

ESTTA Tracking number: **ESTTA86534**

Filing date: **06/21/2006**

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	Netopia, Inc.
Granted to Date of previous extension	07/12/2006
Address	6001 Shellmound Street Marketplace Tower Emeryville, CA 94608 UNITED STATES

Attorney information	Rochelle D. Alpert Morgan, Lewis & Bockius LLP One Market, Spear Street Tower San Francisco, CA 94105 UNITED STATES ralpert@morganlewis.com Phone:415-442-1326
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**Applicant Information**

Application No	75746883	Publication date	03/14/2006
Opposition Filing Date	06/21/2006	Opposition Period Ends	07/12/2006
Applicant	5BY5 NETWORKS, INC. 1135 W. SUNSET BLVD. ROCKLIN, CA 95765 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 2000/05/01 First Use In Commerce: 2000/08/01 All goods and services in the class are opposed, namely: Telecommunications hardware and software, namely, telecommunications hardware and telecommunications computer software for the transmission of voice and data information over public and private telecommunications networks
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Attachments	ITOPIA and design - Serial # 75746883.pdf ( 8 pages )(266230 bytes )
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Signature	/Rochelle D. Alpert/
Name	Rochelle D. Alpert
Date	06/21/2006

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

**In the matter of application Serial No. 75/746,883  
Filed July 9, 1999  
For the mark ITOPIA and design  
Published in the OFFICIAL GAZETTE on March 14, 2006**

NETOPIA, INC.,

Opposer,

v.

5BY5 Networks, Inc.,

Applicant.

Opposition No.:

BOX TTAB – FEE  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

Netopia, Inc., (“Netopia”) a Delaware corporation having its principal place of business at Marketplace Tower, 6001 Shellmound Street, 4th Floor, Emeryville, CA 94608, believes that it will be damaged by registration of the mark shown in Serial No. 75/746,883 and hereby opposes the same.

As grounds for the opposition, it is alleged as follows:

1. Netopia is in the business of developing computer hardware and software products for use in establishing, maintaining, managing and securing wide area and local area

computer networks and computer network connections, including global computer network connections as well as computer hardware and communications software for electronic file transfer, remote computer access and remote network access. Netopia's customers include, among others, telecommunications companies and businesses using telecommunications technology and products. Netopia also offers related services. Netopia maintains an Internet website at the domain name "www.netopia.com" on which users can find information on the computer hardware and software products, and related services that Netopia offers under its trade name, trademark and service mark NETOPIA®.

2. Since at least as early as 1995, well before the filing date of the application for the opposed mark, Netopia has been using, and continues to use in commerce, the trademark and service mark NETOPIA®, the trade name Netopia and the domain name www.netopia.com.

3. Netopia owns a federal registration (Reg. No. 2,269,305) for the mark NETOPIA® for "computer hardware and software for use in establishing, maintaining and managing wide area and local area computer networks and computer network connections, including global computer network connections; computer hardware and communications software for electronic file transfer, remote computer access and remote network access, all in the fields of wide area and local area networks, including global computer networks; user manuals supplied as a unit with the foregoing," in International Class 9. This mark has been in use in commerce since at least as early as November 1995 and registered on August 10, 1999. The mark has been in continuous use since registration and has become incontestable. The mark has become identified with Netopia and its computer hardware and software products, and related services.

4. By way of the opposed intent-to-use application, 5BY5 Networks, Inc. (“Applicant”) seeks to register the confusingly similar designation ITOPIA and design (Ser. No. 75/746,883) for “telecommunications hardware and software, namely, telecommunications hardware and telecommunications computer software for the transmission of voice and data information over public and private telecommunications networks” in International Class 9. The opposed application was filed well after Netopia filed and obtained United States trademark registrations for its NETOPIA<sup>®</sup> marks, and well after Netopia first commenced use of its NETOPIA<sup>®</sup> marks, names and domain names.

5. The designation for which Applicant seeks registration by way of the opposed intent-to-use application for ITOPIA and design, is confusingly similar in sight, sound and meaning to Netopia’s NETOPIA<sup>®</sup> mark, name and domain name.

6. On information and belief, Netopia alleges that the goods for which Applicant seeks to register the opposed ITOPIA and design designation are competitive with and/or directly related to and/or complementary to Netopia’s goods and services. Moreover, on information and belief, Netopia alleges that Applicant intends to direct its products under the confusingly similar ITOPIA and design designation to the same and/or overlapping consumers that use Netopia’s products and services and to whom Netopia promotes and offers its products and services bearing its NETOPIA<sup>®</sup> marks and names. Further, on information and belief, Netopia alleges that Applicant and Netopia use or will use the same or overlapping channels of trade to target the same or overlapping prospective customers.

7. Inasmuch as Netopia’s NETOPIA<sup>®</sup> marks and names are confusingly similar in terms of sight, sound and meaning to the applied for ITOPIA and design designation, and because the goods identified in the opposed application and the apparent channels of trade and

prospective customer base for those goods and services overlap with the goods and services of Netopia, Applicant's application for the ITOPIA and design designation is likely to cause confusion, or to cause mistake, or to deceive or disparage by falsely suggesting a connection with Netopia, when there is none. As a result, Netopia will be damaged by the registration of the designation sought to be protected in Applicant's application and requests that registration of the opposed application be denied.

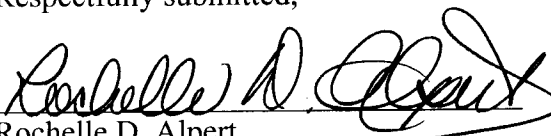
8. On information and belief, Netopia alleges that Applicant did not have use the applied for designation on all goods and services specified in its application at the time it filed its amendment to allege use and it does not have use on all goods listed in the application even presently.

WHEREFORE, Netopia prays that Application Serial No. 75/746,883 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Netopia.

The Assistant Commissioner is hereby authorized to charge \$300.00 to **Deposit Account No. 13-4520**, and all other fees necessary to institute this opposition

Dated: June 21, 2006

Respectfully submitted,

By:   
Rochelle D. Alpert  
Attorney for Netopia, Inc.

Morgan, Lewis & Bockius LLP  
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San Francisco, CA 94105  
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**EXHIBIT A**  
**to Notice of Opposition**

**NETOPIA, INC. v. 5BY5 Networks, Inc.**  
Serial No.: 75/746,883  
Submitted by: Netopia, Inc.

**EXHIBIT A**  
**PAGE 1 of 4**

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2006-05-15 18:19:11 ET**

**Serial Number:** 75746883 Assignment Information

**Registration Number:** (NOT AVAILABLE)

**Mark**



**(words only):** ITOPIA

**Standard Character claim:** No

**Current Status:** A request for an extension of time to file an opposition has been filed at the Trademark Trial and Appeal Board.

**Date of Status:** 2006-04-04

**Filing Date:** 1999-07-09

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 112

**Attorney Assigned:**  
STRZYZ KAREN MARIE Employee Location

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2006-02-01

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. 5BY5 NETWORKS, INC.

**Address:**  
5BY5 NETWORKS, INC.

1135 W. SUNSET BLVD.  
ROCKLIN, CA 95765  
United States  
**Legal Entity Type:** Corporation  
**State or Country of Incorporation:** Delaware

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**GOODS AND/OR SERVICES**

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**International Class:** 009  
**Class Status:** Active  
Telecommunications hardware and software, namely, telecommunications hardware and telecommunications computer software for the transmission of voice and data information over public and private telecommunications networks  
**Basis:** 1(a)  
**First Use Date:** 2000-05-01  
**First Use in Commerce Date:** 2000-08-01

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**ADDITIONAL INFORMATION**

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**Design Search Code(s):**  
**01.07.25** - Globes, other  
**27.01.04** - Letters forming objects; Numbers forming objects; Objects composed of letters or numerals; Punctuation forming objects

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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- 2006-04-04 - Extension Of Time To Oppose Received
- 2006-03-14 - Published for opposition
- 2006-02-22 - Notice of publication
- 2006-01-31 - Law Office Publication Review Completed
- 2006-01-31 - Assigned To LIE
- 2006-01-12 - Approved for Pub - Principal Register (Initial exam)
- 2006-01-12 - Amendment to Use approved
- 2005-04-06 - Report Completed Suspension Check Case Still Suspended
- 2004-08-11 - Report Completed Suspension Check Case Still Suspended

EXHIBIT A  
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2004-07-27 - Report Completed Suspension Check Case Still Suspended

2003-11-20 - Case File in TICRS

2001-01-29 - Letter of suspension mailed

2000-08-07 - Communication received from applicant

2000-10-04 - Amendment to use processing complete

2000-08-07 - Amendment to Use filed

2000-02-07 - Non-final action mailed

2000-01-06 - Case file assigned to examining attorney

1999-12-02 - Case file assigned to examining attorney

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**CORRESPONDENCE INFORMATION**

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**Correspondent**

KIM J. MUELLER (Attorney of record)

KIM J. MUELLER  
ORRICK, HERRINGTON & SUTCLIFFE LLP  
400 CAPITOL MALL, SUITE 3000  
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