

TTAB

STATEK.013M

TRADEMARK/SERVICE MARK

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

STATEK CORPORATION,

Opposer,

v.

DIPL.-ING RAINER PULS and
DIPL.-ING. OLIVER PULS,

Applicants.

Opposition No. _____

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on

January 7, 2003
(Date)

Jeffrey L. Van Hoosear

NOTICE OF OPPOSITION

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

01-13-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #70

ATT: BOX TTAB FEE

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1200.00 DP

Dear Sir:

Opposer, Statek Corporation, a California corporation, (hereinafter referred to as "Statek"), located and doing business at 512 N. Main Street, Orange, California 92868, believes that it will be damaged by registration of the mark STATEK, shown in Serial No. 76/202,322, filed January 30, 2001 by Dipl.-Ing Rainer Puls and Dipl.-Ing. Oliver Puls (hereinafter referred to as "Applicants") and hereby opposes the same.

A description of Applicants' application and the goods and services at issue is as follows:

Mark: STATEK
Serial No.: 76/202,322
Filed: January 30, 2001
Published: December 10, 2002
Int'l. Classes: 7, 9, 12 and 42
Goods/Services: 7 - drives for machines for moving loads, namely

DD

motors with transmissions, clutches, brakes and hoists; 9 - testing equipment for determining physical values, namely, travel distance meters, speedometers, accelerometers, power meters, force meters, thermometers, pressure meters, and chronographs for use as specialized time recording apparatuses; computers for monitoring and controlling drives and drive components, namely, motors, transmissions, clutches and brakes; 12 - drives for land vehicles, namely motors with transmissions, clutches and brakes; 42 - designing of drives, namely, motors, motors with transmissions clutches and brakes, and hoists; designing structures for supporting drives and hoists; development of computer software for the data processing for controlling drives and testing equipment

Alleged Date of First Use: Intent-to-Use

As grounds of opposition, it is alleged:

1. For over 30 years, Statek has been a recognized technological leader in the design, manufacture and sale of electronic timing devices and has offered such goods in connection with the name and mark STATEK.

2. Statek is the owner of United States Trademark Registration No. 2,245,679 for the mark STATEK for "electronic timing devices, namely crystals and oscillators" in International Class 9, which was registered on the Principal Register on May 18, 1999. Said registration is based on an application filed in the United States Patent and Trademark Office on December 4, 1997, alleging a date of first use of January 1971. Thus, Statek's dates of first use and registration are prior to the date Applicants filed their application and prior to Applicants' priority filing date, and prior to Applicant's alleged date of first use.

3. Statek is also the owner of United States Trademark Registration No. 2,241,565 for the mark STATEK and Design for "electronic timing devices, namely crystals and oscillators" in International Class 9, which was registered on the Principal Register on April 27, 1999. Said

registration is based on an application filed in the United States Patent and Trademark Office on December 4, 1997, alleging a date of first use of January 1971. Thus, Statek's dates of first use and registration are prior to the date Applicants filed their application and prior to Applicants' priority filing date, and prior to Applicant's alleged date of first use.

4. Since at least as early as 1971, Statek has used the STATEK and STATEK and Design marks (the "STATEK Marks") in interstate commerce in connection with the goods identified in paragraphs 1, 2 and 3 above. Statek's STATEK Marks, by virtue of Statek's substantial use, have acquired great value as identification of Statek and its goods, and distinguishes such goods from the goods of others.

5. Statek, through sales, advertising and promotion of its goods under the STATEK Marks has built up at great expense and effort, valuable goodwill symbolized by its marks.

6. Statek is the owner of and relies upon its United States Registrations specified in paragraphs 2 and 3 above. Statek's use of its STATEK Marks has been valid and continuous since said date of first use and has not been abandoned. Statek's registrations are valid, subsisting, unrevoked and uncanceled; as such this constitutes prima facie evidence of the validity of the registered marks and of the registrations thereof, and of Statek's ownership of the marks shown therein and of Statek's exclusive right to use the marks in commerce in connection with the goods name therein, without condition or limitation. Said registrations also constitute notice to Applicants of Statek's claim of ownership of the marks shown therein; all as provided in Section 7(b), 22 and 33(a) of the Trademark act of 1946, as amended.

7. Statek's use of the STATEK Marks, as specified in paragraphs 2 and 3 above, was prior to the filing of Applicants' application. Said registrations of Statek are valid and subsisting. In view of the similarity of the respective marks and the related nature of the goods of the respective parties, Statek alleges that Applicants' mark so resembles Statek's registered

STATEK Marks, previously used in the United States and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive.

8. Statek's use of the STATEK Marks and STATEK trade name has been valid and continuous since at least as early as the date of first use indicated in paragraphs 2 and 3 above and has not been abandoned. Said name and marks of Statek are symbolic of extensive goodwill and consumer recognition built up by Statek through time and effort in advertising or promotion. In view of the similarity of the respective marks and the related nature of the goods of the respective parties, it is alleged that Applicants' mark so resembles Statek's name and marks previously used in the United States, and not abandoned, as to be likely to cause confusion, or to cause mistake or deceive.

WHEREFORE, Statek prays that Application Serial No. 76/202,322 be rejected and stricken and that no registration be issued thereon to Applicant for such goods and services, and this opposition be sustained in favor of Statek.

Statek submits herewith a duplicate copy of this Notice of Opposition, along with a check in the amount of \$1,200 for the filing of the Notice of Opposition. Please charge Deposit Account No. 11-1410 for any additional fees which may be required, or credit any overpayment to this account.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: January 7, 2003

By: Jeffrey L. Van Hoosear
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Statek Corporation