

TTAB

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

Applicant: ETERRA, LLC
Serial No.: 75/799,570
Filed: September 14, 1999
Published: October 16, 2001
Mark: ETERRA



01-10-2002

U.S. Patent & TMO/TM Mail Ropt Dt. #74

Alstom Esca Corporation)
)
Opposer,)
)
v.)
)
ETERRA, LLC)
)
Applicant.)

Opposition No.:

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

NOTICE OF OPPOSITION

Alstom Esca Corporation, a Washington corporation, located at 11120 NE 33rd Place, Bellevue, Washington 98004 (the "Opposer"), believes it would be damaged by registration of ETERRA as shown in Application Serial No. 75/799,570, and hereby opposes the same under the provisions of Section 13 of the Trademark Act of July 5, 1946 [15 U.S.C. Section 1063].

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GROUND FOR OPPOSITION

1. On or about December 9, 1999, Opposer filed an intent to use application for registration on the Principal Register for E-TERRA, Application No. 75/867,313, in Class 9 for computer software used to assist the energy industry in the generation, distribution, transmission and trading of energy and market management, namely platform software which is used to open and close breakers, for supervisory control and data acquisition of remote field devices, real-time generation control, real-time transmission network analysis, and for dispatcher training simulation.¹ (“Opposer’s Mark”).

2. On or about May 26, 2000, Opposer filed an Allegation of Use showing actual use of the mark in connection with the identified goods.

3. Since at least as early as November 12, 1999, Opposer has used Opposer’s Mark on or in connection with computer software. Opposer’s Mark is used with a family, or suite, of power management software products sold for use in the energy industry in the generation, distribution, transmission and trading of energy, and tools for use by deregulating utilities in market managements. Opposer’s Mark is used in very specific trade channels as follows:

- Transmission companies or transmission system operators.
- Energy trading organizations operating in bilateral or spot markets and trading future financial or physical commodities.
- Generation companies or independent power producers directly or indirectly involved in trading activities.

- 1 • Energy service companies involved in energy retailing business.
- 2 • Distribution companies operating in a deregulated competitive energy market.
- 3 • Central market (energy, ancillary services, or transmission) operators.

4
5 4. By virtue of its efforts, and the expenditure of substantial sums on promotional and
6 advertising activities, the excellence of Opposer's goods provided under Opposer's Mark,
7 and unsolicited media attention in connection with its mark, Opposer has gained valuable
8 goodwill with respect to E-TERRA in the energy industry.

9
10 5. Opposer's extensive promotion and use of Opposer's Mark have caused the
11 customers and potential customers in Opposer's trade channels to associate ETERRA with
12 Opposer and to believe that certain goods used in connection with Opposer's Mark have an
13 association with or are sponsored by Opposer.

14 6. Opposer's Mark ETERRA has acquired secondary meaning in the eyes of
15 Opposer's customers, potential customers and the trade by virtue of Opposer's continuous
16 and significant use and promotion of Opposer's Mark.

17
18 7. Upon information and belief, Applicant, ETERRA, LLC, is an Alaskan limited
19 liability company, located at 3330 Arctic Boulevard, Suite 101, Anchorage, Alaska 99503.

20
21 8. Applicant seeks to register ETERRA² ("Applicant's Mark") as a trade/service mark
22 for:

23
24 ¹ This is the current agreed identification of goods sold in conjunction with Opposer's mark following
Responses to Office Actions filed on or about May 26, 2000 and May 31, 2001, respectively.

25 ² Applicant has another pending application for "E-TERRA" in class 9. 35. 41 and 42 under Serial No.
75/782,867 for similar, but not identical, services. It is unclear why the Applicant has two pending
applications, and Opposer has opposed the pending application for "E-TERRA".

1 Analysis, conversion, consultation, installation, updating, diagnosis, programming,
2 integration, maintenance, design and implementation services, all done for others,
3 for a wide variety of software applications, websites, databases, digital information,
4 graphics and other data to support geographic information systems and automated
5 mapping, facilities management and other map-enabled applications; providing
6 databases, search engines and use of software applications for processing digital
7 information, graphics and other data on computers from a global computer network
8 and a wide variety of computer media, or objects on which data can be stored,
9 namely, hard discs, floppy discs, and CD-ROMS, to support geographic
10 information systems and automated mapping, facilities management and other
11 map-enabled applications.

12 9. The intent to use application for Applicant's Mark was originally filed by
13 GeoNorth, Inc., an Alaskan corporation, on or about September 14, 1999. The Applicant
14 was formed as a legal entity on or about September 15, 1999. On information and belief,
15 GeoNorth, Inc. assigned "the entire interest and good will" in the mark to Applicant on or
16 about July 27, 2000. At the time of the assignment, it appears that Applicant was already
17 using the mark ETERRA in commerce. Based on the fact that GeoNorth, Inc. (now known
18 as 3GLP, Inc.) is one of the members of the Applicant, and the other members of the
19 Applicant are officers and directors of GeoNorth, Inc., Applicant is an affiliate or
20 subsidiary of the entity that filed the intent to use application.

21 10. Applicant had no *bona fide* intention to use the applied-for mark, as required by
22 Section 1(b) of the Trademark Act of July 5, 1946 [15 U.S.C. Section 1051(b)], since the
23 Applicant was not even in existence at the time the application was filed. The later
24 assignment did not cure this defect since the assignment did not assign the entire goodwill
25 of GeoNorth, Inc. (both companies remained in existence and continued doing business
after the assignment). The Applicant's application was therefore *void ab initio*.

11. To the extent that the description of goods sold in conjunction with Applicant's
Mark prevents the Opposer's Mark from proceeding to registration it is overly broad. It is

1 clear that Applicant's services supporting Applicant's software products and trade channels
2 are entirely different and distinct from those of Opposer. The services sold in conjunction
3 with the mark ETERRA clearly relate solely to geographic information systems ("GIS")
4 and mapping applications. Opposer first learned of Applicant's Mark as a result of Office
5 Action Number 1 issued by the Patent and Trademark Office.³ After reviewing Opposer's
6 Mark and the use thereof, Applicant came to the conclusion that the marks are not
7 confusingly similar because no confusion in the trade channels in which the Opposer and
8 Applicant operate would be likely to occur. Opposer entered into negotiations with
9 Applicant to attempt to reach an agreement as to use and trade channels of the respective
10 marks to eliminate any potential likelihood of confusion and to forestall future disputes
11 between the parties. In May, 2000, the parties reached an agreement that there is no
12 likelihood of confusion between their respective marks, and that a concurrent use or
13 consent agreement would be appropriate. Opposer's counsel prepared a Concurrent Use
14 Agreement that reflected the discussions between the parties, and submitted it to counsel
15 for Applicant in August, 2000. In November, 2000, counsel for Opposer contacted
16 Applicant's counsel to determine the status of the review of the Concurrent Use
17 Agreement. Two weeks after that inquiry, Applicant's counsel informed the Opposer that
18 Applicant had "changed its mind" without any other explanation.

19 12. If Applicant were permitted to register Applicant's Mark to broadly cover services
20 supporting Applicant's computer software to the extent that it prevents Opposer's Mark
21 from proceeding to registration, Opposer's prior rights in Opposer's Mark would be lost.

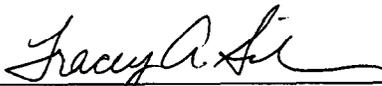
22 13. Opposer respectfully requests that Applicant's application be found to be *void ab*
23 *initio* or, in the alternative, that the registration of Applicant's Mark to the extent that it
24

25 ³ Opposer conducted a trademark search prior to filing its application, with the results being dated August 12,
1999. Applicant's application was filed on September 14, 1999.

1 prevents Opposer's Mark from proceeding to registration, as shown on Application Serial
2 No. 75/799,570, be denied and that this opposition be sustained.

3
4 Respectfully submitted,

5 Alstom Esca Corporation

6
7 By: 

8 David J. Sprinkle

9 Tracey A. Silva

Attorneys for Opposer

10 Dated: January 10th, 2002.

11
12 David J. Sprinkle
13 Tracey A. Silva
14 Lasher Holzapfel Sperry & Ebberson P.L.L.C.
15 601 Union Street, #2600
16 Seattle, Washington 98101-4000

17 **CERTIFICATE OF MAILING BY EXPRESS MAIL**

18 I hereby certify that this document is being deposited with the United States Postal
19 Service as Express Mail, label num. **EK448382168US** postage prepaid, in an
20 envelope addressed to: Assistant Commissioner for Trademarks, Box TTAB, FEE, 2900
21 Crystal Drive, Arlington, Virginia 22202-3513, on January 10th, 2002.

22 
23 Rebekah Grant

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CERTIFICATE OF SERVICE

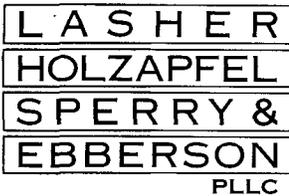
I, Rebekah Grant, hereby certify that I have this 10th day of January, 2002,
mailed by first class mail, postage prepaid, the forgoing Opposition to the following:

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01-10-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #74

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QUENTIN WILDSMITH

**Re: Our client Alstom Esca Corporation
Opposition to Mark ETERRA, 75/799,570**

Dear Sir or Madam:

Enclosed please find two originals of our Notice of Opposition to "ETERRA", Serial No. 75/799,570, along with a check in the sum of \$300.

Please return any responsive documents to this office as shown on the Notice of Opposition. Please call our office if you have any questions. Thank you for your assistance.

Very truly yours,

LASHER HOLZAPFEL
SPERRY & EBBERSON, P.L.L.C.

Rebekah Grant
Legal Assistant to David J. Sprinkle

/rg
Enclosures
cc: Alstom Esca Corporation

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