

EXHIBITS

VIA EXPRESS MAIL
#EU206441871 US

05-28-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #26

TAB

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

In the matter of Application Serial No. 75/845,350, INTELLIWEAR
Published in the *Official Gazette* on October 30, 2001

| | | |
|-----------------|---|--------------------------|
| -----X | : | |
| MARK D. TANNEN, | : | |
| | : | |
| Opposer, | : | |
| | : | Opposition No. 91 151109 |
| vs. | : | |
| | : | |
| JAY MACK, | : | |
| | : | |
| Applicant. | : | |
| -----X | : | |

**CORRECTED DECLARATION OF MARK D. TANNEN
IN SUPPORT OF OPPOSER'S MEMORANDUM IN
OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT**

I, Mark D. Tannen, declare:

1. I am the owner of American Intellware, a computer hardware and software systems business that I have operated and managed as a sole proprietorship since the early 1990's. I have been engaged for close to twenty (20) years in the development, marketing and sale of desktop and portable computer hardware and/or software systems, and computer software and related products and services.

2. American Intellware's computer hardware and software systems, computer software, services and manuals have been developed, marketed and/or sold under the marks AMERICAN INTELLIWARE, AI AMERICAN INTELLIWARE and Design or variants in numerous quantities in interstate commerce since at least as early as June 15, 1984, either by a predecessor company that I incorporated in California in 1983, namely, American Intellware Corporation ("AIC") or myself through my business American Intellware.

TRADEMARK TRIAL AND APPEAL BOARD
02 JUN -4 AM 23

K

3. Continuously since that time either through a predecessor American Intellware Corporation or through my own business American Intellware, I have advertised marketed and sold AMERICAN INTELLIWARE and AI AMERICAN INTELLIWARE and Design computer hardware and software systems and related goods and services, including, micro-processor-powered computers, manuals and associated software, and other software and hardware used for or in connection with data entry of graphics, sound and text by means of video, keyboard or hands-free (voice), data storage, data retrieval, and data (graphics and word) processing, and used for or in connection with word processing, faxing, electronic messaging or email, and for or in connection with connecting to networks of other computers and to the Internet. I have also rendered computer consulting services, system configuration and installation services under the marks.

4. Over the past several years alone, I have sold under the marks AMERICAN INTELLIWARE and/or AI AMERICAN INTELLIWARE and Design hundreds of computer hardware and software systems and related products and services amounting to hundreds of thousands of dollars in sales . Attached hereto as Exhibit 1 is a confidential summary of American Intellware's sales.

5. Since 1984, tens of thousands of dollars have been expended advertising AMERICAN INTELLIWARE and AI AMERICAN INTELLIWARE and Design computer hardware and software systems and related products and services.

6. On information and belief, significant professional consumers have come to associate the AMERICAN INTELLIWARE and AMERICAN INTELLIWARE and Design marks with my business American Intellware, particularly in conjunction with desktop and portable computer hardware and software systems, services and manuals. On information and

belief, as a result of the long, extensive and continuous development, marketing, advertising, sale, use and promotion of products bearing or services rendered by me under the marks AMERICAN INTELLIWARE and/or AI AMERICAN INTELLIWARE and Design, they have acquired significant professional consumer recognition, possess a favorable reputation and distinctiveness with an invaluable amount of goodwill, solely signifying my business American Intelliware as the source of computer hardware and software systems, computer software, computer services and/or related products and services and have become assets of considerable value to me.

7. I also won a valid U.S. Trademark registration No. 1,347,429 for the mark AI AMERICAN INTELLIWARE and DESIGN. The registration is valid and in force. The Certificate of Registration for the above referenced registration is Attached hereto and incorporated by reference as Exhibit 2.

8. On March 2, 1990, American Intelliware Corporation ("AIC") at a Board of Director's meeting approved the transfer of title of all its trademarks, copyrights and intellectual properties worldwide to me, in good faith, with the explicit understanding, that, if necessary, I would freely grant a license for their use of AMERICAN INTELLIWARE in New York as American Intelliware Corporation (CA) is restructured, expands or officially relocated to New York. A copy of AIC's Board of Directors meeting minutes is attached hereto and incorporated by reference as Exhibit 3.

9. The assignment of AIC's intellectual property to me, including United States Trademark Registration No. 1,347,429, occurred prior to June 1, 1994, and was later reflected in the form of an Assignment document on June 30, 1995, which was recorded with the Assignment Branch of the United States Patent and Trademark Office on July 28, 1995. A copy

of the Assignment as recorded with the United States Patent and Trademark Office is attached hereto and incorporated by reference as Exhibit 4.

10. The foregoing registration is valid, subsisting, and in full force and effect, and the assignment further demonstrates my ownership of the mark covered by such registration and used in commerce in connection with the goods and services identified in the registration. The above-cited registration is in addition to my common law trademark rights in AMERICAN INTELLIWARE, AI AMERICAN INTELLIWARE and Design and variants (hereinafter collectively referred to as the AMERICAN INTELLIWARE marks).

11. The AMERICAN INTELLIWARE marks have been used continuously on or in connection with the foregoing goods and services, either through my predecessor AIC or by myself, in connection with American Intelliware since 1984, and/or by myself since at least the early 1990's.

12. The AMERICAN INTELLIWARE Marks have been used continuously on or in connection with the foregoing goods and services. In particular, I developed and market under the AMERICAN INTELLIWARE marks STORYBOARDER® [United States Trademark Registration No. 1,355,167] and SCRIPTWRITER® [United States Trademark Registration No. 1,566,821], two software products which are uniquely designed to be intelligent, versatile and cost-effective productivity tools. They have been used extensively by professionals and educators, with a long history of credits over many years and sold under the AMERICAN INTELLIWARE Marks. These were originally two of the first, if not the first, professional multimedia software products on the market, and although they are sold separately, they are also sold together with other software as part of a complete "turnkey" computer system which

American Intelliware developed and markets under their mark MACFATS® [United States Trademark Registration No. 1,347,428].

13. Since the early 1990's and continuing to this day through my American Intelliware business, I bundle software under the AMERICAN INTELLIWARE marks with many other general software products for a great variety of multimedia software applications, word processing, graphics and Internet connectivity, just to name a few. In addition, I offer through American Intelliware a variety of made-to-order complete "turnkey" system bundles of computer hardware with packaged or pre-installed software, customized software and other software for a variety of general markets. I also render services, including consulting services, system configuration and purchasing services, long-term leasing and on-site installation and training. Moreover, each "turnkey" system is customized differently to suit the requirements of particular customers.

14. Under the AMERICAN INTELLIWARE marks through my business American Intelliware, I bundle "turnkey systems" with just about every kind of computer on many platforms; the configuration simply depends upon the customer's requirements. As such, it is fair to say that I offer a full spectrum of general software and hardware system bundles, of every conceivable make and model, customizing the "turnkey" system bundles with service and support, portability and mobility, or "networkability" as needed by customers. If a customer requires security systems, I add encryption software and hardware. If a customer needs OCR (optical character recognition) for rapid data input, I add OCR software and a page scanner. If a customer requires voice recognition, I add voice cognition software with microphone arrays. If graphics scanners for artwork are required, or if graphics tablets for handwriting recognition are required, I deliver them. If wireless Internet connectivity, worldwide web browsers with e-mail

capabilities, or wireless networking are required, I deliver them, too. Through American Intelliware, I even deliver wearable PDA computers with mobile software to customers, e.g., Kyocera SmartPhones with integrated PDA's (which can easily be worn) with 3G (broadband) secure Sprint PCS wireless web connectivity, e-mail, graphics, portable databases with handwriting recognition input. Hence, American Intelliware offers a broad variety of products and solutions.

15. The AMERICAN INTELLIWARE marks create a distinctive designation of the origin of my products and services and are used in connection with goods and services offered, authorized or sponsored by my business. Attached hereto as Exhibit 5 and incorporated by reference are representative examples of my current use of the AMERICAN INTELLIWARE Marks .

16. As a result of widespread and extensive use of the AMERICAN INTELLIWARE marks for computer hardware and software systems and related or complementary services and products, I have acquired significant goodwill in the individual AMERICAN INTELLIWARE marks. On information and belief, because of the use of the AMERICAN INTELLIWARE marks for a wide variety of products and services, consumers have come to associate the name AMERICAN INTELLIWARE exclusively with me and my business American Intelliware.

17. The first use of AMERICAN INTELLIWARE in connection with computer products and services was at least as early as 1984, almost 20 years ago. I have promoted to the professional consuming public many of these marks through telephones, demonstrations, newspapers, magazines, direct mail, trade shows and over the Internet. Indeed, the American Intelliware web site alone which has been operational since 2001, twenty-four

hours a day, seven days a week, 365 days a year, presents numerous uses of the AMERICAN INTELLIWARE marks. A copy of the web site is attached hereto and incorporated by reference as Exhibit 6.

18. Attached hereto as Exhibit 7 and incorporated by reference are representative examples of advertisements and promotional materials demonstrating use of the AMERICAN INTELLIWARE marks in connection with my business. On information and belief, significant professional consumers recognize the AMERICAN INTELLIWARE marks as being associated with American Intellware's business on account of such advertising, promotional materials and sale of products and services. Furthermore, over the years, there has been unsolicited press coverage of products sold under the AMERICAN INTELLIWARE marks in newspapers, magazines, trade publications and on the Internet. Representative examples are attached hereto as Exhibit 8 and incorporated by reference.

19. In view of my prior use of the AMERICAN INTELLIWARE marks as well as my registration, I filed through my attorneys a Notice of Opposition on February 27, 2002 against Applicant's United States Application Serial No. 75/845,350 for the mark INTELLIWEAR. A copy of the Notice of Opposition as filed is attached hereto as Exhibit 9.

20. Prior to the filing of Jay Mack's application on December 1, 1999, I used and promoted many of the AMERICAN INTELLIWARE marks in such a way as to create public perception of the marks as an indication of source. Indeed, the INTELLIWARE feature of the AMERICAN INTELLIWARE marks is itself distinctive as used in connection with computer hardware and software systems and related or complementary products and services. Indeed, American Intellware's customers very often verbally abbreviate the name simply as "INTELLIWARE" and my business is often referred to as INTELLIWARE at trade shows. By

virtue of my efforts and the expenditure of money for promotional activities and product development to establish the AMERICAN INTELLIWARE marks, my American Intelliware business has become known to many professionals and educators who use computers and multimedia, particularly in the multimedia marketplace.

21. On information and belief, Applicant's intended use of INTELLIWEAR, which is highly evocative of my goods and services in view of the historical and broad use of the AMERICAN INTELLIWARE marks, will be very likely to confuse American Intelliware's customers and those familiar with my business, products and services because of the similarity between the marks and goods and services. Indeed, INTELLIWEAR and INTELLIWARE are phonetic equivalents that convey similar impressions to consumers.

22. On information and belief, Jay Mack's INTELLIWEAR mark will be used for services which relate to the computer hardware and software industry. I have been engaged in the computer industry for close to two decades and have advertised, marketed and sold products and services under the AMERICAN INTELLIWARE marks for many years. My use of the AMERICAN INTELLIWARE marks is directly related to the Applicant's goods in that Applicant's wearable computers are geared toward consumers being able to wear mobile computer hardware and mobile software system bundles which are also offered by American Intelliware. American Intelliware has already sold smart wearable mobile cellular telephones with built-in PDA's and mobile software, similar to Jay Mack's products. Moreover, consumers are likely to encounter both of our products or services at similar or identical trade shows.

23. Since Jay Mack's alleged INTELLIWEAR products (wearable software and hardware systems) are a subset of, related to, and/or complement products I market and sell in a variety of markets, I may find myself at a computer hardware and software tradeshow at a

booth next to Applicant in the future, and the confusion would be obvious. On information and belief, because Jay Mack's apparently markets third-party solutions from other companies, I may also find myself marketing the same or related third-party products to identical customers in the near future.

24. In an effort to build up brand awareness and as a result of my substantial and extensive expenditure of time money, labor and other efforts in marketing and promoting American Intellware products and services under the AMERICAN INTELLIWARE marks, the public has come to recognize me and my business as the sole source of the products and services offered in connection and association with the AMERICAN INTELLIWARE marks.

25. I have accumulated incalculable good will associated with the AMERICAN INTELLIWARE marks. The AMERICAN INTELLIWARE marks are on information and belief strongly associated with American Intellware business, and have been used for a long time, advertised, and promoted so long that they are now very strong.

26. Since a date long prior to the filing date of the above identified application and continuing through the present, the AMERICAN INTELLIWARE marks have been identified with American Intellware business and have appeared on a significant amount of marketing materials, product packaging, and advertisements for goods and services. Accordingly, I have priority over Applicant because my use, whether or not through a predecessor or on my own, and/or the registration date for the AMERICAN INTELLIWARE marks predate the Applicant's filing date for its intent-to-use application. As a result of the long, extensive and continuous development, marketing, advertising, sale, use and promotion of products and services under the marks, the AMERICAN INTELLIWARE marks have acquired significant professional consumer recognition, possess a favorable reputation and distinctiveness

with an invaluable amount of goodwill, solely signifying my business as the source of computer hardware and software systems, computer software, services and/or related manuals and have become assets of considerable value to Opposer.

27. Since Opposer has advertised and marketed his products under the AMERICAN INTELLIWARE marks for more than 16 years, it would indeed be costly and damaging to American Intelliware if Applicant marketed and sold products under the designation INTELLIWEAR at a nearby booth at the same trade show, or if he were able to market similar products on the Internet or in the same newspaper or magazine pages under the mark INTELLIWEAR because of the likelihood of confusion that could result.

Pursuant to 28 U.S.C. § 1746, I, Mark D. Tannen, further declare under penalty of perjury that all statements made herein based on my own personal knowledge are true and that all statements made on information and belief are believed to be true.

Date: May 28, 2002

By: Mark D. Tannen
Mark D. Tannen

CERTIFICATE OF MAIL AND SERVICE

I hereby certify that the foregoing, CORRECTED DECLARATION OF MARK D. TANNEN IN SUPPORT OF OPPOSER'S MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT was deposited with the United States Postal Service "Express Mail Post Office To Addressee Service" in an envelope with sufficient postage, addressed to:

Box TTAB NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

and a true and correct copy of the foregoing was served on Applicant's attorneys of record via the United States Postal Service as First Class Mail, in an envelope with sufficient postage, addressed to following:

Robert T. Daunt, Esq.
DAVIS & SCHROEDER
215 W. Franklin Street, 4th Floor
Post Office Box 3080
Monterey, California 93942

on May 28, 2002.

By: 
Paul J. Reilly