

ESTTA Tracking number: **ESTTA235897**

Filing date: **09/10/2008**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	The Chamberlain Group, Inc.
Granted to Date of previous extension	09/10/2008
Address	845 Larch Avenue Elmhurst, IL 60126-1196 UNITED STATES

Attorney information	Joseph T. Nabor Fitch, Even, Tabin & Flannery 120 South LaSalle, Suite 1600 Chicago, IL 60603 UNITED STATES trademark@fitcheven.com Phone:312-577-7000
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Applicant Information

Application No	77348726	Publication date	05/13/2008
Opposition Filing Date	09/10/2008	Opposition Period Ends	09/10/2008
Applicant	Master Lock Comapny LLC P.O. Box 927 137 W. Forest Hill Avenue Oak Creek, WI 53154 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Electronic security devices, namely, biometric detection devices, proximity detection devices, motion detection devices, infrared controlled locks, radio frequency controlled locks, electronic door locks, electronic padlocks and electronic security locks

Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	863447	Application Date	06/21/1967
Registration Date	01/14/1969	Foreign Priority Date	NONE

Word Mark	LIFTMASTER
Design Mark	
Description of Mark	NONE
Goods/Services	Class U021 (International Class 009). First use: First Use: 1967/05/17 First Use In Commerce: 1967/05/17 RESIDENTIAL ELECTRICAL GARAGE DOOR CONTROLLERS

U.S. Registration No.	1401035	Application Date	11/26/1985
Registration Date	07/15/1986	Foreign Priority Date	NONE
Word Mark	GARAGE MASTER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1985/09/01 First Use In Commerce: 1985/10/21 ELECTRONIC GARAGE DOOR OPENERS		

U.S. Registration No.	1781236	Application Date	11/16/1992
Registration Date	07/13/1993	Foreign Priority Date	NONE
Word Mark	LIFT-MASTER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1967/05/17 First Use In Commerce: 1967/05/17 electric door openers and structural parts thereof		

U.S. Registration No.	2034080	Application Date	12/21/1993
Registration Date	01/28/1997	Foreign Priority Date	NONE
Word Mark	ACCESSMASTER		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1994/01/21 First Use In Commerce: 1994/01/21 radio receiver units, radio transmitter units, keypads card readers, control panels, and for controlling electronic door and gate openers, and parts therefor		

U.S. Registration No.	2724638	Application Date	09/22/1999
Registration Date	06/10/2003	Foreign Priority Date	NONE
Word Mark	LIFTMASTER		
Design Mark			
Description of Mark	NONE		

Goods/Services	<p>Class 007. First use: First Use: 1967/05/17 First Use In Commerce: 1967/05/17 Electric motors for doors, gates and shutters; Tubular electric motors for doors, gates and shutters; central vacuum system for residential use, comprised of central vacuum units, tubing and fittings</p> <p>Class 009. First use: First Use: 1967/05/17 First Use In Commerce: 1967/05/17 Remote control systems and components thereof-namely radio controls for garage and warehouse entrance doors or gates, automatic garage door openers, lights, motors, antennas, transmitters, receivers and controllers responding thereto and used in such systems; electrical safety equipment; namely, an electric eye for sensing obstructions and controlling doors; electronic security devices, namely, electronic controls for granting access and egress through doors or gates; radio receiver units, radio transmitter units, keypads and card readers; a centralized automated system comprising a programmable controller, power line carrier modules, and one or more control modules or control receptacles, for controlling audio equipment, lighting, and other appliances in a residence</p> <p>Class 037. First use: First Use: 1998/01/00 First Use In Commerce: 1998/01/00 Providing technical advice and information in the maintenance and repair in the field of garage door opener installation, remote control systems, electrical safety equipment electronic security systems centralized automation systems and central vacuum systems</p> <p>Class 042. First use: First Use: 1998/01/00 First Use In Commerce: 1998/01/00 Providing research and design services for other enterprises regarding consumer, industrial, military and construction projects in the field of garage door openers, remote control systems, rolling shutters, awnings, telephone access systems, intercoms, electrical safety equipment, electronic security, centralized automation systems, and central vacuum systems</p>
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Attachments	<p>75806471#TMSN.gif (1 page)(bytes) 93436 CGI v. Master Lock Company.pdf (9 pages)(402172 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	/Joseph T. Nabor/
Name	Joseph T. Nabor
Date	09/10/2008

5569-93436

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

The Chamberlain Group, Inc.,)

Opposer,)

v.)

Master Lock Company LLC,)

Applicant.)

Serial No.: 77/348,726)

Filed: December 11, 2007)

Mark: IMASTER)

Published: May 13, 2008)

NOTICE OF OPPOSITION

The Chamberlain Group, Inc., a Connecticut corporation, located and doing business at 845 Larch Avenue, Elmhurst, Illinois 60126-1196 ("Chamberlain"), believes that it will be damaged by registration of the IMASTER trademark Application No. 77/348,726, and hereby opposes the same on the following grounds:

COUNT I - TRADEMARK INFRINGEMENT

1. In Application Serial No. 77/348,726, Master Lock Company ("Applicant"), is seeking to obtain registration on the Principal Register for the mark IMASTER for use in connection with "Electronic security devices; namely, biometric detection devices, proximity detection devices, motion detection devices, infrared controlled locks, radio frequency controlled locks, electronic door locks, electronic padlocks and electronic security locks."

2. Since at least as early as May 17, 1967, Chamberlain adopted and began using the mark LIFTMASTER for use on overhead door operating systems which are and have been marketed in commerce throughout the United States.

3. On January 14, 1969, the United States Patent & Trademark Office registered on the Principal Register and issued, Registration No. 863,447 for the mark LIFTMASTER for use on residential electrical garage door controllers. Said Registration is presently valid and subsisting and is now owned by Chamberlain and is *prima facie* evidence of Chamberlain's exclusive right to use said mark in commerce on the goods. Said Registration is also incontestable under 15 U.S.C. § 1065.

4. On July 15, 1986, the United States Patent & Trademark Office registered on the Principal Register and issued, Registration No. 1,401,035 for the mark GARAGE MASTER for use on electronic garage door. Said Registration is presently valid and subsisting and is now owned by Chamberlain and is *prima facie* evidence of Chamberlain's exclusive right to use said mark in commerce on the goods. Said Registration is also incontestable under 15 U.S.C. § 1065. Chamberlain has made substantially continuous use in commerce of said mark on the said goods since at least as early as October 21, 1985.

5. On July 13, 1993, the United States Patent & Trademark Office registered on the Principal Register and issued, Registration No. 1,781,236 for the mark LIFT-MASTER for use on electrical door openers and structural parts thereof. Said Registration is presently valid and subsisting and is now owned by Chamberlain and is *prima facie* evidence of Chamberlain's exclusive right to use said mark in commerce on the goods. Said Registration is also incontestable under 15 U.S.C. § 1065. Chamberlain has made substantially continuous use in commerce of the said mark on the said goods since at least as early as May 17, 1967.

6. On January 28, 1997, the United States Patent & Trademark Office registered on the Principal Register and issued, Registration No. 2,034,080 for the mark ACCESSMASTER for use on radio receiver units, radio transmitter units, keypads card

readers, control panels, and for controlling electronic door and gate openers, and parts therefor. Said Registration is presently valid and subsisting and is now owned by Chamberlain and is *prima facie* evidence of Chamberlain's exclusive right to use said mark in commerce on the goods. Said Registration is also incontestable under 15 U.S.C. § 1065. Chamberlain has made substantially continuous use in commerce of the said mark on the said goods since at least as early as January 21, 1994.

7. On June 10, 2003, the United States Patent & Trademark Office registered on the Principal Register and issued, Registration No. 2,724,638 for the mark LIFTMASTER for use on in connection with "Electric motors for doors, gates and shutters; tubular electric motors for doors, gates and shutters; central vacuum system for residential use, comprised of central vacuum units, tubing and fittings; remote control systems and components thereof-namely radio controls for garage and warehouse entrance doors or gates, automatic garage door openers, lights, motors, antennas, transmitters, receivers and controllers responding thereto and used in such systems; electrical safety equipment; namely, an electric eye for sensing obstructions and controlling doors; electronic security devices, namely, electronic controls for granting access and egress through doors or gates; radio receiver units, radio transmitter units, keypads and card readers; a centralized automated system comprising a programmable controller, power line carrier modules, and one or more control modules or control receptacles, for controlling audio equipment, lighting, and other appliances in a residence; Providing technical advice and information in the maintenance and repair in the field of garage door opener installation, remote control systems, electrical safety equipment, electronic security systems and centralized automation systems; Providing research and design services for other enterprises regarding consumer, industrial, military and construction projects in the field of garage door openers, remote control systems, rolling shutters, awnings, telephone access systems, intercoms, electrical safety equipment, electronic security and centralized automation systems." Said Registration is

presently valid and subsisting and is now owned by Chamberlain and is *prima facie* evidence of Chamberlain's exclusive right to use said mark in commerce on the goods. Said Registration is also incontestable under 15 U.S.C. § 1065. Chamberlain has made substantially continuous use in commerce of the said mark on the said goods since at least as early as May 17, 1967.

8. Chamberlain is the owner of all right, title and interest in the following Federal trademark registrations:

MARK	REG. NO.	REG. DATE	GOODS
LIFTMASTER	863,447	January 14, 1969	Residential electrical garage door controllers
LIFT-MASTER	1,781,236	July 13, 1993	Electric door openers and structural parts thereof
ACCESSMASTER	2,034,080	January 28, 1997	Radio receiver units, radio transmitter units, keypads card readers, control panels, and for controlling electronic door and gate openers, and parts therefor
GARAGE MASTER	1,401,035	July 15, 1986	Electronic garage door openers
LIFTMASTER	2,724,638	June 10, 2003	Electric motors for doors, gates and shutters; tubular electric motors for doors, gates and shutters; central vacuum system for residential use, comprised of central vacuum units, tubing and fittings; remote control systems and components thereof-namely radio controls for garage and warehouse entrance doors or gates, automatic garage door openers, lights, motors, antennas, transmitters, receivers and controllers responding thereto and used in such systems; electrical safety equipment; namely, an electric eye for sensing obstructions and controlling doors; electronic security devices, namely, electronic controls for granting access and egress through doors or gates; radio receiver units, radio transmitter units, keypads and card readers; a centralized automated system comprising a programmable controller, power line carrier modules, and one or more control modules or control receptacles, for controlling audio equipment, lighting, and other appliances in a

			residence; Providing technical advice and information in the maintenance and repair in the field of garage door opener installation, remote control systems, electrical safety equipment, electronic security systems and centralized automation systems; Providing research and design services for other enterprises regarding consumer, industrial, military and construction projects in the field of garage door openers, remote control systems, rolling shutters, awnings, telephone access systems, intercoms, electrical safety equipment, electronic security and centralized automation systems
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Chamberlain's adoption and its manner of use of the above listed marks, constitute a MASTER family of marks.

9. Long prior to Applicant's intended adoption of the IMASTER mark for the goods specified in the subject application, Chamberlain was actively engaged in interstate and foreign commerce in the business of manufacturing, distributing, advertising and selling electronic door operating systems and related products bearing the aforesaid marks and the MASTER family of trademarks.

10. Chamberlain has expended millions of dollars in advertising and promoting its products, and has sold millions of dollars of products bearing the aforesaid marks and the MASTER family of trademarks in the United States and throughout the world.

11. On information and belief, Applicant has intended to adopt the IMASTER trademark for the goods specified in the subjection application with full knowledge of Chamberlain's famous aforesaid marks and its MASTER family of trademarks. Applicant has intended to use the trademark for those goods without the consent of Chamberlain with the intent to trade and capitalize on the goodwill generated by Chamberlain's extensive and exclusive use of its aforesaid marks and its MASTER family of trademarks.

12. Applicant's intended adoption, use, distribution, offer for sale, and sale of goods bearing the IMASTER mark for the goods specified in the subject application constitutes trademark infringement by causing confusion, mistake or deception as to the origin of the goods among the relevant consuming public. The public is likely to believe that Applicant's products originate with Chamberlain, are licensed by Chamberlain, or are sponsored, authorized, endorsed, or are otherwise related to Chamberlain.

13. On information and belief, the Applicant has not used the mark IMASTER in interstate commerce on the goods specified in the Application.

14. On information and belief, the earliest date of actual or constructive use for the goods specified in the subject application upon which the Applicant can rely is December 11, 2007, the filing date of Application Serial No. 77/348,726.

15. The goods for which Applicant seeks registration of the IMASTER trademark are similar to the goods which Chamberlain distributes bearing the aforesaid marks and its MASTER family of marks.

16. On information and belief the goods for which Applicant seeks registration of the IMASTER mark are likely to be sold to the same customers or channels of trade to which Chamberlain sells its goods bearing the aforesaid marks and its MASTER family of marks.

17. Applicant's trademark as applied to the goods specified in the subject application is confusingly similar to Chamberlain's aforesaid marks and its MASTER family of marks, and use thereof is likely to cause confusion, mistake or deception that Applicant's goods are those of Chamberlain's, or are otherwise endorsed, sponsored or approved by Chamberlain.

COUNT II - FEDERAL TRADEMARK DILUTION

18. Paragraphs 1-17 are incorporated by reference herein.

19. Chamberlain has expended substantial monies in marketing, advertising and promoting its aforesaid marks and its MASTER family of marks on its goods.

20. Chamberlain possesses extremely valuable goodwill in the aforesaid marks and its MASTER family of marks by reason of its extensive use, marketing, publicity, advertising and geographic extent of its use and promotion. This goodwill was established long prior to the filing of this Application Serial No. 77/348,726.

21. Chamberlain has sold goods bearing the aforesaid marks and its MASTER family of marks in excess of millions of dollars.

22. The aforesaid marks and its MASTER family of marks are famous and distinctive within the meaning of the Lanham Act, and are entitled to the protection of the anti-dilution provisions of the Lanham Act, including 15 U.S.C. § 1125(c).

23. Applicant filed the Application after the aforesaid marks and its MASTER family of marks became famous and distinctive.

24. Chamberlain has expended substantial monies in marketing, advertising and promoting the aforesaid marks and its MASTER family of marks.

25. If Applicant is granted registration of its IMASTER trademark, Applicant will obtain the *prima facie* exclusive right to use such mark for the goods specified in the subject application, and such registration will impair, diminish, and dilute Chamberlain's goodwill and rights in its aforesaid marks and its MASTER family of marks. Therefore, Chamberlain opposes registration of Applicant's IMASTER trademark for the goods specified in the subject application pursuant to 15 U.S.C. § 1052 and 1063(a), as amended by the Trademark Amendment Act of 1999, which permits opposition of trademark applications filed on or after January 16, 1996 on grounds of dilution.

PRAYER FOR RELIEF

WHEREFORE, Chamberlain prays that Application Serial No. 77/348,726 be rejected, and that registration of the IMASTER trademark for the goods specified therein be refused.

Respectfully submitted,

September 10, 2008

By:



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Attorney for Opposer

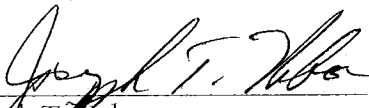
CERTIFICATE OF SERVICE

I, Joseph Nabor, Attorney for the Applicant, hereby certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail, postage prepaid, upon:

William A. Johnston
Calfee, Halter & Griswold LLP
800 superior Ave E Ste 1400
Cleveland, OH 44114-2617

September 10, 2008

By:



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