ESTTA Tracking number:	**ESTTA1344877**
Filing date:	**03/08/2024**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner information

Name	ERM Electronic Systems LTD.		
Entity	limited company	Incorporated or registered in	Israel
Address	16 HASAR SHAPIRA ST. RISHON LEZIYYON, 7570418 ISRAEL		

Attorney information	PAULO A. DE ALMEIDA PATEL & ALMEIDA, P.C. 16830 VENTURA BLVD., SUITE 360 ENCINO, CA 91436 UNITED STATES Primary email: trademarks@paiplaw.com Secondary email(s): paulo@paiplaw.com, alex@paiplaw.com, nikki@paiplaw.com, andrew@paiplaw.com, inbox@paiplaw.com 8183801900
Docket no.	

Registration subject to cancellation

Registration no.	5697506	Registration date	03/12/2019
Register	Principal		
International registration no.	NONE	International registration date	NONE
Registrant	SUBARU CORPORATION 1-20-8, EBISU SHIBUYA-KU, TOKYO JAPAN		

Goods/services subject to cancellation

Class 012. First Use: Aug 2014 First Use In Commerce: Aug 2014
All goods and services in the class are subject to cancellation, namely: Electronic interface modules sold as an integral part of a motor land vehicle for wired and wireless interface of handheld electronic devices which include a communication function, and their parts and fittings

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)

Marks cited by petitioner as basis for cancellation

U.S. application no.	90734117	Application date	05/25/2021
Register	Principal		
Registration date	NONE	Foreign priority date	NONE
Word mark	STARLINK		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: 2009 First Use In Commerce: 2009 GPS tracking and navigation devices for vehicles; Wireless communication devices for voice, data or image transmission for use in vehicles Class 038. First use: First Use: Jan 25, 2021 First Use In Commerce: Jan 25, 2021 Telecommunications services, namely, providing access to satellite transmissions of audio and visual data for GPS navigation and location for vehicles; Providing user access to global positioning signals for navigation and location for vehicles; Providing services for electronic transmission of text, audio, video, image, signals, position, movement and data between land vehicles		

U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		
Registration date	NONE		
Mark	STARLINK		
Goods/services	Wireless GPS tracking, navigation, and telecommunications devices for vehicles; Wireless telecommunications based devices for enabling access to satellite transmissions of data for GPS navigation and positioning signals for location; data transmission for vehicle telematics, fleet management and stolen vehicle recovery applications; and electronic transmission of data such as text, audio, video, images, signals, positions, movement, and other data between land vehicles to cloud servers		

Attachments	STARLINK Petition for Cancellation.pdf(143423 bytes)

Signature	/Paulo A. de Almeida/
Name	Paulo A. de Almeida
Date	03/08/2024

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

ERM Electronic Systems LTD., Petitioner, v. Subaru Corporation, Respondent.	Cancellation No.: _____ Registration No.: 5,697,506 Mark: STARLINK

PETITION FOR CANCELLATION

ERM Electronic Systems LTD. ("Petitioner"), a limited company of Israel, believes it has been damaged by Registration No. 5,697,506 for the mark STARLINK in International Class 12, and hereby petitions to cancel the same. As grounds in support of its petition, Petitioner alleges as follows:

Petitioner and its STARLINK Mark

1. Petitioner is an advanced telematics technology company established in 1985 which designs, develops, and produces electronic devices and software solutions in the fields of vehicle tracking and monitoring, IoT (Internet of Things), and security.
2. Since at least as early as 2009, Petitioner has produced and sold wireless GPS tracking, navigation, and telecommunications devices for vehicles in the United States under its word trademark STARLINK (hereinafter, the "STARLINK Mark"). A photograph of the STARLINK device is shown as follows:

STARLINK is a telecommunications based device for enabling access to satellite transmissions of data for GPS navigation and positioning signals for location; data transmission for vehicle telematics, fleet management and stolen vehicle recovery applications; and electronic transmission of data such as text, audio, video, images, signals, positions, movement, and other data between land vehicles to cloud servers.

3. As a result of Petitioner's continuous use of the STARLINK Mark for the foregoing devices for many years, the STARLINK Mark has come to represent highly valuable consumer goodwill.

4. Petitioner has developed common law trademark rights in the STARLINK Mark for the foregoing goods, with priority of use established at least as early as 2009.

5. On May 25, 2021, Petitioner filed U.S. Trademark Application Ser. No. 90/734,117 for the mark STARLINK based on its use of the mark in commerce for the following goods and services:

> International Class 9
>
> GPS tracking and navigation devices for vehicles; Wireless communication devices for voice, data or image transmission for use in vehicles

International Class 38

> Telecommunications services, namely, providing access to satellite transmissions of audio and visual data for GPS navigation and location for vehicles; Providing user access to global positioning signals for navigation and location for vehicles; Providing services for electronic transmission of text, audio, video, image, signals, position, movement and data between land vehicles

("Petitioner's STARLINK Application").

6. On February 7, 2022, Petitioner's STARLINK Application was refused under Section 2(d) based on a finding of a likelihood of confusion with U.S. Reg. No. 5,697,506 for the mark STARLINK, petitioned herein (the "STARLINK Registration").

Respondent's STARLINK Registration

7. On May 7, 2012, Respondent Subaru Corporation (hereinafter, "Respondent"), then under its previous company name FUJI JUKOGYO KABUSHIKI KAISHA, filed U.S. Trademark Application Serial Number 85/618,266 for the mark STARLINK based on its alleged *bona fide* intent use the mark in commerce for the following goods in International Class 9:

> Electronic interface modules sold as an integral part of a motor land vehicle for wired and wireless interface of handheld electronic devices which include a communication function, and their parts and fittings; electronic interface modules for use in motor land vehicles for wired and wireless interface of mobile phones and handheld telecommunication devices with an automotive electric system, and their parts and fittings; telecommunication machines and apparatus for vehicles; navigational instruments for vehicles; telecommunication machines and apparatus; electronic machines, apparatus and their parts

(hereinafter, the "Subaru STARLINK Application"). The Subaru STARLINK Application included a Section 44(d) priority claim based on Japanese Trademark Application No. 2012-020349 filed on March 16, 2012. Therefore, under Section 44(d) of the Trademark Act, the Subaru STARLINK Application was given a priority filing date of March 16, 2012.

8. On July 13, 2017, the USPTO recorded a "Change of Name and Address" for the Subaru STARLINK Application updating the applicant's name from FUJI JUKOGYO KABUSHIKI KAISHA to Subaru Corporation.

9. On July 19, 2018, Respondent Subaru Corporation filed a Statement of Use for the STARLINK Application. In the Statement of Use, Respondent alleged use of the STARLINK mark in commerce for "Electronic interface modules sold as an integral part of a motor land vehicle for wired and wireless interface of handheld electronic devices which include a communication function, and their parts and fittings" in International Class 12. Respondent alleged a "first use" of the STARLINK mark anywhere and in commerce as of August of 2014.

10. On March 12, 2019, the USPTO issued Reg. No, 5,697,506 for the STARLINK Registration to Respondent.

COUNT I - PRIORITY OF USE AND LIKELIHOOD OF CONFUSION

11. On information and belief, Respondent does not have any basis for claiming rights in the mark STARLINK before March 16, 2012, the Section 44(d) priority filing date of the Subaru STARLINK Application.

12. Petitioner's first use of the STARLINK Mark at least as early as 2009 predates the Section 44(d) priority filing date of Subaru's STARLINK Application.

13. Petitioner's first use of the STARLINK Mark at least as early as 2009 predates Respondent’s claimed first use date of STARLINK in August of 2014.
14. Petitioner's first use of the STARLINK Mark at least as early as 2009 predates the earliest priority date upon which Respondent may rely for STARLINK.
15. Petitioner has priority in the STARLINK Mark as against Respondent.
16. The STARLINK mark of the STARLINK Registration is identical to Petitioner's STARLINK Mark, and is likely, when applied to Respondent's goods, to cause confusion, mistake or deception among consumers within the meaning of 15 U.S.C. § 1052(d).
17. According to the USPTO’s Office Action refusal of Petitioner’s STARLINK Application, Respondent's goods of the STARLINK Registration are related to Petitioner’s STARLINK goods for likelihood of confusion purposes. Thus, Respondent’s goods are or would be sold, advertised and directed at the same marketing and trade channels, and to the same consumers, as Petitioner's goods, or are in the natural scope of expansion of Petitioner's goods.
18. The STARLINK mark of the STARLINK Registration so resembles Petitioner's STARLINK Mark, and the goods are related such that the public is likely to view the mark of Respondent’s registration as denoting an affiliation, connection, or association of Respondent with Petitioner and as to the origin, sponsorship, and approval of Respondent's goods by Petitioner, when that is not the case, thereby damaging Petitioner.
19. Petitioner has been damaged in that Respondent’s continued registration of STARLINK will give colorable exclusive statutory rights to the Respondent in

violation and derogation of the prior and superior common law trademark rights of Petitioner. In addition, Petitioner's STARLINK Application has been refused under Section 2(d) based on a finding of a likelihood of confusion with the STARLINK Registration.

WHEREFORE, Petitioner prays that this Petition for Cancellation be sustained, and that Registration No. 5,697,506 be cancelled.

Respectfully Submitted,

Dated: March 8, 2024

By: /Paulo A. de Almeida/

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