

ESTTA Tracking number: **ESTTA456347**

Filing date: **02/14/2012**

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    | Smartrac IP B.V.   |             |                 |
| Entity  | limited liability company                                | Citizenship | The Netherlands |
| Address | Parnassusweg 103<br>Amsterdam, NL-1077 DE<br>NETHERLANDS |             |                 |

|                      |   |
|----------------------|---|
| Attorney information | Dean R. Karau, Cynthia A. Moyer<br>Fredrikson & Byron, P.A.<br>200 South Sixth Street Suite 4000<br>Minneapolis, MN 55402-1425<br>UNITED STATES<br>ip@fredlaw.com, dkarau@fredlaw.com, cmoyer@fredlaw.com<br>Phone:6124927178 |
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**Applicant Information**

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 85391789  | Publication date       | 01/17/2012 |
| Opposition Filing Date | 02/14/2012  | Opposition Period Ends | 02/16/2012 |
| Applicant              | THE TRUSTESS OF CUBESMART<br>460 EAST SWEDES FORD ROAD SUITE 3000<br>WAYNE, PA 19087<br>UNITED STATES |                        |            |

**Goods/Services Affected by Opposition**


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| Class 009. First Use: 2011/06/00 First Use In Commerce: 2011/06/00<br>All goods and services in the class are opposed, namely: Computer software for tracking and monitoring personal belongings, furniture and other items during a move or while in storage; computer software for producing notifications and reports regarding shipments and deliveries of personal belongings, furniture and other items; computer software for monitoring the temperature in a storage unit; computer software for locating and reserving space in self-storage centers; computer software for use as bar code readers and bar code scanners |
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**Grounds for Opposition**

|                                      |                            |
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| Priority and likelihood of confusion | Trademark Act section 2(d) |
|--------------------------------------|----------------------------|

**Mark Cited by Opposer as Basis for Opposition**

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3302678    | Application Date      | 02/15/2005 |
| Registration Date     | 10/02/2007 | Foreign Priority Date | 08/17/2004 |

|                     |  |
|---------------------|--|
| Word Mark           | SMARTRAC   |
| Design Mark         |    |
| Description of Mark | NONE   |
| Goods/Services      | <p>Class 007. First use:<br/> Machines and machine tools for the electric, electronics and plastics industries, namely, adhesive tape dispensing machines, automatic stamping machines, cutting machines, electric welding machines, embossing machines and semiconductor manufacturing machines, except household and kitchen appliances; shaping machines, namely, punching and bending machines; mechanical tools for punching and bending machines, namely, belts, brakes, clutches, compressors, motors, filters, cylinders, blades, valves, wheels; machines for the packaging of integrated circuits, handling and assembly machines, in particular for the processing of microparts and for microbonding, fine-wire winding machines, in particular for manufacturing electric coils and for connecting electronic components to coils; components and assemblies for the aforesaid machines, in particular sensor, control and regulating devices, mainly consisting of sensors, processors, actuators and optional apparatus for image processing; * all the aforesaid products other than for the field of polyurethane, injection moulding and extrusion; all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animal *</p> <p>Class 009. First use:<br/> Blank magnetic data-carriers; cash registers, calculators, data processors and computers; electric and electronic components for computers, namely, micro-processors, microchips and hard disks; signal processors; computer chips; computer peripherals; blank optical and magneto-optical data carriers; blank transponder cards and blank chip cards; readers for transponder cards and chip cards; transponders in the form of contact or non-contact chip encoded cards with an integrated microchip for access systems, fare payment systems, identification applications and for airline ticket applications; transponders with an integrated encoded microchip for access systems, namely, electronic keys, for cashless payment systems and for customer acquisition and identification; transponders in the form of disc-type labels and tags with an integrated encoded microchip for parking systems, namely, tickets or transport tickets, for ski passes in the leisure industry, and for industrial applications; transponders in the form of adhesive laminate inlays with an integrated encoded microchip for use in access systems, for automatic fare-collection systems, for identification purposes and for airline tickets; transponders in the form of pre-embossed or pre-laminated encoded chip cards with an integrated microchip for use in the production of combination cards for access systems, automatic fare collection, identification systems, electronic money exchanges, cashless sales systems and portable database systems; transponders in the form of programmed microchips for implanting under the skin for identifying animals; transponders in the form of attachable signboards and tags with an integrated encoded microchip for identifying trees, telegraph poles and the like, and for use in the arts to identify works of arts, copies of original and restored works of art; transponders in the form of contact and non-contact paper labels and tags with an integrated encoded microchip for use in the management of supply chains, in production supervision, in luggage identification, for use with express parcel services and goods transport services, and for use in preventing fraud and the identification of</p> |

|  |  |
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|  | <p>works of art; transponders in the form of adhesive labels and tags with an integrated encoded microchip for identifying industrial gas cylinders; encoders and readers for bar codes, electronic cards and magnetic encoded cards; computer monitors and computer screens for all the aforesaid goods, software applications, namely, pre-recorded computer software for use in the field of radio frequency identification for operating the aforesaid goods; electronic passports and security documents, namely, blank electronic chip cards, blank integrated circuit card, electronic circuit cards, encoded electronic chip cards for identifying persons, objects or animals, encoded integrated circuit cards for identifying persons, objects or animals, encoded smart cards for identifying persons, objects or animals, magnetic cards and microchip cards; electronic labels containing programming for the processing, transmission and reception of data; electronic payment devices, namely, electronic and magnetic id cards for use in connection with payment for goods and services, and electronic payment terminals; all the afore-mentioned goods except laundry machine vending cards; * all the aforesaid products other than for the field of polyurethane, injection moulding and extrusion; all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animal *</p> <p>Class 017. First use:</p> <p>Semi-finished plastic products, namely, inlays for electronic passports, security-and identification-documents; plastics in the form of sheets and foils for use in the manufacture of electronic chip cards, integrated circuit cards, smart cards, magnetic cards and microchip cards for use as carrier material or substrate for electronic components; plastics in the form of sheets and foils for use in the manufacture of electronic chip cards, integrated circuit cards, smart cards, magnetic cards and microchip cards for use as carrier material or substrate for transponders; * all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animals; all the aforementioned products other than for the field of polyurethane, injection moulding and extrusion *</p> |
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| Attachments | 79015010#TMSN.jpeg ( 1 page )( bytes )<br>Notice of Opposition.pdf ( 6 pages )(27631 bytes ) |
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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 | /Dean R. Karau/ |
| Name      | Dean R. Karau   |
| Date      | 02/14/2012      |

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

In the Matter of

Trademark Serial No. 85391789

For the Mark: **SmartTrakr**®

Filed: August 8, 2011

Published: January 17, 2012

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Smartrac IP B.V. ,

Opposer,

Opposition No. \_\_\_\_\_

v.

The Trustees of Cubesmart, William M. Diefenderfer III,  
Dean Jernigan, Piero Bussani, Marianne M. Keler, David J. Larue,  
John F. Remondi, and Jeffrey Rogatz,

Applicant.

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**NOTICE OF OPPOSITION**

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This opposition is made to the application of Applicant, The Trustees of Cubesmart, William M. Diefenderfer III, Dean Jernigan, Piero Bussani, Marianne M. Keler, David J. Larue, John F. Remondi, and Jeffrey Rogatz, for registration of the mark **SmartTrakr**®, Application Serial No. 85391789, published on January 17, 2012. Opposer, Smartrac IP B.V., believes it will be damaged by the registration of the mark shown in the application, and hereby opposes the same. As grounds for its opposition, Opposer states and alleges as follows:

1. Opposer is a limited liability company organized under the laws of The Netherlands, with its principal place of business located at Parnassusweg 103, NL-1077 DE, Amsterdam, The Netherlands.

2. On information and belief, Applicant is a Real Estate Investment Trust organized under

the laws of Maryland, with its principal place of business located at 460 East Swedesford Road Suite 3000 Wayne Pennsylvania 19087.

3. Opposer has used its SMARTRAC trademark in connection with its wide variety of products and applications in many countries around the world. Opposer has used its SMARTRAC mark in U.S. commerce, continuously and exclusively, for years. In addition, Opposer is the owner of U.S. Registration No. 3302678 for the trademark SMARTRAC, registered on the Principal Register on October 2, 2007, based on an application filed on February 15, 2005, for a request of an extension of protection of International Registration No. 0861259, with a priority date of August 17, 2004. The mark in the registration is for the following goods:

IC 007: Machines and machine tools for the electric, electronics and plastics industries, namely, adhesive tape dispensing machines, automatic stamping machines, cutting machines, electric welding machines, embossing machines and semiconductor manufacturing machines, except household and kitchen appliances; shaping machines, namely, punching and bending machines; mechanical tools for punching and bending machines, namely, belts, brakes, clutches, compressors, motors, filters, cylinders, blades, valves, wheels; machines for the packaging of integrated circuits, handling and assembly machines, in particular for the processing of microparts and for microbonding, fine-wire winding machines, in particular for manufacturing electric coils and for connecting electronic components to coils; components and assemblies for the aforesaid machines, in particular sensor, control and regulating devices, mainly consisting of sensors, processors, actuators and optional apparatus for image processing; \* all the aforesaid products other than for the field of polyurethane, injection moulding and extrusion; all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animal \*

IC 009: Blank magnetic data-carriers; cash registers, calculators, data processors and computers; electric and electronic components for computers, namely, micro-processors, microchips and hard disks; signal processors; computer chips; computer peripherals; blank optical and magneto-optical data carriers; blank transponder cards and blank chip cards; readers for transponder cards and chip cards; transponders in the form of contact or non-contact chip encoded cards with an integrated microchip for access systems, fare payment systems, identification applications and for airline ticket applications; transponders with an integrated encoded microchip for access systems, namely, electronic keys, for cashless payment systems and for customer acquisition and identification; transponders in the form of disc-type labels and tags with an integrated encoded microchip for

parking systems, namely, tickets or transport tickets, for ski passes in the leisure industry, and for industrial applications; transponders in the form of adhesive laminate inlays with an integrated encoded microchip for use in access systems, for automatic fare-collection systems, for identification purposes and for airline tickets; transponders in the form of pre-embossed or prelaminated encoded chip cards with an integrated microchip for use in the production of combination cards for access systems, automatic fare collection, identification systems, electronic money exchanges, cashless sales systems and portable database systems; transponders in the form of programmed microchips for implanting under the skin for identifying animals. transponders in the form of attachable signboards and tags with an integrated encoded microchip for identifying trees, telegraph poles and the like, and for use in the arts to identify works of arts, copies of original and restored works of art; transponders in the form of contact and non-contact paper labels and tags with an integrated encoded microchip for use in the management of supply chains, in production supervision, in luggage identification, for use with express parcel services and goods transport services, and for use in preventing fraud and the identification of works of art; transponders in the form of adhesive labels and tags with an integrated encoded microchip for identifying industrial gas cylinders; encoders and readers for bar codes, electronic cards and magnetic encoded cards; computer monitors and computer screens for all the aforesaid goods, software applications, namely, pre-recorded computer software for use in the field of radio frequency identification for operating the aforesaid goods; electronic passports and security documents, namely, blank electronic chip cards, blank integrated circuit card, electronic circuit cards, encoded electronic chip cards for identifying persons, objects or animals, encoded integrated circuit cards for identifying persons, objects or animals, encoded smart cards for identifying persons, objects or animals, magnetic cards and microchip cards; electronic labels containing programming for the processing, transmission and reception of data; electronic payment devices, namely, electronic and magnetic id cards for use in connection with payment for goods and services, and electronic payment terminals. all the afore-mentioned goods except laundry machine vending cards; \* all the aforesaid products other than for the field of polyurethane, injection moulding and extrusion; all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animal \*

IC 017: Semi-finished plastic products, namely, inlays for electronic passports, security- and identification-documents; plastics in the form of sheets and foils for use in the manufacture of electronic chip cards, integrated circuit cards, smart cards, magnetic cards and microchip cards for use as carrier material or substrate for electronic components; plastics in the form of sheets and foils for use in the manufacture of electronic chip cards, integrated circuit cards, smart cards, magnetic cards and microchip cards for use as carrier material or substrate for transponders; \* all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animals \*

This registration, a copy of which is attached hereto, is valid and subsisting.

4. On August 8, 2011, Applicant filed an intent-to-use application to register the mark **SmartTrakr®**, Application Serial No. 85391789, and the mark was published for opposition for Class 009 goods described as computer software for tracking and monitoring personal belongings, furniture and other items during a move or while in storage; computer software for producing notifications and reports regarding shipments and deliveries of personal belongings, furniture and other items; computer software for monitoring the temperature in a storage unit; computer software for locating and reserving space in self-storage centers; computer software for use as bar code readers and bar code scanners.

5. Opposer's priority date for its SMARTRAC mark is long before any date of use or constructive date of use by Applicant of the mark **SmartTrakr®**.

6. Opposer has developed enormous and widespread goodwill through its use of its SMARTRAC mark. By reason of such advertising, promotion and widespread use, the consuming public recognizes the SMARTRAC mark and associates the SMARTRAC mark exclusively with Opposer and its goods.

7. Opposer's mark is inherently distinctive and is a strong mark and should be accorded the broad protection given to strong marks.

8. Use by Applicant of the trademark **SmartTrakr®** for which registration is sought in the application opposed herein is likely to cause confusion, mistake or deception as to the source of origin, sponsorship or approval of Applicant's goods in that purchasers or others are likely to believe that Applicant's goods are Opposer's goods, or are in some way legitimately connected with, licensed by, or approved by Opposer. Use by Applicant of the trademark **SmartTrakr®** for which registration is sought in the application opposed herein has lessened, and will continue to



**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the NOTICE OF OPPOSITION was served by United States mail on the correspondent of record for Applicant, Dana S. Gross, Morgan, Lewis & Bockius LLP, 1111 Pennsylvania Ave NW, Washington, DC 20004-2541, by mailing it to the address of record by first class mail, postage prepaid, this 14th day of February, 2012.

/Dean R. Karau/

Dean R. Karau

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