

ESTTA Tracking number: **ESTTA526428**

Filing date: **03/13/2013**

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	Mophie, Inc.
Granted to Date of previous extension	03/13/2013
Address	2850 RED HILL AVE. SUITE 128 SANTA ANA, CA 92705 UNITED STATES

Attorney information	Michelle Hon Donovan Duane Morris LLP 750 B Street, Suite 2900 San Diego, CA 92101 UNITED STATES mhdonovan@duanemorris.com
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### Applicant Information

Application No	85660328	Publication date	11/13/2012
Opposition Filing Date	03/13/2013	Opposition Period Ends	03/13/2013
Applicant	ABM Wireless, Inc. 205 Marcus Blvd. Hauppauge, NY 11788 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, headsets for cell phones, earphones, cellular phone battery chargers, batteries, memory cards, antennas, electronic data cables, carrying cases for cell phones, adapters and accessories for portable music players in the nature of carrying cases and protective covers
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### Grounds for Opposition

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

U.S. Registration No.	3227725	Application Date	06/08/2006
Registration Date	04/10/2007	Foreign Priority Date	NONE

Word Mark	M MOPHIE
Design Mark	
Description of Mark	The mark consists of a partially shaded rectangle with a partially shaded circle in its center. A stylized letter "m" appears in the circle and the word "mophie" appears below the circle.
Goods/Services	Class 009. First use: First Use: 2005/08/01 First Use In Commerce: 2005/08/01 electronic and optical communications instruments and components, namely, FM transmitters, audio signal splitters, FM receivers, audio speakers, wireless transmitters and receivers; carrying and protective cases for audio devices, audio-visual devices, calculators and cellular telephones, portable computers

U.S. Registration No.	3681443	Application Date	12/10/2007
Registration Date	09/08/2009	Foreign Priority Date	NONE

Word Mark	M
Design Mark	
Description of Mark	The mark consists of the letter "M" in a circle.
Goods/Services	Class 009. First use: First Use: 2007/11/30 First Use In Commerce: 2007/11/30 Audio speakers; loud speakers; loud speakers and stereo systems comprised of speakers, speakers used on docking stations for portable audio devices, namely, MP3 players, and docking stations for use with audio speakers; electronic and optical communications instruments and components, namely, audio speakers, carrying and protective cases for audio devices, battery packs, namely, batteries with integrated docking for mobile electronic devices; batteries and battery chargers for use as external power sources with mobile consumer electronic products; electrical cells and batteries, namely, external power sources with integrated housing and electrical connector; cell phone battery chargers, namely, external power sources with integrated housing and electrical connector for mobile phones; and mobile telephone batteries, namely, external battery packs with integrated docking for mobile telephones

U.S. Registration No.	3681444	Application Date	12/10/2007
Registration Date	09/08/2009	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	The mark consists of The letter "M."		
Goods/Services	<p>Class 009. First use: First Use: 2007/11/30 First Use In Commerce: 2007/11/30  Audio speakers; loud speakers; loud speakers and stereo systems comprised of speakers, speakers used on docking stations for portable audio devices, namely, MP3 players, and docking stations for use with audio speakers; electronic and optical communications instruments and components, namely, audio speakers, carrying and protective cases for audio devices, battery packs, namely, batteries with integrated docking for mobile electronic devices; batteries and battery chargers for use as external power sources with mobile consumer electronic products; electrical cells and batteries, namely, external power sources with integrated housing and electrical connector; cell phone battery chargers, namely, external power sources with integrated housing and electrical connector for mobile phones; and mobile telephone batteries, namely, external battery packs with integrated docking for mobile telephones</p>		

U.S. Application No.	85448268	Application Date	10/14/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	M		
Design Mark			
Description of Mark	The mark consists of a white letter "M" inside a black circle.		
Goods/Services	<p>Class 009. First use: First Use: 2009/04/00 First Use In Commerce: 2009/04/00  (Based on Use in Commerce) carrying and protective cases, namely, armbands used as a case, belt clips used as a case, holsters, hard cases, soft cases, and</p>		

	<p>silicone cases for use with mobile electronic devices in the nature of mobile card readers, mobile point-of-sale terminals, mobile phones, digital audio and video players, personal digital assistants, electronic personal organizers, and cameras, and mobile computing devices in the nature of handheld computers, tablet computers and electronic notepads; peripherals and accessories, namely, battery chargers, USB cables and power converters for use with mobile electronic devices; protective screen shields for mobile electronic devices; card readers to scan information contained in smart cards, radio frequency identification cards, chip cards, credit cards, bank cards, debit cards, licenses, identification cards and frequent buyer cards; card reader terminal for use with mobile electronic devices, to scan information contained in electronic strips of various cards, namely, credit cards, bank cards, debit cards, licenses, identification cards and frequent buyer cards; barcode scanners; computer devices and systems, namely, haptic interfaces and devices for providing haptic, force and tactile feedback with integrated audio speakers for use with mobile electronic devices; software used to generate haptic, force and tactile feedback for use with such devices and systems; and software for mobile electronic devices and computers, namely, computer software for processing electronic payments via mobile electronic devices and computers; (Based on Intent to Use) cases and covers with integrated keyboard and battery for mobile electronic devices, namely, mobile phones, digital audio and video players, personal digital assistants, electronic personal organizers, cameras and mobile computing devices in the nature of handheld computers, tablet computers and electronic notepads; docking station with integrated keyboard and battery for mobile electronic devices, namely, mobile phones, digital audio and video players, personal digital assistants, electronic personal organizers, cameras and mobile computing devices in the nature of handheld computers, tablet computers and electronic notepads; wireless electronic devices, namely, wireless headphones, headsets, and ear buds, wireless headphones, headsets and ear buds for use with mobile electronic devices, and wireless speakers; wireless electronic devices using wireless personal area network technology, namely, wireless headphones, headsets, and ear buds, wireless headphones, headsets and ear buds for use with mobile electronic devices, and wireless speakers; wireless receivers and transmitters for mobile electronic devices integrated as part of a battery pack; television tuners integrated into a carrying or protective case and battery pack for mobile electronic devices; digital media receivers integrated into a carrying or protective case and battery packs for mobile electronic devices; radio receivers and radio signal tuners integrated into a carrying or protective case and battery packs for mobile electronic devices; wireless receivers and transmitters for mobile electronic devices; and software for mobile electronic devices and computers related to battery power management and remote control operations</p>
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Related Proceedings	Opposition No. 91206211
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Attachments	<p>78903789#TMSN.jpeg ( 1 page )( bytes )  77977640#TMSN.jpeg ( 1 page )( bytes )  77977641#TMSN.jpeg ( 1 page )( bytes )  85448268#TMSN.jpeg ( 1 page )( bytes )  ABM Notice of Opposition.pdf ( 8 pages )(205782 bytes )</p>
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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	/Michelle Hon Donovan/
Name	Michelle Hon Donovan
Date	03/13/2013

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

In the matter of Trademark Application Serial No. 85/660,328

Filed: June 25, 2012

For the Mark: 

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MOPHIE, INC.

Mophie,

v.

ABM WIRELESS, INC., DBA MOBILEISTIC  
Applicant.

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Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Mophie, Inc. (hereinafter “Mophie”), a corporation duly organized and existing under the laws of California, having a principal place of business at 2850 Red Hill Avenue, Suite 128, Santa Ana, CA 92705, believes that it will be damaged by registration of the mark  shown in Serial No. 85/660,328 as applied to “Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, headsets for cell phones, earphones, cellular phone battery chargers, batteries, memory cards, antennas, electronic data cables, carrying cases for cell phones, adapters and accessories for portable music players in the nature of carrying cases and protective covers” in Class 009, and hereby opposes registration of same. As grounds for opposition, Mophie alleges the following:

## I. The Parties and Their Respective Marks

### A. Mophie's Prior Use of the "M" Mark.

1. Mophie is a leading developer and manufacturer of various consumer electronics, including but not limited to cellular phone accessories as set forth in its registrations and application listed below.

2. Mophie and/or its predecessor in interest has sold these goods under the name "mophie" and the logo of the letter "m" in a shaded circle since at least as early as August 1, 2005.

3. Mophie is the owner of the mark  and U.S. Registration No. 3227725 for "electronic and optical communications instruments and components, namely, FM transmitters, audio signal splitters, FM receivers, audio speakers, wireless transmitters and receivers; carrying and protective cases for audio devices, audio-visual devices, calculators and cellular telephones, portable computers" in Class 009.

4. Applicant and/or its predecessor in interest has used the  mark as early as August 1, 2005.

5. Mophie is also the owner of the mark  and U.S. Registration No. 3681443 for "Audio speakers; loud speakers; loud speakers and stereo systems comprised of speakers, speakers used on docking stations for portable audio devices, namely, MP3 players, and docking stations for use with audio speakers; electronic and optical communications instruments and components, namely, audio speakers, carrying and protective cases for audio devices, battery packs, namely, batteries with integrated docking for mobile electronic devices; batteries and

battery chargers for use as external power sources with mobile consumer electronic products; electrical cells and batteries, namely, external power sources with integrated housing and electrical connector; cell phone battery chargers, namely, external power sources with integrated housing and electrical connector for mobile phones; and mobile telephone batteries, namely, external battery packs with integrated docking for mobile telephones” in Class 009.

6. Mophie is also the owner of the mark  and U.S. Registration No. 3681444 for “Audio speakers; loud speakers; loud speakers and stereo systems comprised of speakers, speakers used on docking stations for portable audio devices, namely, MP3 players, and docking stations for use with audio speakers; electronic and optical communications instruments and components, namely, audio speakers, carrying and protective cases for audio devices, battery packs, namely, batteries with integrated docking for mobile electronic devices; batteries and battery chargers for use as external power sources with mobile consumer electronic products; electrical cells and batteries, namely, external power sources with integrated housing and electrical connector; cell phone battery chargers, namely, external power sources with integrated housing and electrical connector for mobile phones; and mobile telephone batteries, namely, external battery packs with integrated docking for mobile telephones” in Class 009.

7. On October 14, 2011, Mophie filed U.S. Trademark Application Serial No. 85/448,268 to register its  design mark on the Principal Register for “carrying and protective cases, namely, armbands used as a case, belt clips used as a case, holsters, hard cases, soft cases, and silicone cases for use with mobile electronic devices in the nature of mobile card readers, mobile point-of-sale terminals, mobile phones, digital audio and video players, personal digital assistants, electronic personal organizers, and cameras, and mobile computing devices in

the nature of handheld computers, tablet computers and electronic notepads; peripherals and accessories, namely, battery chargers, USB cables and power converters for use with mobile electronic devices; protective screen shields for mobile electronic devices; card readers to scan information contained in smart cards, radio frequency identification cards, chip cards, credit cards, bank cards, debit cards, licenses, identification cards and frequent buyer cards; card reader terminal for use with mobile electronic devices, to scan information contained in electronic strips of various cards, namely, credit cards, bank cards, debit cards, licenses, identification cards and frequent buyer cards; barcode scanners; computer devices and systems, namely, haptic interfaces and devices for providing haptic, force and tactile feedback with integrated audio speakers for use with mobile electronic devices; software used to generate haptic, force and tactile feedback for use with such devices and systems; and software for mobile electronic devices and computers, namely, computer software for processing electronic payments via mobile electronic devices and computers.”

8. Mophie’s  and  marks are sufficiently similar and create the same commercial impression as Mophie’s original “M” design, such that the earlier priority date of August 1, 2005 can be tacked on to those marks.

**B. Applicant and Its Later Adoption of Its “M” Marks.**

9. Upon information and belief, applicant ABM Wireless, Inc. (hereinafter “Applicant”), is a New York Corporation having its place of business at 205 Marcus Blvd. Hauppauge, NY 11788.

10. Upon information and belief, Applicant is engaged in the business of distribution and retail store services related to telecommunications products and cellular phone accessories.

11. On June 25, 2012, Applicant filed Application Serial No. 85/660,328 on an intent-to-use basis to register, on the Principal Register, the design mark  (hereinafter the “Applicant’s Mark”) for “Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, headsets for cell phones, earphones, cellular phone battery chargers, batteries, memory cards, antennas, electronic data cables, carrying cases for cell phones, adapters and accessories for portable music players in the nature of carrying cases and protective covers” in Class 009.

12. Applicant’s Mark was published for opposition in the *Official Gazette* on November 13, 2012.

13. Mophie timely filed a request for extension of time to oppose Applicant’s Mark, which extended the time to oppose Applicant’s Mark until March 13, 2013.

14. Applicant claims to own the mark  and U.S. Registration No. 4011446 for “Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, headsets for cell phones, earphones, cellular phone battery chargers, batteries, memory cards, antennas, electronic data cables, carrying cases for cell phones, adapters and accessories for portable music players in the nature of carrying cases and protective covers” in Class 009 and “Distributorship services and retail store services in the field of telephone handsets and telecommunication products, cellular phones and cellular phone accessories, namely, wireless equipment, chargers, batteries, memory cards, headsets, data cables, antennas, cases, navigation equipment, adaptors, accessories for portable music players; Retail store services featuring telecommunications service plans and telecommunications service activation” in Class 035.

15. Applicant claims to have used this mark in commerce as early as January 1, 2006.

16. Applicant also claims to own the mark  and U.S. Registration No. 4051955 for “Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, portable media players, cell phone battery chargers, batteries, memory cards, headsets for cell phones, data electronic cables, antennas, carrying cases for cell phones, GPS navigation devices, clips, holders, adaptors and accessories for portable music players in the nature of carrying cases, media storage devices in the nature of memory cards and flash drives, hands free devices and holders thereto, headsets, earphones and data electronic cables” in Class 009 and “Distributorship services and retail store services in the field of telephone handsets and telecommunication products, cellular phones and cellular phone accessories, namely, wireless equipment, chargers, batteries, memory cards, headsets, data cables, antennas, cases, navigation equipment, adaptors, accessories for portable music players; Retail store services featuring telecommunications service plans and telecommunications service activation” in Class 035.

17. Applicant claims to have used this mark in commerce as early as January 1, 2006.

Applicant’s Mark, , and  are hereinafter collectively referenced as the “ABM Marks”).

18. On information and belief, Mophie has never sold any telecommunication products or cellular phone accessories under any of the ABM Marks.

## **II. Applicant’s Opposition of Mophie’s “M” Mark**

19. On July 24, 2012, Applicant filed a Notice of Opposition seeking to prevent the registration of Mophie’s  mark as set forth in Application Serial No. 85/448,268 (Opposition No. 91206211).

20. Applicant's Mark and pending Application Serial No. 85/660,328 were cited as

grounds for opposing Mophie's  mark.

21. Applicant claims that it has prior rights to the "M" in circle design and that it will be damaged by the registration of Mophie's  mark because use and registration of this mark is allegedly "likely to cause confusion, to cause mistake, and to deceive customers, potential customers and others as to the source of its goods."

22. However, based on the first use dates claimed by the respective parties, Mophie clearly has prior rights to the "M" in circle design and thus, is the senior user of the mark. Additionally, on information and belief, Applicant has never used Applicant's mark in connection with the sale of goods in Class 009.

23. Therefore, Mophie believes it will be damaged by the registration of Applicant's Mark in Application Serial No. 85/660,328, and respectfully requests that this opposition be sustained and that the registration sought by Applicant be denied.

Respectfully submitted,

MOPHIE, INC.

Date: March 13, 2013

By:           /Michelle Hon Donovan/            
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**Certificate of Service**

The undersigned hereby certifies that a true and correct copy of the foregoing NOTICE OF OPPOSITION is being deposited with the United States Postal Service, with sufficient postage as first class mail in an envelope address to Applicant at:

Brian A. Bloom  
CERTILMAN BALIN ADLER & HYMAN, LLP  
90 Merrick Avenue, 9th Floor  
East Meadow, NY 11554

On March 13, 2013

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/Michelle Hon Donovan/

**Certificate of Electronic Filing**

The undersigned hereby certifies that the original of the Notice of Opposition was filed with the Trademark Trial and Appeal Board by electronic filing through the Electronic System for the Trademark Trial and Appeals at <http://estta.uspto.gov> on the date indicated below.

On March 13, 2013

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/Michelle Hon Donovan/