

ESTTA Tracking number: **ESTTA1132132**

Filing date: **05/07/2021**

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	JLG Industries, Inc.
Granted to Date of previous extension	05/08/2021
Address	1 JLG DRIVE MCCONNELLSBURG, PA 17233 UNITED STATES
Attorney information	DONNA J. BUNTON NIXON & VANDERHYE P.C. 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 UNITED STATES Primary Email: nixonptomail@nixonvan.com Secondary Email(s): djb@nixonvan.com, slg@nixonvan.com, clisenby@nixonvan.com 703-816-4003
Docket Number	3638-1871

Applicant Information

Application No.	79279812	Publication date	03/09/2021
Opposition Filing Date	05/07/2021	Opposition Period Ends	05/08/2021
International Registration No.	1517225	International Registration Date	01/15/2020
Applicant	S6 Innovations Inc. 305 - 740 4TH AVE. S., ALBERTA; LETHBRIDGE T1J0N9 CANADA		

Goods/Services Affected by Opposition

<p>Class 007. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Floating light and heavy machines, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines; light and heavy machinery, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines, wheel loaders, tiling machines for agriculture, combine harvester, timber harvesting machinery; floating cranes; cranes; floating excavating machines; excavator machines; floating operator cabs forexcavator machines, cranes and light and heavy machinery and equipment in the nature of dredging machines, earth movingmachines, mine working machines, drilling machines, tun-</p>

nel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines; operator cabs for excavator machines, cranes and light and heavy machinery and equipment, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines, wheel loaders, tiling machines for agriculture, combine harvester, timber harvesting machinery; operator cabs for amphibious vehicles; detachable cabs for amphibious vehicles; detachable cabs for excavator machines, cranes and light and heavy machinery and equipment, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines, wheel loaders, tiling machines for agriculture, combine harvester, timber harvesting machinery; floating detachable cabs for amphibious vehicles; floating detachable cabs for excavator machines, cranes and light and heavy machinery and equipment, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines


Class 037. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Rental, leasing, repair, and maintenance of heavy machinery; rental, leasing, repair, and maintenance of floating light and heavy machinery and equipment; rental, leasing, repair, and maintenance of light and heavy machinery and equipment; rental, leasing, repair, and maintenance of floating cranes; rental, leasing, repair, and maintenance of cranes; rental, leasing, repair, and maintenance of floating excavators; rental, leasing, repair, and maintenance of excavators; rental, leasing, repair, and maintenance of floating operator cabs for excavators, cranes and light and heavy machinery and equipment; rental, leasing, repair, and maintenance of operator cabs for excavators, cranes and light and heavy machinery and equipment; rental, leasing, repair, and maintenance of operator cabs for amphibious vehicles; rental, leasing, repair, and maintenance of detachable cabs for amphibious vehicles; rental, leasing, repair, and maintenance of detachable cabs for excavators, cranes and light and heavy machinery and equipment; rental, leasing, repair, and maintenance of floating detachable cabs for amphibious vehicles; rental, leasing, repair, and maintenance of floating detachable cabs for excavators, cranes and light and heavy machinery and equipment

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), 44(e) or 66(a)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3562608	Application Date	04/12/2006
Registration Date	01/13/2009	Foreign Priority Date	NONE
Word Mark	LIFTPOD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 007. First use: First Use: 2008/09/24 First Use In Commerce: 2008/09/24		

	AERIAL WORK PLATFORMS
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Attachments	78860397#TMSN.png(bytes) LIFEPOD-Notice of Opposition.pdf(556029 bytes)
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Signature	/Donna J. Bunton/
Name	DONNA J. BUNTON
Date	05/07/2021

The grounds are as follows:

(1) Application Serial No. 79/279,812 seeks registration of the mark LIFEPOD for the following description of goods and services and services in Class 7 and Class 37 (hereafter "Applicant's goods/services"):

Class 7: Floating light and heavy machines, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines; light and heavy machinery, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines, wheel loaders, tiling machines for agriculture, combine harvester, timber harvesting machinery; floating cranes; cranes; floating excavating machines; excavator machines; floating operator cabs for excavator machines, cranes and light and heavy machinery and equipment in the nature of dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines; operator cabs for excavator machines, cranes and light and heavy machinery and equipment, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines, wheel loaders, tiling machines for agriculture, combine harvester, timber harvesting machinery; operator cabs for amphibious vehicles; detachable cabs for amphibious vehicles; detachable cabs for excavator machines, cranes and light and heavy machinery and equipment, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines, wheel loaders, tiling machines for agriculture, combine harvester, timber harvesting machinery; floating detachable cabs for amphibious vehicles; floating detachable cabs for excavator machines, cranes and light and heavy machinery and equipment, namely, dredging machines, earth moving machines, mine working machines, drilling machines, tunnel boring machines, roadbuilding machines, loading and unloading machines, hoisting machines

Class 37: Rental, leasing, repair, and maintenance of heavy machinery; rental, leasing, repair, and maintenance of floating light and heavy machinery and equipment; rental, leasing, repair, and maintenance of light and heavy machinery and equipment; rental, leasing, repair, and maintenance of floating cranes; rental, leasing, repair, and maintenance of cranes; rental, leasing, repair, and maintenance of floating excavators;

rental, leasing, repair, and maintenance of excavators; rental, leasing, repair, and maintenance of floating operator cabs for excavators, cranes and light and heavy machinery and equipment; rental, leasing, repair, and maintenance of operator cabs for excavators, cranes and light and heavy machinery and equipment; rental, leasing, repair, and maintenance of operator cabs for amphibious vehicles; rental, leasing, repair, and maintenance of detachable cabs for amphibious vehicles; rental, leasing, repair, and maintenance of detachable cabs for excavators, cranes and light and heavy machinery and equipment; rental, leasing, repair, and maintenance of floating detachable cabs for amphibious vehicles; rental, leasing, repair, and maintenance of floating detachable cabs for excavators, cranes and light and heavy machinery and equipment.

(2) The application was filed on January 15, 2020 and is based on Applicant's bona fide intention to use the mark LIFEPOD in commerce pursuant to Section 1(b) of the Trademark Act.

(3) On information and belief, Applicant made no use of the mark LIFEPOD prior to the filing of Application Serial No. 79/279,812 and has not commenced use of the mark LIFEPOD in commerce in connection with any of the goods or services covered by said application.

(4) Opposer is recognized worldwide as a leading designer, manufacturer and marketer of access equipment, including lifts, aerial work platforms and telehandlers, and a wide range of parts and complementary accessories for such equipment, as well as parts, attachments and accessories for construction machines, earth moving machines, agricultural machines, loaders, hoists and hosting equipment, cranes and the like.

(5) Long prior to the filing date of Application Serial No. 79/279,812 on January 15, 2020, Opposer adopted and began using in commerce the mark LIFTPOD for "aerial work platforms" (hereafter "Opposer's goods").

(6) Opposer is the owner of the trademark LIFTPOD for “aerial work platforms”, having continuously used the mark LIFTPOD for those goods in commerce since September 2008.

(7) Opposer duly registered the trademark LIFTPOD in the United States Patent and Trademark Office, Registration No. 3,562,608, dated January 13, 2009. A printout from the PTO TSDR database evidencing the current status and ownership of Registration No. 3,562,608 is annexed hereto as Opposer’s Exhibit A.

(8) Registration No. 3,562,608 is *prima facie* evidence of the validity thereof, Opposer’s ownership and exclusive right to use the mark LIFTPOD in commerce and is constructive notice of Opposer’s ownership thereof, all as provided by §§ 7(b) and 22 of the Trademark Act of 1946. As Opposer’s right to use the mark LIFTPOD in commerce has become incontestable, Registration No 3,562,608 is conclusive evidence of Opposer’s right to use said mark in commerce on the goods specified in the registration, as provided by §§ 15 and 33(b) of the Trademark Act of 1946.

(9) By virtue of Opposer’s long, continuous and substantial promotion and sale of the goods covered by Registration No. 3,562,608 and its maintenance of high quality standards relating thereto, purchasers, consumers and users of such products, and others, have come to recognize the mark LIFTPOD as an indication of origin in Opposer, as a consequence of which Opposer has established valuable goodwill and exclusive rights in the mark LIFTPOD (hereafter “Opposer’s Mark”).

(10) On information and belief, Applicant was aware of Opposer and Opposer’s mark LIFTPOD at the time that the mark LIFEPOD was adopted and/or at the time that Application Serial No. 79/279,812 was filed.

(11) Opposer's mark LIFTPOD and Applicant's mark LIFEPOD are virtually identical, differing by only one letter; each two-syllable mark begins with the letters "LIF_" and ends with the word "POD." The marks LIFTPOD and LIFEPOD are visually and phonetically very similar and create strikingly similar commercial impressions.

(12) Opposer's goods promoted and sold under the mark LIFTPOD and Applicant's goods and services intended for use under the mark LIFEPOD are similar and closely related and overlapping products which are or are likely to be advertised, sold and distributed through the same or overlapping channels of trade to the same or overlapping classes of purchasers so that purchasers, prospective purchasers, users and others are likely to be confused, mistaken or deceived into the belief, contrary to fact, that Applicant's goods and services offered under the mark LIFEPOD emanate from and/or are in some way sponsored or approved by Opposer, or are otherwise related to Opposer's goods offered under the mark LIFTPOD, thereby damaging Opposer.

(13) Applicant is not lawfully entitled to the registration which it seeks for the reason, *inter alia*, that the mark LIFEPOD as used for Applicant's goods/services so resembles Opposer's previously used and registered mark LIFTPOD as to be likely to cause confusion, to cause mistake or to deceive within the meaning of Section 2(d) of the Federal Trademark Act, thereby damaging Opposer.

(14) On information and belief, Applicant lacked a bona fide intention to use the mark in U.S. commerce on the identified goods and services in Application Serial No. 79/279,812 as of the filing date of the application.

WHEREFORE, Opposer prays that the present opposition be sustained and the registration of the mark LIFEPOD sought by Applicant be refused.

The requisite filing fee is submitted herewith.

JLG INDUSTRIES, INC.

By its Attorneys

Date: May 7, 2021

By: Donna J. Bunton

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EXHIBIT A

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Mark: LIFTPOD

LIFTPOD

US Serial Number: 78860397

Application Filing Date: Apr. 12, 2006

US Registration Number: 3562608

Registration Date: Jan. 13, 2009

Register: Principal

Mark Type: Trademark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Feb. 01, 2019

Publication Date: Aug. 28, 2007

Notice of Allowance Date: Nov. 20, 2007

Mark Information

Mark Literal Elements: LIFTPOD

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

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: AERIAL WORK PLATFORMS

International Class(es): 007 - Primary Class

U.S Class(es): 013, 019, 021, 023, 031, 034, 035

Class Status: ACTIVE

Basis: 1(a)

First Use: Sep. 24, 2008

Use in Commerce: Sep. 24, 2008

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: JLG Industries, Inc.

Owner Address: 1 JLG Drive
McConnellsburg, PENNSYLVANIA UNITED STATES 172339533

Legal Entity Type: CORPORATION

State or Country: PENNSYLVANIA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Donna J. Bunton

Docket Number: DJB/6534-100

Attorney Primary Email Address: nixonptomail@nixonvan.com

Attorney Email Authorized: Yes

Correspondent

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Correspondent e-mail: nixonptomail@nixonvan.com djb@nixonvan.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Feb. 01, 2019	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Feb. 01, 2019	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	75461
Feb. 01, 2019	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	75461
Feb. 01, 2019	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	75461
Jan. 07, 2019	TEAS SECTION 8 & 9 RECEIVED	
Jan. 13, 2018	COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED	
Mar. 26, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Mar. 26, 2014	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	68335
Mar. 10, 2014	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	68335
Mar. 26, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Mar. 10, 2014	TEAS SECTION 8 & 15 RECEIVED	
Jan. 13, 2009	REGISTERED-PRINCIPAL REGISTER	
Dec. 09, 2008	LAW OFFICE REGISTRATION REVIEW COMPLETED	76568
Dec. 08, 2008	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Dec. 04, 2008	STATEMENT OF USE PROCESSING COMPLETE	76874
Nov. 20, 2008	USE AMENDMENT FILED	76874
Dec. 04, 2008	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76874
Nov. 20, 2008	PAPER RECEIVED	
May 29, 2008	EXTENSION 1 GRANTED	66154
May 20, 2008	EXTENSION 1 FILED	66154
May 20, 2008	PAPER RECEIVED	
Nov. 20, 2007	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Aug. 28, 2007	PUBLISHED FOR OPPOSITION	
Aug. 08, 2007	NOTICE OF PUBLICATION	
May 21, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	76568
May 18, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 26, 2007	AMENDMENT FROM APPLICANT ENTERED	76568
Apr. 26, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	76568
Apr. 26, 2007	ASSIGNED TO LIE	76568
Mar. 26, 2007	PAPER RECEIVED	
Sep. 25, 2006	NON-FINAL ACTION E-MAILED	6325
Sep. 25, 2006	NON-FINAL ACTION WRITTEN	76731

Sep. 16, 2006 ASSIGNED TO EXAMINER
Apr. 20, 2006 NOTICE OF PSEUDO MARK MAILED
Apr. 19, 2006 NEW APPLICATION ENTERED IN TRAM

76731

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Feb. 01, 2019