

ESTTA Tracking number: **ESTTA385585**

Filing date: **12/23/2010**

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	Systemax, Inc.
Granted to Date of previous extension	12/26/2010
Address	11 Harbor Park Drive Port Washington, NY 11050 UNITED STATES

Attorney information	Laura Goldbard George Stroock & Stroock & Lavan LLP 180 Maiden Lane New York, NY 10038-4982 UNITED STATES lgoldbard@stroock.com, afisher@stroock.com, tm@stroock.com, mmarsh@stroock.com Phone:212 806 5400
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**Applicant Information**

Application No	77812096	Publication date	06/29/2010
Opposition Filing Date	12/23/2010	Opposition Period Ends	12/26/2010
Applicant	Harmonics Limited, LLC Jefferson Technology Center 1801 Route 51 South, Building 4 Jefferson Hills, PA 15025 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 2001/01/01 First Use In Commerce: 2001/01/01 All goods and services in the class are opposed, namely: electronic circuits that filter and suppress harmonic currents arising from electrical power distribution systems
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**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.	3265407	Application Date	10/15/1997
Registration Date	07/17/2007	Foreign Priority Date	NONE
Word Mark	SYSTEMAX		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1998/04/30 First Use In Commerce: 1998/04/30 Desktop computers, laptop computers, notebook computers, computer mice, computer keyboards and computer servers, each of which is used by a single computer [ ; ] *.* specifically excluded are the following [ ; ] * : * wire, cables, cords, connectors, wire patch cords, jacks, adaptors used to connect a computer to another computer or that are part of any computer network (whether or not any such cable, cord, wire patch connector, adaptor or other such device contains a microprocessor or any memory), including electrical wire for use in the telecommunications industry, fiber optic wire, cords and cables; telecommunications adaptors; fiber optic interconnection cables; telecommunications adaptors; telecommunications connectors, plugs, jacks and connecting blocks; telecommunications devices tat repeat, reshape, or reformat signals from data terminals and controllers; telecommunications brackets, clips and clamps to house and support cable and telecommunications equipment all distributed as a unit, and also including, computer networking and other networking, telecommunications and transmission devices and telecommunications and transmission devices and equipment, such as "Wi-Fi", WLAN and MLAN equipment, as well as sensors, end points and connectivity equipment for building automated systems, as well as other products including but not limited telecommunications closets and residential distribution points, such as but not limited to racks, cabinets, closets, power supplies and jacks used with or for cable or cord; local cords, cables, and wiring necessary to obtain electrical power from a wall outlet or to connect a single computer with a mouse, a printer, a keyboard, a monitor or a drive or CD burner

U.S. Registration No.	3534396	Application Date	10/15/1997
Registration Date	11/18/2008	Foreign Priority Date	NONE
Word Mark	SYSTEMAX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1998/02/00 First Use In Commerce: 1998/02/00 Computer monitors, each of which is used by a single computer; specifically excluded are the following; wire, cables, cords, connectors, wire patch cords, jacks, adaptors used to connect a computer to another computer or that are part of any computer network (whether or not any such cable, cord, wire patch connector, adaptor or other such device contains a microprocessor or any memory), including electrical wire for use in the telecommunications industry, fiber optic wire, cords and cables; telecommunications adaptors; fiber optic interconnection cables; telecommunications adaptors; telecommunications connectors, plugs, jacks and connecting blocks; telecommunications devices that repeat, reshape, or reformat signals from data terminals and controllers; telecommunications brackets, clips and clamps to house and support cable and telecommunications equipment all distributed as a unit, and also including, computer networking and other networking, telecommunications and transmission devices and telecommunications and transmission devices and equipment, such as "Wi-Fi", WLAN and MLAN equipment, as well as sensors, end points and connectivity equipment for building automated systems, as well as other products including but not limited telecommunications closets and residential distribution points, such as but not Limited to racks, cabinets, closets, power supplies and jacks used with or for cable or cord; local cords, cables, and		

	wiring necessary to obtain electrical power from a wall outlet or to connect a single computer with a mouse, a printer, a keyboard, a monitor or a drive or CD burner
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Attachments	357032-0919-NoticeOfOpposition.pdf ( 17 pages )(939023 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	/laura goldbard george/
Name	Laura Goldbard George
Date	12/23/2010

Client Matter No. 357032.0919

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

Application Serial No. 77/812,096  
Mark: SystemMax  
Published: June 29, 2010

-----X		
SYSTEMAX INC.,	:	
	:	
Opposer,	:	
	:	
	:	Opposition No.
v.	:	
	:	
HARMONICS LIMITED, LLC,	:	
	:	
Applicant.	:	
-----X		

Commissioner for Trademarks  
P.O. Box 1451  
Arlington, Virginia 22313-1451

**NOTICE OF OPPOSITION**

Opposer, Systemax Inc., is a corporation organized and existing under the laws of the State of Delaware, having a principal place of business at 11 Harbor Park Drive, Port Washington, New York 11050 (hereinafter “Opposer” or “Systemax”) believes that it will be damaged by registration of the mark SystemMax shown in Application Serial No. 77/812,096 (“Application”) and hereby opposes registration of same.

1. For many years prior to the filing of the Application, Opposer has been using the trademark SYSTEMAX and composite marks containing the term “SYSTEMAX” therein in

interstate commerce within the United States in connection with computers (desktop, laptop and notebook) and computer accessories (mice, keyboards, servers and monitors).

2. Systemax is the owner of U.S. Registration No. 3,265,407 issued on July 17, 2007 for the mark SYSTEMAX for desktop computers, laptop computers, notebook computers, computer mice, computer keyboards and computer servers, each of which is used by a single computer; specifically excluded are the following: wire, cables, cords, connectors, wire patch cords, jacks, adaptors used to connect a computer to another computer or that are part of any computer network (whether or not any such cable, cord, wire patch connector, adaptor or other such device contains a microprocessor or any memory), including electrical wire for use in the telecommunications industry, fiber optic wire, cords and cables; telecommunications adaptors; fiber optic interconnection cables; telecommunications adaptors; telecommunications connectors, plugs, jacks and connecting blocks; telecommunications devices that repeat, reshape, or reformat signals from data terminals and controllers; telecommunications brackets, clips and clamps to house and support cable and telecommunications equipment all distributed as a unit, and also including, computer networking and other networking, telecommunications and transmission devices and telecommunications and transmission devices and equipment, such as "Wi-Fi", WLAN and MLAN equipment, as well as sensors, end points and connectivity equipment for building automated systems, as well as other products including but not limited to telecommunications closets and residential distribution points, such as but not limited to racks, cabinets, closets, power supplies and jacks used with or for cable or cord; local cords, cables, and wiring necessary to obtain electrical power from a wall outlet or to connect a single computer with a mouse, a printer, a keyboard, a monitor or a drive or CD burner. This registration is valid

and subsisting, in full force and effect and incontestable. A copy of the TARR record of Registration No. 3,265,407 is annexed hereto as Exhibit 1.

3. Systemax is the owner of U.S. Registration No. 3,534,396 issued on November 18, 2008 for the mark SYSTEMAX for computer monitors, each of which is used by a single computer; specifically excluded are the following; wire, cables, cords, connectors, wire patch cords, jacks, adaptors used to connect a computer to another computer or that are part of any computer network (whether or not any such cable, cord, wire patch connector, adaptor or other such device contains a microprocessor or any memory), including electrical wire for use in the telecommunications industry, fiber optic wire, cords and cables; telecommunications adaptors; fiber optic interconnection cables; telecommunications adaptors; telecommunications connectors, plugs, jacks and connecting blocks; telecommunications devices that repeat, reshape, or reformat signals from data terminals and controllers; telecommunications brackets, clips and clamps to house and support cable and telecommunications equipment all distributed as a unit, and also including, computer networking and other networking, telecommunications and transmission devices and telecommunications and transmission devices and equipment, such as "Wi-Fi", WLAN and MLAN equipment, as well as sensors, end points and connectivity equipment for building automated systems, as well as other products including but not limited telecommunications closets and residential distribution points, such as but not Limited to racks, cabinets, closets, power supplies and jacks used with or for cable or cord; local cords, cables, and wiring necessary to obtain electrical power from a wall outlet or to connect a single computer with a mouse, a printer, a keyboard, a monitor or a drive or CD burner. This registration is valid and subsisting, in full force and effect and incontestable. A copy of the TARR record of Registration No. 3,534,396 is annexed hereto as Exhibit 2.

4. By reason of extensive distribution, sale and promotion of Opposer's goods in and throughout the United States, Systemax's mark SYSTEMAX has acquired substantial goodwill, distinctiveness, secondary meaning and fame as indicating a line of computers (desktop, laptop and notebook) and computer accessories (mice, keyboards, servers and monitors) (collectively the "Opposer's Goods") having their origin exclusively with Systemax.

5. On August 25, 2009, Applicant, Harmonics Limited, LLC, a corporation organized and existing under the laws of the State of Pennsylvania, located and doing business at Jefferson Technology Center, 1801 Route 51 South, Building 4, Jefferson Hills, Pennsylvania 15025, filed Application Serial No. 77/812,096 for the mark Systemax for electronic circuits that filter and suppress harmonic currents arising from electrical power distribution systems, in International Class 9 (the "Applicant's Goods").

6. Applicant's mark is likely to cause confusion with Opposer's marks. The mark sought to be registered, namely, Systemax is identical to the mark "SYSTEMAX". Thus, Opposer's mark and Applicant's mark are the same.

7. The Goods in the Application are related to Opposer's Goods. Applicant's Goods can control the electronic current communicated to Opposer's Goods. More specifically, consumers are accustomed to using Applicant's Goods to regulate the current sent to a transformer as part of an overall computer system. As there is no limitation as to Applicant's customers, both Opposer's and Applicant's customers may be the same. Thus, as Opposer's and Applicant's respective goods are related, there is a likelihood that consumers would be confused because the respective goods are or will be sold under confusingly similar marks.

**COUNT I**  
**LIKELIHOOD OF CONFUSION**

8. Opposer repeats and re-alleges the allegations in Paragraphs 1 through 7, as if fully set forth herein.

9. In view of the confusing similarity of Applicant's mark and Applicant's Goods to Opposer's Goods and mark, Applicant's use and registration of the mark Systemax is likely to cause confusion, mistake and deceive the trade and public into believing that Applicant's Goods originate with or are otherwise licensed, sponsored or authorized by Opposer.

10. The use and registration of the mark Systemax by Applicant is likely to damage and destroy the distinctiveness, goodwill, reputation, secondary meaning and fame created and established by Systemax in its SYSTEMAX mark by virtue of the confusion, mistake and deception likely to occur between the respective marks in derogation of Opposer's exclusive right to continue to use the registered marks for its present goods and to expand the use of its marks to related goods and services.

11. By reason of all the foregoing, Opposer will be gravely damaged by the registration of the mark Systemax for Applicant's Goods.

**COUNT II**  
**DILUTION**

12. Opposer repeats and re-alleges the allegations contained in Paragraphs 1-7 and 9-10, as if fully set forth herein.

13. Systemax's SYSTEMAX mark is famous and the use and registration of Applicant's mark Systemax is likely to dilute the distinctive quality of such famous marks pursuant to 15 U.S.C. §1125(c), which is applicable in an opposition proceeding.

14. By reason of all the foregoing, Opposer will be gravely damaged by the registration of the mark Systemax for Applicant's Goods.

WHEREFORE, by reason of the confusing similarity of Applicant's and Opposer's marks and the likelihood that Applicant's mark will dilute Opposer's mark, Opposer respectfully requests that the opposition be sustained and that registration of the mark Systemax be refused.

Respectfully submitted,

STROOCK & STROOCK & LAVAN LLP  
Attorneys for Opposer  
180 Maiden Lane  
New York, New York 10038-4982  
(212) 806-5400

By   
Laura Goldbard George

Dated: New York, New York  
December 23, 2010

# **EXHIBIT 1**

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

**This page was generated by the TARR system on 2010-12-23 15:02:28 ET**

**Serial Number:** 75983590 Assignment Information      Trademark Document Retrieval

**Registration Number:** 3265407

**Mark (words only):** SYSTEMAX

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2007-07-17

**Filing Date:** 1997-10-15

**Transformed into a National Application:** No

**Registration Date:** 2007-07-17

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 103

**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:** (NOT AVAILABLE)

**Date In Location:** 2010-12-17

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

---

1. Systemax, Inc.

**Address:**

Systemax, Inc.  
11 Harbor Park Drive  
Port Washington, NY 11050  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** New York

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**GOODS AND/OR SERVICES**

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**International Class:** 009

**Class Status:** Active

Desktop computers, laptop computers, notebook computers, computer mice, computer keyboards and

computer servers, each of which is used by a single computer . specifically excluded are the following : wire, cables, cords, connectors, wire patch cords, jacks, adaptors used to connect a computer to another computer or that are part of any computer network (whether or not any such cable, cord, wire patch connector, adaptor or other such device contains a microprocessor or any memory), including electrical wire for use in the telecommunications industry, fiber optic wire, cords and cables; telecommunications adaptors; fiber optic interconnection cables; telecommunications adaptors; telecommunications connectors, plugs, jacks and connecting blocks; telecommunications devices that repeat, reshape, or reformat signals from data terminals and controllers; telecommunications brackets, clips and clamps to house and support cable and telecommunications equipment all distributed as a unit, and also including, computer networking and other networking, telecommunications and transmission devices and telecommunications and transmission devices and equipment, such as "Wi-Fi", WLAN and MLAN equipment, as well as sensors, end points and connectivity equipment for building automated systems, as well as other products including but not limited to telecommunications closets and residential distribution points, such as but not limited to racks, cabinets, closets, power supplies and jacks used with or for cable or cord; local cords, cables, and wiring necessary to obtain electrical power from a wall outlet or to connect a single computer with a mouse, a printer, a keyboard, a monitor or a drive or CD burner

**Basis:** 1(a)

**First Use Date:** 1998-04-30

**First Use in Commerce Date:** 1998-04-30

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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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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2010-10-28 - Section 7 amendment filed

2010-11-05 - Section 7 correction issued

2010-11-04 - Case Assigned To Post Registration Paralegal

2010-10-28 - TEAS Section 7 Request Received

2007-07-17 - Registered - Principal Register

2007-06-11 - Case File In TICRS

2007-05-26 - Law Office Registration Review Completed

2007-05-18 - Assigned To LIE

2007-05-03 - Allowed for Registration - Principal Register (SOU accepted)

2007-04-27 - Notice Of Divided Trademark Application Mailed  
2007-04-24 - Assigned To Examiner  
2007-04-23 - Statement Of Use Processing Complete  
2007-03-09 - Use Amendment Filed  
2007-04-23 - Divisional processing completed  
2007-03-09 - Divisional request received  
2007-04-01 - Extension 1 granted  
2007-03-05 - Extension 1 filed  
2007-03-09 - PAPER RECEIVED  
2007-03-05 - TEAS Extension Received  
2006-10-03 - NOA Mailed - SOU Required From Applicant  
2006-10-02 - Assigned To Examiner  
2006-06-06 - PAPER RECEIVED  
2006-08-21 - Opposition terminated for Proceeding  
2001-04-27 - Opposition instituted for Proceeding  
2000-12-11 - Extension Of Time To Oppose Received  
2000-11-14 - Published for opposition  
2000-10-13 - Notice of publication  
2000-09-13 - Approved For Pub - Principal Register  
1999-10-11 - Communication received from applicant  
1999-03-11 - Letter of suspension mailed  
1999-02-16 - Communication received from applicant  
1998-08-17 - Non-final action mailed  
1998-07-15 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**  
LAURA E GOLDBARD

**Correspondent**

LAURA E GOLDBARD  
STROOCK & STROOCK & LAVAN LLP  
180 MAIDEN LN  
NEW YORK, NY 10038

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# **EXHIBIT 2**

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

**This page was generated by the TARR system on 2010-12-23 15:02:02 ET**

**Serial Number:** 75373437 [Assignment Information](#)      [Trademark Document Retrieval](#)

**Registration Number:** 3534396

**Mark (words only):** SYSTEMAX

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2008-11-18

**Filing Date:** 1997-10-15

**Transformed into a National Application:** No

**Registration Date:** 2008-11-18

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 107

**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](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 650 -Publication And Issue Section

**Date In Location:** 2010-11-04

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

---

1. Systemax, Inc.

**Address:**

Systemax, Inc.  
11 Harbor Park Drive  
New York, NY 11050  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** New York

**Phone Number:** (516) 608-7612

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**GOODS AND/OR SERVICES**

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**International Class:** 009

**Class Status:** Active

Computer monitors, each of which is used by a single computer; specifically excluded are the following; wire, cables, cords, connectors, wire patch cords, jacks, adaptors used to connect a computer to another computer or that are part of any computer network (whether or not any such cable, cord, wire patch connector, adaptor or other such device contains a microprocessor or any memory), including electrical wire for use in the telecommunications industry, fiber optic wire, cords and cables; telecommunications adaptors; fiber optic interconnection cables; telecommunications adaptors; telecommunications connectors, plugs, jacks and connecting blocks; telecommunications devices that repeat, reshape, or reformat signals from data terminals and controllers; telecommunications brackets, clips and clamps to house and support cable and telecommunications equipment all distributed as a unit, and also including, computer networking and other networking, telecommunications and transmission devices and telecommunications and transmission devices and equipment, such as "Wi-Fi", WLAN and MLAN equipment, as well as sensors, end points and connectivity equipment for building automated systems, as well as other products including but not limited to telecommunications closets and residential distribution points, such as but not limited to racks, cabinets, closets, power supplies and jacks used with or for cable or cord; local cords, cables, and wiring necessary to obtain electrical power from a wall outlet or to connect a single computer with a mouse, a printer, a keyboard, a monitor or a drive or CD burner

**Basis:** 1(a)

**First Use Date:** 1998-02-00

**First Use in Commerce Date:** 1998-02-00

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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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**NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.**

2010-11-19 - Applicant/Correspondence Changes (Non-Responsive) Entered

2010-11-19 - TEAS Change Of Owner Address Received

2010-11-04 - Case Assigned To Post Registration Paralegal

2010-10-28 - TEAS Section 7 Request Received

2008-11-18 - Registered - Principal Register

2008-10-10 - Law Office Registration Review Completed

2008-10-01 - Assigned To LIE

2008-09-23 - Allowed for Registration - Principal Register (SOU accepted)

2008-09-23 - Assigned To Examiner

2008-09-17 - Statement Of Use Processing Complete

2008-09-12 - Use Amendment Filed

2008-09-17 - Extension 4 granted

2008-09-11 - Extension 4 filed

2008-09-17 - Case Assigned To Intent To Use Paralegal

2008-09-12 - TEAS Statement of Use Received

2008-09-11 - TEAS Extension Received

2008-03-31 - Extension 3 granted

2008-03-11 - Extension 3 filed

2008-03-11 - TEAS Extension Received

2007-10-10 - Extension 2 granted

2007-09-27 - Extension 2 filed

2007-09-27 - TEAS Extension Received

2007-04-23 - Divisional processing completed

2007-03-09 - Divisional request received

2007-04-01 - Extension 1 granted

2007-03-05 - Extension 1 filed

2007-03-09 - PAPER RECEIVED

2007-03-05 - TEAS Extension Received

2006-10-03 - NOA Mailed - SOU Required From Applicant

2006-10-02 - Assigned To Examiner

2006-06-06 - PAPER RECEIVED

2006-08-21 - Opposition terminated for Proceeding

2001-04-27 - Opposition instituted for Proceeding

2000-12-11 - Extension Of Time To Oppose Received

2000-11-14 - Published for opposition

2000-10-13 - Notice of publication

2000-09-13 - Approved For Pub - Principal Register  
1999-10-11 - Communication received from applicant  
1999-03-11 - Letter of suspension mailed  
1999-02-16 - Communication received from applicant  
1998-08-17 - Non-final action mailed  
1998-07-15 - Assigned To Examiner

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**ATTORNEY/CORRESPONDENT INFORMATION**

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**Attorney of Record**

Laura Goldbard George

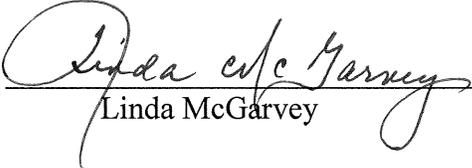
**Correspondent**

Laura Goldbard George  
STROOCK & STROOCK & LAVAN LLP  
NEW YORK NY 10038-4982  
180 Maiden Lane  
New York NY 10038  
Phone Number: 212-806-5400  
Fax Number: 212-806-6006

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Applicant by forwarding a copy by first class mail to David G. Oberdick, Esq., Meyer, Unkovic & Scott LLP, 535 Smithfield Street, Suite 1300, Pittsburgh, Pennsylvania 15222, attorney for Applicant, on December 23, 2010.

  
Linda McGarvey