

ESTTA Tracking number: **ESTTA1185577**

Filing date: **01/19/2022**

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	HCL Technologies Limited
Granted to date of previous extension	01/19/2022
Address	806 SIDHARTH, 96 NEHRU PLACE NEW DELHI, 110019 INDIA

Attorney information	HOPE V. SHOVEIN BROOKS KUSHMAN P.C. 1000 TOWN CENTER, 22ND FLOOR SOUTHFIELD, MI 48075 UNITED STATES Primary email: trademarks@brookskushman.com Secondary email(s): hshovein@brookskushman.com, jringlel@brookskushman.com, ejbrooks@brookskushman.com 248-358-4400
Docket no.	IBM0248OC

Applicant information

Application no.	90683854	Publication date	09/21/2021
Opposition filing date	01/19/2022	Opposition period ends	01/19/2022
Applicant	Shenzhen Olight E-Commerce Technology Co., Ltd. 5TH FL., BLDG. A2, FUHAI INFO. HARBOR QIAOTOU, FUHAI SUBDISTRICT, BAO'AN DIST. SHENZHEN, N/A CHINA		

Goods/services affected by opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Batteries, electric; Bullet-proof clothing; Clothing for protection against accidents, irradiation and fire; Downloadable computer software for word processing; Electric navigational instruments; Intercoms; Protective helmets; Radios; Satellite and microwave communications apparatus to transmit communications from a vehicle to another vehicle, or from a vehicle to a satellite; Telescopic sights for artillery
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Grounds for opposition

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

False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols	Trademark Act Section 2(a)
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Marks cited by opposer as basis for opposition

U.S. registration no.	2742145	Application date	06/24/1996
Register	Principal		
Registration date	07/29/2003	Foreign priority date	NONE
Word mark	DOMINO		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: 1994/00/00 First Use In Commerce: 1995/00/00 computer software for use in accessing global information networks and developing global information network applications, developing and accessing local area network applications, and for use in personal information management, data processing applications, text processing applications, networking, electronic mail and instruction manuals sold as a unit		

U.S. application/ registration no.	NONE	Application date	NONE
Register	NONE		
Registration date	NONE		
Mark	DOMINO		
Goods/services	computer software, including a collaborative client-server software platform that provides, in part, email, calendars, instant messaging, discussions/forums, blogs, a personnel/user directory, as well as additional approval / workflow and document management applications		

Attachments	Notice of Opposition SHENZHEN OLIGHT - OMINO - with DOMINO reg.pdf(148220 bytes)
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Signature	/hope v shovein/
Name	HOPE V. SHOVEIN
Date	01/19/2022

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

In re Trademark Application Serial No. 90683854

Trademark: OMINO

HCL Technologies Limited)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
Shenzhen Olight E-Commerce)	
Technology Co., Ltd.)	
)	
Applicant.)	

NOTICE OF OPPOSITION

HCL Technologies Limited ("HCL" or "Opposer"), an India Limited Company, believes that it is and will continue to be damaged by Applicant's application to register the OMINO trademark for goods in Class 9 as set forth in Application Serial No. 90683854, and hereby opposes the referenced application.

As grounds for opposition, Opposer alleges as follows:

1. Applicant, Shenzhen Olight E-Commerce Technology Co., Ltd. ("Shenzhen Olight" or "Applicant"), filed intent-to-use based Application No. 90683854 for OMINO on Apr. 30, 2021, which application published in the Official Gazette of Sep. 21, 2021 in Class 9 for

Batteries, electric; Bullet-proof clothing; Clothing for protection against accidents, irradiation and fire; Downloadable computer software for word processing; Electric navigational instruments; Intercoms; Protective helmets; Radios; Satellite and microwave communications apparatus to transmit communications from a vehicle to another vehicle, or from a vehicle to a satellite; Telescopic sights for artillery.

2. Opposer HCL is a global technology company that was founded in 1976 as one of India's original IT garage start-ups. The HCL flagship offers a wide range of goods and services and has a presence across varied industry sectors. HCL offers an integrated portfolio of products, solutions, services, and IP built around Digital, IoT, Cloud, Automation, Cybersecurity, Analytics, Infrastructure Management and Engineering Services, amongst others, to help enterprises reimagine their businesses for the digital age. HCL has generated annual revenues of over US \$10 billion with more than 1,59,000 employees across the globe.

3. Since at least as early as 1994, Opposer, itself and through its predecessors-in-interest, has continuously used the DOMINO trademark in commerce in the United States in connection with computer software, including a collaborative client-server software platform that provides, in part, email, calendars, instant messaging, discussions/forums, blogs, a personnel/user directory, as well as additional approval / workflow and document management applications.

4. HCL is the owner of the DOMINO trademark in the United States, including incontestable U.S. Registration No. 2742145 for DOMINO, filed June 24, 1996, registered July 29, 2003, and claiming use from at least as early as 1994 for the following goods:

Class 9: Computer software for use in accessing global information networks and developing global information network applications, developing and accessing local area network applications, and for use in personal information management, data processing applications, text processing applications, networking, electronic mail and instruction manuals sold as a unit

This registration is valid and subsisting, uncanceled and unrevoked.

5. There is no issue as to priority. Opposer, itself and through its predecessors-in-

interest, has used the DOMINO trademark since at least as early as 1994, more than a quarter of a century prior to the Apr. 30, 2021 filing date of Applicant's intent-to-use based Application No. 90683854.

6. Opposer has expended considerable effort and expense in promoting its registered and common law DOMINO trademark and the goods and services associated therewith, with the result that the purchasing public has come to know and recognize the products and services of Opposer by this mark. Opposer has an exceedingly valuable good will established in its DOMINO trademark.

7. Applicant's OMINO trademark is substantially similar to Opposer's DOMINO trademark, and the goods identified are identical or so closely related to the goods of HCL as to be likely, when used in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 USC §1052(d).

8. Applicant's OMINO trademark so resembles Opposer's DOMINO trademark, and the goods identified are identical or so closely related to the goods of HCL as to be likely, when used in connection with Applicant's goods, to falsely suggest a connection with HCL in violation of Section 2(a) of the Lanham Act, 15 USC §1052(a).

9. Through extensive use and promotion of the DOMINO trademark by Opposer, Opposer's DOMINO trademark has become distinctive and famous as defined under Section 43(c)(2) of the Lanham Act, as amended, 15 USC 1125(c)(2), and it was famous prior to the filing date of Applicant's applications for the OMINO trademark.

10. Applicant's use and registration of the OMINO trademark is likely to cause and will cause dilution by blurring of Opposer's famous DOMINO trademark under the Trademark Act, Section 43(c). Furthermore, Applicant's registration of OMINO presents a bar to Opposer's efforts to prevent dilution by blurring or dilution by tarnishment.

11. If Applicant were granted the registration herein opposed, it would obtain at least a *prima facie* exclusive right to use of the OMINO trademark in connection with all the designated goods. Such registration would be a source of injury and damage to Opposer.

WHEREFORE, Opposer, HCL Technologies Limited, prays that Application Serial No. 90683854 for the OMINO trademark be rejected, denied and refused.

Respectfully submitted,

HCL Technologies Limited

By /hope v shovein/
Hope V. Shovein
BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075
Phone: 248-358-4400
Fax: 248-358-3351

Attorneys for Opposer

Date: January 19, 2022

Generated on: This page was generated by TSDR on 2022-01-19 19:30:50 EST

Mark: DOMINO

US Serial Number: 75124486

Application Filing Date: Jun. 24, 1996

US Registration Number: 2742145

Registration Date: Jul. 29, 2003

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: Mar. 23, 2013

Publication Date: Feb. 26, 2002 Notice of Allowance Date: May 21, 2002

Mark Information

Mark Literal Elements: DOMINO

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: computer software for use in accessing global information networks and developing global information network applications, developing and accessing local area network applications, and for use in personal information management, data processing applications, text processing applications, networking, electronic mail and instruction manuals sold as a unit

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: 1994

Use in Commerce: 1995

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: HCL TECHNOLOGIES LIMITED

Owner Address: 806 SIDHARTH, 96 NEHRU PLACE
NEW DELHI INDIA

Legal Entity Type: LIMITED COMPANY

State or Country INDIA
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Hope V. Shovein

Docket Number: GEOM0185TUS

Attorney Primary trademarks@brookskushman.com

Attorney Email Yes

Email Address:

Authorized:

Correspondent

Correspondent Hope V. Shovein

Name/Address: Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MICHIGAN UNITED STATES 48075

Phone: 248-358-4400

Fax: 248-358-3351

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 15, 2020	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Jan. 15, 2020	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Nov. 20, 2019	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Mar. 23, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Mar. 23, 2013	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	70131
Mar. 23, 2013	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	70131
Mar. 23, 2013	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70131
Mar. 12, 2013	TEAS SECTION 8 & 9 RECEIVED	
Dec. 04, 2009	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	69471
Dec. 04, 2009	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	69471
Nov. 23, 2009	TEAS SECTION 8 & 15 RECEIVED	
Jul. 08, 2008	CASE FILE IN TICRS	
Jul. 29, 2003	REGISTERED-PRINCIPAL REGISTER	
May 27, 2003	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Apr. 05, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Apr. 15, 2003	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Apr. 15, 2003	PAPER RECEIVED	
Mar. 03, 2003	NON-FINAL ACTION MAILED	
Feb. 07, 2003	STATEMENT OF USE PROCESSING COMPLETE	
Nov. 21, 2002	USE AMENDMENT FILED	
Nov. 21, 2002	PAPER RECEIVED	
May 21, 2002	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Feb. 26, 2002	PUBLISHED FOR OPPOSITION	
Feb. 06, 2002	NOTICE OF PUBLICATION	
Dec. 04, 2001	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 29, 2001	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Oct. 29, 2001	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Jul. 14, 2000	LETTER OF SUSPENSION MAILED	
May 30, 2000	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Nov. 29, 1999	CONTINUATION OF FINAL REFUSAL MAILED	

Jul. 29, 1999 CORRESPONDENCE RECEIVED IN LAW OFFICE
 Feb. 02, 1999 NON-FINAL ACTION MAILED
 Feb. 01, 1999 ASSIGNED TO EXAMINER
 Feb. 01, 1999 PREVIOUS ALLOWANCE COUNT WITHDRAWN
 Dec. 16, 1997 EXTENSION OF TIME TO OPPOSE RECEIVED
 Nov. 18, 1997 PUBLISHED FOR OPPOSITION
 Oct. 17, 1997 NOTICE OF PUBLICATION
 Sep. 12, 1997 APPROVED FOR PUB - PRINCIPAL REGISTER
 Aug. 18, 1997 CORRESPONDENCE RECEIVED IN LAW OFFICE
 Feb. 18, 1997 NON-FINAL ACTION MAILED
 Feb. 03, 1997 ASSIGNED TO EXAMINER

68603

59830

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Mar. 23, 2013

Assignment Abstract Of Title Information

Summary

Total Assignments: 2

Registrant: INTERNATIONAL BUSINESS MACHINES CORPORATION

Assignment 1 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [2575/0634](#)

Pages: 5

Date Recorded: Nov. 14, 2002

Supporting Documents: [assignment-tm-2575-0634.pdf](#)

Assignor

Name: [LOTUS DEVELOPMENT CORPORATION](#)

Execution Date: Oct. 21, 2002

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: [INTERNATIONAL BUSINESS MACHINES CORPORATION](#)

Legal Entity Type: CORPORATION

State or Country Where Organized: NEW YORK

Address: NEW ORCHARD ROAD
ARMONK, NEW YORK 10504

Correspondent

Correspondent Name: KENYON & KENYON

Correspondent Address: JAMES E. ROSINI
ONE BROADWAY
NEW YORK, NY 10004

Domestic Representative - Not Found

Assignment 2 of 2

Conveyance: NUNC PRO TUNC ASSIGNMENT EFFECTIVE 06/30/2019

Reel/Frame: [6796/0830](#)

Pages: 10

Date Recorded: Nov. 08, 2019

Supporting Documents: [assignment-tm-6796-0830.pdf](#)

Assignor

Name: [INTERNATIONAL BUSINESS MACHINES CORPORATION](#)

Execution Date: Oct. 09, 2019

Legal Entity Type: CORPORATION

State or Country NEW YORK
Where Organized:

Assignee

Name: [HCL TECHNOLOGIES LIMITED](#)

Legal Entity Type: LIMITED COMPANY

State or Country INDIA
Where Organized:

Address: 806 SIDHARTH, 96 NEHRU PLACE
NEW DELHI, INDIA

Correspondent

Correspondent HOPE V. SHOVEIN
Name:

Correspondent 1000 TOWN CENTER, 22ND FLOOR
Address: SOUTHFIELD, MI 48075

Domestic Representative - Not Found

From: TMOfficialNotices@USPTO.GOV
Sent: Saturday, March 23, 2013 11:01 PM
To: ibmtm@us.ibm.com
Subject: Trademark RN 2742145: Official Notice of Acceptance and Renewal under Sections 8 and 9 of the Trademark Act

Serial Number: 75124486
Registration Number: 2742145
Registration Date: Jul 29, 2003
Mark: DOMINO
Owner: INTERNATIONAL BUSINESS MACHINES CORPORAT, etc

Mar 23, 2013

NOTICE OF ACCEPTANCE UNDER SECTION 8

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

NOTICE OF REGISTRATION RENEWAL UNDER SECTION 9

The renewal application filed for the above-identified registration meets the requirements of Section 9 of the Trademark Act, 15 U.S.C. §1059. **The registration is renewed.**

The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.

Class(es):
009

TRADEMARK SPECIALIST
POST-REGISTRATION DIVISION
571-272-9500

REQUIREMENTS FOR MAINTAINING REGISTRATION IN SUCCESSIVE TEN-YEAR PERIODS

WARNING: Your registration will be canceled if you do not file the documents below during the specified time periods.

What and When to File: You must file a declaration of use (or excusable nonuse) **and** an application for renewal between every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

Grace Period Filings

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

*****The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.*****

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=75124486>. NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,742,145

United States Patent and Trademark Office

Registered July 29, 2003

**TRADEMARK
PRINCIPAL REGISTER**

DOMINO

INTERNATIONAL BUSINESS MACHINES CORPORATION (NEW YORK CORPORATION)
NEW ORCHARD ROAD
ARMONK, NY 10504 BY ASSIGNMENT LOTUS
DEVELOPMENT CORPORATION (DELAWARE CORPORATION) CAMBRIDGE, MA 02142

FOR: COMPUTER SOFTWARE FOR USE IN ACCESSING GLOBAL INFORMATION NETWORKS AND DEVELOPING GLOBAL INFORMATION NETWORK APPLICATIONS, DEVELOPING AND ACCESSING LOCAL AREA NETWORK APPLICATIONS, AND FOR USE IN PERSONAL

INFORMATION MANAGEMENT, DATA PROCESSING APPLICATIONS, TEXT PROCESSING APPLICATIONS, NETWORKING, ELECTRONIC MAIL AND INSTRUCTION MANUALS SOLD AS A UNIT, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 0-0-1994; IN COMMERCE 0-0-1995.

SN 75-124,486, FILED 6-24-1996.

PATRICIA EVANKO, EXAMINING ATTORNEY