

TTAB

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

GENERAL INSTRUMENT CORPORATION)
)
Opposer,)
)
v.)
)
ENEGREN COMPUTER SERVICE, INC.)
)
Applicant.)
_____ /

Opposition No. _____
Serial No. 76/412,206
Mark: WEBSURF & DESIGN



01-07-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

NOTICE OF OPPOSITION

Opposer, General Instrument Corporation, a Delaware corporation at 101 Tournament Drive, Horsham, Pennsylvania 19044 ("Opposer"), believes that it will be damaged by registration of the mark of Application Serial No. 76/412,206 by Enegren Computer Service, Inc., Applicant herein ("Applicant"), and hereby opposes the same on the grounds that (1) the mark is likely to cause confusion or to cause mistake or to deceive with respect to Opposer's prior use of, and registrations and applications for registration of, various marks formed or dominated by a surfboard design and/or the term "SURF" ("Opposer's Marks"), including (a) Registration No. 2,471,712 for SURFBOARD DESIGN, (b) Registration No. 2,137,690 for SURFBOARD & SURFBOARD DESIGN, (c) Registration No. 2,088,180 for SURFBOARD, (d) Registration No. 2,234,682 for SURFVIEW ("Opposer's Registrations") and (e) Application Serial No. 75/809,864 for SURFVIEW; and (2) that registration of Applicant's mark dilutes the

distinctiveness of Opposer's Marks.

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Application Serial No. 76/412,206 is for the mark WEBSURF & DESIGN for “*providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information*” in International Class 38 (“Applicant’s Mark”).

1. Opposer is extensively engaged in the business of manufacturing, marketing and selling a broad range products for use in association with broadband communications systems, networks and equipment, including modems, adapters, converters, terminals, processors, multiplexers, receivers, aggregators, tuners, transcoders, generators, modulators, demodulators, transponders, decoders, amplifiers, filters, line extenders, equalizers, and related computer software and hardware (“Opposer’s Goods”).

2. In connection with the above-stated activities, Opposer has used Opposer’s Marks. Opposer’s Marks have been in continuous use in commerce since at least as early as September, 1995.

3. As a result of the quality of Opposer’s Goods, and the widespread promotion, marketing, and sale thereof under Opposer’s Marks, the goods have met with substantial commercial success and customer recognition. As a further result, Opposer’s Marks have become symbols of Opposer, its quality products, and its goodwill. In addition, Opposer’s Marks are famous.

4. In recognition of the valuable rights in and to Opposer’s Marks, the United States Patent and Trademark Office has granted Opposer’s Registrations. Registration No. 2,088,180 has achieved incontestable status and thus constitutes conclusive evidence of the validity of the mark, the registration therefor, Opposer’s ownership of the mark and Opposer’s exclusive right to use the mark in commerce. The remaining registrations constitute *prima facie* evidence of the

validity of the respective marks, the registrations therefor, Opposer's ownership of the marks and Opposer's exclusive right to use the marks in commerce.

5. On information and belief, Applicant is a Kansas corporation at 6730 West Kellogg, Suite 5, Wichita, Kansas 67209.

6. Notwithstanding Opposer's prior use of, and registrations and/or applications filed for, Opposer's Marks, on May 20, 2002, Applicant filed Application Serial No. 76/412,206 for the mark WEBSURF & DESIGN for "*providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information*" in International Class 38 ("Applicant's Services").

7. On information and belief, Applicant's Mark is confusingly similar to Opposer's Marks. Further, Applicant's services and Opposer's Goods are related, are marketed to the same class of purchasers, are purchased by the same class of purchasers, and are marketed and sold through the same channels of trade.

8. In view thereof, purchasers are likely to mistakenly assume that Applicant's Services originate from, are sponsored by, or are in some way associated with Opposer. Applicant's Mark so resembles Opposer's Marks as to be likely to cause confusion, or to cause mistake or deception as to source, sponsorship, affiliation or association, in violation of federal trademark law. Accordingly, Opposer is likely to be damaged by registration of the mark of Application Serial No. 76/412,206.

9. Moreover, Opposer's Marks are famous. Registration of Applicant's Mark dilutes the strength of, and blurs and tarnishes the distinctiveness of Opposer's Marks.

WHEREFORE, Opposer prays that Application Serial No. 76/412,206 be refused registration, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

A filing fee for the Notice of Opposition in the amount of \$300 should be charged to Deposit Account No. 18-0013. Any additional fees required should be charged to the same account.

Respectfully submitted,

Dated: January 5, 2004

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I hereby certify that this Notice of Opposition is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to BOX TTAB – FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on January 5, 2004, by Michelle L. Visser

Michelle L. Visser

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