

ESTTA Tracking number: **ESTTA394913**

Filing date: **02/24/2011**

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

Proceeding	77667022
Applicant	Computerized Security Systems, Inc.
Correspondence Address	ERIC P STEVENS POYNER SPRUILL LLP 301 FAYETTEVILLE STREET SUITE 1900 RALEIGH, NC 27601-2173 UNITED STATES estevens@poynerspruill.com
Submission	Applicants Request for Remand and Amendment
Attachments	quantum -- remand motion.pdf (3 pages)(155501 bytes) Quantum Consent Letter.pdf (2 pages)(601666 bytes)
Filer's Name	Eric Stevens
Filer's e-mail	estevens@poyners.com
Signature	/Eric Stevens/
Date	02/24/2011

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

Applicant: Computerized Security Systems, Inc.)
Mark: QUANTUM) Trademark Law Office 106
Serial No.: 77667022) Trademark Attorney
Filed: February 10, 2009) Edward Nelson

**Motion to Extend Suspension of Proceedings and
Remand to Examining Attorney for Consideration of Consent Letter**

NOW COMES Applicant Computerized Security Systems, Inc. and moves the Board pursuant to 37 CFR § 2.142(d) (1) to remand this application to the Examining Attorney for consideration of the Letter of Consent that the Applicant has entered into with the prior registrant, Intellikey Corporation and (2) to extend the temporary suspension of the proceedings in this matter until the Examining Attorney’s reconsideration of his Section 2(d) refusal to register the mark is complete.

On November 24, 2010, the Applicant moved the Board to suspend proceedings in the above-captioned matter until February 1, 2011 due to negotiations that were taking place with Intellikey Corporation. This motion was granted on November 29, 2010. The Board stated that the Applicant should provide a “progress report about the status of its negotiations with the owner of the cited registration” no later than February 1, 2011. On January 31, 2011, the Applicant moved for an extension of the suspension, indicating that it was in the final stages of negotiating a consent arrangement with Intellikey.

Negotiations with Intellikey are now complete, and Intellikey has executed a “Letter of Consent for U.S. Trademark Application Serial Number 77667022” dated February 14, 2011 (the “Consent Letter,” a copy of which is being filed with this motion). Pursuant to the Consent

Letter, Intellikey has confirmed that: Intellikey and the Applicant have entered into a concurrent use arrangement; pursuant to the arrangement both parties' respective uses of the QUANTUM mark have been restrained in a manner that eliminates any potential for consumer confusion; and the concurrent use and registration of the QUANTUM mark by both Intellikey and the Applicant in accordance with the limitations to which the parties have agreed will not create a likelihood of consumer confusion. Agreements like the Consent Letter are entitled to great weight in making a likelihood of confusion determination, *see Bongrain Intern. (American) Corp. v. Delice de France, Inc.*, 811 F.2d 1479 (Fed. Cir. 1987), and Applicant respectfully submits that remand is appropriate to allow the Examiner to consider whether to reverse the Section 2(d) refusal to register the Mark in light of the execution and submission of the Consent Letter.

WHEREFORE, the Applicant prays that the Board will (1) remand the application to the Examining Attorney for reconsideration of the 2(d) refusal in light of new evidence in the form of the Consent Letter and (2) extend the suspension of this proceeding until the Examining Attorney's reconsideration is complete.

Respectfully submitted, this the 24th day of February, 2011.

POYNER SPRUILL LLP

By: /s/ Eric P. Stevens

Eric P. Stevens
N.C. State Bar No. 17609
John W. O'Hale
N.C. State Bar No. 35895
301 Fayetteville St., Suite 1900
Raleigh, NC 27601
Phone: (919) 783-6400
Fax:: (919) 783-1075

Attorneys for
Computerized Security Systems, Inc.

Letter of Consent for U.S. Trademark Application
Serial No. 77667022

Intellikey Corporation, 4325 Woodland Park Dr. Suite 102, W. Melbourne, Florida, 32904, hereinafter referred to as "INTELLIKEY," hereby provides its consent for Computerized Security Systems, Inc., 31750 Sherman Avenue, Madison Heights, Michigan, U.S., hereinafter referred to as "SAFLOK," to register the mark QUANTUM (U.S. Federal Application Ser. No. 77667022) for use in connection with "electronic door locks" on the register of the U.S. Patent and Trademark Office under the terms and conditions set forth herein.

INTELLKEY is the owner of United States federal registration number 2083073 for the trademark "QUANTUM" (hereinafter the "Intellikey Mark") covering goods described as "computer software to control and drive a stand alone lock and key hardware system" (the "Intellikey Goods"), and INTELLIKEY claims commercial use of the Intellikey Mark in connection with the Intellikey Goods since 1994.

SAFLOK is the owner of United States pending federal application serial number 77667022 for the trademark "QUANTUM" (hereinafter the "Saflok Mark"), covering goods described as "electronic door locks" (the "Saflok Goods"), and SAFLOK claims commercial use of the Saflok Mark in connection with the Saflok Goods since 2007.

It appears to INTELLIKEY that the parties have both, through concurrent use in commerce, become simultaneously entitled to use their respective marks in connection with their respective goods, and that due to differences in the products and the markets for the products and due to the sophistication of customers for the parties' respective products, the parties can continue their concurrent use of the respective marks in a manner that will not lead to a likelihood of consumer confusion, deception, or mistake; and

Though both parties have continuously used the mark QUANTUM in interstate commerce in connection with their respective goods since 2007, neither party is aware of any actual or alleged consumer confusion between the two marks.

In order to eliminate any risk of confusion, the parties have agreed to further restrictions on their respective uses of the QUANTUM mark as follows:

- (a) SAFLOK shall have the worldwide right - which shall not be challenged by INTELLIKEY - to use the Saflok Mark in connection with the marketing and sale of the Saflok Goods to customers in the Hospitality Market. For purposes of this Agreement, the "Hospitality Market" shall mean hotels, motels, inns, multi-housing, military housing, and other businesses that provide short-term lodging. SAFLOK shall not have the right to use the Saflok Mark in connection with the marketing or sale of any software program to control and drive a stand alone lock and key hardware system or in connection with any

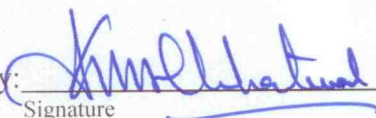
other software product (except that SAFLOK may sell electronic door locks under the Saflok Mark regardless of whether the products contain embedded software or firmware).

- (b) INTELLIKEY shall have the worldwide right - which shall not be challenged by SAFLOK - to use the Intellikey Mark in connection with the marketing and sale of the Intellikey Goods. INTELLIKEY shall not have the right to use the Intellikey Mark as a trademark for electronic door hardware or other lock and key systems apart from use in connection with the Intellikey Goods. INTELLIKEY and SAFLOK agree to take all reasonable steps to continue to avoid any confusion between the parties in connection with the use of the mark QUANTUM on their respective goods.

The parties have agreed that there will be no likelihood of confusion as a result of the contemporaneous use of these marks in accordance with the limitations set forth above. The parties are satisfied that their respective trademarks are sufficiently different that confusion is unlikely to occur so long as the parties comply with the limitations set forth herein.

The parties have agreed to continue to take steps to avoid any consumer confusion. The parties have further agreed to notify each other of any alleged or actual confusion and will cooperate to eliminate or minimize any such confusion.

Intellikey Corporation

By: 
Signature

February 14, 2011
Date

Singh Chhatwal
Printed Name

General Manager/Officer
Position/title