

TTAB

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



-----X  
 MERCATOR SOFTWARE, INC., )  
 )  
 Opposer, )  
 )  
 v. ) Opposition No. \_\_\_\_\_  
 )  
 MERCATA INC., )  
 )  
 Applicant. )  
 -----X

08-10-2001  
U.S. Patent & TMO/tm Mail Rpt Dt #76

08 OCT 2001 17 09:03  
U.S. PATENT & TRADEMARK OFFICE

BOX TTAB FEE  
Asst. Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Va. 22202-3513

**NOTICE OF OPPOSITION**

In the matter of trademark application Serial No. 75/78999, filed September 1, 1999 and published for opposition in the Official Gazette of June 12, 2001:

Mercator Software, Inc., a Connecticut corporation, having a business address of 45 Danbury Road, Wilton, Connecticut, believes that it will be damaged and hereby opposes the registration of said trademark. The grounds for opposition are as follows:

08/15/2001 TSMITH 00000191 7578999

01 FC:377 300.00 OP

1. Applicant, Mercata Inc., seeks to register "MERCATA" as a service mark for use with respect to "retail store services via a global computer network in the field of consumer electronics, hand and power tools, home and kitchen supplies, lawn and garden care equipment, gifts, sporting goods, fitness equipment and watches; advertising

fb.

the goods and services of others via a global computer network and television" in class 35.

2. Mercator Software, Inc. (hereinafter "Opposer") is and has for many years been engaged in the use of a global computer network relating to enterprise system integration software for data mapping, data conversion, electronic commerce, data warehousing, application linking, integration of web applications, cross platform applications, cross platform integration and electronic data interchange. The Opposer's goods and services are germane to Applicant's ability to provide retail store services via a global computer network resulting in a likelihood of confusion.

3. Opposer has used, since at least as early as December 11, 1992, and continues to use in commerce, the mark "MERCATOR" for, on and with respect to its goods and services which are interrelated to the Applicant's ability to provide retail store services via a global computer network.

4. Opposer adopted and began using the mark MERCATOR well in advance of Applicant's filing date.

5. By virtue of extensive use in commerce of the mark MERCATOR in the United States, the relevant trade and public have come to associate goods and services bearing its MERCATOR Family of Marks with Opposer and Opposer alone.

6. On information and belief, the goods of Applicant and the goods and services of Opposer are substantially identical and related.

7. Opposer's common-law trademark rights, trademark application and trademark registrations are referred to hereinafter as the "MERCATOR Family of Marks."

8. Applicant's "MERCATA" mark, as applied to the goods set forth in the application herein opposed, is so confusingly similar to Opposer's MERCATOR Family of Marks as applied to its good and services that it is likely to cause confusion, mistake and/or deception.

9. The respective marks are nearly identical in sight, sound and appearance.

10. If Applicant is permitted to register "MERCATA" for the goods set forth in the application, confusion of the trade and public is likely to result, such confusion resulting in damage and injury to Opposer.

11. Purchasers and potential purchasers, upon seeing Applicant's "MERCATA" mark used in connection with its goods are likely to believe, in error, that such goods are sold in association or affiliation with, endorsed by, or under license from Opposer.

12. If Applicant is permitted to register its mark for the services set forth in the application herein opposed, confusion of the relevant trade and public resulting in damage and injury to Opposer would be likely to result. Any persons familiar with the goods and services of Opposer would be likely to assume that Applicant's goods are sponsored by or produced under license from or otherwise affiliated with Opposer, or as goods that are a part of Opposer's varied line of products and services. Furthermore, any defect, objection to or fault found with Applicant's goods sold under its mark, and would necessarily reflect on and seriously injure the reputation that Opposer has established for its services and products sold under its MERCATOR Family of Marks.

13. If Applicant were granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer.

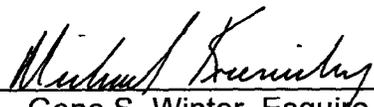
WHEREFORE, Opposer prays that registration of the mark of application No. 75/789999 be refused and that this opposition be sustained.

A duplicate copy of this Notice of this Opposition is enclosed herewith.

The filing fee of \$300.00 is enclosed herewith and any additional fees or deficiencies deemed to be due and owing in connection with this opposition may be charged to Deposit Account No. 19-4516 and any overpayment may be credited thereto.

Respectfully submitted,  
MERCATOR SOFTWARE, INC.

Date: August 10, 2001

By:   
Gene S. Winter, Esquire  
Michael W. Krenicky, Esquire  
**ST. ONGE STEWARD JOHNSTON & REENS LLC**  
986 Bedford Street  
Stamford, CT 06905  
(203) 324-6155  
Attorneys for Opposer