

ESTTA Tracking number: **ESTTA661060**

Filing date: **03/13/2015**

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	ARDUINO S.R.L.		
Entity	Corporation	Citizenship	Italy
Address	VIA ROMANO 12 SCARMAGNO (TO), 10010 ITALY		

Correspondence information	Paolo A. Strino Attorney for Opposer Gibbons PC 37th Floor New York, NY 10119 UNITED STATES ipdocket@gibbonslaw.com Phone:2126132023
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**Applicant Information**

Application No	86392594	Publication date	03/03/2015
Opposition Filing Date	03/13/2015	Opposition Period Ends	04/02/2015
Applicant	Arduino, LLC 72 Oak Street, #4 Somerville, MA 02143 UNITED STATES		

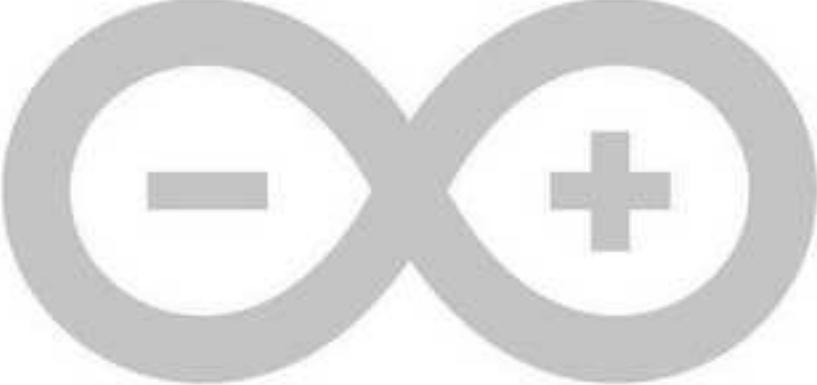
**Goods/Services Affected by Opposition**

Class 009. First Use: 2010/09/26 First Use In Commerce: 2010/09/26 All goods and services in the class are opposed, namely: computer hardware; circuit boards; micro-controllers; computer software development tools; computer hardware kits for making electronic projects consisting of cables, wires, resistors, push buttons, temperature sensors, tilt sensors, LEDs, servo motors, piezoelectric sound components, capacitors, transistors, electric resistors, batteries and electronic connectors
Class 035. First Use: 2010/00/00 First Use In Commerce: 2010/00/00 All goods and services in the class are opposed, namely: online retail store services featuring electronics, computer hardware, circuit boards, microcontrollers, electronic kits, wearable electronics, books, 3D printer components and supplies

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	wrong owner; false allegation of use

**Mark Cited by Opposer as Basis for Opposition**

U.S. Application No.	86402315	Application Date	09/22/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of an infinity symbol with a negative sign inside of the left loop and a positive sign inside of the right loop.		
Goods/Services	Class 009. First use: First Use: 2010/09/22 First Use In Commerce: 2010/09/22 Peripheral devices (computer); stand alone general purpose micro controller boards used for calculation and interface to low voltage electronic components, eletromechanical components and electronic systems like personal computers, modems and wireless devices		

Related Proceedings	92060077
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Attachments	86402315#TMSN.png( bytes ) Notice of Opposition to be Filed.pdf(88653 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	/PAS/
Name	Paolo A. Strino
Date	03/13/2015



## COUNT I

1. To the best of Opposer's knowledge, Arduino LLC, a limited liability company organized under the laws of Massachusetts and having its address of record at 72 Oak Street, #4 Somerville MA 02143 ("Applicant"), filed an application on September 11, 2014 seeking to register the trademark PLUS MINUS and Design (sometimes "Applicant's Trademark"). The particulars of this application are included below:

<u>Mark</u>	<u>Ser. No.</u>	<u>Goods</u>	<u>Filing Basis</u>
 (PLUS MINUS and Design)	86/392,594	Computer hardware; circuit boards; microcontrollers; computer software development tools; computer hardware kits for making electronic projects consisting of cables, wires, resistors, push buttons, temperature sensors, tilt sensors, LEDs, servo motors, piezoelectric sound components, capacitors, transistors, electric resistors, batteries and electronic connectors in International Class 9  Online retail store services featuring electronics, computer hardware, circuit boards, microcontrollers, electronic kits, wearable electronics, books, 3D printer components and supplies in International Class 35.	1(a), use in commerce

The above-referenced information is evidenced by the publication of said mark in the Official Gazette on March 3, 2015.

2. Opposer is and has been engaged, by itself, and through companies operating under its direct supervision or control, in the design, manufacture and sale of a wide range of computer hardware including a variety of microcontroller boards and their accessories intended to make building interactive objects or environments more accessible, as well as printed circuit expansion boards that provide or enable, *inter alia*, GSM connectivity, wireless modules, SD cards, and Bluetooth. For various years, Opposer has been selling, distributing and providing such goods and services under the mark PLUS MINUS and Design throughout the United States, and in many countries across the world. Opposer's products are regarded as some of the best devices in their class.

3. As a result of the widespread use in interstate commerce, Opposer's trademark has acquired extensive goodwill, and is well known and recognized by the public.

4. Opposer has filed the following U.S. trademark application:

<u>Mark</u>	<u>Ser. No.</u>	<u>Goods</u>	<u>Filing Basis</u>
 (PLUS MINUS and Design)	86/402,315 Filed on September 22, 2014	Peripheral devices (computer); stand alone general purpose micro controller boards used for calculation and interface to low voltage electronic components, electromechanical components and electronic systems like personal computers, modems and wireless devices in International Class 9	1(a), use in commerce

Printouts of the PTO summary page for this application is attached as Exhibit A.

5. Considering that the challenged application essentially reproduces Opposer's mark ("Opposer's Trademark"), registration of the proposed mark would damage Opposer's exclusive rights in such mark. This fact, coupled with Opposer's claims stated below, constitutes a "real interest" in the proceeding as well as a "reasonable basis" that Opposer would be damaged if the proposed mark registered. Thus, Opposer's standing is not at issue.

6. For many years, since at least as early as 2010, Opposer has been designing, manufacturing, and selling its products under Opposer's Trademark throughout the United States and is currently manufacturing and selling them in U.S. commerce under the mark. Accordingly, Opposer has acquired common law rights in Opposer's Trademarks through the exclusive and continuous use of the mark in U.S. commerce on the products identified under 2. above and in App. Ser. No.: 86/402,315.

7. U.S. law provides that a trademark applicant must be the lawful owner of the mark. This basic rule applies to both use-based and Intent to Use applications. If the entity filing the application was not the owner of the mark as of the filing date, any resulting registration is void *ab initio*.

8. Upon information and belief, Arduino LLC is not the lawful owner of Applicant's Marks, and was not the lawful owner at the time of filing their applications.

9. Upon information and belief, Applicant is not currently involved, neither directly nor indirectly, in the manufacturing, sale or distribution of the products bearing Applicant's Trademark. Applicant was not involved in such activities in 2010, nor at the time of filing the subject application.

10. Upon information and belief, Applicant does not have any legal authority to, and in fact it does not, direct nor controls Applicant's Trademark, nor the quality of the products

bearing those marks. Applicant did not direct or control such activities in 2010, nor at the time of filing the application for Applicant's Mark.

11. Upon information and belief, Applicant does not have any legal authority to, and in fact it does not control or direct use or placement of Applicant's Mark by any person or entity involved in the manufacturing, distribution or sale of the products bearing Applicant's Mark. Applicant did not control or direct use or placement of Applicant's Marks in 2010, nor at the time of filing the applications for Applicant's Mark.

12. Upon information and belief, to the extent that Applicant has ever used the mark in connection with the services claimed in Class 35, such use of the mark was done under direction and control of Opposer. As such, this use inured exclusively to the benefit of Opposer.

13. Accordingly, Applicant is not, and has never been, the lawful owner of the mark in the opposed application. Thus, the application is void and registration should be denied.

## **COUNT II**

14. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 13 as though set forth herein.

15. If there is a false statement of pre-application use in a use-based application and in fact no use occurred until after the filing of the application, then the registration is void *ab initio*.

16. The challenged application was filed alleging use under Section 1(a) of the Trademark Act.

17. Upon information and belief, at the time of the application, Applicant was not using the applied-for mark on any of the goods identified in Ser. No. 86/392,594.

18. Upon information and belief, to the extent that Applicant has ever used the mark in connection with the services listed in Class 35 of the subject application, use of the mark occurred under direction and control of Opposer. As such, the trademark use inured exclusively to the benefit of Opposer.

19. Opposer is informed and believes, and on that basis alleges that Applicant submitted with its trademark applications specimens of use that depict the products created, manufactured, or sold by Opposer.

20. Accordingly, the challenged application is *void* and otherwise subject to Opposition because Applicant had no lawful trademark use by the time of filing its application.

### **COUNT III**

21. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 20 as though set forth herein.

22. Opposer's U.S. common law rights in Opposer's Trademark date back to 2010.

23. Upon information and belief, Applicant has no trademark rights dating back to 2010.

24. Particularly, Applicant has no valid trademark rights, since it has never used Applicant's Marks on the listed products, has never manufactured, or otherwise sold the products despite Applicant's baseless allegations of use.

25. Upon information and belief, Applicant has no valid trademark rights also in connection with the services listed in Class 35 of the subject application. In fact, to the extent that Applicant has ever used the applied-for mark in connection with the services listed in Class 35 of the subject application, use of the mark occurred under direction and control of Opposer. As such, the trademark use inured exclusively to the benefit of Opposer.

26. Applicant has applied for registration of the trademark PLUS MINUS and Design in connection with identical goods as those sold by Opposer, and in connection with substantially similar and related services.

27. As evidenced by the submission of specimens of use depicting Opposer's products, there is no doubt that Applicant intends the products listed in its registrations to be identical to Opposer's.

28. Upon information and belief, Applicant does not manufacture the products, nor does anybody under Applicant's direction or license, manufacture the products bearing the mark. However, it is clear that persons encountering the parties' products in the future under their respective marks will assume that they originate at the same source or that any product ever sold by Applicant under Applicant's Trademark is endorsed or sponsored by Opposer.

29. Applicant's Trademark and Opposer's Trademark are effectively identical.

30. For these reasons, when applied to Applicant's goods, Applicant's Trademark are likely to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Opposer may be the source of any goods that Applicant may produce or sell, or that such goods are approved, endorsed, sponsored by Opposer. As a result, Opposer would be injured by the registration of Applicant's mark.

31. Any defect, objection to, or fault found with Applicant's products sold under Applicant's Trademarks would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods and business in the United States and abroad.

32. Additionally, when applied to Applicant's services, Applicant's Trademark is likely to cause confusion, to cause mistake, and to deceive the trade and public, who is likely to believe that Opposer may be the source of any of the services that Applicant may provide, or that

such services are approved, endorsed, or sponsored by Opposer. As a result, Opposer would be injured by the registration of Applicant's marks.

33. Therefore, the Board should find that there is likelihood of confusion under Section 2(d) of the Trademark Act between Applicant's and Opposer's trademarks.

WHEREFORE, Opposer prays that registration of the mark PLUS MINUS and Design in U.S. Ser. No.: 86/392,594 be refused and this Opposition be sustained.

A fee in the amount of \$300 as required by 37 CFR §2.6(a)(17) has been submitted electronically, for each party joined, for each class in which registration is opposed, in each application against which the opposition is filed. See T.B.M.P §305.

The Commissioner is authorized to draw on the Deposit Account of Gibbons P.C., Account No. 03/3839, with reference to file 113217, if the accompanying fee is insufficient or inadvertently omitted.

Please recognize as attorneys for Opposer in this proceeding, Paolo A. Strino of Gibbons P.C., One Pennsylvania Plaza, New York, NY 10119.

Respectfully Submitted,

Dated: March 13, 2015

By:



Paolo A. Strino, Esq.  
Gibbons P.C.  
One Pennsylvania Plaza  
New York, NY 10119  
(212) 613-2023  
ipdocket@ gibbonslaw.com  
pstrino@gibbonslaw.com

*Attorney for Opposer*

**CERTIFICATE OF SERVICE AND FILING**

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION, including any exhibits thereof, has been served on Applicant, by mailing said copy on March 13, 2015, via First Class Mail, postage prepaid to Applicant's Attorney of record:

Martin B. Schwimmer  
Leason Ellis LLP  
One Barker Avenue, Fifth Floor  
White Plains, NY 10601

A courtesy copy has been mailed to Applicant's address of record, at 72 Oak Street, #4 Somerville, MA 02143.

The undersigned further certifies that this correspondence is being transmitted electronically to the Commissioner for Trademarks on March 13, 2015, by filing the same electronically at <http://esta.uspto.gov/filing-type.jsp>

By 

Paolo A. Strino, Esq.  
Gibbons P.C.  
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*Attorney for Opposer*

# EXHIBIT A

Generated on: This page was generated by TSDR on 2015-03-13 16:54:10 EDT

Mark:



US Serial Number: 86402315

Application Filing Date: Sep. 22, 2014

Register: Principal

Mark Type: Trademark

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Jan. 16, 2015

## Mark Information

Mark Literal Elements: None

Standard Character Claim: No

Mark Drawing Type: 2 - AN ILLUSTRATION DRAWING WITHOUT ANY WORDS(S)/ LETTER(S)/NUMBER(S)

Description of Mark: The mark consists of an infinity symbol with a negative sign inside of the left loop and a positive sign inside of the right loop.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Design Search Code(s): 24.17.06 - Plus symbol (+)  
24.17.07 - Minus symbol (-)  
24.17.12 - Infinity symbols

## 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 incontestability; and
- Asterisks \*...\* identify additional (new) wording in the goods/services.

For: Peripheral devices (computer); stand alone general purpose micro controller boards used for calculation and interface to low voltage electronic components, electromechanical components and electronic systems like personal computers, modems and wireless devices

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 22, 2010

Use in Commerce: Sep. 22, 2010

## Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

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: ARDUINO S.R.L.

Owner Address: VIA ROMANO 12  
SCARMAGNO (TO) 10010  
ITALY

Legal Entity Type: SOCIETÀ A RESPONSABILITÀ LIMITATA (SRL)

State or Country Where Organized: ITALY

## Attorney/Correspondence Information

### Attorney of Record

Attorney Name: PAOLO A. STRINO

Docket Number: BUZZ-1002-TM

Attorney Primary Email Address: [info@lmiplaw.com](mailto:info@lmiplaw.com)

Attorney Email Authorized: Yes

#### Correspondent

**Correspondent Name/Address:** PAOLO A. STRINO  
Gibbons P.C.  
One Penn Plaza, 37th Floor  
New York, NEW YORK 10119-3701  
UNITED STATES

**Phone:** 212.613.2023

**Fax:** 212.554.9623

**Correspondent e-mail:** [ipdocket@gibbonslaw.com](mailto:ipdocket@gibbonslaw.com)

**Correspondent e-mail Authorized:** Yes

#### Domestic Representative

**Domestic Representative Name:** PAOLO A. STRINO

**Phone:** 212-661-8000

**Fax:** 212-661-8002

**Domestic Representative e-mail:** [info@lmiplaw.com](mailto:info@lmiplaw.com)

**Domestic Representative e-mail Authorized:** Yes

## Prosecution History

Date	Description	Proceeding Number
Jan. 20, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 16, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jan. 16, 2015	NON-FINAL ACTION E-MAILED	6325
Jan. 16, 2015	NON-FINAL ACTION WRITTEN	83182
Jan. 14, 2015	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jan. 06, 2015	ASSIGNED TO EXAMINER	83182
Oct. 01, 2014	NOTICE OF DESIGN SEARCH CODE E-MAILED	
Sep. 30, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 25, 2014	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

#### TM Staff Information

**TM Attorney:** TOOLEY, DAVID E

**Law Office Assigned:** LAW OFFICE 112

#### File Location

**Current Location:** TMO LAW OFFICE 112 - EXAMINING ATTORNEY ASSIGNED

**Date in Location:** Jan. 16, 2015

## Assignment Abstract Of Title Information

#### Summary

**Total Assignments:** 1

**Applicant:** Smart Projects S.r.l.

#### Assignment 1 of 1

**Conveyance:** CHANGE OF NAME

**Reel/Frame:** [5436/0672](#)

**Pages:** 8

**Date Recorded:** Jan. 08, 2015

**Supporting Documents:** [assignment-tm-5436-0672.pdf](#)

#### Assignor

**Name:** [SMART PROJECTS S.R.L.](#)

**Execution Date:** Nov. 05, 2014

**Legal Entity Type:** SOCIETÀ A RESPONSABILITÀ LIMITATA (SRL)

**State or Country Where Organized:** ITALY

#### Assignee

**Name:** [ARDUINO S.R.L.](#)

**Legal Entity Type:** SOCIETÀ A RESPONSABILITÀ LIMITATA (SRL)

**State or Country Where Organized:** ITALY

**Address:** VIA ROMANO 12  
SCARMAGNO (TO), ITALY 10010

#### Correspondent

**Correspondent Name:** PAOLO A. STRINO OF GIBBONS P.C.

Correspondent Address: 37TH FLOOR  
ONE PENNSYLVANIA PLAZA  
NEW YORK, NY 10119

Domestic Representative - Not Found

## Proceedings

### Summary

Number of Proceedings: 1

#### Type of Proceeding: Cancellation

Proceeding Number: [92060077](#)

Filing Date: Oct 03, 2014

Status: Pending

Status Date: Oct 03, 2014

Interlocutory Attorney: ANN LINNEHAN VOGLER

#### Defendant

Name: Arduino, LLC

Correspondent Address: MARTIN B SCHWIMMER  
LEASON ELLIS LLP  
ONE BARKER AVENUE, FIFTH FLOOR  
WHITE PLAINS NY , 10601  
UNITED STATES

Correspondent e-mail: [schwimmer@leasonellis.com](mailto:schwimmer@leasonellis.com) , [levin@leasonellis.com](mailto:levin@leasonellis.com) , [tmocket@leasonellis.com](mailto:tmocket@leasonellis.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
ARDUINO	Cancellation Pending	<a href="#">77708806</a>	<a href="#">3931675</a>
ARDUINO	Cancellation Pending	<a href="#">85144567</a>	<a href="#">4113794</a>

#### Plaintiff(s)

Name: Arduino S.r.l.

Correspondent Address: PAOLO A STRINO  
GIBBONS PC  
ONE PENNSYLVANIA PLAZA, 37TH FLOOR  
NEW YORK NY , 10119-3701  
UNITED STATES

Correspondent e-mail: [ipocket@gibbonslaw.com](mailto:ipocket@gibbonslaw.com) , [pstrino@gibbonslaw.com](mailto:pstrino@gibbonslaw.com) , [paolostrino@gmail.com](mailto:paolostrino@gmail.com) , [TOWens@gibbonslaw.com](mailto:TOWens@gibbonslaw.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
ARDUINO	Non-Final Action - Mailed	<a href="#">86402315</a>	
ARDUINO	Non-Final Action - Mailed	<a href="#">86400350</a>	

#### Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Oct 03, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Oct 06, 2014	Nov 15, 2014
3	PENDING, INSTITUTED	Oct 06, 2014	
4	D MOT FOR EXT W/O CONSENT	Nov 17, 2014	
5	CHANGE OF CORRESP ADDRESS	Nov 30, 2014	
6	P OPP/RESP TO MOTION	Nov 30, 2014	
7	ANSWER	Dec 15, 2014	
8	EXTENSION OF TIME GRANTED	Jan 05, 2015	
9	P CHANGE OF NAME	Jan 12, 2015	
10	TRIAL DATES REMAIN AS SET	Jan 24, 2015	