

ESTTA Tracking number: **ESTTA480097**

Filing date: **06/26/2012**

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 | Western Digital Technologies, Inc. | | |
| Entity | Corporation | Citizenship | Delaware |
| Address | 3355 Michelson Drive, Suite 100 Irvine, CA 92612 UNITED STATES | | |

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|----------------------|--|--|--|
| Attorney information | Diane M. Reed Knobbe, Martens, Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@kmob.com, Bonnie.Gess@wdc.com Phone:949-760-0404 | | |
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Applicant Information

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|--------------------------------|--|---------------------------------|------------|
| Application No | 79096438 | Publication date | 06/05/2012 |
| Opposition Filing Date | 06/26/2012 | Opposition Period Ends | 07/05/2012 |
| International Registration No. | 1074557 | International Registration Date | 01/18/2011 |
| Applicant | GTB Global Trade Berlin GmbH Wielandstraße 27 12159 Berlin GERMANY | | |

Goods/Services Affected by Opposition


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| Class 009. All goods and services in the class are opposed, namely: Apparatus for recording, transmission or reproduction of sound and images, and parts and accessories, namely, memory cards and blank USB flash drives, and casings, namely, carrying cases and protective cases for tablet computers, personal computers, laptop computers, memory cards, USB flash drives, cameras, mp3 players, and mobile phones, and casing replacement parts thereof |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

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|-----------------------|------------|------------------|------------|
| U.S. Registration No. | 3062297 | Application Date | 06/18/2004 |
| Registration Date | 02/28/2006 | Foreign Priority | NONE |

| | | | |
|---------------------|--|------|--|
| | | Date | |
| Word Mark | WD | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 1996/00/00 First Use In Commerce: 1996/00/00 Computer products, namely hard drives | | |

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|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3130924 | Application Date | 09/23/2004 |
| Registration Date | 08/15/2006 | Foreign Priority Date | NONE |
| Word Mark | WD | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 2004/09/15 First Use In Commerce: 2004/09/15 Computer products, namely hard drives and disk drives | | |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3706865 | Application Date | 01/29/2009 |
| Registration Date | 11/03/2009 | Foreign Priority Date | NONE |
| Word Mark | WD TV | | |

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|---------------------|--|
| Design Mark | WD TV |
| Description of Mark | NONE |
| Goods/Services | Class 009. First use: First Use: 2008/11/03 First Use In Commerce: 2008/11/03 Computer hardware, set top boxes, media players, audio-visual accessories, namely, digital electronic devices for recording, transmitting, organizing, manipulating, receiving, playing and reviewing text, data, image, audio and video files; computer software for enabling the viewing and playing of audio, video, digital images and multimedia content, and computer software for transferring audio, video, digital images and multimedia content from a storage device to a television, monitor, projector, or other device for viewing or playing such audio, video, digital images or multimedia content |

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| Attachments | 78438064#TMSN.jpeg (1 page)(bytes) 78488844#TMSN.gif (1 page)(bytes) 77659719#TMSN.jpeg (1 page)(bytes) 2012-06-26 Notice of Opposition-WESDIGT.311M.PDF (6 pages)(177769 bytes) |
|-------------|--|

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 | /Diane M. Reed/ |
| Name | Diane M. Reed |
| Date | 06/26/2012 |

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


Western Digital Technologies, Inc.,

Opposer,

v.

GTB Global Trade Berlin GmbH

Applicant.

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) Opposition No.: _____
)
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) Serial No.: 79/096,438
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)
)
) Mark: 
)
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NOTICE OF OPPOSITION

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

Dear Sir or Madam:

Western Digital Technologies, Inc. (“Opposer”), located and doing business at 3355 Michelson Drive Suite 100, Irvine, California 92612, believes that it will be damaged by registration of the mark shown in U.S. Trademark Application Serial No. 79/096,438 (“the Application”) filed January 18, 2011 by GTB Global Trade Berlin GmbH (hereinafter referred to as “Applicant”), and hereby opposes the same.

A description of the Application is as follows:


Mark: 
Serial No.: 79/096,438
Filing Date: January 18, 2011
Publication Date: June 5, 2012
Goods: Apparatus for recording, transmission or reproduction of sound and images, and parts and accessories, namely, memory cards and blank USB flash drives, and casings, namely, carrying cases and protective cases for tablet computers,


personal computers, laptop computers, memory cards, USB flash drives, cameras, mp3 players, and mobile phones, and casing replacement parts thereof in International Class 09

As grounds for opposition, it is alleged:

1. Since at least as early as 1996, Opposer has used a family of names and marks containing the term WD, including the marks set forth in Paragraphs 2 through 4 below (collectively, the "WD Marks").

2. Opposer is the owner of and relies on U.S. Trademark Registration No. 3,062,297 (the "'297 Registration") for the mark WD for "computer products, namely hard drives" in International Class 09. The '297 Registration was filed on June 18, 2004 and issued on February 28, 2006. Thus, both the filing date and date of registration of the '297 Registration are prior to the filing date of the Application. By virtue of Opposer's compliance with the provisions of 15 U.S.C. § 1065, Opposer's right to use the WD mark shown in the '297 Registration is incontestable.

3. Opposer is the owner of and relies on U.S. Trademark Registration No. 3,130,924 (the "'924 Registration") for the mark  for "computer products, namely hard drives and disk drives" in International Class 09. The '924 Registration was filed on September 23, 2004 and issued on August 15, 2006. Thus, both the filing date and date of registration of the '924 Registration are prior to the filing date of the Application. By virtue of Opposer's compliance with the provisions of


15 U.S.C. § 1065, Opposer's right to use the  mark shown in the '924 Registration is incontestable.

4. Opposer is the owner of and relies on U.S. Trademark Registration No. 3,706,865 (the "'865 Registration") for the mark WD TV for "computer hardware, set top boxes, media players, audio-visual accessories, namely, digital electronic devices for recording, transmitting, organizing, manipulating, receiving, playing and reviewing text, data, image, audio and video files; computer

software for enabling the viewing and playing of audio, video, digital images and multimedia content, and computer software for transferring audio, video, digital images and multimedia content from a storage device to a television, monitor, projector, or other device for viewing or playing such audio, video, digital images or multimedia content” in International Class 09. The '865 Registration was filed on January 29, 2009 and issued on November 3, 2009. Thus, both the filing date and date of registration of the '865 Registration are prior to the filing date of the Application.


5. The '297, '924, and '865 Registrations are valid, subsisting, unrevoked and uncanceled; as such they constitute prima facie evidence of the validity of the registered marks and of the registrations thereof, and of Opposer's ownership of the marks shown therein and Opposer's exclusive right to use the marks in commerce in connection with the goods named therein, without condition or limitation. The '297, '924, and '865 Registrations also constitute notice to Applicant of Opposer's claim of ownership of the marks shown therein; all as provided in Section 7(b), 22 and 33(a) of the Trademark Act of 1946, as amended.

6. In view of the substantial similarity of the respective marks and the related nature of the goods of the respective parties, Applicant's mark as shown in the Application so resembles the registered WD Marks, previously used and registered in the United States and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive.

7. If Applicant is permitted to register the mark shown in the Application, Applicant's corresponding prima facie exclusive right to use the  mark in nationwide commerce will conflict with Opposer's lawful and prima facie exclusive right to use the WD Marks nationwide.

8. Since a date well prior to the filing date of the Application, Opposer has used the WD Marks in connection with the provision and advertisement of Opposer's goods. Such use has been valid and continuous, and has not been abandoned. As a result of this use, the relevant class of the public has come to associate Opposer with the family of WD Marks.

9. By reason of Opposer's widespread and continuous use of the WD Marks, in addition to the protection afforded to Opposer by the '297, '924, and '865 Registrations, Opposer has extensive, non-registered statutory and common law rights in the WD Marks.

10. In view of Opposer's prior statutory and common law rights in the WD Marks, Applicant is not entitled to register the  mark pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. Applicant's registration of the mark in U.S. Trademark Application Serial No. 79/096,438 will dilute the distinctive quality of the WD Marks within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. 1125(c), and will lessen the ability of the WD Marks to distinguish the goods of Opposer.

12. By reason of the foregoing, Opposer will be gravely damaged by registration of the mark shown in the Application because registration of this mark would be in violation of Opposer's trademark and trade name rights.

WHEREFORE, Opposer prays that U.S. Trademark Application Serial No. 79/096,438 be rejected and stricken, that no registration be issued thereon to Applicant, and this opposition be sustained in favor of Opposer.

Please charge Deposit Account No. 11-1410 for any fees which may be required, or credit any overpayment to this account.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

By: 

Dated: June 26, 2012

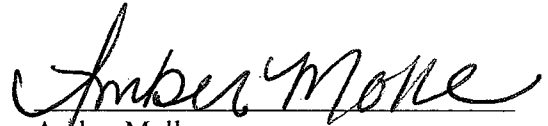
Diane M. Reed
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Irvine, CA 92614
(949) 760-0404
efiling@kmob.com

Attorneys for Opposer,
Western Digital Technologies, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on June 26, 2012, addressed as follows:

Michael M. Ballard
Workman Nydegger
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111


Amber Molle

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