

ESTTA Tracking number: **ESTTA504067**

Filing date: **11/06/2012**

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	Shockfish SA
Granted to Date of previous extension	11/07/2012
Address	Rue des Terreaux 10 Lausanne, 1003 SWITZERLAND

Attorney information	Jill Anderfuren Marshall, Gerstein & Borun LLP 233 S. Wacker Drive Suite 6300 Chicago, IL 60606-6357 UNITED STATES janderfuren@marshallip.com Phone:3124746300
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Applicant Information

Application No	85386566	Publication date	07/10/2012
Opposition Filing Date	11/06/2012	Opposition Period Ends	11/07/2012
Applicant	Boomerang Digital Inc. 530 Magdalena Avenue Los Altos, CA 94024 UNITED STATES		

Goods/Services Affected by Opposition


Class 009. First Use: 2011/07/05 First Use In Commerce: 2011/07/05 All goods and services in the class are opposed, namely: Personal financial computer software for mobile devices, namely, a downloadable computer software application allowing groups of people to share, allocate and pay expenses
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Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3254166	Application Date	01/27/2005
Registration Date	06/19/2007	Foreign Priority Date	NONE

Word Mark	SPOTME
Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2006/01/01 First Use In Commerce: 2006/04/07 computers, computer hardware, computer peripherals, hand held computers, personal digital assistants, wireless communication devices, namely personal digital assistants with wireless communication, telephones, computer gaming machines, microprocessors, computer memories pre-recorded with computer software and data, electrical circuit boards, printed circuit boards, memory cards, computer monitors, liquid crystal displays, videophones, videocameras and digital still image cameras; pre-recorded computer programs for personal information management, database management software, wireless communication software, optical and touch screen based character recognition software, telephony management software, electronic mail and messaging software, paging software, database synchronization software, computer programs for accessing, browsing and searching online databases; instruction manuals sold as a unit

U.S. Registration No.	3160787	Application Date	05/11/2005
Registration Date	10/17/2006	Foreign Priority Date	NONE
Word Mark	SPOTME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 2006/01/01 First Use In Commerce: 2006/04/07 Electronic transmission of messages and data; [electronic voice messaging, namely, the recording, storage and subsequent transmission of voice messages; Mobile radio communication;] telecommunication services, namely, electronic messaging services; wireless transmission of [voice,] data, information, images, signals and messages; rental of apparatus for telecommunications, namely, rental of electronic transmission, recording and monitoring equipment comprised		

	of telecommunications hardware and software including components and peripherals thereof
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U.S. Registration No.	3213848	Application Date	06/13/2003
Registration Date	02/27/2007	Foreign Priority Date	NONE
Word Mark	SPOTME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2006/01/01 First Use In Commerce: 2006/04/07 computer programming for others; rental of computer hardware and software; design for others in the field of telecommunications equipment; consultation in the design, installation, maintenance and repair of computer facilities, computer networks and computer hardware		

Attachments	78554710#TMSN.jpeg (1 page)(bytes) 78627325#TMSN.jpeg (1 page)(bytes) SPOTME Not of Opp.pdf (5 pages)(715904 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	/ja/
Name	Jill Anderfuren
Date	11/06/2012

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

In Re:
Application Serial No.: 85/386,566
Trademark: SPOTME
Applicant: Boomerang Digital Inc.
International Class(es): 9
Filed: August 2, 2011
Published in Official Gazette of July 10, 2012

Shockfish SA,
Opposer,
- vs. -
Boomerang Digital Inc.,
Applicant.

NOTICE OF OPPOSITION

Shockfish SA (“Opposer”), a Swiss corporation, with a business address at Rue des Terreaux, Lausanne CH-1003, Switzerland, believes that it will be damaged by the registration by Boomerang Digital Inc. (“Applicant”) of the mark that is the subject of the above-identified application (the “Application”), and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer commenced use in interstate and foreign commerce, at least as early as April 7, 2006, and is presently using and has registered the trademark SPOTME (“Opposer’s Mark”), in connection with the following goods and services:

Class 9: wireless communication devices, namely personal digital assistants with wireless communication, telephones, wireless communication software, database synchronization software, computer programs for accessing, browsing and searching online databases.

Class 38: Electronic transmission of messages and data; telecommunication services, namely, electronic messaging services; wireless transmission of data, information, images, signals and messages; rental of apparatus for telecommunications, namely, rental of electronic transmission, recording and monitoring equipment comprised of telecommunications hardware and software including components and peripherals thereof.

Class 42: Computer programming for others; rental of computer hardware and software; design for others in the field of telecommunications equipment; consultation in the design, installation, maintenance and repair of computer facilities, computer networks and computer hardware.

2. Opposer’s Mark is the subject of the following United States trademark registrations: Reg. No. 3,254,166 based on USSN 78/554710 filed January 27, 2005; Reg. No. 3,160,787 based on USSN 78/627325 filed May 11, 2005 and Reg. No. 3,213,848 based on USSN 78/262008 filed June 13, 2003.

3. By virtue of the Opposer’s continuous use of Opposer’s Mark, and its promotional activities, and by virtue of the quality of the goods and services offered under Opposer’s Mark, Opposer’s Mark has developed goodwill and consumer recognition.

4. Applicant filed an application for the mark SPOTME on August 2, 2011 (“Applicant’s Mark”) for “personal financial computer software for mobile devices, namely, a

downloadable computer software application allowing groups of people to share, allocate and pay expenses” (“Applicant’s Goods”).

5. There is no issue as to priority. Opposer’s applications were all filed on an intent-to-use basis, with applications being filed in 2003 and 2005. Opposer commenced use of Opposer’s Mark, in interstate and foreign commerce, over 5 years prior to July 5, 2011.

6. The first use date of Applicant’s mark, both anywhere and in commerce, is July 5, 2011.

7. Applicant’s Mark is confusingly similar to Opposer’s Mark, so as to cause confusion and deceive the public as to origin of Applicant’s goods to be offered under Applicant’s Mark. Consumers and persons in the trade will assume, contrary to fact, that Applicant’s goods are associated with, endorsed by or in some other way related to Opposer and/or Opposer’s goods and services.

8. Applicant’s Mark is deceptively similar to Opposer’s Mark so as to cause confusion and deceive the public as to the origin of Applicant’s goods to be offered under Applicant’s Mark. Consumers and persons in the trade will assume, contrary to the fact, that Applicant’s goods are associated with, endorsed by or in some other way related to Opposer and/or Opposer’s goods and services.

9. Opposer alleges and believes, for the reasons set forth above, that if Applicant is permitted to use and/or register Applicant’s Mark in connection with Applicant’s goods, as specified in the Application, confusion in the trade would occur, resulting in damage and injury to Opposer.

10. If Applicant is granted the registration herein opposed, Applicant would thereby obtain at least a prima facie exclusive right to the use of Applicant's Mark. Such registration would be a source of damage and injury to Opposer.

WHEREFORE, Opposer, respectfully requests that this opposition be sustained in favor of Opposer and that registration of Applicant's Mark be rejected and denied.

Opposer, Shockfish SA, hereby appoints Jill Anderfuren, Julianne M. Hartzell, Michael R. Graham, and all attorneys of Marshall, Gerstein & Borun LLP of 233 S. Wacker Drive, Suite 6300, Chicago, Illinois 60606-6357 to act as attorneys for Opposer herein, with full power to prosecute said Opposition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts and to receive all official communication in connection with this opposition.

Payment in the amount of \$300.00 is made to cover the cost of the opposition. The Director is hereby authorized to charge any additional fees that may be required to Deposit Account Number 13-2855.

Respectfully submitted,



Bendicht Ledin
President
Shockfish SA

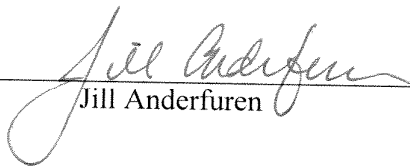
Date: November ⁶ /, 2012

CONTACT:
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CERTIFICATE OF SERVICE

I hereby certify that a true and exact copy of the foregoing **NOTICE OF OPPOSITION** was mailed to the following persons by first class mail, postage prepaid, on: November 6, 2012

John W. Crittenden
Cooley LLP
777 6th Street NW, Suite 1100
Washington, DC 20001



Jill Anderfuren