

ESTTA Tracking number: **ESTTA608889**

Filing date: **06/09/2014**

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	Thomas Magnete GmbH
Granted to Date of previous extension	06/08/2014
Address	San Fernando 35 Herdorf, 57562 GERMANY

Attorney information	John Wilson Jones Jones & Smith, LLP 2777 Allen Parkway Suite 1000 Houston, TX 77019 UNITED STATES jjones@jonessmith.net Phone:7135283100
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Applicant Information

Application No	86014656	Publication date	12/10/2013
Opposition Filing Date	06/09/2014	Opposition Period Ends	06/08/2014
Applicant	Gardner Denver Thomas, Inc. 1149 Illinois Avenue Sheboygan, WI 53081 UNITED STATES		

Goods/Services Affected by Opposition

Class 007. First Use: 1971/06/00 First Use In Commerce: 1971/06/00 All goods and services in the class are opposed, namely: air compressors, vacuum pumps, liquid pumps
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Application No	86014661	Publication date	12/10/2013
Opposition Filing Date	06/09/2014	Opposition Period Ends	
Applicant	Gardner Denver Thomas, Inc. 1149 Illinois Avenue Sheboygan, WI 53081 UNITED STATES		

Goods/Services Affected by Opposition


Class 007. First Use: 2005/06/00 First Use In Commerce: 2005/06/00 All goods and services in the class are opposed, namely: air compressors, vacuum pumps, liquid
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pumps


Grounds for Opposition


Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
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.	3547095	Application Date	10/30/2007
Registration Date	12/16/2008	Foreign Priority Date	05/25/2007
Word Mark	THOMAS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 007. First use: First Use: 0 First Use In Commerce: 0 Machine parts, namely, electromechanically, pyrotechnically, and electro-hydraulically operated actuators and valves for use as machine parts for control and regulation purposes; valves for use as machine parts for control and regulation purposes and as parts of pumps, namely, hydraulic valves, proportional valves, control valves, pressure valves and throttling servo valves; injection valves as parts of pumps</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Data processing equipment and computers; electronic equipment and instruments composed of data processing equipment and computers for use in control and regulation of actuators; control and regulation systems for use in machines or vehicles, namely, electronic actuators; centrifugal metering pumps for fuels; self-regulating fuel pumps for service stations; magnets; switching magnets; electromechanically and electro-hydraulically operated vehicle parts for use in control and regulation purposes, namely, electric actuators and electromagnetically and pyrotechnically actuated magnetic control valves for controlling gases or fluids; valves for use in control and regulation purposes as parts of ferromagnetic and electromagnetic components, namely, hydraulic control valves for regulating the flow of gases and liquids, pressure control valves, and proportional control valves for regulating the flow of gases and liquids</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 Scientific services, namely, scientific research; technological services, namely, technological consultation in the technology field of automotive engineering, fluid power engineering and mechanical engineering; design for others in the field of automotive engineering, fluid power engineering and mechanical engineering; engineering services</p>		

U.S. Registration No.	3543842	Application Date	10/30/2007
Registration Date	12/09/2008	Foreign Priority Date	05/25/2007
Word Mark	THOMAS DRIVEN BY MAGNETICS		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 007. First use: First Use: 0 First Use In Commerce: 0 Machine parts, namely, electromechanically, pyrotechnically, and electro-hydraulically operated actuators and valves for use as machine parts for control and regulation purposes; valves for use as machine parts for control and regulation purposes and as parts of pumps, namely, hydraulic valves, proportional valves, control valves, pressure valves and throttling servo valves; injection valves as parts of pumps</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Data processing equipment and computers; electronic equipment and instruments composed of data processing equipment and computers for use in control and regulation of actuators; control and regulation systems for use in machines or vehicles, namely, electronic actuators; centrifugal metering pumps for fuels; self-regulating fuel pumps for service stations; magnets; switching magnets; electromechanically and electro-hydraulically operated vehicle parts for use in control and regulation purposes, namely, electric actuators and electromagnetically and pyrotechnically actuated magnetic control valves for controlling gases or fluids; valves for use in control and regulation purposes as parts of ferromagnetic and electromagnetic components, namely, hydraulic control valves for regulating the flow of gases and liquids, pressure control valves, and proportional control valves for regulating the flow of gases and liquids</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 Scientific services, namely, scientific research; technological services, namely, technological consultation in the technology field of automotive engineering, fluid power engineering and mechanical engineering; design for others in the field of automotive engineering, fluid power engineering and mechanical engineering; engineering services</p>

U.S. Registration No.	3547094	Application Date	10/30/2007
Registration Date	12/16/2008	Foreign Priority Date	05/25/2007
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 0 First Use In Commerce: 0		

	<p>Machine parts, namely, electromechanically, pyrotechnically, and electro-hydraulically operated actuators and valves for use as machine parts for control and regulation purposes; valves for use as machine parts for control and regulation purposes and as parts of pumps, namely, hydraulic valves, proportional valves, control valves, pressure valves and throttling servo valves; injection valves as parts of pumps</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0</p> <p>Data processing equipment and computers; electronic equipment and instruments composed of data processing equipment and computers for use in control and regulation of actuators; control and regulation systems for use in machines or vehicles, namely, electronic actuators; centrifugal metering pumps for fuels; self-regulating fuel pumps for service stations; magnets; switching magnets; electromechanically and electro-hydraulically operated vehicle parts for use in control and regulation purposes, namely, electric actuators and electromagnetically and pyrotechnically actuated magnetic control valves for controlling gases or fluids; valves for use in control and regulation purposes as parts of ferromagnetic and electromagnetic components, namely, hydraulic control valves for regulating the flow of gases and liquids, pressure control valves, and proportional control valves for regulating the flow of gases and liquids</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Scientific services, namely, scientific research; technological services, namely, technological consultation in the technology field of automotive engineering, fluid power engineering and mechanical engineering; design for others in the field of automotive engineering, fluid power engineering and mechanical engineering; engineering services</p>
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Attachments	<p>79048003#TMSN.jpeg(bytes) 79048112#TMSN.jpeg(bytes) 79048002#TMSN.jpeg(bytes) Notice_of_Opposition.pdf(71929 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	/John Wilson Jones/
Name	John Wilson Jones
Date	06/09/2014

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

Applicant: Gardner Denver Thomas, Inc.

Application Serial Number: 86-014,656
Application Filing Date: 07/19/2013
Mark: THOMAS
Date of Publication: 12/10/2013

Application Serial Number: 86-014,661
Application Filing Date: 07/19/2013
Mark: THOMAS (stylized)
Date of Publication: 12/10/2013

THOMAS MAGNETE GmbH

v.

GARDNER DENVER THOMAS, INC.

NOTICE OF OPPOSITION

This Notice of Opposition is being filed by **Thomas Magnete GmbH** (“Opposer”), having its principal place of business at San Fernando 35, 57562 Herdorf, Federal Republic of Germany, against registration of the marks THOMAS by Gardner Denver Thomas, Inc. (“Defendant”) which is the subject of U.S. Trademark Application Serial No. 86-014,656 and THOMAS (Stylized) by Defendant which is the subject of U.S. Trademark Application Serial No. 86-014,661.

Opposer believes that it will be damaged by registration of the marks THOMAS and THOMAS (stylized) by Defendant and hereby opposes the same.

The grounds for opposition are as follows:

1. Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d): Defendant’s marks so resemble one or more marks registered by Opposer as well as marks and trade names previously used in the United States by Opposer and not abandoned, as to be likely, when used on or in connection with the goods or services of Defendant, to cause confusion, or to cause mistake, or to deceive. Opposer will be damaged by the registration of the marks by Defendant since the registered

marks of Opposer so resemble the mark of the above-identified applications as to be likely to cause confusion in the marketplace. Opposer is the owner of U.S. Trademark Registration No. 3,547,095 for THOMAS, registered on December 16, 2008 in International Classes 7, 9, and 42; and U.S. Trademark Registration No. 3,543,842 for THOMAS DRIVEN BY MAGNETICS (stylized), registered on December 9, 2008 in International Classes 7, 9, and 42. In addition, Opposer is the owner of U.S. Trademark Registration No. 3,543,838 for Driven by magnetics, registered on December 9, 2008 in International Classes 7, 9 and 42; and U.S. Trademark Registration No. 3,547,094 for stripes (stylized), registered on December 16, 2008 in International Classes 7, 9 and 42.

2. Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(e) in that the mark of the above-identification application falsely suggests a connection with the name or identity of Opposer.

Respectfully submitted,

Date: June 9, 2014

/John Wilson Jones, Reg. #31380/
John Wilson Jones
Attorney for Opposer

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