

ESTTA Tracking number: **ESTTA543832**

Filing date: **06/19/2013**

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	ADT US Holdings, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1501 Yamato Road Boca Raton, FL 33431 UNITED STATES		

Attorney information	Mark Tidman Baker & Hostetler Suite 1100 1050 Connecticut Avenue, N.W. Washington, DC 20036 UNITED STATES trademarks@bakerlaw.com Phone:202.861.1500
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Applicant Information

Application No	85794406	Publication date	05/21/2013
Opposition Filing Date	06/19/2013	Opposition Period Ends	06/20/2013
Applicant	LifeSafety Management, Inc. 6040 Lake Worth Road Lake Worth, FL 33463 UNITED STATES		

Goods/Services Affected by Opposition

Class 037. All goods and services in the class are opposed, namely: Installation and maintenance of carbon monoxide, fire, burglar, sprinkler and security alarm systems, fire extinguishers, closed circuit TV and access control systems
Class 042. All goods and services in the class are opposed, namely: Monitoring of carbon monoxide, fire, burglar, sprinkler and security alarm systems, fire extinguishers, closed circuit TV and access control systems

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2586569	Application Date	01/31/2001
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Registration Date	06/25/2002	Foreign Priority Date	NONE
Word Mark	ADT ALWAYS THERE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2001/05/01 First Use In Commerce: 2001/05/01 security system monitoring services		

U.S. Registration No.	3445424	Application Date	10/10/2006
Registration Date	06/10/2008	Foreign Priority Date	04/27/2006
Word Mark	ADT ALWAYS THERE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 037. First use: Installation and maintenance of computer hardware, computer peripherals, smart card readers, and radio signal receivers for electronic payment; installation, maintenance and repair of apparatus and instruments for controlling and rescue, namely, automatic discharge systems for fire protection, electronic protection equipment, namely, intrusion detection equipment, environmental detection equipment, fire alarm and detection equipment, alarm central stations, and monitoring central stations, namely, audio and video transmission, recording and playback equipment; installation, maintenance and repair of equipment for monitoring fire suppression substance discharge systems and waterflow alarms; installation, maintenance and repair of anti-theft and break-in alarm equipment; installation, maintenance and repair of strong-room alarm equipment; installation, maintenance, repair of motion sensing equipment; installation, maintenance and repair of electronic network equipment; installation, maintenance and repair of electronic communication equipment; installation, maintenance and repair of nurse call systems; installation, maintenance, repair of message programming equipment; and installation, maintenance and repair of electronic locking systems</p> <p>Class 045. First use: Electrical protection services for central offices, namely, electronic monitoring services for security purposes in the fields of residences, businesses and commercial properties; anti-theft and break-in alarm services, namely, monitoring anti-theft, intruder and burglar alarms; fire alarm and protection services, namely, monitoring fire alarms and fire detection systems; services for monitoring waterflow alarms; industrial process supervision services, namely, consultation services in the field of the fire, safety and security needs of commercial and industrial companies, and monitoring alarms and security systems for industrial processes of commercial and industrial companies; security and fire system monitoring services; remotely monitoring fire alarms and security systems for sites, namely, homes, businesses and commercial properties; consultation regarding the integration of solutions with regard to fire and property and personal security, namely, consulting services in the fields of fire detection, property security, and personal security from break-ins; and security services with regard to protection against fires and break-ins, namely, monitoring telephone calls from subscribers of fire protection systems and property security systems and notifying emergency facilities</p>		

U.S. Registration	3483310	Application Date	06/22/2007
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No.			
Registration Date	08/12/2008	Foreign Priority Date	NONE
Word Mark	ADT ALWAYS THERE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2007/04/17 First Use In Commerce: 2007/04/17 Computer consultation services to assist in the management of business in the fields of retail loss prevention, inventory and operations management and exception reporting		

U.S. Registration No.	3902450	Application Date	01/04/2008
Registration Date	01/11/2011	Foreign Priority Date	NONE
Word Mark	ADT ALWAYS THERE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use:</p> <p>Fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal security alarms, smoke alarms, and gas alarms; sprinkler systems for fire protection; radio, video and digital signal transmitters, receivers and switches, antennas, intercoms, lasers not for medical use, electronic locks, telephone communication base stations, telephones, and voice and video communication hubs; computer hardware and computer peripherals; environmental sensors and detectors for detecting heat, temperature, water, smoke, gas, pressure and movement; remote control units, keypads and control panels for security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices and sprinkler systems for fire protection; computer software used to operate, manage and monitor security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls and home automation devices; computer software used to monitor and track movement activity, health conditions and environmental conditions, and used to transmit electronic messages and data via communications networks; home and office automation systems comprising wireless and wired controllers, controlled devices, and software for lighting, HVAC, security, safety and other home and office monitoring and control applications; electrical controllers and switches for use with water flow and sprinkler systems, home automation and lighting; lighting control panels; motion sensitive security lights; electric and electronic video surveillance installations; cameras, including video, television and surveillance cameras; video and television monitors; mounting devices for cameras and monitors; locator systems, namely, satellite and radio transmitters and receivers, transponders, and antennas; vehicle, pet and personnel locator and recovery device programmed to use global positioning systems (GPS) and cellular telecommunications; and user manuals sold as a unit therewith</p> <p>Class 038. First use:</p> <p>Telecommunication services, namely, providing access to pictures, video, alarm status, building plans and other building and security information at a remote station; telecommunication services, namely, electronic transmission of voice, messages and data; telecommunication services, namely, information</p>		

transmission via electronic communications networks; transmission of sound, video and information via computer networks, text messages and voice; transmission, reception and processing of coded and emergency signals; transmission of sound, video and information in the fields of emergencies, security, alarms, security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices, sprinkler systems for fire protection, vehicle, pet and personnel location, automobile safety, vehicle theft, traffic, road navigation and weather; electronic mail services; instant messaging services; electronic voice messaging, namely, the recording and subsequent transmission of voice messages by telephone; and electronic message transmission, namely, providing a website featuring transmission of emergency messaging via computer and telecommunications networks

Class 042. First use:

Technical consultation services in the field of computer hardware, computer peripherals and computer software used for security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices, sprinkler systems for fire protection, vehicle, pet and personnel location, automobile safety, vehicle theft, traffic, and road navigation; technical support services, namely, troubleshooting of computer hardware, computer peripheral and computer software problems; technical consultation in the field of integration of home automation systems with computer networks and monitoring systems; providing temporary use of online non-downloadable computer software used to operate, manage and monitor security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls and home automation devices; providing temporary use of online non-downloadable computer software used to monitor and track movement activity, health conditions and environmental conditions, and used to transmit electronic messages and data via communications networks; and weather information services

Class 045. First use:

Alarm response and verification services; monitoring of alarms, security systems and home automation systems for security purposes; remote monitoring of alarms, security systems and home automation systems for security purposes; monitoring of computer systems for security purposes, namely, remote monitoring of computer systems in the fields of security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices, sprinkler systems for fire protection, vehicle, pet and personnel location, automobile safety, vehicle theft, traffic, and road navigation, all of the foregoing for security purposes; fire alarm sprinkler and water flow monitoring services for fire alarm security purposes; control of building environmental access and security systems; monitoring telephone calls from subscribers and notifying emergency facilities; theft recovery services, namely, tracking, locating and monitoring of vehicles via a computer network; electronic monitoring services for security purposes in the field of pets, homes, people and business buildings; providing security consulting and security consulting via telephone hotline; monitoring telephone calls and messages from subscribers and notifying emergency facilities from call centers in the fields of security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices and sprinkler systems for fire protection; providing security consulting via telephone hotline and monitoring telephone calls from subscribers and notifying emergency facilities from call centers in the fields of vehicle security and navigation; and concierge services for others comprising making requested personal

	arrangements and reservations and providing customer-specific information to meet individual needs rendered together in vehicles
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Attachments	ADT US Holdings v LifeSafety Management.pdf(1968354 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	/Mark Tidman/
Name	Mark Tidman
Date	06/19/2013

equipment, alarm central stations, and monitoring central stations, namely, audio and video transmission, recording and playback equipment; installation, maintenance and repair of equipment for monitoring fire suppression substance discharge systems and waterflow alarms; installation, maintenance and repair of anti-theft and break-in alarm equipment; installation, maintenance and repair of strong-room alarm equipment; installation, maintenance, repair of motion sensing equipment; installation, maintenance and repair of electronic network equipment; installation, maintenance and repair of electronic communication equipment; installation, maintenance and repair of nurse call systems; installation, maintenance, repair of message programming equipment; and installation, maintenance and repair of electronic locking systems” in Class 37 and “Electrical protection services for central offices, namely, electronic monitoring services for security purposes in the fields of residences, businesses and commercial properties; anti-theft and break-in alarm services, namely, monitoring anti-theft, intruder and burglar alarms; fire alarm and protection services, namely, monitoring fire alarms and fire detection systems; services for monitoring waterflow alarms; industrial process supervision services, namely, consultation services in the field of the fire, safety and security needs of commercial and industrial companies, and monitoring alarms and security systems for industrial processes of commercial and industrial companies; security and fire system monitoring services; remotely monitoring fire alarms and security systems for sites, namely, homes, businesses and commercial properties; consultation regarding the integration of solutions with regard to fire and property and personal security, namely, consulting services in the fields of fire detection, property security, and personal security from break-ins; and security services with regard to protection against fires and break-ins, namely, monitoring telephone calls from subscribers of fire protection systems and property security systems and notifying emergency facilities” in Class 45.

3. Opposer is the owner of U.S. Registration No. 3483310 for the trademark ADT ALWAYS THERE in connection with “Computer consultation services to assist in the management of

business in the fields of retail loss prevention, inventory and operations management and exception reporting” in Class 42.

4. Opposer is the owner of U.S. Registration No. 3902450 for the trademark ADT ALWAYS THERE in connection with “ Fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal security alarms, smoke alarms, and gas alarms; sprinkler systems for fire protection; radio, video and digital signal transmitters, receivers and switches, antennas, intercoms, lasers not for medical use, electronic locks, telephone communication base stations, telephones, and voice and video communication hubs; computer hardware and computer peripherals; environmental sensors and detectors for detecting heat, temperature, water, smoke, gas, pressure and movement; remote control units, keypads and control panels for security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices and sprinkler systems for fire protection; computer software used to operate, manage and monitor security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls and home automation devices; computer software used to monitor and track movement activity, health conditions and environmental conditions, and used to transmit electronic messages and data via communications networks; home and office automation systems comprising wireless and wired controllers, controlled devices, and software for lighting, HVAC, security, safety and other home and office monitoring and control applications; electrical controllers and switches for use with water flow and sprinkler systems, home automation and lighting; lighting control panels; motion sensitive security lights; electric and electronic video surveillance installations; cameras, including video, television and surveillance cameras; video and television monitors. mounting devices for cameras and monitors; locator systems, namely, satellite and radio transmitters and receivers, transponders, and antennas; vehicle, pet and personnel locator and recovery device programmed to use global positioning systems (GPS) and

cellular telecommunications; and user manuals sold as a unit therewith” in Class 9, “Telecommunication services, namely, providing access to pictures, video, alarm status, building plans and other building and security information at a remote station; telecommunication services, namely, electronic transmission of voice, messages and data; telecommunication services, namely, information transmission via electronic communications networks; transmission of sound, video and information via computer networks, text messages and voice; transmission, reception and processing of coded and emergency signals; transmission of sound, video and information in the fields of emergencies, security, alarms, security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices, sprinkler systems for fire protection, vehicle, pet and personnel location, automobile safety, vehicle theft, traffic, road navigation and weather; electronic mail services; instant messaging services; electronic voice messaging, namely, the recording and subsequent transmission of voice messages by telephone; and electronic message transmission, namely, providing a website featuring transmission of emergency messaging via computer and telecommunications networks” in Class 38, “Technical consultation services in the field of computer hardware, computer peripherals and computer software used for security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices, sprinkler systems for fire protection, vehicle, pet and personnel location, automobile safety, vehicle theft, traffic, and road navigation; technical support services, namely, troubleshooting of computer hardware, computer peripheral and computer software problems; technical consultation in the field of integration of home automation systems with computer networks and monitoring systems; providing temporary use of online non-downloadable computer software used to operate, manage and monitor security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls and

home automation devices; providing temporary use of online non-downloadable computer software used to monitor and track movement activity, health conditions and environmental conditions, and used to transmit electronic messages and data via communications networks; and weather information services” in Class 42 and “Alarm response and verification services; monitoring of alarms, security systems and home automation systems for security purposes; remote monitoring of alarms, security systems and home automation systems for security purposes; monitoring of computer systems for security purposes, namely, remote monitoring of computer systems in the fields of security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices, sprinkler systems for fire protection, vehicle, pet and personnel location, automobile safety, vehicle theft, traffic, and road navigation, all of the foregoing for security purposes; fire alarm sprinkler and water flow monitoring services for fire alarm security purposes; control of building environmental access and security systems; monitoring telephone calls from subscribers and notifying emergency facilities; theft recovery services, namely, tracking, locating and monitoring of vehicles via a computer network; electronic monitoring services for security purposes in the field of pets, homes, people and business buildings; providing security consulting and security consulting via telephone hotline; monitoring telephone calls and messages from subscribers and notifying emergency facilities from call centers in the fields of security systems, fire alarms, alarm central units, anti-intrusion alarms, burglar alarms, personal health and security alarms, smoke and gas alarms, home surveillance systems, lighting controls, home automation devices and sprinkler systems for fire protection. providing security consulting via telephone hotline and monitoring telephone calls from subscribers and notifying emergency facilities from call centers in the fields of vehicle security and navigation; and concierge services for others comprising making requested personal arrangements and reservations and providing customer-specific information to meet individual needs rendered together in vehicles” in Class 45.

5. Since at least as early as 2001, and prior to any date of first use upon which Applicant can rely, Opposer has validly, continuously and exclusively used the ADT ALWAYS THERE mark throughout the United States for security system monitoring services and related goods and services.
6. Opposer uses and promotes the ADT ALWAYS THERE mark in such a way that the public associates the ADT ALWAYS THERE mark exclusively with the Opposer and Opposer's goods and services.
7. On information and belief, LifeSafety Management, Inc. is a Florida corporation with a business address of 6040 Lake Worth Road, Lake Worth, Florida 33463.
8. On December 4, 2012, Applicant filed an application to register the mark TRULY THERE for services described as "Installation and maintenance of carbon monoxide, fire, burglar, sprinkler and security alarm systems, fire extinguishers, closed circuit TV and access control systems" and "Monitoring of carbon monoxide, fire, burglar, sprinkler and security alarm systems, fire extinguishers, closed circuit TV and access control systems." Applicant's mark was published in the Official Gazette on May 21, 2013.
9. Applicant's TRULY THERE Mark is virtually identical in appearance, sound and commercial impression to Opposer's ADT ALWAYS THERE Mark, and is intended to be used for services virtually identical and/or closely related to the goods and services in connection with which Opposer uses its ADT ALWAYS THERE Mark.

10. Based on the similarities of the marks and the goods, the relevant public is likely to be confused into believing that Applicant's services emanate from Opposer, or are authorized, licensed, endorsed, or sponsored by, or associated with, Opposer. Registration of Applicant's TRULY THERE mark on the Principal Register thus would be inconsistent with Opposer's prior rights in its distinctive ADT ALWAYS THERE Mark.
11. Opposer and the goodwill and reputation symbolized by Opposer's ADT ALWAYS THERE Mark will be damaged by the registration of Applicant's TRULY THERE mark because it so resembles Opposer's Mark as to be likely, when used in connection with the services identified in the subject application, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052.
12. Applicant is not affiliated or connected with, or endorsed or sponsored by, Opposer, nor has Opposer approved any of the services offered by Applicant under the TRULY THERE mark.
13. Applicant's TRULY THERE mark so closely resembles Opposer's ADT ALWAYS THERE Mark that Applicant's mark is likely to cause deception in violation of Section 2(a) of the Trademark Act and to materially alter purchasers' decisions to acquire Applicant's services.
14. Applicant's TRULY THERE mark so closely resembles Opposer's ADT ALWAYS THERE Mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, since Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that the services offered under Applicant's alleged mark are connected with Opposer.
15. Use and registration of the mark TRULY THERE by Applicant will deprive Opposer of its ability to protect its reputation and goodwill.

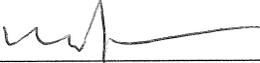
16. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's mark, and registration should be refused.

WHEREFORE, Opposer requests that registration of the mark underlying Application 85/679,671 be refused, and this Notice of Opposition by sustained in Opposer's favor.

This 19th day of June 2013.

Respectfully submitted,

ADT US Holdings, Inc.

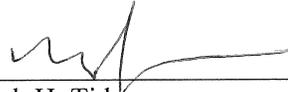
By: 

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Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on this 19th day of June 2013, a true copy of the Notice of Opposition was served on counsel for Applicant via U.S. first-class mail, postage prepaid to:

Michael J. Posner
WARD, DAMON, POSNER, PHETERSON & BLEAU
4420 BEACON CIR
WEST PALM BEACH, FLORIDA 33407



Mark H. Tidman