

ESTTA Tracking number: **ESTTA697808**

Filing date: **09/23/2015**

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 parties oppose registration of the indicated application.

**Opposers Information**

Name	3M Company
Granted to Date of previous extension	09/23/2015
Address	2501 Hudson Road St. Paul, MN 55144 UNITED STATES

Name	3M Deutschland GmbH		
Entity	Corporation	Citizenship	Germany
Address	Carl-Schurz-Str 1 Neuss,, 41453 GERMANY		

Attorney information	Katherine K. Madianos Norton Rose Fulbright US LLP 98 San Jacinto Blvd, Suite 1100 Austin, TX 78701 UNITED STATES aoipdocket@nortonrosefulbright.com, FJ3Mtrademark@nortonrosefulbright.com, katherine.madianos@nortonrosefulbright.com Phone:512 474 5201
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**Applicant Information**

Application No	79149942	Publication date	05/26/2015
Opposition Filing Date	09/23/2015	Opposition Period Ends	09/23/2015
International Registration No.	1210980	International Registration Date	02/21/2014
Applicant	Schmidt & Bender GmbH & Co. KG Am Grossacker 42  GERMANY		

**Goods/Services Affected by Opposition**

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Optical apparatus and instruments, and structural parts and fittings therefor, namely, optical lenses, optical scanners, optical or telescopic lens sights, optical inspection apparatus, and microscopes; Observation instruments, namely, optical or telescopic lens sights, telescopes, binoculars, and microscopes; Instruments containing eyepieces, namely, optical or telescopic lens sights, telescopes, microscopes, and binoculars; Scientific apparatus and instruments for research in laboratories and as laboratory equipment, namely, diode lasers,
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solid-state lasers, fiber lasers, and laser scanning microscopes for scientific purposes; Microscopes and electron microscopes; Borescopes; Technoscopes; Spectrometers; Extinction meters and plotters, namely, electronic plotters, digital plotters, and laser plotters; Photometers; Fluorometers; Stereoscopes; Protective eyepieces; Optical lenses; Semiconductor lenses, namely, optical semiconductor amplifiers; Microscope objectives, namely, lenses for microscopes and lenses for lasers; Optical lenses, prisms, and wedges, namely, optical lenses, prisms for optic purposes, prisms for scientific purposes, and prisms for lasers; Flat optical components, namely, optical mirrors, laser mirrors, filters for optical devices, laser filters, colored glass filters for optical devices, and colored glass filters for lasers; Crystal components and synthetic crystals for optical purposes, namely, optical mirrors, prisms for microscopes, and prisms for lasers; Colorimeters; Optical crystals and optical plummets, namely, optical mirrors, laser mirrors, prisms for microscopes, and prisms for lasers, all the aforesaid goods being for optical purposes and not for medical purposes; Lasers for non-medical use; Microscopes for non-surgical, non-medical purposes; Electron microscopes for non-surgical, non-medical purposes; Diffraction apparatus in the nature of microscopy for non-surgical, non-medical purposes, namely, microscopes and their parts for non-surgical use; Head-mounted magnifiers for non-medical purposes, namely, head-mounted binoculars and head-mounted video magnifiers; Microscope lenses for non-surgical, non-medical purposes

Class 010. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Surgical, medical, dental, and veterinary apparatus and instruments, equipment, and auxiliary devices, namely, surgical apparatus and instruments for medical, dental, or veterinary use, surgical apparatus and instruments for use in ophthalmic surgery, microscopes for surgical operations, dental drills, lasers for surgical operations, lasers for dental cleaning, lasers for use in soft tissue surgery and dermatology, and structural parts and fittings for the aforesaid goods; Optical apparatus, instruments, and equipment for medical purposes, namely, magnifying glasses for medical examination purposes that fit on the user's face in the manner of eyeglasses, endoscopy cameras, and scanning laser ophthalmoscopes; Optical measuring instruments for medical purposes, namely, optometric instruments for locating the optical center of ophthalmic lenses and optometric instruments for measuring the diameter of ophthalmic lenses; Instruments containing eyepieces for medical purposes, namely, microscopes for surgical operations, endoscopy cameras, and endoscopes; Optical instruments for medical endoscopy, endoscopes, and technoscopes, namely, endoscopy cameras, endoscopes, rigid and flexible medical endoscopes, and technoscopes specifically designed for surgical use; Probes for medical purposes; Optical scanners for medical inspection purposes, namely, optical laser computed tomography (CT) scanners and medical and dental apparatus for dimensional measurement in the nature of a 3-D scanner for human body; Optical temperature measuring instruments for medical inspection purposes, namely, thermometers for medical purposes; Optical tomography apparatus for medical purposes, namely, computed tomography (CT) apparatus for medical use and nuclear spin tomographs for medical purposes; Medical apparatus and instruments for use in positron emission tomography (PET) imaging; Spectrometers for medical purposes; Extinction analysers and plotters for medical purposes, namely, electronic plotters specifically for use with ophthalmoscopes to determine vision loss; Photometers for medical purposes; Fluorometers for medical purposes; Stereoscopes for medical purposes; Lasers for medical purposes; Eyepieces, lenses, semiconductor lenses, optical lenses, prisms, and wedges, all specifically designed for use with ophthalmoscopes and medical microscopes; Flat optical components, namely, surgical mirrors, dental mirrors, filters for optical devices used for medical purposes, namely, magnifying glasses for medical examination purposes that fit on the user's face in the manner of eyeglasses, endoscopy cameras, and scanning laser ophthalmoscopes, laser filters, intraocular lens filters for diagnosing eye disease, and colored glass filters, namely, colored intraocular lens filters for diagnosing eye disease; Optical crystal components and synthetic optical crystals for medical purposes, namely, intraocular lenses; perimeters, namely, instruments for measuring the diameter of ophthalmic lenses and devices for measuring the size of wounds; Colorimeters, optical crystals, and optical plummets, namely, intraocular lenses and meters for medical use for measuring a person's ability to see colors; All of the aforesaid goods being for medical purposes

Class 037. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Repair, maintenance and servicing of optical apparatus, equipment and instruments, in particular of optical apparatus, equipment and instruments for medical purposes; repair, maintenance and servicing of lasers and laser systems, apparatus and components therefor

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Lack of Bona Fide Intent to Use # Trademark Act Section 66(a)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2396973	Application Date	12/03/1998
Registration Date	10/24/2000	Foreign Priority Date	NONE
Word Mark	PENTA		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 005. First use: First Use: 1994/08/01 First Use In Commerce: 1994/08/01            Impression material for dental and dental technical uses, bite checking material for dental and dental technical uses, duplicating material for dental and dental technical uses, embedding material for dental and dental technical uses, [ material for tooth crowns and tooth bridges for dental and dental technical uses ]</p> <p>Class 010. First use: First Use: 1994/08/01 First Use In Commerce: 1994/08/01            [ Instruments for the application and ]preparation [ of medical, surgical and dental medical materials, namely, ] dental instruments for mixing, dispensation and application of dental impression materials, bite checking materials</p>		

U.S. Registration No.	1837793	Application Date	04/19/1993
Registration Date	05/31/1994	Foreign Priority Date	NONE
Word Mark	PENTAMIX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 010. First use: First Use: 0 First Use In Commerce: 0            automatic mixing device for elastomer impression materials as used in the fieldof dental medicine</p>		

Attachments	<p>75598574#TMSN.png( bytes )            Notice of Opposition re SN 79149942.pdf(35254 bytes )            Exhibit A.pdf(778053 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	/Katherine K. Madianos/
Name	Katherine K. Madianos
Date	09/23/2015

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

In the matter of Application Serial No. 79/149,942  
By Schmidt & Bender GmbH & Co. KG for the mark **PENTA PULSE**  
Filed: February 21, 2014  
Published: May 26, 2015

3M Company and 3M Deutschland GmbH,	§	
	§	
Opposers,	§	
	§	
v.	§	Opposition No.: _____
	§	
SCHMIDT & BENDER GMBH & CO. KG,	§	
	§	
Applicant.	§	
	§	

**NOTICE OF OPPOSITION**

3M Company, a Delaware corporation having a principal place of business at 3M Center, 2501 Hudson Road, St. Paul, Minnesota, 55144-1000 (“3M Company”), and 3M Deutschland GmbH, a company organized under the laws of Germany and located at Carl-Schurz-Str 1 41453 Neuss, Germany (“3M Deutschland” and, together with 3M Company, “Opposers”), believe that they will be damaged by registration of the mark in Application Serial No. 79/149,942, and oppose this Application under the provisions of 15 U.S.C. § 1063. The Request for Extension of Time to Oppose for Good Cause filed in this proceeding on June 5, 2015 identified 3M Company as the Potential Opposer, which is in privity with 3M Deutschland within the meaning of TBMP § 206.02 as demonstrated by the facts stated below.

As grounds for this opposition, Opposers assert that:

1. 3M Deutschland is the owner of the marks PENTA and PENTAMIX. 3M Deutschland is the wholly-owned subsidiary of 3M Company and licenses the PENTA and PENTAMIX marks to 3M Company for use in the United States.

3M Deutschland, through its predecessor, adopted and began using the PENTA and PENTAMIX marks for dental compounds and instruments at least as early as 1994 and has continuously used its PENTA and PENTAMIX marks with such products since that time.

2. Opposers' PENTA and PENTAMIX marks are inherently distinctive.

3. As a result of Opposers' long use and extensive promotion of the PENTA and PENTAMIX marks, the PENTA and PENTAMIX marks have become distinctive to designate Opposers, to distinguish Opposers and their products from the products of others, and to distinguish the source or origin of Opposers' products. As a result of Opposers' efforts, the purchasing public recognizes and associates the PENTA and PENTAMIX marks with Opposers and their products. Opposers have established valuable goodwill in the PENTA and PENTAMIX marks.

4. As a result of Opposers' long use and extensive promotion of the PENTA and PENTAMIX marks, Opposers have acquired valuable common law rights in the PENTA and PENTAMIX marks throughout the United States.

5. 3M Deutschland is the owner of the following U.S. registrations for the PENTA and PENTAMIX marks:

REG. NO.	MARK	GOODS/SERVICES
2396973	PENTA	<p><u>International Class 5</u>: Impression material for dental and dental technical uses, bite checking material for dental and dental technical uses, duplicating material for dental and dental technical uses, embedding material for dental and dental technical uses</p> <p><u>International Class 10</u>: Preparation dental instruments for mixing, dispensation and application of dental impression materials, bite checking materials</p>
1837793	PENTAMIX	<p><u>International Class 10</u>: Automatic mixing device for elastomer impression materials as used in the field of dental medicine</p>

The above registrations are valid, subsisting and enforceable. True and correct printouts from the TSDR database for each of these registrations are attached as Exhibit A.

6. The above registrations are incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. Consequently, these registrations are conclusive evidence of the validity of the registered marks and of the registration of the marks, of 3M Deutschland’s ownership of the marks, and of 3M Deutschland’s exclusive right to use the registered marks in commerce under Section 33 of the Lanham Act, 15 U.S.C. § 1115.

7. Applicant Schmidt & Bender GmbH & Co. KG (“Applicant”) seeks to register the mark PENTA PULSE (“Applicant’s Mark”) for the following goods and services: “Optical apparatus and instruments, and structural parts and fittings therefor, namely, optical lenses, optical scanners, optical or telescopic lens sights, optical inspection apparatus, and microscopes; Observation instruments, namely, optical or telescopic lens sights, telescopes, binoculars, and microscopes; Instruments containing eyepieces, namely, optical or telescopic lens sights, telescopes,

microscopes, and binoculars; Scientific apparatus and instruments for research in laboratories and as laboratory equipment, namely, diode lasers, solid-state lasers, fiber lasers, and laser scanning microscopes for scientific purposes; Microscopes and electron microscopes; Borescopes; Technoscopes; Spectrometers; Extinction meters and plotters, namely, electronic plotters, digital plotters, and laser plotters; Photometers; Fluorometers; Stereoscopes; Protective eyepieces; Optical lenses; Semiconductor lenses, namely, optical semiconductor amplifiers; Microscope objectives, namely, lenses for microscopes and lenses for lasers; Optical lenses, prisms, and wedges, namely, optical lenses, prisms for optic purposes, prisms for scientific purposes, and prisms for lasers; Flat optical components, namely, optical mirrors, laser mirrors, filters for optical devices, laser filters, colored glass filters for optical devices, and colored glass filters for lasers; Crystal components and synthetic crystals for optical purposes, namely, optical mirrors, prisms for microscopes, and prisms for lasers; Colorimeters; Optical crystals and optical plummet, namely, optical mirrors, laser mirrors, prisms for microscopes, and prisms for lasers, all the aforesaid goods being for optical purposes and not for medical purposes; Lasers for non-medical use; Microscopes for non-surgical, non-medical purposes; Electron microscopes for non-surgical, non-medical purposes; Diffraction apparatus in the nature of microscopy for non-surgical, non-medical purposes, namely, microscopes and their parts for non-surgical use. Head-mounted magnifiers for non-medical purposes, namely, head-mounted binoculars and head-mounted video magnifiers; Microscope lenses for non-surgical, non-medical purposes,” in International Class 009; “Surgical, medical, dental, and veterinary apparatus and instruments, equipment, and auxiliary devices, namely, surgical apparatus and instruments for medical, dental, or veterinary use, surgical apparatus and instruments for use in ophthalmic surgery, microscopes for surgical operations, dental drills, lasers for surgical operations, lasers for dental cleaning, lasers for use in soft tissue surgery and dermatology, and structural parts

and fittings for the aforesaid goods; Optical apparatus, instruments, and equipment for medical purposes, namely, magnifying glasses for medical examination purposes that fit on the user's face in the manner of eyeglasses, endoscopy cameras, and scanning laser ophthalmoscopes; Optical measuring instruments for medical purposes, namely, optometric instruments for locating the optical center of ophthalmic lenses and optometric instruments for measuring the diameter of ophthalmic lenses; Instruments containing eyepieces for medical purposes, namely, microscopes for surgical operations, endoscopy cameras, and endoscopes; Optical instruments for medical endoscopy, endoscopes, and technoscopes, namely, endoscopy cameras, endoscopes, rigid and flexible medical endoscopes, and technoscopes specifically designed for surgical use; Probes for medical purposes; Optical scanners for medical inspection purposes, namely, optical laser computed tomography (CT) scanners and medical and dental apparatus for dimensional measurement in the nature of a 3-D scanner for human body; Optical temperature measuring instruments for medical inspection purposes, namely, thermometers for medical purposes; Optical tomography apparatus for medical purposes, namely, computed tomography (CT) apparatus for medical use and nuclear spin tomographs for medical purposes; Medical apparatus and instruments for use in positron emission tomography (PET) imaging; Spectrometers for medical purposes. Extinction analysers and plotters for medical purposes, namely, electronic plotters specifically for use with ophthalmoscopes to determine vision loss; Photometers for medical purposes; Fluorometers for medical purposes; Stereoscopes for medical purposes; Lasers for medical purposes; Eyepieces, lenses, semiconductor lenses, optical lenses, prisms, and wedges, all specifically designed for use with ophthalmoscopes and medical microscopes; Flat optical components, namely, surgical mirrors, dental mirrors, filters for optical devices used for medical purposes, namely, magnifying glasses for medical examination purposes that fit on the user's face in the manner of eyeglasses, endoscopy cameras, and scanning

laser ophthalmoscopes, laser filters, intraocular lens filters for diagnosing eye disease, and colored glass filters, namely, colored intraocular lens filters for diagnosing eye disease; Optical crystal components and synthetic optical crystals for medical purposes, namely, intraocular lenses; perimeters, namely, instruments for measuring the diameter of ophthalmic lenses and devices for measuring the size of wounds; Colorimeters, optical crystals, and optical plummets, namely, intraocular lenses and meters for medical use for measuring a person's ability to see colors; All of the aforesaid goods being for medical purposes,” in International Class 010; and “Repair, maintenance and servicing of optical apparatus, equipment and instruments, in particular of optical apparatus, equipment and instruments for medical purposes; repair, maintenance and servicing of lasers and laser systems, apparatus and components therefor in International Class 37 (“Applicant’s Goods”).

8. Applicant’s application for and use of Applicant’s Mark has not been authorized by Opposers nor is Applicant affiliated with Opposers.

9. There is no issue as to priority. Applicant filed its application under Section 66(a) of the Trademark Act, 15 U.S.C. §§1141f(a), on February 21, 2014 with a priority date of August 21, 2013. In contrast, 3M Deutschland, through its licensee 3M Company and predecessor-in-interest, has been continuously using the PENTA and PENTAMIX marks in commerce since 1994. Opposers therefore have priority over Applicant with respect to the marks at issue.

10. The mark that Applicant seeks to register so resembles the PENTA and PENTAMIX marks as to be likely, when used on or in connection with Applicant’s Goods, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to falsely believe that Applicant’s Goods offered under Applicant’s Mark are sponsored, endorsed, or approved by

Opposers, or are in some way affiliated, connected, or associated with Opposers or Opposers' goods offered under the PENTA and PENTAMIX marks.

11. On information and belief, Applicant does not have a bona fide intention to use Applicant's Mark in connection with all of the goods and services identified in the Application, and did not have such intent when filing the Application. As such the Application does not satisfy the bona fide intent to use requirement of Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a).

12. Registration of Applicant's Mark would be a source of damage to Opposers because purchasers are likely to attribute the source or sponsorship of Applicant's Goods to Opposers.

13. Registration of Applicant's Mark would be a source of damage to Opposers, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Opposers' long prior use of the PENTA and PENTAMIX marks.

WHEREFORE, 3M Company and 3M Deutschland GmbH pray that Application Serial No. 79/149,942 be rejected, and that registration of the mark therein be refused under 15 U.S.C. §§ 1052(d), 1063 and 1141f(a).

The filing fee in the amount of \$1,800.00 required by 37 C.F.R. § 2.6(a)(17) is being submitted herewith. The Commissioner is authorized to draw on the deposit account of Norton Rose Fulbright US L.L.P., Account No. 50-1212/THRT.T2245/11408701/MSM, in the event that anything prevents the successful completion of electronic payment of the filing fee.

Date: September 23, 2015

Respectfully submitted,

/s/Katherine K. Madianos/  
Katherine K. Madianos  
NORTON ROSE FULBRIGHT US LLP  
98 San Jacinto Blvd., Suite 1100  
Austin, Texas 78701  
Tel: 512.474.5201  
Fax: 512.536.4598

ATTORNEYS FOR OPPOSERS  
3M COMPANY and  
3M DEUTSCHLAND GMBH

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on Maureen Beacom Gorman by mailing said copy on this the 23<sup>rd</sup> day of September 2015, via First Class Mail, postage prepaid to:

Maureen Beacom Gorman  
Marshall Gerstein & Borun  
233 South Wacker Drive  
Suite 6300  
Chicago, ILLINOIS 60606

/s/Erin Molson/  
Erin Molson

# **EXHIBIT A**



Trademark Status & Document Retrieval (TSDR)

SEARCH MULTI-SEARCH ?
US Registration No 2396973 Status Documents

Status results found

TAB: STATUS DOCUMENTS ? Download Print Preview

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Mark: PENTA

PENTA

US Serial Number: 75598574 Application Filing Date: Dec. 03, 1998

US Registration Number: 2396973 Registration Date: Oct. 24, 2000

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Dec. 13, 2010

Publication Date: Aug. 01, 2000

Mark Information

Collapse All

Mark Literal Elements: PENTA

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Related Properties Information

Claimed Ownership of US Registrations: 1837793

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: Impression material for dental and dental technical uses, bite checking material for dental and dental technical uses, duplicating material for dental and dental technical uses, embedding material for dental and dental technical uses, [ material for tooth crowns and tooth bridges for dental and dental technical uses ]

International Class(es): 005 - Primary Class U.S Class(es): 006, 018, 044, 046, 051, 052

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 01, 1994 Use in Commerce: Aug. 01, 1994

For: [ Instruments for the application and ] preparation [ of medical, surgical and dental medical materials, namely, ] dental instruments for mixing, dispensation and application of dental impression materials, bite checking materials

International Class(es): 010 - Primary Class U.S Class(es): 026, 039, 044

Class Status: ACTIVE

Basis: 1(a)

First Use: Aug. 01, 1994 Use in Commerce: Aug. 01, 1994

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 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: 3M DEUTSCHLAND GMBH

Owner Address: CARL-SCHURZ-STR 1  
41453 NEUSS  
GERMANY

Legal Entity Type: CORPORATION

State or Country Where  
Organized: GERMANY

### Attorney/Correspondence Information

#### Attorney of Record

Attorney Name: James F. Voegeli

Docket Number: 32988

Attorney Primary Email  
Address: trademarks@mmm.com

Attorney Email Authorized: Yes

#### Correspondent

Correspondent  
Name/Address: James F. Voegeli  
3M INNOVATIVE PROPERTIES COMPANY  
220-9E-01  
3M CENTER, 2501 HUDSON ROAD  
ST. PAUL, MINNESOTA 55144  
UNITED STATES

Phone: 651 736-6989

Fax: 651 736-3783

Correspondent e-mail: trademarks@mmm.com

Correspondent e-mail  
Authorized: Yes

#### Domestic Representative

Domestic Representative  
Name: JOHN E. MCKIE

### Prosecution History

Date	Description	Proceeding Number
Feb. 08, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Dec. 13, 2010	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	75461
Dec. 13, 2010	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Dec. 08, 2010	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75461
Oct. 21, 2010	TEAS SECTION 8 & 9 RECEIVED	
Feb. 06, 2009	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	71378
Apr. 19, 2007	ASSIGNED TO PARALEGAL	71378
Mar. 22, 2007	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Mar. 22, 2007	TEAS SECTION 8 & 15 RECEIVED	
Jan. 30, 2006	CASE FILE IN TICRS	
Oct. 24, 2000	REGISTERED-PRINCIPAL REGISTER	
Aug. 01, 2000	PUBLISHED FOR OPPOSITION	
Jun. 30, 2000	NOTICE OF PUBLICATION	
Mar. 28, 2000	APPROVED FOR PUB - PRINCIPAL REGISTER	
Dec. 16, 1999	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Jun. 16, 1999	NON-FINAL ACTION MAILED	
Jun. 14, 1999	ASSIGNED TO EXAMINER	60740

### Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Oct. 24, 2010

### TM Staff and Location Information

TM Staff Information - None

#### File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Dec. 13, 2010

## Assignment Abstract Of Title Information

### Summary

Conveyance Filter

Total Assignments: 2

Registrant: ESPE Dental AG

### Assignment 1 of 2

Collapse All

Conveyance: CHANGE OF NAME

Reel/Frame: 2644/0750

Pages: 14

Date Recorded: Jan. 06, 2003

Supporting Documents: [assignment-tm-2644-0750.pdf](#)

#### Assignor

Name: ESPE DENTAL AG

Execution Date: Mar. 22, 2001

Legal Entity Type: GERMAN CORPORATION

State or Country Where Organized: No Place Where Organized Found

#### Assignee

Name: 3M ESPE AG

Legal Entity Type: GERMAN CORPORATION

State or Country Where Organized: No Place Where Organized Found

Address: ESPE PLATZ  
SEEFELD, GERMANY 82229

#### Correspondent

Correspondent Name: LADAS & PARRY

Correspondent Address: JOHN E. MCKIE  
224 S. MICHIGAN AVE.  
SUITE 1200  
CHICAGO, IL 60604

#### Domestic Representative - Not Found

### Assignment 2 of 2

Conveyance: MERGER EFFECTIVE 12/23/2011

Reel/Frame: 4710/0836

Pages: 17

Date Recorded: Feb. 03, 2012

Supporting Documents: [assignment-tm-4710-0836.pdf](#)

#### Assignor

Name: 3M ESPE AG

Execution Date: Dec. 23, 2011

Legal Entity Type: CORPORATION

State or Country Where Organized: GERMANY

#### Assignee

Name: 3M DEUTSCHLAND GMBH

Legal Entity Type: CORPORATION

State or Country Where Organized: GERMANY

Address: CARL-SCHURZ-STR 1  
41453 NEUSS, GERMANY

#### Correspondent

Correspondent Name: JAMES F. VOEGELI, 3M INNOVATIVE PROPERTI

Correspondent Address: 3M CENTER, 2501 HUDSON ROAD  
220 9E 01  
ST. PAUL, MN 55144

#### Domestic Representative - Not Found

### Proceedings - Click to Load

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- » Notification and Federal Employee Antidiscrimination and Retaliation (NoFEAR) Act
- » Budget & Performance

- » Freedom of Information Act (FOIA)
- » Department of Commerce NoFEAR Act Report
- » Regulations.gov
- » STOP!Fakes.gov

- » Strategy Targeting Organized Piracy (STOP!)
- » Information Quality Guidelines
- » Department of Commerce
- » USPTO Webmaster



Trademark Status & Document Retrieval (TSDR)

SEARCH MULTI-SEARCH ?
US Registration No 1837793 Status Documents

Status results found

STATUS DOCUMENTS ? Download Print Preview

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Mark: PENTAMIX

No image exists for this case.

US Serial Number: 74380319

Application Filing Date: Apr. 19, 1993

US Registration Number: 1837793

Registration Date: May 31, 1994

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: May 05, 2014

Publication Date: Mar. 08, 1994

Mark Information

Collapse All

Mark Literal Elements: PENTAMIX

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Foreign Information

Foreign Registration Number: 2028871

Foreign Registration Date: Jan. 27, 1993

Foreign Application/Registration Country: GERMANY

Foreign Expiration Date: Sep. 01, 2002

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: automatic mixing device for elastomer impression materials as used in the field of dental medicine

International Class(es): 010 - Primary Class

U.S Class(es): 044

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Table with 3 columns: Filed Use, Currently Use, Amended Use. Rows include ITU, 44D, 44E, 66A, and No Basis.

Current Owner(s) Information

Owner Name: 3M DEUTSCHLAND GMBH

**Owner Address:** CARL-SCHURZ-STR 1  
41453 NEUSS  
GERMANY

**Legal Entity Type:** CORPORATION

**State or Country Where  
Organized:** GERMANY

### ▼ Attorney/Correspondence Information

#### Attorney of Record

**Attorney Name:** James F. Voegeli

**Docket Number:** 32991

**Attorney Primary Email  
Address:** trademarks@mmm.com

**Attorney Email Authorized:** Yes

#### Correspondent

**Correspondent  
Name/Address:** James F. Voegeli  
3M INNOVATIVE PROPERTIES COMPANY  
3M Center, 2501 Hudson Road  
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#### Domestic Representative - Not Found

### ▼ Prosecution History

Date	Description	Proceeding Number
May 05, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
May 05, 2014	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	66607
May 05, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	66607
May 02, 2014	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	66607
May 02, 2014	TEAS SECTION 8 & 9 RECEIVED	
Feb. 08, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
May 02, 2011	CASE FILE IN TICRS	
Mar. 24, 2011	CASE FILE IN TICRS	
Jul. 27, 2004	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jul. 27, 2004	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
May 26, 2004	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
May 26, 2004	TEAS SECTION 8 & 9 RECEIVED	
Aug. 11, 2000	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jul. 17, 2000	RESPONSE RECEIVED TO POST REG. ACTION - SEC. 8 & 15	
Feb. 11, 2000	POST REGISTRATION ACTION MAILED - SEC. 8 & 15	
Oct. 06, 1999	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
May 31, 1994	REGISTERED-PRINCIPAL REGISTER	
Mar. 08, 1994	PUBLISHED FOR OPPOSITION	
Feb. 04, 1994	NOTICE OF PUBLICATION	
Dec. 14, 1993	APPROVED FOR PUB - PRINCIPAL REGISTER	
Dec. 01, 1993	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Aug. 10, 1993	NON-FINAL ACTION MAILED	
Jul. 28, 1993	ASSIGNED TO EXAMINER	67971

### ▼ Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** May 31, 2014

### ▼ TM Staff and Location Information

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: May 05, 2014

Assignment Abstract Of Title Information - Click to Load

Proceedings

Summary

Party type

Proceeding type

Number of Proceedings: 1

Type of Proceeding: Opposition

Collapse All

Proceeding Number: 91192096

Filing Date: Sep 29, 2009

Status: Terminated

Status Date: Jan 27, 2011

Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: Biomed Est.

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Associated marks

Mark	Application Status	Serial Number	Registration Number
PENTAGUM	Abandoned - After Inter-Partes Decision	77659070	

Plaintiff(s)

Name: 3M ESPE AG

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Associated marks

Mark	Application Status	Serial Number	Registration Number
PENTAMIX	Renewed	74380319	1837793
PENTA	Renewed	75598574	2396973

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 29, 2009	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 29, 2009	Nov 08, 2009
3	PENDING, INSTITUTED	Sep 29, 2009	
4	ANSWER	Nov 09, 2009	
5	P'S MOT FOR EXTEN. OF TIME W/ CONSENT	Dec 14, 2009	
6	EXTENSION OF TIME GRANTED	Dec 16, 2009	
7	STIPULATION FOR AN EXTENSION OF TIME	Apr 29, 2010	
8	EXTENSION OF TIME GRANTED	Apr 30, 2010	
9	P'S MOTION FOR SUMMARY JUDGMENT	Nov 24, 2010	
10	SUSPENDED PENDING DISP OF OUTSTNDNG MOT	Dec 01, 2010	
11	BOARD'S DECISION: SUSTAINED	Jan 27, 2011	
12	TERMINATED	Jan 27, 2011	

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