

ESTTA Tracking number: **ESTTA765702**

Filing date: **08/19/2016**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Group Dekko, Inc.		
Entity	Corporation	Citizenship	Indiana
Address	2505 Dekko Drive Garrett, IN 46721 UNITED STATES		

Attorney information	Joseph S. Edelstein Taylor IP, P.C. 142 South Main St. Avilla, IN 46710 UNITED STATES mbrady@taylorip.com Phone:(260) 897-3400		
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Registration Subject to Cancellation

Registration No	4792492	Registration date	08/18/2015
International Registration No.	NONE	International Registration Date	NONE
Registrant	Deko-Light Elektronik-Vertriebs GmbH Auf der Hub 2 76307 Karlsbad, GERMANY		

Goods/Services Subject to Cancellation

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Electric and electronic apparatus and instruments for controlling light installations, namely, electronic controllers, electronic control units, printed circuit boards, and mixing desks in the nature of audio mixers for controlling light installations; computer software for controlling light installations; PC interface boards; printed circuit boards; LEDs; apparatus for controlling and regulating electricity in the field of LED technology, red-green-blue LED technology and white LED mixing technology</p>
<p>Class 011. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Electronically controlled lighting fixtures having conventional or LED technology; LED spotlights; lighting apparatus, namely, lighting installations for red-green-blue LED technology and for white LED mixing technology; infrared or radio-controlled LED lighting apparatus, namely, LED lighting fixtures</p>

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
No use of mark in commerce before application, amendment to allege use, or statement of use was filed	Trademark Act Sections 14(1) and 1(a), (c), and (d)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1946394	Application Date	06/24/1994
Registration Date	01/09/1996	Foreign Priority Date	NONE
Word Mark	G D GROUP DEKKO		
Design Mark			
Description of Mark	The mark consists, in part, of a stylized representation of the letters "G" and "D".		
Goods/Services	Class 035. First use: First Use: 1994/03/07 First Use In Commerce: 1994/03/07 providing accounting, business marketing consulting, and business management consultation services to a diversified group of independent companies in the fields of electrical wire-related products, plastics and plastics forming, low watt heater technology, and raw materials reclamation		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	GROUP DEKKO		
Goods/Services	electrical distribution systems for the distribution of AC and/or DC electrical energy or signals in an office environment, namely, electrical distribution harnesses, electrical receptacles in the nature of electrical outlets, electrical data receptacles, low voltage chargers for portable electronic devices, electric data connectors, electric power conductors, electrical connectors, electrical jumper cables, electrical power distribution blocks and electrical terminal boxes; electrical lighting fixtures and electrical lighting assemblies consisting primarily of lighting housings in the nature of electric lighting fixtures, lenses, and electrical connectors, sold as a unit; electrical heating devices in the nature of flexible heating elements, namely, molded electric heaters for commercial use, namely, foil heaters, flexible rope heaters, and printed thick film heaters		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	DEKKO		
Goods/Services	electrical distribution systems for the distribution of AC and/or DC electrical energy or signals in an office environment, namely, electrical distribution harnesses, electrical receptacles in the nature of electrical outlets, electrical data receptacles, low voltage chargers for portable electronic devices, electric data connectors, electric power conduct-		

	ors, electrical connectors, electrical jumper cables, electrical power distribution blocks and electrical terminal boxes; electrical lighting fixtures and electrical lighting assemblies consisting primarily of lighting housings in the nature of electric lighting fixtures, lenses, and electrical connectors, sold as a unit; electrical heating devices in the nature of flexible heating elements, namely, molded electric heaters for commercial use, namely, foil heaters, flexible rope heaters, and printed thick film heaters
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

Signature	/Joseph S. Edelstein/
Name	Joseph S. Edelstein
Date	08/19/2016

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

In the matter of Trademark Registration No. 4,792,492

For the mark DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH

Date registered: August 18, 2015

GROUP DEKKO, INC.,

Petitioner,

v.

Cancellation No. _____

DEKO-LIGHT ELEKTRONIK-VERTRIEBS GMBH,

Registrant.

PETITION TO CANCEL

Petitioner Group Dekko, Inc. is an Indiana corporation with a place of business at 2505 Dekko Drive, Garrett, Indiana 46738.

To the best of Petitioner's knowledge, the name of the current owner of the above-identified registration is Deko-Light Elektronik-Vertriebs GmbH, whose address is Auf der Hub 2, 76307 Karlsbad, Federal Republic of Germany.

Petitioner believes that it will be damaged by the continued registration of the above-identified registration and hereby petitions to cancel the same on the grounds stated below:

1. Petitioner is engaged in the business of producing and selling various electronic goods in the United States. Some of Petitioner's offered products include lighting systems, electronic distribution systems, and other power solutions for commercial and industrial settings.

2. Petitioner has used a family of marks with the “DEKKO” name and has continuously used various forms of the name “DEKKO” in commerce since 1953.

3. Some of Petitioner’s previously used forms of the “DEKKO” name include GROUP DEKKO INTERNATIONAL, GROUP DEKKO, DEKKO ENGINEERING, DEKKO HEATING TECHNOLOGIES, DEKKO SERVICES, DEKKO TECHNOLOGIES, and, most recently, DEKKO by itself.

4. Petitioner’s various forms of the name “DEKKO” are well-known in the office lighting and power distribution industries and associated with attractive designs and innovative solutions. Petitioner’s products have earned numerous design awards at industry trade shows and are the subject of numerous utility and design patents.

5. Petitioner owns U.S. Trademark Registration No. 1,946,394 for the mark G D GROUP DEKKO, which registered on January 9, 1996, for providing accounting, business marketing consulting, and business management consultation services to a diversified group of independent companies in the fields of electrical wire-related products, plastics and plastics forming, low watt heater technology, and raw materials reclamation.

6. Petitioner has been producing and selling lighting systems and electrical power distribution systems for commercial and industrial settings in the United States in association with various forms of the name “DEKKO” since 2008.

7. On April 17, 2014, Registrant filed Application Serial No. 79152690 for the mark DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design with the U.S. Patent and Trademark Office on an extension of use basis of International Reg. No. 1217692 for various electronic products and services, including electric and electronic apparatus and instruments for controlling light installations and electronically controlled lighting fixtures having conventional

or LED technology. International Reg. No. 1217692 has a listed priority date of October 23, 2013.

8. On August 18, 2015, the Patent and Trademark Office issued Registration No. 4,792,492 for the mark DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design for various electronic products and services, including electric and electronic apparatus and instruments for controlling light installations and electronically controlled lighting fixtures having conventional or LED technology in the name of Registrant.

9. Registrant's registration of the DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design was without Petitioner's permission or authorization.

10. On information and belief, it appears that Registrant is a German limited liability company which produces and sells lights and other related goods in the European Union through a network of dealers.

11. Also on information and belief, it appears that Registrant has a subsidiary company based in Hong Kong which produces and sells lights and other related goods in Asia through a network of dealers.

12. On October 22, 2015, Petitioner filed Application Serial No. 86796327 for the mark GROUP DEKKO and Application Serial No. 86796363 for the mark GD GROUP DEKKO & design with the U.S. Patent and Trademark Office based on actual use in commerce. The identified goods in both applications include electrical distribution systems for the distribution of ac and/or dc electrical energy or signals in an office environment and electrical lighting fixtures and electrical lighting assemblies. Both applications claim first use in commerce at least as early as January 1, 2008.

13. On November 24, 2015, Petitioner filed Application Serial No. 86830400 for the mark DEKKO LIGHTING with the U.S. Patent and Trademark Office based on an intent to use the mark in commerce. The identified goods are electrical lighting fixtures and electrical lighting assemblies.

14. On January 27, 2016, Petitioner filed Application Serial No. 86887985 for the mark D DEKKO and design and Application Serial No. 86888043 for the mark D DEKKO and design with the U.S. Patent and Trademark Office based on an intent to use the mark in commerce. The identified goods in both applications include electrical distribution systems for the distribution of ac and/or dc electrical energy or signals in an office environment and electrical lighting fixtures and electrical lighting assemblies.

15. On February 22, 2016, the U.S. Patent and Trademark Office issued Office Actions rejecting Petitioner's filed Application Serial Nos. 86796327, 86796363, 86830400, 86887985, and 86888043 based on a likelihood of confusion with the mark of Registration No. 4,792,492.

16. By reason of the foregoing, Registrant's continued ownership of Registration No. 4,792,492 is damaging to Petitioner.

CLAIM FOR RELIEF BASED ON LIKELIHOOD OF CONFUSION

17. Petitioner repeats and re-alleges each and every allegation contained in paragraphs 1-16 as if fully set forth herein.

18. The DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design mark has been cited by the U.S. Patent and Trademark Office to reject Petitioner's various trademark

applications based on a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

19. Petitioner established common-law trademark rights in the use of “DEKKO” in association with electronic and lighting systems since at least 2008.

20. Petitioner continuously used various forms of the name “DEKKO” in association with electronic and lighting systems in commerce more than 5 years before the October 23, 2013, priority date of Reg. No. 4,792,492.

21. Registrant’s use and registration of the DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design mark is without Petitioner’s permission or authorization.

22. By reason of the foregoing, Registrant’s continued ownership of Registration No. 4,792,492 is damaging to Petitioner.

CLAIM FOR RELIEF BASED ON NONUSE OF THE MARK

23. Petitioner repeats and re-alleges each and every allegation contained in paragraphs 1-16 as if fully set forth herein.

24. As of August 18, 2016, Registrant has not made any statement of use of the DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design mark in commerce.

25. On information and belief, Registrant only offers goods and services in association with the DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design mark in the European Union and Asia.

26. On information and belief, Registrant has not in fact offered for sale or sold any goods or services in association with the DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design mark in commerce and has no immediate plans to do so in the future. Accordingly, the registration is also void for non-use and must be cancelled.

27. By reason of the foregoing, Registrant's continued ownership of Registration No. 4,792,492 is damaging to Petitioner.

CLAIM FOR RELIEF BASED ON LACK OF BONA FIDE

INTENT TO USE THE MARK IN COMMERCE

28. Petitioner repeats and re-alleges each and every allegation contained in paragraphs 1-16 and 24-26 as if fully set forth herein.

29. On information and belief, Registrant had no bona fide intent to use the DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design mark in association with the listed goods in commerce on the April 17, 2014, filing date of Application Serial No. 79152690 which resulted in Registration No. 4,792,492. Accordingly, the registration is also void for lack of bona fide intent to use the mark in commerce and must be cancelled.

WHEREFORE, Petitioner requests that this Petition to Cancel be sustained in its favor and Registration No. 4,792,492 for the mark DEKO-LIGHT ELEKTRONIK VERTRIEBS GMBH & design be cancelled.

Please address all correspondence to Joseph S. Edelstein at jedelstein@taylorip.com and 142 S. Main St., Avilla, IN, 46710.

Respectfully submitted,

/ Joseph S. Edelstein /

Joseph S. Edelstein

Attorney for Petitioner

Electronically filed: *

TAYLOR IP, P.C.

P.O. Box 560

Avilla, IN 46710

Telephone: 260-897-3400

Facsimile: 260-897-9300

CERTIFICATE OF SERVICE

The undersigned hereby certifies that he has caused the foregoing **Petition to Cancel** to be served upon Registrant in these proceedings by depositing a true copy of the same with the United States Postal Service as Priority Mail Express in a sealed envelope, all necessary postage prepaid, addressed to Deko-Light Elektronik-Vertriebs GmbH, Auf der Hub 2, 76307 Karlsbad, Federal Republic of Germany, on this 19th day of August, 2016.

/ Joseph S. Edelstein /
Attorney for Petitioner
Group Dekko, Inc.