

TTAB
Exhibits

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

In the matter of Application Serial No. 76/079,893

Published in the Official Gazette of May 22, 2001



09-19-2001

U.S. Patent & TMOft/TM Mail Rcpt Dt #B:

ADEPTIS, INC.,

Opposer,

v.

ADEPTIA INC.,

Applicant.

Opposition
No. _____

NOTICE OF OPPOSITION

Commissioner for Trademarks
Box TTAB FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Madam:

In the matter of the application for the registration of the trademark ADEPTIA for providing business to business software development services for others, Serial No. 76/079,893, filed June 27, 2000, by Adeptia Inc. (hereinafter "Applicant") of Chicago, Illinois, published in the Official Gazette of May 22, 2001, Adeptis, Inc. (hereinafter "Opposer"), a corporation duly organized and existing under the laws of the State of Delaware, with its principal place of business in Waltham, Massachusetts, believes that it will be damaged by the issuance of the proposed registration and hereby opposes the application for registration of said mark.

09-19-2001 09:19:00 AM

09/24/2001 ZCLIFT01 00000100 76079893

01 FC:377

300.00 OP

The grounds for the opposition are as follows:

FACTS COMMON TO ALL GROUNDS FOR OPPOSITION

1. Opposer has been and is now extensively engaged in the business of consulting services, training and education services, and design and performance testing services in the fields of computer software, computer systems, and information technology systems, as well as custom software development services, all of which are provided in interstate commerce.

2. Opposer provides these services under its ADEPTIS service mark. Opposer has used its ADEPTIS service mark in interstate commerce since at least as early as February 1999. Since that time, Opposer has actively and widely used and promoted its ADEPTIS mark as its exclusive service mark for its consulting services, training and education services, design and performance testing services, and custom software development services.

3. Opposer's use in interstate commerce of its ADEPTIS mark in connection with its services is prior to Applicant's intent-to-use filing date of June 27, 2000, and prior to Applicant's alleged first use date of July 1, 2000, as claimed by Applicant in its application, United States Trademark Application Serial No. 76/079,893.

4. Opposer is the owner of pending United States Trademark Application Serial No. 76/217,037 for the mark ADEPTIS, for "consulting services in the fields of computer software, computer systems, and information technology systems; training and education services in the fields of computer software, computer systems, and information technology systems; design and performance testing services in the fields of computer software, computer systems, and information technology systems; custom software development services." A true and accurate copy of the filing receipt for this application is attached hereto as Exhibit A.

5. Opposer also has common law trademark rights in its ADEPTIS mark, having used the mark in commerce in connection with its services since at least as early as February

1999. Opposer's services bearing its ADEPTIS mark have been extensively and continuously offered and sold in commerce in the United States. Further, Opposer has advertised its services bearing the ADEPTIS mark in commerce in the United States, as evidenced on its Internet web site adeptis.com. True and accurate copies of printouts from Opposer's Internet web site are attached hereto as Exhibit B. By reason of such advertising, promotion and sale of Opposer's services under the ADEPTIS mark, Opposer has developed substantial goodwill in connection with its ADEPTIS mark. Opposer's ADEPTIS mark is distinctive and strong as applied to the services, and the mark is entitled to a broad scope of protection.

6. Notwithstanding Opposer's prior rights in and to the ADEPTIS mark, Applicant, on June 27, 2000, filed an application to register the mark ADEPTIA for providing business to business software development services for others. Said Application was given Serial No. 76/079,893 and the mark was published for opposition on May 22, 2001.

7. Upon information and belief, Applicant made no use of the mark ADEPTIA prior to the June 27, 2000 filing date of its intent-to-use application.

GROUND I – LIKELIHOOD OF CONFUSION

8. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 7 hereof as if fully set forth herein.

9. Applicant's ADEPTIA mark sought to be registered is confusingly similar to Opposer's ADEPTIS mark, and the registration of the mark and use by Applicant in association with its services is likely to cause confusion as to source, or origin, and mislead consumers, all to Opposer's damage. Opposer's mark and Applicant's mark are strikingly similar in sound, meaning, appearance and commercial impression. Further, the services of the parties are the same or closely related – both relating to software development services, and they are both offered in the same and/or similar channels of trade to the same and/or similar customers.

10. Registration by Applicant of the mark ADEPTIA would seriously damage Opposer and should be refused because use and/or registration of the ADEPTIA mark is likely to cause confusion in the minds of the public and deceive purchasers. The public, upon seeing Applicant's mark in connection with Applicant's services, would believe that such services originate with, or have some connection with, the Opposer, and Opposer avers that Applicant's use of said mark interferes with Opposer's use of its ADEPTIS mark and will and does impede Opposer in the free use of said mark; and registration of this mark by Applicant will seriously damage the Opposer under 15 U.S.C. § 1052(d).

11. Registration of ADEPTIA would be prima facie evidence of rights of Applicant under 15 U.S.C. § 1057(b), to the detriment of Opponent's rights in ADEPTIS.

12. Pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the infringing use of its ADEPTIA mark sought to be registered, and will give color and exclusive statutory right to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

GROUND II – DILUTION

13. Opposer hereby incorporates by reference the allegations of Paragraphs 1 through 12 hereof as if fully set forth herein.

14. Because of the high degree of distinctiveness of Opposer's ADEPTIS mark, the length of time and extent to which Opposer has used its ADEPTIS mark, the extensive advertising and publicity Opposer's ADEPTIS mark has received, the nationwide trading area in which the Opposer's ADEPTIS mark is used, and the high degree of customer recognition of the Opposer's ADEPTIS mark, ADEPTIS is a famous trademark pursuant to 15 U.S.C. § 1125(c)(1).

15. Registration of Applicant's ADEPTIA mark for providing business to business software development services for others would lessen the capacity of Opposer's famous ADEPTIS mark to identify and distinguish Opposer's services sold thereunder and,

as such, would cause dilution of the ADEPTIS mark in violation of 15 U.S.C. §§ 1125(c) and 1127.

16. Pursuant to 15 U.S.C. § 1063(a), as amended, Opposer believes it will be damaged by the registration sought by Applicant because such registration will support and assist Applicant in the infringing and diluting use of its ADEPTIA mark sought to be registered, and will give color and exclusive statutory right to Applicant in violation and derogation of prior and superior statutory and common law rights of Opposer.

WHEREFORE, Opposer believes that it will be damaged by the requested registration, and prays that it be denied.

Two copies of this Notice of Opposition, as well as the filing fee in the amount of \$300.00, are filed herewith.

Please recognize as attorneys for Opposer in this proceeding David O. Johanson and Emilia F. Cannella (members of the Bar of the Commonwealth of Massachusetts) and the firm of Bingham Dana LLP, 150 Federal Street, Boston, Massachusetts 02110. Please address all communications to David O. Johanson at the address below.

ADEPTIS, INC.



Dated: September 19, 2001

By: David O. Johanson
Emilia F. Cannella
BINGHAM DANA LLP
150 Federal Street
Boston, MA 02110
(617) 951-8000

Attorneys for Opposer,
Adeptis, Inc.

CERTIFICATE OF EXPRESS MAIL

Express Mail Label Number: EL705386792US

Date: September 19, 2001

By my signature below, I hereby certify that this Notice of Opposition (in duplicate) is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above, addressed to: Commissioner for Trademarks, Box TTAB FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Respectfully submitted,



Eileen M. Sullivan
Senior Trademark Paralegal

TTAB

BINGHAM DANA



09-19-2001

U.S. Patent & TMO's/TM Mail Rcpt Dt #8!

Emilia F. Cannella
Direct Dial: 617-951-8854
E-Mail: efcannella@bingham.com

September 19, 2001

Bingham Dana LLP
150 Federal Street
Boston, MA
02110-1726

T 617.951.8000
F 617.951.8736

www.bingham.com

Boston
New York
Washington
Los Angeles
Hartford
London
Singapore

VIA EXPRESS MAIL

Commissioner for Trademarks
Box TTAB FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Notice of Opposition
Mark: ADEPTIA
Serial No.: 76/079,893
Our Ref.: RLMSO-002

Dear Madam:

Enclosed are the following:

1. Opposition to U.S. Application Serial No. 76/079,893, in duplicate.
2. Check in the amount of \$300.00 for the government filing fee in connection with the opposition. Please charge any additional fees to Deposit Account No. 500927. An extra copy of this letter is attached for that purpose.
3. A self-addressed, stamped return acknowledgement postcard.

Very truly yours,

Emilia F. Cannella

cc: Mr. Steve Nevins
(w/enclosure)

T.A.