

ESTTA Tracking number: **ESTTA659184**

Filing date: **03/04/2015**

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	P3 International Corp.
Granted to Date of previous extension	03/04/2015
Address	132 Nassau Street New York, NY 10038 UNITED STATES

Attorney information	James A. Power Jr Power Del Valle LLP 233 West 72nd Street New York, NY 10023 UNITED STATES jp@powerdel.com Phone:212-877-0100
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Applicant Information

Application No	79143481	Publication date	11/04/2014
Opposition Filing Date	03/04/2015	Opposition Period Ends	03/04/2015
International Registration No.	1194278	International Registration Date	09/12/2013
Applicant	P3 ingenieuresellschaft mbH Am Kraftversorgungsturm 3 GERMANY		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Optical apparatus and instruments for testing video performance of mobile devices; computer controlled measuring apparatus and instruments for measuring quality of service and customer experience for use in the fields of telecommunication, aviation, automotive, electrical and mechanical engineering, and energy; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity for use with electric-powered vehicles, bicycles, scooters, bikes, bicycles and car connectivity, namely, electrical power adaptors, electrical connectors and adapter plugs, electrical transformers, charging-connectors, electronic components for signal transformation, conversion and transmission, excluding brake controllers; electrical power adaptors, electrical connectors and adapter plugs, namely, electrical transformers, charging connectors, electronic components for signal transformation, conversion and transmission; data processing apparatus for use in the field of telecommunication, aviation, automotive, electrical and mechanical engineering, and energy; telephone terminals, mobile phones, telephonic transmission apparatus, hands-free equipment for phones, videophones telephones for use with measuring mobile and wireless communication networks and devices; apparatus for recording, transmission or reproduction of sound or images for use with measuring mobile and wireless devices;</p>
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blank sound, image and data carriers, namely, magnetic recording carriers, phonograph records, audiotapes, video cassettes, music cassettes, CDs, CD-ROMs, DVDs, video disks and USB sticks for use with telecom, aviation, automotive, electrical and mechanical engineering, and energy testing systems; batteries and accumulators for use with wireless and mobile devices, vehicles and observation devices; electrical charging and testing devices for use with accumulators and batteries; computer controlled testing apparatus not for medical purposes for measuring and testing quality of service and customer experience for use with telecommunication, aviation, automotive, electrical and mechanical engineering and energy testing systems

Class 011. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Emergency lighting installations

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Applicant does not have a bona fide intent to use the mark in commerce in connection with the opposed goods. The opposed goods are not goods in trade insofar as they are not sold or transported by applicant in commerce but, rather, are merely incidental to applicant's services.

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4001042	Application Date	06/11/2010
Registration Date	07/26/2011	Foreign Priority Date	NONE
Word Mark	P3 INTERNATIONAL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 007. First use: First Use: 2005/09/15 First Use In Commerce: 2005/09/15 robotic vacuum cleaners</p> <p>Class 009. First use: First Use: 1995/02/03 First Use In Commerce: 1995/02/03 environmental weather monitoring system comprising meters and sensors for measuring and reporting temperature, barometric pressure, humidity, wind speed and direction; temperature sensors; barometers; thermometers; swimming pool temperature and ambient humidity sensors with alarm; wind speedometers; hygro-thermometers measuring temperature, humidity and precipitation; electronic humidity sensors; electronic precipitation gauges; electronic moisture sensors; portable electronic energy meters for monitoring and reporting electrical energy usage; electronic timers; voltage surge suppressors; audio recorders and players; telephone answering machines; electronic camera detectors; electronic pest repelling devices, namely, sonic devices for repelling animals, birds and insects; electronic animal and bird repelling devices; sonic animal repelling devices with lights; electric lighted magnifying glasses; automotive safety kits</p>		

	<p>comprising warning lights, strobes, and hand tools for the repair and maintenance of automobiles</p> <p>Class 010. First use: First Use: 2006/07/13 First Use In Commerce: 2006/07/13 electronic heating devices for treatment of itching, bites and stings</p> <p>Class 011. First use: First Use: 2002/03/27 First Use In Commerce: 2002/03/27 portable electric fans; portable electronic air purifiers; motion-activated home and garden lighting devices; electronic water softening units; decorative electric garden lighting devices; garden lighting devices with insect traps</p> <p>Class 020. First use: First Use: 2009/05/14 First Use In Commerce: 2009/05/14 electrically illuminated mirrors</p>
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U.S. Registration No.	4001043	Application Date	06/11/2010
Registration Date	07/26/2011	Foreign Priority Date	NONE

Word Mark	P3
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Description of Mark	The mark consists of the characters "P3" within a circle. The white in the mark is used to show background and is not a feature of the mark.
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Goods/Services	<p>Class 007. First use: First Use: 2005/09/15 First Use In Commerce: 2005/09/15 robotic vacuum cleaners</p> <p>Class 009. First use: First Use: 1987/12/01 First Use In Commerce: 1987/12/01 environmental weather monitoring system comprising meters and sensors for measuring and reporting temperature, barometric pressure, humidity, wind speed and direction; temperature sensors, barometers, thermometers, swimming pool temperature and ambient humidity sensors with alarm; wind speedometers; hygro-thermometers measuring temperature, humidity and precipitation; electronic humidity sensors; electronic precipitation gauges; electronic moisture sensors; portable water consumption meters; portable electronic energy meters for monitoring and reporting electrical energy usage; electronic timers; voltage surge suppressors; audio recorders and players; telephone answering machines; electronic camera detectors; electronic pest repelling devices, namely, sonic devices for repelling animals, birds and insects; electronic animal and bird re-</p>
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	<p>repelling devices; sonic animal repelling devices with lights; electric lighted magnifying glasses; automotive safety kits comprising warning lights, strobes, and hand tools for the repair and maintenance of automobiles</p> <p>Class 010. First use: First Use: 2006/07/13 First Use In Commerce: 2006/07/13 electronic heating devices for treatment of itching, bites and stings</p> <p>Class 011. First use: First Use: 1996/11/07 First Use In Commerce: 1996/11/07 portable electric fans; portable electronic air purifiers; motion-activated home and garden lighting devices; night lights; electronic water softening units; decorative electric garden lighting devices; garden lighting devices with insect traps</p> <p>Class 020. First use: First Use: 2009/05/14 First Use In Commerce: 2009/05/14 electrically illuminated mirrors</p>
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Attachments	<p>85060909#TMSN.png(bytes) 85060921#TMSN.png(bytes) Notice Opposition.pdf(43152 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	/jpower/
Name	James A. Power Jr
Date	03/04/2015

UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD

P3 INTERNATIONAL CORP,

Opposer,

v.

P3 INGENIEURGESELLSCHAFT MBH,

Applicant.

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) In the Matter of:
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) Application No. 79/143,481
)

) Mark: P3 group
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Attorney Ref. 228.609

Commissioner for Trademarks
Arlington, Virginia 22202-3513

NOTICE OF OPPOSITION

P3 International Corp., a New York corporation with an office at 132 Nassau Street, New York, New York 10023 , believes that it will be damaged by the registration sought in the above identified application and hereby opposes such registration on the following grounds:

1. Opposer is the owner of United States Trademark Registrations No. 4,001,042 for P3 INTERNATIONAL and 4,001,043 for P3 (stylized), each issued July 26, 2011 for, *inter alia*, electronic energy meters for monitoring electrical energy usage, voltage surge protectors, audio recorders and players, telephone answering machines, safety kits with warning lights, electronic meters and sensors for measuring environmental conditions in international class 9, electric fans, electronic air purifiers and lighting devices in international class 11..

2. Applicant filed, on September 12, 2013, Application Ser. No. 79/143,481 to register the mark P3 GROUP on the Principal Register for a wide array of electronic measuring and testing apparatus, electrical power adaptors, electrical connectors and adapter plugs, electrical transformers, electrical charging connectors, telecommunications equipment, apparatus for recording, transmission or reproduction of sound or images ,electrical charging and testing devices in international class 9 and for emergency lighting installations in

international class 11 pursuant to a request for extension of protection of a foreign registration and section 66(a) of the Lanham Act.

3. Upon information and belief, applicant has not used the mark P3 GROUP in the United States or in commerce in connection with the goods described in Application Ser. No. 79/143,481, or any other goods, or at any time prior to its filing of that application.

4. Since long prior to applicant's filing of its application to register P3 GROUP or any use of that mark, opposer has continuously and extensively used its P3 marks in commerce in the United States in connection with the sale of the goods described in its registrations.

5. Applicant's registration of the mark P3 GROUP would be inconsistent with opposer's exclusive rights to use its registered P3 marks for the goods identified in its registrations, would create an incorrect record, may be used unfairly as a basis for questioning opposer's lawful use of its marks and would, therefore, interfere with opposer's exclusive right to use said mark in commerce.

6. Upon information and belief, applicant does not have a *bona fide* intention to use the mark applied for in connection with the goods listed by applicant in international classes 9 and 11. Those goods are not goods in trade insofar as they are not sold or transported by applicant in commerce but, rather, are merely incidental to applicant's services.

7. Applicant should therefore be refused registration of P3 GROUP for all goods in international classes 9 and 11 on the grounds that it is likely to cause confusion, mistake or to deceive in violation of section 2(d) of the Act, and/or to dilute opposer's P3 marks in violation of section 43(c) of the Act, that the goods listed in international classes 9 and 11 are not goods in trade and merely incidental to applicant's services, and that applicant has no *bona fide* intention to use the mark in commerce in connection with those goods.

WHEREFORE, opposer prays that this opposition be sustained, that registration of the mark P3 GROUP to applicant in international classes 9 and 11 be refused, that the entire international classes 9 and 11 be deleted from its application, and that opposer be granted such other and further relief as this Board deems just and proper.

P3 INTERNATIONAL CORP.

New York, New York
March 4, 2015

By: /jpower/
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jp@powerdel.com

Attorneys for Opposer

Certificate of Service

I hereby certify that, on March 4, 2015, a copy of the foregoing Notice of Opposition was served upon applicant's correspondent and domestic representative of record by first class mail, postage prepaid, in an envelope addressed to:

Darren M. Geliebter, Esq.
Lombard & Geliebter LLP
305 Broadway, 7th Floor
New York, New York 10007

/jpower/
James A. Power Jr