

ESTTA Tracking number: **ESTTA76426**

Filing date: **04/17/2006**

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	Intermatic Incorporated
Granted to Date of previous extension	04/16/2006
Address	Intermatic Plaza Spring Grove, IL 60081 UNITED STATES

Attorney information	John Gabrielides Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago, IL 60610 UNITED STATES officeactions@brinkshofer.com, jtg@brinkshofer.com Phone:312 321 4208
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Applicant Information

Application No	79003259	Publication date	10/18/2005
Opposition Filing Date	04/17/2006	Opposition Period Ends	04/16/2006
International Registration No.	0827009	International Registration Date	04/19/2004
Applicant	ASSA ABLOY IP AB Box 70340 SE-107 23 Stockholm SWEDEN		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Electronically controlled, electro-mechanic, electro-hydraulic and electro-pneumatic door openers; electronic sensors for opening, closing and stopping of doors for entry and exit

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	548984	Application Date	03/04/1950
Registration Date	10/02/1951	Foreign Priority	NONE

		Date	
Word Mark	INTERMATIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U026 (International Class 009). First use: First Use: 1941/04/01 First Use In Commerce: 1941/04/01 ELECTRIC SWITCHES SUBJECT TO AUTOMATIC CONTROL BY A TIMING DEVICE AND ALSO SUBJECT TO MANUAL CONTROL		

U.S. Registration No.	1080228	Application Date	10/06/1975
Registration Date	12/27/1977	Foreign Priority Date	NONE
Word Mark	INTERMATIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1974/07/31 First Use In Commerce: 1974/07/31 [ELECTRICALLY ILLUMINATED HOUSE ADDRESS SIGN] Class 011. First use: First Use: 1974/04/30 First Use In Commerce: 1974/04/30 ELECTRIC LIGHTING FIXTURES [AND PORTABLE ELECTRIC HEATER FANS]		

U.S. Registration No.	1117585	Application Date	06/22/1976
Registration Date	05/08/1979	Foreign Priority Date	NONE
Word Mark	INTERMATIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1972/05/31 First Use In Commerce: 1972/05/31 TIME SWITCHES, TIMERS, AND PHOTOELECTRIC SWITCHES Class 011. First use: First Use: 1974/04/30 First Use In Commerce: 1974/04/30 [INDOOR ELECTRIC GREENHOUSES]		

U.S. Registration No.	1117588	Application Date	08/02/1976
Registration Date	05/08/1979	Foreign Priority	NONE

		Date	
Word Mark	INTERMATIC		
Design Mark	INTERMATIC		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1941/04/01 First Use In Commerce: 1941/04/01 TIMING MOTORS, TIME SWITCHES, TIMERS, PHOTO-ELECTRIC SWITCHES, [THERMOSTAT CONTROLS, ELECTRICALLY ILLUMINATED HOUSE ADDRESS SIGNS]</p> <p>Class 011. First use: First Use: 1974/08/05 First Use In Commerce: 1974/08/05 ELECTRIC LIGHTING FIXTURES, [INDOOR ELECTRIC GREENHOUSES, AND PORTABLE ELECTRIC HEATERS]</p>		

U.S. Registration No.	1381137	Application Date	06/17/1985
Registration Date	02/04/1986	Foreign Priority Date	NONE
Word Mark	INTERMATIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1972/05/31 First Use In Commerce: 1972/05/31 TIME SWITCHES, TIMERS, AND TIMING MOTORS		

U.S. Registration No.	2399112	Application Date	12/09/1998
Registration Date	10/31/2000	Foreign Priority Date	NONE
Word Mark	INTERMATIC		
Design Mark	INTERMATIC		
Description of	NONE		

Mark	
Goods/Services	Class 009. First use: First Use: 1989/07/01 First Use In Commerce: 1989/07/01 surge protectors for use with computers, TV/VCR equipment and telecommunication equipment

Attachments	73065239#TMSN.gif (1 page) 73091263#TMSN.gif (1 page) 73095263#TMSN.gif (1 page) 73543531#TMSN.gif (1 page) 75602277#TMSN.gif (1 page) Not of Opp F 041706.pdf (16 pages)
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Signature	/jtg/
Name	John Gabrielides
Date	04/17/2006

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

In the matter of application Serial No. 79/003,259
Published in the *Official Gazette* (Trademarks) on October 18, 2005

INTERMATIC INCORPORATED,)
)
 Opposer,)
)
 v.)
)
 BESAM INTERNATIONAL AB,)
)
 Applicant.)

NOTICE OF OPPOSITION

Intermatic Incorporated hereby alleges and avers, on information and belief, as follows:

1. Intermatic Incorporated ('Opposer') is a Delaware corporation located and doing business at Intermatic Plaza, Spring Grove, Illinois 60081.
2. Opposer owns each of the following U.S. Trademark Registrations registered on the Principal Register (copies attached at Exhibits A-F, respectively):
 - A. Reg. No. 548,984: INTERMATIC for 'electric switches subject to automatic control by a timing device and also subject to manual control,' in Class 9, registered October 2, 1951.
 - B. Reg. No. 1,080,228: INTERMATIC and Design for 'electric lighting fixtures,' in Class 11, registered December 27, 1977.
 - C. Reg. No. 1,117,585: INTERMATIC and Design for 'time switches, timers, and photoelectric switches,' in Class 9, registered on May 8, 1979.

- D. Reg. No. 1,117,588: INTERMATIC for 'timing motors, time switches, timers, photo-electric switches,' in Class 9; and for 'electric lighting fixtures,' in Class 11, registered on May 8, 1979.
- E. Reg. No. 1,381,137: INTERMATIC and Design for 'time switches, timers, and timing motors,' in Class 9, registered on February 4, 1986.
- F. Reg. No. 2,399,112: INTERMATIC for 'surge protectors for use with computers, TV/VCR equipment and telecommunication equipment,' in Class 9, registered on October 31, 2000.

- 3. Registration No. 548,984 is incontestable under §15 of the Lanham Act.
- 4. Registration No. 1,080,228 is incontestable under §15 of the Lanham Act.
- 5. Registration No. 1,117,585 is incontestable under §15 of the Lanham Act.
- 6. Registration No. 1,117,588 is incontestable under §15 of the Lanham Act.
- 7. Registration No. 1,381,137 is incontestable under §15 of the Lanham Act.
- 8. Long before December 5, 2003, or the date on which Besam International AB

('Applicant') claims actual or constructive use of the mark under application, or Applicant's claimed priority date, whichever is earliest, Opposer adopted and first used INTERMATIC (with and/or without a corresponding design) as a trademark on or in connection with the goods listed above. Since then, Opposer has continuously used, has not abandoned, and is now using INTERMATIC as its trademark on or in connection with some or all of the goods.

9. Long before December 5, 2003, or the date on which Applicant claims actual or constructive use of the mark under application, or Applicant's claimed priority date, whichever is earliest, Opposer adopted and used INTERMATIC as its trade name. Since then, Opposer has continuously used, has not abandoned, and is now using INTERMATIC as its trade name.

10. As a result of (among other things) Opposer's lengthy, substantial, and widespread use and promotion of its trademark and trade name in interstate commerce, INTERMATIC has become widely and favorably known throughout the United States and has become recognized by the trade and public as identifying Opposer's goods and trade identity and distinguishing them from the goods and trade identities of others. Opposer has thus established an exceedingly valuable goodwill and consumer recognition in its INTERMATIC trademark and trade name.

11. Also as a result of (among other things) Opposer's lengthy, substantial, and widespread use and promotion of its trademark and trade name in interstate commerce, INTERMATIC is famous and has been famous since before December 5, 2003, or the date on which Applicant claims actual or constructive use of the mark under application, or Applicant's claimed priority date, whichever is earliest.

12. Opposer's INTERMATIC trademark and trade name has been found to be famous as a matter of law based on, in part, Opposer's long history and use of INTERMATIC and the fact that it is a strong, fanciful, federally-registered mark that has been used exclusively by Opposer for more than 50 years. *Intermatic Inc. v. Toeppen*, 40 U.S.P.Q.2d 1412, 1421-22, *adopted in full and supplemented*, 41 U.S.P.Q.2d 1223 (N.D.Ill. 1996).

13. On information and belief, Applicant is a limited partnership organized and located in Sweden. On information and belief, Applicant is composed of Entre-Matic AB, Besam AB, and Besam Export AB, all Swedish joint stock companies.

14. On April 19, 2004, Applicant filed with the U.S. Patent and Trademark Office an application to register ENTRE MATIC and Design for use on or in connection with 'electronically controlled, electro-mechanical, electro-hydraulic and electro-pneumatic door openers; electronic sensors for opening, closing and stopping of doors for entry and exit,' in Class 9. The application was given Serial No. 79/003,259.

15. ENTRE MATIC and Design, when used on or in connection with the goods listed in Applicant's application, is likely to cause confusion, mistake, or deception as to the affiliation, connection, or association between Applicant and Opposer.

16. ENTRE MATIC and Design, when used on or in connection with the goods listed in Applicant's application, is likely to cause confusion, mistake, or deception as to the origin, sponsorship, or approval of Applicant's goods by Opposer.

17. ENTRE MATIC and Design, when used on or in connection with the goods listed in Applicant's application, is likely to cause dilution of Opposer's famous INTERMATIC trademark and trade name.

18. If Applicant is permitted to register ENTRE MATIC and Design for the goods specified in its application, Opposer will be damaged.

WHEREFORE, Opposer prays that application Serial No. 79/003,259 be refused registration and that this opposition be sustained.

Respectfully submitted,



John T. Gabrielides
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

Attorneys for Opposer
INTERMATIC, INC.

Exhibit A

Int. Cl.: 9

Prior U.S. Cl.: 26

United States Patent and Trademark Office
10 Year Renewal

Reg. No. 548,984

Registered Oct. 2, 1951

Renewal Term Begins Oct. 2, 1991

**TRADEMARK
PRINCIPAL REGISTER**

INTERMATIC

INTERMATIC INCORPORATED (ILLI-
NOIS CORPORATION)
INTERMATIC PLAZA
SPRING GROVE, IL 60081, BY ASSIGN-
MENT AND CHANGE OF NAME
FROM INTERNATIONAL REGISTER
COMPANY (ILLINOIS CORPORA-
TION) CHICAGO 12, IL

FOR: ELECTRIC SWITCHES SUBJECT
TO AUTOMATIC CONTROL BY A
TIMING DEVICE AND ALSO SUBJECT
TO MANUAL CONTROL, IN CLASS 26
(INT. CL. 9).²

FIRST USE 4-1-1941; IN COMMERCE
4-1-1941.

SER. NO. 71-593,414, FILED 3-4-1950.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on July 28, 1992.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Exhibit B

Int. Cls.: 9 and 11

Prior U.S. Cls.: 13, 21, 23, 26, 31, 34, 36 and 38

United States Patent and Trademark Office

10 Year Renewal

Reg. No. 1,080,228

Registered Dec. 27, 1977

Renewal Term Begins Dec. 27, 1997

TRADEMARK
PRINCIPAL REGISTER

INTERMATIC

INTERMATIC, INCORPORATED
(DELAWARE CORPORATION)
INTERMATIC PLAZA
SPRING GROVE, IL 60081

OWNER OF U.S. REG. NO. 855,464.

FOR: [ELECTRICALLY ILLUMINATED
HOUSE ADDRESS SIGN], IN CLASS
9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 7-31-1974; IN COMMERCE
7-31-1974.

FOR: ELECTRIC LIGHTING FIX-
TURES [AND PORTABLE ELECTRIC
HEATER FANS], IN CLASS 11 (U.S. CLS.
13, 21, 23, 31 AND 34).

FIRST USE 4-30-1974; IN COMMERCE
4-30-1974.

SER. NO. 73-065,239, FILED 10-6-1975.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on May 26, 1998.*

Exhibit C

Int. Cl.: 9

Prior U.S. Cl.: 21

Reg. No. 1,117,585

United States Patent and Trademark Office

Registered May 8, 1979

10 Year Renewal

Renewal Term Begins May 8, 1999

TRADEMARK
PRINCIPAL REGISTER

XINTERMATIC

INTERMATIC INCORPORATED (DELA-
WARE CORPORATION)
INTERMATIC PLAZA
SPRING GROVE, IL 60081

OWNER OF U.S. REG. NOS. 548,984
AND 855,464.

FOR: TIME SWITCHES, TIMERS, AND
PHOTOELECTRIC SWITCHES, IN
CLASS 9 (U.S. CL. 21).

FIRST USE 5-31-1972; IN COMMERCE
5-31-1972.

SER. NO. 73-091,263, FILED 6-22-1976.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Aug. 10, 1999.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Exhibit D

Int. Cls.: 9 and 11

Prior U.S. Cls.: 13, 21, 23, 26, 31, 34, 36 and 38

United States Patent and Trademark Office

10 Year Renewal

Reg. No. 1,117,588

Registered May 8, 1979

Renewal Term Begins May 8, 1999

**TRADEMARK
PRINCIPAL REGISTER**

INTERMATIC

INTERMATIC INCORPORATED (DELA-
WARE CORPORATION)
INTERMATIC PLAZA
SPRING GROVE, IL 60081

OWNER OF U.S. REG. NOS. 548,984
AND 855,464.

FOR: TIMING MOTORS, TIME
SWITCHES, TIMERS, PHOTO-ELEC-
TRIC SWITCHES, [THERMOSTAT CON-
TROLS, ELECTRICALLY ILLUMINAT-
ED HOUSE ADDRESS SIGNS], IN
CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 4-1-1941; IN COMMERCE
4-1-1941.

FOR: ELECTRIC LIGHTING FIX-
TURES, [INDOOR ELECTRIC GREEN-
HOUSES, AND PORTABLE ELECTRIC
HEATERS], IN CLASS 11 (U.S. CLS. 13,
21, 23, 31 AND 34).

FIRST USE 8-5-1974; IN COMMERCE
8-5-1974.

SER. NO. 73-095,263, FILED 8-2-1976.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Jan. 18, 2000.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Exhibit E

Int. Cl.: 9

Prior U.S. Cls.: 21 and 26

United States Patent and Trademark Office

Reg. No. 1,381,137

Registered Feb. 4, 1986

**TRADEMARK
PRINCIPAL REGISTER**

INTERMATIC

INTERMATIC INCORPORATED (DELAWARE
CORPORATION)
INTERMATIC PLAZA
SPRING GROVE, IL 60081

FIRST USE 5-31-1972; IN COMMERCE
5-31-1972.
OWNER OF U.S. REG. NOS. 855,464, 1,080,228,
AND 1,117,585.

FOR: TIME SWITCHES, TIMERS, AND
TIMING MOTORS, IN CLASS 9 (U.S. CLS. 21
AND 26).

SER. NO. 543,531, FILED 6-17-1985.

PAUL F. GAST, EXAMINING ATTORNEY

Exhibit F

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36 and 38

Reg. No. 2,399,112

United States Patent and Trademark Office

Registered Oct. 31, 2000

**TRADEMARK
PRINCIPAL REGISTER**

INTERMATIC

**INTERMATIC INCORPORATED (DELAWARE COR-
PORATION)
INTERMATIC PLAZA
SPRING GROVE, IL 60081**

**FOR: SURGE PROTECTORS FOR USE WITH
COMPUTERS, TV/VCR EQUIPMENT AND TELE-**

**COMMUNICATION EQUIPMENT, IN CLASS 9 (U.S.
CLS. 21, 23, 26, 36 AND 38).
FIRST USE 7-1-1989; IN COMMERCE 7-1-1989.**

SER. NO. 75-602,277, FILED 12-9-1998.

JENNIFER MARTIN, EXAMINING ATTORNEY