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

UMAC, INC.

Opposer,

v.

UPSIDE SOFTWARE INC.

Applicant.

Opposition No. \_\_\_\_\_



02-25-2004 #22

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

**NOTICE OF OPPOSITION**

In the matter of an application to register a trademark under the Trademark Act of 1946, Application Serial No. 76/257,660, in the name of Upside Software Inc., which was published for opposition in the Trademark Official Gazette of October 28, 2003, Vol. 1275, No. 4 at page TM 266, for the mark UPSIDESOFTWARE. Opposer believes it will be damaged by registration of said alleged mark, and hereby opposes same.

The grounds for opposition are as follows:

1. The Opposer, UMAC, INC. ("Opposer") is a Delaware corporation, located and doing business at 1100 Wilson Boulevard, Arlington, VA 22209.
2. Opposer markets a business publication throughout the United States for executives and investors in technology industries under the mark UPSIDE ("Opposer's Mark").
3. Opposer is the owner of U.S. Trademark Reg. No. 1,653,067, which issued August 6, 1991, for "monthly business magazine for executives and investors in technology industries." This registration is incontestable, and is therefore conclusive evidence of Opposer's exclusive right to use its UPSIDE mark in commerce, of Opposer's ownership of the registration, and of the validity of the registration, pursuant to 15 U.S.C. §§1065 and 1115(b).

4. Commencing long before the November 15, 2000 priority filing date of the opposed application, Serial No. 776/257,660, Opposer, through its predecessor in interest and title, has continuously sold, advertised and promoted its publications in connection with Opposer's Mark throughout the United States.

5. Since the initial use of Opposer's Mark, Opposer's customers, and the relevant trade and public, have come to know and recognize Opposer's Mark and to associate same with Opposer.

6. Upon information and belief, notwithstanding Opposer's prior reputation in its UPSIDE mark, Applicant Upside Software Inc. filed an application on May 15, 2001 for registration of the mark UPSIDE SOFTWARE, for "computer consulting services for electronic commerce, namely, assisting clients in the processing of supplier invoices and invoicing customer accounts electronically over the world wide web" in Int'l. Class 42. This application was assigned Serial No. 76/257,660, and was published for opposition on October 28, 2003; the opposition period has been extended to and including February 25, 2004.

7. Upon information and belief, Applicant's adoption of the mark UPSIDE SOFTWARE was with knowledge and notice of Opposer's Mark and the established reputation in connection therewith.

8. The mark sought to be registered by Applicant -- UPSIDE SOFTWARE -- is substantially identical to, phonetically equivalent, confusingly similar to, and a colorable imitation of Opposer's Mark UPSIDE. Applicant's published UPSIDE SOFTWARE mark so resembles Opposer's Mark as to be likely, when used in connection with the services of Applicant, to cause confusion or mistake or to deceive actual and/or prospective purchasers, the trade, and

consumers, thereby resulting in damage and detriment to Opposer, Opposer's Mark, and reputation.

9. Upon information and belief, Opposer's actual and/or prospective customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's services marketed, promoted, advertised and/or sold under the UPSIDE SOFTWARE mark sought to be registered by Applicant, and misled into believing that such services are sold by, emanate from, affiliated with, sponsored by, or in some way, directly or indirectly, are associated with Opposer and/or its UPSIDE mark, to the damage and detriment of Opposer and its reputation.

10. Opposer has been and, upon information and belief, will be, damaged by the registration by Applicant of the opposed UPSIDE SOFTWARE mark, as set forth in the opposed application therefor, Ser. No. 76/257,660, in that said mark is substantially similar to, a colorable imitation of, and substantially identical to, Opposer's Mark, and is likely to cause confusion therewith.

11. By virtue of the prior use of Opposer's Mark, if Applicant is granted the registration opposed herein and Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, Opposer will continue to be subjected to great and irreparable damage, and Applicant will obtain unlawful gain and advantage to which it is not entitled under the Trademark Act of 1946.

WHEREFORE, Opposer, UMAC, INC., believes and alleges that it will be damaged by registration of the Applicant's mark as aforesaid, and therefore Opposer prays that:

(a) judgment in the present Opposition be entered in favor of Opposer;

(b) registration on the application of Upside Software, Inc., Serial No. 76/257,660, be rejected and refused; and

(c) the present Opposition be sustained in favor of Opposer.

The filing fee for this opposition in the amount of \$300.00 is enclosed herewith in the form of counsel's Credit Card Charge Form. Should this form become detached, or the amount be insufficient, please charge Deposit Account No. 06-1358.

UMAC, INC.

By:

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SIMOR L. MOSKOWITZ  
Jacobson Holman, PLLC.  
400 Seventh Street, N.W.  
Washington, D.C. 20004-2201  
(202) 638-6666  
ATTORNEYS FOR OPPOSER

Dated: February 25, 2004  
Atty. Dkt. No.: I-4980