

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

In the Matter of Application Serial No. 78/097,653
For the Mark SMARTWAVE
Published in the Official Gazette on April 1, 2003

TELIGENT, INC.,)
)
 Opposer,)
)
 v.)
)
 NITA STURIALE (Individual),)
)
 Applicant.)

Opposition No. _____



10-09-2003

U.S. Patent & TMO/tm Mail Rcpt Dt. #22

NOTICE OF OPPOSITION

Opposer, Teligent, Inc., a corporation duly organized and existing under the laws of the State of Delaware, with its principal place of business at 460 Herndon Parkway, Herndon, Virginia 20170, hereby opposes registration of the mark SMARTWAVE (design) that is the subject of Application Serial No. 78/097,653, published in the Official Gazette of April 1, 2003, and requests that registration to Applicant be refused.

Pursuant to Sections 2(a), 2(d) and 13(a) of the Trademark Act of 1946, (as amended, the Lanham Act) 15 U.S.C. §§ 1052 and 1063, and as grounds in support of its opposition, Opposer asserts as follows:

1. Opposer owns four valid and subsisting federal registrations for the SMARTWAVE mark. Those registrations are:

- SMARTWAVE, Registration No. 2,488,174, filed on October 23, 1998, with a first use date of January 1999, for use in connection with "telecommunications services, namely, the electronic transmission of voice, data and video via a communications network," in International Class 38.
- SMARTWAVE PRI, Registration No. 2,528,349, filed on January 7, 2000, with a first use date of June 1, 2000, for use in connection with

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“telecommunications services, namely, the electronic transmission of voice, data and video via a communications network,” in International Class 38.

- SMARTWAVE DSL, Registration No. 2,464,411, filed on May 21, 1999, with a first use date of July 1999, for use in connection with “telecommunications services, namely, the electronic transmission of voice, data and video via a communications network,” in International Class 38.
- SMARTWAVES, Registration No. 2,437,860, filed on June 4, 1998, with a first use date of August 5, 1997, for use in connection with “engineering services in the field of microwave and millimeter wave antenna and radio design,” in International Class 42.

(hereinafter Opposer’s four registrations will be referred to collectively as “Opposer’s Marks”).

2. Upon information and belief, Applicant, Nita Sturiale is an individual located at One Broadway, Suite 600, Cambridge, Massachusetts 02142.

3. Notwithstanding Opposer’s prior rights in and to Opposer’s SMARTWAVE Marks, Applicant filed, on December 11, 2001, an application for registration of the trademark SMARTWAVE (design) based on its use of the mark since December 1, 2001, for use in connection with “computer software development and customized services that integrate nomadic computing, wireless LANs and hand-held devices and applications in order to develop vertical applications that enable information input/output, activity recording, communication, and location-aware features for mobile hand-held users,” in International Class 42.

4. As demonstrated by Opposer’s registrations, Opposer and/or its predecessor in interest have used the SMARTWAVES mark in interstate commerce since at least August 1997 (with a constructive use date of October 23, 1998), and has used the SMARTWAVE mark in interstate commerce since at least January 1999 (with a constructive use date of June 4, 1998), all of which dates are well prior to Applicant’s application and Applicant’s first use date of the SMARTWAVE mark. There is no issue as to priority in this matter. The date of Applicant’s filing (December 11, 2001) and its claimed date of first use of December 1, 2001, are subsequent

to the first use dates and constructive use dates of Opposer's four registrations. Therefore, Opposer has prior and superior rights to the SMARTWAVE mark.

5. Applicant's SMARTWAVE mark, when used in connection with the services set forth in the Applicant's application, which include services related to Opposer's services, is likely to cause confusion, or to cause mistake, or to deceive purchasers and potential purchasers of Applicant's products into erroneously believing that there is some relationship between Opposer and Applicant, or that Opposer has authorized, sponsored or licensed Applicant's use of the mark SMARTWAVE, in violation of 15 U.S.C. § 1052(d).

6. Applicant's SMARTWAVE mark, when used in connection with the services set forth in the Applicant's application, which include services related to Opposer's services, so closely resembles Opposer's Marks that Applicant's mark will falsely suggest a connection with Opposer, in violation of 15 U.S.C. § 1052(a).

7. Registration of Applicant's mark will damage Opposer, as any concurrent use by Applicant of its mark with inferior services will cause irreparable harm to Opposer's business reputation and erode the value of the goodwill associated with Opposer's Marks.

8. Registration of Applicant's mark will damage Opposer, as such registration will give color of exclusive statutory rights to the mark SMARTWAVE to Applicant in derogation and violation of the prior rights of Opposer to Opposer's Marks.

Conclusion

For any or all of the reasons stated above, Opposer avers that it would be seriously damaged and injured if a registration for the SMARTWAVE mark is issued to Applicant.

WHEREFORE, Opposer requests that its Opposition be sustained and that registration of Applicant's SMARTWAVE mark for the services specified in Applicant's application be denied.

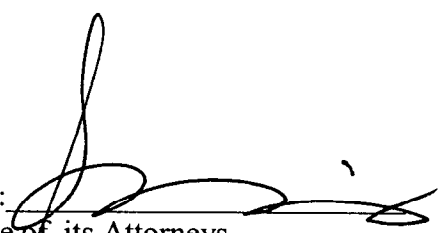
Please address all communications to Roger P. Furey, Esq., Katten Muchin Zavis Rosenman, 1025 Thomas Jefferson Drive, N.W., Suite 700, East Lobby, Washington, DC 20007. Teligent hereby appoints Roger P. Furey, Esq., Peter J. Riebling, Esq., Sylvia D. Davis, Esq. and Rebecca McDougall, Esq., of Katten Muchin Zavis Rosenman, 1025 Thomas Jefferson Drive, N.W., Suite 700, East Lobby, Washington, DC 20007, a law firm comprising members of the Bar of the District of Columbia, as its attorneys with full powers of substitution and revocation, to file this Notice of Opposition, to receive all related communications, to transact all business in the U.S. Patent and Trademark Office and/or Trademark Trial and Appeal Board in connection therewith, and to represent it in all proceedings and appeals that may arise in the U.S. Patent and Trademark Office or the courts concerning this Notice of Opposition.

The filing fees in the amount of \$300.00 for the filing of this opposition, and any additional fees should be charged to the Deposit Account of Katten Muchin & Zavis, No. 50-1877.

A duplicate copy of this Notice of Opposition is enclosed herewith.

TELIGENT, INC.

Dated: October 9, 2003

By: 
One of its Attorneys
Roger P. Furey, Esq.
Sylvia Denise Davis, Esq.
KATTEN MUCHIN ZAVIS ROSENMAN
1025 Thomas Jefferson Drive, N.W.
Suite 700, East Lobby
Washington, DC 20007

CERTIFICATE OF HAND-DELIVERY

I hereby certify that the foregoing **Notice of Opposition of SMARTWAVE** (U.S. Application Serial No. 78/097,653) in Class 42, filed on behalf of Opposer, Teligent, Inc., was hand-delivered to the following address, this 9th day of October, 2003:

Commissioner for Trademarks
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3514
MAIL STOP BOX TTAB – FEE



Richard Lukas
Trademark Paralegal
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Arlington, Virginia 22202-3514

VIA HAND DELIVERY



10-09-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

MAIL STOP BOX TTAB – FEE

RE: Opposer: Teligent, Inc.
Applicant: Nita Sturiale
Application No.: 78/097,653 for SMARTWAVE
Publication Date: April 1, 2003
Our Reference: 214026.00005

Dear Sir:

Submitted herewith are the following:

1. Notice of Opposition of SMARTWAVE in Class 42 (4 Pages);
2. Two copies of Notice of Opposition of SMARTWAVE in Class 42 (8 Pages total);
2. Certificate of Hand Delivery (1 Page); and
3. A receipt to be date stamped with the filing date (1 Pink sheet).

The Commissioner is hereby authorized to charge the \$300 fee for filing this Notice of Opposition in International Class 38 and any additional necessary fees to the Deposit Account of Katten Muchin Zavis Rosenman, Account No. 50-1877.

Please direct all inquiries and correspondence in this matter to Roger P. Furey, Esq., at the address on this letterhead or by telephone at (202) 625-3630.

Respectfully submitted,

Richard Lukas
Trademark Paralegal

Date: October 9, 2003

Enclosures

cc: Brian Leventhal, Esq.
Roger P. Furey, Esq.