

TTAB

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

In the matter of trademark application Serial No. 76121013
For the mark "MAP*IT"
Published in the Official Gazette on April 23, 2002



05-09-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #26

IT-Map, Inc.

v.

Maersk Logistics International A/S

NOTICE OF OPPOSITION

The name, address and state of incorporation of opposer is:

IT-Map, Inc.
534 Burdick Street
Libertyville IL 60048
State of Incorporation: Illinois

Correspondence should be sent to:

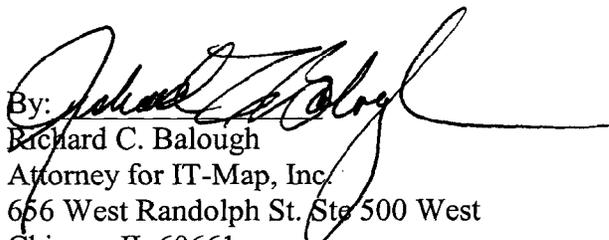
Richard C. Balough
Attorney at Law
6565 West Randolph St. Ste. 500 West
Chicago IL 60661

The above-identified opposer believes that it will be damaged by registration in classes 9 and 42 of the mark shown in the above-identified application and hereby opposes the same.

The grounds for opposition are as follows:

1. IT-Map, Inc. is a corporation incorporated under the laws of the State of Illinois.
2. IT-Map, Inc. develops software to assist corporations in managing and controlling their data bases.
3. IT-Map, Inc. has registered with the United States Patent and Trademark Office on the Principal Register the mark "IT-Map", Registration No. 2,476,077 with the first use date of February 1, 1998 in the United States.
4. The IT-Map mark is registered in Class 9 for: "Computer software for data management, record retrieval and document imaging used in information technology management and planning in the field of corporate management and planning."

5. The IT-Map mark also is registered in Class 42 for: "Computer software development and consulting in the field of corporate management and planning."
6. IT-Map, Inc., has spent considerable time, effort and funds to develop and to use the IT-Map mark.
7. Applicant's intent to use filing is for the mark "Map*IT" in the same in the exact same classes as IT-Map, Inc.'s mark.
8. Applicant's mark merely transposes the two words used in Opposer's registered mark.
9. There is a likelihood of confusion by the users of opposer's products between Opposer's registered mark "IT-Map" and Applicant's proposed mark "Map*IT."
10. A demonstration of the confusion has been shown by the Trademark Office itself in IT-Map, Inc.'s application No. 76/073566 for the mark "IT-Map 2000." In the First Office Action in 76/073566, the examining attorney cited the pending "Map*IT" mark of Applicant as a reason to suspend IT-Map's application stating "there may be a likelihood of confusion between the marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d)." A copy of the First Office Action is attached as Exhibit A to this opposition.
11. On January 28, 2002, the Trademark Office issued a Non-Final Action-Suspension to IT-Map, Inc.'s application 76/073566 again finding that the "Map*IT proposed mark would cause a likelihood of confusion with the "IT-Map 2000" mark. A copy of the Non-Final Action is attached as Exhibit B to this opposition.
12. As a result of the examining attorney's finding in Ser. No. 76/073566, it is clear that if "IT-Map 2000" is confusingly similar to "Map*IT" to prevent the registration of "IT-Map 2000", then certainly "Map*IT" is confusingly similar to the registered mark "IT-Map."
13. Because a consumer would be confused by the similarity of the marks "IT-Map" and "Map*IT" for similar services provided by the two companies, IT-Map, Inc. would be harmed if the mark "Map*IT" were approved.

By: 
Richard C. Balough
Attorney for IT-Map, Inc.
656 West Randolph St. Ste 500 West
Chicago IL 60661
312.902.9970
Fax: 312.902.9981
Email: rbalough@balough.com

Placed with the U. S. Postal Service with adequate postage paid on this 6th day of May 2002.

EXHIBIT A

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 76/073566 IT-Map Inc.	APPLICANT IT-MAP INC.	PAPER NO. _____
MARK IT-MAP 2000		ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov If no fees are enclosed, the address should include the words "Box Responses - No Fee." Please provide in all correspondence: 1. Filing Date, serial number, mark and applicant's name. 2. Filing date of this Office action. 3. Examining Attorney's name and Office number. 4. Telephone number and ZIP code.
ADDRESS RICHARD C. BALOUGH IT-MAP INC. 656 WEST RANDOLPH, 5TH FLOOR CHICAGO, IL 60661	ACTION NO. 01	
FORM PTO-1525 (5-90)	MAILING DATE 02/16/01	
U.S. DEPT. OF COMM. PAT. & TM OFFICE TRADEMARK LAW OFFICE 107 Serial Number: 76/073566 Mark: IT-MAP 2000 **Please Place on Upper Right Corner** **of Response to Office Action ONLY **	REF. NO. Richard C. I	

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 76/073566 - IT-MAP 2000

The assigned examining attorney has reviewed the referenced application and determined the following.

Prior Pending Applications

Although the examining attorney has searched the Office records and has found no similar *registered* mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), the examining attorney encloses information regarding pending Application Serial Nos. 75425147, 75889539 and 76121013 (priority date March 2, 2000). The filing and/or priority dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If the referenced applications mature into registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01.

Applicant Must Disclaim 2000

Trademark Act Section 6(a), 15 U.S.C. Section 1056(a), states that the Commissioner may require the applicant to disclaim an unregistrable component of a mark. Trademark Act Section 2(e), 15 U.S.C. Section 1052(e), bars the registration of a mark which is merely descriptive of the goods.

Moreover, a component of a mark that is generic is likewise barred from registration. TMEP 1209.01(c). If an applicant does not comply with a disclaimer requirement, the examining attorney may refuse registration of the entire mark. TMEP section 1213.01(b).

The term 2000 is merely descriptive of the identified goods because it describes a feature of the goods, namely, that they were capable of use in the year 2000. Accordingly, the applicant must insert a disclaimer of 2000 in the application. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.09(a)(i).

A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use 2000 apart from the mark as shown.

Specimen does not Show Use of Mark in Connection with Services

The specimen is unacceptable as evidence of actual service mark use because it does not show the mark used in connection with the recited services in commerce. The applicant must submit a specimen showing the mark as it is used in commerce. 37 C.F.R. Section 2.56. Examples of acceptable specimens are signs, photographs, brochures or advertisements that show the mark used in the sale or advertising of the services. TMEP section 1301.04. *Please note* that tags, labels, instruction manuals or containers are usually not acceptable specimens to show a service mark used in commerce. The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimen was in use in commerce at least as early as the filing date of the application. 37 C.F.R. Section 2.59(a); TMEP section 905.10.

Meaning of MAP

If the examining attorney is not satisfied that there is sufficient information in the record, or that he or she can secure sufficient information from sources available to him or her, to permit proper examination of the application, the examining attorney may request the applicant to furnish information. 37 C.F.R. §2.61(b). The examining attorney has an affirmative duty to seek out information necessary for proper examination. *Bart Schwartz International Textiles, Ltd. v. Federal Trade Commission*, 289 F.2d 665, 129 USPQ 258 (C.C.P.A. 1961), *aff'g* 121 USPQ 99 (TTAB 1959). TMEP section 1105.02.

Please state whether the term MAP has any meaning in the industry or as applied to the software stated in the identification of goods. In addition, please state whether the letters "MAP" are an acronym and, if so, the words they represent. Please state whether the words they represent have any significance in the relevant trade or industry or as applied to the goods. If the words represented are not in English, please provide translations of those words. In addition, please state whether the letters "MAP" have any other meaning.

Response Guidelines

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying

information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



Gwen P. Stokols
Trademark Attorney
Law Office 107
(703) 308-9107, ext. 275

[Typed Drawing]

Mark

ITMAP

Pseudo Mark

IT MAP

Goods and Services

IC 035. US 100 101 102. G & S: Business consulting services, namely, consultation services in the nature of assessing and recommending the appropriate computing environment for business marketing purposes

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75425147

Filing Date

January 28, 1998

Filed ITU

FILED AS ITU

Owner Name and Address

(APPLICANT) Electronic Data Systems Corporation CORPORATION DELAWARE 5400
Legacy Drive M/S H3-3A-05 Plano TEXAS 75024

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

L JOY GRIEBENOW

C-IT MAP

Mark

C-IT MAP

Pseudo Mark

C IT MAP; SEE IT MAP

Goods and Services

IC 009. US 021 023 026 036 038. G & S: Computer software, namely software for the management, retrieval, analysis and visualization of data and information, as well as software for the development, deployment and utilization of applications which provide for the management, retrieval, analysis, presentation and visualization of information through graphics and textual representations of data, for use on personal computers and other personal computing devices, network servers and clients, web servers and web browsers and navigation devices

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

75889539

Filing Date

January 7, 2000

Filed ITU

FILED AS ITU

Owner Name and Address

(APPLICANT) ObjectFX Corporation CORPORATION MINNESOTA Suite 200 2515
Wabash Avenue St. Paul MINNESOTA 55114

Type of Mark

TRADEMARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

Frank S. Farrell

MAP*IT

Mark

MAP*IT

Pseudo Mark

MAP IT

Goods and Services

IC 009. US 021 023 026 036 038. G & S: Computer software

IC 042. US 100 101. G & S: Development, maintenance, repair,
installation and implementation of computer software

Mark Drawing Code

(1) TYPED DRAWING

Serial Number

76121013

Filing Date

September 1, 2000

Filed ITU

FILED AS ITU

Owner Name and Address

(APPLICANT) Maersk Logistics International A/S CORPORATION DENMARK
Kalkbraenderihavnsgeade 4, st. DK-2100 Kobenhavn 0 DENMARK

Section 44 Indicator

SECT44

Priority Date

March 2, 2000

Type of Mark

TRADEMARK. SERVICE MARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

Attorney of Record

JOSEPH J VILLAPOL

EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO. 76/073566 IT-Map Inc.	APPLICANT 	PAPER NO.
MARK IT-MAP 2000		ADDRESS: Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513 www.uspto.gov <small>If no fees are enclosed, the address should include the words "Box Responses - No Fee."</small>
ADDRESS RICHARD C. BALOUGH IT-MAP INC. 656 WEST RANDOLPH, 5TH FLOOR CHICAGO, IL 60661		
ACTION NO. U2	MAILING DATE 01/28/02	
FORM PTO-1525 (5-90)		REF. NO. Richard C.
U.S. DEPT. OF COMM. PAT. & TM OFFICE TRADEMARK LAW OFFICE 107 Serial Number: 76/073566 Mark: IT-MAP 2000 **Please Place on Upper Right Corner** **of Response to Office Action ONLY **		Please provide in all correspondence: ing Date, serial number, mark and plicant's name. iling date of this Office action. amining Attorney's name and w Office number. ur telephone number and ZIP code.

RE: Serial Number: 76/073566 – IT-MAP 2000

NON-FINAL ACTION - SUSPENSION

This letter responds to the applicant's communication filed on August 16, 2001.

Application is SUSPENDED

In the office action dated February 16, 2001, the examining attorney cited a prior pending trademark/service mark application, which, upon registration, could give rise to a likelihood of confusion with the applicant's mark. In addition, the examining attorney required the applicant to provide a disclaimer, submit a substitute specimen and state the meaning of MAP.

In its response, the applicant traversed the prior pending applications. The examining attorney has carefully considered the applicant's arguments, but remains unpersuaded as to Serial Numbers 75425147 and 76121013 (Serial Number 75889539 has been abandoned). Accordingly, action on this application is **SUSPENDED** pending the disposition of Application Serial Numbers 75425147 and 76121013. Because applicant's effective filing date is subsequent to the effective filing dates of the aforesaid applications, the latter, if and when they register, may be cited against this application. See 37 C.F.R. §2.83. A copy of information relevant to this pending application(s) was sent previously.

The applicant may request that the application be removed from suspension by presenting arguments related to the potential conflict between the relevant applications or other arguments related to the ground for suspension. The applicant's election to present or not to present arguments at this time will not affect the applicant's right to present arguments later.

Additional Requirements CONTINUED

Also in its response, the applicant provided the required disclaimer, submitted substitute specimens and stated the meaning of MAP. The disclaimer and meaning of MAP are accepted and made of record.

The following requirement is CONTINUED:

Specimens for Class 9 Goods

The specimens for Class 42 are acceptable. The specimens are unacceptable as evidence of actual trademark use in connection with the class 9 goods because they do not show the mark used in connection with the identified goods in commerce. The applicant must submit a specimen showing the mark as used in commerce. 37 C.F.R. Section 2.56. Examples of acceptable specimens are tags, labels, instruction manuals, containers or photographs that show the mark on the goods or packaging. *Please note* that signs, photographs, brochures or advertisements are usually not acceptable specimens to show a mark used in commerce.

The applicant must verify, with an affidavit or a declaration under 37 C.F.R. Section 2.20, that the substitute specimen was in use in commerce at least as early as the filing date of the application. *Jim Dandy Co. v. Siler City Mills, Inc.*, 209 USPQ 764 (TTAB 1981); 37 C.F.R. Section 2.59(a); TMEP section 905.10.

For the applicant's convenience, the following is a properly worded declaration under 37 C.F.R. Section 2.20:

The substitute specimen was in use in commerce at least as early as the filing date of the application.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

(Signature)

(Date)

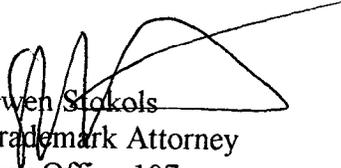
(Print or Type Name and Position/Title)

Declaration in Support of Class 42 Specimens

Please note, the declaration submitted in support of the substitute specimens for Class 42 failed to state that "the substitute specimen was in use in commerce at least as early as the filing date of the application."

Thus, a substitute declaration for the Class 42 services must be submitted.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



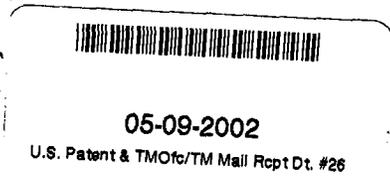
Gwen Stokols
Trademark Attorney
Law Office 107

Telephone: 703-308-9107, ext. 275
Fax: (703) 746-8107

richard c. balough •

attorney at law

6 May 2002



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

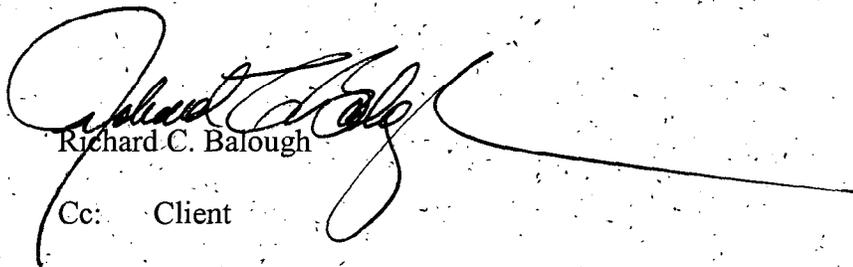
Re: Opposition for Serial No. 76121013; Mark: "MAP*IT"

Dear Sir or Madam:

Enclosed please find the Notice of Opposition for Ser. No. 76121013; Mark "MAP*IT" along with check No. 1176 in the amount of \$600. I am also enclosing a post card receipt.

Thank you for your prompt attention to this matter.

Sincerely,



Richard C. Balough

Cc: Client

Mr. Joseph J. Villapol
Ladas & Parry
26 W. 61st St.
New York NY 10023-7604

02 MAY 22 AM 8:23
TRADEMARK TRIAL AND
APPEAL BOARD