial Notice of Opposition against Spansion's HYPERRAM application. *See* Opposition No. 91218100. Kingston filed an Amended Notice of Opposition on September 23, 2014. (A copy of which is attached as Exhibit A).

5. In its Amended Notice of Opposition, Kingston alleges that Spansion's HYPERRAM mark is merely descriptive or generic. In support of this claim, Kingston alleges that the prefix “hyper” means “above” or “more than,” is used with “technical concepts and products” “to convey a more advanced or automatic quality,” and is a “laudatory term” in the “electronics and computer industry.” Kingston alleges that the prefix “hyper” is merely descriptive of electronic and computer goods. *See* Exhibit A, Kingston's Amended Notice of Opposition, at ¶¶ 8 and 12.

6. Based on Kingston's own arguments as to the descriptive nature of the term "HYPER," in its Answer, Spansion counterclaimed seeking cancellation or limitation as to several of the HYPERX registrations asserted by Kingston in that proceeding. *See* Opposition No. 91218100, Spansion's Answer and Counterclaims to Amended Notice of Opposition, filed February 12, 2015. (A copy of which is attached hereto as Exhibit B).

7. Notwithstanding its statements in its Amended Notice of Opposition asserting the descriptive nature of the term “HYPER,” Kingston has embarked upon a pattern of seeking to register a family of “HYPERX” marks for a variety of electronic and computer goods. Included in this pattern is Kingston's recent registration of the mark HYPERX SKYN for "Computer accessories, namely, mouse pads for use with electronic and online gaming," in Class 9 (Reg. No. 4,721,431).

8. By virtue of its own allegations and logic, Kingston has conceded that the “HYPER” prefix in Kingston's HYPERX SKYN mark is used to convey the descriptive connotation that its electronic and computer products are better or “more advanced” than others and that the “HYPER” element is merely laudatory.

9. In addition, the character "X" in Kingston's registration is non-distinctive, as either highly descriptive and/or generic. As used by Kingston, the “X” element is a term that also describes goods that feature an “extra” quality and/or some other descriptive or generic feature, such as reflecting the roman numeral character for “10” to identify a 10th version of the product.

10. The parties' assertions, claims, and counterclaims in Opposition No. 91218100 are directly related to the claims in the instant cancellation proceeding. Spansion is damaged by Kingston's attempts to develop a family of “HYPERX” marks in the electronics and computer industries, while simultaneously taking inconsistent positions as to the descriptiveness of the “HYPER” element in the marks at issue in pending Opposition No. 912818100 and the “HYPERX” element of the registration which is the subject of the instant proceeding.

**Count I: Request for Disclaimer of "HYPERX" in Reg. No. 4,721,431
on the Ground that "HYPERX" is Merely Descriptive**

11. Spansion repeats and re-alleges the allegations of Paragraph 1 through 10 as though fully set forth herein.

12. Kingston claims in its Amended Notice of Opposition against Spansion's HYPERRAM mark that the term "HYPER" is laudatory and descriptive of electronics and computer products. By its logic and allegations, Kingston has conceded that the "HYPER" element of its HYPERX SKYN mark is merely laudatory and descriptive of the electronics and computer products set forth in Reg. No. 4,721,431. Further, the letter "X" element of the mark is non-distinctive, as either highly descriptive and/or generic.

13. As set forth in its Answer and Counterclaims to the Amended Notice of Opposition in Opposition No. 91218100, Spansion denies that the prefix "hyper" is a merely descriptive term as applied to electronic and computer goods or that its mark HYPERRAM is descriptive. However, to the extent that the Trademark Trial and Appeal Board holds in Opposition No. 91218100 that the term "HYPER" is a merely descriptive term for electronic and computer goods, that Spansion's HYPERRAM mark is descriptive or generic, or that, when the term HYPER is combined with another highly descriptive or generic term, the resulting composite mark must be found descriptive or generic, then Kingston's use of the prefix "HYPER" in conjunction with the character "X" for electronic and computer-related goods in the "HYPERX" portion of its HYPERX SKYN mark must likewise be held to be a merely descriptive element of the mark which should be disclaimed, as it simply constitutes a combination of the same prefix "HYPER" and the highly descriptive or generic term "X."

WHEREFORE, Spansion respectfully requests that, if Opposition No. 91218100 is sustained on the basis of descriptiveness or genericness, Kingston's Registration No. 4,721,431 likewise be restricted and modified to include a disclaimer of the term "HYPERX" on the basis of descriptiveness, pursuant to Section 18 of the Lanham Act, 15 U.S.C. § 1068.

Respectfully submitted,

PATTISHALL, McAULIFFE, NEWBURY,
HILLIARD & GERALDSON LLP

Date: July 8, 2015

By: /Belinda J. Scrimenti/

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Attorneys for Applicant, Spansion LLC

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition has been served upon
the attorney of record for Registrant and Registrant, directly:

Christine Yang
Law Offices Of S.J. Christine Yang
17220 Newhope St. Ste 101-102
Fountain Valley, California 92708-4272

Kingston Technology Corporation
17600 Newhope Street
Fountain Valley, CA 92708

by United States mail, postage prepaid, this 8th day of July 2015.

/Belinda J. Scrimenti/
Belinda J. Scrimenti