

ESTTA Tracking number: **ESTTA190318**

Filing date: **02/01/2008**

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	Future Communications Corporation of New York d/b/a Virtual Service
Granted to Date of previous extension	02/02/2008
Address	104 W. 40th Street 2nd Floor New York, NY 10018 UNITED STATES

Attorney information	Zeynel Karcioglu Zeynel Karcioglu, Esq. 36 East 20th Street New York, NY 10003 UNITED STATES zeynel@karcioglu-law.com Phone:212.505.6933
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Applicant Information

Application No	77067418	Publication date	12/04/2007
Opposition Filing Date	02/01/2008	Opposition Period Ends	02/02/2008
Applicant	American Security Systems, Inc. 5-44 50th Avenue Long Island City, NY 11101 UNITED STATES		

Goods/Services Affected by Opposition

Class 045. First Use: 2007/04/00 First Use In Commerce: 2007/04/00 All goods and services in the class are opposed, namely: electronic monitoring of building entry ways for security purposes, namely, remote video monitoring through a system connected to a central station for monitoring or accepting deliveries of packages and other items

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	77076929	Application Date	01/05/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	VIRTUAL DOORMAN		
Design Mark			

Description of Mark	"VIRTUAL"
Goods/Services	<p>Class 009. First use: First Use: 2001/04/01 First Use In Commerce: 2001/06/30 Security and surveillance systems, namely, audio and video equipment in the nature of video monitors, surveillance cameras, video intercoms, modems and routers, video code cards, speakers, microphones, intercoms, software for operating and interacting with surveillance systems; security and surveillance computer programs for the enabling or prevention of building access; biometrics equipment, namely, biometrics scanners for locking and unlocking entryways and permitting use of systems; remote entry and locking equipment in the nature of biometric locks and locks controlled over IP; proximity sensors; security and surveillance systems, namely, electronic regulating and control devices for remote operation of HVAC, lighting, elevators, alarms, sirens, gates, locks, audio video equipments, such as televisions, stereos, computers, telephones, all for residential buildings and homes; security and surveillance systems, namely, electronic regulating and control devices for the same; none of the above for use with vehicles</p> <p>Class 037. First use: First Use: 2001/04/01 First Use In Commerce: 2001/06/30 Installation and maintenance of security systems</p> <p>Class 045. First use: First Use: 2001/04/01 First Use In Commerce: 2001/06/30 Monitoring security and surveillance systems</p>

Attachments	77076929#TMSN.jpeg (1 page)(bytes) Notice of Opposition - VIDEO DOORMAN.pdf (7 pages)(214545 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/zk/
Name	Zeynel Karcioglu
Date	02/01/2008

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

In the matter of Application Serial No. 77/067,418 for the
Mark VIDEO DOORMAN
Published in the Official Gazette December 4, 2007

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FUTURE COMMUNICATIONS CORPORATION
OF NEW YORK d/b/a VIRTUAL SERVICE

Opposer,

v.

AMERICAN SECURITY SYSTEMS, INC.

Applicant

_____x

NOTICE OF OPPOSITION

Future Communications Corporation of New York, d/b/a/ VIRTUAL SERVICE, a New York Corporation, having a place of business at 104 W. 40th Street, 2nd Floor New York, New York 10018 (“Opposer” or “Virtual Service”) believes that it will be damaged by the registration of the application for VIDEO DOORMAN, Serial Number 77/067,418, published in the Official Gazette December 4, 2007, and hereby opposes said application.

As grounds for its opposition, Opposer, by its attorney, Zeynel Karcioğlu, Esq., an attorney in good standing admitted to practice in the State of New York, alleges, upon its own knowledge, or otherwise upon information and belief, as follows:

1. Commencing long prior to Applicant’s filing date of December 19, 2006, Opposer has continuously and consistently used the mark VIRTUAL DOORMAN in connection with the advertising, promotion and sale of its security and surveillance systems, hardware and software

related to these systems, as well installation and monitoring services in connection with the same.

2. Opposer has expended large sums of money and great time and effort in developing, using, advertising and promoting the VIRTUAL DOORMAN mark and the products and services associated with that mark across the United States.

3. Opposer's mark is distinctive, and further, as a result of the Opposer's expenditures, promotion, and use of the mark, has acquired even greater distinctiveness, tremendous strength, goodwill, as well as purchaser recognition among the public, relevant consumers, and competitors in Opposer's industry and market.

4. The relevant consuming public has come to know and associate Opposer's security and surveillance systems, and installation and monitoring services with the VIRTUAL DOORMAN mark.

5. Opposer applied for registration of VIRTUAL DOORMAN January 5, 2007 based on actual use in commerce long before Applicant's filing date.

6. Opposer's Application, Serial No. 77/076,929 for VIRTUAL DOORMAN covers International Classes 009 for "Security and surveillance systems, namely, audio and video equipment in the nature of video monitors, surveillance cameras, video intercoms, modems and routers, video code cards, speakers, microphones, intercoms, software for operating and interacting with surveillance systems; security and surveillance computer programs for the enabling or prevention of building access; biometrics equipment, namely, biometrics scanners for locking and unlocking entryways and permitting use of systems; remote entry and locking equipment in the nature of biometric locks and locks controlled over IP; proximity sensors; security and surveillance systems, namely, electronic regulating and control devices for remote

operation of HVAC, lighting, elevators, alarms, sirens, gates, locks, audio video equipments, such as televisions, stereos, computers, telephones, all for residential buildings and homes; security and surveillance systems, namely, electronic regulating and control devices for the same; none of the above for use with vehicles;” Class 037 for “Installation and maintenance of security systems,” and 045 for “Monitoring security and surveillance systems,” with dates of first use in commerce listed at least as early as June 30, 2001.

7. Applicant seeks to register the mark VIDEO DOORMAN in International Class 045 in connection with “electronic monitoring of building entry ways for security purposes, namely, remote video monitoring through a system connected to a central station for monitoring or accepting deliveries of packages and other items.” All of these goods and services listed in Applicant’s application are opposed.

8. The VIDEO DOORMAN mark that Applicant seeks to register is confusingly similar to Opposer’s VIRTUAL DOORMAN mark in appearance, pronunciation and overall impression.

9. Furthermore, the services recited in Applicant’s application are in the same International Class as certain of Opposer’s goods, namely Class 045; moreover, Applicant’s claimed services are substantially similar and related in nature to Opposer’s aforesaid goods and services, and are likely to be promoted through the same and/or similar media, similar and/or overlapping channels of trade, and are likely to be directed at the same, or similar consumers.

10. Applicant initially filed its application for VIDEO DOORMAN on an “Intent to Use in Commerce” Basis in December 2006, and has since claimed use in commerce as of April 2007.

11. Applicant's filing date and claimed date of first use in commerce are subsequent to Opposer's date of first use of VIRTUAL DOORMAN.

12. Applicant's filing date and claimed date of first use in commerce are also long after Opposer's VIRTUAL DOORMAN mark became well-known and recognized in the industry, among both consumers and competitors in the relevant market.

13. Applicant had actual knowledge of Opposer's superior rights in VIRTUAL DOORMAN. In 2004, Opposer attended an industry trade show that was also attended by Applicant. At that trade show, Opposer Virtual Service prominently displayed the VIRTUAL DOORMAN product and services.

14. At the 2004 trade show, representatives of Applicant approached Opposer, discussed the VIRTUAL DOORMAN product and services, and sought to discuss the possibility that the two companies could work together in some fashion.

15. Nothing came of this meeting, and the parties did not enter into any agreement, contract, or joint venture of any kind, particularly regarding the VIRTUAL DOORMAN mark.

16. Since that time, however, Applicant has sought to register VIDEO DOORMAN in Class 045, which application's entire goods and services recital is the subject of this Opposition.

17. Upon information and belief, Applicant had actual knowledge of Opposer's prior rights in and to VIRTUAL DOORMAN before adopting and seeking to register VIDEO DOORMAN for competing services, and seeks to harm Opposer by doing so.

18. Furthermore, Opposer is likely to be harmed by registration of Applicant's application, as the Examining Attorney for Opposer's application has indicated that, if Applicant's application proceeds to registration, registration may be refused Opposer's

VIRTUAL DOORMAN due to a likelihood of confusion with Applicant's mark under Section 2(d).

19. When applied to Applicant's goods and services, Applicant's VIDEO DOORMAN mark is likely to cause confusion or mistake, or to deceive persons and consumers by creating the erroneous impression that Applicant's goods and services originate with, or come from the same source as Opposer's goods and services, or that they are endorsed by, sponsored by or connected in some way with Opposer, resulting in a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

20. Since long before Applicant's application, Opposer Virtual Service has used trademarked slogans in connection with its VIRTUAL DOORMAN mark, such as being a "TOTAL SECURITY SOLUTIONS" Provider; Opposer also uses the trademarked slogans "TECHNOLOGY FOR EASY LIVING," "SAME SERVICES AS A DOORMAN, BUT FOR A FRACTION OF THE COST," as well as a Doorman Logo it uses in connection with its products.

21. Applicant, in addition to its bad faith application for VIDEO DOORMAN, has also mimicked the use of slogans and logos confusingly similar to Opposer's, including adopting a similar doorman logo and similar slogans, claiming that its product functions just like an actual "DOORMAN, BUT FOR A FRACTION OF THE COST."

22. In fact, Applicant's specimen submitted in connection with its application contains not only the confusingly similar, junior VIDEO DOORMAN designation, but also the Opposer's slogan "TOTAL SECURITY SOLUTIONS PROVIDER" at the bottom of the page.

23. Applicant's use, as described above, further increases the likelihood of confusion, and harm to Opposer if Applicant's application is permitted to register.

24. Opposer has superior rights of a prior user in the mark VIRTUAL DOORMAN, and if the Application is granted, Opposer would be wrongly damaged as Applicant would be granted rights inconsistent with Opposer's rights. Furthermore, Opposer, who possesses superior rights, will be wrongly damaged if its own, senior, mark is not permitted to register due to Applicant's registration.

25. By reason of the foregoing, Opposer will likely to be harmed by registration of Application Serial No. 77/067,418 for the mark VIDEO DOORMAN for use in connection with the goods and services set forth in its application in Class 045, and also any and all goods or services directly competing with, or closely related to goods and services used and sought to be registered by Opposer.

WHEREFORE, in light of the foregoing, Opposer respectfully requests that this opposition be sustained and that the registration sought by Applicant in Application Serial No. 77/067,418 be denied in its entirety.

Dated: February 1, 2008

ZEYNEL KARCIOGLU, ESQ.

By: /s/ .
Zeynel Karcioğlu
Attorney for Opposer Virtual Service
36 East 20th Street
New York, NY 10003
(212) 505 - 6933

CERTIFICATE OF SERVICE

I hereby certify that this 1st day of February, 2008, a copy of the foregoing was served by First Class mail and overnight courier upon Registrant, to the attention of :

**ROBERT C. FABER
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 AVENUE OF THE AMERICAS FL 7
NEW YORK, NY 10036-8401**

Dated: New York, NY
February, 1, 2008

_____/s/_____
Zeynel Karcioğlu, Esq.