

ESTTA Tracking number: **ESTTA683254**

Filing date: **07/13/2015**

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

Proceeding	92061796
Party	Plaintiff Spansion LLC
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Submission	Other Motions/Papers
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Signature	/Belinda J. Scrimenti/
Date	07/13/2015
Attachments	Exhibits A and B to Cancellation Petition.pdf(210935 bytes)

**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,)	
)	
Opposer,)	
)	
v.)	Cancellation No.
)	
Kingston Technology Corporation)	
)	
Applicant,)	
_____)	

EXHIBITS TO
PETITION FOR PARTIAL CANCELLATION/LIMITATION

Accompanying here are Exhibits A and B to the Petition For Partial
Cancellation/Limitation which were inadvertently not attached to the PDF of the original Petition
For Partial Cancellation/Limitation.

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 Exhibits to Petition For Partial Cancellation/Limitation 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

Exhibit A

ESTTA Tracking number: **ESTTA628686**

Filing date: **09/23/2014**

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

Proceeding	91218100
Party	Plaintiff Kingston Technology Corporation
Correspondence Address	John D. McConaghy Novak Druce Connolly Bove + Quigg LLP North Tower Suite 2300333 South Grand Avenue Los Angeles, CA 90071-1504 UNITED STATES jmconaghy@novakdruce.com, trademarks@novakdruce.com, cy-ang@sjclawpc.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	John D. McConaghy
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Signature	/John D. McConaghy/
Date	09/23/2014
Attachments	Kingston4amdopp.pdf(170294 bytes)

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

KINGSTON TECHNOLOGY CORPORATION, A California corporation,)	Opposition No. 91218100
)	
Opposer.)	
vs.)	
)	
SPANSION LLC, A Limited Liability Company,)	
)	
Applicant.)	

AMENDED NOTICE OF OPPOSITION

In the matter of an application to register a trademark, Serial No. 86/189,104, filed February 10, 2014, for the mark HYPERRAM, in the name of Spansion LLC (hereinafter "Applicant"), published for opposition in the Trademark Official Gazette of July 1, 2014 at page TM 568, Opposer, Kingston Technology Corporation, believes it will be damaged by issuance of the applied for registration of the mark HYPERRAM, and hereby opposes same. The Applicant having not yet answered, Opposer presents this Amended Notice of Opposition without leave of the Trademark Trial and Appeal Board.

The grounds for opposition are as follows:

COUNT I – MERELY DESCRIPTIVE

1. Opposer, Kingston Technology Corporation, is a corporation duly organized and existing under the laws of the State of California and has a place of business at 17600 Newhope Street, Fountain Valley, California 92708. Opposer markets, distributes and sells memory devices including random access memory (RAM), memory modules, solid state drives for data storage devices and flash drives.

2. Commencing prior to the filing date of the opposed application, Opposer has, and is now, engaged in the distribution and sale in commerce in the United States of the products listed under and in connection with the U.S. registered trademarks HYPERX and HYPERX BEAST (collectively, Opposer's "HYPERX marks"). Opposer continually has used the HYPERX marks in commerce in connection with Opposer's products produced, advertised, offered for sale and sold by Opposer to identify, designate and distinguish these products from the products of others.

3. Opposer is the owner of the following U.S. Trademark Registrations for its HYPERX marks:

<u>U.S. Reg. No.</u>	<u>Issue Date</u>
Reg. No. 2,848,874	June 1, 2004
Reg. No. 4,162,334	June 19, 2012
Reg. No. 4,316,905	April 9, 2013
Reg. No. 4,452,249	December 17, 2013

Said registrations are valid, subsisting and constitute *prima facie* and/or conclusive evidence of Opposer's ownership and exclusive right to use the HYPERX marks in commerce in connection with the goods set forth in these Registrations.

4. Since Opposer's initial use of the HYPERX marks, Opposer has used, advertised, produced, offered and sold in commerce its goods under and in connection with the HYPERX marks to the public directly by way of the internet, through Internet retailers, distributors and brick and mortar retail outlets with the result that Opposer's customers and the public in general have come to know and recognize and associate the HYPERX marks with Opposer and/or with the goods produced, advertised, marketed, distributed and sold directly or indirectly by Opposer. Opposer has thus built up goodwill in connection with the sale of its products under Opposer's HYPERX marks.

5. On February 10, 2014, Applicant filed the opposed Application to register the mark HYPERRAM. The opposed Application was accorded Serial No. 86/189,104, and was published for opposition in the Official Gazette on July 1, 2014 at page TM 568 for the following goods in International Class 009:

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 drives.

6. The HYPERRAM mark sought to be registered by Applicant is descriptive of memory devices and Opposer and has an equal right to use the term descriptively.

7. The term HYPERRAM, whether one word or two, is used in the electronics and computer industry to describe random-access memories which are active or of significant capabilities.

8. The Applicant is not exclusive in the use of "hyper" with "ram" to describe random access memory. The term "hyper" is a Greek work meaning "above" or "more than." It is used as a prefix to technical concepts and products to convey a more advanced or more automatic capability. Further, "hyper" is a highly used laudatory term or prefix in the electronics and computer industry and is the subject of many U.S. Trademark Registrations in conjunction with other terms and designs in International Class 009.

COUNT II – MERELY GENERIC

9. Opposer restates and realleges Paragraphs 1 through 5, inclusive, above, of this Notice of Opposition, and hereby incorporates same as if fully set forth herein.

10. The HYPERRAM mark sought to be registered by Applicant is generic of memory devices and Opposer, Kingston, has an equal right to use the term generically.

11. The term HYPERRAM, whether one word or two, is used in the electronics and computer industry to mean and identify random-access memories which are active or of significant capabilities.

12. The Applicant is not exclusive in the use of "hyper" with "ram" to describe random access memory. The term "hyper" is a Greek work meaning "above" or "more than." It is used as a prefix to technical concepts and products to

convey a more advanced or more automatic capability. Further, "hyper" is a highly used laudatory term or prefix in the electronics and computer industry and is the subject of many U.S. Trademark Registrations in conjunction with other terms and designs in International Class 009.

WHEREFORE, Opposer Kingston believes and alleges that it will be damaged by registration of the HYPERRAM mark of Application Serial No. 86/189,104, as aforesaid, and prays that:

- A. Judgment in the present opposition be entered in favor of Opposer on Counts I and II;
- B. The present Opposition is sustained; and
- C. Registration of Application Serial No. 86/189,104 be rejected and refused.

Respectfully submitted,

KINGSTON TECHNOLOGY CORPORATION

Date: September 23, 2014

By /John D. McConaghy/ (Electronic signature)

John D. McConaghy
Breton Bocchieri
Christine Yang

Attorneys for Opposer

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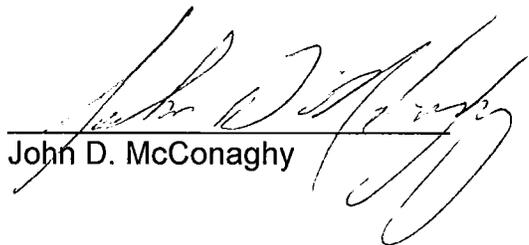
Law Offices of S.J. Christine Yang
17220 Newhope Street, Suite 101-102
Fountain Valley, CA. 92708

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this paper is being served upon all parties to this proceeding at the address recorded in the following manner on the date this filing is submitted, SEPTEMBER 23, 2014.

By Mail to:

Belinda J. Scrimenti
Pattishall, McAuliffe, Newbury, Hilliard & Geraldts
200 S Wacker Dr Ste 2900
Chicago, Illinois 60606-5896



John D. McConaghy

Exhibit B

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

US Trademark Application Serial No. 86/189,104 for HYPERRAM
Filed: February 10, 2014
Published: July 1, 2014

Kingston Technology Corporation,)	
)	
Opposer)	
)	
v.)	Opposition No. 91218100
)	
Spanion LLC)	
)	
Applicant)	
_____)	

ANSWER AND COUNTERCLAIMS TO AMENDED NOTICE OF OPPOSITION

ANSWER

Applicant, Spanion LLC ("Spanion"), hereby answers the Amended Notice of Opposition as follows in response to each numbered Paragraph thereof:

1. Applicant admits that online records of the California Secretary of State indicate that Opposer Kingston Technology Corporation is a California corporation with a place of business at 17600 Newhope Street, Fountain Valley, California 92708, but Applicant lacks knowledge or information sufficient to form a belief as to the truth of such allegations, and therefore denies them. Applicant further lacks Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 1 and therefore denies them.

2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2 and therefore denies them.

3. Applicant admits that United States Patent and Trademark Office records indicate that Opposer owns the registrations alleged in Paragraph 3, with the listed registration dates. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 3 and therefore denies them. Applicant further avers that ownership of such registrations, even assuming, *arguendo*, their validity, does not confer upon Opposer exclusive rights to use of a mark with a prefix of the element HYPER for the identical or related goods.

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 and therefore denies them.

5. Applicant admits the allegations of Paragraph 5.

6. Applicant denies the allegations of Paragraph 6.

7. Applicant denies the allegations of Paragraph 7.

8. Applicant denies that it "is not exclusive in the use of 'hyper' with 'ram' to describe random access memory." Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 8 and therefore denies them. Applicant further avers that the existence of numerous other registrations on the United States Trademark Office Principal Register in Class 9 beginning with a prefix of "hyper" and including a second element of a generic, descriptive, or disclaimed term, including marks for goods highly related to those of Opposer and/or Applicant, reflects the Office's longstanding and accepted principle that such marks commonly are found not to be descriptive or generic.

9. Applicant restates its answers and averments to Paragraphs 1 through 5, as if fully set forth herein and incorporates them by reference in response to the allegations of Paragraph 9.

10. Applicant denies the allegations of Paragraph 10.

11. Applicant denies the allegations of Paragraph 11.

12. Applicant denies that it "is not exclusive in the use of 'hyper' with 'ram' to describe random access memory." Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 12 and therefore denies them. Applicant further avers that the existence of numerous other registrations on the United States Trademark Office Principal Register in Class 9 beginning with a prefix of "hyper" and including a second element of a generic, descriptive, or disclaimed term, including marks for goods highly related to those of Opposer and/or Applicant, reflects the Office's longstanding and accepted principle that such marks commonly are found not to be descriptive or generic.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

Opposer has failed to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Opposer's HYPERX mark consists merely of the term "hyper" with the non-distinctive or generic letter "x". Opposer has nonetheless asserted exclusive rights in the term HYPERX, as evidenced by its U.S. Trademark Registration Nos. 2,848,874; 4,162,334; 4,316,905. These registrations, none of which are based on acquired distinctiveness, constitute an assertion that the term "hyper" is not merely descriptive in the relevant industry identified by Opposer as "the electronics and computer industry." Opposer's claims are thus barred, in whole or in part, by the doctrine of estoppel.

THIRD AFFIRMATIVE DEFENSE

The existence of numerous other registrations on the United States Trademark Office Principal Register in Class 9 beginning with a prefix of “hyper” and including a second element of a generic, descriptive, or disclaimed term, including marks for goods highly related to those of Opposer and/or Applicant, reflects the Trademark Office’s and Board’s longstanding and accepted principle that composite marks incorporating such a combination of elements commonly are found to be not descriptive and not generic. Under the “reasoned decisionmaking doctrine,” no rational basis exists to justify the Board’s veering significantly from this vast prior precedent. Opposer has not alleged in its Amended Notice of Opposition, nor can it allege, any such rational basis for a diversion from such long-standing and voluminous precedent. Thus, Opposer’s claim fails under controlling law, and Applicant’s mark should be found not descriptive and not generic.

COUNTERCLAIMS

Spansion, a Delaware limited liability company located and doing business at 915 DeGuigne Drive, Sunnyvale, California 94085 (“Spansion”), believes it is damaged and will continue to be damaged by Registration Nos. 4,162,334 and 4,316,905 for the mark HYPERX and Registration No. 4,452,249 for the mark HYPERX BEAST owned by Opposer Kingston Technology Corporation, and hereby petitions to cancel or modify such marks as set forth herein. As grounds for its petition, Spansion alleges as follows:

**FIRST COUNTERCLAIM FOR CANCELLATION OF
REGISTRATION NOS. 4,162,334 AND 4,316,905 FOR THE MARK HYPERX**

1. Spansion applied to register the trademark HYPERRAM for "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." Application Serial No. 86/189,104.

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

3. Opposer filed its first Notice of Opposition on August 28, 2014.

4. Opposer initially alleged as grounds for opposition in Count I "likelihood of confusion," in addition to descriptiveness and genericness.

5. Opposer subsequently amended its Notice of Opposition to withdraw its claim of likelihood of confusion when filing the Amended Notice of Opposition.

6. Opposer's Amended Notice of Opposition alleges in Paragraphs 8 and 12 that the prefix "hyper" is used "to convey a more advanced or automatic quality" and that it is a "highly laudatory term." Thus, Opposer alleges that the prefix "hyper" is merely descriptive of electronic and computer goods.

7. Notwithstanding its statements in its Notice, Opposer owns Trademark Registration No. 4,162,334 for the mark HYPERX for "solid state drives for data storage devices" in Class 9.

8. Additionally, Opposer owns Trademark Registration No. 4,316,905 for the mark HYPERX for "blank USB flash drives" in Class 9.

9. The character "x" in Opposer's registrations is non-distinctive and/or generic. As used by Opposer, the "x" element is a term that descriptively implies goods that feature an

“extra” quality and/or implies some other descriptive or generic feature, such as reflecting the roman numeral character for “10” to identify a 10th version of the product.

10. As set forth in its Answer, 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 finds otherwise, Opposer's use of the prefix "hyper" in conjunction with the non-distinctive character "x" for electronic and computer goods in the mark HYPERX is likewise merely descriptive, 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 Opposer's opposition is sustained on the basis of descriptiveness or genericness, that Opposer's Registration Nos. 4,162,334 and 4,316,905 likewise be cancelled under Section 18 of the Lanham Act, 15 U.S.C. §1068, on the basis of descriptiveness.

**SECOND COUNTERCLAIM FOR RESTRICTION OF
REGISTRATION NO. 4,452,249 FOR THE MARK HYPERX BEAST**

11. Spansion restates and realleges its allegations in Paragraphs 1 through 10 of its Counterclaims, as if fully set forth herein and incorporates them by reference herein.

12. Opposer owns Trademark Registration No. 4,452,249 for the mark HYPERX BEAST for "dynamic random access memory (DRAM)" in Class 9.

13. Registration No. 4,452,249 should be restricted and modified to include a disclaimer of the term “hyperx” under Section 18 of the Lanham Act, 15 U.S.C. §1068, thus reflecting only the distinctive element of “beast” as non-descriptive.

WHEREFORE, Spansion respectfully requests that, if Opposer's opposition is sustained on the basis of descriptiveness or genericness, that Opposer's Registration No. 4,452,249 likewise be restricted to include a disclaimer of the term "hyperx" on the basis of descriptiveness.

Respectfully submitted,

PATTISHALL, McAULIFFE, NEWBURY,
HILLIARD & GERALDSON LLP

Date: February 12, 2015

By: /Belinda J. Scrimenti/

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Attorneys for Applicant, Spansion LLC

CERTIFICATE OF SERVICE

I, Andrew R.W. Hughes, hereby certify that a true and accurate copy of the foregoing Answer and Counterclaims to Amended Notice of Opposition was by first class mail, postage prepaid, with a courtesy copy by email, this 12th day of February 2015, on the following counsel for Opposer:

John D. McConaghy
Novak Druce Connolly Bove + Quigg LLP
North Tower Suite 2300
333 South Grand Avenue
Los Angeles, CA 90071-1504

By: /Belinda J. Scrimenti/
Belinda J. Scrimenti