

08-25-2004

U.S. Patent & TMO/TM Mail Rpt Dt. #22

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

ESTERLINE TECHNOLOGIES CORPORATION  
and  
MEMTRON TECHNOLOGIES CO.,

Opposers,

v.

MEMTRONICS CORPORATION,

Applicant.

Opposition No.:

NOTICE OF OPPOSITION

Application Serial No.: 76/440,078

Filing Date: August 14, 2002

Publication Date: April 27, 2004

Esterline Technologies Corporation ("Esterline") and Memtron Technologies Co. ("Memtron") (collectively, "Opposer") believe that they will be damaged by the registration of the mark MEMTRONICS ("Applicant's Mark") in International Classes 9, 40 and 42, for use in connection with those goods and services ("Applicant's Goods and Services") listed in Application Serial No. 76/440,078 (the "Application"), and hereby oppose same. As grounds for its opposition, Opposer alleges as follows:

**I. PARTIES**

1. Esterline is a Delaware corporation, having a place of business in Bellevue, Washington.
2. Memtron is a Delaware corporation, having a place of business in Frankenmuth, Michigan.
3. On information and belief, Applicant Memtronics Corporation ("Applicant") is a Texas corporation, having a place of business in Plano, Texas.

08/30/2004 KGIBBONS 00000011 76440078

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900.00 DP

**II. OPPOSER'S MARK**

4. Esterline, through its licensee and subsidiary Memtron, is engaged in the manufacture, sale and distribution of electrical membrane switches and switch panels (the "Registered Goods"), as well as passive and active PC board-backed membrane

switches, custom flat panel membrane switches and keypads, and graphic overlays, and related services including fully integrated system level support services, custom component manufacturing, design collaboration and application, reliability and compliance engineering (together with the Registered Goods, "Opposer's Goods and Services"), under the mark MEMTRON ("Opposer's Mark").

### **III. APPLICANT'S MARK**

5. The Application to register Applicant's Mark was filed on an intent-to-use basis on August 14, 2002 (the "Filing Date") and assigned Serial No. 76/440,078. It was published in the Official Gazette on April 27, 2004.
6. On information and belief, Applicant's Goods and Services all relate to integrated circuits and systems for controlling high-frequency signals in wireless telecommunication, defense, security, automotive, computer networking, satellite communications, radar and radio frequency imaging and other radio frequency applications (collectively, "Micro-Electro-Mechanical Systems (MEMS) Technology").

### **IV. CLAIMS**

#### **A. PRIOR USE AND REGISTRATION OF OPPOSER'S MARK**

7. For more than 20 years, Opposer and its predecessors in interest have used and promoted Opposer's Mark in connection with Opposer's Goods and Services. As a result, Opposer's Mark has developed substantial goodwill.
8. On June 26, 1984, Bronner Screen Printing Incorporated (dba Memtron Technologies) received registration No. 1,283,172 (Opposer's Registration) for Opposer's Mark covering the Registered Goods. A certified copy of Opposer's Registration, showing title to and status of the registration, together with an excerpt from the on-line records of the Trademark Office showing timely renewal of the registration, are attached to this Notice of Opposition.

9. Through a series of assignments, all properly executed and filed with the Assignment Branch of the Trademark Office, Opposer's Mark is now owned by Esterline.
10. Opposer has continuously used Opposer's Mark in connection with Opposer's Goods and Services since the date of first use of such goods and services, and has not abandoned Opposer's Mark.
11. Both registration of Opposer's Mark in connection with Opposer's Goods and first use of Opposer's Mark in connection with Opposer's Goods and Services are substantially prior to Applicant's Filing Date.
12. On information and belief, Applicant has not used Applicant's Mark in commerce.

**B. RELATIONSHIP BETWEEN ESTERLINE AND MEMTRON**

13. Memtron is a wholly-owned subsidiary of Esterline.
14. Memtron uses Opposer's Mark with Opposer's Goods and Services under an exclusive license from Esterline.

**C. LIKELIHOOD OF CONFUSION**

15. Applicant's Mark and Opposer's Mark share the component "MEMTRON", which constitutes the entirety of Opposer's Mark and the first seven letters of Applicant's Mark.
16. Applicant's Mark is highly similar in sound, meaning and appearance to Opposer's Mark.
17. Opposer's Goods and Services are increasingly incorporating MEMS technology.
18. Applicant's Goods and Services are or may be sold and/or marketed to the same types of customers and through the same channels of trade as Opposer's Goods and Services.
19. In view of the close similarity between the respective marks and the close relationship between the goods and services of the parties, Applicant's Mark so resembles Opposer's Mark as to be likely to cause confusion, or to cause mistake, or to deceive as to the origin, sponsorship and approval of Applicant's Goods and Services, and is

likely to suggest an affiliation, connection or association of Applicant and Applicant's Goods and Services with Opposer and Opposer's Goods and Services, with consequent injury to Opposer, to the trade and to the public.

20. The registration of Applicant's Mark would prevent Opposer from exercising exclusive control over the goodwill and reputation associated with Opposer's Mark. Therefore, the registration of Applicant's Mark would damage and injure Opposer.
21. Opposer will also be damaged by the registration of Applicant's Mark because such registration will yield confusion as to source or affiliation and will support statutory rights for Applicant in violation and derogation of Opposer's prior, superior and exclusive rights in Opposer's Mark.
22. Because Opposer's rights in Opposer's Mark are prior and senior to Applicant's rights in Applicant's Mark, and there exists a likelihood of confusion between these marks, registration of Applicant's Mark should be denied.

**D. DILUTION**

23. Opposer's Mark is inherently distinctive for Opposer's Goods and Services. Opposer has acquired further distinctiveness in Opposer's Mark because Opposer has expended considerable effort and expense in publicizing and promoting Opposer's Goods and Services, and Opposer has achieved widespread and substantial sales of Opposer's Goods and Services under the Opposer's Mark over at least two decades.
24. Opposer's Mark is distinctive and famous marks under the Lanham Act §43(c).
25. Applicant's registration of Applicant's Mark would lessen the capacity of Opposer's Mark to identify and distinguish Opposer's Goods and Services and will dilute the strength of Opposer's Mark. As a result, registration of Applicant's Mark should be denied.

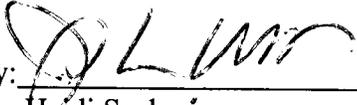
**V. REQUEST FOR RELIEF**

WHEREFORE, Opposer requests that the mark in Application Serial No. 76/440,078 be denied registration.

DATED: August 25, 2004.

Respectfully submitted,

**PERKINS COIE LLP**

By: 

Heidi Sachs

Jim Vana

Attorneys for Opposer  
1201 Third Avenue, 48th Floor  
Seattle, Washington 98101-3099

(206) 359-8000

**CERTIFICATE OF MAILING**

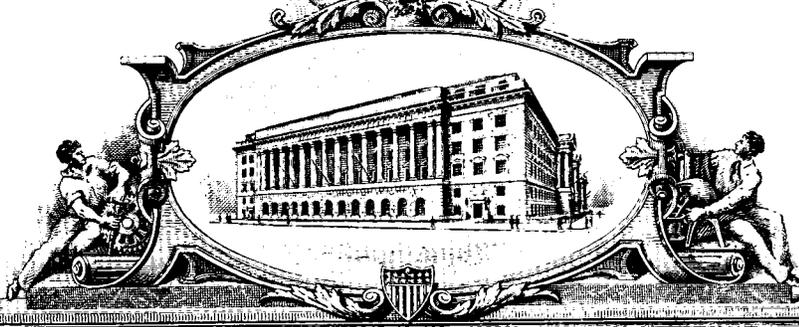
I hereby certify that on August 25, 2004, I mailed (via U.S. Express Mail # EV095497999US) the original and two copies of the attached NOTICE OF OPPOSITION regarding the mark MEMTRONICS (Serial No. 76/440,078) to:

U. S. Patent & Trademark Office  
Trademark Trial & Appeal Board  
Box TTAB-FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

  
\_\_\_\_\_  
Signature

Linda L. Martin  
\_\_\_\_\_  
Print Name

1211169



# THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

August 18, 2004

THE ATTACHED U.S. TRADEMARK REGISTRATION 1,283,172 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 20 YEARS FROM *June 26, 1984*

SECTION 8 & 15

SAID RECORDS SHOW TITLE TO BE IN:

*ESTERLINE TECHNOLOGIES CORPORATION  
A DE CORP*



By Authority of the  
COMMISSIONER OF PATENTS AND TRADEMARKS

E. BORNETT  
Certifying Officer

Int. Cl.: 9

Prior U.S. Cl.: 21

**United States Patent and Trademark Office**

**Reg. No. 1,283,172**

**Registered Jun. 26, 1984**

**TRADEMARK**  
Principal Register

**MEMTRON**

Bronner Screen Printing Incorporated (Michigan  
corporation), d.b.a. Memtron Technologies  
1400 Weiss St.  
Frankenmuth, Mich. 48734

For: ELECTRICAL MEMBRANE SWITCHES  
AND SWITCH PANELS, in CLASS 9 (U.S. Cl. 21).  
First use Dec. 15, 1982; in commerce Feb. 21,  
1983.

Ser. No. 419,283, filed Mar. 29, 1983.

CONNIE M. JUDGE, Examining Attorney

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2004-08-23 13:39:52 ET**

**Serial Number:** 73419283 Assignment Information

**Registration Number:** 1283172 Assignment Information

**Mark (words only):** MEMTRON

**Standard Character claim:** No

**Current Status:** This registration has been renewed.

**Date of Status:** 2004-08-21

**Filing Date:** 1983-03-29

**Transformed into a National Application:** No

**Registration Date:** 1984-06-26

**Register:** Principal

**Law Office Assigned:** (NOT AVAILABLE)

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 837 -Post Registration

**Date In Location:** 2004-08-21

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. ESTERLINE TECHNOLOGIES CORPORATION

**Address:**

ESTERLINE TECHNOLOGIES CORPORATION  
500 - 108TH AVENUE N.E. SUITE 1500  
BELLEVUE, WA 98004  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** Delaware

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**GOODS AND/OR SERVICES**

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**International Class:** 009

Electrical Membrane Switches and Switch Panels

**First Use Date:** 1982-12-15

**First Use in Commerce Date:** 1983-02-21

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2004-08-21 - First renewal 10 year

2004-08-21 - Section 8 (10-year) accepted/ Section 9 granted

2004-06-16 - Combined Section 8 (10-year)/Section 9 filed

2004-06-16 - TEAS Section 8 & 9 Received

1990-05-25 - Section 8 (6-year) accepted & Section 15 acknowledged

1990-03-29 - Section 8 (6-year) and Section 15 Filed

1984-06-26 - Registered - Principal Register

1984-04-03 - Published for opposition

1984-02-16 - Notice of publication

1983-12-30 - Approved for Pub - Principal Register (Initial exam)

1983-12-08 - Non-final action mailed

1983-11-01 - Case file assigned to examining attorney

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**CONTACT INFORMATION**

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**Correspondent**

Heidi L. Sachs (Attorney of record)

Heidi L. Sachs  
Perkins Coie LLP  
Suite 4800, 1201 Third Avenue  
Seattle, WA 98101-3099



# TTAB

James L. Vana  
PHONE: 206.359.3036  
FAX: 206.359.9000  
EMAIL: Jvana@perkinscoie.com

**Perkins  
Coie**

1201 Third Avenue, Suite 4800  
Seattle, WA 98101-3099  
PHONE: 206.359.8000  
FAX: 206.359.9000  
www.perkinscoie.com

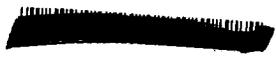
August 25, 2004

**VIA EXPRESS MAIL No. EV095497999US**

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
BOX TTAB FEE  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

EV095497999US

**Re: NOTICE OF OPPOSITION**  
**Mark: MEMTRONICS**  
**Classes: 9, 40, 42**  
**Serial No.: 76/440078**  
**Filing Date: August 14, 2002**  
**Publication date: April 27, 2004**  
**Applicant: Memtronics Corporation**  
**Ref. No.: 27329-9700.0000.CX019**

  
**08-25-2004**  
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Ladies and Gentlemen:

Enclosed for filing is the original and two copies of a Notice of Opposition regarding the mark indicated above, together with a check for \$900 to cover the filing fee.

You are authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 502278.

This request is being submitted in duplicate as required by 37 CFR §2.104(a). Please date-stamp and return the enclosed self-addressed, stamped postcard to confirm your receipt of this document.

Very truly yours,

PERKINS COIE LLP



Heidi L. Sachs  
James L. Vana  
Attorneys for Potential Opposer  
1201 Third Avenue, Suite 4800  
Seattle, Washington 98101-3099

cc: Esterline Technologies Corporation  
[27329-970027329.9700SL042380.015]

**CERTIFICATE OF MAILING UNDER 37 § 1.10**

"Express Mail" mailing Label No.: EV095497999US

I hereby certify that the Notice of Opposition against MEMTRONICS CORPORATION (SN: 76/440,078) is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR § 1.10 on August 25, 2004 is addressed to Commissioner of Trademarks, Box TTAB Fee, 2900 Crystal Drive, Arlington, Virginia 22202-3514,

Signature:   
Printed Name: Linda L. Martin