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July 3, 2007

VIA EXPRESS MAIL

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By: Kara L. Bearfield
Kara L. Bearfield

Re: NOTICE OF OPPOSITION
Applicant : Avid Ratings Company
Mark : Avid
Serial No. : 78/961,632
Publication Date : March 6, 2007
Opposer : Avid Center
Our Ref : 31040-14-T01

Dear Sirs:

Enclosed herewith please find Avid Center's Notice of Opposition in the above identified matter. The Notice is being filed in duplicate. The opposed mark was published on March 6, 2007 in the *Official Gazette*.

All correspondence in this matter should be sent to:

Mitchell P. Brook, Esq.
Luce, Forward, Hamilton & Scripps, LLP
11988 El Camino Real, Ste. 200
San Diego, California 92130
(858) 720-6300

07/10/2007 SWILSON1 00000029 502298 78961632
01 FC:6402 300.00 DA



07-06-2007

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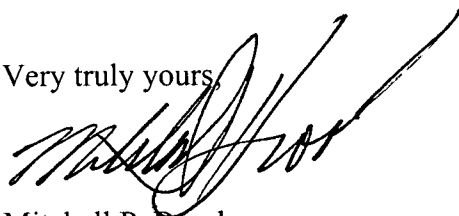
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July 3, 2007

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Please file-stamp and return the self-addressed postcard to this office for our records. The Commissioner is hereby authorized to charge the amount of \$300.00 for the opposition fee to Deposit Account No. 50-2298 and to charge any deficit or credit any excess to Deposit Account No. 50-2298 in the name of Luce, Forward, Hamilton & Scripps LLP.

Very truly yours,

A handwritten signature in black ink, appearing to read "Mitchell P. Brook", written over the closing "Very truly yours,".

Mitchell P. Brook

of

LUCE, FORWARD, HAMILTON & SCRIPPS LLP

MPB/klb

Enclosure

701003154.1

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

In the Matter of Application Serial No. 78/961,632

Avid

International Class: 35

Published in the *Official Gazette* of March 6, 2007

Avid Center)	
)	
Opposer)	
)	
vs.)	Opposition No. _____
)	
Avid Ratings Company)	
)	
Applicant)	
<u>Our Ref: 31040-14-T01</u>)	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Opposer, Avid Center, a Californian non profit organization located and doing business at 5120 Shoreham Place, Ste. 120, San Diego, California 92122 United States, believes that it will be damaged by registration of the mark shown in Serial No. 78/961,632 Avid, and hereby opposes the same.

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Label No. EV 092442735 US "Express Mail Post Office to Addressee", in an envelope addressed to Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, on this 3rd Day of July, 2007.


Kara L Bearfield

Applicant's application for "Avid" was filed on August 28, 2006 in the name of NRS Corporation. Assignments are recorded against the application which now stands in the name of Avid Ratings Company. The services identified are "Conducting business and market research surveys; Contests and incentive award programs to promote the sale of products and services of others" in International Class 35. It was published for opposition in the Official Gazette on March 6, 2007 (copy annexed as Exhibit A).

GROUND FOR OPPOSITION

1. Common Law Rights. Opposer has standing to oppose the published application based on Opposer's common law rights in its AVID trademark. Opposer has adopted and used the AVID trademark since at least as early as 1980. Opposer has continued to use the mark in association with a range of goods and services including the provision of educational programs, printed materials, conferences and other related goods and services. This use has been valid and continuous since the date of first use and has not been abandoned. This use also has been popular, well known and continuous. The AVID mark is distinctive and has acquired secondary meaning through Opposer's extensive use. The AVID mark is therefore entitled to strong protection under trademark law and would be damaged by the registration of the mark shown in Application Serial No. 78/961,632 Avid.

2. Registrations. Opposer is the owner of the following registrations, collectively referred to as the "AVID mark" or "AVID marks":

- a. U.S. Registration No. 2,372,132 for AVID in connection with "educational services directed to schools and school districts; namely, conducting workshops in the field of a college preparatory curriculum; distribution of written materials in conjunction therewith; and consulting services related thereto." in class 41, which

recites a first use in 1980 and a first use in commerce in 1986 (copy of printout from PTO database annexed as Exhibit B); and

- b. U.S. Registration No. 2,386,964 for AVID in connection with “Printed educational matter, namely, college preparatory curriculum courseware in print form, books and brochures” in Class 16, which recites a first use in 1980 and a first use in commerce in 1986 (copy of printout from PTO database annexed as Exhibit C).
- c. U.S. Registration No. 2,735,956 for AVID PRESS in connection with “Educational publications, namely, training manuals in the field of secondary school subjects (English, English as a second language, mathematics, science, social science, world languages) and college preparatory materials.” in Class 16, which recites a first use in 2000 and a first use in commerce in 2000 (copy of printout from PTO database annexed as Exhibit D).

Each of the above-identified registrations has a filing date that precedes August 28, 2006, the filing date of Applicant’s application.

3. Opposer’s use in interstate commerce in connection with its AVID mark (including registered and common law rights, as used herein) is prior to the filing date of United States Trademark Application Serial No. 78/961,632 Avid, which was filed on August 28, 2006 as an Intent-to-Use application.

4. Opposer’s mark and trade name are symbolic of the extensive goodwill and consumer recognition built up by Opposer in the AVID mark through substantial amounts of time and effort in advertising, promotion, substantial sales of goods and services. Opposer has

offered its goods and services in association with the AVID mark extensively and continuously in commerce. Opposer's use has been valid and continuous and has not been abandoned.

5. In view of the similarity/identity of the respective marks and the related nature of the services of the respective parties, it is respectfully evident that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion, or to cause mistake, or to deceive, or to falsely suggest an association with Opposer.

6. If Applicant is permitted to use and register its mark for its services, as specified in the application herein opposed, the resulting likelihood of confusion, mistake, deception, or false association will cause irreparable damage to the goodwill and consumer recognition that Opposer has built up in the AVID and AVID PRESS mark.

7. Opposer avers that the Applicant's use of said mark interferes with the Opposer's use of its AVID and AVID PRESS mark and will embarrass Opposer in the free use of its marks. Registration of the mark by Applicant will seriously damage Opposer under Section 2(d) of the Trademark Act.

8. Opposer's AVID mark is well known and famous and by virtue of the renown and fame, and in view of the dominant role of fame in analyzing likelihood of confusion, there is an increased likelihood of confusion between the AVID mark and the opposed mark.

WHEREFORE, Opposer prays that said Application Serial No. 78/961,632 Avid be rejected, that no registration be issued thereon to Applicant and that this opposition be sustained in favor of Opposer. A duplicate copy of this Notice of Opposition is enclosed herewith.

In payment of the requisite filing fee in the amount of \$300.00 the Commissioner is authorized to charge our Deposit Account No. 50-2298 (Luce, Forward, Hamilton & Scripps

LLP). Please address all correspondence to Mitchell P. Brook, Esq., LUCE, FORWARD, HAMILTON & SCRIPPS, 11988 El Camino Real, 2nd Floor, San Diego, California 92130.

Respectfully Submitted,

Date: July 3, 2007

By: 

Mitchell P. Brook
LUCE, FORWARD, HAMILTON & SCRIPPS, LLP
11988 El Camino Real, 2nd Floor
San Diego, California 92130
(858) 720-6300

Attorney for Opposer

701003136.1

Exhibit "A"



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Avid

Word Mark AVID
Goods and Services IC 035. US 100 101 102. G & S: Conducting business and market research surveys; Contests and incentive award programs to promote the sale of products and services of others
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Design Search Code
Serial Number 78961632
Filing Date August 28, 2006
Current Filing Basis 1B
Original Filing Basis 1B
Published for Opposition March 6, 2007
Owner (APPLICANT) AVID RATINGS COMPANY COMPANY WISCONSIN 918 DEMING WAY, SUITE 200 MADISON WISCONSIN 53717
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Mark A. Kassel
Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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Document Description: **Notice of Publication**Mail / Create Date: **14-Feb-2007****UNITED STATES PATENT AND TRADEMARK OFFICE**Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

Feb 14, 2007

NOTICE OF PUBLICATION UNDER 12(a)

- | | |
|-------------------------------------|---|
| 1. Serial No.:
78/961,632 | 2. Mark:
AVID
Standard Character Mark |
| 3. International Class(es):
35 | |
| 4. Publication Date:
Mar 6, 2007 | 5. Applicant:
NRS Corporation |

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents
U.S. Government Printing Office
PO Box 371954
Pittsburgh, PA 15250-7954
Phone: 202-512-1800

By direction of the Commissioner.

Correspondence Address:

Mark A. Kassel
Foley & Lardner LLP
150 East Gilman Street
Madison WI 53703-1481

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Typed Drawing

Word Mark	AVID
Goods and Services	IC 041. US 100 101 107. G & S: educational services directed to schools and school districts; namely, conducting workshops in the field of a college preparatory curriculum; distribution of written materials in conjunction therewith; and consulting services related thereto. FIRST USE: 19800900. FIRST USE IN COMMERCE: 19860700
Mark Drawing Code	(1) TYPED DRAWING
Design Search Code	
Serial Number	75567209
Filing Date	October 1, 1998
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	May 9, 2000
Registration Number	2372132
Registration Date	August 1, 2000
Owner	(REGISTRANT) Swanson, Mary Catherine INDIVIDUAL UNITED STATES AVID Center McConaughy House 2490 Heritage Park Row San Diego CALIFORNIA 92110
	(LAST LISTED OWNER) AVID CENTER CORPORATION 5120 Shoreham Place, Ste. 120 San Diego CALIFORNIA 92122
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	KATHERINE M. HOFFMAN
Type of Mark	SERVICE MARK
Register	PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

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Exhibit "C"



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Typed Drawing

Word Mark	AVID
Goods and Services	IC 016. US 002 005 022 023 029 037 038 050. G & S: Printed educational matter, namely, college preparatory curriculum courseware in print form, books and brochures. FIRST USE: 19800900. FIRST USE IN COMMERCE: 19860700
Mark Drawing Code	(1) TYPED DRAWING
Design Search Code	
Serial Number	75562975
Filing Date	October 1, 1998
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	June 27, 2000
Registration Number	2386964
Registration Date	September 19, 2000
Owner	(REGISTRANT) Swanson, Mary Catherine INDIVIDUAL UNITED STATES AVID Center McConaughy House 2490 Heritage Park Row San Diego CALIFORNIA 92110
	(LAST LISTED OWNER) AVID CENTER CORPORATION 5120 Shoreham Place, Ste. 120 San Diego CALIFORNIA 92122
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	KATHERINE M. HOFFMAN
Type of Mark Register	TRADEMARK PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).
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Typed Drawing

Word Mark AVID PRESS
Goods and Services IC 016. US 002 005 022 023 029 037 038 050. G & S: Educational publications, namely, training manuals in the field of secondary school subjects (English, English as a second language, mathematics, science, social science, world languages) and college preparatory materials. FIRST USE: 20001100. FIRST USE IN COMMERCE: 20001100
Mark Drawing Code (1) TYPED DRAWING
Design Search Code
Serial Number 76308309
Filing Date September 4, 2001
Current Filing Basis 1A
Original Filing Basis 1A;1B
Published for Opposition April 22, 2003
Registration Number 2735956
Registration Date July 15, 2003
Owner (REGISTRANT) AVID Center NONPROFIT PUBLIC BENEFIT CORPORATION CALIFORNIA 5120 Shoreham Place Suite 120 SAN DIEGO CALIFORNIA 92122
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record KATHERINE M HOFFMAN
Prior Registrations 2372132;2386964;2533626
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Type of Mark TRADEMARK

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