

ESTTA Tracking number: **ESTTA462322**

Filing date: **03/16/2012**

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	Grounded Pte Ltd.
Granted to Date of previous extension	03/24/2012
Address	32 And Mo Kio Industrial Park 2 #05-03 Sing Industrial Complex Singapore, 569510 SINGAPORE

Attorney information	Jonathan Pearce SoCal IP Law Group, LLP 310 N. Westlake Blvd. Ste 120 Westlake Village, CA 91362 UNITED STATES uspto@socalip.com
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Applicant Information

Application No	85047267	Publication date	01/24/2012
Opposition Filing Date	03/16/2012	Opposition Period Ends	03/24/2012
Applicant	Dirk Lindley #713 27068 LaPaz Road Aliso Viejo, CA 92656 UNITED STATES		

Goods/Services Affected by Opposition

Class 014. First Use: 2010/05/17 First Use In Commerce: 2010/05/25 All goods and services in the class are opposed, namely: Jewelry; Rubber or silicon wristbands in the nature of a bracelet
Class 025. First Use: 2010/05/17 First Use In Commerce: 2010/05/25 All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Wristbands

Applicant Information

Application No	85047326	Publication date	01/24/2012
Opposition Filing Date	03/16/2012	Opposition Period Ends	
Applicant	Dirk Lindley #713 27068 LaPaz Road Aliso Viejo, CA 92656 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 2010/05/17 First Use In Commerce: 2010/05/25
 All goods and services in the class are opposed, namely: Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	No bona fide use of the marks 15 U.S.C. Â§ 1051(a) Applicant is not, and was not at the time of filing of the Applications, the rightful owner of the applied-for marks in the Applications. T.B.M.P. Â§ 309.03(c)(7)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85559237	Application Date	03/02/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	GROUNDED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: First Use: 2010/05/10 First Use In Commerce: 2010/05/25 Bracelets; Bracelets made of silicone or rubber; Rubber or silicon wristbands in the nature of a bracelet		

U.S. Application No.	85559232	Application Date	03/02/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	G		

Design Mark	
Description of Mark	The mark consists of a stylized "G".
Goods/Services	Class 014. First use: First Use: 2010/05/10 First Use In Commerce: 2010/05/25 Bracelets; Bracelets made of silicone or rubber; Rubber or silicon wristbands in the nature of a bracelet

Attachments	85559237#TMSN.jpeg (1 page)(bytes) 85559232#TMSN.jpeg (1 page)(bytes) Notice of Opposition w Exhibits.pdf (11 pages)(981739 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	/jonathan pearce/
Name	Jonathan Pearce
Date	03/16/2012

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

Grounded Pte. Ltd.

Opposer,

v.

Dirk Lindley

Applicant.

Opposition No.

Application Ser. Nos. 85/047,267
85/047,326

NOTICE OF OPPOSITION

In support of this Notice, Grounded Pte. Ltd. (hereinafter “Grounded” or the “Opposer”) states and claims as follows:

1. The Opposer is Grounded Pte. Ltd., a Singapore private limited company whose address is 32 And Mo Kio Industrial Park 2, #05-03 Sing Industrial Complex, Singapore 569510 Singapore.

2. The Opposer is the owner of trademark registration number T1005249J for the **GROUND**ED (“GROUND”ED”) mark in Singapore. The GROUND”ED mark was applied-for on April 28, 2010 and registered on October 21, 2010. This registration is in class 25 including, “Clothings; apparel, namely clothing for men, women and children.”

3. The Opposer is also the owner of trademark registration numbers 301648936 and 301734057 for the GROUND”ED mark in Hong Kong. These registrations cover class 25 goods of “Clothing,” class 16 goods of “printed holograms” and class 28 goods of “bands of rubber or silicon for use in playing sports; wrist bands of rubber or silicone for use in playing sports.” The GROUND”ED marks were registered on June 25, 2010 and October 12, 2010, respectively.

4. The Opposer is also the owner of a trademark registration for the GROUND”ED mark in Japan under serial number 1050659 for goods in class 25 of “Clothing; apparel, namely clothing

for men, women and children.” This mark was registered in Japan on April 8, 2011 based upon international application number 1050659 filed on June 10, 2010.

5. The Opposer is also the owner of a trademark registration for the GROUNDED mark in Korea under serial number 105659 for goods in class 25 of “clothing, etc.” This mark was registered on August 22, 2011 based upon international application number 1050659 filed on June 10, 2010.

6. The Opposer is also the owner of trademark registration numbers T100525E and T1010486E for the  (the “G Logo”) mark in Singapore. The first G Logo registration covers goods in class 25 including, “Clothings; apparel, namely clothing for men, women and children.” The second G Logo registration covers goods in class 16 of “Wrist bands of rubber or silicon; Printed holograms.” The first G Logo mark was applied-for on April 28, 2010 and registered on January 14, 2011, the second was applied-for on April 28, 2010 and registered on October 21, 2010.

7. The Opposer is also the owner of trademark registrations for the G Logo mark in Hong Kong under serial numbers 301648945 and 301734048. These marks cover goods in class 25 of “clothing,” in class 16 of “printed holograms” and in class 28 of “bands of rubber or silicon for use in playing sports; wrist bands of rubber or silicon for use in playing sports.” These applications were registered on June 25, 2010 and October 11, 2010, respectively.

8. The Opposer is also the owner of a pending application to register the “GROUNDED” mark in Indonesia (Ser. No. D00210 021762) filed on June 15, 2010. The filing date of this application predates the filing and use dates in Applicant’s applications in the U.S.

9. The Opposer is also the owner of pending applications to register the G Logo mark in Indonesia (Ser. No. D00 2010 021763) filed June 15, 2010, Japan (Ser. No. 1084134), the European Union (Ser. No. 1084134) and the Republic of Korea (Ser. No. 1084134). The Indonesian application predates the Applicant’s applications in the U.S.

10. The Opposer is also the owner of a pending application to register the G Logo in combination with the GROUNDED mark under serial number 2175952 in class 16 covering goods of “printed holograms; wrist bands of silicon or rubber” in India.



11. The Opposer is also the owner of pending applications to register the (the “G Tree Logo”) in Singapore (Ser. Nos. T1109690D, classes 16 and 25) and India (Ser. No. 2175951, class 16).

12. The Opposer is also the owner of pending U.S. application number 85/559,237 for the word mark “GROUNDED” and U.S. application number 85/559,232 to register the G Logo mark in the United States. These applications cover goods in class 14 including “Bracelets; Bracelets made of silicone or rubber; Rubber or silicon wristbands in the nature of a bracelet” and were filed on March 2, 2012.

13. Opposer opposes Applicant’s pending application serial number 85/047,267 for the G Logo and application serial number 85/047,326 for the “GROUNDED” word mark (the “Applications”).

14. Applicant’s application number 85/047,267 for the G Logo covers goods in class 14 of “Jewelry; Rubber or silicon wristbands in the nature of a bracelet” and goods in class 25 of “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Wristbands.”

15. Applicant’s application number 85/047,326 for the “GROUNDED” word mark covers goods in class 25 of “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms.”

16. The Applicant seeks to register marks that have a confusingly similar appearance, sound, and commercial impression to Opposer’s GROUNDED and G Logo trademarks.

17. The goods recited in the Applications are similar or related to the goods of the Opposer.

18. Since prior to the filing date of the Applications, Opposer has used the GROUNDED and G Logo trademarks in connection with, among other goods, “Bracelets; Bracelets made of silicone or rubber; Rubber or silicon wristbands in the nature of a bracelet.”

19. In particular, Opposer alleges that the dates of first use in Applicant’s Applications are based upon product manufactured by Opposer and shipped by the Opposer from Singapore on May 15, 2010 to the Applicant in the U.S. (*See* Exhibits A and B).

20. The shipping of product bearing the GROUNDED and G Logo marks to the U.S. by Opposer constitutes use by the Opposer predating the alleged use of the Applicant.

21. Upon information and belief, Applicant then sold and/or gave away as a promotion Opposer’s product bearing Opposer’s GROUNDED and G Logo marks in the U.S. and, subsequently, filed the Applications claiming himself as the owner of the marks in those Applications. Accordingly, Applicant’s sale of the Opposer’s products, bearing Opposer’s trademark were not use by the Applicant, but use properly attributed to the Opposer.

22. Accordingly, Applicant has no bona fide use of the marks identified in the Applications in the U.S. As such, Applicant’s application to register should be refused under 15 U.S.C. § 1051(a).

23. Opposer also opposes the Applications on the basis that the Applicant is not, and was not at the time of filing of the Applications, the rightful owner of the applied-for marks in the Applications. T.B.M.P. § 309.03(c)(7).

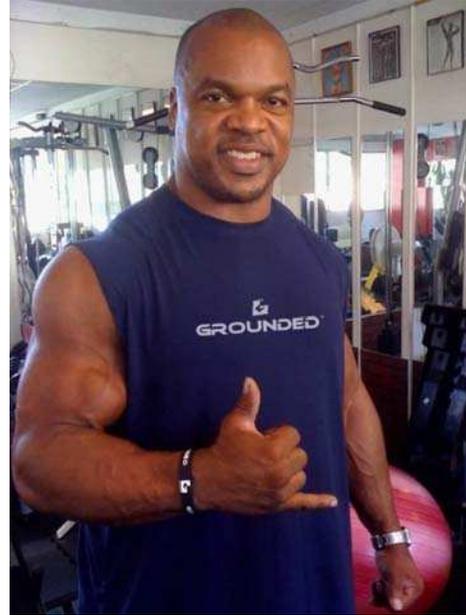
24. Furthermore, the Applications seeks to register marks that consist of or comprise marks which so resemble Opposer’s marks as to be likely, when used on or in connection with the goods recited by the Applicant, to cause confusion, to cause mistake, or to deceive. Such confusion, mistake, or deception would be the cause of damage to Opposer.

25. Because Applicant’s marks are likely to cause confusion with Opposer’s trademarks, Applicant’s marks should be refused registration under 15 U.S.C. § 1052(d).

26. Upon information and belief, Applicant committed fraud during the prosecution of the Applications. It appears that the majority of the specimens submitted with the Applications are “mock ups” or images created with photo editing software. See, for example:



Original Image

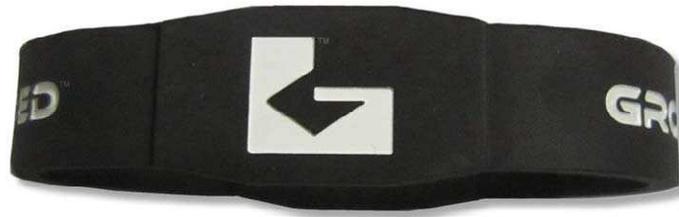


Specimen Submitted in the 85/047,267
and 85/047,326 Applications

27. The above image depicts bodybuilder and trainer Brian Copeland wearing a silicone bracelet manufactured by Opposer. However, the image was edited by the Applicant prior to submission as a specimen in the Applications. The edited image includes a t-shirt labeled with the GROUNDED and G Logo marks. Upon information and belief, no products in class 25 bearing either the GROUNDED or G Logo mark were used in commerce by the date of first use alleged by Applicant.

28. Upon information and belief, many of the other specimens submitted in the Applications are “mock ups” or edited images of product that were not in existence at the time of the specimens’ submission to the Patent Office.

29. Those specimens that are not “mock ups” or edited images all depict product manufactured by Opposer. Opposer provided these images to Applicant. These images include, for example:



Silicone Bracelet Manufactured by Opposer



Necklace and Charm Manufactured by Opposer



Sleeve, Wristbands and Bracelets Manufactured by Opposer

30. Accordingly, Applicant committed fraud during the prosecution of its application for registration by submitting “mock ups” and edited images as specimens that do not in fact depict actual product that had been used in commerce by Applicant. T.B.M.P. § 309.03(c)(17).

WHEREFORE, Grounded Pte. Ltd. respectfully requests that this opposition be granted and that application numbers 85/047,267 and 85/047,326 be denied registration.

March 16, 2012

Respectfully submitted,

/s/ jonathan pearce

Jonathan Pearce, Cal. Bar No. 245,776
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SOCAL IP LAW GROUP LLP
310 N. Westlake Blvd., Suite 120
Westlake Village, CA 91362-3788
Phone: (805) 230-1350
Fax: (805) 230-1355

Attorney for Opposer
Grounded Pte. Ltd.

CERTIFICATE OF SERVICE

I hereby certify that Applicant was served this document on this date via first class mail to the address of record in the Applications: Dirk Lindley, #713, 27068 LaPaz Road, Aliso Viejo, CA 92656. A copy was also sent via email to the email address of record in the Applications: dirklindley@gmail.com.

March 16, 2012

/s/ jonathan pearce

Exhibit A

1 From Please print and press hard. Sender's FedEx Account Number **129733705**

Date **05/15/2010**

Sender's Name **Matthew** Phone **96959455**

Company **Grounded Pte Ltd**

Address **32 Ang Mo Kio Ind. Park 2**

Address **#05-03 Sing Ind. complex**

City **Singapore** State Province **Singapore** ZIP Postal Code **569510**

2 To Recipient's Name **Dirk Lindley, Silvia Lindley** Phone **9493061227**

Company **27068 La Paz Road #713** Dept./Floor **Aliso Viejo, CA**

City **California** State Province **United States** ZIP Postal Code **92656**

Recipient's Tax ID Number for Customs Purposes **92656**
e.g. GST/REG/VAT/IEA/VABN, or as locally required.

3 Shipment Information For EU Only. Tick here if goods are not in free circulation and provide C.I.

Total Packages Shipper's Label and Count/SAC **One** Total Weight **9.0** lbs. kg DIM L W H in. cm

Commodity Description <small>DETAIL REQUIRED</small>	Harmonized Code	Country of Manufacture	Value for Customs <small>REQUIRED</small>
2" Silicon wafer samples		Singapore	USD 1520
8" S. Silicon wafer samples		Singapore	USD 1520
hologram stickers		Singapore	USD 139

Has EE/ISED been filed in AES? No EE/ISED required, value \$2,500 or less per Sch. B Number, For U.S. Export Only. Check One no license required (NLR), not subject to ITR. If other than NLR, enter License Exception: **179**

Total Declared Value for Customs **USD 179** Total Value (Specify Currency)

No EE/ISED required, enter exemption number: Yes - Enter AES proof of filing citation:

4 Express Package Service

FedEx Intl. Priority FedEx Intl. First Available to select locations. Higher rates apply.

FedEx Intl. Economy FedEx Envelope and FedEx Pak rate not available.

5 Packaging

FedEx Envelope FedEx Pak FedEx Box FedEx Tube Other FedEx 10kg Box* FedEx 25kg Box*

6 Special Handling

HOLD at FedEx Location SATURDAY Delivery Available to select locations for FedEx Intl. Priority only.

7a Payment Bill transportation charges to:

Enter FedEx Acct. No. or Credit Card No. below.

Sender Acct. No. in Section 1 will be billed. Recipient Third Party Cash Check Cheque Credit Card Card FedEx Use Only

Credit Card No. _____
Credit Card Exp. Date _____

7b Payment Bill duties and taxes to:

Enter FedEx Acct. No. below.

Sender Acct. No. in Section 1 will be billed. Recipient Third Party

FedEx Acct. No. _____

8 Your Internal Billing Reference

Enter 24 characters will appear on invoice. OPTIONAL

9 Required Signature

Use of this Air Waybill constitutes your agreement to the Conditions of Contract on the back of this Air Waybill, and you represent that this shipment does not require a U.S. State Department License or contain dangerous goods. Certain international treaties, including the Warsaw Convention, may apply to this shipment and limit our liability for damage, loss, or delay, as described in the Conditions of Contract. **WARNING:** These commodities, technology, or software were exported from the United States in accordance with Export Administration Regulations. Diversion contrary to U.S. law prohibited.

Sender's Signature: **Matthew**

This is not authorization to deliver this shipment without a recipient's signature.

For Completion Instructions, see back of fifth page.

FedEx Tracking Number **8707 6993 9750** Form ID No. **0402**

 Ship and track packages at fedex.com

The terms and conditions of service may vary from country to country. Consult our local office for specific information. Non-Negotiable International Air Waybill - ©1994-2006 FedEx

Questions? Go to our Web site at fedex.com.

Or in the U.S., call 1.800.247.4747. Outside the U.S., call your local FedEx office.

Exhibit B

Invoice

DATE : 15th May 2010

Shipper's Information

Company Name : Grounded Pte Ltd
Address : 32 Ang Mo Kio Industrial Park 2, #05-03 Sing Industrial Complex Singapore 569510
Company REG. NO : 201006869M
Contact Name : Matthew Lam
Tel : (65) 96959455

Ship to

Name : Dirk Lindley / Silvia Lindley / Joshua Lindley
Address : 27068 La Paz Road #713, Aliso Viejo, CA 92656 United States.
Contact Name : Dirk Lindley / Silvia Lindley / Joshua Lindley
Tel : 949-306-1227

No.	Description	Qty	Unit USD	Total USD
1	Silicone band samples - 7"	200	0.1	20.00
2	Silicone band samples - 8"	200	0.1	20.00
3	Packs of holograms stickers sample 144 stickers per sheet	1390 sheets	0.1	139.00
Total price			USD	179.00



Signature
Grounded Pte Ltd