

ESTTA Tracking number: **ESTTA735634**

Filing date: **03/24/2016**

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	PNY Technologies, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	100 Jefferson Road Parsippany, NJ 07054 UNITED STATES		

Attorney information	JONATHAN SHORT MCCARTER & ENGLISH LLP 100 MULBERRY STREET, FOUR GATEWAY CTR NEWARK, NJ 07102 UNITED STATES jshort@mccarter.com, kknoll@mccarter.com Phone:973-622-4444		
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Applicant Information

Application No	86729017	Publication date	02/23/2016
Opposition Filing Date	03/24/2016	Opposition Period Ends	03/24/2016
Applicant	BNY-WIRELESS INC 40-38 194th St. Apt 3B Flushing, NY 11358 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2014/04/05 First Use In Commerce: 2014/04/05
All goods and services in the class are opposed, namely: Carrying cases for cell phones; Cell phone battery chargers; Cell phone cases; Protective covers and cases for tablet computers

Grounds for Opposition

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

U.S. Registration No.	4681107	Application Date	05/22/2014
Registration Date	02/03/2015	Foreign Priority Date	NONE
Word Mark	PNY		

Design Mark	<h1>PNY</h1>
Description of Mark	NONE
Goods/Services	Class 006. First use: First Use: 2012/09/15 First Use In Commerce: 2012/09/28 Security products, namely, metal locks and metal locking devices in the nature of non-electric cables and clamps for computers and other electronic devices

U.S. Registration No.	4678254	Application Date	06/03/2014
Registration Date	01/27/2015	Foreign Priority Date	NONE

Word Mark	PNY
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Design Mark	<h1>PNY</h1>
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Description of Mark	NONE
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Goods/Services	Class 009. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 Computer hardware for transferring, storing and transporting electronic data between electronic storage devices; computer memory modules, namely, random access memory chips; computer hardware and peripheral devices, namely, printers, modems, scanners, all incorporating or utilizing memories; back up memory storage devices, namely, flash memory cards, flash memory drives, hard disk drives and solid state hard drives; upgrades for increasing the capability and productivity of personal computers and peripherals namely, memory boards graphics cards for personal computers and workstations; memory module upgrades in the nature of memory expansion modules for personal computers, notebook computers, tablet personal computers, mobile personal computers, handheld personal computers, workstations, servers, and other memory-driven devices; flash memory cards, flash memory multi-media cards, flash card readers, computer workstation graphic boards, computer memory for gaming applications, and computer graphic cards used to enhance the performance of computer games, personal and desktop computers and computer workstations; storage accelerator cards that utilize redundant array of inexpensive disks (RAID) technology for data storage on hard drives, which are used to increase system performance and optimize hard drive management; blank solid state floppy disc cards and flash card memory for digital cameras and personal
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	computers, namely, handheld, notebook, laptop, portable and desk top computers and personal digital assistants; computer hardware, namely, motherboards, computer mainboards, digital signal processing baseboards, circuit boards, computer graphics boards, computer system boards and, computer logic boards; blank computer backup and storage devices, namely, solid state memory drives, solid state memory disks, disk on module (DOM), disk on chip (DOC), and embedded flash memory card; battery chargers and rechargeable battery packs for computers and other electronic devices; power supply apparatus for computers and other electronic devices; earphones
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U.S. Registration No.	3531856	Application Date	06/28/2007
Registration Date	11/11/2008	Foreign Priority Date	NONE

Word Mark	PNY
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Description of Mark	NONE
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Goods/Services	<p>Class 009. First use: 2007/07/00 First Use In Commerce: 2007/07/00</p> <p>Computer hardware for transferring, storing and transporting electronic data between electronic storage devices; Computer memory modules, namely, random access memory chips; Computer hardware and peripheral devices, namely, printers, modems, scanners, all incorporating or utilizing memories; back up memory storage devices, namely, flash memory cards, flash memory drives, hard disk drives and solid state hard drives; upgrades for increasing the capability and productivity of personal computers and peripherals, namely, memory boards graphics cards for personal computers and workstations; memory module upgrades in the nature of memory expansion modules for personal computers, notebook computers, tablet personal computers, mobile personal computers, handheld personal computers, workstations, servers, and other memory-driven devices; flash memory cards, flash memory multi-media cards, flash card readers, computer workstation graphic boards, computer memory for gaming applications, and computer graphic cards used to enhance the performance of computer games, personal and desktop computers and computer workstations; storage accelerator cards that utilize redundant array of inexpensive disks (RAID) technology for data storage on hard drives, which are used to increase system performance and optimize hard drive management; blank solid state floppy disc cards and flash card memory for digital cameras and personal computers, namely, handheld, notebook, laptop, portable and desk top computers and personal digital assistants; Computer hardware, namely, motherboards, computer mainboards, digital signal processing baseboards, circuit boards, computer graphics boards, computer system boards and, computer logic boards; Blank computer backup and storage devices, namely, solid state memory drives, solid state memory disks, disk on module (DOM), disk on chip (DOC), and embedded flash memory card</p>
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Attachments	<p>86288778#TMSN.png(bytes)</p> <p>86298686#TMSN.png(bytes)</p>
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	77217696#TMSN.png(bytes) BNY WIRELESS Notice of Opposition.pdf(648572 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	/Jonathan Short/
Name	JONATHAN SHORT
Date	03/24/2016

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

In the matter of Application :
Serial No. 86/729,017 :
For the mark: :
BNY WIRELESS :
 :
 :
Published in the Official :
Gazette (Trademarks) on :
February 23, 2016 :
 :
PNY TECHNOLOGIES, INC., :
Opposer, :
 :
v. :
 :
BNY-WIRELESS INC, :
Applicant. :

OPPOSITION NO. _____

NOTICE OF OPPOSITION

1. PNY Technologies, Inc. (“Opposer”) is a corporation of the State of Delaware with its principal place of business at 100 Jefferson Road, Parsippany, New Jersey 07054.
2. Upon information and belief, the applicant BNY-Wireless Inc (“Applicant”) is a corporation organized and existing under the laws of the State of New York, having a place of business at 40-38 194th St. Apt 3B, Flushing, New York 11358.
3. Opposer believes that it will be damaged by the registration of Applicant’s application Serial No. 86/729,017 for the mark BNY WIRELESS as it relates to the following goods:

“Carrying cases for cell phones; Cell phone battery chargers; Cell phone cases; Protective covers and cases for tablet computers,” in Class 9,

(“Applicant’s Mark”), and hereby opposes the same.

4. Opposer is a corporation which has been engaged since at least as early as 1985 as a leading provider within the consumer electronics market for computer-related products and accessories, including but not limited to flash memory cards, USB flash drives, solid state drives, high speed cables, computer memory upgrade modules, consumer graphics cards, professional graphics cards, headphones and portable locking systems for computers and other electronic devices (collectively, “Opposer’s Goods”).

5. Since at least as early as 1988, Opposer adopted and has continuously used throughout the United States marks consisting of the term “PNY” (collectively, the “PNY Marks”) in connection with Opposer’s Goods. Opposer owns the following U.S. registrations for its PNY Marks:

MARK	REG. NO.	REG. DATE	GOODS	CLASS
PNY	4,681,107	February 3, 2015	Security products, namely, metal locks and metal locking devices in the nature of non-electric cables and clamps for computers and other electronic devices.	6

PNY	4,678,254	January 27, 2015	<p>Computer hardware for transferring, storing and transporting electronic data between electronic storage devices; computer memory modules, namely, random access memory chips; computer hardware and peripheral devices, namely, printers, modems, scanners, all incorporating or utilizing memories; back up memory storage devices, namely, flash memory cards, flash memory drives, hard disk drives and solid state hard drives; upgrades for increasing the capability and productivity of personal computers and peripherals namely, memory boards graphics cards for personal computers and workstations; memory module upgrades in the nature of memory expansion modules for personal computers, notebook computers, tablet personal computers, mobile personal computers, handheld personal computers, workstations, servers, and other memory-driven devices; flash memory cards, flash memory multi-media cards, flash card readers, computer workstation graphic boards, computer memory for gaming applications, and computer graphic cards used to enhance the performance of computer games, personal and desktop computers and computer workstations; storage accelerator cards that utilize redundant array of inexpensive disks (RAID) technology for data storage on hard drives, which are used to increase system performance and optimize hard drive management; blank solid state floppy disc cards and flash card memory for digital cameras and personal computers, namely, handheld, notebook, laptop, portable and desk top computers and personal digital assistants; computer hardware, namely, motherboards, computer mainboards, digital signal processing baseboards, circuit boards, computer graphics boards, computer system boards and, computer logic boards. blank computer backup and storage devices, namely, solid state memory drives, solid state memory disks, disk on module (DOM), disk on chip (DOC), and embedded flash memory card; battery chargers and rechargeable battery packs for computers and other electronic devices; power supply apparatus for computers and other electronic devices; earphones.</p>	9
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PNY (Stylized)	3,531,856	November 11, 2008 (now incontestable)	Computer hardware for transferring, storing and transporting electronic data between electronic storage devices; Computer memory modules, namely, random access memory chips; Computer hardware and peripheral devices, namely, printers, modems, scanners, all incorporating or utilizing memories; back up memory storage devices, namely, flash memory cards, flash memory drives, hard disk drives and solid state hard drives; upgrades for increasing the capability and productivity of personal computers and peripherals, namely, memory boards graphics cards for personal computers and workstations; memory module upgrades in the nature of memory expansion modules for personal computers, notebook computers, tablet personal computers, mobile personal computers, handheld personal computers, workstations, servers, and other memory-driven devices; flash memory cards, flash memory multi-media cards, flash card readers, computer workstation graphic boards, computer memory for gaming applications, and computer graphic cards used to enhance the performance of computer games, personal and desktop computers and computer workstations; storage accelerator cards that utilize redundant array of inexpensive disks (RAID) technology for data storage on hard drives, which are used to increase system performance and optimize hard drive management; blank solid state floppy disc cards and flash card memory for digital cameras and personal computers, namely, handheld, notebook, laptop, portable and desk top computers and personal digital assistants; Computer hardware, namely, motherboards, computer mainboards, digital signal processing baseboards, circuit boards, computer graphics boards, computer system boards and, computer logic boards. Blank computer backup and storage devices, namely, solid state memory drives, solid state memory disks, disk on module (DOM), disk on chip (DOC), and embedded flash memory card.	9
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Annexed as **Exhibit A** are copies of TESS printouts showing the status of the trademark registrations for Opposer's PNY Marks.

6. By reason of the long and extensive promotion, print and internet advertising, and provision of high-quality goods manufactured and distributed by Opposer in conjunction with the PNY Marks, the public and the trade have come to recognize goods offered in conjunction with these marks as signifying Opposer and Opposer's Goods.

7. Notwithstanding Opposer's long prior rights in the PNY Marks, Applicant filed an application, Serial No. 86/729,017, for registration of BNY WIRELESS for "Carrying cases for cell phones; Cell phone battery chargers; Cell phone cases; Protective covers and cases for tablet computers," in Class 9, with a disclaimer of the term "WIRELESS." Applicant's BNY WIRELESS application was published for opposition in the Official Gazette on February 23, 2016.

8. There is no issue as to priority. Applicant's filing date for its BNY WIRELESS application is August 18, 2015, which is long after the dates when Opposer first used and registered its PNY Marks.

9. The trademark that Applicant has proposed for registration, BNY WIRELESS, with a disclaimer of the term "WIRELESS," is nearly identical to Opposer's PNY Marks, and is used on or in connection with goods closely related to Opposer's goods and is likely to be confused therewith and mistaken therefor. Applicant's Mark is deceptively similar to Opposer's PNY Marks so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing Applicant's Mark.

10. If Applicant is permitted to use and register its BNY WIRELESS mark for its goods in Class 9 as specified in the application herein opposed, confusion in the trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity

between Applicant's BNY WIRELESS mark and Opposer's PNY Marks. Accordingly, consumers will associate Applicant's goods with Opposer's Goods, and think that such goods are provided or endorsed by, or otherwise affiliated with, Opposer.

11. If Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its BNY WIRELESS mark. Such registration would be a source of damage and injury to Opposer.

12. Through Opposer's extensive advertisement and promotion and substantial sales, Opposer's PNY Marks have become famous.

13. Upon information and belief, any use by Applicant of Applicant's BNY WIRELESS mark has occurred many years after Opposer's PNY Marks became famous.

14. Applicant's registration and/or use of its BNY WIRELESS mark is likely to blur or tarnish the positive associations among consumers and the trade of Opposer's PNY Marks.

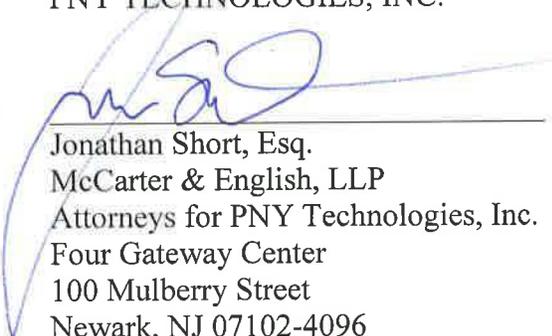
15. Thus, if Applicant is permitted to register and use its BNY WIRELESS mark, it is likely to cause dilution of the distinctive quality of Opposer's PNY Marks.

WHEREFORE, Opposer PNY Technologies, Inc. prays that this Opposition be sustained and that Application Serial No. 86/729,017 for the mark BNY WIRELESS be refused registration for the goods in International Class 9 therein specified and for such other relief as may be deemed just and proper.

Respectfully submitted,

PNY TECHNOLOGIES, INC.

By:



Jonathan Short, Esq.
McCarter & English, LLP
Attorneys for PNY Technologies, Inc.
Four Gateway Center
100 Mulberry Street
Newark, NJ 07102-4096
(973) 622-4444

Dated: March 24, 2016

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the original of the foregoing Notice Of Opposition has been served by first class mail on Applicant at the following address:

BNY-WIRELESS INC
40-38 194th St. Apt 3B
Flushing, New York 11358

Date: March 24, 2016



Kimberly A. Knoll

EXHIBIT A



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(Use the "Back" button of the Internet Browser to return to TESS)

PNY

Word Mark	PNY
Goods and Services	IC 006. US 002 012 013 014 023 025 050. G & S: Security products, namely, metal locks and metal locking devices in the nature of non-electric cables and clamps for computers and other electronic devices. FIRST USE: 20120915. FIRST USE IN COMMERCE: 20120928
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86288778
Filing Date	May 22, 2014
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	November 18, 2014
Registration Number	4681107
Registration Date	February 3, 2015
Owner	(REGISTRANT) PNY Technologies, Inc. CORPORATION DELAWARE 100 Jefferson Road Parsippany NEW JERSEY 07054
Attorney of	

Record Jonathan Short
Prior Registrations 3531856;3565814;3734606;AND OTHERS
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

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PNY

Word Mark
Goods and Services

PNY

IC 009. US 021 023 026 036 038. G & S: Computer hardware for transferring, storing and transporting electronic data between electronic storage devices; computer memory modules, namely, random access memory chips; computer hardware and peripheral devices, namely, printers, modems, scanners, all incorporating or utilizing memories; back up memory storage devices, namely, flash memory cards, flash memory drives, hard disk drives and solid state hard drives; upgrades for increasing the capability and productivity of personal computers and peripherals namely, memory boards graphics cards for personal computers and workstations; memory module upgrades in the nature of memory expansion modules for personal computers, notebook computers, tablet personal computers, mobile personal computers, handheld personal computers, workstations, servers, and other memory-driven devices; flash memory cards, flash memory multi-media cards, flash card readers, computer workstation graphic boards, computer memory for gaming applications, and computer graphic cards used to enhance the performance of computer games, personal and desktop computers and computer workstations; storage accelerator cards that utilize redundant array of inexpensive disks (RAID) technology for data storage on hard drives, which are used to increase system performance and optimize hard drive management; blank solid state floppy disc cards and flash card memory for digital cameras and personal computers, namely, handheld, notebook, laptop, portable and desk top computers and personal digital assistants; computer hardware, namely, motherboards, computer mainboards, digital signal processing baseboards, circuit boards, computer graphics boards, computer system boards and, computer logic boards. blank computer backup and storage devices, namely, solid state memory drives, solid state memory disks, disk on module (DOM), disk on chip (DOC), and embedded flash memory card; battery chargers and rechargeable battery packs for computers and other electronic devices; power supply apparatus for computers and other electronic devices; earphones. FIRST USE: 19880000. FIRST USE IN COMMERCE: 19880000

Standard

Characters

Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 86298686

Filing Date June 3, 2014

Current Basis 1A

Original Filing Basis 1A

Published for Opposition November 11, 2014

Registration Number 4678254

Registration Date January 27, 2015

Owner (REGISTRANT) PNY Technologies, Inc. CORPORATION DELAWARE 100 Jefferson Road Parsippany NEW JERSEY 07054

Attorney of Record Jonathan Short

Prior Registrations 3531856;3565814;3734606;AND OTHERS

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Word Mark
Goods and
Services

PNY

IC 009. US 021 023 026 036 038. G & S: Computer hardware for transferring, storing and transporting electronic data between electronic storage devices; Computer memory modules, namely, random access memory chips; Computer hardware and peripheral devices, namely, printers, modems, scanners, all incorporating or utilizing memories; back up memory storage devices, namely, flash memory cards, flash memory drives, hard disk drives and solid state hard drives; upgrades for increasing the capability and productivity of personal computers and peripherals, namely, memory boards graphics cards for personal computers and workstations; memory module upgrades in the nature of memory expansion modules for personal computers, notebook computers, tablet personal computers, mobile personal computers, handheld personal computers, workstations, servers, and other memory-driven devices; flash memory cards, flash memory multi-media cards, flash card readers, computer workstation graphic boards, computer memory for gaming applications, and computer graphic cards used to enhance the performance of computer games, personal and desktop computers and computer workstations; storage accelerator cards that utilize redundant array of inexpensive disks (RAID) technology for data storage on hard drives, which are used to increase system performance and optimize hard drive management; blank solid state floppy disc cards and flash card memory for digital cameras and personal computers, namely, handheld, notebook, laptop, portable and desk top computers and personal digital assistants; Computer hardware, namely, motherboards, computer mainboards, digital signal processing baseboards, circuit boards, computer graphics boards, computer system boards and, computer logic boards. Blank computer backup and storage devices, namely, solid state memory drives, solid state memory disks, disk on module (DOM), disk on chip (DOC), and embedded flash memory card. FIRST USE: 20070700. FIRST USE IN COMMERCE: 20070700

Mark Drawing
Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Trademark Search Facility Classification Code LETTER-3-OR-MORE PNY Combination of three or more letters as part of the mark

Serial Number 77217696

Filing Date June 28, 2007

Current Basis 1A

Original Filing Basis 1B

Published for Opposition January 15, 2008

Registration Number 3531856

Registration Date November 11, 2008

Owner (REGISTRANT) PNY Technologies, Inc. CORPORATION DELAWARE 100 Jefferson Rd Parsippany NEW JERSEY 07054

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Jonathan Short

Prior Registrations 2428341;2899726;2904761;AND OTHERS

Description of Mark Color is not claimed as a feature of the mark.

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead Indicator LIVE

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