

TTAB

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

In the matter of Application Serial No: 76/081,580
by Digitronics Inventioning Corp. for the Mark: **SITETRAK**
Filed: June 30, 2000

Published in the Official Gazette
at page TM 299 on May 28, 2002

U.S. Patent & TMOtc/TM Mail Rcpt. Dt. #57

09-24-2002

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TMAPP DIVISION AND

Liebert Corporation

Opposer,

v.

Digitronics Inventioning Corp.

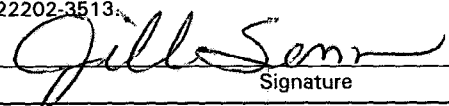
Applicant.

Opposition No. _____

BOX TTAB - FEE

Commissioner of Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Madam:

EXPRESS MAIL MAILING LABEL	
NUMBER:	<u>EL 231814320 US</u>
DATE OF DEPOSIT	<u>9/24/02</u>
I hereby certify that this paper or fee is being deposited with the United States Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to: BOX TTAB - FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.	
	
Signature	

NOTICE OF OPPOSITION

Opposer, Liebert Corporation ("Liebert") a corporation organized and existing under the laws of the State of Ohio, having its principal place of business at 9650 Jeronimo Road, Irvine, California 92718, believes that it will be damaged by registration of the mark shown in Application Serial No. 76/081,580 in International Class 9, which was filed on June 30, 2000 and hereby opposes the same.

10/18/2002 MPETTY 00000141 012508 76081580
01 FC:6402 300.00 CH

As grounds of opposition, it is alleged that:

1. Liebert is the owner of U.S. Registration No. 1,394,704 for the mark **SITESCAN** for “computer based facilities management system comprising computer programs and electronic monitors and controllers for use in monitoring and controlling power protection, environmental control, fire and water detection, security protection and computer support equipment,” in International Class 9. A copy of that registration is attached hereto as **EXHIBIT A**. This registration is valid and subsisting and Liebert’s right to use the mark is incontestable under Section 15 of the Trademark Statute (15 U.S.C. § 1065).

2. Liebert adopted and began using the mark **SITESCAN** in commerce which may be lawfully regulated by Congress at least as early as 1984, on and in connection with its products and has continuously used the **SITESCAN** mark from that time until the present on and in connection with such products.

3. Liebert is the owner of U.S. Registration No. 1,278,765 for the mark “**SITEMASTER**” for “monitors for providing readout and analysis of electrical power supplies,” in International Class 9. A copy of the certificate of registration for this mark is attached hereto as **EXHIBIT B**. This registration is valid and subsisting and Liebert’s right to use the mark is incontestable under Section 15 of the Trademark Statute. Liebert adopted and began using this mark in commerce which may be lawfully regulated by Congress at least as early as July 1982, on and in connection with its monitoring products and has continuously used the **SITEMASTER** mark from that time until the present on and in connection with such products.

4. Liebert is the owner of U.S. Registration No. 1,933,970 for the mark **SITENET** for “computer programs and circuit modules for monitoring uninterruptible power supplies,” in International Class 9. A copy of the certificate of registration for this mark is attached hereto as

EXHIBIT C. This registration is valid and subsisting and Liebert's right to use the mark is incontestable under Section 15 of the Trademark Statute. Liebert adopted and began using this mark in commerce which may lawfully be regulated by Congress at least as early as March 1995, on and in connection with its computer products and has continuously used the **SITENET** mark from that time until the present on and in connection with such products.

5. Liebert is also the owner of U.S. Application Serial No. 76/194,376 for the mark **SITELINK** covering "uninterruptible power supplies," in International Class 9. The application was filed on January 16, 2001 and a Notice of Allowance was mailed on November 13, 2001. The application is currently pending.

6. Liebert is also the owner of U.S. Application Serial No. 75/484,645 for the word mark **SITENET ENERGY MANAGER** covering "software for controlling power consumption during electrical line power outages when and uninterruptible power supply supplies power," in International Class 9. The application was filed on May 13, 1998 and is currently pending.

7. Liebert has expended considerable effort and expense in promoting the **SITESCAN**, **SITEMASTER** and **SITENET** marks and the products offered under those marks with the result that the purchasing public has come to know, rely upon, and recognize the products of Liebert by such marks. Liebert has established valuable goodwill in its **SITESCAN**, **SITEMASTER** and **SITENET** marks. As a result of Liebert's long usage and promotion of its **SITESCAN** and **SITEMASTER** marks, those marks are now famous.

8. Digitronics Inventioneering Corp. ("Applicant") seeks to register the mark **SITETRAK** for "industrial monitoring devices, namely, remote terminal units, remote terminal industrial controllers, electronic devices placed at remote locations to perform monitoring and control functions used for reporting real-time conditions by telephone modem or other electronic

means, providing alarms, and collecting and storing data,” in International Class 9. The alleged date of first use of the mark **SITETRAK** is February 23, 2001. In contrast, Liebert’s use of its **SITEMASTER** mark commenced at least as early as 1982 and its use of its **SITESCAN** mark commenced at least as early as 1984, and such use has been continuous and has not been abandoned. On information and belief, Applicant and Liebert’s goods are, or would be, marketed and sold in the same trade channels.

9. The mark that Applicant seeks to register so resembles Liebert’s **SITESCAN**, **SITEMASTER** and **SITENET** marks as to be likely, when used on or in connection with Applicant’s goods, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the goods of Applicant offered under the mark **SITETRAK** are sponsored, endorsed, or approved by Liebert, or are in some way affiliated, connected, or associated with Liebert. Registration should therefore be refused under 15 U.S.C. § 1052(d).

10. Registration of the mark **SITETRAK** would be a source of damage to Liebert because purchasers are likely to attribute the source or sponsorship of Applicant’s goods to Liebert.

11. Registration of the mark **SITETRAK** would be a further source of damage to Liebert, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of Liebert’s long prior use and registration of its **SITESCAN** mark.

12. On May 28, 2002, the application for **SITETRAK** was published for opposition in the Official Gazette. The deadline to file an opposition against this application has been extended to September 25, 2002. Accordingly, this Notice of Opposition is timely filed.

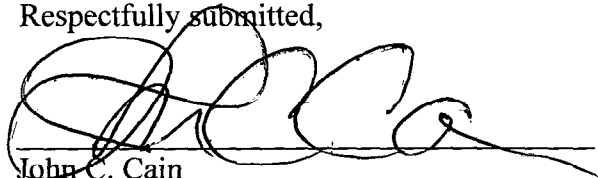
WHEREFORE, Liebert prays that Application Serial No. 76/081,580 be rejected, and that registration of the mark therein be refused.

A duplicate copy of this Opposition as required in 37 C.F.R. § 2.104 is enclosed herewith.

The Commissioner is authorized to draw on Deposit Account No. 01-2508, Ref. 11564.0071.000000 for the \$200.00 filing fee as required in 37 C.F.R. § 2.6(a)(17). Please return the enclosed postcard to evidence receipt of this Notice of Opposition.

Dated: 24th SEPTEMBER 2002

Respectfully submitted,



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ATTORNEYS FOR OPPOSER,
LIEBERT CORPORATION

Int. Cl.: 9

Prior U.S. Cls.: 26 and 38

United States Patent and Trademark Office **Reg. No. 1,394,704**
Registered May 27, 1986

**TRADEMARK
PRINCIPAL REGISTER**

SITESCAN

**LIBERT CORPORATION (OHIO CORPORATION)
1050 DEARBORN DRIVE
COLUMBUS, OH 43229**

FOR: COMPUTER BASED FACILITIES MANAGEMENT SYSTEM COMPRISING COMPUTER PROGRAMS AND ELECTRONIC MONITORS AND CONTROLLERS FOR USE IN MONITORING AND CONTROLLING POWER PROTECTION, ENVIRONMENTAL CONTROL

FIRE AND WATER DETECTION, SECURITY PROTECTION AND COMPUTER SUPPORT EQUIPMENT, IN CLASS 9 (U.S. CLS. 26 AND 38).

FIRST USE 10-16-1984; IN COMMERCE 10-16-1984.

SER. NO. 536,961, FILED 3-9-1985.

BARRY SOLOMON, EXAMINING ATTORNEY

Int. Cl.: 9

Prior U.S. Cl.: 26

United States Patent and Trademark Office

Reg. No. 1,278,765
Registered May 22, 1984

TRADEMARK
Principal Register

SITEMASTER

Liebert Corporation (Ohio corporation)
1050 Dearborn Dr.
Columbus, Ohio 43229

**For: MONITORS FOR PROVIDING READ-
OUT AND ANALYSIS OF ELECTRICAL POW-
ER SUPPLIES, in CLASS 9 (U.S. Cl. 26).**
First use Jul. 1982; in commerce Jul. 1982.

Ser. No. 420,672, filed Apr. 8, 1983.

LAURA ELLEN DAVIS, Examining Attorney

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

United States Patent and Trademark Office

Reg. No. 1,933,970

Registered Nov. 7, 1995

**TRADEMARK
PRINCIPAL REGISTER**

SITENET

LIEBERT CORPORATION (OHIO CORPORATION)
1050 DEARBORN DRIVE
COLUMBUS, OH 43229

TERRUPTIBLE POWER SUPPLIES, IN CLASS 9
(U.S. CLS. 21, 23, 26, 36 AND 38).
FIRST USE 3-7-1995; IN COMMERCE
3-7-1995.

FOR: COMPUTER PROGRAMS AND CIRCUIT
MODULES FOR MONITORING UNIN-

SN 74-474,478, FILED 12-23-1993.
LORI SCHULMAN, EXAMINING ATTORNEY