

ESTTA Tracking number: **ESTTA487752**

Filing date: **08/07/2012**

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	PNY Technologies, Inc.
Granted to Date of previous extension	08/08/2012
Address	100 Jefferson Road Parsippany, NJ 07054 UNITED STATES

Attorney information	Robert W. Smith, Esq. McCarter & English, LLP 100 Mulberry Street, 4 Gateway Center Newark, NJ 07102 UNITED STATES rsmith@mccarter.com, kknoll@mccarter.com Phone:973-622-4444
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Applicant Information

Application No	85423501	Publication date	04/10/2012
Opposition Filing Date	08/07/2012	Opposition Period Ends	08/08/2012
Applicant	Gradus Group LLC 420 Ninth Avenue New York, NY 10001 UNITED STATES		


Goods/Services Affected by Opposition


Class 009. All goods and services in the class are opposed, namely: Connecting devices for operating photographic equipment, namely, cable connectors, not for transferring, storing, and transporting electronic data between electronic storage devices; Audio cable connectors; Connectors for video cables; Connection plugs for audio and video cables; Connectors for video camera cables; Connecting sockets for audio cables and cables for composite video signals and component video signals; Connectors for video cables, and video cable sockets and plugs, used in the transmission of video signals in and to audio visual equipment, and not for transferring, storing, and transporting electronic data between electronic storage devices; all of the foregoing excluding use in transferring storing, and transporting electronic data between electronic storage devices

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.	3430852	Application Date	09/17/2007
Registration Date	05/20/2008	Foreign Priority Date	NONE
Word Mark	ATTACHÉ#		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/03/03 First Use In Commerce: 2003/05/00 Computer hardware for transferring, storing and transporting electronic data between electronic storage devices		

U.S. Registration No.	2944947	Application Date	03/05/2003
Registration Date	04/26/2005	Foreign Priority Date	NONE
Word Mark	ATTACHE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/03/03 First Use In Commerce: 2003/05/00 Computer hardware for transferring, storing and transporting electronic data between electronic storage devices		

U.S. Registration No.	3454566	Application Date	01/16/2007
Registration Date	06/24/2008	Foreign Priority Date	NONE
Word Mark	SECURE ATTACHÉ#		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2007/01/06 First Use In Commerce: 2007/03/14 Computer hardware for transferring, storing and transporting electronic data between electronic storage devices

Attachments	77281275#TMSN.jpeg (1 page)(bytes) 78221675#TMSN.gif (1 page)(bytes) 77084109#TMSN.jpeg (1 page)(bytes) Notice of Opposition 85423501 ATTACHE.pdf (16 pages)(481601 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	/Robert W. Smith/
Name	Robert W. Smith, Esq.
Date	08/07/2012

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

PNY TECHNOLOGIES, INC.,

Opposer,

-vs-

GRADUS GROUP, LLC,

Applicant.

Mark: ATTACHÉ
Serial No.: 85/423,501

NOTICE OF OPPOSITION

In the matter of the application of Gradus Group, LLC ("Applicant"), for the registration of ATTACHÉ, Application No. 85/423,501, published in the Official Gazette of April 10, 2012, PNY Technologies, Inc., a corporation of the State of Delaware with its principal place of business at 100 Jefferson Road, Parsippany, New Jersey 07054 ("Opposer"), believes it would be damaged by the registration of the mark shown in the above-referenced application and hereby opposes same under the provisions of Section 13 of the Trademark Act of July 5, 1946 (15 U.S.C. § 1063). The grounds for the opposition are:

1. Opposer is a corporation which has been engaged since at least as early as 1985 as a leading provider within the consumer electronics market for computer-related products, including but not limited to flash memory cards, USB flash drives, solid state drives, high speed cables, computer memory upgrade modules, consumer graphics cards, and professional graphics cards.

2. Opposer since at least as early as May 2003 has adopted and used throughout the United States marks consisting of or including the term "ATTACHÉ" (collectively, the "ATTACHÉ Marks") for computer hardware for transferring, storing and transporting electronic data between electronic storage devices ("Opposer's Goods"). Opposer owns the following U.S. registrations for its ATTACHÉ Marks:

MARK	REG. NO.	REG. DATE	GOODS/	CLASS
ATTACHÉ	3,430,852	May 20, 2008	Computer hardware for transferring, storing and transporting electronic data between electronic storage devices.	9
ATTACHÉ (Stylized)	2,944,947	April 26, 2005	Computer hardware for transferring, storing and transporting electronic data between electronic storage devices.	9
SECURE ATTACHÉ & Design	3,454,566	June 24, 2008	Computer hardware for transferring, storing and transporting electronic data between electronic storage devices.	9

Annexed as Exhibit A are copies of TARR printouts of the trademark registrations referenced above.

3. By reason of the long and extensive promotion, print and internet advertising, and provision of high-quality goods manufactured and distributed by Opposer in conjunction with the ATTACHÉ Marks, the public and the trade have come to recognize goods offered in conjunction with these marks as signifying Opposer and Opposer's Goods.

4. Notwithstanding Opposer's long prior rights in the ATTACHÉ Marks, Applicant filed an application, Serial No. 85/423,501, for registration of ATTACHÉ for "Connecting devices for

operating photographic equipment, namely, cable connectors, not for transferring, storing, and transporting electronic data between electronic storage devices; Audio cable connectors; Connectors for video cables; Connection plugs for audio and video cables; Connectors for video camera cables; Connecting sockets for audio cables and cables for composite video signals and component video signals; Connectors for video cables, and video cable sockets and plugs, used in the transmission of video signals in and to audio visual equipment, and not for transferring, storing, and transporting electronic data between electronic storage devices; all of the foregoing excluding use in transferring storing, and transporting electronic data between electronic storage devices,” in Class 9. Applicant’s ATTACHÉ mark was published for opposition in the Official Gazette on April 10, 2012.

5. There is no issue as to priority. Applicant’s intent to use filing date for its ATTACHÉ mark is September 15, 2011, long after the dates when Opposer first used and registered its ATTACHÉ Marks.

6. The trademark proposed for registration by the Applicant, ATTACHÉ, is identical to Opposer’s ATTACHÉ Marks, and is used on or in connection with goods closely related to those of Opposer and is likely to be confused therewith and mistaken therefor. The Applicant's mark is deceptively similar to Opposer’s ATTACHÉ Marks so as to cause confusion and lead to deception as to the origin of Applicant's goods bearing Applicant's ATTACHÉ mark.

7. If Applicant is permitted to use and register its ATTACHÉ mark for its goods in Class 9 as specified in the Application herein opposed, confusion in the trade resulting in damage and injury to Opposer would be caused and would result by reason of the similarity between the Applicant’s ATTACHÉ mark and the Opposer's ATTACHÉ Marks. Accordingly, consumers will associate Applicant’s goods with those of Opposer, and think that such goods are provided

or endorsed by, or otherwise affiliated with, Opposer.

8. If Applicant were granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its ATTACHÉ mark. Such registration would be a source of damage and injury to Opposer.

9. Through Opposer's extensive advertisement and promotion and substantial sales, Opposer's ATTACHÉ Marks have become famous.

10. Upon information and belief, any use by Applicant of Applicant's ATTACHÉ Mark has occurred many years after Opposer's ATTACHÉ Marks became famous.

11. Applicant's registration and/or use of Applicant's ATTACHÉ Mark is likely to blur or tarnish the positive associations among consumers and the trade of Opposer's ATTACHÉ Marks.


12. Thus, if Applicant is permitted to register and use Applicant's ATTACHÉ Mark, it is likely to cause dilution of the distinctive quality of Opposer's ATTACHÉ Marks.

WHEREFORE, the Opposer, PNY Technologies, Inc., prays that this Opposition be sustained and that Application Serial No. 85/423,501 for the ATTACHÉ mark be refused registration for the goods therein specified in International Class 9 and for such other relief as may be deemed just and proper.

Respectfully submitted,

PNY TECHNOLOGIES, INC.

By:


Robert W. Smith
McCarter & English, LLP
Attorneys for PNY Technologies, Inc.
Four Gateway Center
100 Mulberry Street
Newark, NJ 07102-4096
(973) 622-4444

Dated: August 7, 2012

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the original of the foregoing NOTICE OF OPPOSITION has been served by U.S. First Class Postal Mail to Applicant's attorney of record at the following address:

Barbara A. Friedman
Edell, Shapiro & Finnan, LLC
1901 Research Blvd
Ste 400
Rockville, MD 20850-6120

Date: August 7, 2012

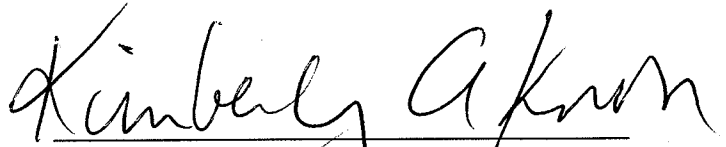

Kimberly Knoll

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-08-07 16:09:24 ET

Serial Number: 77281275 Assignment Information Trademark Document Retrieval

Registration Number: 3430852

Mark

ATTACHÉ

(words only): ATTACHÉ

Standard Character claim: Yes

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2008-05-20

Filing Date: 2007-09-17

Transformed into a National Application: No

Registration Date: 2008-05-20

Register: Principal

Law Office Assigned: LAW OFFICE 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-05-20

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. PNY Technologies, Inc.

Address:

PNY Technologies, Inc.
100 Jefferson Rd
Parsippany, NJ 07054
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Delaware

GOODS AND/OR SERVICES

International Class: 009**Class Status:** Active

Computer hardware for transferring, storing and transporting electronic data between electronic storage devices

Basis: 1(a)**First Use Date:** 2003-03-03**First Use in Commerce Date:** 2003-05-00

ADDITIONAL INFORMATION

Prior Registration Number(s):

2944947

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2012-04-02 - Applicant/Correspondence Changes (Non-Responsive) Entered

2012-04-02 - TEAS Change Of Owner Address Received

2008-05-20 - Registered - Principal Register

2008-03-04 - Published for opposition

2008-02-13 - Notice of publication

2008-01-31 - Law Office Publication Review Completed

2008-01-30 - Assigned To LIE

2007-12-19 - Approved for Pub - Principal Register (Initial exam)

2007-12-19 - Assigned To Examiner

2007-09-20 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

William J. Heller

Correspondent

WILLIAM J. HELLER

MCCARTER & ENGLISH, LLP

100 MULBERRY ST

NEWARK, NJ 07102-4056

Phone Number: 973-622-4444

Fax Number: 973-624-7070

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-08-07 16:09:53 ET

Serial Number: 78221675 Assignment Information Trademark Document Retrieval

Registration Number: 2944947

Mark



(words only): ATTACHE

Standard Character claim: No

Current Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Date of Status: 2010-05-19

Filing Date: 2003-03-05

Transformed into a National Application: No

Registration Date: 2005-04-26

Register: Principal

Law Office Assigned: LAW OFFICE 115

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: M60 -TMO Law Office 115

Date In Location: 2010-05-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. PNY Technologies, Inc.

Address:

PNY Technologies, Inc.
100 Jefferson Rd
Parsippany, NJ 07054
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 009
Class Status: Active
Computer hardware for transferring, storing and transporting electronic data between electronic storage devices
Basis: 1(a)
First Use Date: 2003-03-03
First Use in Commerce Date: 2003-05-00

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2012-04-02 - Applicant/Correspondence Changes (Non-Responsive) Entered
2012-04-02 - TEAS Change Of Owner Address Received
2010-08-04 - Assignment Of Ownership Not Updated Automatically
2010-05-19 - Section 8 (6-year) accepted & Section 15 acknowledged
2010-05-19 - Case Assigned To Post Registration Paralegal
2010-05-04 - TEAS Section 8 & 15 Received
2005-04-26 - Registered - Principal Register
2005-01-11 - Law Office Registration Review Completed
2004-09-28 - Assigned To LIE

2004-09-28 - Assigned To LIE
2004-09-18 - Allowed for Registration - Principal Register (SOU accepted)
2004-09-13 - Assigned To Examiner
2004-09-07 - Statement Of Use Processing Complete
2004-08-18 - Use Amendment Filed
2004-08-18 - TEAS Statement of Use Received
2004-08-10 - NOA Mailed - SOU Required From Applicant
2004-05-18 - Published for opposition
2004-04-28 - Notice of publication
2004-03-09 - Approved For Pub - Principal Register
2003-11-24 - Communication received from applicant
2003-11-24 - TEAS Response to Office Action Received
2003-09-29 - Final refusal e-mailed
2003-09-09 - Communication received from applicant
2003-09-09 - TEAS Response to Office Action Received
2003-08-26 - Non-final action e-mailed
2003-08-26 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

William J. Heller

Correspondent

William J. Heller

MCCARTER & ENGLISH, LLP

FOUR GATEWAY CENTER 100 MULBERRY STREET

NEWARK NJ 07102

Phone Number: 973-622-4444

Fax Number: 973-624-7070

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2012-08-07 16:10:24 ET

Serial Number: 77084109 Assignment Information Trademark Document Retrieval

Registration Number: 3454566

Mark



(words only): SECURE ATTACHÉ

Standard Character claim: No

Current Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Date of Status: 2008-06-24

Filing Date: 2007-01-16

Transformed into a National Application: No

Registration Date: 2008-06-24

Register: Principal

Law Office Assigned: LAW OFFICE 110

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2008-05-20

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. PNY Technologies, Inc.

Address:

PNY Technologies, Inc.
100 Jefferson Rd
Parsippany, NJ 07054
United States

Legal Entity Type: Corporation**State or Country of Incorporation:** Delaware

GOODS AND/OR SERVICES

International Class: 009**Class Status:** Active

Computer hardware for transferring, storing and transporting electronic data between electronic storage devices

Basis: 1(a)**First Use Date:** 2007-01-06**First Use in Commerce Date:** 2007-03-14

ADDITIONAL INFORMATION

Color(s) Claimed: Color is not claimed as a feature of the mark.**Disclaimer:** "SECURE"**Design Search Code(s):**

14.11.08 - Locks; Locks and key holes; padlocks; combination locks; Locks, combination; Padlocks

Prior Registration Number(s):

2944947

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2012-04-02 - Applicant/Correspondence Changes (Non-Responsive) Entered

2012-04-02 - TEAS Change Of Owner Address Received

2010-08-04 - Assignment Of Ownership Not Updated Automatically

2008-06-24 - Registered - Principal Register

2008-05-20 - Law Office Registration Review Completed
2008-05-20 - Allowed for Registration - Principal Register (SOU accepted)
2008-05-02 - Statement Of Use Processing Complete
2008-05-02 - Extension 1 granted
2008-04-14 - Use Amendment Filed
2008-04-14 - Extension 1 filed
2008-04-14 - TEAS Extension Received
2008-04-14 - TEAS Statement of Use Received
2007-11-27 - NOA Mailed - SOU Required From Applicant
2007-09-04 - Published for opposition
2007-08-15 - Notice of publication
2007-05-26 - Law Office Publication Review Completed
2007-05-26 - Assigned To LIE
2007-05-10 - Approved For Pub - Principal Register
2007-05-10 - Teas/Email Correspondence Entered
2007-05-09 - Communication received from applicant
2007-05-09 - TEAS Response to Office Action Received
2007-05-08 - Non-final action e-mailed
2007-05-08 - Non-Final Action Written
2007-05-03 - Assigned To Examiner
2007-01-23 - Notice Of Design Search Code Mailed
2007-01-22 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
William J. Heller

Correspondent

William J. Heller
MCCARTER & ENGLISH, LLP
FOUR GATEWAY CENTER
100 MULBERRY STREET
NEWARK NJ 07102
Phone Number: 973-622-4444
Fax Number: 973-624-7070
