

In re trademark application: 76/156,933
Filed: October 31, 2000
Applicant: Valverde Investments, Inc. by assignment from
Rodolfo Ibarra and Fernando Valverde
Mark: BACKPAGE
For: Computer software used to assist in the design and
deployment of software applications on the Internet;
computer software used to pair or join two or more
existing web pages such that they travel throughout
the Internet as one entity
International Class: 9
Published: September 17, 2002

A copy of the publication notice is attached to this Notice of Opposition as Exhibit 1 -
Official Gazette (Trademark), September 17, 2002 at TM-404.

The grounds for this Opposition are as follows:

1. Opposer is in the business, *inter alia*, of developing and marketing a wide variety of computer software and related products and services, including software for designing and deployment of software applications on the Internet and numerous Internet-related products and services.
2. Beginning as early as October 11, 1995, and well prior to the October 31, 2000 filing date of Applicant's intent-to-use application, Opposer and its predecessor-in-interest have used the mark FRONTPAGE in connection with computer software for the design and development of Internet applications.
3. Opposer's predecessor Vermeer Technologies, Inc. ("Vermeer") applied for and received United States Trademark Registration No. 2,046,526 for the mark FRONTPAGE for computer authoring software for use on computer communication networks, namely, software for creating, editing and delivering textual and graphic information, locally and remotely, and instruction manuals sold as a unit. Said registration and all rights in the registered FRONTPAGE mark were assigned to Opposer by virtue of Articles of Merger recorded by the United States Patent

and Trademark Office at reel 1809, frame 0552. Opposer continues to maintain said registration, which is valid and subsisting. A copy of the registration is annexed hereto as Exhibit 2.

4. Opposer's mark FRONTPAGE symbolizes extensive good will and consumer recognition which have been developed by Opposer and its predecessor through substantial sales of goods under the mark and through substantial and extensive advertising, promoting and popularizing of the FRONTPAGE mark in the United States. This use and promotion includes Opposer's FRONTPAGE Logo program, under which software developers who designed and deployed their Internet applications and web sites using Opposer's FRONTPAGE product displayed FRONTPAGE logos on their website to promote that their sites were created and managed using Opposer's FRONTPAGE software.

5. As a result of Opposer's and consumers' use and advertising of Opposer's FRONTPAGE trademark, the mark is well known in the United States and is recognized as identifying the high-quality goods of Opposer. The FRONTPAGE mark and the associated goodwill are valuable assets of Opposer.

6. Applicant's BACKPAGE mark and Opposer's FRONTPAGE mark share the root word "PAGE." The term "BACK," shown in Applicant's mark, and the term "FRONT," shown in Opposer's mark, are associative terms. The mark BACKPAGE will be immediately associated with FRONTPAGE in the minds of relevant consumers. *See Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367 (Fed. Cir. 2002) (confusion likely between Applicant's POWERWAVE and Opposer's ACOUSTIC WAVE and WAVE marks); *The Downtowner Corp. v. Uptowner Inns, Inc.*, 178 U.S.P.Q. 105 (T.T.A.B. 1973) (the marks UPTOWNER and DOWNTOWNER found to be "associative" in nature and confusingly similar), and *National Ass'n of Blue Shield Plans v. United Bankers Life Ins. Co.*, 362 F.2d 374 (5th Cir. 1966) (likelihood of confusion between the BLUE SHIELD and RED SHIELD marks).

7. Applicant's BACKPAGE mark for "computer software used to assist in the design and deployment of software applications on the Internet; computer software used to pair or join two or more existing web pages such that they travel throughout the Internet as one entity," as described

in the subject application, is confusingly and deceptively similar to Opposer's FRONTPAGE mark and registration and Opposer's goods and services associated therewith, such that the trade and purchasing public will be confused by and deceived into believing that Applicant's goods and services originate with or are otherwise authorized by, sponsored by, licensed by, or associated with Opposer.

8. In view of the similarity of the respective marks and the related nature of the goods or services of the respective parties, Applicant's BACKPAGE mark so resembles the FRONTPAGE mark registered and used by and associated with Opposer in the United States, and not at any time abandoned, that Applicant's use of its proposed mark is likely to cause confusion, or to cause mistake or to deceive.

9. The goods and services of Opposer and Applicant are so closely related that if the parties' respective goods and/or services are marketed and sold under the same or confusingly similar marks, a likelihood of confusion will result.

10. Applicant selected its BACKPAGE mark knowledge of Opposer's FRONTPAGE mark.

11. Applicant filed the present application with knowledge of Opposer's FRONTPAGE mark.

12. Upon information and belief, neither Applicant nor any predecessor-in-interest of Applicant has made use of Applicant's BACKPAGE as a trademark or service mark prior to October 31, 2000, the filing date of Applicant's intent-to-use application.

13. Upon information and belief, Applicant's BACKPAGE mark merely describes its product, has not acquired secondary meaning and therefore is an unregistrable mark.

14. Opposer's FRONTPAGE mark was a famous mark at the time Applicant filed its application and will be diluted by the registration Applicant seeks here.

15. By reason of all of the foregoing, Opposer would be greatly damaged by the registration of Applicant's BACKPAGE mark.

WHEREFORE, Opposer prays that this Opposition be sustained and the application be denied and the mark refused registration.

Opposer herewith submits this Notice of Opposition in duplicate along with the requisite filing fee in the amount of three hundred dollars (\$300). Please charge any additional fees or credit any excess to our Deposit Account No. 19-1090. A duplicate copy of this notice is enclosed.

Correspondence Address

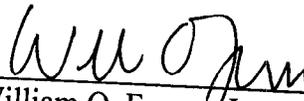
Please direct all communications to:

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DATED this 15th day of January, 2003.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC



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Enclosures:

Postcard
Check for \$300
Exhibits 1 and 2
Copy of Notice of Opposition

669005.828/349222_1.DOC

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CLASS 9—(Continued).

SN 76-156,933. VALVERDE INVESTMENTS, INC., CORAL GABLES, FL. BY ASSIGNMENT IBARRA, RODOLFO, MIAMI, FL. AND VALVERDE, FERNANDO, CORAL GABLES, FL. FILED 10-31-2000.

BACKPAGE

FOR COMPUTER SOFTWARE USED TO ASSIST IN THE DESIGN AND DEPLOYMENT OF SOFTWARE APPLICATIONS ON THE INTERNET; COMPUTER SOFTWARE USED TO PAIR OR JOIN TWO OR MORE EXISTING WEB PAGES SUCH THAT THEY TRAVEL THROUGHOUT THE INTERNET AS ONE ENTITY (U.S. CLS. 21, 23, 26, 36 AND 38).

SN 76-157,376. O'BRIEN, WILLIAM KEISTER. COLUMBUS, OH. FILED 10-30-2000.

PC FLYER

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "PC", APART FROM THE MARK AS SHOWN. FOR DESKTOP COMPUTERS, LAPTOP COMPUTERS, COMPUTER SOFTWARE THAT IS USED TO ENHANCE THE PERFORMANCE OF SOFTWARE APPLICATIONS AND COMPUTER SYSTEMS AND COMPUTER SOFTWARE THAT IS USED FOR SYSTEM SETUPS (U.S. CLS. 21, 23, 26, 36 AND 38).
FIRST USE 9-1-2000; IN COMMERCE 9-1-2000.

SN 76-159,449. ITT INDUSTRIES, INC., WHITE PLAINS, NY. FILED 11-6-2000.

UNILOGIC 3

OWNER OF U.S. REG. NO. 1,456,318. FOR PUMP MICROCONTROLLERS FOR USE IN AND WITH PUMPS IN THE FIELDS OF FLUID TECHNOLOGY, CONTROL AND HANDLING (U.S. CLS. 21, 23, 26, 36 AND 38).

SN 76-162,956. SURF COMMUNICATIONSOLUTIONS LTD., YOKNEAM, ISRAEL, FILED 11-10-2000.

SURF
Communication Solutions

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "COMMUNICATION SOLUTIONS", APART FROM THE MARK AS SHOWN.
FOR SOFTWARE FOR USE IN TRANSMISSION OF VOICE, FACSIMILES AND DATA BY TELECOMMUNICATION EQUIPMENT (U.S. CLS. 21, 23, 26, 36 AND 38).
FIRST USE 3-0-1997; IN COMMERCE 10-0-1997.

CLASS 9—(Continued).

SN 76-163,045. DOLAN-JENNER INDUSTRIES, INC., LAWRENCE, MA. FILED 11-9-2000.

DOLAN-JENNER

FOR FIBER OPTIC ILLUMINATORS FOR NON-MEDICAL APPLICATIONS; ILLUMINATOR POWER SUPPLIES; FIBER OPTIC LIGHT SOURCES FOR NON-MEDICAL APPLICATIONS; FIBER OPTIC LIGHT GUIDES FOR NON-MEDICAL APPLICATIONS; FIBER OPTIC STROBES FOR NON-MEDICAL APPLICATIONS; QUARTZ HALOGEN ILLUMINATORS FOR NON-MEDICAL APPLICATIONS; FIBER OPTIC ILLUMINATION PLATFORMS FOR NON-MEDICAL APPLICATIONS, COMPRISING, GANTRY TYPE BASE, CAMERA MOUNTS, FLEXIBLE ARM TARGET/ACCESSORY HOLDERS, FIBER OPTIC FLOODS, FIBER OPTIC RING LIGHTS, FIBER OPTIC LINE LIGHTS, FIBER OPTIC BACKLIGHTS, LENSES, POLARIZERS, FILTERS AND FIBER OPTIC ILLUMINATORS FOR USE IN MACHINE VISION AND MICROSCOPY APPLICATIONS; LINE LIGHTS FOR NON-MEDICAL APPLICATIONS, COMPRISING, FIBER OPTIC LIGHT GUIDES, CONNECTORS, LIGHT SPLITTERS, AND LINE LIGHT HEADS FOR REFLECTING AND DIRECTING THE LIGHT SOURCE INTO THE SHAPE OF A LINE FOR USE IN MACHINE VISION AND MICROSCOPY APPLICATIONS; RINGLIGHTS FOR NON-MEDICAL APPLICATIONS, COMPRISING, FIBER OPTIC LIGHT GUIDES, CONNECTORS, AND RING LIGHT HEADS FOR REFLECTING AND DIRECTING THE LIGHT SOURCE INTO THE SHAPE OF A RING FOR USE IN MACHINE VISION AND MICROSCOPY APPLICATIONS; AND BACKLIGHTS FOR NON-MEDICAL APPLICATIONS, COMPRISING, FIBER OPTIC LIGHT GUIDES, CONNECTORS, HOUSING, AND DIFFUSERS FOR USE IN MACHINE VISION AND MICROSCOPY APPLICATIONS (U.S. CLS. 21, 23, 26, 36 AND 38).
FIRST USE 0-0-1966; IN COMMERCE 0-0-1966.

SN 76-164,451. K-2 CORPORATION, YASHON, WA. FILED 11-13-2000.

AVALANCHE BALL

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "AVALANCHE", APART FROM THE MARK AS SHOWN.
FOR LIFE-SAVING APPARATUS FOR SKIERS AND SNOWBOARDERS COMPRISED OF A FLAG AND TETHER FOR LOCATING A USER IN AN AVALANCHE (U.S. CLS. 21, 23, 26, 36 AND 38).
FIRST USE 1-25-2001; IN COMMERCE 1-25-2001.

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Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

United States Patent and Trademark Office

Reg. No. 2,046,526

Registered Mar. 18, 1997

**TRADEMARK
PRINCIPAL REGISTER**

FRONTPAGE

VERMEER TECHNOLOGIES, INC. (DELA-
WARE CORPORATION)
725 CONCORD AVENUE
CAMBRIDGE, MA 02138

FOR: COMPUTER AUTHORING SOFTWARE
FOR USE ON COMPUTER COMMUNICATION
NETWORKS, NAMELY, SOFTWARE FOR CRE-
ATING, EDITING AND DELIVERING TEXTU-
AL AND GRAPHIC INFORMATION, LOCALLY

AND REMOTELY, AND INSTRUCTION
MANUALS SOLD AS A UNIT, IN CLASS 9 (U.S.
CLS. 21, 23, 26, 36 AND 38).

FIRST USE 10-11-1995; IN COMMERCE
10-11-1995.

SN 74-684,587, FILED 6-5-1995.

ELIZABETH A. DUNN, EXAMINING ATTOR-
NEY

The United States of America



CERTIFICATE OF REGISTRATION PRINCIPAL REGISTER

The Mark shown in this certificate has been registered in the United States Patent and Trademark Office to the named registrant.

The records of the United States Patent and Trademark Office show that an application for registration of the Mark shown in this Certificate was filed in the Office; that the application was examined and determined to be in compliance with the requirements of the law and with the regulations prescribed by the Commissioner of Patents and Trademarks, and that the Applicant is entitled to registration of the Mark under the Trademark Act of 1946, as Amended.

A copy of the Mark and pertinent data from the application are a part of this certificate.

This registration shall remain in force for TEN (10) years, unless terminated earlier as provided by law, and subject to compliance with the provisions of Section 8 of the Trademark Act of 1946, as Amended.



Bence Lehman

Commissioner of Patents and Trademarks

COPY TO CLIENT

DATE SENT 3/27/97