

ESTTA Tracking number: **ESTTA559679**

Filing date: **09/16/2013**

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	Liebert Corporation
Granted to Date of previous extension	09/15/2013
Address	1050 Dearborn Drive Columbus, OH 43085 UNITED STATES

Attorney information	Lisa M. DuRoss Harness Dickey & Pierce, PLC 5445 Corporate Drive, Suite 200 Troy, MI 48348 UNITED STATES docketingTM@hdp.com, duross@hdp.com, tjcomparoni@hdp.com, jgant@hdp.com
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Applicant Information

Application No	85739008	Publication date	03/19/2013
Opposition Filing Date	09/16/2013	Opposition Period Ends	09/15/2013
Applicant	Shanghai Feixun Communication Co., Ltd. Building 20, 90, HQ Business Park 4855 Guangfulin Road, Songjiang District Shanghai, CHINA		

Goods/Services Affected by Opposition

<p>Class 009. All goods and services in the class are opposed, namely: Computers; computer keyboards; computer operating programs; computer mouse; downloadable electronic publications in the nature of magazines, journals, newsletters, and brochures in the field of telecommunications industry; mouse pads, being computer peripheral; laptop computers; electric navigational instruments; radiotelephony sets; satellite navigational system, namely, a global positioning system; global positioning system; cell phone straps; electronic monitors for monitoring flowmeters; downloadable ring tones for mobile phones; headphones; portable media players; downloadable music files; electric converters; electric connections; chargers for electric batteries; electric batteries; electric accumulators; notebook computers; switchboards; radios; lightning arresters; downloadable image file containing artwork, text, audio, video, games and Internet Web links relating to sporting and cultural activities; galvanic batteries</p>

Grounds for Opposition

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

U.S. Registration No.	3059613	Application Date	06/02/2004
Registration Date	02/14/2006	Foreign Priority Date	NONE
Word Mark	ICOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2005/04/00 First Use In Commerce: 2005/04/00 electronic controller for controlling air conditioners		

Attachments	Not_of_Opp.pdf(240786 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	/lmd/
Name	Lisa M. DuRoss
Date	09/16/2013

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

Liebert Corporation)	
)	
Opposer,)	Opposition No. _____
)	
v.)	Mark: PHICOMM
)	Serial No.: 85/739,008
Shanghai Feixun Communication)	Filed: September 26, 2012
Co., Ltd.)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, Liebert Corporation (“Liebert”), an Ohio corporation, with a principal place of business at 1050 Dearborn Drive, Columbus, OHIO 43229, believes that it is being damaged, and will be damaged, by registration of the mark PHICOMM in Application Serial No. 85/739,008, and opposes the same. As grounds for opposition, Liebert alleges that, upon actual knowledge with respect to Liebert’s own acts, and upon information and belief as to matters:

1. Liebert owns incontestable Reg. No. 3,059,613 for the standard character mark ICOM for “electronic controller for controlling air conditioners” in International Class 9. The registration issued on February 14, 2006 and has been granted incontestable status. Printouts from the TSDR and Assignment databases are enclosed as Exhibit A.
2. The incontestable registration in Paragraph 1 constitutes conclusive proof of Liebert’s ownership of and exclusive rights to use the mark in connection with the

goods recited in the registration. The registration predates the filing date of Applicant's Application Serial No. 85/739,008 and any date of first use that Applicant can prove.

3. Upon information and belief, Applicant Shanghai Feixun Communication Co., Ltd. ("Applicant") is a corporation of China, with an address of Building 20, 90, HQ Business Park, 4855 Guangfulin Road, Songjiang District, Shanghai, CHINA.
4. On September 26, 2012, Applicant filed an application for the stylized mark PHICOMM for "Computers; computer keyboards; computer operating programs; computer mouse; downloadable electronic publications in the nature of magazines, journals, newsletters, and brochures in the field of telecommunications industry; mouse pads, being computer peripheral; laptop computers; electric navigational instruments; radiotelephony sets; satellite navigational system, namely, a global positioning system; global positioning system; cell phone straps; electronic monitors for monitoring flowmeters; downloadable ring tones for mobile phones; headphones; portable media players; downloadable music files; electric converters; electric connections; chargers for electric batteries; electric batteries; electric accumulators; notebook computers; switchboards; radios; lightning arresters; downloadable image file containing artwork, text, audio, video, games and Internet Web links relating to sporting and cultural activities; galvanic batteries" in International Class 9, without specifying a filing basis.

LIKELIHOOD OF CONFUSION

5. Liebert repeats and realleges each and every allegation in Paragraphs 1-4.

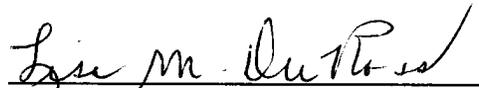
6. Liebert has priority based on its pleaded prior-issued registration for the ICOM mark.
7. Application Serial No. 85/739,008 for the PHICOMM mark covers goods that are closely related to the goods covered by Liebert's ICOM mark.
8. Applicant's PHICOMM mark so resembles Liebert's prior-registered ICOM mark as to be likely, when used in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. §1052(d).

WHEREFORE, Liebert believes that it is being and will be damaged by the registration of the mark shown in Application Serial No. 85/739,008, and requests that the opposition be sustained, and that registration to Applicant be refused.

Please charge the filing fee for this Opposition to the Deposit Account of Harness, Dickey & Pierce, PLC, No. 080750.

LIEBERT CORPORATION

Date: September 16, 2013



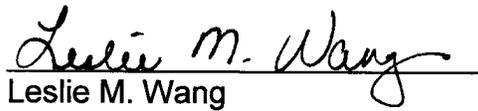
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first-class mail, postage prepaid, on this 16th day of September, 2013, on counsel for Applicant at the following address of record:

Correspondent of Record:

ANDREW D. PRICE
VENABLE LLP
575 7TH ST NW
WASHINGTON, DISTRICT OF COLUMBIA 20004-1607
UNITED STATES


Leslie M. Wang
Harness, Dickey & Pierce, PLC
5445 Corporate Drive, Suite 200
Troy, Michigan 48098
Phone: 248-641-1600

Opposition to Serial No. 85/739,008
Attorney Ref.: 6499-500148

**EXHIBIT A
TO
NOTICE OF OPPOSITION**

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Mark: ICOM

ICOM

US Serial Number: 78428355 **Application Filing Date:** Jun. 02, 2004
US Registration Number: 3059613 **Registration Date:** Feb. 14, 2006
Register: Principal
Mark Type: Trademark
Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.
Status Date: Mar. 21, 2012
Publication Date: May 17, 2005 **Notice of Allowance Date:** Aug. 09, 2005

Mark Information

Mark Literal Elements: ICOM
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.
Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services.
- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *..* identify additional (new) wording in the goods/services.

For: electronic controller for controlling air conditioners
International Class(es): 009 - Primary Class **U.S Class(es):** 021, 023, 026, 036, 038
Class Status: ACTIVE
Basis: 1(a)
First Use: Apr. 2005 **Use in Commerce:** Apr. 2005

Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Liebert Corporation
Owner Address: 1050 Dearborn Drive
Columbus, OHIO 43229
UNITED STATES
Legal Entity Type: CORPORATION **State or Country Where Organized:** OHIO

Attorney/Correspondence Information

Attorney of Record
Attorney Name: Michael P. Brennan, Lisa M. DuRoss **Docket Number:** 6499-200060/
Attorney Primary Email: DocketingTM@hdp.com **Attorney Email:** Yes

Address: _____

Authorized:

Correspondent

Correspondent Name/Address: Michael P. Brennan; Lisa M. DuRoss
Harness, Dickey & Pierce, PLC
5445 Corporate Drive, Suite 200
Troy, MICHIGAN 48098
UNITED STATES

Phone: 248-641-1600

Fax: 248-641-0270

Correspondent e-mail: DocketingTM@hdp.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Mar. 21, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Mar. 21, 2012	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	68973
Mar. 21, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68973
Feb. 13, 2012	TEAS SECTION 8 & 15 RECEIVED	
Feb. 14, 2006	REGISTERED-PRINCIPAL REGISTER	
Jan. 05, 2006	LAW OFFICE REGISTRATION REVIEW COMPLETED	71441
Jan. 05, 2006	ASSIGNED TO LIE	71441
Dec. 23, 2005	ASSIGNED TO LIE	76537
Dec. 21, 2005	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Dec. 20, 2005	STATEMENT OF USE PROCESSING COMPLETE	61813
Dec. 02, 2005	USE AMENDMENT FILED	61813
Dec. 02, 2005	TEAS STATEMENT OF USE RECEIVED	
Aug. 09, 2005	NOA MAILED - SOU REQUIRED FROM APPLICANT	
May 17, 2005	PUBLISHED FOR OPPOSITION	
Apr. 27, 2005	NOTICE OF PUBLICATION	
Jan. 27, 2005	LAW OFFICE PUBLICATION REVIEW COMPLETED	76537
Jan. 21, 2005	ASSIGNED TO LIE	76537
Jan. 11, 2005	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 11, 2005	EXAMINERS AMENDMENT E-MAILED	6328
Jan. 11, 2005	EXAMINERS AMENDMENT -WRITTEN	62520
Jan. 05, 2005	ASSIGNED TO EXAMINER	62520
Jun. 08, 2004	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 114

Date in Location: Mar. 21, 2012



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No assignment has been recorded at the USPTO

For Serial Number: 78428355

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350. v.2.3.4
Web interface last modified: Jul 8, 2013 v.2.3.4

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