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

Proceeding	91224081
Party	Plaintiff Concorde Battery Corporation
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Signature	/Paul A. Bost/
Date	01/13/2016
Attachments	Motion to Join- Complete.pdf(455278 bytes)

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

<p>In re Matter of Application Ser. No. 86/497,484 for the mark: PLATINUM SERIES</p> <p>In re Matter of Reg. No. 4,726,130 for the mark: PLATINUM SERIES MU-2</p> <p>Concorde Battery Corporation,</p> <p style="text-align: center;">Opposer and Petitioner,</p> <p style="text-align: center;">vs.</p> <p>Air 1st Aviation Companies, Inc.,</p> <p style="text-align: center;">Applicant and Registrant.</p>	<p>Opposition No. 91-224081 (parent) Cancellation No. 92-062356</p> <p>OPPOSER AND PETITIONER CONCORDE BATTERY CORPORATION'S MOTION TO JOIN MITSUBISHI HEAVY INDUSTRIES AMERICA, INC. AS A PARTY DEFENDANT AND FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION AND PETITION FOR CANCELLATION</p>
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Pursuant to TBMP § 512.01, Opposer and Petitioner Concorde Battery Corporation (“Opposer”) hereby moves the Board for an order joining Mitsubishi Heavy Industries America, Inc. (“Mitsubishi”) as a party defendant. On October 16, 2015, an assignment of Reg. No. 4,726,130 for the mark PLATINUM SERIES MU-2 from Applicant and Registrant Air 1st Aviation Companies, Inc. (“Applicant”) to Mitsubishi was recorded with the U.S. Patent & Trademark Office (“PTO”). (Declaration of Paul A. Bost (“Bost Decl.”) ¶ 2, Ex. A.) Accordingly, Mitsubishi is the now record owner and registrant of PLATINUM SERIES MU-2, which registration is the subject of the instant petition for cancellation.

Relatedly, and pursuant to TBMP § 507.01 and Fed. R. Civ. P. 15(a)(2), Opposer hereby moves the Board for leave to amend its Notice of Opposition and Petition for Cancellation in the consolidated proceedings. Applicant’s purported assignment of its rights to PLATINUM

SERIES MU-2 to Mitsubishi compromises both Applicant's and Mitsubishi's claims to ownership of the PLATINUM SERIES and PLATINUM SERIES MU-2 marks respectively. Opposer seeks leave of the Board to file the First Amended Notice of Opposition and First Amended Petition for Cancellation, enclosed herein as **Exhibits B and C** to the Bost Declaration, respectively, to account for the foregoing.¹

This motion is supported by the accompanying brief, the Bost Declaration, Opposer's proposed First Amended Notice of Opposition and First Amended Petition for Cancellation, and a redline reflecting Opposer's proposed revisions to its original Notice of Opposition and Petition for Cancellation, as well as any such other papers and argument as may be presented to the Board.

Respectfully submitted,

SHEPPARD MULLIN RICHTER & HAMPTON, LLP

Dated: January 13, 2016

By: /s/Paul A. Bost
Paul A. Bost

Attorneys for Opposer and Petitioner
Concorde Battery Corporation

¹ Redlines reflecting changes to Opposer's initial Notice of Opposition and Petition for Cancellation are attached hereto as **Exhibits D and E** to the Bost Declaration, respectively.

BRIEF IN SUPPORT OF MOTION

I. FACTUAL BACKGROUND

Opposer owns trademark rights in PLATINUM SERIES and owns a registration of the same for “aircraft batteries” in Class 9.

On April 16, 2013, Applicant filed its application for registration of PLATINUM SERIES MU-2 for “refurbished airplanes” in Class 12. On April 28, 2015, registration of PLATINUM SERIES MU-2 (the “Registration”) issued to Applicant.

On January 7, 2015, Applicant filed its application for registration of PLATINUM SERIES for “refurbished airplanes” in Class 12 (the “Application”). On May 13, 2015, the Application was published for opposition.

On September 28, 2015, Opposer filed a Petition for Cancellation against the Registration on the following grounds: (1) likelihood of confusion pursuant to 15 U.S.C. § 1052(d); and (2) failure to use PLATINUM SERIES MU-2 as a trademark. (Canc. No. 92-062356; Docket No. 1.) Also, on September 28, 2015, Opposer filed a Notice of Opposition to registration of the Application based on a likelihood of confusion pursuant to 15 U.S.C. § 1052(d). (Opp. No. 91-224081; Docket No. 1.)

On November 5, 2015, Applicant filed answers in both proceedings denying all material allegations and asserting various affirmative defenses. Then, on December 7, 2015, Opposer, with the express consent of Applicant, filed a motion to consolidate the proceedings, which motion was granted by the Board. (*Id.*; Docket Nos. 5-6.)

Subsequently, Opposer learned that an assignment of Applicant’s rights and interest in the PLATINUM SERIES MU-2 mark, including the Registration, to Mitsubishi had been

recorded with the PTO on October 16, 2015 (the “Assignment”). The Assignment was executed on March 1, 2015.

Discovery in this matter just recently opened on January 8, 2016. (*Id.*; Docket No. 8.)

Neither party has served any discovery requests. (Bost Decl. ¶ 4.)

II. MITSUBISHI SHOULD BE JOINED AS A PARTY DEFENDANT

“When there has been an assignment of a mark that is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board’s own initiative.” TBMP § 512.01. “If the mark in an application or registration which is the subject matter of an inter partes proceeding before the Board is assigned, together with the application or registration, the assignee may be joined as a party (as a party defendant, in the case of an opposition or cancellation proceeding; or as a junior or senior party, as the case may be, in an interference or concurrent use proceeding) upon the filing with the Board of a copy of the assignment.” *Id.*

The Board should join Mitsubishi as a party defendant in the consolidated proceedings, specifically, as a defendant registrant in Opposer’s petition to cancel the Registration. The Assignment of the PLATINUM SERIES MU-2 mark, including the Registration, was recorded with the PTO. Mitsubishi now purports to own the trademark rights that are the subject of Opposer’s petition for cancellation. Additionally, because the Assignment was recorded with the PTO on a date subsequent to the filing of the petition for cancellation (but before the closing of the discovery and testimony periods) and Applicant remains a viable entity, Mitsubishi should be joined as party defendant, not substituted in for Applicant. *See NSM Res. Corp. v. Microsoft Corp.*, 113 U.S.P.Q.2d 1029, 1031 (TTAB 2014) (“Where a mark pleaded by a plaintiff is assigned and such assignment is recorded with the USPTO's Assignment Branch, the assignee

ordinarily will be substituted for the originally named party if the assignment occurred prior to the commencement of the proceeding, if the discovery and testimony periods have closed, if the assignor is no longer in existence, or, at the Board's discretion, if the defendant raises no objection to substitution. Otherwise, the assignee will be joined, rather than substituted"); *Drive Trademark Holdings LP v. Inofin*, 83 U.S.P.Q.2d 1433, 1434 n.2 (TTAB 2007) ("Applicant's motion, filed February 26, 2006, to join Mark Walsh as a defendant to this proceeding is granted in view of the assignment of Serial No. 78445657, the subject application. The assignment was recorded on February 22, 2006 (a date subsequent to the commencement of this proceeding).")

III. THE MOTION FOR LEAVE TO AMEND SHOULD BE GRANTED

A. The Liberal Standard for Granting Leave to Amend

Amendments to pleadings in *inter partes* proceedings before the Board are governed by the Federal Rules of Civil Procedure. TBMP § 507.01 ("[P]leadings in an *inter partes* proceeding before the Board may be amended in the same manner and to the same extent as in a civil action in a United States district court.") Fed.R.Civ.P. 15(a) provides that "[t]he [Board] should freely give leave when justice so requires." *See also* TBMP § 507.01. The Board liberally grants leave to amend pleadings "at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of the opposing party." *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (TTAB 1993) (quoting *American Optical Corp. v. American Olean Tile Co., Inc.*, 168 USPQ 471, 473 (TTAB 1971)).

Where the motion for leave to amend is filed prior to the close of the discovery period, there typically is no prejudice to the non-moving party because that party will have an opportunity to take discovery on the matters raised in the proposed amended pleading. *See*

Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992) (motion for leave to amend timely because it “was filed prior to opening of petitioner's testimony period and thus the discovery period may be reopened without undue prejudice to respondent.”) Furthermore, where, as here, the non-moving party is solely in possession of the relevant information relevant to the added claim, any issues raised by the moving party’s timing and resulting prejudice to the non-moving party decrease in significance. *See* TBMP § 507.02(a) (“Exercise of such discretion to reopen discovery, however, may not be necessary when the proposed additional claim or allegation concerns a subject on which the non-moving party can be expected to have relevant information in hand. This is especially true when the factual basis for the motion to amend was obtained by the moving party through discovery taken from the non-moving party.”)

Importantly, Opposer need not prove its case on this motion to amend nor prove a likelihood of success on the merits. Rather, Opposer must merely satisfy the liberal pleading standards of the Federal Rules of Civil Procedure and those of the Board, which Opposer has done.

B. The Board Should Grant Opposer Leave to Amend

Here, there is no conceivable prejudice to Applicant – or Mitsubishi – should the Board allow Opposer leave to file its amended pleading. Discovery in this case only recently opened on January 8, 2016 and is not scheduled to close until July 6, 2016. Even if discovery was closed or near closing (which is not the case), Opposer’s added claims do not require Applicant or Mitsubishi to take any discovery of Opposer or any third party. All documents and information relevant to the added claims are within their possession, custody, and control. Thus, Opposer’s amendment will not inject any inefficiencies into this matter. Finally, any delay in filing the

motion to amend – which added claims are based on the Assignment – is attributable to Applicant, who never informed Opposer of the Assignment. On the contrary, Applicant filed its answer to the petition for cancellation in its name even after the Assignment had been executed and recorded, and did not inform Opposer of the Assignment at the parties’ discovery conference. (Bost Decl. ¶ 5.) Opposer has moved to join Mitsubishi and amend its claims expeditiously.

Also, Opposer’s proposed amended pleading is legally sufficient. Applicant’s purported Assignment of its entire right, title, and interest in PLATINUM SERIES MU-2 to Mitsubishi, while purporting to retain all right, title, and interest in the PLATINUM SERIES mark, raises questions as to Applicant’s and Mitsubishi’s claimed ownership rights in the PLATINUM SERIES and PLATINUM SERIES MU-2 marks, respectively. It is well established that a trademark must identify a single source. *See Crystal Entertainment & Filmworks, Inc. v. Jurado*, 99 U.S.P.Q.2d 1197, 1203-05 (11th Cir. 2011) (“The parties recognize the bedrock principle of trademark law that a mark can identify and distinguish only a single commercial source” and “[t]rademark law ordinarily does not permit two entities to share a mark due to the consumer confusion that would ensue.”) The validity of the Assignment – that is, as an outright sale of all rights in the PLATINUM SERIES MU-2 mark – is undermined by Applicant’s retention of rights in the PLATINUM SERIES mark. Accordingly, the Assignment is invalid as a naked assignment – because it does not transfer all goodwill associated with the PLATINUM SERIES MU-2 mark – and/or the Assignment is more properly characterized as a license. In either case, Mitsubishi is not the owner of the PLATINUM SERIES MU-2 mark and, thus, cannot own a registration of the PLATINUM SERIES MU-2 mark. Likewise, if the Assignment is, in fact, a license to Mitsubishi to use the PLATINUM SERIES MU-2 mark, it is a naked license by

Applicant's failure to retain any power to control the use of the PLATINUM SERIES MU-2 mark and the goods offered thereunder. Such naked licensing constitutes an abandonment by Applicant of the PLATINUM SERIES mark.

IV. CONCLUSION

Based on the foregoing, Opposer respectfully requests that the Board enter an order joining Mitsubishi as a party defendant and granting Opposer leave to file its proposed amended pleadings and that the Board deem the pleadings filed and served.

Respectfully submitted,

SHEPPARD MULLIN RICHTER & HAMPTON, LLP

Dated: January 13, 2016

By: /s/Paul A. Bost
Paul A. Bost

Attorneys for Opposer and Petitioner
Concorde Battery Corporation

DECLARATION OF PAUL A. BOST

I, Paul A. Bost, declare as follows:

1. I am an attorney duly licensed to practice in the State of California. I am an associate in the law firm of Sheppard Mullin Richter & Hampton, LLP, counsel of record for Opposer in this case. I have personal knowledge of the facts set forth in this declaration, and if called to testify, I could and would testify competently thereto.

2. Attached hereto as **Exhibit A** is a true and correct copy of the March 1, 2015 assignment of Reg. No. 4,726,130 for the mark PLATINUM SERIES MU-2 from Applicant to Mitsubishi, which was recorded with the PTO on October 16, 2015 and assigned Reel/Frame 005647/0320.

3. Attached hereto as **Exhibits B and C** are true and correct copies of Opposer's proposed First Amended Notice of Opposition and First Amended Petition for Cancellation, respectively. Also attached hereto as **Exhibits D and E** are redlines reflecting any differences between Opposer's initial and First Amended Notices of Opposition and initial and First Amended Petitions for Cancellation, respectively.

4. As of the date of this declaration, no discovery has been served in this matter.

5. On December 2, 2015, Charles C. Stebbins, III and Mitchell B. Snyder of Warlick, Stebbins, Murray & Chew, LLP, counsel for Applicant, and I conducted the parties' Fed.R.Civ.P. 26(f) conference. At the conference, Applicant's counsel did not inform me of the Assignment. Instead, Opposer learned of the Assignment on December 11, 2015 when it was contacted directly by Mitsubishi. I telephoned Applicant's counsel on December 16, 2015 to inquire about the Assignment, and, in response, Mr. Snyder emailed me on December 22, 2015, stating that, "[s]o far as Mitsubishi owning the Platinum Series MU-2 mark, I am unaware that

Mitsubishi owns that mark. However, Clay has spoken with their attorneys, and we will be sure to let you know if anything changes.” A true and correct copy of that email is attached hereto as

Exhibit F.

I declare all of the foregoing under the penalty of perjury under the laws of the United States of America. Executed this 13th day of January, 2016 in Los Angeles, California.

/s/Paul A. Bost

Paul A. Bost

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **OPPOSER AND PETITIONER CONCORDE BATTERY CORPORATION'S MOTION TO JOIN MITSUBISHI HEAVY INDUSTRIES AMERICA, INC. AS A PARTY DEFENDANT AND FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION AND PETITION FOR CANCELLATION** is being submitted electronically to the Commissioner for Trademarks, Trademark Trial and Appeals, through ESTTA, on this 13th day of January, 2016.

/s/Lynne Thompson
Lynne Thompson

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **OPPOSER AND PETITIONER CONCORDE BATTERY CORPORATION'S MOTION TO JOIN MITSUBISHI HEAVY INDUSTRIES AMERICA, INC. AS A PARTY DEFENDANT AND FOR LEAVE TO AMEND ITS NOTICE OF OPPOSITION AND PETITION FOR CANCELLATION** is being deposited as first class mail, postage prepaid, in an envelope addressed to:

Charles C. Stebbins, III
Mitchell B. Snyder
WARLICK, STEBBINS, MURRAY & CHEW, LLP
P.O. Box 1495
Augusta, GA 30903-1495

on this 13th day of January, 2016.

/s/Lynne Thompson
Lynne Thompson

SMRH:224430989.1

EXHIBIT A

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM358952

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Air 1st Aviation Companies		03/01/2015	CORPORATION: GEORGIA
RECEIVING PARTY DATA			
Name:	Mitsubishi Heavy Industries America, Inc.		
Street Address:	4951 Airport Parkway		
Internal Address:	Suite 530		
City:	Addison		
State/Country:	TEXAS		
Postal Code:	75001		
Entity Type:	CORPORATION: DELAWARE		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Serial Number:	86089204	PLATINUM SERIES MU-2	
CORRESPONDENCE DATA			
Fax Number:	2149691751		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	2149691767		
Email:	usptodallas@tklaw.com		
Correspondent Name:	Deborah L. Lively, Thompson & Knight LLP		
Address Line 1:	1722 Routh Street		
Address Line 4:	Dallas, TEXAS 75201		
ATTORNEY DOCKET NUMBER:	056346.000012		
NAME OF SUBMITTER:	Deborah L. Lively		
SIGNATURE:	/deborah l. lively/		
DATE SIGNED:	10/16/2015		
Total Attachments: 1			
source=assignment#page1.tif			

CH \$40.00 86089204

TRADEMARK ASSIGNMENT

This Trademark Assignment is made and entered into by Air 1st Aviation Companies, Inc. d/b/a Air 1st ("Air 1st"), a Georgia corporation, whose address is 234 Air Park Blvd., Aiken, South Carolina 29805 ("ASSIGNOR") in favor of Mitsubishi Heavy Industries America, Inc. ("MHIA"), a Delaware corporation, whose address is 4951 Airport Parkway, Suite 530, Addison, Texas 75001 ("ASSIGNEE").

WHEREAS, ASSIGNOR is the owner of record of common law and statutory rights in and to U.S. Serial No. 86/089204 for PLATINUM SERIES MU-2 (the "Mark"); and

WHEREAS, ASSIGNEE has obtained a license from Assignee to use the Mark in association with Assignor's business; and

WHEREAS, in light of the foregoing, this Trademark Assignment is intended to effectuate a full and complete assignment by ASSIGNOR to ASSIGNEE of all rights in and to the Trademarks.

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR hereby assigns, conveys and transfers to ASSIGNEE, its successors, assigns and legal representatives ASSIGNOR'S entire right, title and interest in and to the Mark, together with the goodwill symbolized by the Mark, and any and all trademark applications and renewals and all registrations or certificates that may be issued or granted for the Mark throughout the United States and in any and all other countries of the world, as well as the right to sue for and recover damages for past, present and future infringements and all rights of priority.

IN TESTIMONY WHEREOF, Assignor has caused its duly authorized representative to execute this Trademark Assignment as of March 1st, 2015.

Air 1st Aviation Companies, Inc.

By: Michael S. Lauer
Name: MICHAEL S LAUER
Title: PRESIDENT

EXHIBIT B

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

<p>In re Matter of Application Ser. No. 86/497,484 for the mark: PLATINUM SERIES</p> <p>Concorde Battery Corporation,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">vs.</p> <p>Air 1st Aviation Companies, Inc.,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91-224081 (parent)</p> <p>OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED NOTICE OF OPPOSITION</p>
<p>In re Matter of Reg. No. 4,726,130 for the mark: PLATINUM SERIES MU-2</p> <p>Concorde Battery Corporation,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">vs.</p> <p>Air 1st Aviation Companies, Inc. and Mitsubishi Heavy Industries America, Inc.,</p> <p style="text-align: center;">Registrants.</p>	<p>Cancellation No. 92-062356</p>

Opposer Concorde Battery Corporation, a corporation organized and existing under the laws of the State of California, having a place of business at 2009 San Bernardino Road, West Covina, California 97190 (“Opposer”), believes that it will be damaged by registration of the mark PLATINUM SERIES for “refurbished airplanes” in International Class 12, as shown in application Serial No. 86/497,484 (the “Application”), filed on September 26, 2013 by Applicant

Air 1st Aviation Companies, Inc. AKA Air 1st Corporation, a corporation organized and existing under the laws of the State of Georgia, having an address at 234 Air Park Blvd, Aiken, South Carolina 29805 (“Applicant”), and hereby opposes the same.

As grounds for opposition, Opposer alleges that:

1. Opposer is engaged, among other things, in the business of manufacturing and selling aircraft batteries under its mark PLATINUM SERIES.
2. Opposer is the owner of U.S. Registration No. 2,734,038 for the mark PLATINUM SERIES, registered on July 8, 2003 in connection with “aircraft batteries” in International Class 9.
3. Opposer’s Registration No. 2,734,038 is valid, subsisting and in full force and effect. Opposer’s registration is incontestable pursuant to 15 U.S.C. § 1065, and thus serves as conclusive evidence of the validity of Opposer’s PLATINUM SERIES mark, pursuant to 15 U.S.C. § 1115(b).
4. Opposer has been using the PLATINUM SERIES mark continuously in commerce, throughout the United States, for the recited goods in International Class 9 since at least as early as December 21, 2001 and intends to continue so using the PLATINUM SERIES mark in the future. A true, correct, and current printout of the TESS page reflecting Opposer’s Registration No. 2,734,038 is attached hereto as **Exhibit A**. Opposer uses the mark PLATINUM SERIES by applying it in ways customary in the trade.
5. On January 7, 2015, Applicant filed the Application with the U.S. Patent and Trademark Office to register PLATINUM SERIES in connection with “refurbished airplanes” in International Class 12. The Application alleges a date of first use anywhere and in commerce of August 21, 2012.

6. The Application was published for opposition on June 2, 2015.

First Ground for Opposition: Likelihood of Confusion

7. Opposer, through the use of its PLATINUM SERIES mark, from a time prior to Applicant's alleged date of first use in commerce or the filing of the Application, and by virtue of the quality of Opposer's goods, has built up a valuable goodwill and reputation in connection with its PLATINUM SERIES mark.

8. Applicant's proposed mark PLATINUM SERIES is identical in appearance, sound, connotation, and commercial impression to Opposer's PLATINUM SERIES mark. Applicant admitted as much in its application to register PLATINUM SERIES MU-2. There, in a response to an office action refusing registration of PLATINUM SERIES MU-2 based, in part, on Opposer's registration of PLATINUM SERIES, Applicant admitted that "[t]here are already at least four (4) trademarks registered using just the terms Platinum Series" and "[t]hese marks[, including Opposer's PLATINUM SERIES mark,] would all appear very confusing to the general consumer" but for Applicant's addition of MU-2 to its mark.

9. Applicant's goods and Opposer's goods offered under their respective marks are related.

10. Opposer believes that it will be damaged by the registration of Applicant's proposed mark PLATINUM SERIES and opposes the Application because Applicant's registration and use of its proposed mark PLATINUM SERIES in connection with the goods set forth in the Application likely to cause confusion, to cause mistake, and to deceive customers, potential customers and others, pursuant to 15 U.S.C. § 1052(d), thereby injuring Opposer and the consuming public and jeopardizing the valuable goodwill and reputation Opposer has built up in connection with its PLATINUM SERIES mark.

Second Ground for Opposition: Abandonment by Naked Licensing

11. Prior to filing the Application, Applicant filed an application to register a version or derivative of the PLATINUM SERIES mark, namely, the mark PLATINUM SERIES MU-2 for “refurbished airplanes” in International Class 12 (the “PLATINUM SERIES MU-2 Application”).

12. On March 1, 2015, Applicant purported to assign all of its entire right, title, and interest in the PLATINUM SERIES MU-2 mark, and the goodwill related thereto, to Mitsubishi Heavy Industries America, Inc. (“Mitsubishi”), including its rights and interest in the PLATINUM SERIES MU-2 Application. A true and correct copy of the Assignment as recorded with the U.S. Patent & Trademark Office on or around October 16, 2015 is attached hereto as **Exhibit B**.

13. Applicant, however, purported to retain all right, title, and interest in the PLATINUM SERIES mark for “refurbished airplanes,” including the Application, which Applicant did not assign to Mitsubishi.

14. Accordingly, the Assignment is, in fact, a naked license by Applicant of its purported trademark rights in the PLATINUM SERIES mark to Mitsubishi. Applicant has not retained any control over Mitsubishi’s use of the PLATINUM SERIES MU-2 mark or the goods on which they are used. Based on its naked licensing, Applicant has abandoned any ownership rights it had in the PLATINUM SERIES mark.

15. Accordingly, for each and every reason stated above, Opposer believes that it will be damaged by the registration of Applicant’s PLATINUM SERIES mark and opposes registration of Applicant’s PLATINUM SERIES mark in the Application.

WHEREFORE, Opposer prays that this opposition be sustained and that the registration of Applicant's PLATINUM SERIES mark in the Application be refused.

Respectfully submitted,

SHEPPARD MULLIN RICHTER & HAMPTON, LLP

Dated: January 13, 2016

By: /s/Paul A. Bost
Paul A. Bost

Attorneys for Opposer and Petitioner
Concorde Battery Corporation

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED NOTICE OF OPPOSITION** is being submitted electronically to the Commissioner for Trademarks, Trademark Trial and Appeals, through ESTTA, on this 13th day of January, 2016.

/s/Lynne Thompson _____
Lynne Thompson

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED NOTICE OF OPPOSITION** is being deposited as first class mail, postage prepaid, in an envelope addressed to:

Charles C. Stebbins, III
Mitchell B. Snyder
WARLICK, STEBBINS, MURRAY & CHEW, LLP
P.O. Box 1495
Augusta, GA 30903-1495

on this 13th day of January, 2016.

/s/Lynne Thompson _____
Lynne Thompson

SMRH:224433100.1

EXHIBIT A



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PLATINUM SERIES

Word Mark	PLATINUM SERIES
Goods and Services	IC 009. US 021 023 026 036 038. G & S: AIRCRAFT BATTERIES. FIRST USE: 20011221. FIRST USE IN COMMERCE: 20011221
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76363901
Filing Date	January 25, 2002
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 15, 2003
Registration Number	2734038
Registration Date	July 8, 2003
Owner	(REGISTRANT) Concorde Battery Corporation CORPORATION CALIFORNIA 2009 San Bernardino Road West Covina CALIFORNIA 97190
Attorney of Record	C. Robert Rhodes
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SERIES" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130629.
Renewal	1ST RENEWAL 20130629

Live/Dead Indicator LIVE

TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	SEARCH OG	TOP	HELP	PREV LIST	CURR LIST
NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

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EXHIBIT B

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM358952

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Air 1st Aviation Companies		03/01/2015	CORPORATION: GEORGIA
RECEIVING PARTY DATA			
Name:	Mitsubishi Heavy Industries America, Inc.		
Street Address:	4951 Airport Parkway		
Internal Address:	Suite 530		
City:	Addison		
State/Country:	TEXAS		
Postal Code:	75001		
Entity Type:	CORPORATION: DELAWARE		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Serial Number:	86089204	PLATINUM SERIES MU-2	
CORRESPONDENCE DATA			
Fax Number:	2149691751		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	2149691767		
Email:	usptodallas@tklaw.com		
Correspondent Name:	Deborah L. Lively, Thompson & Knight LLP		
Address Line 1:	1722 Routh Street		
Address Line 4:	Dallas, TEXAS 75201		
ATTORNEY DOCKET NUMBER:	056346.000012		
NAME OF SUBMITTER:	Deborah L. Lively		
SIGNATURE:	/deborah l. lively/		
DATE SIGNED:	10/16/2015		
Total Attachments: 1			
source=assignment#page1.tif			

CH \$40.00 86089204

TRADEMARK ASSIGNMENT

This Trademark Assignment is made and entered into by Air 1st Aviation Companies, Inc. d/b/a Air 1st ("Air 1st"), a Georgia corporation, whose address is 234 Air Park Blvd., Aiken, South Carolina 29805 ("ASSIGNOR") in favor of Mitsubishi Heavy Industries America, Inc. ("MHIA"), a Delaware corporation, whose address is 4951 Airport Parkway, Suite 530, Addison, Texas 75001 ("ASSIGNEE").

WHEREAS, ASSIGNOR is the owner of record of common law and statutory rights in and to U.S. Serial No. 86/089204 for PLATINUM SERIES MU-2 (the "Mark"); and

WHEREAS, ASSIGNEE has obtained a license from Assignee to use the Mark in association with Assignor's business; and

WHEREAS, in light of the foregoing, this Trademark Assignment is intended to effectuate a full and complete assignment by ASSIGNOR to ASSIGNEE of all rights in and to the Trademarks.

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR hereby assigns, conveys and transfers to ASSIGNEE, its successors, assigns and legal representatives ASSIGNOR'S entire right, title and interest in and to the Mark, together with the goodwill symbolized by the Mark, and any and all trademark applications and renewals and all registrations or certificates that may be issued or granted for the Mark throughout the United States and in any and all other countries of the world, as well as the right to sue for and recover damages for past, present and future infringements and all rights of priority.

IN TESTIMONY WHEREOF, Assignor has caused its duly authorized representative to execute this Trademark Assignment as of March 1st, 2015.

Air 1st Aviation Companies, Inc.

By: Michael S. Lauer
Name: MICHAEL S LAUER
Title: PRESIDENT

EXHIBIT C

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

<p>In re Matter of Application Ser. No. 86/497,484 for the mark: PLATINUM SERIES</p> <p>Concorde Battery Corporation,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">vs.</p> <p>Air 1st Aviation Companies, Inc.,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 91-224081 (parent)</p> <p>OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED PETITION FOR CANCELLATION</p>
<p>In re Matter of Reg. No. 4,726,130 for the mark: PLATINUM SERIES MU-2</p> <p>Concorde Battery Corporation,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">vs.</p> <p>Air 1st Aviation Companies, Inc. and Mitsubishi Heavy Industries America, Inc.,</p> <p style="text-align: center;">Registrants.</p>	<p>Cancellation No. 92-062356</p>

Petitioner, Concorde Battery Corporation, a corporation organized and existing under the laws of the State of California, having a place of business at 2009 San Bernardino Road, West Covina, California 97190 (“Petitioner”), believes that it will be damaged by the existence on the Principal Register of the mark PLATINUM SERIES MU-2 for “refurbished airplanes” in

International Class 12, as shown in Registration No. 4,726,130 (the “Registration”), registered on April 28, 2015, and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner alleges that:

1. Petitioner is engaged, among other things, in the business of manufacturing and selling aircraft batteries under its mark PLATINUM SERIES.
2. Petitioner is the owner of U.S. Registration No. 2,734,038 for the mark PLATINUM SERIES, registered on July 8, 2003 in connection with “aircraft batteries” in International Class 9.
3. Petitioner’s Registration No. 2,734,038 is valid, subsisting and in full force and effect. Petitioner’s registration is incontestable pursuant to 15 U.S.C. § 1065, and thus serves as conclusive evidence of the validity of Petitioner Concorde Battery’s PLATINUM SERIES mark, pursuant to 15 U.S.C. § 1115(b).
4. Petitioner has been using the PLATINUM SERIES mark continuously in commerce, throughout the United States, for the recited goods in International Class 9 since at least as early as December 21, 2001 and intends to continue so using the PLATINUM SERIES mark in the future. A true, correct, and current printout of the TESS page reflecting Petitioner’s Registration No. 2,734,038 is attached hereto as **Exhibit A**. Petitioner uses the mark PLATINUM SERIES by applying it in ways customary in the trade.
5. On October 11, 2013, Air 1st Aviation Companies, Inc. (“Air 1st”) filed an application, Serial No. 86/089,204, with the U.S. Patent and Trademark Office to register PLATINUM SERIES MU-2 in connection with “refurbished airplanes” in International Class 12. The application alleges a date of first use anywhere and in commerce of August 21, 2012.

6. On March 1, 2015, Air 1st purported to assign all of its entire right, title, and interest in the PLATINUM SERIES MU-2 mark, and the goodwill related thereto, to Mitsubishi Heavy Industries America, Inc. (“Mitsubishi”), including its rights and interest in the PLATINUM SERIES MU-2 application. A true and correct copy of the Assignment as recorded with the U.S. Patent & Trademark Office on or around October 16, 2015 is attached hereto as **Exhibit B**.

7. This application, Serial No. 86/089,204 matured into the Registration on April 28, 2015.

First Ground for Opposition: Likelihood of Confusion

8. Petitioner, through the use of its PLATINUM SERIES mark, from a time prior to the filing of the application underlying the Registration or the alleged date of first use therein, and by virtue of the quality of Petitioner’s goods, has built up a valuable goodwill and reputation in connection with its PLATINUM SERIES mark.

9. The mark PLATINUM SERIES MU-2 is similar in appearance, sound, connotation, and commercial impression to Petitioner’s PLATINUM SERIES mark.

10. The goods identified in the Registration and Petitioner’s goods offered under the PLATINUM SERIES mark are related.

11. Petitioner believes that it will be damaged by the continued registration of PLATINUM SERIES MU-2 and petitions to cancel the Registration because Registrant’s registration and use of its mark PLATINUM SERIES MU-2 in connection with the goods set forth in the Registration is likely to cause confusion, to cause mistake, and to deceive customers, potential customers and others, pursuant to 15 U.S.C. § 1052(d), thereby injuring Petitioner and

the consuming public and jeopardizing the valuable goodwill and reputation Petitioner has built up in connection with its PLATINUM SERIES mark.

Second Ground for Opposition: Failure to Use as a Trademark

12. Air 1st failed to demonstrate valid use in commerce of the registered mark PLATINUM SERIES MU-2 in connection with the recited goods because each specimen submitted to the U.S. Patent & Trademark Office failed to demonstrate use of the mark PLATINUM SERIES MU-2 “on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale.” 15 U.S. Code § 1127.

13. On information and belief, Air 1st did not make valid use of the mark PLATINUM SERIES MU-2 in connection with the recited goods prior to or at the time of the filing of the application underlying the Registration.

Third Ground for Opposition: Lack of Ownership

14. Although Air 1st purports to have assigned its entire right, title, and interest in the PLATINUM SERIES MU-2 mark to Mitsubishi on March 1, 2015, Air 1st claims to have retained its entire right, title, and interest in the PLATINUM SERIES mark, and related application, Ser. No. 86/497,484, which seeks registration of the PLATINUM SERIES mark for “refurbished airplanes” in International Class 12.

15. Air 1st’s assignment to Mitsubishi is an invalid naked assignment. It did not include all of Air 1st’s purported goodwill in the PLATINUM SERIES MU-2 mark because Air 1st retained all right, title, and interest in the PLATINUM SERIES mark. Because the

assignment is invalid as naked, Mitsubishi is not the owner of the PLATINUM SERIES MU-2 mark.

16. Air 1st's purported assignment of rights to Mitsubishi is, in fact, a license to Mitsubishi to use the PLATINUM SERIES mark with Mitsubishi's MU-2 mark. Consequently, Mitsubishi is not the owner of the PLATINUM SERIES MU-2 mark, but a licensee.

17. Accordingly, for each and every reason stated above, Petitioner believes that it will be damaged by the continued registration of the PLATINUM SERIES MU-2 mark and petitions to cancel the Registration.

WHEREFORE, Petitioner prays that this petition for cancellation be sustained and that the Registration be canceled.

Respectfully submitted,

SHEPPARD MULLIN RICHTER & HAMPTON, LLP

Dated: January 13, 2016

By: /s/Paul A. Bost
Paul A. Bost

Attorneys for Opposer and Petitioner
Concorde Battery Corporation

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this **OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED PETITION FOR CANCELLATION** is being submitted electronically to the Commissioner for Trademarks, Trademark Trial and Appeals, through ESTTA, on this 13th day of January, 2016.

/s/Lynne Thompson _____
Lynne Thompson

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED PETITION FOR CANCELLATION** is being deposited as first class mail, postage prepaid, in an envelope addressed to:

Charles C. Stebbins, III
Mitchell B. Snyder
WARLICK, STEBBINS, MURRAY & CHEW, LLP
P.O. Box 1495
Augusta, GA 30903-1495

on this 13th day of January, 2016.

/s/Lynne Thompson _____
Lynne Thompson

SMRH:224433101.1

EXHIBIT A


United States Patent and Trademark Office
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Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Tue Jan 12 03:21:01 EST 2016

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NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

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TSDR	ASSIGN Status	TTAB Status	(Use the "Back" button of the Internet Browser to return to TESS)
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PLATINUM SERIES

Word Mark	PLATINUM SERIES
Goods and Services	IC 009. US 021 023 026 036 038. G & S: AIRCRAFT BATTERIES. FIRST USE: 20011221. FIRST USE IN COMMERCE: 20011221
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	76363901
Filing Date	January 25, 2002
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 15, 2003
Registration Number	2734038
Registration Date	July 8, 2003
Owner	(REGISTRANT) Concorde Battery Corporation CORPORATION CALIFORNIA 2009 San Bernardino Road West Covina CALIFORNIA 97190
Attorney of Record	C. Robert Rhodes
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SERIES" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20130629.
Renewal	1ST RENEWAL 20130629

Live/Dead Indicator LIVE

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NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

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EXHIBIT B

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM358952

SUBMISSION TYPE:	NEW ASSIGNMENT		
NATURE OF CONVEYANCE:	ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL		
CONVEYING PARTY DATA			
Name	Formerly	Execution Date	Entity Type
Air 1st Aviation Companies		03/01/2015	CORPORATION: GEORGIA
RECEIVING PARTY DATA			
Name:	Mitsubishi Heavy Industries America, Inc.		
Street Address:	4951 Airport Parkway		
Internal Address:	Suite 530		
City:	Addison		
State/Country:	TEXAS		
Postal Code:	75001		
Entity Type:	CORPORATION: DELAWARE		
PROPERTY NUMBERS Total: 1			
Property Type	Number	Word Mark	
Serial Number:	86089204	PLATINUM SERIES MU-2	
CORRESPONDENCE DATA			
Fax Number:	2149691751		
<i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i>			
Phone:	2149691767		
Email:	usptodallas@tklaw.com		
Correspondent Name:	Deborah L. Lively, Thompson & Knight LLP		
Address Line 1:	1722 Routh Street		
Address Line 4:	Dallas, TEXAS 75201		
ATTORNEY DOCKET NUMBER:	056346.000012		
NAME OF SUBMITTER:	Deborah L. Lively		
SIGNATURE:	/deborah l. lively/		
DATE SIGNED:	10/16/2015		
Total Attachments: 1			
source=assignment#page1.tif			

CH \$40.00 86089204

TRADEMARK ASSIGNMENT

This Trademark Assignment is made and entered into by Air 1st Aviation Companies, Inc. d/b/a Air 1st ("Air 1st"), a Georgia corporation, whose address is 234 Air Park Blvd., Aiken, South Carolina 29805 ("ASSIGNOR") in favor of Mitsubishi Heavy Industries America, Inc. ("MHIA"), a Delaware corporation, whose address is 4951 Airport Parkway, Suite 530, Addison, Texas 75001 ("ASSIGNEE").

WHEREAS, ASSIGNOR is the owner of record of common law and statutory rights in and to U.S. Serial No. 86/089204 for PLATINUM SERIES MU-2 (the "Mark"); and

WHEREAS, ASSIGNEE has obtained a license from Assignee to use the Mark in association with Assignor's business; and

WHEREAS, in light of the foregoing, this Trademark Assignment is intended to effectuate a full and complete assignment by ASSIGNOR to ASSIGNEE of all rights in and to the Trademarks.

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR hereby assigns, conveys and transfers to ASSIGNEE, its successors, assigns and legal representatives ASSIGNOR'S entire right, title and interest in and to the Mark, together with the goodwill symbolized by the Mark, and any and all trademark applications and renewals and all registrations or certificates that may be issued or granted for the Mark throughout the United States and in any and all other countries of the world, as well as the right to sue for and recover damages for past, present and future infringements and all rights of priority.

IN TESTIMONY WHEREOF, Assignor has caused its duly authorized representative to execute this Trademark Assignment as of March 1st, 2015.

Air 1st Aviation Companies, Inc.

By: Michael S. Lauer
Name: MICHAEL S LAUER
Title: PRESIDENT

EXHIBIT D

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

<p><u>In re Matter of Application Ser. No. 86/497,484 for the mark: PLATINUM SERIES</u></p> <p>Concorde Battery Corporation, Opposer,</p> <p>v <u>vs.</u></p> <p>Air 1st Aviation Companies, Inc. AKA Air 1st Corporation, Applicant.</p> <hr/> <hr/>	<p>Opposition No. _____</p> <p>Serial<u>Opposition</u> No. 86/497,484<u>91-224081</u> (parent) Filed: January 7, 2015</p> <p>Mark: PLATINUM SERIES Published: June 2, 2015<u>OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED NOTICE OF OPPOSITION</u></p>
<p><u>In re Matter of Reg. No. 4,726,130 for the mark: PLATINUM SERIES MU-2</u></p> <p><u>Concorde Battery Corporation,</u> <u>Petitioner,</u></p> <p><u>vs.</u></p> <p><u>Air 1st Aviation Companies, Inc. and Mitsubishi Heavy Industries America, Inc.,</u> <u>Registrants.</u></p>	<p><u>Cancellation No. 92-062356</u></p>

NOTICE OF OPPOSITION

~~Commissioner for Trademarks
P.O. Box 1451~~

~~Alexandria, VA 22313-1451~~

Madam:

Opposer, Concorde Battery Corporation, a corporation organized and existing under the laws of the State of California, having a place of business at 2009 San Bernardino Road, West Covina, California 97190 (“Opposer”), believes that it will be damaged by registration of the mark PLATINUM SERIES for “refurbished airplanes” in International Class 12, as shown in application Serial No. 86/497,484 (the “Application”), filed on September 26, 2013 by Applicant, Air 1st Aviation Companies, Inc. AKA Air 1st Corporation, a corporation organized and existing under the laws of the State of Georgia, having an address at 234 Air Park Blvd, Aiken, South Carolina 29805 (“Applicant”), and hereby opposes the same.

As grounds for opposition, Opposer alleges that:

1. Opposer is engaged, among other things, in the business of manufacturing and selling aircraft batteries under its mark PLATINUM SERIES.

2. Opposer is the owner of U.S. Registration No. 2,734,038 for the mark PLATINUM SERIES, registered on July 8, 2003 in connection with “aircraft batteries” in International Class 9.

3. Opposer’s Registration No. 2,734,038 is valid, subsisting and in full force and effect. Opposer’s registration is incontestable pursuant to 15 U.S.C. § 1065, and thus serves as conclusive evidence of the validity of Opposer’s PLATINUM SERIES mark, pursuant to 15 U.S.C. § 1115(b).

4. Opposer has been using the PLATINUM SERIES mark continuously in commerce, throughout the United States, for the recited goods in International Class 9 since at least as early as December 21, 2001 and intends to continue so using the PLATINUM

SERIES mark in the future. A true, correct, and current printout of the TESS page reflecting Opposer's Registration No. 2,734,038 is attached hereto as **Exhibit A**. Opposer uses the mark PLATINUM SERIES by applying it in ways customary in the trade.

5. On January 7, 2015, Applicant filed the Application with the U.S. Patent and Trademark Office to register PLATINUM SERIES in connection with "refurbished airplanes" in International Class 12. The Application alleges a date of first use anywhere and in commerce of August 21, 2012.

6. The Application was published for opposition on June 2, 2015.

First Ground for Opposition: Likelihood of Confusion

7. Opposer, through the use of its PLATINUM SERIES mark, from a time prior to Applicant's alleged date of first use in commerce or the filing of the Application, and by virtue of the quality of Opposer's goods, has built up a valuable goodwill and reputation in connection with its PLATINUM SERIES mark.

8. Applicant's proposed mark PLATINUM SERIES is identical in appearance, sound, connotation, and commercial impression to Opposer's PLATINUM SERIES mark.

Applicant admitted as much in its application to register PLATINUM SERIES MU-2. There, in a response to an office action refusing registration of PLATINUM SERIES MU-2 based, in part, on Opposer's registration of PLATINUM SERIES, Applicant admitted that "[t]here are already at least four (4) trademarks registered using just the terms Platinum Series" and "[t]hese marks[, including Opposer's PLATINUM SERIES mark,] would all appear very confusing to the general consumer" but for Applicant's addition of MU-2 to its mark.

9. Applicant's goods and Opposer's goods offered under their respective marks are related.

10. Opposer believes that it will be damaged by the registration of Applicant's proposed mark PLATINUM SERIES and opposes the Application because Applicant's registration and use of its proposed mark PLATINUM SERIES in connection with the goods set forth in the Application likely to cause confusion, to cause mistake, and to deceive customers, potential customers and others, pursuant to 15 U.S.C. § 1052(d), thereby injuring Opposer and the consuming public and jeopardizing the valuable goodwill and reputation Opposer has built up in connection with its PLATINUM SERIES mark.

Second Ground for Opposition: Abandonment by Naked Licensing

11. Prior to filing the Application, Applicant filed an application to register a version or derivative of the PLATINUM SERIES mark, namely, the mark PLATINUM SERIES MU-2 for "refurbished airplanes" in International Class 12 (the "PLATINUM SERIES MU-2 Application").

12. On March 1, 2015, Applicant purported to assign all of its entire right, title, and interest in the PLATINUM SERIES MU-2 mark, and the goodwill related thereto, to Mitsubishi Heavy Industries America, Inc. ("Mitsubishi"), including its rights and interest in the PLATINUM SERIES MU-2 Application. A true and correct copy of the Assignment as recorded with the U.S. Patent & Trademark Office on or around October 16, 2015 is attached hereto as **Exhibit B**.

13. Applicant, however, purported to retain all right, title, and interest in the PLATINUM SERIES mark for "refurbished airplanes," including the Application, which Applicant did not assign to Mitsubishi.

14. Accordingly, the Assignment is, in fact, a naked license by Applicant of its purported trademark rights in the PLATINUM SERIES mark to Mitsubishi. Applicant has

not retained any control over Mitsubishi's use of the PLATINUM SERIES MU-2 mark or the goods on which they are used. Based on its naked licensing, Applicant has abandoned any ownership rights it had in the PLATINUM SERIES mark.

15. ~~44.~~ Accordingly, for each and every reason stated above, Opposer believes that it will be damaged by the registration of Applicant's PLATINUM SERIES mark and opposes registration of Applicant's PLATINUM SERIES mark in the Application.

WHEREFORE, Opposer prays that this opposition be sustained and that the registration of Applicant's PLATINUM SERIES mark in the Application be refused.

~~Opposer requests that the Board charge Deposit Account No. 50-3563 for the filing fee of \$300 under 37 C.F.R. § 2.6(a)(17) and any additional fees as necessary.~~

~~September 28, 2015~~

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON, LLP

Dated: January 13, 2016

By: /s/ Paul A. Bost
Paul A. Bost

~~By: /Edwin~~
~~Komen/~~

~~EDWIN KOMEN
SUSAN HWANG
PAUL BOST~~

Attorneys for Opposer and Petitioner
Concorde Battery Corporation
~~CONCORDE BATTERY CORPORATION~~

~~Sheppard Mullin Richter & Hampton LLP
2099 Pennsylvania Avenue, NW, Suite 100
Washington, DC 20006-6804
Tel.: (202) 747-1900~~

CERTIFICATE OF TRANSMISSION**ELECTRONIC FILING**

I hereby certify that this ~~Notice of Opposition~~**OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED NOTICE OF OPPOSITION** is being ~~transmitted~~**submitted** electronically ~~through the ESTTA Filing System to the United States Patent and Trademark Office on this day, September 28, 2015~~**to the Commissioner for Trademarks, Trademark Trial and Appeals, through ESTTA, on this 13th day of January, 2016.**

/s/Lynne Thompson
Lynne Thompson

~~/Susan Hwang/~~
~~Susan Hwang~~

CERTIFICATE OF SERVICE

I hereby certify that ~~this Notice of Opposition~~**a copy of the foregoing OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED NOTICE OF OPPOSITION** is being deposited ~~with the United States Postal Service, postage prepaid,~~**as** first class mail, ~~postage prepaid,~~**in an envelope addressed to applicant, on this day, September 28, 2015:**

Charles C. Stebbins, III
Mitchell B. Snyder
WARLICK, STEBBINS, MURRAY & CHEW, LLP
P.O. Box 1495
Augusta, GA 30903-1495

on this 13th day of January, 2016.

/s/Lynne Thompson
Lynne Thompson

~~Air 1st Aviation Companies Inc.~~

~~234 Air Park Blvd~~

~~Aiken, South Carolina 29805-8924~~

SMRH:224433100.1

~~/Betty I. Rodriguez/~~
~~Betty I. Rodriguez~~

Summary report:	
Litéra® Change-Pro TDC 7.5.0.145 Document comparison done on 1/12/2016 5:54:42 PM	
Style name: SMRH Standard	
Intelligent Table Comparison: Active	
Original DMS: iw://DMS_PHX/EAST/204217829/3	
Modified DMS: iw://DMS_PHX/EAST/224433100/1	
Changes:	
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Delete	47
Move From	0
Move To	0
Table Insert	4
Table Delete	5
Table moves to	0
Table moves from	0
Embedded Graphics (Visio, ChemDraw, Images etc.)	0
Embedded Excel	0
Format changes	0
Total Changes:	97

EXHIBIT E

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

<p><u>In re Matter of Application Ser. No. 86/497,484 for the mark: PLATINUM SERIES</u></p> <p>Concorde Battery Corporation,</p> <p>Petitioner <u>Opposer,</u></p> <p>✓ <u>vs.</u></p> <p>Air 1st Aviation Companies, Inc. AKA Air 1st Corporation,</p> <p>Registrant.</p> <hr/> <p><u>Applicant.</u></p>	<p>Cancellation No. _____</p> <p>Reg. Opposition No. 4,726,130 91-224081 (parent)</p> <p>Registered: April 28, 2015</p> <p>Mark: PLATINUM SERIES MU-2</p> <p><u>OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED PETITION FOR CANCELLATION</u></p>
<p><u>In re Matter of Reg. No. 4,726,130 for the mark: PLATINUM SERIES MU-2</u></p> <p><u>Concorde Battery Corporation,</u></p> <p><u>Petitioner,</u></p> <p><u>vs.</u></p> <p><u>Air 1st Aviation Companies, Inc. and Mitsubishi Heavy Industries America, Inc.,</u></p> <p><u>Registrants.</u></p>	<p><u>Cancellation No. 92-062356</u></p>

PETITION FOR CANCELLATION

~~Commissioner for Trademarks
P.O. Box 1451~~

~~Alexandria, VA 22313-1451~~

Madam:

Petitioner, Concorde Battery Corporation, a corporation organized and existing under the laws of the State of California, having a place of business at 2009 San Bernardino Road, West Covina, California 97190 (“Petitioner”), believes that it will be damaged by the existence on the Principal Register of the mark PLATINUM SERIES MU-2 for “refurbished airplanes” in International Class 12, as shown in Registration No. 4,726,130 (the “Registration”), registered on April 28, 2015 ~~by Registrant, Air 1st Aviation Companies, Inc. AKA Air 1st Corporation, a corporation organized and existing under the laws of the State of Georgia, having an address at 234 Air Park Blvd, Aiken, South Carolina 29805 (“Registrant”)~~, and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner alleges that:

1. Petitioner is engaged, among other things, in the business of manufacturing and selling aircraft batteries under its mark PLATINUM SERIES.
2. Petitioner is the owner of U.S. Registration No. 2,734,038 for the mark PLATINUM SERIES, registered on July 8, 2003 in connection with “aircraft batteries” in International Class 9.
3. Petitioner’s Registration No. 2,734,038 is valid, subsisting and in full force and effect. Petitioner’s registration is incontestable pursuant to 15 U.S.C. § 1065, and thus serves as conclusive evidence of the validity of Petitioner Concorde Battery’s PLATINUM SERIES mark, pursuant to 15 U.S.C. § 1115(b).

4. Petitioner has been using the PLATINUM SERIES mark continuously in commerce, throughout the United States, for the recited goods in International Class 9 since at least as early as December 21, 2001 and intends to continue so using the PLATINUM SERIES mark in the future. A true, correct, and current printout of the TESS page reflecting Petitioner's Registration No. 2,734,038 is attached hereto as **Exhibit A**. Petitioner uses the mark PLATINUM SERIES by applying it in ways customary in the trade.

5. On October 11, 2013, ~~Registrant~~ Air 1st Aviation Companies, Inc. ("Air 1st") filed an application, Serial No. 86/089,204, with the U.S. Patent and Trademark Office to register PLATINUM SERIES MU-2 in connection with "refurbished airplanes" in International Class 12. The application alleges a date of first use anywhere and in commerce of August 21, 2012.

6. On March 1, 2015, Air 1st purported to assign all of its entire right, title, and interest in the PLATINUM SERIES MU-2 mark, and the goodwill related thereto, to Mitsubishi Heavy Industries America, Inc. ("Mitsubishi"), including its rights and interest in the PLATINUM SERIES MU-2 application. A true and correct copy of the Assignment as recorded with the U.S. Patent & Trademark Office on or around October 16, 2015 is attached hereto as **Exhibit B**.

7. ~~6. Registrant Air 1st's~~ This application, Serial No. 86/089,204 matured into the Registration on April 28, 2015.

First Ground for Opposition: Likelihood of Confusion

8. ~~7.~~ Petitioner, through the use of its PLATINUM SERIES mark, from a time prior to ~~Registrant's~~ the filing of the application underlying the Registration or the alleged date of first use ~~in commerce or the filing of its application underlying the~~

~~Registration~~therein, and by virtue of the quality of Petitioner's goods, has built up a valuable goodwill and reputation in connection with its PLATINUM SERIES mark.

~~1ST GROUND FOR CANCELLATION – LIKELIHOOD OF CONFUSION~~

~~9.~~ ~~8. Registrant's~~The mark PLATINUM SERIES MU-2 is similar in appearance, sound, connotation, and commercial impression to Petitioner's PLATINUM SERIES mark.

~~9. The MU-2 component of Registrant's mark PLATINUM SERIES MU-2 mark does not distinguish Registrant's mark from Petitioner's PLATINUM SERIES mark because MU-2 refers to a type of airplane and, thus, is weak, if not descriptive of the goods offered by Registrant under its mark, and is not proprietary to Registrant.~~

10. ~~Registrant's~~The goods identified in the Registration and Petitioner's goods offered under ~~their respective marks~~the PLATINUM SERIES mark are related.

11. Petitioner believes that it will be damaged by the continued registration of ~~Registrant's mark~~ PLATINUM SERIES MU-2 and petitions to cancel the Registration because Registrant's registration and use of its mark PLATINUM SERIES MU-2 in connection with the goods set forth in the Registration is likely to cause confusion, to cause mistake, and to deceive customers, potential customers and others, pursuant to 15 U.S.C. § 1052(d), thereby injuring Petitioner and the consuming public and jeopardizing the valuable goodwill and reputation Petitioner has built up in connection with its PLATINUM SERIES mark.

~~2nd GROUND FOR CANCELLATION – FAILURE TO USE AS A TRADEMARK~~

Second Ground for Opposition: Failure to Use as a Trademark

12. ~~Registrant~~Air 1st failed to demonstrate valid use in commerce of the registered mark PLATINUM SERIES MU-2 in connection with the recited goods because each specimen submitted to the U.S. Patent ~~and~~& Trademark Office failed to demonstrate use of the mark PLATINUM SERIES MU-2 “on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale.” 15 U.S. Code § 1127.

13. On information and belief, ~~Registrant~~Air 1st did not make valid use of the ~~registered~~ mark PLATINUM SERIES MU-2 in connection with the recited goods prior to or at the time of the filing of the application underlying the Registration.

Third Ground for Opposition: Lack of Ownership

14. Although Air 1st purports to have assigned its entire right, title, and interest in the PLATINUM SERIES MU-2 mark to Mitsubishi on March 1, 2015, Air 1st claims to have retained its entire right, title, and interest in the PLATINUM SERIES mark, and related application, Ser. No. 86/497,484, which seeks registration of the PLATINUM SERIES mark for “refurbished airplanes” in International Class 12.

15. Air 1st’s assignment to Mitsubishi is an invalid naked assignment. It did not include all of Air 1st’s purported goodwill in the PLATINUM SERIES MU-2 mark because Air 1st retained all right, title, and interest in the PLATINUM SERIES mark. Because the

assignment is invalid as naked, Mitsubishi is not the owner of the PLATINUM SERIES MU-2 mark.

16. Air 1st's purported assignment of rights to Mitsubishi is, in fact, a license to Mitsubishi to use the PLATINUM SERIES mark with Mitsubishi's MU-2 mark. Consequently, Mitsubishi is not the owner of the PLATINUM SERIES MU-2 mark, but a licensee.

17. ~~44.~~ Accordingly, for each and every reason stated above, Petitioner believes that it will be damaged by the continued registration of ~~Registrant's~~the PLATINUM SERIES MU-2 mark and petitions to cancel the Registration.

WHEREFORE, Petitioner prays that this petition for cancellation be sustained and that the Registration be canceled. ~~Petitioner requests that the Board charge Deposit Account No. 50-3563 for the filing fee of \$300 under 37 C.F.R. § 2.6(a)(17) and any additional fees as necessary.~~

September 28, 2015

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON, LLP

Dated: January 13, 2016

By: /s/Paul A. Bost

Paul A. Bost

By: ~~/Edwin Komen/~~

~~EDWIN KOMEN
SUSAN HWANG
PAUL BOST~~

Attorneys for Opposer and Petitioner

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CERTIFICATE OF ~~TRANSMISSION~~ELECTRONIC FILING

I hereby certify that this ~~Petition for Cancellation~~**OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED PETITION FOR CANCELLATION** is being ~~transmitted~~**submitted** electronically ~~through the ESTTA Filing System to the United States Patent and Trademark Office on this day, September 28, 2015~~**to the Commissioner for Trademarks, Trademark Trial and Appeals, through ESTTA, on this 13th day of January, 2016.**

/s/Lynne Thompson
Lynne Thompson

~~/Susan Hwang/~~
~~Susan Hwang~~

CERTIFICATE OF SERVICE

I hereby certify that ~~this Petition for Cancellation~~**a copy of the foregoing OPPOSER CONCORDE BATTERY CORPORATION'S FIRST AMENDED PETITION FOR CANCELLATION** is being deposited ~~with the United States Postal Service, postage prepaid,~~**as** first class mail, ~~postage prepaid,~~**in an envelope addressed to Registrant, on this day, September 28, 2015:**

Charles C. Stebbins, III
Mitchell B. Snyder
WARLICK, STEBBINS, MURRAY & CHEW, LLP
P.O. Box 1495
Augusta, GA 30903-1495

on this 13th day of January, 2016.

/s/Lynne Thompson
Lynne Thompson

~~Air 1st Aviation Companies Inc.~~

~~234 Air Park Blvd~~

~~Aiken, South Carolina 29805-8921~~

[SMRH:224433101.1](#)

~~/Betty I. Rodriguez/~~
~~Betty I. Rodriguez~~

Summary report: Litéra® Change-Pro TDC 7.5.0.145 Document comparison done on 1/12/2016 5:56:58 PM	
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Intelligent Table Comparison: Active	
Original DMS: iw://DMS_PHX/EAST/204219829/6	
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Embedded Excel	0
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