

ESTTA Tracking number: **ESTTA20374**

Filing date: **12/01/2004**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Fram Trak Industries, Inc.		
Entity	Corporation	Citizenship	New Jersey
Address	205 Hallock Avenue Middlesex, NJ 08846 UNITED STATES		

Attorney information	Todd A. Denys Mathews, Collins, Shepherd & McKay, P.A. 100 Thanet Circle Suite 306 Princeton, NJ 08540 UNITED STATES tdenys@mathewslaw.com Phone:609-924-8555		
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Registration Subject to Cancellation

Registration No	2883311	Registration date	09/07/2004
Registrant	WireTracks LLC 10703 Durland Ave NE Seattle, WA 98125 UNITED STATES		
Goods/Services Subject to Cancellation	Class 009. First Use: 20030303, First Use In Commerce: 20030303 Goods/Services: Plastic conduit for use in electrical installations and electrical use		

Attachments	Petition to Cancel.pdf (4 pages) Exhibit A to Petition to Cancel - 09 08 04 WIRE TRAK & DESIGN office action.pdf (3 pages)
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Signature	/todd a denys/
Name	Todd A. Denys
Date	12/01/2004

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

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FRAM TRAK INDUSTRIES, INC.,	:	
	:	
Petitioner,	:	Cancellation No.:
	:	
vs.	:	
	:	
WIRETRACKS LLC,	:	
	:	
Respondent.	:	
	:	
----- X		

PETITION FOR CANCELLATION

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202

Commissioner:

In the matter of the registration of the mark “WIRETRACKS” by WireTracks LLC for “plastic conduit for use in electrical installations and electrical use” in International Class 9, United States Trademark Registration Number 2,883,311 granted September 7, 2004.

Fram Trak Industries, Inc., a corporation of the State of New Jersey, having a place of business at 205 Hallock Avenue, Middlesex, New Jersey, believes that it is damaged by the registration and hereby petitions for Cancellation thereof on the following grounds:

1. Petitioner has used the marks "WIRE TRAK" and "WIRE TRAK & DESIGN" for conduits, covers and guides for electrical, telephone, and signal wires and for coaxial and fiber optic cables since at least as early as July 3, 2002, and has used those marks on the named goods in interstate commerce since at least as early as July 3, 2002, and continues to use those marks on the named goods and is the owner of said marks for the named goods.

2. Petitioner has so used the marks "WIRE TRAK" and "WIRE TRAK & DESIGN" on its goods that the public has come to associate said marks with Petitioner and as indicating that any conduits, covers and guides for electrical, telephone, and signal wires and for coaxial and fiber optic cables sold under said marks originate with Petitioner. As a result, Petitioner has created and is the owner of substantial goodwill in the marks "WIRE TRAK" and "WIRE TRAK & DESIGN."

3. Petitioner filed United States Trademark Application Serial Number 78/289,780 for its mark "WIRE TRAK & DESIGN" in the United States Patent and Trademark Office on August 20, 2003.

4. By Official Action mailed September 8, 2004, Petitioner's Trademark Application Serial Number 78/289,780 to register the mark "WIRE TRAK & DESIGN" was refused registration based on Section 2(d) of the Lanham Act, in view of United States Trademark Registration Number 2,883,311, the registration herein sought to be Cancelled. A copy of said Official Action is attached to this Petition as Exhibit A.

5. Upon information and belief, WireTracks LLC claimed date of first use of its alleged “WIRETRACKS” mark is March 3, 2003, a date later than Petitioner’s date of first use of its “WIRE TRAK” and “WIRE TRAK & DESIGN” marks.

6. The goods sold by Petitioner and Respondent under their respective marks are identical or closely related. Moreover, Petitioner’s goods and those sold by Respondent travel in the same channels of trade, and could be offered for sale by the same retail outlets and purchased by the same end users.

7. Respondent’s “WIRETRACKS” mark so resembles Petitioner’s “WIRE TRAK” and “WIRE TRAK & DESIGN” marks previously used by Petitioner on Petitioner’s goods as to cause confusion or to cause mistake or to deceive as to the source of origin or sponsorship of the parties’ goods.

8. The continued registration by Respondent of its mark enables Respondent to utilize and trade on the goodwill established by Petitioner in its “WIRE TRAK” and “WIRE TRAK & DESIGN” marks, and the continued registration of Respondent’s mark injures Petitioner in the use of its marks.

9. Because Petitioner has used the marks “WIRE TRAK” and “WIRE TRAK & DESIGN” from a date earlier than Respondent has used the mark “WIRETRACKS,” it is Petitioner that is entitled to registration rather than Respondent.

WHEREFORE, Petitioner prays that United States Trademark Registration Number 2,883,311 granted September 7, 2004 to WireTracks LLC be cancelled and be stricken from the Principal Register of the United States Patent and Trademark Office in accordance with Section 14 of the Trademark Act (15 U.S.C. §1064).

Respectfully Submitted,

FRAM TRAK INDUSTRIES, INC.

BY: 
Todd A. Denys

MATHEWS, COLLINS, SHEPHERD & MCKAY, P.A.
100 Thanet Circle, Suite 306
Princeton, New Jersey 08540-3674
(609) 924-8555

Attorneys for Petitioner

Dated: 12/1/04

/tad

CERTIFICATE OF FILING

I hereby certify that this Petition For Cancellation is being filed with the United States Patent and Trademark Office via the Trademark Trial and Appeal Board's Electronic System for Trademark Trials and Appeals [ESTTA] on-line filing process.

12/1/04
(Date of Deposit)


(Signature)

12/1/04
(Date of Signature)

Goldsmith, Susan O.

From: ECom114 [ecom114@USPTO.GOV]
Sent: Wednesday, September 08, 2004 7:48 AM
To: Goldsmith, Susan O.
Subject: TRADEMARK APPLICATION NO. 78289780 - WIRE TRAK - N0672-00017

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/289780

APPLICANT: Fram Trak Industries, Inc.

78289780

CORRESPONDENT ADDRESS:

Susan Okin Goldsmith, Esq.
Duane Morris LLP
Suite 100
100 College Road West
Princeton, NJ 08540

RETURN ADDRESS:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3514

MARK: WIRE TRAK

CORRESPONDENT'S REFERENCE/DOCKET NO: N0672-00017

Please provide in all correspondence:

CORRESPONDENT EMAIL ADDRESS:

sogoldsmith@duanemorris.com

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

TO AVOID ABANDONMENT, WE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF OUR MAILING OR E-MAILING DATE.

Serial Number 78/289780

This letter responds to the applicant's communication filed on 8/31/2004.

Applicant's AAU has been reviewed and accepted.

Previously-referenced conflicting application SN 78/255230 has matured into a registration. Accordingly, the examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d), because the applicant's mark, when used on or in connection with the identified goods/services, so resembles the mark in U.S. Registration No. 2,883,311 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP §§1207.01 *et seq.* See the enclosed registration.

EXHIBIT A

9/8/2004

The Court in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), listed the principal factors to be considered in determining whether there is a likelihood of confusion under Section 2(d). Any one of the factors listed may be dominant in any given case, depending upon the evidence of record. In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods/services, and similarity of trade channels of the goods/services. TMEP §§1207.01 *et seq.* The marks and the goods involved here are essentially identical.

Please note that the Section 2(d) refusal as to RN 2,191,641 is maintained for the reasons noted previously.

Applicant's response is otherwise accepted as filed.

Further action awaits response to the above.

NOTICE: TRADEMARK OPERATION RELOCATING OCTOBER AND NOVEMBER 2004

The Trademark Operation is relocating to Alexandria, Virginia, in October and November 2004. Effective October 4, 2004, all Trademark-related paper mail (except documents sent to the Assignment Services Division for recordation, certain documents filed under the Madrid Protocol, and requests for copies of trademark documents) must be sent to:

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Applicants, registration owners, attorneys and other Trademark customers are strongly encouraged to correspond with the USPTO online via the Trademark Electronic Application System (TEAS), at www.uspto.gov.

To reach the undersigned attorney by telephone after October 20, 2004, please call (571) 272 - 9229. Thank you.

/David H. Stine/
Trademark Attorney
Law Office 114
(703)308-9114x154

How to respond to this Office Action:

To respond formally using the Office's Trademark Electronic Application System (TEAS), visit <http://www.uspto.gov/teas/index.html> and follow the instructions.

To respond formally via regular mail, your response should be sent to the mailing Return Address listed above and include the serial number, law office and examining attorney's name on the upper right corner of each page

EXHIBIT A

9/8/2004

of your response.

To check the status of your application at any time, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov/>

For general and other useful information about trademarks, you are encouraged to visit the Office's web site at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY.