

ESTTA Tracking number: **ESTTA1115120**

Filing date: **02/17/2021**

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	Prime Wire & Cable, Inc.
Granted to Date of previous extension	02/17/2021
Address	1330 VALLEY VISTA DRIVE DIAMOND BAR, CA 91765 UNITED STATES
Attorney information	JOHN K. BUCHE BUCHE & ASSOCIATES, P.C. 875 PROSPECT ST., SUITE 305 LA JOLLA, CA 92037 UNITED STATES Primary Email: jbuche@buchelaw.com Secondary Email(s): bma@buchelaw.com (858) 459-9111
Docket Number	Prime-Primel

**Applicant Information**

Application No.	79272243	Publication date	10/20/2020
Opposition Filing Date	02/17/2021	Opposition Period Ends	02/17/2021
International Registration No.	1498901	International Registration Date	08/26/2019
Applicant	DeoVolente Beheer BV WISMASTATE 7 NL-8926 RA LEEUWARDEN NETHERLANDS		

**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: Coaxial adapters, namely, connectors for coaxial cables; battery adapters, namely, battery chargers, battery cables, and battery separators; power adapters; electrical adapters; USB adapters, namely, USB card readers, USB hubs, and USB charging ports; radio frequency adapters, namely, radio-frequency transmitters, receivers, antennas, and power meters; plugadaptors; computer network adapters; flash card adapters; wireless adapters for computers, namely, adapters for wireless network access; gender changers in the nature of electrical adapters; adapters for connection between media devices, namely, high definition multimedia interface splitters and wireless high definition multimedia interface adapters; adapters for connecting telephones to hearing aids, namely, connection cables; battery packs; battery separators; power units, namely, batteries; dry-cell batteries; chargers for electric batteries; batteries for lighting; batter-</p>
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ies, electric; galvanic batteries; rechargeable batteries; power packs, namely, batteries; battery chargers; battery boxes; batteries; battery testers; batteries for pocketlamps; rechargeable electric batteries; battery chargers for tablet computers; battery chargers for use with telephones; battery compensation chargers; battery chargers for laptop computers; batteries for electronic cigarettes; solar-powered rechargeable batteries; batteries for electronic smokers' articles; self-adhesive labels, namely, encoded bar code labels; labels carrying magnetically recorded or encoded information for identification; battery chargers for electronic cigarettes; chargers for electronic cigarettes; USB battery chargers for electronic cigarettes; battery chargers in the nature of portable charging cases for electronic cigarettes and vaporizers; power adapters for use in vehicle lighter sockets; downloadable firmware and downloadable software for electronic cigarettes, namely, firmware and software for controlling the functionality of electronic cigarettes; blank USB flash drives; blank credit card-style USB flash drives; blank USB flash drives with micro USB connectors compatible with mobile phones; non pre-recorded, blank USB flash drives; blank USB cards; USB hardware; USB dongles being wireless network adapters; USB wireless routers; USB modems; computer hardware, namely, USB port cards; USB card readers; USB cables for cellphones; luminous USB cables; USB cables; downloadable USB (universal serial bus) operating software; USB battery chargers; LCD (liquid crystal display) projectors; liquid crystal displays (LCDs) for home theaters; LCD large-screen displays; LCD monitors; LCD projectors; liquid crystal display (LCD) televisions; home theater products, namely, LCD (liquid crystal display) screens in the nature of monitors, video screens, and television screens; thin film transistor-liquid crystal display (tft-LCD) panels; anti-glare color filters for liquid crystal displays, namely, televisions and computer monitors; graphic display terminals, namely, LCD monitors and LCD televisions; wearable displays, namely, wearable video display monitors; electronic displays, namely, electronic paper displays, electronic numeric displays, and digital signage; active matrix displays, namely, LED displays; displays for vehicles, namely, LCD monitors; head-up displays in the nature of transparent electronic displays for use in general aviation aircraft, projection of data from a mobile device onto a vehicle windshield, and providing motorcycle riders with navigational and operational information; head-mounted holographic video displays; heads-up displays for motor vehicles in the nature of transparent electronic displays for use in projection of data from a mobile device onto a vehicle windshield and providing motorcycle riders with navigational and operational information; terminal computer keyboards; computer keypads; computer keyboards; keyboards for tablet computers; multifunction computer keyboards; anti-glare screen filters for computers and televisions; computer screens; flexible flat panel displays for computers; shaped covers for tablet computers; stands adapted for laptops; arm rests for use with computers; document printers for use with computers; computing visual display units, namely, computer monitors; compact disc players for use with computers; headsets for use with computers; backup drives for computers; swivelling stands adapted for computers; computer hardware, namely, drawing apparatus and instruments adapted for use with computers; computer mouse, namely, touchpads for computers; joysticks for use with computers, other than for video games; dust covers for computers; computer whiteboards; wrist rests for use with computers; peripherals adapted for use with computers and other smart devices, namely, smartphone mounts, smartphone stabilizers, and wireless charging pads for smartphones; mouse pads; wrist rests for computer mouse users; holographic screens, namely, video screens and projection screens; screens, namely, computer screens, fluorescent screens, and touch screens; light emitting diode displays; fluorescent screens; head mounted 3D stereoscopic video displays; head mounted 2D monoscopic video displays; head mounted augmented reality video displays; head mounted stereoscopic video displays; head mounted monoscopic video displays; liquid crystal protective films for smartphones; display modules for mobile phones, namely, touch screens; displays for smartphones, namely, touch screens; batteries for laptop computers

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1522471	Application Date	05/26/1988
Registration Date	01/31/1989	Foreign Priority	NONE

		Date	
Word Mark	PRIME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1987/06/12 First Use In Commerce: 1987/06/12 ELECTRICAL CABLES FOR ELECTRICAL POWER TRANSMISSION, NAMELY, ELECTRICAL EXTENSION CORDS AND PORTABLE POWER CABLES SOLD TO INDUSTRIAL (NON-COMMUNICATIONS) AND RETAIL HARDWARE CUSTOMERS FOR USE IN POWERING ELECTRICAL MACHINERY, TOOLS AND APPLIANCES		

U.S. Registration No.	1686158	Application Date	01/17/1991
Registration Date	05/12/1992	Foreign Priority Date	NONE
Word Mark	PRIME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1987/09/00 First Use In Commerce: 1987/10/08 electrical sound and speaker cables		

U.S. Registration No.	1727147	Application Date	01/17/1991
Registration Date	10/27/1992	Foreign Priority Date	NONE
Word Mark	PRIME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1987/07/02 First Use In Commerce: 1987/08/03 electrical (non-communications) power transmission devices; namely, power blockadapters, extension cord adapters, cordset adapters, battery booster cables, welding cable, R.V. motor home adapters, tractor-trailer cables, multiple outlet service blocks, junction boxes, electrical ground connectors, plugs and connectors Class 011. First use: First Use: 1987/07/02 First Use In Commerce: 1987/08/03 trouble lights, work lights, and outdoor light strings		

U.S. Application No.	88774941	Application Date	01/27/2020
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PRIME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1987/07/02 First Use In Commerce: 1987/08/03 Lighting, namely, LED lighting apparatuses for job sites, construction settings, or		

	garage settings, work lights for job sites, construction settings, or garage settings, flood lights, head lamps, string lights for job sites, construction settings, garage settings, or decorative purposes, electric night lights, and clamp lamps
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U.S. Registration No.	3688492	Application Date	11/06/2008
Registration Date	09/29/2009	Foreign Priority Date	NONE
Word Mark	PRIME WIRE CABLE MALL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2008/09/01 First Use In Commerce: 2008/09/01 on-line retail store services and direct mail order services featuring electrical extension cords, surge protectors, power strips and accessories		

U.S. Registration No.	3244758	Application Date	07/17/2006
Registration Date	05/22/2007	Foreign Priority Date	NONE
Word Mark	PRIMELIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1995/10/31 First Use In Commerce: 1995/10/31 Electrical extension cords		

U.S. Registration No.	3344148	Application Date	07/17/2006
Registration Date	11/27/2007	Foreign Priority Date	NONE
Word Mark	PRIMELOK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1987/12/31 First Use In Commerce: 1987/12/31 Electrical extension cords		

Attachments	2021.02.17_Notice of Opposition.pdf(115185 bytes )
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Signature	/Byron Ma/
Name	BYRON MA
Date	02/17/2021

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

PRIME WIRE & CABLE, INC.,

Opposer,

v.

DEOVOLENTE BEHEER BV,

Applicant.

Opposition No.

Mark: PRIMELECT

U.S. App. Serial No.: 79/272,243

NOTICE OF OPPOSITION

1. On August 26, 2019, DeoVolente Beheer BV (“Applicant” or “DeoVolente”) filed Application Serial Number 79/272,243 (“the ‘243 Application”) for PRIMELECT (“Applicant’s Mark”). The Applicant is a Netherlands limited liability company. Prime Wire & Cable, Inc. (“Opposer” or “Prime Wire”) is a California corporation. Pursuant to 15 U.S.C. §§ 1052, 1063, and 1125(c) and 37 C.F.R. §§ 2.101 and 2.104(a), Prime Wire, by and through its attorneys, opposes Trademark Application Serial Number 79/272,243 for registration in Class 009.

2. The ‘243 Application was filed in class 009 for: “Coaxial adapters, namely, connectors for coaxial cables; battery adapters, namely, battery chargers, battery cables, and battery separators; power adapters; electrical adapters; USB adapters, namely, USB card readers, USB hubs, and USB charging ports; radio frequency adapters, namely, radio-frequency transmitters, receivers, antennas, and power meters; plug adaptors; computer network adapters; flash card adapters; wireless adapters for computers, namely, adapters for wireless network access; gender changers in the nature of electrical adapters; adapters for connection between media devices, namely, high definition multimedia interface splitters and wireless high definition multimedia interface adapters; adapters for connecting telephones to hearing aids, namely,

connection cables; battery packs; battery separators; power units, namely, batteries; dry-cell batteries; chargers for electric batteries; batteries for lighting; batteries, electric; galvanic batteries; rechargeable batteries; power packs, namely, batteries; battery chargers; battery boxes; batteries; battery testers; batteries for pocketlamps; rechargeable electric batteries; battery chargers for tablet computers; battery chargers for use with telephones; battery compensation chargers; battery chargers for laptop computers; batteries for electronic cigarettes; solar-powered rechargeable batteries; batteries for electronic smokers' articles; self-adhesive labels, namely, encoded bar code labels; labels carrying magnetically recorded or encoded information for identification; battery chargers for electronic cigarettes; chargers for electronic cigarettes; USB battery chargers for electronic cigarettes; battery chargers in the nature of portable charging cases for electronic cigarettes and vaporizers; power adapters for use in vehicle lighter sockets; downloadable firmware and downloadable software for electronic cigarettes, namely, firmware and software for controlling the functionality of electronic cigarettes; blank USB flash drives; blank credit card-style USB flash drives; blank USB flash drives with micro USB connectors compatible with mobile phones; non pre-recorded, blank USB flash drives; blank USB cards; USB hardware; USB dongles being wireless network adapters; USB wireless routers; USB modems; computer hardware, namely, USB port cards; USB card readers; USB cables for cellphones; luminous USB cables; USB cables; downloadable USB (universal serial bus) operating software; USB battery chargers; LCD (liquid crystal display) projectors; liquid crystal displays (LCDs) for home theaters; LCD large-screen displays; LCD monitors; LCD projectors; liquid crystal display (LCD) televisions; home theater products, namely, LCD (liquid crystal display) screens in the nature of monitors, video screens, and television screens; thin film transistor-liquid crystal display (tft-LCD) panels; anti-glare color filters for liquid crystal displays, namely, televisions and computer

monitors; graphic display terminals, namely, LCD monitors and LCD televisions; wearable displays, namely, wearable video display monitors; electronic displays, namely, electronic paper displays, electronic numeric displays, and digital signage; active matrix displays, namely, LED displays; displays for vehicles, namely, LCD monitors; head-up displays in the nature of transparent electronic displays for use in general aviation aircraft, projection of data from a mobile device onto a vehicle windshield, and providing motorcycle riders with navigational and operational information; head-mounted holographic video displays; heads-up displays for motor vehicles in the nature of transparent electronic displays for use in projection of data from a mobile device onto a vehicle windshield and providing motorcycle riders with navigational and operational information; terminal computer keyboards; computer keypads; computer keyboards; keyboards for tablet computers; multifunction computer keyboards; anti-glare screen filters for computers and televisions; computer screens; flexible flat panel displays for computers; shaped covers for tablet computers; stands adapted for laptops; arm rests for use with computers; document printers for use with computers; computing visual display units, namely, computer monitors; compact disc players for use with computers; headsets for use with computers; backup drives for computers; swiveling stands adapted for computers; computer hardware, namely, drawing apparatus and instruments adapted for use with computers; computer mouse, namely, touchpads for computers; joysticks for use with computers, other than for video games; dust covers for computers; computer whiteboards; wrist rests for use with computers; peripherals adapted for use with computers and other smart devices, namely, smartphone mounts, smartphone stabilizers, and wireless charging pads for smartphones; mouse pads; wrist rests for computer mouse users; holographic screens, namely, video screens and projection screens; screens, namely, computer screens, fluorescent screens, and touch screens; light emitting diode displays; fluorescent screens;

head mounted 3D stereoscopic video displays; head mounted 2D monoscopic video displays; head mounted augmented reality video displays; head mounted stereoscopic video displays; head mounted monoscopic video displays; liquid crystal protective films for smartphones; display modules for mobile phones, namely, touch screens; displays for smartphones, namely, touch screens; batteries for laptop computers.” The ‘243 Application was also applied for in the following classes: (i) class 016 for “Label paper; labels of paper; adhesive labels; adhesive printed labels; paper gift tags; handheld label printing machines for offices; baggage claim check tags of paper; baggage claim check tags of cardboard; labels of paper or cardboard; adhesive labels of paper; wet erase paper labels”; (ii) class 020 for “Contour chairs; ergonomic chairs for seated massage”; and, (iii) class 042 for “Professional consultancy relating to the science of ergonomics, namely, designing workplace facilities and equipment to optimize efficiency and safety.” The ‘243 Application was filed as a Section 66(a) basis for filing. The international registration number is 1498901 with an alleged international registration date of August 26, 2019. The ‘243 Application was published for opposition on October 20, 2020. A 30-day extension of time to oppose the ‘243 Application was granted on November 19, 2020 and then a 60-day extension of time to oppose the ‘243 Application was granted on December 18, 2020. Accordingly, this Notice of Opposition is timely filed.

3. Since at least as early as 1987 Prime Wire has been using the term “PRIME” in connection with electrical cables. Moreover, since long prior to August 26, 2019, Prime Wire has gained common law and federally registered rights in various PRIME WIRE and PRIME marks in connection with, among other goods, power cords, timers, remotes, surge protectors, power strips, power adapters, electrical adapters, USB adapters, USB hubs, USB charging powers, battery



chargers, lighting, and lighting accessories. Prime Wire offers its goods and services through the United States.

4. Prime Wire is the owner of the following registered trademarks:

Trademark	Reg. No.	Goods and Services	Filing Date	Reg. Date
PRIME	1,522,471	Class 009: Electrical cables for electrical power transmission, namely, electrical extension cords and portable power cables sold to industrial (non-communications) and retail hardware customers for use in powering electrical machinery, tools and appliances.	5/26/1988	1/31/1989
PRIME	1,686,158	Class 009: Electrical sound and speaker cables	1/17/1991	5/12/1992
PRIME	1,727,147	Class 009 for Electrical (non-communications) power transmission devices; namely, power block adapters, extension cord adapters, cordset adapters, battery booster cables, welding cable, R.V. motor home adapters, tractor-trailer cables, multiple outlet service blocks, junction boxes, electrical ground connectors, plugs and connectors.  Class 011: Trouble lights, work lights, and outdoor string lights	1/17/1991	10/27/1992
PRIME	88/774,941	Class 011: Lighting, namely, LED lights, work lights, flood lights, head lamps, string lights, night lights, and clamp lamps.	1/27/2020	
PRIME WIRE CABLE MALL	3,688,492	Class 035: On-line retail store services and direct mail order services featuring electrical extension cords, surge protectors, power strips and accessories.	11/6/2008	9/29/2009
PRIMELIGHT	3,244,758	Class 009: Electrical extension cords	7/17/2006	5/22/2007
PRIMELOK	3,344,148	Class 009: Electrical extension cords	7/17/2006	11/27/2007

5. The marks shown in paragraph 4 and Prime Wire's common law use of PRIME WIRE shall be collectively referred to herein as "Prime Wire's Marks."

6. Prime Wire's above referenced trademark registrations are valid. Prime Wire's trademark registrations for U.S. Reg. Nos. 1,522,471; 1,686,158; 1,727,147; 3,244,758; and 3,344,148 are incontestable.

7. The Applicant's goods described in the goods and services of the '243 Application are closely related to the Opposer's goods, including, but not limited to, "battery adapters, namely, battery chargers," "power adapters," "electrical adapters," "USB adapters," "USB hubs," "USB charging ports," and "USB battery chargers." Therefore, because of the similarity between PRIMELECT and PRIME, as well as between PRIMELECT and Prime Wire's remaining registered and common law marks, and the related goods, a likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d) exists between the Applicant's Mark and Prime Wire's Marks. That is, the Applicant's Mark is likely to cause consumer confusion, mistake, or deception in the trade and among consumers as to the source, origin, affiliation, or sponsorship of the parties' respective goods.

8. On information and belief, the Applicant has not made use of the Mark in the United States for any product or service prior to August 26, 2019, which is subsequent to the dates of Prime Wire's dates of first use of its "PRIME" and "PRIME WIRE" marks as federally registered, used at common law, and publicly attributed to Prime Wire.

9. Applicant's commercial use of the PRIMELECT Mark will cause a likelihood of confusion and a presumption or false suggestion that Prime Wire has endorsed or approved of the goods bearing the Applicant's Mark, or that Prime Wire is affiliated or associated with the Applicant, to the detriment of Prime Wire.

10. PRIMELECT is likely to cause dilution of the distinctive quality of Prime Wire's famous marks and names.

11. Prime Wire has expended a considerable amount of time, effort, and resources in advertising and in otherwise promoting its goods and services and, as a result, the public has come to associate Prime Wire's Marks with its goods and services. Therefore, if Applicant obtains a registration, then it would reap the benefits of Prime Wire's goodwill and reputation attached to its marks and irreparably damage Prime Wire.

12. Based on the above, registration of PRIMELECT will cause loss, damage, and injury to Prime Wire and the purchasing public.

WHEREFORE, Prime Wire prays that this Notice of Opposition be sustained and that '243 Application be refused registration in Class 009.

Date: February 17, 2021

Respectfully submitted,

BUCHE & ASSOCIATES, P.C.

By: /s/ John K. Buche  
John K. Buche (CA Bar No. 239477)  
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Attorneys for Opposer,  
Prime Wire & Cable, Inc.

CERTIFICATE OF TRANSMISSION

I hereby certify that this NOTICE OF OPPOSITION is being filed electronically with the Trademark Trial and Appeal Board through ESTTA located at <http://estta.uspto.gov/>.

Date: February 17, 2021

/s/ Byron E. Ma  
Byron E. Ma

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on the Applicant DeoVolente Beheer BV, by forwarding said copy on February 17, 2021, via first class mail and electronic mail to Applicant's attorney of record:

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Date: February 17, 2021

/s/ Byron E. Ma  
Byron E. Ma