

ESTTA Tracking number: **ESTTA303851**

Filing date: **08/31/2009**

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	GeorgeShokrola
Granted to Date of previous extension	08/30/2009
Address	11414 Thurston Circle Los Angeles, CA 90049-2435 UNITED STATES

Attorney information	Marc E Hankin Hankin Patent Law, A Professional Corporation 11414 Thurston Circle Los Angeles, CA 90049-2435 UNITED STATES marc@hankinpatentlaw.com Phone:(310) 892-1613
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Applicant Information

Application No	77537996	Publication date	03/03/2009
Opposition Filing Date	08/31/2009	Opposition Period Ends	08/30/2009
Applicant	XM Satellite Radio Inc. 1500 Eckington Place, N.E. Washington, DC 20002 UNITED STATES		

Goods/Services Affected by Opposition


Class 009. All goods and services in the class are opposed, namely: Digital audio radio receivers, parts and accessories, namely, headphones, remote controllers, adapter kits comprising an antenna, DC power adapter and cable used for connecting the receiver to car audio apparatus, and adapter kits comprising an antenna, AC power adapter and cable used for connecting the receiver to home audio apparatus
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3153229	Application Date	04/24/2005
Registration Date	10/10/2006	Foreign Priority	NONE

		Date	
Word Mark	XMMICRO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1997/01/01 First Use In Commerce: 1997/01/01 Computer accessories, namely, computer hardware; video game software, video game accessories, namely game consoles and electronic gaming consoles; blank DVD's and CD-ROM's for sound or video recording; digital cameras; headphones, audio speakers; television sets; computer monitors; VCR players; CD changer; cellular telephone; cellular accessories, namely, cell phone battery chargers, earphones; wireless accessories, namely, wireless earphones; computer devices, namely, computer storage jump drives, biometric security software, digital computer input scanner, USB hardware, printers, visual display unit, modems, and computer storage software; electronic computer mouse; MP3 and MP4 players, namely, media players; flash drives; flash memory card; USB flash drives; and memory cards		

Attachments	78615563#TMSN.jpeg (1 page)(bytes) XMICRO Notice of Opposition Trademark.pdf (5 pages)(25386 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	/Marc E. Hankin/
Name	Marc E Hankin
Date	08/31/2009

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

George Shokrola, an individual)	In re Application of: 77/537,996
)	
Opposer,)	For the Mark: XM MP3
)	
v.)	
)	Filed: August 4, 2008
XM Satellite Radio, Inc.)	
)	Published in the Trademark Official
Applicant,)	Gazette on: March 3, 2009
_____)	

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

NOTICE OF OPPOSITION

George Shokrola, an individual who may be contacted at 11414 Thurston Circle, Los Angeles, California 90049, believes that he will be damaged by the registration of the mark shown in the above-identified application, and hereby opposes the same.

The grounds for opposition are as follows:

1. Applicant filed an intent-to-use trademark application given Application Serial No. 77/537,996 in the United States Patent and Trademark Office (“USPTO”) on August 4, 2008 (the “Application”) to register the mark “XM MP3” (the “Applicant’s Mark”) for intended future use in International Class 009 in connection with “Digital audio radio receivers, parts and accessories, namely, headphones, remote controllers, adapter kits comprising an antenna, DC power adapter and cable used for connecting the receiver to car audio apparatus, and adapter kits comprising an antenna, AC power adapter and cable used for connecting the receiver to home audio apparatus.”
2. On information and belief, Applicant has not filed a Statement of Use for the Application.
3. On information and belief, Applicant has not yet made actual use of the

Applicant's Mark as a trademark with each of Applicant's goods.

4. The Application was Published for Opposition in the *Official Gazette* on March 3, 2009. On March 7, 2009, the Opposer timely filed a request for a 60-day extension of time to oppose the Application for Applicant's Mark, which was granted until May 2, 2009. On April 30, 2009, the Opposer timely filed a request for a 60-day extension of time to oppose the Application for Applicant's Mark, which was granted until July 1, 2009. Finally, on June 30, 2009, the Opposer timely filed a request for a 60-day extension of time to oppose the Application for Applicant's Mark, which was granted until August 30, 2009.
5. Opposer is the owner of U.S. Registered Trademark Number 3,153,229, for the mark "XMMICRO" ("the Opposer's Mark") filed with the USPTO on April 24, 2005 (the "Opposer's Filing Date") based upon a bona fide intention to use Opposer's Mark. On October 22, 2005, the Opposer filed proof with the USPTO of use of the Opposer's Mark with "Computer accessories, namely, computer hardware; video game software, video game accessories, namely game consoles, electronic gaming, consoles; DVD blank CD ROMS for sound or video recording; digital cameras; headphones, audio speakers; video discs, namely laser discs; television sets; Computer monitors; VCR players; CD changer; cellular telephone; cellular accessories, namely cell phones, cell chargers, ear pieces, wireless accessories namely wireless ear piece; Computer devices, namely, computer storage devices, biometric security device, computer input devices, USB devices, printers, visual display unit, modems, storage; Electronic computer mouse, namely mouse; MP3 and MP4 players, namely media player; Flash Drives; flash memory; USB flash drives; and memory cards" (the Opposer's Goods") and an Amendment to Allege Use of the Opposer's Mark with a date of first use and of first use in commerce of at least as early as January 1, 1997 (the "Opposer's First Use Dates"). The Opposer's Mark was granted registration on October 10, 2006 (the "Opposer's Registration Date") and was given U.S. Registration No. 3,153,229.
6. The Opposer, or his predecessor-in-interest, has used the Opposer's Mark in association with the Opposer's Goods in commerce since at least as early as

January 1, 1997 and the Opposer's Mark is currently in use in commerce with Opposer's Goods.

7. Through advertising and promotions, the Opposer's Mark has become recognized and relied upon by the relevant industry and purchasing public throughout the United States. As a result, the Opposer's Mark has become a valuable asset of the Opposer, representing the significant goodwill and reputation of the Opposer, the Opposer's business activities, and the Opposer's Goods.
8. The Opposer's Filing Date, the Opposer's Registration Date, and the Opposer's First Use Dates for the Opposer's Mark are earlier than the Applicant's filing date.
9. The Opposer's Filing Date, the Opposer's Registration Date, and the Opposer's First Use Dates for the Opposer's Mark are earlier than the Applicant's date of first use in commerce for the Applicant's Mark.
10. Priority is not an issue in this case because the Opposer's Filing Date, the Opposer's Registration Date, and the Opposer's First Use Dates for the Opposer's Mark all precede the Applicant's filing date and the Applicant's date of first use in commerce for the Applicant's Mark by several years.
11. The Applicant's Mark, "XM MP3" is substantially and confusingly similar to the Opposer's Mark, "XMMICRO". The registration of the Applicant's Mark would likely create confusion, mistake, or deception in the minds of prospective purchasers as to the origin or source of the Opposer's Goods associated with the Applicant's Mark.
12. The Applicant offers goods that are confusingly similar to the Opposer's Goods, including, but not limited to MP3 players.
13. The Opposer's Goods and Applicant's goods, both being electronics goods, travel in the same channels of trade and are viewed by the same customers, including, but not limited to those customers who buy MP3 players. Thus, the Applicant offers goods that are confusingly similar to the Opposer's Goods.
14. Purchasers familiar with the Opposer's Goods are likely to mistakenly believe that the Applicant's goods are sponsored by, authorized, endorsed, affiliated with, or otherwise approved by the Opposer because Applicant's Mark is substantially

and confusingly similar to the Opposer's Mark.

15. For the foregoing reasons, the registration sought by Applicant is contrary to the provisions of Section 2 of the Lanham Act, and Opposer believes that it would be damaged thereby.
16. WHEREFORE, Opposer respectfully requests that registration of the mark shown in Application Serial No. 77/537,996 be refused and that this Opposition be sustained in favor of Opposer.

Payment of the required fee of \$300.00 is made by credit card. Please charge any deficiency or credit any excess fee payment to Deposit Account No. 50-3514.

Opposer respectfully requests that all further communications pertaining to this Opposition be conducted with Applicant's attorney:

Marc E. Hankin
Hankin Patent Law, A Professional Corporation
11414 Thurston Circle
Los Angeles, CA 90049-2435
Marc@HankinPatentLaw.com
Cell: (310) 892-1613

Dated: August 31, 2009

Respectfully submitted,

/Marc E. Hankin/

Marc E. Hankin
USPTO Reg. No. 38,908

PROOF OF SERVICE

I am employed in the County of Los Angeles, State of California. I am over the age of eighteen years and not a party to the within action; my business address is 6404 Wilshire Blvd., Suite 1020, Los Angeles, CA 90211.

On August 31, 2009, I caused to be served a copy of the foregoing **NOTICE OF OPPOSITION** on Counsel for APPLICANT by placing a true and correct hard copy thereof enclosed in sealed envelopes addressed as follows:

Nancy S. Lapidus
Howrey LLP
1299 Pennsylvania Avenue, NW
Washington, DC 20004-2402
lapidusN@howrey.com

XX (BY MAIL) The envelope was mailed with postage thereon fully prepaid U.S. Mail. I am “readily” familiar with the firm’s practice of collection and processing correspondence for mailing. It is deposited with U.S. Postal Service or FED EX on that same day in the ordinary course of business.

___ (BY PERSONAL SERVICE) I delivered such envelope by hand to the office of the addressee listed above.

XX Via E-Mail to the e-mail address of the addressee listed above.

___ Via Facsimile to the fax number of the addressee listed above.

Date: August 31, 2009

/Jessica S. Bernstein/

Jessica S. Bernstein