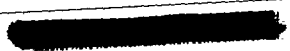


TTAB

Attorney Ref. No. 10246/01

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



Amplifier Technologies, Inc.)
)
 Opposer,)
)
 v.)
)
 Audio Technologies)
 Incorporated,)
)
 Applicant.)
)

12-20-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #77

Opposition No. 91152554
Serial No.: 75/264,785

Mark: ATI AND DESIGN
Goods: Professional audio products

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**OPPOSER'S SURREPLY BRIEF IN OPPOSITION TO
APPLICANT'S MOTION TO DISMISS**

Applicant's Reply Brief mischaracterizes Opposer's reliance on 35 U.S.C. § 1068 (Section 18 of the Trademark Act). Opposer files this Surreply Brief to address this issue raised in Applicant's Reply Brief.

Opposer's Statutory Basis Is Likelihood of Confusion, Not Section 18

Applicant's Brief in support of Applicant's Motion to Dismiss argued that the Notice of Opposition fails to state a claim upon which relief can be granted because the Notice of Opposition does not plead or allege likelihood of confusion. Applicant also argued in its Reply Brief that Section 18 does not provide a statutory basis for this opposition.

Opposer's brief ("Opposer's Response Brief") in opposition to the Motion to Dismiss raised Section 18 as the *basis* for the *relief* sought in the Notice of Opposition, i.e., that registration to Applicant be refused, or in the alternative, that Applicant be required to limit the description of goods in its application. Opposer is not relying on Section 18 as the statutory

basis of this opposition, but rather has alleged and argued a likelihood of confusion as part and parcel of the relief requested by Opposer.

The Notice of Opposition alleges in paragraphs 9 and 10 that the Examining Attorney for Opposer's pending application, Serial No. 75/726,424, for Opposer's ATI AMPLIFIER TECHNOLOGIES mark, refused registration based on a perceived likelihood of confusion with Applicant's ATI AND DESIGN trademark application, Serial No. 75/264,785, if Applicant's application receives registration, on the basis of a likelihood of confusion. In addition, the Notice of Opposition in paragraphs 2 and 6 alleges that "opposer has had substantially exclusive and continuous use [of] its ATI AMPLIFIER TECHNOLOGIES mark in United States Commerce since at least as early as 1995 in connection with audio and video system components for consumer audiophile and home theater use" and that the "consumer electronics industry associates the ATI AMPLIFIER TECHNOLOGIES mark with Opposer."

Although the Notice of Opposition states Opposer's belief that confusion is not likely, (a) it should be evident that a basis for this belief is the different channels of trade and different target markets (professional vs. consumer audiophile and home theater use) (see Notice of Opposition, paragraph 10), and (b) the Trademark Office is on record as disagreeing with Opposer's belief, as pleaded in the Notice of Opposition. The Section 18 relief requested in the Notice of Opposition (that Applicant be required to limit the description of goods in its application) is predicated on the likelihood of confusion finding of the Examining Attorney in Opposer's pending application (75/726,424), which is clearly pleaded in the Notice of Opposition.¹

Thus, a likelihood of confusion is in fact alleged in the Notice of Opposition². If there is any doubt on this issue, it should be resolved in favor of Opposer when deciding Applicant's Motion to Dismiss since the notice of opposition, taken as a whole, must be liberally construed in

¹ The Applicant now also appears to believe that there is a likelihood of confusion. Although Applicant previously has stated that "there should be no confusion in commerce and trademarks" in a letter to Opposer, Applicant's attorney now maintains that there has been no admission by Applicant that there is no confusion. (Applicant's Reply Brief, note 1.)

² Applicant alleges that any likelihood of confusion issue would be resolved in its favor because it has priority of use. However, that is an issue to be decided during the course of the opposition in view of Opposer's allegation in paragraph 2 of the Notice of opposition that "Opposer has had substantially exclusive and continuous use" of its mark in its channels of trade. As pointed out in Opposer's Response Brief, perhaps the issues being argued in this Notice of Opposition are more appropriately raised in a motion for summary judgment at the proper time.

the light most favorable to the opposer. See, e.g., . *Universal City Studios Inc. v. Cleveland Museum of Natural History*, 39 U.S.P.Q.2d 1382 (T.T.A.B. 1996), citing *Scotch Whisky Assoc. v. United States Distilled Products Co.*, 952 F.2d 1317, 21 U.S.P.Q.2d 1145 (Fed. Cir. 1991).

Section 18 And Eurostar

This opposition parallels and is analogous to the proceeding in *Eurostar, Inc. v. Euro-Star Restmoden GmbH & Co.*, 34 USPQ2d 1266, 1268 (TTAB1994). *Eurostar* involved a cancellation; this is an opposition. In *Eurostar*, the petitioner sought partial cancellation under Section 18 to restrict the description of goods of the concerned registration to conform to channels of trade. Here, Opposer seeks to restrict the goods of a pending application of Applicant to conform to channels of trade (Applicant's professional market). In *Eurostar*, the petitioner alleged that the respondent had abandoned use in certain channels of trade. Here, Opposer alleges it has priority in certain channels of trade (consumer audiophile and home theater).³ In *Eurostar* four of petitioner's applications to register were refused based on a registration, and in this case, an application of Opposer is suspended based on a likelihood of confusion with Applicant's published application.

Applicant's Reply Brief raised two Section 18 issues over and above the likelihood of confusion issue. Both issues were treated in *Eurostar*. One issue is whether the Board has the authority to grant Section 18 relief in this case. In *Eurostar*, the Board concluded that it had the authority to order restriction "if doing so will avoid a likelihood of confusion." An issue of likelihood of confusion has been pleaded as discussed above regarding possible use by Applicant of its trademark in Opposer's consumer audiophile and home markets, in which channels of trade Opposer has priority.⁴

The other Section 18 point raised by Applicant is that the relief sought by Opposer, (i.e., restricting Applicant's goods) will not result in a likelihood of confusion. If a registration is granted to Applicant that is not restricted as requested by Opposer, then it is likely that Applicant will conclude that it has the right to use it's now registered trademark in Opposer's consumer

³ Paragraph 2 of the Notice of Opposition alleges that Opposer has had substantially exclusive and continuous use of its mark in the consumer audiophile and home theater markets.

⁴ Although the Board in *Eurostar* found that petitioner's pleadings were deficient on the likelihood of confusion issue, the Board allowed petitioner to file an amended pleading, stating that it would permit the restriction of goods that petitioner seeks "if the petitioner alleges (and later proves) that a likelihood of confusion will be avoided if the registration is restricted in the manner sought by the petitioner." At worst, Opposer should be given that opportunity here.

audiophile and home theater channels of trade, in which Opposer has superior rights. If anything, that would increase the likelihood of confusion, while restricting Applicant's registration would have the opposite effect.

Section 18 Relief Was Requested in the Notice Of Opposition And Is Not Newly Raised

Applicant's reply Brief (page 7) argues that Opposer in its Response Brief has raised matters not properly of record. As discussed above, the Notice of Opposition expressly requested the restriction relief that Section 18 affords. Opposer's Response Brief simply discussed the applicability of *Eurostar*. Opposer points out that a notice of opposition must include "(1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark and (2) a short and plain statement of one or more grounds for opposition." 37 CFR 2.104(a). Briefs are the proper place to cite authority and present legal arguments.

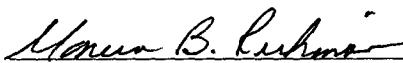
Conclusion

For the foregoing reasons, Opposer respectfully requests that Applicant's Motion to Dismiss be DENIED.

Respectfully submitted,

Amplifier Technologies, Inc., Opposer

Date: December 17, 2002 By:



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Attorney for Opposer

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

Amplifier Technologies, Inc.)
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Opposer,)
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v.)
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Audio Technologies)
Incorporated,)
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Applicant.)
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Opposition No. 91152554
Serial No.: 75/264,785

Mark: ATI AND DESIGN
Goods: Professional audio products

TRANSMITTAL

Dear Sir or Madam:

Enclosed is Opposer's Surreply to Applicant's Reply to Opposer's Answer to Applicant's Motion to Dismiss. Applicant kindly requests consideration of this Surreply by the Trademark Trial and Appeal Board.

Respectfully submitted,

Amplifier Technologies, Inc.

Date: December 17, 2002

By:



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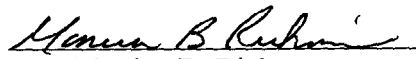
Attorney for Opposer

Certificate of Service

The undersigned hereby certifies that a copy of the foregoing Opposer's Surreply Brief in Opposition to Applicant's Motion to Dismiss in connection with Opposition No. 91152554 has been served upon the attorney for Applicant on December 17, 2002, by depositing same in the United States Mail, first class postage prepaid, in an envelope addressed as follows:

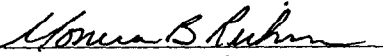
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PHILADELPHIA PA 19103-7396

Dated: December 17, 2002


Monica B. Richman

Certificate of First Class Mailing

I hereby certify that this Opposer's Surreply Brief in Opposition to Applicant's Motion to Dismiss in connection with Opposition # 91152554 is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Box: TTAB No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive Arlington, Virginia 22202-3513 on December 17, 2002.

By: 
Monica B. Richman