

ESTTA Tracking number: **ESTTA535231**

Filing date: **04/30/2013**

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	ICLICK, INC.
Granted to Date of previous extension	06/12/2013
Address	3931 1st Avenue S Seattle, WA 98134 UNITED STATES

Attorney information	John P. Schmitz Mills Schmitz & Zaloudek, LLC 1019 8th Street Suite 301 Golden, CO 80401 UNITED STATES jschmitz@mszlawfirm.com Phone:303-384-3922
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Applicant Information

Application No	85466788	Publication date	02/12/2013
Opposition Filing Date	04/30/2013	Opposition Period Ends	06/12/2013
Applicant	Lee, Cheng-Chung 6F, No.262, Dunhua N.Rd. Taipei, TAIWAN		

Goods/Services Affected by Opposition

Class 009. First Use: 2011/07/30 First Use In Commerce: 2011/07/30 All goods and services in the class are opposed, namely: Specialized protective shells for mobile phones, Mobile phone-specific adapters, Mobile phone-specific cradles in the nature of in-car telephone handset cradles, Specialized transmission cables for mobile phones for the transmission of sounds and images, and Specialized protective covers for mobile phones

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.	3364676	Application Date	03/28/2007
Registration Date	01/08/2008	Foreign Priority Date	NONE
Word Mark	ICLICK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2002/12/01 First Use In Commerce: 2002/12/01 USB pen drives; USB hardware; and portable listening devices, namely, MP3 players Class 035. First use: First Use: 2002/12/01 First Use In Commerce: 2002/12/01 Preparing promotional and merchandising material for others

Attachments	ICLICK Opp 489487.pdf (6 pages)(85422 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	/John P. Schmitz/
Name	John P. Schmitz
Date	04/30/2013

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

ICLICK, INC.)	
)	
Opposer,)	Opposition No. _____
)	Serial No. 85/466,788
vs.)	
)	
LEE, CHENG-CHUNG,)	
)	
Applicant)	
)	
_____)	

NOTICE OF OPPOSITION

In the matter of Application Serial No. 85/466,788 for registration of “ICLIC” (the “Application”, “Applicant’s Mark”, or “Applicant’s Mark ICLIC”) by Lee, Cheng-Chung (“Applicant” or “Applicant ICLIC”), published in the Official Gazette (Trademarks) on February 12, 2013. ICLICK, INC. (“Opposer or “Opposer ICLICK”) believes it will be damaged by the registration of this Application and therefore opposes the same.

As grounds for the opposition, Opposer alleges as follows:

1. On information and belief, Applicant is an individual residing at 6F, No. 262, Dunhua N. Rd. Taipei, Taiwan.
2. Opposer is a corporation, organized and existing under the laws of the state of Washington, having a place of business at 3931 1st Avenue S, Seattle, WA 98134.
3. Opposer is a leading electronic and promotional products company providing a broad range of products and services related thereto.

4. Opposer is the registered owner of the Word Mark ICLICK, registration number 3,364,676 registered in International Class 009 for USB pen drives; USB hardware; and portable listening devices, namely, MP3 players. FIRST USE: December 01, 2002. FIRST USE IN COMMERCE: December 01, 2002. Registration Number 3,364,676 is registered in International Class 035 for preparing promotional and merchandising material for others. FIRST USE: December 01, 2002. FIRST USE IN COMMERCE: December 01, 2002.

5. Opposer is the owner of the Word Mark ICLICK, serial number 85/732,875 in International Class 016 for writing instruments.

6. U.S. Registration No. 3,364,676 is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065, and serves as conclusive evidence of the validity and Opposer's ownership of the mark ICLICK, pursuant to 15 U.S.C. § 1115(b).

7. Opposer has successfully promoted, and has made substantial sales of goods and services under the different marks ICLICK (together "Opposer's Mark ICLICK").

8. Applicant's Application is currently in IC 09 for protective shells for mobile phones, mobile phone-specific adapters, mobile phone-specific cradles in the nature of in-car telephone handset cradles, specialized transmission cables for mobile phones for the transmission of sounds and images, and specialized protective covers for mobile phones.

9. On November 8, 2011, Applicant filed the Application ICLIC claiming 1 (a) filing basis with a first use in commerce date of July 30, 2011.

10. Applicant has sworn to the United States Patent and Trademark Office that Applicant, or a related company or licensee, has used the Applicant's Mark since July 7, 2011 in conjunction with the sale of computer keyboards, specialized protective covers for computer keyboards, wireless presenters in the nature of wireless remote pointers, computer mouse, mouse pads, microphones, wireless transmitters, specialized protective shells for notebook computers, computer speakers, network video recorders, tablet PC cases, tablet PC stylus, special protective shells for mobile phones, mobile phone-specific adapters, mobile phone-specific cradles in the nature of in-car telephone handset cradles, specialized transmission cables for mobile phones for the transmission of sounds and images, and specialized protective covers for mobile phones.

11. Opposer sells its goods and services via, among other means, catalog and the world wide web at www.iclick.com.

12. On information and belief, Applicant sells its goods and services via, among other means, the world wide web at www.iclic.com.tw.

13. Opposer's Mark ICLICK is distinctive.

COUNT I
LIKELIHOOD OF CONFUSION

14. Opposer repeats and realleges each and every preceding allegation set forth herein.

15. Opposer commenced use of its trademark ICLICK well before Applicant filed the Application and commenced use of Applicant's Mark ICLIC in commerce.

16. Applicant's Mark ICLIC is similar to Opposer's Mark ICLICK in sight, sound, connotation, and overall commercial impression.

17. Applicant's Mark ICLIC incorporates Opposer's Mark ICLICK or an almost identical depiction thereof.

18. The goods and services identified in the Applicant's Application are identical, or similar and related, or related to the goods and services for which the Opposer's Marks are registered.

19. Registration of Applicant's Mark ICLIC is likely to cause confusion, mistake, or deception as to the source of Applicant's goods and is likely to falsely suggest a common association, sponsorship or origin of said goods between Applicant ICLIC and Opposer ICLICK pursuant to Section 2(d) of the Lanham Act, 15. U.S.C. § 1052(d).

20. Registration of the Applicant's Mark ICLIC would be likely to cause confusion or mistake in the minds of the public and lead the public and prospective customers into assuming and believing that Applicant's goods are those of Opposer ICLICK, or associated with Opposer ICLICK, thus causing damage and injury to the purchasing public and to the damage and injury of Opposer ICLICK.

21. Contrary to Applicant's sworn statement to the United States Patent and Trademark Office stating that the goods and services of Applicant are not confusingly similar, or that such goods and services are not in the similar stream of commerce as that of Opposer's goods, *inter alia*, Applicant's website indicates otherwise.

22. Based on the foregoing, the grant of a registration for Applicant's Mark ICLIC, as sought in the Application, should be denied.

WHEREFORE, it is respectfully requested that this Opposition be sustained and that registration to Applicant be refused.

Sincerely,

/John P. Schmitz/

John P. Schmitz, Esq.

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(303) 384-3922

Opposition No. _____
Serial No. 85/466,788

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the attached NOTICE OF OPPOSITION was filed electronically with the Trademark Trial and Appeal Board on April 30, 2013.

/John P. Schmitz/
John P. Schmitz, Esq.

CERTIFICATE OF SERVICE

I hereby certify that a copy of this NOTICE OF OPPOSITION was served by First Class Mail to the following address on April 30, 2013, such being the Applicant's correspondence address listed in the TARR system as of this date:

CHUN-MING SHIH
HDLS IPR SERVICES
PO BOX 220746
CHANTILLY, VA 20153-0746

/John P. Schmitz/
John P. Schmitz, Esq.