

ESTTA Tracking number: **ESTTA1152923**

Filing date: **08/12/2021**

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	Louis Poulsen A/S		
Entity	Aktieselskab	Citizenship	Denmark
Address	GAMMEL STRAND 28 COPENHAGEN K, 1202 DENMARK		

Attorney information	LISA A. HARKINS FLENER IP & BUSINESS LAW 77 W WASHINGTON STREET, SUITE 800 CHICAGO, IL 60602 UNITED STATES Primary Email: info@fleneriplaw.com Secondary Email(s): lharkins@fleneriplaw.com, zflener@fleneriplaw.com 3127248874		
Docket Number	CS-791		

Applicant Information

Application No.	90271992	Publication date	07/13/2021
Opposition Filing Date	08/12/2021	Opposition Period Ends	08/12/2021
Applicant	Google LLC 1600 AMPHITHEATRE PARKWAY MOUNTAIN VIEW, CA 94043 UNITED STATES		


Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 Opposed goods and services in the class: Light switches; lighting control panels; light systems comprising light sensors and switches; home climate devices and lighting products via wireless networks
Class 011. First Use: 0 First Use In Commerce: 0 Opposed goods and services in the class: light bulbs, lighting fixtures, lighting strips, and lamps
Class 037. First Use: 0 First Use In Commerce: 0 Opposed goods and services in the class: Installation of lighting
Class 042. First Use: 0 First Use In Commerce: 0 Opposed goods and services in the class: Providing temporary use of online non-downloadable software for controlling home automation systems, namely, lighting

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4004505	Application Date	06/04/2010
Registration Date	08/02/2011	Foreign Priority Date	12/04/2009
Word Mark	LP NEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 011. First use: First Use: 0 First Use In Commerce: 0 Lighting apparatus, namely, apparatus for street lighting in the nature of street lamps</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 [Wholesale store services and wholesale ordering services in the field of lighting apparatus, including wholesale store services and wholesale ordering services in the field of lighting apparatus that are available via global networks]</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 [Industrial design, in particular industrial design of lighting apparatus, including apparatus for street lighting]</p>		

Attachments	79085260#TMSN.png(bytes) 2021-08-12 Notice of Opposition CS-791 .pdf(100174 bytes)
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Signature	/Lisa A. Harkins/
Name	Lisa A. Harkins
Date	08/12/2021

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

In the Matter of U.S. Application Serial No. 90/271,992

For: NEST

Filed: October 22, 2020

Date of Publication: July 13, 2021

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LOUIS POULSEN A/S)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
Google, LLC)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer, Louis Poulsen A/S (“Opposer”), a public limited company organized under the laws of Denmark with its principal place of business at Gammel Strand 28, Copenhagen K, DK 1202, Denmark, believes it will be damaged by the registration of the mark in U.S. Application Serial No. 90/271,992 (“Serial No. 90/271,992”) and hereby opposes the same in accordance with Section 13 of The Trademark (Lanham) Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, Opposer alleges as follows:

1. Upon information and belief, Google, LLC (“Applicant”) is a Delaware limited liability company with its principal place of business at 1600 Amphitheatre Parkway, Mountain View, California 94043, United States.

2. As evidenced by the publication of Serial No. 90/271,992 in the Official Gazette of July 13, 2021, Applicant seeks to register NEST (the “Opposed Mark”) in connection with:

“Computer hardware for streaming and playing audio, video, and multimedia content, and for controlling televisions, monitors, gaming systems, DVD players, portable media players, and digital media streaming devices; Audio speakers; Loud Speakers; Wireless indoor and outdoor speakers; Voice controlled audio speakers; Electronic monitors and sensors for monitoring water, humidity levels, heat, temperature, air quality, light, movement, motion, sound, and the presence of people, animals and objects; Light switches; lighting control panels; light systems comprising light sensors and switches; Electronic locks; programmable locking systems comprised of electronic door locks and keypads; digital door locks; Electronic doorbells, namely, electric doorbells; electronic wirelessly enabled electric doorbells; electronic doorbells known as electric doorbells featuring a camera; intercoms; Smoke alarms, carbon monoxide alarms, fire alarms; access control and alarm monitoring systems; sound alarms; alarm sensors; security alarm controllers; keypads for use with security alarm devices; electronic key fobs being remote control apparatus; Stand alone information device, namely, voice and manual controlled audio speakers with personal digital assistant capabilities for streaming and playing audio, video, and multimedia content, for controlling televisions, monitors, gaming systems, DVD Players, portable media players, and digital media streaming devices; Stand alone information device, namely, voice and manual controlled audio speakers with personal digital assistant capabilities for accessing and searching online databases, websites, mobile phones, computers, tablets, smart phones, handheld computers, portable computers for documents, files, and other stored information on command; Stand alone information device, namely, voice and manual controlled audio speakers with personal digital assistant capabilities for providing personal concierge services for others initiated by voice-controlled commands via a mobile phone, computer, tablet, smart phone, handheld computer, portable computer, namely, adding and accessing calendar appointments, alarms, timers, reminders, making restaurant, travel, and hotel reservations, and making professional services appointments; Downloadable Software for controlling home automation systems, namely, lighting, appliances, HVAC systems, thermostats, air quality monitors and sensors, alarms and other safety equipment, locks, doorbells, cameras, and home monitoring equipment; Downloadable software for streaming and playing audio, video, and multimedia content, and for controlling televisions, monitors, gaming systems, DVD players, portable media players, and digital media streaming devices; Downloadable voice-controlled search engine software for obtaining data, images, audio and video via a global computer network; Computer network hubs and switches; Computer hardware for telecommunications; Computer networking hardware; Computer hardware for wireless content delivery; Downloadable computer application software for mobile phones, portable media players, handheld computers, namely, Downloadable software

for monitoring, controlling, integrating and managing multiple wireless network routers; Downloadable computer application software for mobile phones, portable media players, handheld computers, namely, Downloadable software for connecting, operating, controlling, integrating and managing networked consumer electronic devices, home climate devices and lighting products via wireless networks; electronic room temperature, humidity, and air quality sensors” in Class 09;

“Air conditioning, air cooling and ventilation apparatus and instruments; heating and cooling panels used for indoor heating and cooling purposes; HVAC units; light bulbs, lighting fixtures, lighting strips, and lamps; electric space heaters, air conditioners, and electric fans” in Class 11;

“Installation of electronic devices, computer hardware, and security and video surveillance products, HVAC systems, lighting, and appliances” in Class 37;

“Providing temporary use of online non-downloadable software for providing a personal voice-enabled digital assistant; Providing temporary use of online non-downloadable voice recognition software; Computer services, namely, providing a non-downloadable voice-controlled search engine for obtaining data, images, audio and video via a global computer network; Provision of Internet search engines; Providing temporary use of online non-downloadable software used to provide voice-controlled information and communications; Providing temporary use of online non-downloadable software for streaming and playing audio, video, and multimedia content, and for controlling televisions, monitors, gaming systems, DVD players, portable media players, and digital media streaming devices; Providing temporary use of online non-downloadable software for use in providing personal concierge services for others by voice-controlled commands via a mobile phone, computer, tablet, smart phone, handheld computer, portable computer, namely, adding and accessing calendar appointments, alarms, timers, reminders, making restaurant, travel, hotel reservations, and making professional services appointments; Providing temporary use of online non-downloadable software for controlling home automation systems, namely, lighting, appliances, HVAC systems, thermostats, air quality monitors and sensors, alarms and other safety equipment, locks, doorbells, cameras, and home monitoring equipment; Providing temporary use of non-downloadable computer software that allows the sharing and transmission of data and information between electronic devices for the purposes of facilitating environmental monitoring, control, and automation in homes; Installation of security and surveillance software” in Class 42

3. Upon information and belief, Applicant filed Serial No. 90/271,992 on October 22, 2020 based on an intent to use the Opposed Mark in commerce in connection with the claimed goods.

5. Since at least eight (8) years prior to the filing date for Serial No. 90/271,992, Opposer registered and has continuously used its LP NEST mark in connection with its goods in the United States.

6. Opposer is the owner of the following incontestable U.S. Trademark Registration for its LP NEST mark (hereinafter the "LP NEST Mark"):

Registration No. 4,004,505 for LP NEST for "Lighting apparatus, namely, apparatus for street lighting in the nature of street lamps" in Class 11 registered August 2, 2011.

7. The above-identified registration is valid, subsisting, uncancelled and is evidence of Opposer's exclusive right to use its LP NEST mark in commerce in connection with the goods specified in the registration.

8. Opposer's use of the LP NEST Mark has not been abandoned. Opposer has provided its goods throughout the United States, and its goods are associated with the LP NEST Mark among customers and the relevant trade.

9. In addition to its registered trademark rights, Opposer owns non-registered statutory and common law rights in and to its LP NEST Mark in the United States.

10. Applicant has no license, consent, or permission from Opposer to use or register the Opposed Mark.

11. The Opposed Mark so resembles Opposer's LP NEST Mark that it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of The

Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(d); and more particularly, the Opposed Mark and use thereof are likely to cause confusion in, or to cause mistake by, or to deceive the purchasing public into believing that the goods in Serial No. 90/271,992 originate with Opposer or otherwise are authorized, licensed or sponsored by Opposer.

12. By reason of all the foregoing, Opposer will be damaged by the registration of the Opposed Mark for the services covered by Serial No. 90/271,992, because registration of the mark would be in violation of Opposer's trademark rights.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained in favor of Opposer and that Serial No. 90/271,992 be denied registration. Opposer submits herewith its payment of the \$2,400 filing fee, as required by 37 C.F.R. §2.6(a)(17).

Respectfully submitted,

LOUIS POULSEN A/S

Lisa A. Harkins

Date: August 12, 2021 By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition was served on Applicant by first class mail and email this August 12, 2021, addressed to:

Emily Burns
1600 Amphitheatre Parkway
Mountain View, California 94043
United States

By: /s/ Lisa A. Harkins
Lisa A. Harkins