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

Proceeding	91163056
Party	Defendant Board of Regents, The University of Texas System Board of Regents, The University of Texas System 201 West 7th Street Austin, TX 78701
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Date	12/30/2004
Attachments	answer.pdf (5 pages)

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

_____)	
EPLAN Software & Service GmbH & Co. KG,)	
Opposer,)	
v.)	Opposition No.: 91163056
)	
BOARD OF REGENTS, THE UNIVERSITY)	
OF TEXAS SYSTEM)	
Applicant)	
_____)	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM, for its answer to the Notice of Opposition filed by EPLAN Software & Service GmbH & Co. KG against application for registration of BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM's trademark EPLAN, Serial No. 78/252,199, filed May 20, 2003 and published in the Official Gazette of May 25, 2004, pleads and avers as follows:

1. With respect to paragraph 1 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to admit or deny the allegations contained therein and accordingly denies the allegations.
2. With respect to paragraph 2 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to admit or deny the allegations contained therein and accordingly denies the allegations.
3. With respect to paragraph 3 of the Notice of Opposition, Applicant admits that U.S. Registration Number 1,485,111 is for "Computer programs" in international classification 9, "Training services in the use and operation of computers and computer

programs” in international classification 41, and “Computer programming services” in international classification 42. Except as expressly stated in this paragraph, Applicant does not have sufficient knowledge or information to admit or deny the remaining allegations contained in paragraph 3 of the Notice of Opposition and accordingly denies the remaining allegations.

4. With respect to paragraph 4 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to admit or deny the allegations contained therein and accordingly denies the allegations.

5. With respect to paragraph 5 of the Notice of Opposition, Applicant does not have sufficient knowledge or information to admit or deny the allegations contained therein and accordingly denies the allegations.

6. With respect to paragraph 6 of the Notice of Opposition, Applicant admits the allegations thereof, except that the trademark application recites use in connection with “Computer services, namely, integrating emergency response contingency plans; tracking the filing and maintenance of emergency response plans; compiling, handling, filing, updating, distributing and maintaining hazardous material information; and providing reliable, rapid facility information to emergency responders in the event of an emergency via a global telecommunications network.”

7. With respect to paragraph 7 of the Notice of Opposition, Applicant denies each and every allegation contained therein.

8. With respect to paragraph 8 of the Notice of Opposition, Applicant admits that the claimed first date of use found in the opposed application is October 1, 2002. Except as expressly stated in this paragraph, Applicant does not have sufficient knowledge or

information to admit or deny the remaining allegations contained in paragraph 8 of the Notice of Opposition and accordingly denies the remaining allegations.

9. With respect to paragraph 9 of the Notice of Opposition, Applicant admits the allegations thereof.

AFFIRMATIVE DEFENSES AND PLEADINGS

10. Upon information and belief, Opposer is not entitled to the requested relief as a result of abandonment due to a course of conduct that has caused Opposer's mark to lose significance as an indication of source.

11. Upon information and belief, Opposer is not entitled to the requested relief as a result of acquiescence due to the existence of subsequent third party registrations for similar marks and similar goods/service.

12. Upon information and belief, Opposer is not entitled to the requested relief as a result of laches due to the existence of subsequent third party registrations for similar marks and similar goods/service.

13. Applicant affirmatively alleges that the Notice of Opposition fails to include a short and plain statement of **the reason(s)** why Opposer believes it would be damaged by the registration of the opposed mark as required by 37 CFR § 2.104(a) and TBMP § 309.03(a)(2).

14. Applicant affirmatively alleges that as a result of its continuous substantial usage of its mark EPLAN since adoption, this mark is a valuable asset of Applicant and carries considerable goodwill and consumer acceptance of its vital national security emergency planning services provided under the mark. Such goodwill and widespread usage has made the mark distinctive to the Applicant.

15. Applicant further affirmatively alleges that Applicant's use of the mark EPLAN in connection with the services recited in the application, when viewed in its entirety, is not likely to cause confusion, mistake or deception with respect to Oppser's registration as determined by the Examining Attorney that approved Applicant's application for publication. The realities of the marketplace are such that the very specialized emergency planning services provided by Applicant are vital to national security and there is no likelihood of confusion, mistake or deception.

16. Applicant further affirmatively alleges that other third party registrations to marks similar to Opposer's mark currently exist and have existed in the field of computer services without any likelihood of confusion, mistake or deception.

PRAYER FOR RELIEF

In view of the foregoing, Applicant contends that this opposition is groundless and baseless in fact; that Opposer has not shown wherein it will be, or is likely to be, damaged by the registration of Applicant's trademark; that Applicant's trademark is manifestly distinct from any alleged mark of the Opposer or any designation of the Opposer and Applicant prays that this Opposition be dismissed and that Applicant be granted registration of its trademark and any other relief unto which Applicant is entitled.

Chalker Flores, LLP



Edwin S. Flores

Attorneys for Applicant

BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM

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Date: December 30, 2004

Certificate of Service

I hereby certify that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION was mailed first-class mail, postage prepaid, to Fred Carl, III, Cantor Colburn LLP, 55 Griffin Road South, Bloomfield, Connecticut 06002, attorneys for Opposer, this 30th day of December 2004.



Attorney for Applicant

Edwin S. Flores