

ESTTA Tracking number: **ESTTA753493**

Filing date: **06/20/2016**

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	The Boeing Company
Granted to Date of previous extension	06/19/2016
Address	7755 E. Marginal Way S. Seattle, WA 98108 UNITED STATES
Attorney information	James L. Vana and Winfield B. Martin Perkins Coie LLP 1201 Third Avenue Suite 4900 Seattle, WA 98101 UNITED STATES pctrademarks@perkinscoie.com

Applicant Information

Application No	79163070	Publication date	12/22/2015
Opposition Filing Date	06/20/2016	Opposition Period Ends	06/19/2016
International Registration No.	1241988	International Registration Date	09/30/2014
Applicant	DJI GmbH Im Birkenfeld 2 GERMANY		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Data processing apparatus; electric navigational instruments; radar detectors; remote control telemetering machines and apparatus; printed circuits; electric installations for the remote control of industrial operations; all the aforementioned goods are not for use for automobiles</p>
<p>Class 012. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Amphibious vehicles; air bags as safety-devices for automobiles; parachutes; aerial conveyors; aircraft; airplanes; screw propellers for vehicles</p>
<p>Class 028. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Amusement game machines, except for games in relation to toy cars; scale model airplanes, namely, multi-rotor scale model aircraft; scale model kits as toys, except for scale model automobiles; mechanical toys, except for toy cars and scale model automobiles; body-building apparatus; exercise machines; Christmas tree ornaments, except confectionery and electric Christmas tree lights</p>

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2635413	Application Date	08/20/2001
Registration Date	10/15/2002	Foreign Priority Date	NONE
Word Mark	PHANTOM WORKS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2001/06/01 First Use In Commerce: 2001/06/01 advanced research and development services in the fields of commercial, military, space and communications products and services		

U.S. Registration No.	2466357	Application Date	04/09/1999
Registration Date	07/03/2001	Foreign Priority Date	NONE
Word Mark	F-4 PHANTOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1999/09/00 First Use In Commerce: 1999/09/00 Toy and model airplanes		

Attachments	78080084#TMSN.png(bytes) 75679901#TMSN.png(bytes) DJI PHANTOM Notice of Opposition.pdf(292777 bytes)
-------------	---

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	/Winfield B. Martin/
Name	James L. Vana and Winfield B. Martin
Date	06/20/2016

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

THE BOEING COMPANY,

Opposer,

v.

DJI GMBH,

Applicant.

Opposition No.:

NOTICE OF OPPOSITION

Mark:

 | PHANTOM

Application No.: 79163070.

The Boeing Company (“Opposer”) believes that it will be damaged by the registration by DJI GmbH (“Applicant”) of the mark DJI PHANTOM & Design (the “Mark”) in International Classes 9, 12 and 28, and covering those goods (“Applicant’s Goods”) listed in Application No. 79163070 (the “Application”), and hereby opposes the Application. As grounds for opposition, Opposer alleges as follows:

I. PARTIES

1. Opposer is a Delaware corporation, having a place of business in Chicago, Illinois.
2. On information and belief, Applicant is a German entity, having a place of business in Schondra-Schildeck, Germany.

II. OPPOSER’S MARKS

3. Opposer is one of the world’s leading aerospace and defense manufacturers.
4. As part of its aerospace and defense offerings, Opposer’s services include research and development across a number of industries, including commercial aviation, military, defense and security, space and communications.

5. Since at least as early as 2001, Opposer has used and established rights in the mark PHANTOM WORKS (the “PHANTOM WORKS Mark”) in connection with these research and development services (the “PHANTOM WORKS Services”).

6. Between 1958 and 1981, Opposer and its predecessor in interest manufactured the McDonnell Douglas F-4 Phantom II fighter aircraft, which set multiple flight records and was used by air forces throughout the world. In total over 5,000 F-4 aircraft were built, with some remaining in operation until June 2013.

7. As a means of promoting its world-renowned F-4 Phantom aircraft, Opposer has used and established rights in the mark F-4 PHANTOM (the “F-4 PHANTOM Mark”) in connection with toy and model airplanes (the “F-4 PHANTOM Goods”).

8. Opposer owns the following incontestable federal registrations for the PHANTOM WORKS Mark and the F-4 PHANTOM Mark (the “Registrations”):

REGISTRATION #	MARK	REGISTRATION DATE	FIRST USE DATE	DESCRIPTION COMBINED
2635413	PHANTOM WORKS	10/15/2002	06/01/2001	Class 42: Advanced research and development services in the fields of commercial, military, space and communications products and services
2466357	F-4 PHANTOM	07/03/2001	09/30/1999	Class 28: Toy and model airplanes

9. Soft copies of Opposer’s Registrations, in the form of excerpts from the Trademark Office’s on-line records showing status of and title for the Registrations, are attached as **Exhibit A**.

III. THE APPLIED FOR MARK AND APPLICATION

10. Applicant filed the Application on September 30, 2014 (the “Application Date”), based on an International Registration issued on September 30, 2014 and containing a priority claim of April 2, 2014 (the “Priority Date”).

11. The Application covers data processing apparatus, electric navigational instruments, radar detectors, remote control telemetering machines and apparatus, printed circuits, and electric installations for the remote control of industrial operations, all of the aforementioned goods are not for use in automobiles, in Class 9; amphibious vehicles, air bags as safety devices for automobiles, parachutes, aerial conveyors, aircraft, airplanes, and screw propellers for vehicles in Class 12; and amusement game machines, except for games in relation to toy cars, scale model airplanes, namely, multi-rotor scale model aircraft, scale model kits as toys, except for scale model automobiles, mechanical toys, except for toy cars and scale model automobiles, body-building apparatus, exercise machines, and Christmas tree ornaments, except confectionary and electric Christmas tree lights, in Class 28.

12. On information and belief, Applicant has not made any use of the Mark in the United States earlier than the Priority Date or taken any other action that would entitle Applicant to rights in the Mark earlier than the Priority Date.

IV. CLAIMS

A. LIKELIHOOD OF CONFUSION

13. The PHANTOM WORKS Mark is distinctive for the PHANTOM WORKS Services.

14. The F-4 PHANTOM mark is distinctive for the F-4 PHANTOM Goods.

15. Opposer’s use and promotion of the PHANTOM WORKS Mark and the F-4 PHANTOM Mark (together, “Opposer’s Marks”) with the PHANTOM WORKS Services and

the F-4 PHANTOM Goods (together, “Opposer’s Goods and Services”) has led to the establishment of substantial goodwill and consumer recognition in Opposer’s Marks.

16. Opposer’s first uses of Opposer’s Marks in connection with Opposer’s Goods and Services are both well prior to the Priority Date.

17. Applicant’s Mark incorporates the distinctive term “PHANTOM” in connection with Applicant’s house brand, leaving “PHANTOM” as the dominant distinctive term. Applicant’s Mark is thus highly similar to Opposer’s Marks, both of which include “PHANTOM” as the dominant distinctive element.

18. Applicant and Opposer offer related and, in part, identical goods and services. Both the Application and Opposer’s registration for the F-4 PHANTOM Mark cover model airplanes. Moreover, Opposer’s registration for the PHANTOM WORKS Mark covers services used to develop the types of vehicles and equipment covered in the Application.

19. In view of the highly similar nature of the parties’ marks and the related nature of the goods and services of the parties, Applicant’s Mark so closely resembles Opposer’s Marks as to be likely to cause confusion, or to cause mistake, or to deceive as to the origin, sponsorship and approval of Applicant’s Goods, and is likely to suggest an affiliation, connection or association of Applicant and Applicant’s Goods with Opposer and Opposer’s Goods and Services, with consequent injury to Opposer, the trade and the public.

20. Registration of Applicant’s Mark would prevent Opposer from exercising exclusive control over the goodwill and reputation associated with Opposer’s Marks. Therefore, the registration of Applicant’s Mark would damage and injure Opposer.

21. Opposer will also be damaged by the registration of Applicant’s Mark because such registration will support statutory rights for Applicant in violation and derogation of Opposer’s prior, super and exclusive rights in Opposer’s Marks.

V. REQUEST FOR RELIEF

WHEREFORE, Opposer believes that it will be damaged by the registration of the Mark as reflected in the Application and requests that the Application be refused.

VI. FEES

The \$300.00 fee for this Notice of Opposition is being electronically submitted with this filing.

Opposer hereby appoints the law firm of Perkins Coie LLP, and each of James L. Vana, Winfield B. Martin, Lydia Z. Ansari, Stefan B. Blum, Alexander J.A. Garcia, Mark S. Goodrich, Lynne E. Graybeal, Patchen M. Haggerty, John P. Halski, Jason S. Howell, Jennifer L. Jolley, Elizabeth A. Kristoferson, Alexander M. Montgomery, Lisa T. Oratz, Seth H. Reagan, Heidi L. Sachs, Grace Han Stanton, and Robert G. Woolston, each of whom is admitted to practice law in the State of Washington and/or another state of the United States, with full power of substitution and revocation, to represent Opposer in connection with this proceeding.

DATED: June 20, 2016

Respectfully submitted,

PERKINS COIE LLP

By: 

James L. Vana

Winfield B. Martin

Attorneys for Opposer

1201 Third Avenue, 49th Floor

Seattle, Washington 98101

Phone: (206) 359-8000

Exhibit A

TSDR

ASSIGN Status

TTAB Status

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

PHANTOM WORKS

Word Mark PHANTOM WORKS

Goods and Services IC 042. US 100 101. G & S: advanced research and development services in the fields of commercial, military, space and communications products and services. FIRST USE: 20010601. FIRST USE IN COMMERCE: 20010601

Mark Drawing Code (1) TYPED DRAWING

Serial Number 78080084

Filing Date August 20, 2001

Current Basis 1A

Original Filing Basis 1A

Published for Opposition July 23, 2002

Registration Number 2635413

Registration Date October 15, 2002

Owner (REGISTRANT) BOEING MANAGEMENT COMPANY CORPORATION DELAWARE M/S 110-SB70 2201 SEAL BEACH BOULEVARD SEAL BEACH CALIFORNIA 907401515

(LAST LISTED OWNER) THE BOEING COMPANY CORPORATION DELAWARE 2201 SEAL BEACH BOULEVARD SEAL BEACH CALIFORNIA 907401515

Assignment Recorded ASSIGNMENT RECORDED

Attorney of Record Heidi L. Sachs

Type of Mark SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20120430.

Renewal 1ST RENEWAL 20120430

Live/Dead Indicator LIVE

TSDR**ASSIGN Status****TTAB Status**

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

F-4 PHANTOM

Word Mark	F-4 PHANTOM
Goods and Services	IC 028. US 022 023 038 050. G & S: Toy and model airplanes. FIRST USE: 19990900. FIRST USE IN COMMERCE: 19990900
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75679901
Filing Date	April 9, 1999
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	November 23, 1999
Registration Number	2466357
Registration Date	July 3, 2001
Owner	(REGISTRANT) BOEING MANAGEMENT COMPANY CORPORATION DELAWARE 2201 SEAL BEACH BLVD., M/S 110 SB-70 SEAL BEACH CALIFORNIA 907401515 (LAST LISTED OWNER) THE BOEING COMPANY CORPORATION DELAWARE 2201 SEAL BEACH BOULEVARD SEAL BEACH CALIFORNIA 907401515
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Heidi L. Sachs
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 8 (6-YR). SECTION 8(10-YR) 20101108.
Renewal	1ST RENEWAL 20101108
Live/Dead Indicator	LIVE