

ESTTA Tracking number: **ESTTA528577**

Filing date: **03/25/2013**

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	TomTom International B.V.		
Entity	Corporation	Citizenship	Netherlands
Address	Rembrandtplein 35 Amsterdam, NL-1017 CT NETHERLANDS		

Attorney information	Alan S. Cooper Wiley Rein LLP 1776 K Street, NW Washington, DC 20006 UNITED STATES acooper@wileyrein.com Phone:202-719-7000
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Registration Subject to Cancellation

Registration No	3411788	Registration date	04/15/2008
International Registration No.	NONE	International Registration Date	NONE
Registrant	Thomas Snieders Junkersstraße 3 82178 Puchheim, GERMANY		

Goods/Services Subject to Cancellation

Class 003. All goods and services in the class are cancelled, namely: Perfumery, essential oils, cosmetics, hair lotions; dentifrices; soaps

Grounds for Cancellation

Abandonment	Trademark Act section 14
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Petitioner as Basis for Cancellation

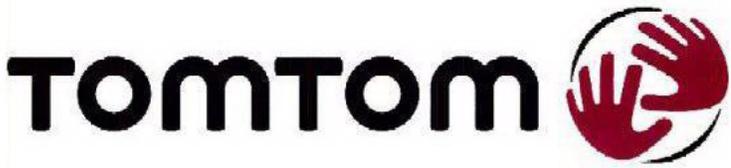
U.S. Registration No.	3409331	Application Date	05/04/2006
Registration Date	04/08/2008	Foreign Priority Date	04/06/2006
Word Mark	TOMTOM		

Design Mark	<h1 style="text-align: center; margin: 0;">TOMTOM</h1>
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: Computer hardware; computer software for use with satellite and for use with satellite and/or GPS navigation systems for navigation, route and trip planning, and electronic mapping; computer software for travel information systems for the provision or rendering of travel advice and/or information concerning service stations, car parks, multi-storey car parks, restaurants, car dealers and other information regarding travel and transport; hardware and software for information management for the transport and traffic industries; computer software to be used for viewing and downloading electronic maps; software for operating route planners; route planners in the nature of hand-held personal computers; software for operating digital dictionaries; electronic digital dictionaries; location, orientation, and navigation sensors, transmitters, actuators, cameras and global positioning systems, namely, GPS comprising computers, computer software, transmitters, GPS and satellite receivers, network interface devices, connecting cables, and parts and fittings thereof; holders for pocket personal computers, namely, protective carrying cases specially adapted for personal digital assistants (PDA); satellite and radio transmission processors and receivers; telecommunication installations, networks and apparatus, namely, mounting racks for telecommunications hardware, telecommunications switches; computer terminals to be used with navigation systems, route planners and digital maps; blank magnetic data carriers and blank recording discs; audio and video apparatus, namely, audio and video receivers and processors; hand-held personal computers; personal digital assistants; electric and electronic instruments for providing information regarding maps, navigation, traffic, weather and interesting locations; alarm apparatus and instruments to be used for tracking and tracing vehicles, namely, vehicle locating and tracking systems comprised of computers, computer software, transceivers, transponders, global positioning satellite receivers and antennas</p> <p>Class 038. First use: Secured or not secured telecommunication services, namely, transmission and delivery of digital data, light files, sound files, data, information and image signals, by means of computer, cable, radio and satellite networks, all in particular for navigation systems, route planners and the use of electronic maps; wireless transmission of data by means of videotext, the Internet, GSM and WAP; wireless transmission of digital data; communication by way of computer terminals; telecommunication services for the communication with means of transport, namely, transmission of digital data, light files, sound files, data, information and image signals, by means of wireless and satellite networks; rental of telecommunication equipment; technical telecommunications consultation concerning all services mentioned above</p> <p>Class 039. First use: Navigational services, namely, providing navigational information for use in piloting land vehicles, providing global positioning and navigation information via mobile telephone, wireless and satellite networks; information services regarding traffic and traffic congestion; provision of information regarding travel; provision of information to travellers regarding fares, time tables and means of public transport; services of a travel agency, namely booking of rental cars, boats and other vehicles; all of the aforesaid services also provided via a communications network or a mobile telephone or a wireless navigation device</p>

	<p>Class 041. First use: Education services, namely, providing classes and seminars regarding the use of navigation systems; training services in the field of navigation systems; entertainment, namely, the production of radio programs and television programs; organizing community cultural activities and sporting activities</p> <p>Class 042. First use: Development and design of navigation systems, route planners, electronic maps and digital dictionaries for others; computer software and hardware design; development and design of software for use with navigation systems, route planners, electronic maps and digital dictionaries; development and design of telecommunication and data communication networks; providing temporary use of non-downloadable software for tracking and tracing goods and vehicles via computer networks, intranets and the internet</p> <p>Class 045. First use: Security services for the protection of property and individuals, namely, the tracking and tracing of goods and individuals in the context of security</p>
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U.S. Registration No.	3606082	Application Date	03/28/2003
Registration Date	04/14/2009	Foreign Priority Date	02/14/2003
Word Mark	TOMTOM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: Computer hardware and software for use with navigation systems, route planners and the use of electronic maps and digital dictionaries; software for use with satellite and GPS navigation systems; software for travel information systems for the provision and rendering of travel advice and information concerning service stations, car parks, restaurants, car dealers and other travel and transport related information; software for information management for the transport and traffic industries; software to be used for viewing electronic maps; downloadable electronic maps; software for operating route planners; route planners in the nature of hand-held personal computers; software for operating electronic digital dictionaries; electronic digital dictionaries; location, orientation, and navigation sensors, transmitters, actuators, cameras and global positioning systems, namely, GPS consisting of computers, computer software, transmitters, GPS and satellite receivers, network interface devices, connection cables and parts and fittings thereof, holders for pocket personal computers; satellite and radio transmission processors and receivers; telecommunications installations, networks and apparatus, namely, mounting racks for telecommunications hardware, telecommunications switches; computer terminals, all in particular to be used with navigation systems, route planners and digital maps; blank magnetic and disc shaped data carriers; audio and video apparatus, namely, audio and video receivers and processors; hand personal computers; personal digital assistants</p> <p>Class 038. First use: Secured or unsecured telecommunications services, namely, transmission and delivery of digital data, light files, sound files, data, information and image signals by means of computer, cable, radio and satellite transmissions, all in particular for navigation systems, route planners, and the use of electronic maps; wireless transmission of data by means of video text, the internet, GSM and WAP; wireless transmission of digital data; electronic transmission of data and documents via computer terminals; rental of telecommunications</p>		

	<p>equipment; technical consultation in connection with all of the above</p> <p>Class 039. First use: Secured and unsecured telecommunications services, namely, electronic storage of digital data, light files, sound files, data, information and image signals all in particular for navigation systems, route planners and the use of electronic maps</p> <p>Class 042. First use: Consultation in the field of computer software design; providing temporary use of non-downloadable software which provides geographical, map image, and trip routing data obtained with the aid of a global positioning system, GPS, in order to enable third parties to come to an accurate location or orientation; development and design of navigation systems, route planners, electronic maps and digital dictionaries; computer software and hardware design; development and design of software for use with navigation systems, route planners and the use of electronic maps and digital dictionaries; development and design of telecommunications and data communication services and networks</p>
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U.S. Registration No.	3951073	Application Date	02/28/2007
Registration Date	04/26/2011	Foreign Priority Date	NONE
Word Mark	TOMTOM		
Design Mark			
Description of Mark	The mark consists of the wording "TOMTOM" in black followed by the image of a pair of red hands surrounding a globe outlined in black.		
Goods/Services	<p>Class 009. First use: First Use: 2007/06/30 First Use In Commerce: 2007/06/30 Computer hardware and software to be used with satellite and/or GPS navigation systems for navigation purposes; computer software to be used with route planners, electronic maps, and digital dictionaries for navigation and translation purposes; software for travel information systems for the provision or rendering of travel advice and/or information concerning service stations, car parks, restaurants, car dealers and other travel and transport related information; software for information management for the transport and traffic industries; software to be used for viewing electronic maps; downloadable electronic maps; software for operating route planners; route planners in the nature of handheld personal computers; software for operating electronic digital dictionaries; electronic dictionaries; location, orientation and navigation, and global positioning systems (GPS) consisting of computers, computer software, transmitters, GPS and/or satellite receivers, network interface devices, connection cables, and parts and fittings thereof; satellite and radio transmission apparatus technology, namely, processors, mobile telephones and receivers; telecommunications installations, networks and apparatus, namely, mounting racks for telecommunications hardware, telecommunication switches; computer terminals, all in particular to be used with navigation systems, route planners and/or digital maps; audio and video apparatus namely, audio and video receivers and processors; handheld personal computers; personal digital assistants</p> <p>Class 038. First use: First Use: 2007/06/30 First Use In Commerce: 2007/06/30 Secured or unsecured telecommunication services, namely, transmission and delivery of digital data, light files, sound files, data, information and image signals by means of computer, cable radio and satellite, transmissions, all in</p>		

	<p>particular for navigation systems, route planners, and the use of electronic maps; wireless transmission of data, by means of videotext, the Internet, GSM and WAP; wireless transmission of digital data; electronic transmission of data and documents via computer terminals</p> <p>Class 039. First use: First Use: 2007/06/30 First Use In Commerce: 2007/06/30 Secured or unsecured telecommunication services, namely, electronic storage of digital data, light files, sound files, data, information and image signals, all in particular for navigation systems, route planners and the use of electronic maps; providing navigation and information services, namely, information regarding traffic and traffic congestion; provision of information regarding travel; provision of information to travellers regarding fares, time tables and means of public transport; all of the aforesaid services also provided via a communications network or a mobile telephone or a wireless navigation device</p> <p>Class 042. First use: First Use: 2007/06/30 First Use In Commerce: 2007/06/30 Consultation in the field of computer software design; providing temporary use of non-downloadable software which provides geographical, map image and trip routing data obtained with the aid of a Global Positioning System (GPS) in order to enable third parties to come to an accurate location or orientation; development and design of navigation systems, route planners, electronic maps and digital dictionaries; computer software and hardware design; development and design of software for use with navigation systems, route planners and the use of electronic maps and digital dictionaries; development and design of telecommunication and data communication services and networks</p>
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Attachments	<p>79031570#TMSN.jpeg (1 page)(bytes) 77118649#TMSN.jpeg (1 page)(bytes) Petition for Cancellation.pdf (11 pages)(219389 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	/Alan S. Cooper/
Name	Alan S. Cooper
Date	03/25/2013

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

In the Matter of Registration No. 3,411,788
of the Mark TOMTOM issued April 15, 2008

TOMTOM INTERNATIONAL B.V.)	
)	
Petitioner)	
)	
v.)	Cancellation No. _____
)	
THOMAS SNIEDERS)	
)	
Registrant)	

PETITION FOR CANCELLATION

TomTom International B.V., a limited liability company organized under the laws of the Netherlands having its principal offices at Rembrandtplein 35, NL-1017 CT Amsterdam, The Netherlands, believes that it is being damaged by Registration No. 3,411,788 of the mark TOMTOM and hereby petitions for cancellation of said registration pursuant to § 14 of the Federal Trademark Act, as amended, and Rule 2.11 of the Trademark Rules of Practice.

The grounds for the cancellation are as follows:

- (1) On information and belief, Registration No. 3,411,788 of the trademark

TOMTOM, for perfumery, essential oils, cosmetics, hair lotions, dentifrices and soaps, issued April 15, 2008, to Thomas Snieders, a resident of Puchheim in the Federal Republic of Germany (“Registrant”).

(2) Well prior to the issuance of Registration No. 3,411,788 and the claimed priority date for that registration, TomTom International B.V. (“Petitioner”) adopted, continuously used, and is still using the identical mark TOMTOM, alone and in combination with other words and/or designs, in interstate and foreign commerce for an extensive line of GPS systems, portable navigation devices, and related goods, including hardware and software, and services.

(3) Petitioner is the owner of the mark TOMTOM and is the world’s leading supplier of in-car location and navigation products and services focused on providing all drivers with the world’s best navigation experience.

(4) By virtue of the prior, continuous and substantial advertising and sales of GPS systems, navigation tools and related goods and services under the mark TOMTOM, and Petitioner’s maintenance of premium quality standards relating thereto, purchasers of such goods and services as well as the general public have come to recognize the mark TOMTOM as a highly distinctive, singular indication of origin in Petitioner, as a consequence of which Petitioner has established valuable goodwill and broad exclusive rights in the mark TOMTOM.

(5) The mark TOMTOM had become an exceedingly well-known mark having

a particular and singular meaning among the general consuming public and thus had become a famous mark within the meaning of § 43(c)(2)(A) of the Federal Trademark Act, as amended, well prior to the filing date of the application that matured into Registration No. 3,411,788 and the priority date for that registration.

(6) Petitioner duly registered the mark TOMTOM for the following goods and services in the United States Patent and Trademark Office under Registration No. 3,409,331 which issued April 8, 2008:

IC 009. US 021 023 026 036 038. G & S: Computer hardware; computer software for use with satellite and for use with satellite and/or GPS navigation systems for navigation, route and trip planning, and electronic mapping; computer software for travel information systems for the provision or rendering of travel advice and/or information concerning service stations, car parks, multi-storey car parks, restaurants, car dealers and other information regarding travel and transport; hardware and software for information management for the transport and traffic industries; computer software to be used for viewing and downloading electronic maps; software for operating route planners; route planners in the nature of hand-held personal computers; software for operating digital dictionaries; electronic digital dictionaries; location, orientation, and navigation sensors, transmitters, actuators, cameras and global positioning systems, namely, GPS comprising computers, computer software, transmitters, GPS and satellite receivers, network interface devices, connecting cables, and parts and fittings thereof; holders for pocket personal computers, namely, protective carrying cases specially adapted for personal digital assistants (PDA); satellite and radio transmission processors and receivers; telecommunication installations, networks and apparatus, namely, mounting racks for telecommunications hardware, telecommunications switches; computer terminals to be used with navigation systems, route planners and digital maps; blank magnetic data carriers and blank recording discs; audio and video apparatus, namely, audio and video receivers and processors; hand-held personal computers; personal digital assistants; electric and electronic instruments

for providing information regarding maps, navigation, traffic, weather and interesting locations. alarm apparatus and instruments to be used for tracking and tracing vehicles, namely, vehicle locating and tracking systems comprised of computers, computer software, transceivers, transponders, global positioning satellite receivers and antennas

IC 038. US 100 101 104. G & S: Secured or not secured telecommunication services, namely, transmission and delivery of digital data, light files, sound files, data, information and image signals, by means of computer, cable, radio and satellite networks, all in particular for navigation systems, route planners and the use of electronic maps; wireless transmission of data by means of videotext, the Internet, GSM and WAP; wireless transmission of digital data; communication by way of computer terminals; telecommunication services for the communication with means of transport, namely, transmission of digital data, light files, sound files, data, information and image signals, by means of wireless and satellite networks; rental of telecommunication equipment; technical telecommunications consultation concerning all services mentioned above

IC 039. US 100 105. G & S: Navigational services, namely, providing navigational information for use in piloting land vehicles, providing global positioning and navigation information via mobile telephone, wireless and satellite networks; information services regarding traffic and traffic congestion; provision of information regarding travel; provision of information to travellers regarding fares, time tables and means of public transport; services of a travel agency, namely booking of rental cars, boats and other vehicles; all of the aforesaid services also provided via a communications network or a mobile telephone or a wireless navigation device

IC 041. US 100 101 107. G & S: Education services, namely, providing classes and seminars regarding the use of navigation systems; training services in the field of navigation systems; entertainment, namely, the production of radio programs and television programs; organizing community cultural activities and sporting activities

IC 042. US 100 101. G & S: Development and design of navigation

systems, route planners, electronic maps and digital dictionaries for others; computer software and hardware design; development and design of software for use with navigation systems, route planners, electronic maps and digital dictionaries; development and design of telecommunication and data communication networks; providing temporary use of non-downloadable software for tracking and tracing goods and vehicles via computer networks, intranets and the internet

IC 045. US 100 101. G & S: Security services for the protection of property and individuals, namely, the tracking and tracing of goods and individuals in the context of security.

(7) Petitioner duly registered the mark TOMTOM for the following goods and services in the United States Patent and Trademark Office under Registration No. 3,606,082 which issued April 14, 2009:

IC 009. US 021 023 026 036 038. G & S: Computer hardware and software for use with navigation systems, route planners and the use of electronic maps and digital dictionaries; software for use with satellite and GPS navigation systems; software for travel information systems for the provision and rendering of travel advice and information concerning service stations, car parks, restaurants, car dealers and other travel and transport related information; software for information management for the transport and traffic industries; software to be used for viewing electronic maps; downloadable electronic maps; software for operating route planners; route planners in the nature of hand-held personal computers; software for operating electronic digital dictionaries; electronic digital dictionaries; location, orientation, and navigation sensors, transmitters, actuators, cameras and global positioning systems, namely, GPS consisting of computers, computer software, transmitters, GPS and satellite receivers, network interface devices, connection cables and parts and fittings thereof, holders for pocket personal computers; satellite and radio transmission processors and receivers; telecommunications installations, networks and apparatus, namely, mounting racks for telecommunications hardware, telecommunications switches; computer terminals, all in particular to be used with navigation systems, route

planners and digital maps; blank magnetic and disc shaped data carriers; audio and video apparatus, namely, audio and video receivers and processors; hand personal computers; personal digital assistants

IC 038. US 100 101 104. G & S: Secured or unsecured telecommunications services, namely, transmission and delivery of digital data, light files, sound files, data, information and image signals by means of computer, cable, radio and satellite transmissions, all in particular for navigation systems, route planners, and the use of electronic maps; wireless transmission of data by means of video text, the internet, GSM and WAP; wireless transmission of digital data; electronic transmission of data and documents via computer terminals; rental of telecommunications equipment; technical consultation in connection with all of the above

IC 039. US 100 105. G & S: Secured and unsecured telecommunications services, namely, electronic storage of digital data, light files, sound files, data, information and image signals all in particular for navigation systems, route planners and the use of electronic maps

IC 042. US 100 101. G & S: Consultation in the field of computer software design; providing temporary use of non-downloadable software which provides geographical, map image, and trip routing data obtained with the aid of a global positioning system, GPS, in order to enable third parties to come to an accurate location or orientation; development and design of navigation systems, route planners, electronic maps and digital dictionaries; computer software and hardware design; development and design of software for use with navigation systems, route planners and the use of electronic maps and digital dictionaries; development and design of telecommunications and data communication services and networks

(8) Petitioner duly registered the mark TOMTOM & Design for the following goods and services in the United States Patent and Trademark Office under Registration No. 3,951,073 which issued April 26, 2011

IC 009. US 021 023 026 036 038. G & S: Computer hardware and

software to be used with satellite and/or GPS navigation systems for navigation purposes; computer software to be used with route planners, electronic maps, and digital dictionaries for navigation and translation purposes; software for travel information systems for the provision or rendering of travel advice and/or information concerning service stations, car parks, restaurants, car dealers and other travel and transport related information; software for information management for the transport and traffic industries; software to be used for viewing electronic maps; downloadable electronic maps; software for operating route planners; route planners in the nature of handheld personal computers; software for operating electronic digital dictionaries; electronic dictionaries; location, orientation and navigation, and global positioning systems (GPS) consisting of computers, computer software, transmitters, GPS and/or satellite receivers, network interface devices, connection cables, and parts and fittings thereof; satellite and radio transmission apparatus technology, namely, processors, mobile telephones and receivers; telecommunications installations, networks and apparatus, namely, mounting racks for telecommunications hardware, telecommunication switches; computer terminals, all in particular to be used with navigation systems, route planners and/or digital maps; audio and video apparatus namely, audio and video receivers and processors; handheld personal computers; personal digital assistants.

IC 038. US 100 101 104. G & S: Secured or unsecured telecommunication services, namely, transmission and delivery of digital data, light files, sound files, data, information and image signals by means of computer, cable radio and satellite, transmissions, all in particular for navigation systems, route planners, and the use of electronic maps; wireless transmission of data, by means of videotext, the Internet, GSM and WAP; wireless transmission of digital data; electronic transmission of data and documents via computer terminals.

IC 039. US 100 105. G & S: Secured or unsecured telecommunication services, namely, electronic storage of digital data, light files, sound files, data, information and image signals, all in particular for navigation systems, route planners and the use of electronic maps; providing navigation and information services, namely, information regarding traffic and traffic congestion; provision of information regarding travel; provision

of information to travellers regarding fares, time tables and means of public transport; all of the aforesaid services also provided via a communications network or a mobile telephone or a wireless navigation device.

IC 042. US 100 101. G & S: Consultation in the field of computer software design; providing temporary use of non-downloadable software which provides geographical, map image and trip routing data obtained with the aid of a Global Positioning System (GPS) in order to enable third parties to come to an accurate location or orientation; development and design of navigation systems, route planners, electronic maps and digital dictionaries; computer software and hardware design; development and design of software for use with navigation systems, route planners and the use of electronic maps and digital dictionaries; development and design of telecommunication and data communication services and networks.

(10) Registration Nos. 3,409,331, 3,606,082 and 3,951,073 are *prima facie* evidence of the validity of and Petitioner's exclusive right to use of the marks TOMTOM and TOMTOM & Design, and are constructive notice of its ownership thereof, all as provided by §§ 7(b) and 22 of the Federal Trademark Act, 15 U.S.C. §§ 1057(b) and 1072.

(11) Registrant is not lawfully entitled to maintain Registration No. 3,411,788 because its use of the trademark TOMTOM in connection with the products described in said registration is likely to dilute the distinctive qualities of Petitioner's famous marks TOMTOM and TOMTOM & Design within the meaning of § 43(c) of the Federal Trademark Act thereby damaging Petitioner.

(12) Registrant is not lawfully entitled to maintain Registration No. 3,411,788 because its use of the trademark TOMTOM, in connection with goods described in the

said registration, so resembles Petitioner's previously used and registered marks TOMTOM and TOMTOM & Design as to be likely to cause confusion, to cause mistake or to deceive within the meaning of § 2(d) of The Federal Trademark Act, thereby damaging Registrant.

(13) On information and belief, Registrant has discontinued use of the trademark TOMTOM for the goods described in Registration No. 3,411,788 with no intent to resume use, and therefore said mark has lost all capacity as a source indicator for Registrant's goods. Accordingly, Registration No. 3,422,788 should be cancelled on the ground of abandonment.

(14) For all of the reasons stated above, Petitioner is being damaged by the continued existence of Registration No. 3,411,788 because said registration tends to create and/or maintain statutory rights in the trademark TOMTOM in violation and derogation of the prior established rights of Petitioner in the identical mark TOMTOM.

WHEREFORE, Petitioner prays that this Petition for Cancellation be sustained and judgment be entered cancelling Registration 3,411,788.

The Commissioner for Trademarks is authorized to deduct the necessary filing fees for this Petitioner for Cancellation from Wiley Rein Deposit Account No. 501129

Certificate of Service

In accordance with Rule 2.101(b) of the Trademark Rules of Practice, as amended, it is hereby certified that a true copy of the foregoing Petition for Cancellation was served on Registrant at the following address by depositing the same in the U.S. mail, first class postage prepaid, this 25th day of March, 2013:

Thomas Snieder
Junkersstraße 3 82178
Puchheim, Federal Republic of Germany

/Alan S. Cooper/