

ESTTA Tracking number: **ESTTA493614**

Filing date: **09/10/2012**

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	Wind River Systems, Inc.
Granted to Date of previous extension	09/09/2012
Address	500 WIND RIVER WAY ALAMEDA, CA 94501 UNITED STATES

Attorney information	Ariana G. Hiscott, Esq. Cooley LLP 101 California St. Floor 5 San Francisco, CA 94111 UNITED STATES trademarks@cooley.com, ahiscott@cooley.com
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Applicant Information

Application No	85450640	Publication date	03/13/2012
Opposition Filing Date	09/10/2012	Opposition Period Ends	09/09/2012
Applicant	Australian Semiconductor Technology Company Pty Ltd 76 Waymouth Street Adelaide, 5000 AUSTRALIA		

Goods/Services Affected by Opposition

Class 009. First Use: 2011/03/01 First Use In Commerce: 2011/04/01 All goods and services in the class are opposed, namely: Computer software for use in digital computers, namely, simulation software for circuitry and electronic system applications in the nature of design and manufacturing in the areas of automotive, transportation, industrial control, communications, telecommunications, consumer electronics, and electrical systems
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1659595	Application Date	10/29/1990
Registration Date	10/08/1991	Foreign Priority Date	NONE
Word Mark	VXWORKS		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1984/12/14 First Use In Commerce: 1986/07/23 computer programs and instructional manuals sold as a unit with the programs for use in business, education, research and science

Attachments	Notice of Opposition - VWORKS - September 10 2012.pdf (13 pages)(104123 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	/Ariana G. Hiscott/
Name	Ariana G. Hiscott, Esq.
Date	09/10/2012

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

Wind River Systems, Inc.,

Opposer,

v.

Australian Semiconductor Technology
Company Pty Ltd,

Applicant.

Trademark: VWORKS

U.S. Serial No. 85450640

Filed: October 19, 2011

Published: March 13, 2012

Goods: Computer software for use in digital computers, namely, simulation software for circuitry and electronic system applications in the nature of design and manufacturing in the areas of automotive, transportation, industrial control, communications, telecommunications, consumer electronics, and electrical systems, In International Class 09

First Use Claimed: 03/01/2011

First Use in Commerce Claimed: 04/01/2011

NOTICE OF OPPOSITION

Opposer, Wind River Systems, Inc. (“Wind River”), a California corporation having its principal place of business at 1010 Atlantic Avenue Alameda, California, 94501, believes that it will be damaged by the issuance of a registration for the mark VWORKS, in Application Serial No. 85450640 (“Applicant’s Mark”), filed October 19, 2011 by Australian Semiconductor Technology Company Pty Ltd, an Australian Limited Liability Company, doing business at 76 Waymouth Street Adelaide, Australia (“Applicant”). Wind River hereby opposes Applicant’s application pursuant to Section 13 of the United States Trademark Act, as amended, 15 U.S.C. § 1063.

As grounds for its opposition, Opposer alleges as follows:

FACTUAL BACKGROUND:

Wind River Systems, Inc. and the VXWORKS Registration

1. Opposer is a world leader in embedded and mobile software and has pioneered computing inside embedded devices since 1981. Opposer offers the industry's most comprehensive device development portfolio and offers solutions that are hardware-agnostic so that they can be deployed on multiple architectures.
2. Since at least as early as July 23, 1986, Opposer has offered a computer program under the name VXWORKS in interstate commerce.
3. The VXWORKS computer program is a real-time operating system (OS) that is designed for use in embedded systems and is one of the most widely deployed operating systems in the world, powering more than one billion embedded systems.
4. The VXWORKS computer program is currently used by the Mars Science Laboratory rover Curiosity and has been used in several other high-profile NASA devices, including the 1994 Clementine Moon Probe, Mars Exploration Rovers and the Stardust spacecraft.
5. The VXWORKS computer program is also used in a plethora of other devices in the automotive, transportation, robotics, communications, telecommunications, and consumer electronics fields.
6. Opposer owns an incontestable U.S. federal trademark registration, No. 1659595, issued on October 8, 1991, for the mark VXWORKS in connection with "computer programs and instructional manuals sold as a unit with the programs for use in business, education, research and science" in International Class 09.
7. A true and correct copy of Opposer's registration certificate and the U.S. Patent and Trademark Office (USPTO) online Trademark Status page are attached here as Exhibit A, and are incorporated by reference as though fully set forth herein.

8. Opposer has continuously and exclusively used the VXWORKS Mark since at least as early as December 14, 1984 and in interstate commerce since at least as early as July 23, 1986.

Applicant and Its Pending VWORKS Application

9. Applicant seeks to register the word mark VWORKS in connection with “Computer software for use in digital computers, namely, simulation software for circuitry and electronic system applications in the nature of design and manufacturing in the areas of automotive, transportation, industrial control, communications, telecommunications, consumer electronics, and electrical systems” in International Class 09.
10. The application for Applicant’s Mark was filed on October 19, 2011 based on current use in interstate commerce and was published in the Official Gazette of the USPTO on March 13, 2012.
11. Opposer filed a Request for Extension of Time to Oppose on March 14, 2012 and was granted an extension until July 11, 2012.
12. Applicant consented to a further extension of time and Opposer filed a Request for Extension of Time to Oppose Upon Consent on July 10, 2012 and was granted an extension until September 9, 2012, which falls on a Sunday.
13. Applicant’s VWORKS Mark is substantially identical to Opposer’s federally registered VXWORKS Mark, missing only the letter X.
14. The goods that Applicant offers under Applicant’s VWORKS Mark are substantially similar and related to those provided by Opposer under the VXWORKS Mark, are used within the same industries and share target customers and channels of trade.

15. There is no issue as to priority of use. Opposer has priority over Applicant based on Opposer's prior use of the VXWORKS Mark in commerce and based on the filing and registration dates of its federal trademark registration, all of which pre-date Applicant's October 19, 2011 filing date, Applicant's claimed March 1, 2011 first use date and March 1, 2011 first use in interstate commerce date.

GROUND FOR OPPOSITION:

PRIORITY & LIKELIHOOD OF CONFUSION, 15 U.S.C. 1052

16. Opposer incorporates by reference paragraphs 1 through 15, inclusive, as if fully set forth here.
17. Pursuant to Section 2(d) of the Lanham Act, Applicant's Mark "comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive."
18. The VXWORKS Mark is distinctive and was first used in commerce and registered long prior to the first actual or constructive use of Applicant's VWORKS Mark.
19. Applicant's VWORKS Mark is substantially identical to the VXWORKS Mark in appearance, sound, meaning and commercial impression. Applicant's Mark is completely subsumed within Opposer's VXWORKS Mark for highly related computer programs.
20. The absence of the letter X in Applicant's VWORKS Mark is not sufficient to distinguish Applicant's Mark from Opposer's senior VXWORKS Mark.
21. The goods offered under Applicant's Mark, as identified in its application, are highly related to the goods offered by Opposer and would be used for the same types of devices.

22. Applicant offers its product through the same channels of trade as Opposer.
23. Applicant's Mark suggests an affiliation or connection between Applicant and Opposer, where none exists.
24. Opposer is not affiliated or connected with Applicant or its products, nor has Opposer endorsed or sponsored Applicant or its products.
25. Registration of Applicant's Mark will injure Opposer by causing the public to be confused or mistaken into believing that the goods provided by Applicant emanate from or relate to Opposer. Opposer has no control over the nature and quality of the goods offered by Applicant under Applicant's Mark, and Opposer's reputation and goodwill will be damaged and the value of the VXWORKS Mark jeopardized, all to Opposer's detriment. Further, any defect, objection or fault found with Applicant's goods marketed under Applicant's VWORKS Mark would necessarily reflect upon and injure the reputation that Opposer has established for the goods it offers in connection with the VXWORKS Mark.
26. Accordingly, registration of the mark herein opposed will damage Opposer because Applicant's mark is likely, when used on or in connection with the goods described in the opposed application, to cause confusion, or to cause mistake or to deceive. Thus Applicant's Mark is unregistrable under Sections 2(d) and 3 of the United States Trademark Act, as amended, 15 U.S.C. §§ 1052 and 1053, and should be refused registration.

WHEREFORE, Opposer prays that this Opposition be sustained, and that Application Serial No. 85/450,640 be refused registration.

In accordance with 37 C.F.R. §§ 2.101 and 2.6(a)(17), the fee of \$300.00 for one International Class are submitted herewith.

Dated: September 10, 2012

Respectfully submitted,
COOLEY LLP
JOHN W. CRITTENDEN
ARIANA G. HISCOTT

By: *Ariana G. Hiscott*

Ariana G. Hiscott
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Int. Cl.: 9

Prior U.S. Cl.: 38

United States Patent and Trademark Office

Reg. No. 1,659,595

Registered Oct. 8, 1991

**TRADEMARK
PRINCIPAL REGISTER**

VXWORKS

WIND RIVER SYSTEMS, INC. (CALIFORNIA
CORPORATION)
1010 ATLANTIC AVENUE
ALAMEDA, CA 94501

NESS, EDUCATION, RESEARCH AND SCI-
ENCE, IN CLASS 9 (U.S. CL. 38).
FIRST USE 12-14-1984; IN COMMERCE
7-23-1986.

FOR: COMPUTER PROGRAMS AND IN-
STRUCTIONAL MANUALS SOLD AS A UNIT
WITH THE PROGRAMS FOR USE IN BUSI-

SER. NO. 74-109,956, FILED 10-29-1990.
GLENN CLARK, EXAMINING ATTORNEY

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Mark: VXWORKS

US Serial Number: 74109956

Application Filing Date: Oct. 29, 1990

US Registration Number: 1659595

Registration Date: Oct. 08, 1991

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Sep. 30, 2011

Publication Date: Jul. 16, 1991

Mark Information

Mark Literal Elements: VXWORKS

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- • Brackets [..] indicate deleted goods/services;
- • Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- • Asterisks *..* identify additional (new) wording in the goods/services.

For: computer programs and instructional manuals sold as a unit with the programs for use in business, education, research and science

International Class: 009 - Primary Class

U.S Class: 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 14, 1984

Use in Commerce: Jul. 23, 1986

Basis Information (Case Level)

Filed Use:	Yes	Currently Use:	Yes	Amended Use:	No
Filed ITU:	No	Currently ITU:	No	Amended ITU:	No
Filed 44D:	No	Currently 44D:	No	Amended 44D:	No
Filed 44E:	No	Currently 44E:	No	Amended 44E:	No
Filed 66A:	No	Currently 66A:	No		
Filed No Basis:	No	Currently No Basis:	No		

Current Owner(s) Information

Owner Name: WIND RIVER SYSTEMS, INC.
500 WIND RIVER WAY
Owner Address: ALAMEDA, CALIFORNIA 94501
UNITED STATES

Legal Entity Type: CORPORATION
State or Country Where Organized: DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: John W. Crittenden
Docket Number: 237260-204

Correspondent

Correspondent Name/Address: John W. Crittenden
Cooley LLP
777 6th Street, NW, Suite 1100
Washington, DISTRICT OF COLUMBIA 20001
UNITED STATES

Phone: 415-693-2090
Fax: 415- 693-2222

Correspondent e-mail: trademarks@cooley.com
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Sep. 30, 2011	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	67603
Sep. 30, 2011	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	67603
Sep. 29, 2011	TEAS SECTION 8 & 9 RECEIVED	
Nov. 19, 2007	CASE FILE IN TICRS	
Dec. 22, 2006	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 14, 2001	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Nov. 14, 2001	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Aug. 31, 2001	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Apr. 14, 1998	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Mar. 23, 1998	RESPONSE RECEIVED TO POST REG. ACTION	
Oct. 21, 1997	POST REGISTRATION ACTION MAILED - SEC. 8 & 15	
Oct. 03, 1997	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Oct. 08, 1991	REGISTERED-PRINCIPAL REGISTER	
Jul. 16, 1991	PUBLISHED FOR OPPOSITION	
Jun. 14, 1991	NOTICE OF PUBLICATION	
Apr. 08, 1991	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 27, 1991	EXAMINER'S AMENDMENT MAILED	
Mar. 25, 1991	ASSIGNED TO EXAMINER	69191

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Oct. 08, 2011

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: Not Found

Date in Location: Sep. 30, 2011

Assignment Abstract of Title Information

Summary

Total
Assignments: 1

Registrant: Wind River Systems, Inc.

Assignment 1 of 1

Conveyance: CHANGE OF NAME AND MERGER

Reel/Frame: [1659/0468](#)

Pages: 13

Date Recorded: Nov. 26, 1997

Supporting
Documents: No Supporting Documents

Assignor

Name: [WIND RIVER SYSTEMS,
INC.](#)

Execution Date: Apr. 06, 1993

Legal Entity Type: CORPORATION

State or Country
Where
Organized: CALIFORNIA

Assignee

Name: [WIND RIVER SYSTEMS, INC.](#)

Legal Entity Type: CORPORATION

State or Country
Where
Organized: DELAWARE

Address: 1010 ATLANTIC AVENUE
ALAMEDA, CALIFORNIA 94501

Correspondent

Correspondent
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Correspondent
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FIVE PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA 94306-2155

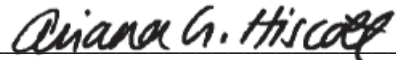
Domestic Representative - Not Found

CERTIFICATE OF TRANSMITTAL AND SERVICE

I hereby certify that this Notice of Opposition is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated below. I hereby further certify that on the date indicated below, a true and correct copy of this Notice of Opposition was placed in the United States Mail, postage prepaid, addressed to Applicant (as identified in the above-referenced application) as follows:

Australian Semiconductor Technology Company Pty Ltd
76 Waymouth Street
Adelaide, AUSTRALIA 5000

Date: September 10, 2012



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