

ESTTA Tracking number: **ESTTA936076**

Filing date: **11/19/2018**

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	PLANATOL GMBH
Granted to Date of previous extension	11/18/2018
Address	FABRIKSTRASSE 30-32 ROHRDORF, 83101 GERMANY
Correspondence information	McGlew and Tuttle, P.C. Scarborough Station Scarborough, NY 10510 UNITED STATES cperry@mcglewtuttle.com, mandt@mcglewtuttle.com 9149415600

Applicant Information

Application No	87750108	Publication date	05/22/2018
Opposition Filing Date	11/19/2018	Opposition Period Ends	11/18/2018
Applicant	Khatibshahidi, Bianca 13331 Mulberry Trail Taylor, MI 48180 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: Printed items, namely, stickers, cardstock, adhesives for stationery, printableplanner inserts, and notebook inserts

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1851014	Application Date	02/11/1993
Registration Date	08/23/1994	Foreign Priority Date	NONE

Word Mark	PLANATOL
Design Mark	
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 1938/00/00 First Use In Commerce: 1950/00/00 full line of adhesives for industrial, commercial, and domestic use

Attachments	T29770.Notice of opposition.pdf(40075 bytes) T29770.74357891.pdf(17632 bytes)
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Signature	/cecelia m perry/
Name	McGlew and Tuttle, P.C.
Date	11/19/2018

ATTORNEY DOCKET NO: T29770

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF:
SERIAL NO: 87750108
FILED : January 10, 2018
FOR : PLANATOMY
PUBLISHED: May 22, 2018

Planatol GMBH

Opposer,

v.

Bianca Khatibshahidi

Applicant.

Opposition No. _____

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Planatol GMBH, a limited liability company duly organized and existing under the laws of Germany, with a principal place of business at Fabrikstrasse 30-32, ROHRDORF, GERMANY 83101 (hereinafter also referred to as opposer), believes that it would be damaged by the registration of the mark shown in the above-identified application, and hereby opposes that mark, pursuant to 15 USC 1063 and 37 CFR §2.101.

As grounds for opposition, it is alleged that:

(1) Planatol GMBH, since a time prior to the filing of the applicant's use based application has been using its trademark PLANATOL in connection with the sale of a full line of adhesives for industrial, commercial, and domestic use. Said use has been valid and continuous since its first use and has not been abandoned.

(2) Planatol GMBH, since a time prior to the filing of the applicant's use based application has also been using the trademarks PLANA, PLANAX, and PLANAMELT in connection with the sale of a adhesive related goods. Said use has been valid and continuous since its first use and has not been abandoned. These together with PLANATOL form a family of PLANA formative marks for adhesive products.

(3) Planatol GMBH, is the owner of an U.S. trademark registration PLANATOL for full line of adhesives for industrial, commercial, and domestic use with a filing date and registration date previous to the date of filing of the applicant's intent to use based application.

(4) Planatol GMBH is the owner of the following valid and subsisting U.S. trademark registration whose TSDR printout is attached:

PLANATOL - Registration No. 1851014, filed, February 11, 1993, and registered on August 23, 1994.

(5) Planatol GMBH's registration is valid and subsisting and is prima facie proof of ownership of the mark from at least its filing date, pursuant to 15 USC 1057(b), and of the exclusive right to use the registered mark in commerce on the goods specified in said registrations.

(6) Plantol GMBH's registration no. 1851014 is incontestable.

(7) Planatol GMBH has used its PLANATOL mark and its other marks in commerce and has acquired valuable goodwill and recognition for its marks. Resulting from this use, the public has come to associate "PLANATOL" and Opposer's other marks with Opposer and Opposer's goods.

(8) Opposer Planatol GMBH's PLANATOL mark has become famous nationwide for its use in connection with a full line of adhesives for industrial, commercial, and domestic use, since well before the filing date of Applicant's use based application.

(9) Opposer's PLANATOL trademark and other PLANA formative marks are inherently distinctive to the public and the trade and serves primarily as a designator of origin of Opposer's goods.

(10) Upon information and belief, notwithstanding Opposer's rights in and to Opposer's PLANATOL trademark, on January 18, 2018, Applicant filed an application to register a mark for PLANATOMY for the goods of printed items, namely, stickers,

cardstock, adhesives for stationery, printable planner inserts, and notebook inserts. Said application was assigned serial no. 877501108 and was published for opposition on May 22, 2018.

(11) Upon information and belief, the bona fides of Applicant's intent to use Applicant's mark in commerce on or in connection with the goods are not apparent from the material of record in the subject application, and Opposer therefore challenges the same and leaves Applicant to its proof regarding the nature and sufficiency of its intention to the mark for all the identified goods at the time of filing Application serial no 87750108, and at anytime thereafter. Section 1(b) of the Trademark Act , 15USC§1051(b)

(12) On information and belief, both Applicant's mark and Planatol GMBH's PLANATOL mark and other marks will be applied to identical or highly related goods and are likely to be sold through the same or similar channels of distribution.

(13) Applicant's mark so resembles Planatol GMBH's registration and PLANATOL trademark and other PLANA formative trademarks in sight, sound and commercial impression, as used in the United States and not abandoned, that when applied to the same or similar goods, would be likely to cause confusion, or to cause mistake or to deceive within Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

(14) Opposer, upon information and belief, avers that its customers and the general public are likely to be confused, mistaken or deceived as to the origin and

sponsorship of Applicant's proposed goods as set forth in Application Serial Number 87750108 to be marketed under Applicant's proposed PLANATOMY mark, and misled into believing that such goods emanate from, are licensed by, or are in some way directly or indirectly associated with, approved by or sponsored by Opposer, all to the detriment and harm of Opposer and Opposer's reputation.

(15) On information and belief, Applicant's actions would substantially harm the Opposer, by permitting registration in favor of Applicant for a mark confusingly similar to marks which the Opposer has registered and/or used on its goods from an earlier date.

OPPOSER Planatol GMBH prays that this application Serial No.87750108, be refused, that no registration be issued thereon to Applicant and that this Opposition be sustained in favor of Planatol GMBH.

Respectfully submitted for Opposer,
Planatol GMBH

By: /Cecelia M. Perry/
Cecelia M. Perry
McGLEW AND TUTTLE, P.C.
Scarborough Station
Scarborough, N.Y. 10510-0827
(914) 941-5600

CMP:JJM

Attach.: TSDR and assignment record for Reg. No. 1851014

DATED: SCARBOROUGH, NEW YORK
November 19, 2018

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT

ACCOUNT 13-0410.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING ELECTRONICALLY FILED WITH THE UNITED STATES PATENT AND TRADEMARK, ON November 19, 2018.

McGLEW AND TUTTLE, P.C.

By: /Cecelia M. Perry/ Date: November 19, 2018

T29770.Notice of opposition

Generated on: This page was generated by TSDR on 2018-11-19 17:13:13 EST

Mark: PLANATOL

US Serial Number: 74357891

Application Filing Date: Feb. 11, 1993

US Registration Number: 1851014

Registration Date: Aug. 23, 1994

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Aug. 23, 2014

Publication Date: Oct. 26, 1993

Notice of Allowance Date: Jan. 18, 1994

Mark Information

Mark Literal Elements: PLANATOL

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *.* identify additional (new) wording in the goods/services.

For: full line of adhesives for industrial, commercial, and domestic use

International Class(es): 001 - Primary Class

U.S Class(es): 005

Class Status: ACTIVE

Basis: 1(a)

First Use: 1938

Use in Commerce: 1950

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: PLANATOL GMBH

Owner Address: FABRIKSTRASSE 30-32
ROHRDORF 83101
GERMANY

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country GERMANY
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: CECELIA M. PERRY

Docket Number: T29770

Attorney Primary Email Address: MandT@mcglewtuttle.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: CECELIA M. PERRY
MCGLEW AND TUTTLE, P.C.
SCARBOROUGH STATION
SCARBOROUGH, NEW YORK 10510-9227
UNITED STATES

Phone: (914) 941-5600

Fax: (914) 941-5855

Correspondent e-mail: MandT@mcglewtuttle.com

Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: MCGLEW AND TUTTLE, P.C.

Phone: (914) 941-5600

Fax: (914) 941-5855

Domestic Representative e-mail: MandT@mcglewtuttle.com

Domestic Representative e-mail Authorized: No

Prosecution History

Date	Description	Proceeding Number
Dec. 13, 2017	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Apr. 05, 2017	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Aug. 23, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Aug. 23, 2014	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	76533
Aug. 23, 2014	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	76533
Aug. 22, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76533
Aug. 06, 2014	TEAS SECTION 8 & 9 RECEIVED	
Jul. 23, 2014	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Apr. 14, 2011	CASE FILE IN TICRS	
Mar. 21, 2011	CASE FILE IN TICRS	
Jul. 27, 2004	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jul. 27, 2004	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
May 25, 2004	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
May 25, 2004	TEAS SECTION 8 & 9 RECEIVED	
Jun. 22, 2000	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Apr. 07, 2000	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Aug. 23, 1994	REGISTERED-PRINCIPAL REGISTER	
May 13, 1994	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
May 12, 1994	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
May 10, 1994	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
May 09, 1994	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Apr. 28, 1994	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 28, 1994	ASSIGNED TO EXAMINER	70432
Apr. 25, 1994	ASSIGNED TO EXAMINER	72102

Apr. 08, 1994 STATEMENT OF USE PROCESSING COMPLETE
 Feb. 18, 1994 USE AMENDMENT FILED
 Jan. 18, 1994 NOA MAILED - SOU REQUIRED FROM APPLICANT
 Oct. 26, 1993 PUBLISHED FOR OPPOSITION
 Sep. 24, 1993 NOTICE OF PUBLICATION
 Aug. 03, 1993 APPROVED FOR PUB - PRINCIPAL REGISTER
 Jul. 28, 1993 EXAMINER'S AMENDMENT MAILED
 Jul. 12, 1993 CORRESPONDENCE RECEIVED IN LAW OFFICE
 May 11, 1993 NON-FINAL ACTION MAILED
 May 06, 1993 ASSIGNED TO EXAMINER

70432

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted
Affidavit of Incontestability: Section 15 - Accepted
Renewal Date: Aug. 23, 2014

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Aug. 23, 2014

Assignment Abstract Of Title Information

Summary

Total Assignments: 3

Registrant: PLANATOL Klebetechnik GmbH

Assignment 1 of 3

Conveyance: CHANGE OF NAME

Reel/Frame: [5326/0308](#)

Pages: 2

Date Recorded: Jul. 21, 2014

Supporting Documents: [assignment-tm-5326-0308.pdf](#)

Assignor

Name: [PLANATOL KLEBETECHNIK GMBH](#)

Execution Date: Aug. 06, 2009

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: GERMANY

Assignee

Name: [PLANATOL HOLDING GMBH](#)

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: GERMANY

Address: FABRIKSTRASSE 30-32
83101 ROHRDORF, GERMANY

Correspondent

Correspondent Name: CECELIA M. PERRY

Correspondent Address: MCGLEW AND TUTTLE, P.C.
SCARBOROUGH STATION
SCARBOROUGH, NY 10510-9227

Domestic Representative - Not Found

Assignment 2 of 3

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [6020/0531](#)

Pages: 3

Date Recorded: Mar. 28, 2017

Supporting Documents: [assignment-tm-6020-0531.pdf](#)

Documents: _____

Assignor

Name: [PLANATOL HOLDING GMBH](#) **Execution Date:** Mar. 16, 2017
Legal Entity Type: LIMITED LIABILITY COMPANY **State or Country Where Organized:** GERMANY

Assignee

Name: [PLANATOL WETZEL GMBH](#) **State or Country Where Organized:** GERMANY
Legal Entity Type: LIMITED LIABILITY COMPANY
Address: FABRIKSTRASSE 30-32
DE-83101 ROHRDORF, GERMANY

Correspondent

Correspondent Name: CECELIA M. PERRY
Correspondent Address: MCGLEW AND TUTTLE, P.C.
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SCARBOROUGH, NY 10510-9227

Domestic Representative - Not Found

Assignment 3 of 3

Conveyance: CHANGE OF NAME
Reel/Frame: [6199/0492](#) **Pages:** 2
Date Recorded: Nov. 08, 2017
Supporting Documents: [assignment-tm-6199-0492.pdf](#)

Assignor

Name: [PLANATOL WETZEL GMBH](#) **Execution Date:** Apr. 10, 2017
Legal Entity Type: LIMITED LIABILITY COMPANY **State or Country Where Organized:** GERMANY

Assignee

Name: [PLANATOL GMBH](#) **State or Country Where Organized:** GERMANY
Legal Entity Type: LIMITED LIABILITY COMPANY
Address: FABRIKSTRASSE 30-32
ROHRDORF, GERMANY 83101

Correspondent

Correspondent Name: CECELIA M. PERRY
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Domestic Representative - Not Found