

ESTTA Tracking number: **ESTTA278321**

Filing date: **04/15/2009**

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	Fonality, Inc.
Granted to Date of previous extension	04/15/2009
Address	200 Corporate Pointe Los Angeles, CA 90230 UNITED STATES

Attorney information	James L. Vana and Brian R. Coleman Perkins Coie, LLP 1201 3rd Ave. Suite 4800 Seattle, WA 98101 UNITED STATES pctrademarks@perkinscoie.com Phone:(206) 359-3036
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Applicant Information

Application No	77155114	Publication date	12/16/2008
Opposition Filing Date	04/15/2009	Opposition Period Ends	04/15/2009
International Registration No.	NONE	International Registration Date	NONE
Applicant	TELEFONICA, S.A. Gran Via, 28 Madrid, 28013 SPAIN		

Goods/Services Affected by Opposition

<p>Class 009. All goods and services in the class are opposed, namely: Computer programs, namely, computer operating programs for buying, downloading, reproducing, transferring, exporting and cataloging, music, films and TV series, in their pay per view or monthly payment form</p>
<p>Class 035. All goods and services in the class are opposed, namely: Retail store services featuring computers, software, telephone apparatus, MP3 digital music players, tape recorders, disc recorders, video and audio cassette recorders, CD-ROMs and DVD recorders and players, stereo amplifiers, stereo receivers, television displays, radio tuners, radio receivers, loudspeakers, pagers, remote email transceivers; on-line retail store services featuring computers, electronically dischargeable software, telephone apparatus, MP3 digital music players, tape recorders, disc recorders, video and audio cassette recorders, CD-ROMs and DVD recorders and players, stereo amplifiers, stereo receivers, television displays, radio tuners, radio receivers, loudspeakers, pagers, remote email transceivers</p>
<p>Class 038. All goods and services in the class are opposed, namely: Telecommunication services, namely,</p>

telecommunication access services, television, cable television, subscription television and radio broadcasting services, video broadcasting, satellite television broadcasting; communications by means of radio, via satellite, by cable, via fiber optic networks, by computer terminals, namely, transmission of data, sound, images and messages by means of satellite, cable and radio transmissions, communications by means of fiber optic communications networks, and communications by means of computer terminals; radio and television program broadcasting, namely, radio and television broadcasting


Class 041.

All goods and services in the class are opposed, namely: Entertainment, amusement, diversion and recreation services for individuals, namely, entertainment in the nature of competitions in the field of all kind sports, athletics, motor racing, horseback riding, sailing; entertainment in the nature of on-going television programs in the field of comedy, news, variety and music; entertainment in the nature of on-going radio programs in the field of news, comedy, variety and music; providing facilities for recreation activities, magic shows, light shows, music concerts, films and theatre plays; management of on line electronic publications not electronically dischargeable, namely, providing non-downloadable publications in the nature of books, magazines, periodicals in the field of entertainment, amusement, diversion and recreation


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3263210	Application Date	03/30/2006
Registration Date	07/10/2007	Foreign Priority Date	NONE
Word Mark	TRIXBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/03/01 First Use In Commerce: 2006/03/01 Computer software for enabling voice-over-Internet-protocol (VoIP) communications; computer software in the field of telecommunications, namely, Private Branch Exchange (PBX) systems comprised of telephones, IP telephones, computer servers, and telephone switchboards and exchangers; computer software programs for use in integrating computer telephony in the field of computer networks		

U.S. Registration No.	3303300	Application Date	12/13/2006
Registration Date	10/02/2007	Foreign Priority Date	NONE

Word Mark	TRIXBOX
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2006/12/01 First Use In Commerce: 2006/12/01 Computer hardware and software in the field of telecommunications, namely, Private Branch Exchange (PBX) systems comprised of telephones, IP telephones, computer servers, and telephone switchboards and exchangers; Computer software programs for use in integrating computer telephony in the field of computer networks; Computer software programs for managing and integrating call center queues; Computer software for enabling voice-over-Internet-protocol (VoIP) communications

U.S. Registration No.	3328944	Application Date	03/28/2007
Registration Date	11/06/2007	Foreign Priority Date	NONE

Word Mark	TRIXBOX
Design Mark	
Description of Mark	The mark consists of the lowercase mark TRIXBOX, where TRIX is gray, BOX is green, the "dot" over the "i" is a green diamond and the "O" is a green diamond.
Goods/Services	Class 009. First use: First Use: 2007/05/01 First Use In Commerce: 2007/05/01 Computer hardware for telephony and telecommunication applications; computer hardware, appliances and software in the field of telecommunications, namely, Private Branch Exchange (PBX) systems comprised of telephones, IP telephones, computer servers, and telephone switchboards and exchangers; Computer software programs for use in integrating computer telephony in the field of computer networks; Computer software programs for managing and integrating call center queues; Computer software for enabling voice-over-Internet-protocol (VoIP) communications Class 038. First use: First Use: 2007/05/01 First Use In Commerce: 2007/05/01 Telephony services, namely managing and integrating call center queues; providing on-line forums for transmission of messages among computer users concerning telecommunication and open source software

Related Proceedings	This opposition is being filed as a combined notice of opposition and petition for cancellation. The cancellation relates to Registration No. 3317988
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Attachments	78850129#TMSN.jpeg (1 page)(bytes) 77063064#TMSN.jpeg (1 page)(bytes)
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	77143111#TMSN.jpeg (1 page)(bytes) Fonality, Inc. Combined Notice of Opposition & Cancellation Petition.pdf (24 pages)(826092 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/James L. Vana/
Name	James L. Vana
Date	04/15/2009

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

FONALITY INC.,)	
)	
Opposer,)	COMBINED NOTICE OF OPPOSITION AND PETITION FOR CANCELLATION
)	
v.)	Mark: PIXBOX
)	Application Serial No. 77/155114
TELEFONICA, S.A. CORP.,)	Filed: April 12, 2007
)	Published: December 16, 2008
Applicant.)	and
)	Registration No. 3317988
)	Registered: October 23, 2007

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

Fonality, Inc. ("Opposer"), by and through its undersigned attorneys, believes that it will be damaged (a) by the registration of the mark PIXBOX ("Applicant's Mark") by Telefonica S.A. Corp. ("Applicant") with those goods and services ("Applicant's Goods and Services") listed in U.S. Trademark Application Serial No. 77/155114 (the "Application") , and (b) by the continued registration of Applicant's Mark by Applicant with Applicant's Services listed in Registration No. 3317988 ("Applicant's Registration"). Opposer therefore opposes the Application and petitions to cancel Applicant's Registration. As grounds for its combined opposition and cancellation, Opposer alleges as follows:

I. PARTIES

1. Opposer is a Delaware Corporation having its principal place of business at 6133 Bristol Pawkway, Suite 150, Culver City, California 90230.

2. Upon information and belief, Applicant is a Spanish Corporation, with an address of Gran Via, 28 Madrid, Spain 28013.

II. OPPOSER'S MARKS, GOODS, AND SERVICES

3. Opposer is the owner of U.S. Registrations No. 3263210, No. 3303300, and No. 3328944 (together, "Opposer's Registrations") for the mark TRIKBOX ("Opposer's Marks"). Soft copies of the registration certificates for Opposer's Registrations are included at Exhibit A attached hereto.
4. Opposer's Marks cover those goods and services ("Opposer's Goods and Services") listed in Opposer's Registrations.
5. Opposer provides a variety of goods and services under Opposer's Marks, including, *inter alia*, computer software for enabling voice-over-internet-protocol communications, computer software in the field of telecommunications, computer hardware, appliances, and software for telephony and telecommunication applications, telephony services, providing on-line forums for transmission of messages among computer users concerning telecommunication and open source software, computer software for use in integrating computer telephony in the field of computer networks, etc.
6. Application Serial No. 78850129, which matured into Opposer's Registration No. 3263210, was filed by Opposer on March 30, 2006.
7. Application Serial No. 77063064, which matured into Opposer's Registration No. 3303300, was filed by Opposer on December 13, 2006.

8. Application Serial No. 77143111, which matured into Opposer's Registration No. 3328944, was filed by Opposer on March 28, 2007.

III. APPLICANT'S MARK, GOODS AND SERVICES

9. Upon information and belief, the Application was filed on April 12, 2007 ("Applicant's Second Filing Date). Applicant claimed a priority date of March 22, 2007 based on Applicant's Spanish national application No. 2.762.653 ("Applicant's Second Foreign Application"). The Application was published for opposition in the Official Gazette on December 16, 2008.
10. Upon information and belief, Applicant seeks to register the Applicant's Mark for goods and services identified as "[c]omputer programs, namely, computer operating programs for buying, downloading, reproducing, transferring, exporting and cataloging, music, films and TV series, in their pay per view or monthly payment form" in International Class 9, "[r]etail store services featuring computers, software, telephone apparatus, MP3 digital music players, tape recorders, disc recorders, video and audio cassette recorders, CD-ROMs and DVD recorders and players, stereo amplifiers, stereo receivers, television displays, radio tuners, radio receivers, loudspeakers, pagers, remote e-mail transceivers; on-line retail store services featuring computers, electronically dischargeable software, telephone apparatus, MP3 digital music players, tape recorders, disc recorders, video and audio cassette recorders, CD-ROMs and DVD recorders and players, stereo amplifiers, stereo receivers, television displays, radio tuners, radio receivers, loudspeakers, pagers, remote e-mail transceivers" in International Class 35, "[t]elecommunication services,

namely, telecommunication access services, television, cable television, subscription television and radio broadcasting services, video broadcasting, satellite television broadcasting; communications by means of radio, via satellite, by cable, via fiber optic networks, by computer terminals, namely transmission of data, sound, images and messages by means of satellite, cable and radio transmissions, communications by means of fiber optic communications networks, and communications by means of computer terminals; radio and television program broadcasting, namely radio and television broadcasting" in International Class 38, and "[e]ntertainment, amusement, diversion and recreation services for individuals, namely, entertainment in the nature of competitions in the fields of all kinds of sports, athletics, motor racing, horseback riding, sailing; entertainment in the nature of on-going television programs in the fields of comedy, news, variety and music; entertainment in the nature of on-going radio programs in the fields of news, comedy, variety and music; providing facilities for recreation activities, magic shows, light shows, music concerts, films and theatre plays; providing on-line non-downloadable publications in the form of electronic books, magazines, and periodicals in the fields of entertainment, amusement, diversion and recreation" in International Class 41 ("Applicant's Goods and Services").

11. Upon information and belief, application Serial No. 78918099 was filed by Applicant on June 7, 2006 ("Applicant's First Filing Date). Applicant claimed a priority date of January 26, 2006 based on Applicant's Spanish national application No. 2.691.262 ("Applicant's First Foreign Application"). That application matured to registration on October 23, 2007

12. Upon information and belief, Applicant has not used Applicant's Mark in commerce with any of Applicant's Goods and Services prior to Applicant's Filing Date.
13. Upon information and belief, Applicant has not used Applicant's Mark in commerce with any of Applicant's Goods and Services on or after Applicant's Filing Date.

IV. PLEADING HISTORY

14. On December 16, 2008, Opposer filed a request to extend the time to oppose registration of Applicant's Mark. The Trademark Trial and Appeal Board granted Opposer's request, resetting Opposer's deadline to file a Notice of Opposition to April 15, 2009. *See* Exhibit B attached herewith.

V. LIKELIHOOD OF CONFUSION CLAIM

15. Opposer's Marks are distinctive for Opposer's Goods and Services.
16. Opposer has continuously used Opposer's Marks since at least as early as December, 2005.
17. Opposer has not abandoned Opposer's Marks in connection with any of Opposer's Goods and Services.
18. Opposer has spent a considerable amount of money marketing its various products and services under the Opposer's Marks, and the mark is of significant value to Opposer as an identifier of source in connection with Opposer's Goods and Services.
19. Opposer's Marks and Applicant's Mark are highly similar: **TRIXBOX** and **PIXBOX**.

Applicant has previously admitted to the similarity of the Opposer's Marks and the Applicant's Mark. *See* Exhibit C attached herewith. Exhibit C is a copy of a Notice of Opposition ("European Opposition Notice") filed by Applicant to oppose Opposer's registration of the TRIXBOX mark in the European Union. In this European Opposition Notice, Applicant expressly states as follows: "[a]s can be easily appreciated from a visual point of view, the similarity of both Marks is striking," "both marks have an almost identical pronunciation," and "as a result of the quasi identify of the signs, it is evident that the conflicting marks will be confusingly IDENTICAL/SIMILAR and will imply an unavoidable risk of confusion, association and error in the mind of consumers." *Id.* If this is true, Opposer's Marks and Applicant's Mark are highly similar for at least the reasons alleged by Applicant in the European Opposition Notice.

20. Applicant's Goods and Services are related to Opposer's Goods and Services.
21. Applicant's Application was filed on April 12, 2007. This is well after Opposer's earliest priority date of December, 2005.
22. Applicant's Registration resulted from an application filed on June 27, 2006. This is well after Opposer's earliest priority date of December, 2005.
23. Opposer has priority of use in commerce.
24. Applicant's use of Applicant's Mark in connection with Applicant's Goods and Services will result in confusion, mistake, and/or deception in that the public will wrongly assume that Opposer has approved of Applicant, is affiliated with Applicant, or has otherwise

sanctioned, sponsored, or licensed Applicant's Goods and Services.

25. Opposer would be damaged by the registration and continued registration of Applicant's Mark as the registration will result in confusion, mistake, and/or deception, and Applicant will be able to trade on Opposer's goodwill and reputation and will thus be unjustly enriched.
26. Opposer will also be damaged by registration and continued registration of Applicant's Mark because such registration will support statutory rights for Applicant in violation and derogation of Opposer's prior, superior, and exclusive rights in Opposer's Marks.

VI. FRAUD CLAIM

27. In filing Applicant's Application, Applicant verified that it had a *bona fide* intent to use Applicant's Mark in commerce.
28. In filing the application that matured into Applicant's Registration, Applicant verified that it had a *bona fide* intent to use Applicant's Mark in commerce.
29. Under the Federal Lanham Act, "commerce" means all commerce which may lawfully be regulated by Congress. 15 U.S.C. § 1127.
30. Such commerce does not include commerce exclusively outside the United States.
31. Exhibit D is a copy of a "Legal Notice" section posted by Applicant in <http://www.terra.es/pixbox/>, which describes Applicant's PIXBOX services as "Music

and Video content streaming and download services."

32. As indicated in Exhibit D, Applicant expressly declares that use of the services identified in Paragraph 28 is strictly restricted for commerce in Spain.

33. On information and belief, Applicant has never offered any product or service in commerce under Applicant's Mark.

34. On information and belief, Applicant has at no time had an intent to offer in commerce any product or service under Applicant's Mark.

35. On information and belief, as of Applicant's First Filing Date, Applicant did not have a *bona fide* intent to use in commerce any of the following services:

- Class 35: Retail store services featuring computers, software, telephone apparatus, MP3 digital music players, tape recorders, disc recorders, video and audio cassette recorders, CD-ROMs and DVD recorders and players, stereo amplifiers, stereo receivers, television displays, radio tuners, radio receivers, loudspeakers, pagers, remote email transceivers; on-line retail store services featuring computers, electronically dischargeable software, telephone apparatus, MP3 digital music players, tape recorders, disc recorders, video and audio cassette recorders, CD-ROMs and DVD recorders and players, stereo amplifiers, stereo receivers, television displays, radio tuners, radio receivers, loudspeakers, pagers, remote email transceivers

- **Class 38: Telecommunication services, namely, telecommunication access services, television, cable television, subscription television and radio broadcasting services, video broadcasting, satellite television broadcasting; communications by means of radio, via satellite, by cable, via fiber optic networks, by computer terminals, namely, transmission of data, sound, images and messages by means of satellite, cable and radio transmissions, communications by means of fiber optic communications networks, and communications by means of computer terminals; radio and television program broadcasting, namely, radio and television broadcasting**
- **Class 41: Entertainment, amusement, diversion and recreation services for individuals, namely, entertainment in the nature of competitions in the field of all kind sports, athletics, motor racing, horseback riding, sailing; entertainment in the nature of on-going television programs in the field of comedy, news, variety and music; entertainment in the nature of on-going radio programs in the field of news, comedy, variety and music; providing facilities for recreation activities, magic shows, light shows, music concerts, films and theatre plays; management of on line electronic publications not electronically dischargeable, namely, providing non-downloadable publications in the nature of books, magazines, periodicals in the field of entertainment, amusement, diversion and recreation**

36. On information and belief, as of Applicant's Second Filing Date, Applicant did not have a *bona fide* intent to use in commerce any of the services identified in Paragraph 35, above.

37. A trademark application not claiming use of the mark in commerce with the goods or services identified in the application as a filing basis must include a claim that the applicant has a *bona fide* intent to use the mark in commerce with the goods or services identified in the application.
38. A representation by an applicant to the Trademark Office that the applicant has a *bona fide* intent to use the mark in commerce with the goods or services identified in the application is material to the Trademark Office.
39. Applicant's representation that it had a *bona fide* intent to use Applicant's Mark in commerce with all of the goods and services listed in Applicant's Application was not true, and thus was a misrepresentation.
40. Applicant's representation that it had a *bona fide* intent to use Applicant's Mark in commerce with all of the goods and services listed in Applicant's Application was a material misrepresentation.
41. Applicant's material misrepresentation that Applicant had a *bona fide* intent to use Applicant's Mark in commerce with all of the goods and services listed in Applicant's Application was reasonably relied on by the U.S. Trademark Office in determining that the application claimed a valid filing basis.



42. Applicant's material misrepresentation, reasonably relied on by the Trademark Office, constitutes fraud upon the Trademark Office in connection with the filing of Applicant's Application.

VII. REQUEST FOR RELIEF

WHEREFORE, Opposer requests (a) that the mark in Application Serial No. 77/155114 be denied registration in International Classes 9, 35, 38, and 41, and (b) that Registration No. 3317988 be cancelled in Classes 35, 38, and 41.

DATED: April 15, 2009

Respectfully submitted,

<p style="text-align: center;">CERTIFICATE OF SERVICE</p> <p>I hereby certify that a true and complete copy of the foregoing COMBINED NOTICE OF OPPOSITION AND PETITION FOR CANCELLATION has been served on Telefonica, S.A. Corp. via Counsel of Record Perla M. Kuhn, by mailing said copy on April 15, 2009 via Federal Express Overnight Service to: 1 Battery Park Plz, Hughes Hubbard & Reed LLP, New York, NY 10004</p> <p>Signature: <u></u></p> <p>Printed Name: <u>Linda L. Martin</u></p>	<p style="text-align: center;">PERKINS COIE LLP</p> <p>By <u></u></p> <p>Brian R. Coleman James L. Vana Perkins Coie LLP 1201 3rd Ave. Seattle, Washington 98101 (206) 359-3036 (206) 359-4036 (Fax) Attorneys for Fonality, Inc.</p>
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Int. Cl.: 9

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

United States Patent and Trademark Office

Reg. No. 3,303,300

Registered Oct. 2, 2007

TRADEMARK
PRINCIPAL REGISTER

The logo for Trixbox, featuring the word "trixbox" in a bold, lowercase, sans-serif font. The letter "i" has a small asterisk above it. The "x" at the end of "trix" and the "x" at the end of "box" are stylized with a double-stroke effect.

FONALITY, INC. (DELAWARE CORPORATION)
SUITE 350 CORPORATE POINTE
LOS ANGELES, CA 90230

FOR: COMPUTER HARDWARE AND SOFTWARE IN THE FIELD OF TELECOMMUNICATIONS, NAMELY, PRIVATE BRANCH EXCHANGE (PBX) SYSTEMS COMPRISED OF TELEPHONES, IP TELEPHONES, COMPUTER SERVERS, AND TELEPHONE SWITCHBOARDS AND EXCHANGERS; COMPUTER SOFTWARE PROGRAMS FOR USE IN INTEGRATING COMPUTER TELEPHONY IN THE FIELD OF COMPUTER NETWORKS; COMPU-

TER SOFTWARE PROGRAMS FOR MANAGING AND INTEGRATING CALL CENTER QUEUES; COMPUTER SOFTWARE FOR ENABLING VOICE-OVER-INTERNET-PROTOCOL (VOIP) COMMUNICATIONS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 12-1-2006; IN COMMERCE 12-1-2006.

SN 77-063,064, FILED 12-13-2006.

ELIZABETH KAJUBI, EXAMINING ATTORNEY

Int. Cl.: 9

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

United States Patent and Trademark Office

Reg. No. 3,263,210

Registered July 10, 2007

**TRADEMARK
PRINCIPAL REGISTER**

TRIXBOX

**FONALITY INC. (DELAWARE CORPORATION)
SUITE 150 6133 BRISTOL PARKWAY
CULVER CITY, CA 90230**

**FOR: COMPUTER SOFTWARE FOR ENABLING
VOICE-OVER-INTERNET-PROTOCOL (VOIP) COM-
MUNICATIONS; COMPUTER SOFTWARE IN THE
FIELD OF TELECOMMUNICATIONS, NAMELY,
PRIVATE BRANCH EXCHANGE (PBX) SYSTEMS
COMPRISED OF TELEPHONES, IP TELEPHONES,
COMPUTER SERVERS, AND TELEPHONE
SWITCHBOARDS AND EXCHANGERS; COMPU-
TER SOFTWARE PROGRAMS FOR USE IN INTE-
GRATING COMPUTER TELEPHONY IN THE**

**FIELD OF COMPUTER NETWORKS, IN CLASS 9
(U.S. CLS. 21, 23, 26, 36 AND 38).**

FIRST USE 3-1-2006; IN COMMERCE 3-1-2006.

**THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.**

SN 78-850,129, FILED 3-30-2006.

**ALEXANDER L. POWERS, EXAMINING ATTOR-
NEY**

Int. Cls.: 9 and 38

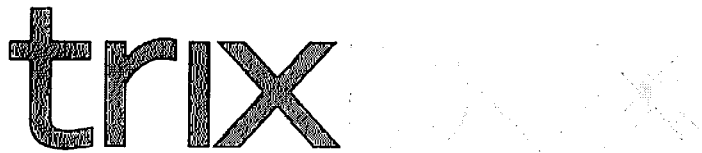
Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101 and 104

United States Patent and Trademark Office

Reg. No. 3,328,944

Registered Nov. 6, 2007

TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER



FONALITY, INC. (DELAWARE CORPORATION)
SUITE 350
200 CORPORATE POINTE
LOS ANGELES, CA 90230

FOR: COMPUTER HARDWARE FOR TELEPHONY AND TELECOMMUNICATION APPLICATIONS; COMPUTER HARDWARE, APPLIANCES AND SOFTWARE IN THE FIELD OF TELECOMMUNICATIONS, NAMELY, PRIVATE BRANCH EXCHANGE (PBX) SYSTEMS COMPRISED OF TELEPHONES, IP TELEPHONES, COMPUTER SERVERS, AND TELEPHONE SWITCHBOARDS AND EXCHANGERS; COMPUTER SOFTWARE PROGRAMS FOR USE IN INTEGRATING COMPUTER TELEPHONY IN THE FIELD OF COMPUTER NETWORKS; COMPUTER SOFTWARE PROGRAMS FOR MANAGING AND INTEGRATING CALL CENTER QUEUES; COMPUTER SOFTWARE FOR ENABLING VOICE-OVER-INTERNET-PROTOCOL (VOIP) COMMUNICATIONS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 5-1-2007; IN COMMERCE 5-1-2007.

FOR: TELEPHONY SERVICES, NAMELY MANAGING AND INTEGRATING CALL CENTER QUEUES; PROVIDING ON-LINE FORUMS FOR TRANSMISSION OF MESSAGES AMONG COMPUTER USERS CONCERNING TELECOMMUNICATION AND OPEN SOURCE SOFTWARE, IN CLASS 38 (U.S. CLS. 100, 101 AND 104).

FIRST USE 5-1-2007; IN COMMERCE 5-1-2007.

THE COLOR(S) GRAY AND GREEN IS/ARE CLAIMED AS A FEATURE OF THE MARK.

THE MARK CONSISTS OF THE LOWERCASE MARK TRIXBOX, WHERE TRIX IS GRAY, BOX IS GREEN, THE "DOT" OVER THE "I" IS A GREEN DIAMOND AND THE "O" IS A GREEN DIAMOND.

SER. NO. 77-143,111, FILED 3-28-2007.

VIVIAN MICZNIK FIRST, EXAMINING ATTORNEY

ESTTA Tracking number: **ESTTA255376**

Filing date: **12/16/2008**

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

Applicant: **TELEFONICA, S.A.**
Application Serial Number: **77155114**
Application Filing Date: **04/12/2007**
Mark: **PIXBOX**
Date of Publication **12/16/2008**

First 90 Day Request for Extension of Time to Oppose for Good Cause

Pursuant to 37 C.F.R. Section 2.102, Fonality, Inc., 200 Corporate Pointe, Los Angeles, CA 90230, UNITED STATES, a corporation organized under the laws of Delaware, respectfully requests that it be granted a 90-day extension of time to file a notice of opposition against the above-identified mark for cause shown.

Potential opposer believes that good cause is established for this request by:

- The potential opposer needs additional time to investigate the claim

The time within which to file a notice of opposition is set to expire on 01/15/2009. Fonality, Inc. respectfully requests that the time period within which to file an opposition be extended until 04/15/2009.

Respectfully submitted,

/brian r. coleman/

12/16/2008

Brian R. Coleman

Perkins Coie, LLP

101 Jefferson Drive

Menlo Park, CA 94025

UNITED STATES

coleb@perkinscoie.com

6508384441

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Brian R. Coleman
Perkins Coie, LLP
101 Jefferson Drive
Menlo Park, CA 94025

Mailed: December 16, 2008

Serial No.: 77155114
ESTTA TRACKING NO: ESTTA255376

The request to extend time to oppose is granted until
4/15/2009 on behalf of potential opposer **Fonality, Inc.**

Please do not hesitate to contact the Trademark Trial and
Appeal Board at (571)272-8500 if you have any questions
relating to this extension.

New Developments at the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to
oppose, notices of opposition, petition for cancellation, notice
of ex parte appeal, and inter partes filings are now available
at <http://estta.uspto.gov>. Images of TTAB proceeding files can
be viewed using TTABVue at <http://ttabvue.uspto.gov>.

TRADEMARK TRIAL AND APPEAL BOARD RULE CHANGES

The USPTO has issued new rules pertaining to TTAB
proceedings. Parties are urged to familiarize themselves
with the new rules.

Among other changes, for any notice of opposition filed on
or after November 1, 2007, the new rules require an opposer
to provide proof of service of the notice of opposition
upon the applicant at the time the notice of opposition is
filed. Trademark Rule 2.101. (Parallel amendments to
Trademark Rule 2.111 require a petitioner to include proof
of service of the petition for cancellation.) Service may
be made by any of the means set out in Trademark Rule

2.119(b). A certificate of service is adequate proof of service; service by a process server is not necessary. A notice of opposition (or petition for cancellation) filed without a certificate of service will not be instituted.

The notice of final rulemaking and a chart summarizing the changes contained in the notice are available for viewing on the TTAB web page:

www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf

www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

Notice of Opposition

Number of pages (including this one)	9	Opponent's/ Representative reference	23800072 / FB
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Opponents

ID number

Multiple opponents

Name of legal entity or first name and surname

TELEFONICA, S.A.

Address

Street and number

GRAN VIA, 28

City and postal

28013 Madrid

Country

SPAIN

Postal address

Nationality

SPANISH

Representative

ID number

1014

Name

JAVIER UNGRIA

Type of representative

professional representative

Challenged application

CTM/ IR No. 5959697

Date of publication 22.10.2007

Language of the Opposition ES DE EN FR IT

Name of CTM applicant or IR holder

Fonality Inc.

Extent of the opposition

against all the goods and services in the application

against part of the goods and services in the application, namely:

Payment of fees

Total € 350.-

Signature



Current account with OHIM

Account No. 000147

Name

JAVIER UNGRIA

Date

21 January 2008

DECLARATION

I, JAVIER UNGRIA, professional representative with ID number 1014 do hereby declare that the attached reproduced copies are extracts obtained from the Spanish Trade Mark Office database and show the current status of the prior opposing marks on which this opposition is based, which it is fully in force on the current date.

Madrid, 21 January 2008

JAVIER UNGRIA



EXPLANATION OF GROUNDS

Taking into account the definition established in Article 8.2.a (ii) of the Council Regulation (EC) 40/90 of 20 December 1993, whereby it is established that "prior mark" is understood as:

8.2. "Earlier mark means:

a) Trade marks of the following kinds with a date of application for registration which is earlier than the date of application for registration of Community trade mark, taking into account, where appropriate, of the priorities claimed in respect of those trade marks.

b) Trade mark registered in a Member State..."

We hereby file the present opposition based on the fact that the Community trade mark application no. 5959697 "TRIXBOX" falls within the prohibition established in Article 8.1. b) of the above-mentioned Regulation, which in connection with the above matter provides:

8.1.b) "If because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks, there exist a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected..."

And by reason of the following:

1. IDENTITY/SIMILARITY OF SIGNS:

The applied Community trademark no. 5959697 "TRIXBOX" is confusingly SIMILAR to our Client's existing prior Spanish Registration, as it can be clearly seen from the following comparison:

PIXBOX	TRIXBOX
Prior Registration	CTM application

As it can be easily appreciated from a visual point of view, the similarity of both Marks is striking, considering that the mark for which the applicant seeks protection, shares with the prior registration of our client, 5 letters of 6, placed all of them in identical order. Additionally, both marks have an almost identical pronunciation. For instance, the prior mark will be pronounced *pix box* whereas the applied CTM would be also *trix box*, noting that the last part of the word elements of the marks are identical, and the first part is phonetically very similar, since the terms PIX and TRIX are composed dominantly by the letters I and X.

Additionally, as stated by the OHIM in some cases the relevance of the beginning of the sign has less weight to the benefit of a more relevant *end or final* part. In this sense, please see Resolution 1670/2001 EN NORVIR NOVIRIO and 174/2000 EN GASTROMIL GASTROBIN.

From a conceptual point of view, we note that the first part of the marks, i.e. PIX and TRIX are fanciful signs and thus no conceptual comparison is needed on this regard. However, the last part of the signs is identical and refers to a BOX which means *a case or receptacle usually having a lid*.

As to the present case, and as a result of the quasi identity of the signs, it is evident that the conflicting marks will be confusingly IDENTICAL/SIMILAR and will imply an unavoidable risk of confusion, association and error in the mind of the consumers if they coexist in the European Market.

2. SIMILARITY OF GOODS AND SERVICES:

The above stated is all the more true if we take into account the services respectively covered by each mark under study.

The present opposition is directed against goods and services included within classes 9, 38, 41 and 42 of the CTM application.

The goods claimed by the prior marks are included in classes 9, 35, 38 and 41.

It is obvious that the products protected by the prior Trademark could be confused and related with those now applied for, taking into account that these services claimed by the contested CTM share the same distribution channels, have all the same nature and for this reason, a well-informed consumer would confuse them.

Hence, considering that the products claimed in classes 9, 38 and 41 by the CTM application are identical to the specification of goods for which the earlier Trade mark is protected in classes 9, 38 and 41, and the services claimed in class 42 are *similar* to those claimed in classes 9 and 38, since they share the same nature, and the goods which will be marketed under the services of such class 42 are those claimed by the prior mark in class 9, namely, software, which by the way are related to computers and goods related thereto, as well as telecommunications which are also claimed in class 38 of the prior mark.

3. FORM OF ORDER SOUGHT

Based on the above arguments, we can conclude that the marks in conflict are confusingly identical/similar.

Hence, taking into account the existing identities/similarities found in the signs and the products of the CTM application and the prior trade mark, we can certainly conclude that a well-informed consumer will confuse the products of one undertaking from those of the other undertaking, and would think that this marks come from the same or economically linked companies.

For the reasons given above, and such others as may be adduced in the course of proceedings, we hereby respectfully request the Office to reject CTM application no. 5959697 "TRIXBOX" based on Rule 8.1.a) and b) of the Regulation.

We also respectfully request the Office to grant our client an award of costs as defined under Rule 94 of the Implementing Regulations if the opposition proceedings are deemed to commence and our request of rejection is accepted.

This party reserves the right to respond to the arguments to be brought forward by the Applicant, and to submit further arguments evidence if necessary or desirable.

pixbox El espacio de entretenimiento digital 24x7



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