Trademark Trial and Appeal Board Electronic Filing System. http://estta.uspto.gov

ESTTA Tracking number: **ESTTA597524**

Filing date: **04/09/2014**

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	Avnet, Inc.
Granted to Date of previous extension	04/13/2014
Address	2211 South 47th Street Phoenix, AZ 85034 UNITED STATES

Attorney information	Kathy Tsai Fish & Richardson, P.C. PO Box 1022 Minneapolis, MN 55440-1022 UNITED STATES tmdoctc@fr.com, tsai@fr.com Phone:650-839-5070

Applicant Information

Application No	85749836	Publication date	10/15/2013
Opposition Filing Date	04/09/2014	Opposition Period Ends	04/13/2014
Applicant	Hanu Software Solutions, Inc. 5 Independence Way, Suite 300 Princeton, NJ 08540 NJ		

Goods/Services Affected by Opposition

Class 042. First Use: 2012/03/00 First Use In Commerce: 2012/03/00
All goods and services in the class are opposed, namely: Computer software consulting; Consulting services in the field of cloud computing; Software development in the field ofcloud computing applications

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4005246	Application Date	10/08/2010
Registration Date	08/02/2011	Foreign Priority Date	NONE
Word Mark	ACCELERATING YOUR SUCCESS		

Design Mark	ACCELERATING YOUR SUCCESS
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2007/10/15 First Use In Commerce: 2007/10/15 computer hardware and computer peripherals; electrical, electronic and computercomponents and equipment, namely, micro-processors, semiconductors, interconnects, passives and electromechanical software and hardware for linking communications and data networks, microchips, circuit boards, servers, display panels, datastorage software and hardware, point-of-sale systems, namely, bar-code scanners, automatic identification software and hardware, and wireless computing software and hardware, embedded operating software and hardware, radio frequency and microwave software and hardware for linking communications and data networks * ; all aforementioned goods unrelated to providing professional commercial or residential real estate services such as real estate property consultancy, real estateproperty management, real estate brokerage sales and real estate leasing transactions, real estate valuations and appraisals, real estate survey, real estate corporate services, real estate auctioneering, real estate agency, real estate mortgage brokerage, real estate project and asset management, real estate fund management, real estate development and other related real estate activities with the exception of warehouse storage services * Class 035. First use: First Use: 2007/10/15 First Use In Commerce: 2007/10/15 Providing of information regarding goods and services on the internet, namely, providing consumer product and service information via the Internet; procuring of contracts for the purchase and sale ofgoods; wholesale store services and online retail and wholesale store services featuring electrical, electronic and computer equipment, electric motors and machinery; electromechanical components andproducts, optoelectronic devices, plastic injection goods, industrial maintenance supplies, factory equipment for industrial, commercial, government, agricultural, mining and utility markets and tools; freight logistics management; supply chain management services; distributorship services in the field of electrical, electronic and computer equipment, electric motors and machinery; distributorship services specializing in electronic, electromechanical components and products, electrical equipment, computers and computer equipment, optoelectronic devices, plastic injection goods, industrial maintenance supplies, factory equipment for industrial, commercial, government, agricultural, mining and utility markets and tools, in particular via the internet*; all aforementioned services unrelated to providing professional commercial or residential real estate services such as real estate property consultancy, real estate property management, real estate brokerage sales and real estate leasing transactions, real estate valuations and appraisals, real estate survey, real estate corporate services, real estate auctioneering, real estate agency, real estate mortgage brokerage, real estate project and asset management, real estate fund management, real estate developmentand other related real estate activities with the exception of warehouse storage services * Class 039. First use: First Use: 2007/10/15 First Use In Commerce: 2007/10/15

	warehouse storage of goods and packaging articles for transportation and assembly; delivery of computer products, electronic and electrical devices, instruments and components, and computer products;logistics services, namely, supply chain logistics and reverse logistics services, namely, storage, transportation, anddelivery of documents, packages, raw materials, and other freight for others byair, rail, ship or truck; advisory and consultation services in the field of warehouse storage goods, packaging articles for transportation * ; all aforementioned services unrelated to providing professional commercial or residential real estate services such as real estate property consultancy, real estate property management, real estate brokerage sales and real estate leasing transactions, real estate valuations and appraisals, realestate survey, real estate corporate services, real estate auctioneering, real estate agency, real estate mortgage brokerage, real estate project and asset management, real estate fund management, real estate development and other related real estate activities with the exception of warehouse storage services * Class 040. First use: First Use: 2007/10/15 First Use In Commerce: 2007/10/15 assembly of computer products and components for others * ; all aforementioned services unrelated to providing professional commercial or residential real estate services such as real estate propertyconsultancy, real estate property management, real estate brokerage sales and real estate leasing transactions, real estate valuations and appraisals, real estate survey, real estate corporate services, real estate auctioneering, real estate agency, real estate mortgage brokerage, real estate project and asset management, real estate fund management, real estate development and other related realestate activities with the exception ofwarehouse storage services * Class 042. First use: First Use: 2007/10/15 First Use In Commerce: 2007/10/15 computer programming for others * ; allaforementioned services unrelated to providing professional commercial or residential real estate services such as realestate property consultancy, real estate property management, real estate brokerage sales and real estate leasing transactions, real estate valuations and appraisals, real estate survey, real estate corporate services, real estate auctioneering, real estate agency, real estate mortgage brokerage, real estate project and asset management, real estate fund management, real estate development and other related real estate activities with the exception of warehouse storage services *

Attachments	85148476#TMSN.jpeg(bytes) 14400-0638PP1 Notice of Opposition.pdf(3490298 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	/kathy tsai/
Name	Kathy Tsai
Date	04/09/2014

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

In the matter of Application Serial No. 85/749,836
Filed on October 10, 2012
For the mark **ACCELERATE YOUR SUCCESS IN THE CLOUD**
Published in the *Official Gazette* on October 15, 2013

AVNET, INC., Opposer, v. HANU SOFTWARE SOLUTIONS, INC., Applicant.	**NOTICE OF OPPOSITION**

NOTICE OF OPPOSITION

Opposer Avnet, Inc. believes that it will be damaged by registration of the mark shown in the above-identified application and hereby opposes the same pursuant to the provisions of 15 U.S.C. § 1063.

The grounds for opposition are as follows:

THE PARTIES

1. Opposer Avnet, Inc. ("Avnet") is a New York corporation with a place of business at 2211 South 47th Street, Phoenix, AZ 85034.

2. Upon information and belief, Applicant Hanu Software Solutions, Inc. ("Applicant") is a New Jersey corporation with a place of business at 5 Independence Way, Suite 300, Princeton, NJ 08540.

FACTUAL BACKGROUND

3. Avnet distributes electronic components, computer products, and embedded technology to customers globally. In October 2007, Avnet introduced computer goods and services under the mark ACCELERATING YOUR SUCCESS ("Avnet Mark"). Since that time, Avnet has consistently and prominently used the Avnet Mark on and in connection with computer products and services.

4. In addition to its common law rights in the Avnet Mark, Avnet owns Registration No. 4,005,246 for the mark ACCELERATING YOUR SUCCESS for various goods and services in Classes 9, 35, 39, 40, and 42, including the following:

> Class 9: *computer hardware and computer peripherals; electrical, electronic and computer components and equipment, namely, micro-processors, semiconductors, interconnects, passives and electromechanical software and hardware for linking communications and data networks, microchips, circuit boards, servers, display panels, data storage software and hardware, point-of-sale systems, namely, bar-code scanners, automatic identification software and hardware, and wireless computing software and hardware, embedded operating software and hardware, radio frequency and microwave software and hardware for linking communications and data networks . . .*
>
> Class 42: *computer programming for others . . .*

The registration issued on August 2, 2011, with a first use and first use in commerce date of October 15, 2007. A copy of Registration No. 4,005,246 is attached at **Exhibit A**.

5. On October 10, 2012, Applicant filed an application to register the mark ACCELERATE YOUR SUCCESS IN THE CLOUD in connection with "Computer software consulting; Consulting services in the field of cloud computing; Software development in the field of cloud computing applications" in class 42 ("Applicant's Services"), based on an alleged first use and first use in commerce date of March 2012, which was designated Application Serial

No. 85/749,836 (the "Application") (the mark that is the subject of the Application is referred to as "Applicant's Mark").

6. The Application was published for opposition in the *Official Gazette* on October 15, 2013. Thereafter, Avnet sought and obtained an extension of time to oppose the Application until February 12, 2014. Avnet further sought and obtained a consented extension of time to oppose the Application until April 13, 2014. Consequently, this Notice of Opposition is timely filed.

GROUNDS FOR OPPOSITION

Priority and Likelihood of Confusion

7. There is no issue as to priority. Avnet has been using the mark ACCELERATING YOUR SUCCESS in commerce since at least as early as October 15, 2007, whereas Applicant's priority dates back to its alleged use starting in March 2012. By virtue of its federal registration, Avnet enjoys nationwide rights in its mark ACCELERATING YOUR SUCCESS dating back to October 15, 2007. Avnet's common law and statutory priority dates precede the priority date of the Application and, upon information and belief, any priority date on which Applicant may rely.

8. The Avnet Mark is distinctive of the computer products and services offered by Avnet.

9. The Avnet Mark enjoys a high degree of distinctiveness in the field of computer products and services. Avnet's registration for ACCELERATING YOUR SUCCESS is the only existing registration with the United States Patent and Trademark Office for computer related products and services in Classes 9, 35, 39, 40, and 42 that contains the terms "ACCELERAT-" and "SUCCESS."

10. Applicant allegedly uses the mark ACCELERATE YOUR SUCCESS IN THE CLOUD, which wholly incorporates the dominant terms "ACCELERAT-," "YOUR," and "SUCCESS" from the Avnet Mark. The non-distinctive terms "IN THE CLOUD" in Applicant's Mark is not sufficient to distinguish the ACCELERATE YOUR SUCCESS IN THE CLOUD mark from Avnet's prior ACCELERATING YOUR SUCCESS mark.

11. Applicant allegedly uses the ACCELERATE YOUR SUCCESS IN THE CLOUD mark in connection with computer software consulting and development services, in particular in the field of cloud computing. The services Applicant allegedly intends to offer under the mark ACCELERATE YOUR SUCCESS IN THE CLOUD are similar and related to the goods and services Avnet offers under its ACCELERATING YOUR SUCCESS mark.

12. Consumers are likely to believe that software services offered in connection with the mark ACCELERATE YOUR SUCCESS IN THE CLOUD originate from Avnet or are somehow affiliated with Avnet and its ACCELERATING YOUR SUCCESS mark, as the ACCELERATE YOUR SUCCESS IN THE CLOUD mark merely combines Avnet's distinctive ACCELERATING YOUR SUCCESS mark with the generic phrase "IN THE CLOUD," and changes the tense of the word "ACCELERATING" to "ACCELERATE." As such, Applicant's ACCELERATING YOUR SUCCESS IN THE CLOUD mark so resembles Applicant's previously used and previously registered mark, as to be likely, when used in connection with Applicant's Services, to cause confusion, to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the services Applicant offers in connection with the Proposed Mark are produced, sponsored, endorsed, or approved by Avnet, or are in some way affiliated, connected, or associated with Avnet, all to the detriment of Avnet.

Registration of Applicant's mark, therefore, should be refused under 15 U.S.C. §§ 1052(d) and 1063.

13. Registration of Applicant's proposed mark ACCELERATE YOUR SUCCESS IN THE CLOUD would be a further source of damage to Avnet because it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Avnet's prior adoption, use, and registration of its marks.

WHEREFORE, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, Opposer Avnet, Inc. respectfully requests that its Notice of Opposition be sustained and that the registration of the mark shown in Application Serial No. 85/749,836 be refused.

Please direct all correspondence with respect to this Opposition to Kathy Tsai at the address below. Please charge the Notice of Opposition fee to the Deposit Account of Fish & Richardson P.C., Account No. 06-1050.

Respectfully Submitted,

Date 4/9/14

Kathy Tsai
FISH & RICHARDSON P.C.
500 Arguello Street, Suite 500
Redwood City, CA 94063
Telephone: (650) 839-5070
Facsimile: (877) 769-7945

Counsel for Avnet, Inc.

CERTIFICATE OF SERVICE

The undersigned herby certifies that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served this 9th day of April, 2014, by First Class U.S. Mail, postage prepaid, upon Applicant Hanu Software Solutions, Inc.'s attorney of record at the following address:

BRIAN GIBBONS
3936 S SEMORAN BLVD STE 330
ORLANDO, FLORIDA 32822-4015
UNITED STATES

Margaret Trevino

EXHIBIT A

United States of America
United States Patent and Trademark Office

ACCELERATING YOUR SUCCESS

Reg. No. 4,005,246

Registered Aug. 2, 2011

Int. Cls.: 9, 35, 39, 40 and 42

TRADEMARK

SERVICE MARK

PRINCIPAL REGISTER

AVNET, INC. (NEW YORK CORPORATION)
2211 SOUTH 47TH STREET
PHOENIX, AZ 85034

FOR: COMPUTER HARDWARE AND COMPUTER PERIPHERALS; ELECTRICAL, ELECTRONIC AND COMPUTER COMPONENTS AND EQUIPMENT, NAMELY, MICRO-PROCESSORS, SEMICONDUCTORS, INTERCONNECTS, PASSIVES AND ELECTROMECHANICAL SOFTWARE AND HARDWARE FOR LINKING COMMUNICATIONS AND DATA NETWORKS, MICROCHIPS, CIRCUIT BOARDS, SERVERS, DISPLAY PANELS, DATA STORAGE SOFTWARE AND HARDWARE, POINT-OF-SALE SYSTEMS, NAMELY, BAR-CODE SCANNERS, AUTOMATIC IDENTIFICATION SOFTWARE AND HARDWARE, AND WIRELESS COMPUTING SOFTWARE AND HARDWARE, EMBEDDED OPERATING SOFTWARE AND HARDWARE, RADIO FREQUENCY AND MICROWAVE SOFTWARE AND HARDWARE FOR LINKING COMMUNICATIONS AND DATA NETWORKS, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-15-2007; IN COMMERCE 10-15-2007.

FOR: PROVIDING OF INFORMATION REGARDING GOODS AND SERVICES ON THE INTERNET, NAMELY, PROVIDING CONSUMER PRODUCT AND SERVICE INFORMATION VIA THE INTERNET; PROCURING OF CONTRACTS FOR THE PURCHASE AND SALE OF GOODS; WHOLESALE STORE SERVICES AND ONLINE RETAIL AND WHOLESALE STORE SERVICES FEATURING ELECTRICAL, ELECTRONIC AND COMPUTER EQUIPMENT, ELECTRIC MOTORS AND MACHINERY; ELECTROMECHANICAL COMPONENTS AND PRODUCTS, OPTOELECTRONIC DEVICES, PLASTIC INJECTION GOODS, INDUSTRIAL MAINTENANCE SUPPLIES, FACTORY EQUIPMENT FOR INDUSTRIAL, COMMERCIAL, GOVERNMENT, AGRICULTURAL, MINING AND UTILITY MARKETS AND TOOLS; FREIGHT LOGISTICS MANAGEMENT; SUPPLY CHAIN MANAGEMENT SERVICES; DISTRIBUTORSHIP SERVICES IN THE FIELD OF ELECTRICAL, ELECTRONIC AND COMPUTER EQUIPMENT, ELECTRIC MOTORS AND MACHINERY; DISTRIBUTORSHIP SERVICES SPECIALIZING IN ELECTRONIC, ELECTROMECHANICAL COMPONENTS AND PRODUCTS, ELECTRICAL EQUIPMENT, COMPUTERS AND COMPUTER EQUIPMENT, OPTOELECTRONIC DEVICES, PLASTIC INJECTION GOODS, INDUSTRIAL MAINTENANCE SUPPLIES, FACTORY EQUIPMENT FOR INDUSTRIAL, COMMERCIAL, GOVERNMENT, AGRICULTURAL, MINING AND UTILITY MARKETS AND TOOLS, IN PARTICULAR VIA THE INTERNET, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 10-15-2007; IN COMMERCE 10-15-2007.

FOR: WAREHOUSE STORAGE OF GOODS AND PACKAGING ARTICLES FOR TRANSPORTATION AND ASSEMBLY; DELIVERY OF COMPUTER PRODUCTS, ELECTRONIC AND ELECTRICAL DEVICES, INSTRUMENTS AND COMPONENTS, AND COMPUTER PRODUCTS; LOGISTICS SERVICES, NAMELY, SUPPLY CHAIN LOGISTICS AND REVERSE LOGISTICS SERVICES, NAMELY, STORAGE, TRANSPORTATION, AND DELIVERY OF DOCUMENTS, PACKAGES, RAW MATERIALS, AND OTHER FREIGHT FOR OTHERS BY

David J. Kappos

Director of the United States Patent and Trademark Office

Reg. No. 4,005,246 AIR, RAIL, SHIP OR TRUCK; ADVISORY AND CONSULTATION SERVICES IN THE FIELD OF WAREHOUSE STORAGE GOODS, PACKAGING ARTICLES FOR TRANSPORTATION, IN CLASS 39 (U.S. CLS. 100 AND 105).

FIRST USE 10-15-2007; IN COMMERCE 10-15-2007.

FOR: ASSEMBLY OF COMPUTER PRODUCTS AND COMPONENTS FOR OTHERS, IN CLASS 40 (U.S. CLS. 100, 103 AND 106).

FIRST USE 10-15-2007; IN COMMERCE 10-15-2007.

FOR: COMPUTER PROGRAMMING FOR OTHERS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 10-15-2007; IN COMMERCE 10-15-2007.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-148,476, FILED 10-8-2010.

THEODORE MCBRIDE, EXAMINING ATTORNEY