

ESTTA Tracking number: **ESTTA348652**

Filing date: **05/20/2010**

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	NAVIGON AG
Granted to Date of previous extension	06/02/2010
Address	Schottmullerstrasse 20A Hamburg, 20251 GERMANY

Attorney information	Janet F. Satterthwaite Venable LLP 575 7th Street, N.W. Washington, DC 20004 UNITED STATES jfsatterthwaite@venable.com, trademarkdocket@venable.com, pjwyles@venable.com Phone: 202-344-4974
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**Applicant Information**

Application No	77842702	Publication date	02/02/2010
Opposition Filing Date	05/20/2010	Opposition Period Ends	06/02/2010
Applicant	DAYMEN PHOTO MARKETING LP 55 Valleywood Drive Markham, Ontario, L3R5L9 CANADA		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: Protective carrying cases specially adapted for global positioning system (GPS) apparatus
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3712226	Application Date	10/02/2008
Registration Date	11/17/2009	Foreign Priority Date	04/04/2008
Word Mark	NAVIGON		

Design Mark	<b>NAVIGON</b>
Description of Mark	NONE
Goods/Services	<p>Class 012. First use: Directional signals for land vehicles</p> <p>Class 035. First use: Advertising services, marketing services and online marketing services provided on digital networks; distribution of advertisements, compilation of data in computer databases for commercial purposes, demonstration of goods in the nature of product demonstration</p> <p>Class 039. First use: Logistics services in the nature of transport for others by a vehicle; transportation of freight by means of a fleet of vehicles that are controlled and steered using electronic navigational and positioning systems</p>

U.S. Registration No.	3286593	Application Date	04/20/2006
Registration Date	08/28/2007	Foreign Priority Date	NONE

Word Mark	NAVIGON
Design Mark	<b>NAVIGON</b>
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: Mileage and kilometer recorders for vehicles; computer programs used in navigation, for calculating and displaying routes, distance and time to destination, and electronic map displays; data processors; electronic publications, namely, manuals featuring installation, use and operation of navigation systems recorded on computer media; electronic notice boards; video display cards; audio and visual receivers; distance measuring apparatus, namely, odometers; tachometers; computer interface boards; microprocessors; portable telephones; modems; navigation apparatus for vehicles in the nature of on-board computers; electric navigational instruments; satellite navigational apparatus, namely, a global positioning system</p> <p>Class 038. First use: Providing telecommunications connections to a global computer network; rental of telecommunication equipment; electronic mail; electronic message sending; telephone communication services; radio broadcasting; communications by fiber optic networks; teleconferencing services, telecommunications routing and junction services; cellular telephone communication; electronic transmission of messages and images; radio/telephone paging services</p> <p>Class 042. First use: Updating of computer software for others; computer programming; consultation</p>

	services in the fields of selection, implementation and use of computer hardware for others; computer software system design for others; computer software design for others; conversion of data or documents from physical to electronic media; duplication of computer programs; research and development and consultation related thereto in the field of navigation hardware and software; installation of computer software; maintenance of computer software; rental of computer software
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Related Proceedings	none
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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	/Janet F. Satterthwaite/
Name	Janet F. Satterthwaite
Date	05/20/2010



## NOTICE OF OPPOSITION

3. Navigon AG owns U.S. Trademark Registration 3712226 for NAVIGON for Directional signals for land vehicles; Advertising services, marketing services and online marketing services provided on digital networks; distribution of advertisements, compilation of data in computer databases for commercial purposes, demonstration of goods in the nature of product demonstration; Logistics services in the nature of transport for others by a vehicle; transportation of freight by means of a fleet of vehicles that are controlled and steered using electronic navigational and positioning systems, issued November 17, 2009, and U.S. trademark registration 3286593 for NAVIGON for Mileage and kilometer recorders for vehicles; computer programs used in navigation, for calculating and displaying routes, distance and time to destination, and electronic map displays; data processors; electronic publications, namely, manuals featuring installation, use and operation of navigation systems recorded on computer media; electronic notice boards; video display cards; audio and visual receivers; distance measuring apparatus, namely, odometers; tachometers; computer interface boards; microprocessors; portable telephones; modems; navigation apparatus for vehicles in the nature of on-board computers; electric navigational instruments; satellite navigational apparatus, namely, a global positioning system; Providing telecommunications connections to a global computer network; rental of telecommunication equipment; electronic mail; electronic message sending; telephone communication services; radio broadcasting; communications by fiber optic networks; teleconferencing services, telecommunications routing and junction services; cellular telephone communication; electronic transmission of messages and images; radio/telephone paging services; Updating of computer software for others; computer programming; consultation services in the fields of selection, implementation and use of computer hardware for others; computer software system design for others; computer software design for others; conversion of

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data or documents from physical to electronic media; duplication of computer programs; research and development and consultation related thereto in the field of navigation hardware and software; installation of computer software; maintenance of computer software; rental of computer software, issued August 28, 2007.

4. Opposer has used the mark NAVIGON in the United States since at least 2004, long prior to the filing date of Applicant's application.

5. The subject application was filed on an intent-to-use basis on October 6, 2009 and covers "Protective carrying cases specially adapted for global positioning system (GPS) apparatus."

### FIRST GROUND OF OPPOSITION:

#### Mark is Merely Descriptive or Generic for the goods covered in the Application.

6. The term NAVI is an abbreviation for navigation or navigational.

7. The term NAVI is widely used in the trade to describe a navigational or GPS device.

8. The term NAVI is a generic designation used to identify GPS/navigational equipment, systems, and accessories.

9. Many third parties use the term NAVI as part of a designation for a navigational product.

10. Consumers will associate a protective carrying cases specially adapted for global positioning system (GPS) apparatus, with the GPS apparatus.

11. Opposer and others who manufacture, market or distribute GPS and navigational equipment area have an equal right to use the term NAVI to identify their goods and services.

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12. The issuance to Applicant of a registration for the generic or descriptive term NAVI will make it potentially more difficult for Opposer and others to use that term descriptively, resulting in damage to Opposer.

13. The applicant has not acquired distinctiveness in the term NAVI.

SECOND (ALTERNATIVE) GROUND OF OPPOSITION:  
Likelihood of Confusion with Opposer's Prior Rights.

14. On information and belief, Applicant did not use its mark in commerce before October 6, 2009. Therefore, on information and belief, Opposer has prior use or priority dates for its marks in the United States on similar goods and services to those covered in the subject application; therefore, Opposer is the senior user.

15. The mark NAVI is so similar to opposer's trademarks, that Applicant's use and registration to identify its goods is likely to cause confusion and lead to deception as to the source of origin and/or the sponsorship of Applicant's goods and services and/or Opposer's services, and Opposer will be injured.

WHEREFORE, Opposer prays that said Application Serial No 77/842,702 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of the Opposer.

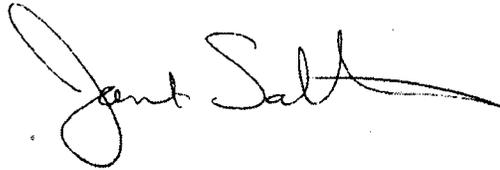
Opposer appoints Janet Satterthwaite, Mark B. Harrison, Meaghan Hemmings Kent, Elissa Reese, David Conway, and along with the law firm of Venable LLP to transact all business on its behalf in connection with this Opposition.

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This Notice of Opposition is submitted online. **Please deduct the filing fee of \$300 (1 class)** and any additional fees from Deposit Account 22-0261.

Respectfully submitted,

Navigon AG



By:

Janet F. Satterthwaite  
Attorney for Opposer

Venable LLP  
575 7<sup>th</sup> St NW  
Washington, D.C. 20004  
(202) 344-4974  
[jfsatterthwaite@venable.com](mailto:jfsatterthwaite@venable.com), [trademarkdocket@venable.com](mailto:trademarkdocket@venable.com)

Dated: May 20, 2010

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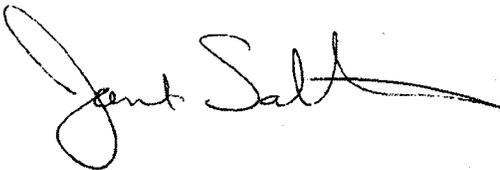
NOTICE OF OPPOSITION

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the foregoing NOTICE OF OPPOSITION to be served by first class mail on counsel for Applicant

LAWRENCE H. BINDEROW  
BINDEROW LAW OFFICES  
1330 CAMINO DEL MAR STE 250  
DEL MAR, CA 92014-2508

This 20<sup>th</sup> day of May, 2010.

A handwritten signature in black ink, appearing to read "Janet Satterthwaite". The signature is written in a cursive style with a large initial "J" and a long horizontal flourish at the end.

Janet F. Satterthwaite