

Exhibits

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

In the matter of
Trademark Application Serial No. 78/166,862
Filed: September 23, 2002
Published: May 13, 2003
Mark: FOLLOW THE SUN


09-10-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #78

SUN MICROSYSTEMS, INC.,)
)
Opposer,)
)
)
vs.)
)
TECHNICAL ADVISORY SERVICES, LLC)
)
Applicant.)

Opposition No. _____

BOX TTAB FEE
COMMISSIONER FOR TRADEMARKS
2900 CRYSTAL DRIVE
ARLINGTON, VIRGINIA 22202-3513

NOTICE OF OPPOSITION

Sun Microsystems, Inc. ("Opposer" or "Sun"), a Delaware corporation having a principal place of business at 4150 Network Circle, Santa Clara, California 95054, believes it will be damaged by registration of the mark shown in Application Serial No. 78/166,862, and hereby opposes that application, alleging as grounds for its opposition that:

09/17/2003 JBROOKS1 00000026 78166862
01 FC:6402 300.00 OP

Express Mail mailing label No. EV 345460190 US
Date of Deposit 9-10-03
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Dr., Arlington, VA 22202-3513.
Nanette Barranti
(Typed or printed name of person mailing paper or fee)
Nanette Barranti
(Signature of person mailing paper or fee)

1. As is evidenced by the publication of the FOLLOW THE SUN mark in the Official Gazette on page TM 562 of the May 13, 2003 issue, Technical Advisory Services, LLC ("Applicant"), seeks to register the mark FOLLOW THE SUN as a service mark in International Class 42 for "Development of new technology for others in the field of computer technology, production processing, business contingency and data center operations." Applicant's application for the FOLLOW THE SUN mark was filed on September 23, 2002, based solely on its intent to use the mark in commerce.

2. Opposer, commonly known as Sun, is a pioneer in the development of new technology in the field of computer technology, voice and data communications technology, and computer and communications networking technology.

3. Opposer is the owner of a number of SUN-based incontestable U.S. Trademark Registrations for various computer technology-related goods and services, including, but not limited to:

<u>Trademarks</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Class: Goods/Services</u>
SUNSPECTRUM	1,867,206	Dec. 13, 1994	37: Computer hardware and software installation, maintenance and repair services. 42: Computer related consulting services.
SUN SITE	1,938,422	Nov. 28, 1995	35: Providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information.

///

///

90/24/0001148

SUN

1,776,322

June 15, 1993

9: Computers, computer workstations composed of processors and memory, video displays, keyboard, mouse pointing device and computer operating systems software and computer software for use in the field of computer networking and graphics applications and computer hardware; namely, processors and memory, video displays, keyboard, mouse pointing device, and cables.

SUN (and design)

1,794,747

Sept. 28, 1993

9: Computers, computer workstations composed of processors and memory, video displays, keyboard, mouse pointing device and computer operating systems software and computer software for use in the field of computer networking and graphics applications and computer hardware; namely, processors and memory, video displays, keyboard, mouse pointing device and cables.

SUN MICROSYSTEMS

1,376,942

Jan. 7, 1986

9: Computers, computer programs recorded on magnetic tapes and discs, and computer memories excluding use of such goods in connection with the analysis and treatment of swimming pool water and the sale of swimming pool products and accessories.

//

//

001124710002171A9 SUN (stylized)	1,384,991	Mar. 4, 1986	9: Computer hardware – namely, processor and memory, video displays, keyboard, mouse pointing device, and cables; and computer software – namely, programs recorded on magnetic disks and tapes.
SUNLINK	1,513,411	Nov. 22, 1988	9: Computer programs for use in the field of computer networking.

Said trademarks were registered on the Principal Register prior to the date of filing of Applicant's ITU application. Copies of the Certificates of Registration for each of the above marks are attached hereto as Exhibits A, B, C, D E, F, and G respectively. Said registered marks of Opposer are valid and subsisting and are conclusive evidence of Opposer's exclusive right to use said marks in commerce on the goods and services specified in said registrations. In view of the similarity of the respective marks and the virtually identical nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's registered trademarks, as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public, and to dilute the distinctive quality of Opposer's marks, thereby causing loss, damage and injury to Opposer and the purchasing public.

4. Opposer is the owner of a number of SUN-based U.S. Trademark Registrations for computer technology-related services, including, but not limited to the following U.S. Trademark Registrations for computer technology-related services in Class 42:

- //
- //
- //

Trademarks

SUNSTART

Reg. No.

1,731,627

Reg. Date

Nov. 10, 1992

Class: Goods/Services

37: Computer hardware, software, and network installation services.

42: Computer consulting services and computer software and network design services.

SUN
MICROSYSTEMS
(and logo)

2,463,402

June 26, 2001

35: Retail services in the fields of computer hardware, computer software, computer peripherals, computer systems and computer networks.

42: Computer services, namely, providing consultation services and advice in the fields of computer hardware, computer software, computer peripherals, computer systems, computer networks, and computer security; leasing services in the fields of computer hardware, computer software, computer peripherals, computer systems and computer networks; installation, maintenance and repair of computer software.

MY SUN

2,653,106

Nov. 26, 2002

42: Providing customized online web pages featuring user-defined information

SUNTONE

2,672,493

Jan. 7, 2003

38: Computer network and global computer network access services.

42: Computer hardware consulting services; computer software consulting services; and integration of computer systems.

Said marks were either registered on the Principal Register or in use prior to the date of filing of Applicant's application. Copies of the Certificates of Registration for each of the above marks are attached hereto as Exhibits H, I, J and K respectively. Said registered marks of Opposer are valid and subsisting and are prima facie evidence of Opposer's exclusive right to use said marks in commerce on the goods and services specified in said registrations. In view of the similarity of the respective marks and the virtually identical nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's registered marks, as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public, and to dilute the distinctive quality of Opposer's marks, thereby causing loss, damage and injury to Opposer and the purchasing public.

5. Opposer is the owner of a number of SUN-based U.S. Trademark Registrations for various computer-technology related goods and services in other Classes, including, but not limited to:

<u>Trademarks</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Class: Goods/Services</u>
SUN MICROSYSTEMS (and logo)	2,368,045	July 18, 2000	9: Computer hardware, namely, computers, mainframe class computers; video displays, keyboards, monitors, servers, integrated circuits, disc drives, computer storage devices, interface boards, mouse pointing devices, mouse pads, peripherals, printed circuit boards containing electrical components and sockets, processors and memories; computer operating systems;

SUN
MICROSYSTEMS
(and logo)
SUN
MICROSYSTEMS
(continued)

SUN
MICROSYSTEMS
(and logo)

(continued)

computer programs for testing compatibility of computer programs; computer programs for use in computer networking; computer programs for use in computer emulation; computer programs for use in electronic mail; computer programs for creating graphical interfaces; computer programs for use in database management; computer programs for document processing; computer programs for use in computer security; computer programs for use in the development of computer programs, programming language, toolkits and compilers; computer programs for use in developing, compiling and executing other computer programs, on computers, computer networks and global computer networks; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs, on computers, computer networks and global computer networks; computer programs downloadable from global computer networks; and user manuals sold with the foregoing items.

//

//

0072410003111110

SUN STOREDGE	2,679,289	Jan. 28, 2003	9: Computer hardware, computer software for use in network computing in connection with data access, sharing, distribution, warehousing, management and protection; computer peripherals; and instruction manuals sold therewith.
SUN RAY	2,530,320	Jan. 15, 2002	9: Computer hardware; computer software, namely, computer software for use in connection with computer servers, computer networks, and global communications networks; computer peripherals; network computers; other electronic devices, namely, enterprise appliances, network appliances, appliances for use in connection with a global computer network, smart cards, and smart card readers; and instructional manuals in association with the foregoing goods.
SUN MICROSYSTEMS (and logo)	2,497,599	Oct. 16, 2001	37: Computer services, namely, installation, maintenance, and repair of computer hardware, computer peripherals, computer systems, and computer networks.
SUNTONE	2,663,626	Dec. 17, 2002	41: Information technology training services.

Said marks were either registered on the Principal Register or in use prior to the date of filing of Applicant's application. Copies of the Certificates of Registration for each of the above marks are attached hereto as Exhibits L, M, N, O and P respectively. Said registered marks of Opposer are valid and subsisting and are prima facie evidence of

Opposer's exclusive right to use said marks in commerce on the goods and services specified in said registrations. In view of the similarity of the respective marks and the virtually identical nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's registered marks, as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public, and to dilute the distinctive quality of Opposer's marks, thereby causing loss, damage and injury to Opposer and the purchasing public.

6. Opposer is the owner of a number of SUN-based U.S. Trademark Applications for various computer-technology related goods and services, including but not limited to:

<u>Trademark</u>	<u>Serial No.</u>	<u>App. Date</u>	<u>Class: Goods/Services</u>
SUNTONE CERTIFIED (and design)	75/888,972	Jan. 6, 2000	9: Computer hardware, e-commerce software for managing distributed transactions; e-commerce software for use in automating business processes; e-commerce software for personalized service automation; e-commerce software for value-chain integration; e-commerce software for facilitating trade; e-commerce software for use in facilitating and managing financial transactions; e-commerce software for creating customized on-line portals; software for use in connecting wireless devices to
//			
//			

SUNTONE
CERTIFIED (and
design)

(continued)

electronic networks for use in e-commerce; software for use in developing, deploying and managing on-line application services; software for use in developing content for Internet web sites for use in e-commerce; on-line billing software; on-line selling software; on-line procurement software; e-commerce software to allow users to perform electronic business transactions; e-commerce operations software, namely software for designing, maintaining, managing and conducting business on-line; commerce exchange software; e-commerce infrastructure software, namely software for designing, maintaining and managing business and information technology infrastructure; messaging software; software developer collaboration software; work group collaboration software; calendaring software; computer network security software; infrastructure software for Internet service providers, namely software for designing, maintaining, and managing business, information technology and network infrastructure; infrastructure software for telecommunications service providers, namely software for designing, maintaining, and managing business, information technology and network infrastructure; infrastructure software for e-commerce

SUNTONE
CERTIFIED (and
design)

(continued)

application service providers, namely software for designing, maintaining and managing business, information technology and network infrastructure; server software; utility software; software for use in developing and executing other software; audio and video streaming software; computer software for use in connecting, sending and receiving information over internal and global computer networks; computer application management software for managing computer application programs on electronic networks; software for use in customer resource management; software for use in sales force automation; database systems software; database management software; software for use in enterprise resource planning and management; supply chain management software; word processing software; document processing software; spreadsheet software; presentation graphics software and utility software for use therewith; organizer, calendaring, and scheduling software software for general business and personal use; project management and project scheduling software for general use; electronic mail software; software for the electronic transmission of data; software for use in accessing, using creating, and maintaining computer newsgroups; software for performing mathematical

SUNTONE
CERTIFIED (and
design)

(continued)

calculations; computer networking software; computer software for navigating, browsing and transferring information on computers, computer networks, and the Internet; computer software for distributing and viewing other computer software; computer operating system software; computer software for testing compatibility of computer software; computer software for computer emulation; computer software for creating graphical interfaces; computer peripherals; and instruction manuals in association therewith.

38: Computer network and global computer network access services; electronic messaging services, and wireless telecommunication services, namely, transmission of voice and data by electronic means.

41: Technology training services.

42: **Computer hardware consulting services; computer software consulting services;** and systems integration services.

SUNPLEX 76/176,908 Dec. 5, 2000

9: Computer hardware, computer software, computer peripherals, servers and instructional manuals in association therewith.

Applications for all of said marks were filed on the Principal Register prior to the date of filing of Applicant's application. Copies of the Notices of Allowance for these applications are attached hereto as Exhibits Q and R. Said applications of Opposer are

09/24/2007 11:59

valid and subsisting and are evidence of Opposer's intent to use said marks in commerce on the goods and services specified in said applications. In view of the similarity of the respective marks and the virtually identical nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's marks, as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public, and to dilute the distinctive quality of Opposer's marks, thereby causing loss, damage and injury to Opposer and the purchasing public.

7. Significantly prior to Applicant's filing of its application for the FOLLOW THE SUN mark, Opposer began offering computer technology-related services, and manufacturing and selling computer hardware, computer software, computer peripherals, and related electronic equipment and accessories under a number of SUN-based trademarks, service marks and trade names, including for example, but not limited to the following trademarks, service marks and trade names: SUN, SUN ONE, SUNNET, SUNPCi, and SUN ENTERPRISE. Said trademarks, service marks and trade names used by Opposer have been valid and continuous since the date of first use of each and have not been abandoned. Opposer's family of SUN-based trademarks, service marks and trade names are symbolic of extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion. In view of the similarity of the respective marks and the related nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's trademarks, service marks and trade names previously used in the United States, and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public, and to dilute the distinctive quality of Opposer's marks, thereby causing loss, damage and injury to Opposer and the purchasing public.

8. As a consequence of Opposer's extensive sales, advertising and marketing activity in interstate commerce, SUN, and the remainder of the above registered and unregistered trade names, trademarks and service marks ("SUN Family of Names and Marks") have come to be identified as a designation of Opposer's goods and services, including computer technology development services, other computer technology-related services, and computer hardware, computer software, computer peripherals, and related electronic equipment and accessories. The SUN Family of Names and Marks have become valuable assets of Opposer and principal symbols of its goodwill. In view of the similarity of the respective marks and related nature of goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's SUN mark and SUN Family of Names and Marks previously used in the United States, and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public.

9. As a consequence of Opposer's extensive sales, advertising and marketing activity in interstate commerce, SUN, and the remainder of the above registered and unregistered trade names, trademarks and service marks ("SUN Family of Names and Marks") have come to be identified as a designation of Opposer's goods and services, including computer technology development services, other computer technology-related services, and computer hardware, computer software, computer peripherals, and related electronic equipment and accessories. The SUN Family of Names and Marks have become valuable assets of Opposer and principal symbols of its goodwill. In addition, Opposer's SUN mark and SUN Family of Names and Marks have become well-known and famous in the computer industry to identify Opposer's goods and services. In view of the similarity of the respective marks and related nature of goods and services of the respective parties, it is alleged that Applicant's mark so

resembles Opposer's SUN mark and SUN Family of Names and Marks previously used in the United States, and not abandoned, as to dilute the distinctive quality of Opposer's marks, thereby causing loss, damage and injury to Opposer and the purchasing public.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained, that Applicant's Trademark Application Serial No. 78/166,862 be rejected, and that Applicant be denied registration of FOLLOW THE SUN as a service mark for the services specified in International Class 42 in that application.

This Notice of Opposition is being submitted in duplicate along with a check for \$300.00 to cover the filing fee. Please charge any additional fees required to our Deposit Account No. 50-0261.

Respectfully submitted,

Dated: September 10, 2003

Tu Tsao
Sally M. Abel, Esq.
Tu T. Tsao, Esq.
Attorneys for Opposer
FENWICK & WEST LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
(650) 988-8500

18631/00000/DOCS/1375386.1



FENWICK & WEST LLP

TTAB

September 10, 2003

VIA EXPRESS MAIL

BOX TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Serial No.: 78/166,862
Mark: FOLLOW THE SUN
Applicant: Technical Advisory Services, LL
Opposer: Sun Microsystems, Inc.
Our Reference: 18631-000


09-10-2003
U.S. Patent & TMOc/TM Mail Rcpt Dt. #78

Dear Madam:

Enclosed for filing is Notice of Opposition, in duplicate, in connection with the above-referenced matter.

A check in the amount of \$300.00 to cover the filing fee is enclosed. If any additional fees are required, please charge to our Deposit Account No. 50-0261.

Please complete this filing, addressing any correspondence or notifications to Sally M. Abel, Esq. at our Mountain View office.

Very truly yours,

FENWICK & WEST LLP

Jennifer Davis Rink
Senior Paralegal

Enclosures

18631/00000/DOCS/1375755.1

Silicon Valley Center
801 California Street
Mountain View, CA 94041

Tel 650.988.8500
Fax 650.938.5200

www.fenwick.com

Silicon Valley ▪ San Francisco ▪ Washington, DC