

ESTTA Tracking number: **ESTTA83653**

Filing date: **06/02/2006**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sunbeam Products, Inc.
Granted to Date of previous extension	06/04/2006
Address	2381 Executive Center Drive Boca Raton, FL 33431 UNITED STATES

Attorney information	Cindy L. Caditz Klarquist Sparkman, LLP 121 S.W. Salmon Street, Suite One World Trade Center Portland, OR 97204 UNITED STATES cindy.caditz@klarquist.com Phone:206-264-2960
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Applicant Information

Application No	76633973	Publication date	12/06/2005
Opposition Filing Date	06/02/2006	Opposition Period Ends	06/04/2006
Applicant	OSRAM GmbH DEPT GC IP TM Hellabrunnerstr. 1 MUNICH D-81543, GERMANY		

Goods/Services Affected by Opposition

Class 009. First Use: 2005/07/22 First Use In Commerce: 2005/07/22 All goods and services in the class are opposed, namely: Light emitting diodes; light emitting diode displays and display circuit modules; and components of the aforementioned goods

Attachments	Sunbeam-Osram.pdf.pdf (7 pages)(280513 bytes)
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Signature	/Cindy L. Caditz/
Name	Cindy L. Caditz
Date	06/02/2006

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

3 Applicant: Osram GmbH Attorney Docket No. 7519-73060-01
4 Serial No.: 76/633,973 International Class: 9
5 Filed: March 14, 2005 Published for Opposition: December 6, 2005
6 Mark: OSTAR Official Gazette: Vol. 1301, No. 1, Page TM 362
7 Goods: IC 9: light emitting diodes; light emitting diode displays and display circuit modules; and
8 components of the aforementioned goods

9 SUNBEAM PRODUCTS, INC. a Delaware
10 corporation,

11 Opposer,

12 v.

13 OSRAM GmbH, a corporation of the Federal
14 Republic of Germany,

15 Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Seattle, Washington 98104

June 2, 2006

NOTICE OF OPPOSITION

18 TO THE COMMISSIONER FOR TRADEMARKS

19 TRADEMARK TRIAL AND APPEAL BOARD

20 Sunbeam Products, Inc., a corporation of the State of Delaware, having a place of business at
21 2381 Executive Center Drive, Boca Raton, Florida 33431 (hereinafter "Opposer"), believes that it
22 will be damaged by registration of the mark OSTAR as requested by Application Serial No.
23 76/633,973 filed March 14, 2005, in International Class 9 and hereby opposes the same.
24

25 As grounds for the opposition, Opposer alleges as follows:
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1 1. On information and belief, Osram GmbH is a corporation of the Federal Republic of
2 Germany, having a place of business at Dept GC IP TM Hellabrunnerstr. 1, Munich D-81543,
3 Germany (hereinafter "Applicant").

4 2. Continuously, since long prior to any date upon which Applicant can rely, Opposer
5 has used the trademark OSTER in association with a wide variety of consumer products and kitchen
6 appliances and a wide variety of related goods.

7 3. Opposer is the owner of U.S. Trademark Registration No. 368,541 for the mark
8 OSTER for hand operated hair clippers, electric hair clippers for human use, electric hair clippers for
9 animal use, fur trimming hair clippers, rug clipping electric clippers, hat trimming clippers, clipper
10 blades, and electric shavers in International Class 8. Said registration issued June 20, 1939, sets forth
11 a date of first use of November 1, 1924, and is currently valid, subsisting and incontestable.

12 4. Opposer is the owner of U.S. Trademark Registration No. 515,517 for the mark
13 OSTER and Design for electric motors; electric toasters; electric food mixers; electric drink mixers;
14 electric food choppers; electric food liquifiers; electric food blenders; electric hair-styling irons;
15 electric flat irons; electric fans; and repair and replacement parts for the above goods in International
16 Classes 7, 8 and 9; portable electric hair clippers for human, animal and industrial uses and separate
17 cutter heads and clipper blades therefor, electric razors; and repair and replacement parts for the
18 above goods in International Class 8; electric hair dryers; hand operated and stand type electric
19 massage machines for human and animal use; and repair and replacement parts for the above goods
20 in International Classes 7, 10, and 11. Said registration issued September 27, 1949, sets forth a date
21 of first use of November 1, 1924, and is currently valid, subsisting and incontestable.
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23 5. Opposer is the owner of U.S. Trademark Registration No. 847,078 for the mark
24 OSTER for electric manicuring devices and parts thereof in International Class 10. Said registration
25 issued April 2, 1968, sets forth a date of first use of April 15, 1966, and is currently valid, subsisting
26 and incontestable.
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1 6. Opposer is the owner of U.S. Trademark Registration No. 858,325 for the mark
2 OSTER for electric hair dryers for human and animal uses, electric massage machines for human and
3 animal uses, electric heat massage machines, electric foot bath massage machines, electric scalp
4 cleaner, and parts thereof in International Classes 7 and 10. Said registration issued October 8, 1968,
5 sets forth a date of first use of July 30, 1930, and is currently valid, subsisting and incontestable.

6 7. Opposer is the owner of U.S. Trademark Registration No. 860,036 for the mark
7 OSTER for portable electric hair clippers for human, animal, and industrial uses, clipper blades, ice
8 crushers, knife and scissors sharpeners, scissors, electric can openers, electric sausage stuffers,
9 electric juice extractors, electric coffee mills, and parts thereof in International Classes 7 and 8. Said
10 registration issued November 12, 1968, sets forth a date of first use of 1924, and is currently valid,
11 subsisting and incontestable.

12 8. Opposer is the owner of U.S. Trademark Registration No. 859,247 for the mark
13 OSTER for electric motors, electric food mixers, electric drink mixers, electric food choppers,
14 electric food liquefiers, electric food blenders, electric food grinders, electric coffee makers, and
15 parts thereof in International Classes 7, 9 and 11. Said registration issued October 29, 1968, sets
16 forth a date of first use of September 18, 1930, and is currently valid, subsisting and incontestable.

17 9. Opposer is the owner of U.S. Trademark Registration No. 930,801 for the mark
18 OSTER for electric beverage heaters, portable electrically heated steam generators for domestic and
19 commercial use for pressing and treating fabrics; and portable electrically heated cooking utensils in
20 International Class 11. Said registration issued March 14, 1972, sets forth a date of first use of
21 March 1961 and is currently valid, subsisting and incontestable.

22 10. Opposer is the owner of U.S. Trademark Registration No. 1,198,487 for the mark
23 OSTER and Design for household electric food preparation appliances – namely, food mixers,
24 blenders, slicers, shredders, grinders, juice extractors, can openers, and parts therefor in International
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1 Class 7. Said registration issued June 22, 1982, sets forth a date of first use of March 1964 and is
2 currently valid, subsisting, and incontestable.

3 11. Opposer is the owner of U.S. Trademark Registration No. 1,636,082 for the mark
4 OSTER for electric ice cream makers in International Class 11. Said registration issued February 26,
5 1991, sets forth a date of first use of November 1985 and is currently valid, subsisting, and
6 incontestable.

7 12. Opposer is the owner of U.S. Trademark Registration No. 2,294,005 for the mark
8 OSTER and Design for sharpening compound; hair shampoo and conditioner for pets in International
9 Class 3; Deodorizers for pets, disinfectant for blades in International Class 5; Electric motors and
10 appliances, namely - Electric food mixers, Electric drink mixers, Electric food choppers, Electric
11 food slicers, Electric food liquefiers, Electric can openers, Electric food processors, Electric food
12 grinders, Electric citrus juicers, Electric juice extractors, Electric coffee grinders, Electric food
13 blenders for domestic and commercial use, Electric knives, Electric knife and scissor sharpeners,
14 Electric sausage stuffers, Electric ice crushers, Filter (non-paper) for coffee makers, Electric hair
15 clippers and trimmers for human and animal use, clipper blades and brushes for use with electric
16 clippers; shears in International Class 7; battery chargers, scales, temperature indicating devices,
17 namely, thermocouples, thermometers and pyrometers, electric irons, steam irons and flat irons in
18 International Class 9; combs, coffee servers not of precious metal in International Class 21; Service
19 repair of household appliances, barber equipment, health devices and animal grooming devices in
20 International Class 37; electric coffee makers, electric beverage heaters, electric beverage dispensers,
21 electric water kettles and tea brewing apparatus, electric rotisseries, electric
22 breadmakers/doughmakers, electric egg cookers, electric ice cream makers, electric indoor grills,
23 electric slow cookers, electric soft serve ice cream makers, electric rice and vegetable steamers,
24 electric deep fryers, electric toasters, electric toaster ovens, electric waffle makers, electric skilletts,
25 electric fans, electric hair dryers for human and animal use, electric garment and fabric steamers for
26
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1 domestic and commercial use in International Class 11; and electric massage machines for human
2 use, electric heat massage machines, electric foot bath massage machines and parts therefor in
3 International Class 10. Said registration issued November 23, 1999 and is currently valid, subsisting,
4 and incontestable.

5 13. Opposer is the owner of U.S. Trademark Registration No. 3,083,873 for the mark
6 OSTER for cooking appliances, namely microwave ovens in International Class 11. Said registration
7 issued April 18, 2006, sets forth a date of first use of August 5, 2005 and is currently valid and
8 subsisting.

9 14. Opposer will be damaged by the registration sought by Applicant insofar as the
10 registration will be *prima facie* evidence of the validity of the registration, Applicant's ownership of
11 the mark OSTAR, and Applicant's exclusive right to use the mark OSTAR when, in fact, Applicant
12 is not entitled to such rights by virtue of Opposer's prior and continuous use of the mark OSTER in
13 association with the sale of a wide variety of consumer and household products in the same channels
14 of trade in which the goods claimed by Application Serial No. 76/633,973, would be sold.

15 15. The mark OSTAR shown by Application Serial No. 76/633,973, when used in
16 association with the goods claimed by said application, so resembles Opposer's mark OSTER as to
17 be likely to cause confusion, or to cause mistake, or to deceive within the meaning of Section 2(d) of
18 the Lanham Act 15 U.S.C. § 1052(d).

19 20 16. As a result of Opposer's long-term, substantial and widespread use of the mark
21 OSTER shown by the registrations identified by Paragraphs 3-13 herein, the mark OSTER has
22 become famous, and is thus a valuable symbol that serves to identify Opposer as the source of all
23 goods and services identified by or promoted with the mark.

24 25 17. The mark OSTER previously used by Opposer and shown by the registrations
26 identified by Paragraphs 3-13 herein became famous prior to any date upon which Applicant can
27 show use of the mark OSTAR shown by Application Serial No. 76/633,973.

1 18. The mark shown by Application Serial No. 76/633,973 so resembles Opposer's
2 famous mark OSTER previously used and registered by Opposer and shown by the registrations
3 identified by Paragraph 3-13 herein, as to be likely to falsely suggest a connection between Opposer
4 and Applicant in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

5 19. The mark shown by Application Serial No. 76/633,973 when used with the goods
6 claimed by said application so resembles Opposer's famous mark OSTER as to cause dilution of the
7 distinctive quality of Opposer's mark OSTER in violation of 15 U.S.C. § 1125(c).

8 20. Based upon the foregoing, registration of the mark OSTAR shown by Application
9 Serial No. 76/633,973, filed March 14, 2005, is likely to cause injury and damage to Opposer.

10 WHEREFORE, Opposer respectfully requests that the registration of the mark OSTAR
11 shown by Application Serial No. 76/633,973 be denied pursuant to Section 2(d) of the Lanham Act,
12 15 U.S.C. § 1052(d), Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a) and 15 U.S.C. § 1125(c),
13 and that this opposition be sustained.
14

15 Please charge the required filing fee to Deposit Account No. 02-4550 of Opposer's counsel
16 noted below.
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2 following address:

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7 Respectfully submitted,

8
9 KLARQUIST SPARKMAN, LLP

10
11 By: s/ Cindy L. Caditz _____

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