

ESTTA Tracking number: **ESTTA696409**

Filing date: **09/17/2015**

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	SD-3C, LLC
Granted to Date of previous extension	09/30/2015
Address	1209 Orange Street Wilmington, DE 19801 UNITED STATES

Attorney information	Pamela M. Deese Arent Fox LLP 1717 K St., NW Washington, DC 20006 UNITED STATES pamela.deese@arentfox.com, TMdocket@arentfox.com, jimeelah.berryman@arentfox.com, luna.samman@arentfox.com Phone:202-857-6000
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Applicant Information

Application No	85653269	Publication date	06/02/2015
Opposition Filing Date	09/17/2015	Opposition Period Ends	09/30/2015
Applicant	Wave Semiconductor 42 West Campbell Avenue, Suite 301 Campbell, CA 95008 UNITED STATES		

Goods/Services Affected by Opposition


Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Computer programs for use in the design of semiconductor devices, and associated documentation and instructional manuals sold together as a unit; Design libraries, namely, downloadable electronic data files for use in integrated circuit and semiconductor design; Semiconductor chips; Semiconductor devices; Semiconductors; Very large scale integration (VLSI) semiconductor integrated circuits


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	2772831	Application Date	09/28/1999
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No.			
Registration Date	10/14/2003	Foreign Priority Date	NONE
Word Mark	SD		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 DATA STORAGE MEDIA, NAMELY INTEGRATED CIRCUIT MEMORY CARDS; INTEGRATED CIRCUITS; SEMICONDUCTORS; INTEGRATED CIRCUIT MEMORY CARD READERS AND WRITERS; PERSONAL COMPUTERS; AUDIO RECORDERS, AUDIO PLAYERS, VIDEO RECORDERS, DIGITAL CAMERAS, VIDEO CAMERAS, ALL USING IC MEMORY CARDS; COMPUTER GAME PLAYERS, NAMELY COMPUTER GAME EQUIPMENT CONTAINING MEMORY DEVICES, NAMELY INTEGRATED CIRCUIT MEMORY CARDS; PRINTERS FOR COMPUTERS, DAISY WHEEL PRINTERS, DOT MATRIX PRINTERS, IMPACT LASER PRINTERS, COLOR PRINTERS, VIDEO PRINTERS, INK JET [PRINTER] * PRINTERS * , BUBBLE JET PRINTERS; MOBILE TELEPHONES; TELEVISION SETS; SATELLITE GLOBAL POSITIONING SYSTEMS (GPS); INTEGRATED CIRCUIT MEMORY CARDS</p>		
U.S. Registration No.	4400349	Application Date	05/11/2009
Registration Date	09/10/2013	Foreign Priority Date	NONE
Word Mark	SD XC		

Design Mark			
Description of Mark	The mark consists of stylized letters "SD XC".		
Goods/Services	<p>Class 009. First use: First Use: 2011/03/00 First Use In Commerce: 2011/03/00</p> <p>Data storage media, namely, integrated circuit memory cards; integrated circuits; semiconductors; electronic integrated circuit memory card readers and writers; personal computers; audio recorders, namely, digital audio recorders, mp3 recorders, audio players, namely, digital audio players, mp3 players, video recorders, namely, digital video recorders, digital video cameras, digital camcorders, digital still cameras, digital photo viewers, digital cameras, video cameras, DVD recorders, DVD players, voice recorders, namely, digital voice recorders, digital voice memo, all using IC memory cards; printers for computers, color printers; television sets; integrated circuit memory cards; interface devices for computers, namely, USB readers and writers; movie projectors and data projectors, namely, digital photo projectors; memory card adapters</p>		
U.S. Registration No.	3816439	Application Date	05/11/2009
Registration Date	07/13/2010	Foreign Priority Date	NONE
Word Mark	MICROSD		



Description of Mark	The mark consists of stylized word "microSD".
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Goods/Services	<p>Class 009. First use: First Use: 2005/06/00 First Use In Commerce: 2005/06/00 data storage media, namely, integrated circuit memory cards; integrated circuits; semiconductors; electronic integratedcircuit memory card readers and writers; personal computers; audio recorders, namely, digital audio recorders, mp3 re- recorders, silicon audio recorders, audio players, namely, digital audio players, mp3 players, silicon audio players, video recorders, namely, digital video record- ers, digital video cameras, digital camcorders, digital still cameras, digital photo viewers, digital cameras, video cameras, DVD recorders, DVD players, voice re- recorders, namely, digital voice recorders, digital voice memo, all using IC memory cards; computer game players, namely,computer game equipment containing memory devices, namely, integrated circuit memory cards; printers for com- puters, daisy wheel printers, dot matrix printers, impact laser printers, color print- ers, video printers, ink jet printers, bubble jet printers; mobile telephones; televi- sion sets; satellite global positioning systems (GPS); integrated circuit memory cards; interface devices for computers, namely, USB readers and writers, pc cardreaders and writers, cardbus readers and writers, modem card, connectivity card, networking card and TV tuner card readers and writers; movie projectors and data projectors, namely, LCD projectors, movie projectors, digital photo pro- jectors, multimedia projectors, portable mediaplayers; personal digital assist- ants; memory card adapters; integrated circuit memory cards recorded with mu- sic, magazines, advertising, promotional material and manuals, books, dictionar- ies, encyclopedias and photographs; sound recordingsfeaturing music and ad- vertising, video recordings featuring music, advertising,promotional material and manuals, books, dictionaries and encyclopedias; audio visual recordings featur- ing music and animation</p>
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U.S. Registration No.	4422734	Application Date	06/12/2012
Registration Date	10/22/2013	Foreign Priority Date	NONE
Word Mark	MICRO SD XC		



Description of Mark	The mark consists of the words "MICRO SD XC" in stylized letters. "MICRO" is stacked above "SD", which is stacked above "XC".
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Goods/Services	Class 009. First use: First Use: 2011/06/00 First Use In Commerce: 2011/06/00 data storage media, namely, integrated circuit memory cards; integrated circuits; semiconductors; electronic integratedcircuit memory card readers and writers; personal computers; audio recorders, namely, digital audio recorders, mp3 recorders; video recorders, namely, digital video recorders, digital video cameras, digital camcorders; digital still cameras; digital photo viewers; digital cameras; video cameras; DVD recorders; DVD players; voice recorders, namely, digital voice recorders, digital voice memo, all using IC memory cards; interface devicesfor computers, namely, USB readers and writers; movie projectors and data projectors, namely, LCD projectors, movie projectors, and digital photo projectors; memory card adapters
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U.S. Registration No.	4422735	Application Date	06/12/2012
Registration Date	10/22/2013	Foreign Priority Date	NONE
Word Mark	MICRO SD HC		

Design Mark	
Description of Mark	The mark consists of the words "MICRO SD HC" in stylized letters. "MICRO" is stacked above "SD", which is stacked above "HC". "HC" appears in a shaded rectangle.
Goods/Services	Class 009. First use: First Use: 2011/06/00 First Use In Commerce: 2011/06/00 Data storage media, namely, integrated circuit memory cards; integrated circuits; semiconductors; electronic integrated circuit memory card readers and writers; personal computers; audio recorders, namely, digital audio recorders, mp3 recorders; video recorders, namely, digital video recorders, digital video cameras, digital camcorders; digital still cameras; digital photo viewers; digital cameras; video cameras; DVD recorders; DVD players; voice recorders, namely, digital voice recorders, digital voice memo, all using IC memory cards; interface devices for computers, namely, USB readers and writers; movie projectors and data projectors, namely, LCD projectors, movie projectors, and digital photo projectors; memory card adapters

Attachments	75813172#TMSN.png(bytes) 77733437#TMSN.png(bytes) 77733438#TMSN.png(bytes) 85649918#TMSN.png(bytes) 85649923#TMSN.png(bytes) (SD-3C) - Notice of Opposition - SD-ASIC filed by Wave Semiconductor.pdf(104515 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	/luna m. samman/
Name	Luna M. Samman
Date	09/17/2015

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

In re Application Serial No. 85/653,269 for the mark SD-ASIC
Filed on June 15, 2012 and published on June 2, 2015.

SD-3C LLC	:	
	:	
Opposer,	:	
	:	Opp. No. _____
v.	:	
	:	
Wave Semiconductor	:	
	:	
Applicant.	:	

NOTICE OF OPPOSITION

SD-3C LLC (“Opposer”) believes that it will be damaged by the registration of the mark SD-ASIC (“Applicant’s Mark”), the subject of Application Serial No. 85/653,269 filed by Wave Semiconductor (“Applicant”). Opposer hereby opposes this Application under the provisions of Lanham Act § 13, 15 U.S.C. § 1063.

As grounds for the opposition, Opposer alleges as follows:

1. Opposer owns a family of famous, federally-registered marks containing the term SD (the “SD Marks”), which have been used extensively on a variety of highly successful data storage products, including integrated circuit memory cards, and related devices that use memory cards for storage, reproduction, and playback of sounds and images, such as digital cameras, mobile telephones, DVD players, and video display monitors, since at least as early as January 2001.
2. Opposer is a licensing company established by Panasonic Corporation, Toshiba Corporation, and SanDisk Corporation to license the technology, trademarks, patents, and other

valuable intellectual property embodied in the memory cards and related electronic devices sold under Opposer's SD Marks.

3. Since Opposer was established, its SD Marks have become synonymous with cutting-edge technology and Opposer is a leading provider of data storage technology in the United States and around the world.

4. Opposer's SD Marks have become well known and famous due to the fact that the marks have been widely advertised and, between 2003 and 2015, SD-3C's member companies and licensees have collectively sold over 4 billion SD memory cards worldwide valued at more than US \$18.5 billion, as well as multiple billion products containing SD Marks and technology such as cell phones, navigation systems, cameras, computers, printers and video players to name a few.

5. Opposer's SD Marks are used by duly qualified licensees pursuant to agreements through which Opposer controls the nature and quality of the goods.

6. All use of the famous SD Marks by its licensees inures to Opposer's benefit pursuant to Section 5 of the Trademark Act, 15 U.S.C. §1055.

7. Opposer filed Application Serial No. 75/813,172 for the mark SD (Stylized) on September 28, 1999, and the U.S. Patent and Trademark Office issued Certificate of Registration No. 2,772,831 for this mark on October 14, 2003. The registration covers "data storage media, namely integrated circuit memory cards; integrated circuits; semiconductors; integrated circuit memory card readers and writers; personal computers; audio recorders, audio players, video recorders, digital cameras, video cameras, all using IC memory cards; computer game players, namely computer game equipment containing memory devices, namely integrated circuit memory cards; printers for computers, daisy wheel printers, dot matrix printers, impact laser

printers, color printers, video printers, ink jet printers, bubble jet printers; mobile telephones; television sets; satellite global positioning systems (GPS); integrated circuit memory cards” in Class 9.

8. Registration No. 2,772,831 is valid and incontestable and serves as conclusive evidence of the validity of the SD mark, the registration of the mark, Opposer’s ownership of the mark, and Opposer’s exclusive right to use the mark in commerce on or in connection with the services specified therein, under Lanham Act § 33, 15 U.S.C. § 1115.

9. Opposer filed Application Serial No. 77/733,437 for the mark SD XC (Stylized) on May 11, 2009, and the U.S. Patent and Trademark Office issued Certificate of Registration No. 4,400,349 for this mark on September 10, 2013. The registration covers “data storage media, namely, integrated circuit memory cards; integrated circuits; semiconductors; electronic integrated circuit memory card readers and writers; personal computers; audio recorders, namely, digital audio recorders, mp3 recorders, audio players, namely, digital audio players, mp3 players, video recorders, namely, digital video recorders, digital video cameras, digital camcorders, digital still cameras, digital photo viewers, digital cameras, video cameras, DVD recorders, DVD players, voice recorders, namely, digital voice recorders, digital voice memo, all using IC memory cards; printers for computers, color printers; television sets; integrated circuit memory cards; interface devices for computers, namely, USB readers and writers; movie projectors and data projectors, namely, digital photo projectors; memory card adapters” in Class 9.

10. Registration No. 4,400,349 is valid and serves as prima facie evidence of the validity of the SD XC mark, the registration of the mark, Opposer’s ownership of the mark, and Opposer’s exclusive right to use the mark in commerce on or in connection with the services specified therein, under Lanham Act § 33, 15 U.S.C. § 1115.

11. Opposer filed Application Serial No. 77/733,438 for the mark MICRO SD (Stylized) on May 11, 2009, and the U.S. Patent and Trademark Office issued Certificate of Registration No. 3,816,439 for this mark on July 13, 2010. The registration covers “data storage media, namely, integrated circuit memory cards; integrated circuits; semiconductors; electronic integrated circuit memory card readers and writers; personal computers; audio recorders, namely, digital audio recorders, mp3 recorders, silicon audio recorders, audio players, namely, digital audio players, mp3 players, silicon audio players, video recorders, namely, digital video recorders, digital video cameras, digital camcorders, digital still cameras, digital photo viewers, digital cameras, video cameras, DVD recorders, DVD players, voice recorders, namely, digital voice recorders, digital voice memo, all using IC memory cards; computer game players, namely, computer game equipment containing memory devices, namely, integrated circuit memory cards; printers for computers, daisy wheel printers, dot matrix printers, impact laser printers, color printers, video printers, ink jet printers, bubble jet printers; mobile telephones; television sets; satellite global positioning systems (GPS); integrated circuit memory cards; interface devices for computers, namely, USB readers and writers, pc card readers and writers, cardbus readers and writers, modem card, connectivity card, networking card and TV tuner card readers and writers; movie projectors and data projectors, namely, LCD projectors, movie projectors, digital photo projectors, multimedia projectors, portable media players; personal digital assistants; memory card adapters; integrated circuit memory cards recorded with music, magazines, advertising, promotional material and manuals, books, dictionaries, encyclopedias and photographs; sound recordings featuring music and advertising, video recordings featuring music, advertising,

promotional material and manuals, books, dictionaries and encyclopedias; audio visual recordings featuring music and animation” in Class 9.

12. Registration No. 3,816,439 is valid and serves as prima facie evidence of the validity of the MICRO SD mark, the registration of the mark, Opposer’s ownership of the mark, and Opposer’s exclusive right to use the mark in commerce on or in connection with the goods specified therein, under Lanham Act § 33, 15 U.S.C. § 1115.

13. Opposer filed Application Serial No. 85/649,918 for the mark MICRO SD XC (Stylized) on June 12, 2012, and the U.S. Patent and Trademark Office issued Certificate of Registration No. 4,422,734 for this mark on October 22, 2013. The registration covers “data storage media, namely, integrated circuit memory cards; integrated circuits; semiconductors; electronic integrated circuit memory card readers and writers; personal computers; audio recorders, namely, digital audio recorders, mp3 recorders; video recorders, namely, digital video recorders, digital video cameras, digital camcorders; digital still cameras; digital photo viewers; digital cameras; video cameras; DVD recorders; DVD players; voice recorders, namely, digital voice recorders, digital voice memo, all using IC memory cards; interface devices for computers, namely, USB readers and writers; movie projectors and data projectors, namely, LCD projectors, movie projectors, and digital photo projectors; memory card adapters” in Class 9.

14. Registration No. 4,422,734 is valid and serves as prima facie evidence of the validity of the MICRO SD XC mark, the registration of the mark, Opposer’s ownership of the mark, and Opposer’s exclusive right to use the mark in commerce on or in connection with the goods specified therein, under Lanham Act § 33, 15 U.S.C. § 1115.

15. Opposer filed Application Serial No. 85/649,923 for the mark MICRO SD HC (Stylized) on June 12, 2012, and the U.S. Patent and Trademark Office issued Certificate of

Registration No. 4,422,735 for this mark on October 22, 2013. The registration covers “data storage media, namely, integrated circuit memory cards; integrated circuits; semiconductors; electronic integrated circuit memory card readers and writers; personal computers; audio recorders, namely, digital audio recorders, mp3 recorders; video recorders, namely, digital video recorders, digital video cameras, digital camcorders; digital still cameras; digital photo viewers; digital cameras; video cameras; DVD recorders; DVD players; voice recorders, namely, digital voice recorders, digital voice memo, all using IC memory cards; interface devices for computers, namely, USB readers and writers; movie projectors and data projectors, namely, LCD projectors, movie projectors, and digital photo projectors; memory card adapters” in Class 9.

16. Registration No. 4,422,735 is valid and serves as prima facie evidence of the validity of the MICRO SD HC mark, the registration of the mark, Opposer’s ownership of the mark, and Opposer’s exclusive right to use the mark in commerce on or in connection with the goods specified therein, under Lanham Act § 33, 15 U.S.C. § 1115.

17. Opposer and its licensees have expended substantial sums in marketing, advertising, and promoting the SD Marks, which are inherently distinctive indicators of the origin of Opposer’s goods.

18. By reason of the extensive marketing, advertising, and promoting of Opposer’s goods, its SD Marks have become extraordinarily famous symbols of the valuable goodwill associated with Opposer and its high quality products.

19. Notwithstanding Opposer’s prior established rights in its SD Marks, Applicant filed Application Serial No. 85/653,269 on June 15, 2012 for the mark SD-ASIC (the “Applicant’s Mark”) for “Computer programs for use in the design of semiconductor devices, and associated documentation and instructional manuals sold together as a unit; Design libraries,

namely, downloadable electronic data files for use in integrated circuit and semiconductor design; Semiconductor chips; Semiconductor devices; Semiconductors; Very large scale integration (VLSI) semiconductor integrated circuits ” in Class 9, which is the subject of this opposition.

20. Applicant’s Mark is nearly identical in appearance and sound to Opposer’s SD Marks, in that it incorporates the entirety of Opposer’s SD mark followed by the descriptive acronym “ASIC.”

21. Applicant filed Application Serial No. 85/653,269 based on an intent to use in commerce.

22. Upon information and belief, Applicant had actual and/or constructive knowledge of Opposer’s SD Marks before Applicant filed the subject application and before it sold any products under Applicant’s Mark in the United States.

24. Opposer has not authorized, endorsed, or approved the goods Applicant intends to offer under the Applicant’s Mark.

Count I: Likelihood of Confusion – §2(d)

25. Opposer hereby incorporates by reference the allegations contained in paragraphs 1 through 24, above.

26. Applicant’s Mark so closely resembles Opposer’s SD Marks that the use and registration of Applicant’s Mark would likely cause confusion, mistake, and deception as to the source or origin of Applicant’s goods and would injure and damage Opposer and the goodwill and reputation symbolized by Opposer’s SD Marks.

27. Given that the term “ASIC” is descriptive, the remaining term “SD” in Applicant’s Mark is the dominant portion of said mark and this is identical to the “SD” found in Opposer’s SD Marks.

28. Likelihood of confusion is enhanced by the fact that the goods listed in the opposed application are related, ancillary, or identical to those offered by Opposer under its SD Marks.

29. Upon seeing related goods offered under the parties’ respective marks, consumers are likely to be confused, to be deceived, and to assume erroneously that Applicant’s goods are those of, or approved by, Opposer, or that Opposer approves of the manner in which Applicant’s Mark is being used, all to Opposer’s irreparable damage.

30. If Applicant is granted registration of Applicant’s Mark, Applicant will obtain the *prima facie* exclusive right to use Applicant’s Mark in the United States, and such registration will impair and diminish Opposer’s goodwill and rights in its SD Marks, thereby causing irreparable damage and injury to Opposer.

Count II: Deception/False Suggestion of Connection – § 2(a)

31. Opposer hereby incorporates by reference the allegations contained in paragraphs 1 through 30, above.

32. Applicant’s Mark so closely resembles Opposer’s SD Marks that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that Applicant’s Mark misdescribes the nature or origin of the goods and services, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods and services, and this is likely to materially alter purchasers’ decisions to acquire Applicant’s goods.

33. Applicant's Mark so closely resembles Opposer's SD Marks that it falsely suggests a connection with Opposer, in violation of Lanham Act Section 2(a), because Applicant's Mark points uniquely to Opposer and is used alongside Opposer's SD Marks, and purchasers will assume that goods sold under Applicant's Mark are connected with or approved by Opposer.

34. Applicant's Mark is deceptive in that it falsely suggests a connection with or approval by Opposer.

35. Use and registration by Applicant of the Applicant's Mark will damage Opposer by depriving it of the ability to protect its reputation, persona and goodwill.

Count III. Dilution – Lanham Act § 43(c)

36. Opposer hereby incorporates by reference the allegations contained in paragraphs 1 through 35 above.

37. Opposer's SD Marks are distinctive and famous and are entitled to the protection afforded by the anti-dilution provisions of Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c).

38. The SD Marks became distinctive and famous prior to the date on which Applicant applied to register Applicant's Mark and, upon information and belief, prior to any use of the Applicant's Mark by Applicant.

39. Permitting the registration of Applicant's Mark will impair, diminish, tarnish, and dilute Opposer's goodwill and rights in its famous SD Marks, thereby causing irreparable injury to Opposer.

40. By reason of the foregoing, Opposer will be damaged by the registration of the Applicant's Mark.

WHEREFORE, Opposer prays that this opposition be sustained and that registration of the Applicant's Mark be denied.

SD-3C LLC



By: _____

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ARENT FOX LLP
1717 K Street, NW
Washington, DC 20006
(202) 857-6000


Date: September 17, 2015

Attorneys for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Notice of Opposition (re U.S. Ser. No. 85/653,269) is being served on September 17, 2015, upon Applicant's attorney of record via first class mail, postage prepaid, at the following address:

David H. Jaffer
Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500-IP Group
McLean, VA 22102

By: 

Luna M. Samman