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Filing date: **02/06/2007**

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

Proceeding	91169802
Party	Plaintiff Karl Storz Imaging, Inc. Karl Storz Imaging, Inc. Karl Storz Imaging, Inc. 175 B Cremona Drive Goleta, CA 93117 UNITED STATES
Correspondence Address	Wesley W. Whitmyer, Jr. St. Onge Steward Johnston & Reens LLC 986 Bedford Street Stamford, CT 06905 UNITED STATES lit@ssjr.com
Submission	Motion to Amend Pleading/Amended Pleading
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Date	02/06/2007
Attachments	91169802 Amended Not of Opposition.pdf (8 pages)(158700 bytes)

1. Opposer is the owner of the mark IMAGE 1, U.S. Trademark Reg. No. 2605738 for "Electronic imaging equipment, namely, video cameras, computer hardware and related software for operating said equipment, all for industrial, scientific and medical use"; and the mark IMAGE 1 and Design, U.S. Trademark Reg. No. 2615958 for "Electronic imaging equipment, namely, video cameras, computer hardware, and related software for operating said equipment, and manuals sold therewith, all for industrial scientific and medical use" (referred to hereinafter as IMAGE 1 marks). Copies of the registrations from the USPTO online database are attached hereto as Exhibit A and incorporated herein by reference.

2. The above identified registrations are valid and subsisting and are evidence of Opposer's exclusive right to use the IMAGE 1 marks in commerce on the goods specified in said registrations.

3. As a result of use and registration of the IMAGE 1 marks identified above, Opposer has a valid and exclusive right to the IMAGE 1 marks for use on or in connection with a wide variety of goods and services, including, without limitation, electronic imaging equipment

4. Opposer's rights in the IMAGE 1 marks are prior in time to any alleged first use or intent to use application by Applicant for IMAGEONE.

5. Applicant admitted during prosecution that Opposer's IMAGE 1 marks have priority over Applicant's IMAGEONE mark.

6. Applicant admitted during prosecution that Applicant's IMAGEONE mark resembles Opposer's IMAGE 1 marks in sound and appearance.

7. In view of the similarities between Applicant's IMAGEONE mark and Opposer's IMAGE 1 marks, there is a likelihood that Applicant's IMAGEONE goods and/or services will be

seen as being sponsored by Opposer.

8. Applicant's IMAGEONE mark is likely to cause confusion, mistake or to deceive with Opposer's IMAGE 1 marks.

9. The use and registration of IMAGEONE by Applicant will damage Opposer in the selling of its goods and services and cause confusion of purchasers.

10. The channels of trade in which Opposer markets its goods and services in connection with the IMAGE 1 marks and in which Applicant markets its goods and services in connection with the IMAGEONE mark are overlapping and/or are the same.

12. Applicant made false and misleading statements to the United States Patent and Trademark Office ("USPTO") by asserting that Opposer's and Applicant's channels of trade were different and distinct, when Applicant knew or reasonably should have known that Applicant's statements were false and misleading because the channels of trade overlapped and/or were the same.

13. Applicant's false and misleading statements to the USPTO were material to the Examining Attorney's decision to approve the application because they resulted in withdrawal of the refusal to register that was based upon Opposer's registrations for the IMAGE 1 marks.

14. Because of the likelihood of confusion and Applicant's improper and fraudulent conduct in making false and misleading statements to the USPTO, Applicant is not entitled to a registration.

WHEREFORE, Opposer prays that said application Serial No. 76/622,434 for IMAGEONE be denied, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

KARL STORZ IMAGING, INC.

February 6, 2007

By 

Wesley W. Whitmyer, Jr.
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Attorneys for Opposer

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing Opposer's Amended Notice of Opposition, is being served on Applicant's counsel of record, this 6th day of February, 2007, by depositing the same as First Class Mail to Addressee, with the United States Postal Service in an envelope addressed to:

David N. Schachter, Esq.
Sherman & Howard L.L.C.
633 17th Street, Suite 3000
Denver, CO 80202-3665

ATTORNEY FOR APPLICANT


February 6, 2007



Joan M. Burnett

CERTIFICATE OF MAILING: I hereby certify that this document is today being submitted via electronic filing to: TTAB, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

February 6, 2007



Joan M. Burnett

EXHIBIT A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,605,738

United States Patent and Trademark Office

Registered Aug. 6, 2002

**TRADEMARK
PRINCIPAL REGISTER**

IMAGE 1

KARL STORZ IMAGING, INC. (CALIFORNIA
CORPORATION)
175 B CREMONA DRIVE
GOLETA, CA 93117

FOR: ELECTRONIC IMAGING EQUIPMENT,
NAMELY, VIDEO CAMERAS, COMPUTER HARD-
WARE AND RELATED SOFTWARE FOR OPERAT-
ING SAID EQUIPMENT, ALL FOR INDUSTRIAL,

SCIENTIFIC AND MEDICAL USE, IN CLASS 9 (U.S.
CLS. 21, 23, 26, 36 AND 38).

FIRST USE 1-2-2002; IN COMMERCE 1-2-2002.

SN 76-184,539, FILED 12-20-2000.

WILLIAM P. SHANAHAN, EXAMINING ATTOR-
NEY

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,615,958

United States Patent and Trademark Office

Registered Sep. 3, 2002

TRADEMARK
PRINCIPAL REGISTER



KARL STORZ IMAGING, INC. (CALIFORNIA
CORPORATION)
175 B CREMONA DRIVE
GOLETA, CA 93117

FOR: ELECTRONIC IMAGING EQUIPMENT,
NAMELY, VIDEO CAMERAS, COMPUTER HARD-
WARE, AND RELATED SOFTWARE FOR OPERAT-
ING SAID EQUIPMENT, AND MANUALS SOLD
THEREWITH, ALL FOR INDUSTRIAL SCIENTIFIC

AND MEDICAL USE, IN CLASS 9 (U.S. CLS. 21, 23,
26, 36 AND 38).

FIRST USE 1-1-2002; IN COMMERCE 1-1-2002.

SN 76-224,665, FILED 3-14-2001.

WILLIAM P. SHANAHAN, EXAMINING ATTOR-
NEY