

different name than the name of the party that filed the request(s) for extension will not be rejected for that reason if the party in whose name the extension was requested was misidentified through mistake. T.B.M.P. § 206.03.

I. Fireye and Walter Kidde Are in Privity

Fireye and Walter Kidde are related companies and are in privity. An opposition filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension. T.B.M.P. § 206.02. Privity in the field of trademarks generally includes the relationship of "related companies" within the meaning of 15 U.S.C. §§ 1055 and 1127. Id. (citing Int'l Nutrition Co. v. Horphag Research Ltd., 220 F.3d 1325 (Fed. Cir. 2000)).

Where a registered mark or a mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the registrant or applicant for registration, and such use shall not affect the validity of such mark or of its registration, provided such mark is not used in such manner as to deceive the public. If first use of a mark by a person is controlled by the registrant or applicant for registration of the mark with respect to the nature and quality of the goods or services, such first use shall inure to the benefit of the registrant or applicant, as the case may be.

15 U.S.C. § 1044 (2004). Similarly, "[t]he term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used." 15 U.S.C. § 1127. The showing of privity should be in the form of a recitation of the facts upon which privity is based. T.B.M.P. § 206.02. The recitation of facts is as follows:

Walter Kidde and Fireye are related companies because both entities are wholly owned by Kidde Fire Protection, Inc., a Delaware Corporation ("Kidde Fire Protection"). Walter Kidde controls use of the FYRNETICS mark, U.S. Registration No. 1,072,151, registered August 30, 1997, and the quality of the goods or services on or in connection with the FYRNETICS mark is used. Any use of the FYRNETICS mark would therefore be controlled by Walter Kidde. Kidde Fire Protection is the parent company of Walter Kidde and is therefore in direct privity with Walter Kidde. Kidde Fire Protection is the parent company of Fireye and is therefore in direct privity with Fireye. As a result, Walter Kidde and Fireye are related companies, and as relates to the FYRNETICS mark, in privity. For this reason, the motion for leave to substitute should be granted.

II. Fireye Was Misidentified In The Requests For Extension Through Mistake

An opposition filed in a different name will not be rejected for that reason if it is shown to the satisfaction of the Board that the party in whose the name was requested was misidentified through mistake. T.B.M.P. § 206.03. Misidentification by mistake means a mistake in the form of the potential opposer's name or its entity type.¹ Id. (citing Custom Computer Services, Inc. v. Paychex Properties, Inc., 337 F.3d 1334 (Fed. Cir. 2003)). The showing to the Board must be in the form of a recitation of the facts upon which the claim of misidentification by mistake is based. Id. The recitation of facts is as follows:

A mistake occurred in this case because of the similarity of the name Fireye, Inc. and the name of the prior owner of the FYRNETICS mark. The FYRNETICS mark was owned by Fyrnetics, Inc. ("Fyrnetics") until Fyrnetics merged with Walter Kidde on June

¹ Misidentification by mistake does not include the naming of a different existing legal entity not in privity with the party that should have been named. T.B.M.P. § 206.03. As discussed above, Fireye, Inc. and Walter Kidde are in privity.

8, 1998. As stated, Walter Kidde and Fireye are both owned by Kidde Fire Protection. Kidde Fire Protection is owned by Kidde US Holdings, Inc., a Delaware Corporation. Kidde US Holdings, Inc is owned by KNA, Inc., a Delaware Corporation. KNA, Inc. is owned by Kidde America Inc. (Delaware), which is owned by Kidde International Limited, a United Kingdom Corporation. Kidde International Limited is owned by Kidde Holdings, Limited (U.K.), which is owned by Kidde plc, a United Kingdom Corporation.

Counsel for Walter Kidde became counsel for Kidde plc and its many subsidiaries (including Walter Kidde, Kidde Fire Protection, and Fireye) around April 2002 and has had numerous assignments to record as a result of the Fyrnetics/Walter Kidde merger and various other Kidde plc mergers. The recording of the Fyrnetics and Walter Kidde merger was recorded on June 1, 2004. As a result of the large number of ongoing assignments and other matters for each of the Kidde plc subsidiaries, Counsel inadvertently filed the requests for extension in the name of Fireye, Inc. Therefore, the request for extension misidentified Fireye, Inc. through mistake. For this reason, the motion for leave to substitute should be granted.

CONCLUSION

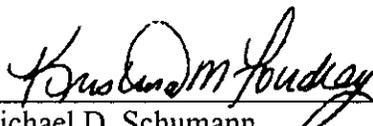
For the abovementioned reasons, Walter Kidde respectfully requests that leave to substitute Walter Kidde Portable Equipment, Inc. for Fireye, Inc. in the First 30 Day Request for An Extension of Time to Oppose and in the 60 Day Request for Extension of Time to Oppose for Good Cause be granted.

Respectfully submitted,

WALTER KIDDE PORTABLE EQUIPMENT INC.

By its attorneys,

Dated: August 13, 2004 


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A Professional Corporation

Walter Kidde Portable Equipment Inc.)
Opposer)
v.) Opposition No _____
Hochiki America Corporation)
Applicant)
)

TTAB

Mark: FIRENET

Serial No.: 76/519201

Docket Number: 13835.120USTA

Official Gazette: February 10, 2004

Due Date: August 13, 2004

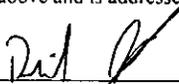
Filing Date: May 21, 2003

CERTIFICATE UNDER 37 CFR 1.10

"Express Mail" mailing label number:

Date of Deposit: August 13, 2004

I hereby certify that this paper or fee is being deposited with the United States Postal Service 'Express Mail Post Office To Addressee' service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514.

By: 

Name: David Ortiz

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

Dear Commissioner:

We are transmitting herewith the attached:

- Return postcard.
- Transmittal Sheet in duplicate containing Certificate Under 37 C.F.R. 1.10
- Other: MOTION FOR LEAVE TO SUBSTITUTE WALTER KIDDE PORTABLE EQUIPMENT, INC. FOR FIREYE, INC. IN THE FIRST 30 DAY REQUEST FOR AN EXTENSION OF TIME TO OPPOSE AND IN THE 60 DAY REQUEST FOR AN EXTENSION OF TIME TO OPPOSE FOR GOOD CAUSE.

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate copy of this sheet is enclosed.

By: 

Name: Michael D. Schumann

MDS/slr



08-13-2004

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(CONTESTED MATTER)