

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

Vantage Technologies Knowledge Assessment, LLC |  
110 Terry Drive |  
Newtown, PA 18940 |  
Opposer |

Opposition No. 91167514  
Application Ser. No. 78210639

v. |

Intelius, Inc. |  
500 108th Avenue, N.E., Suite 1660 |  
Bellevue, WA 98004 |  
Applicant |

**TRANSMITTAL SHEET**

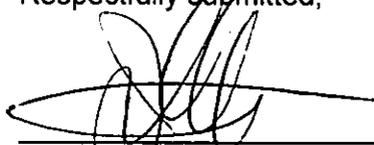
Dear Sir:

Enclosed and attached hereto are the following documents for filing in the United States Patent and Trademark Office:

1. This transmittal letter;
2. Opposer's Response in Opposition to Applicant's Motion for Judgment on the Pleadings and Opposer's Motion for Continued Suspension Pending the Outcome of Pending Litigation in Federal Court; and
3. Acknowledgment postcard to be date-stamped and returned to Paul & Paul.

The Commissioner is hereby authorized to charge any additional fees associated with the is communication, or credit any overpayment, to Paul & Paul Deposit Account No. 16-0750, Order No. 4049.

Respectfully submitted,



John J. Simkanich  
Registration No. 26,036

June 14, 2006

Paul & Paul  
Two Thousand Market Street  
Suite 2900  
Philadelphia, PA 19103  
(215) 568-4900

Order No. 4049



"5. Applicant's intent-to-use services are either identical, or substantially identical, or substantially similar to the services already offered by opposer."

In a motion filed in this matter on November 28, 2005, Applicant erroneously argued that a cancellation of Registration 1908265 will have a bearing on this case as Opposer's rights are based upon being a licensee of the registered mark.

In an answer filed in this matter on December 7, 2005, Opposer argued that the outcome of the cancellation proceeding will not be dispositive of this opposition as Opposer has averred its own use of the mark in commerce and said use inures to Opposer's own rights and benefit.

In a decision issued January 9, 2006, the Board acknowledged Opposer's position that the underlying registration may not completely determine all of the issues in this opposition proceeding. While the lack of a registration will bear on matters of evidence and proof, it will not bar the present action.

The Applicant has now erroneously argued that as a licensee under the mark, Opposer could not have acquired common law rights in the mark in its own right. However, the registration is for goods in International Class 009. Opposer has expressly averred being in commerce advertising and selling services. These services are outside of the scope of the subject registration.

Applicant has erroneously argued that Opposer is barred from asserting its own common law rights in the mark under the doctrine of licensee estoppel. The doctrine of licensee estoppel is well settled law which states that a trademark licensee is prohibited from challenging the validity of the licensed mark. *Pacific Supply Corp. v. Farmers Union Central Exchange, Inc.*, 318 F2d. 894, 137 USPQ 835 (9th Cir. 1963), *cert. denied*, 375 US 965 (1964); *Danskin Inc. v. Dan Rivers, Inc.*, 498 F2d. 1386, 182 USPQ 370 (CCPA 1975); *Gilson - Trademark Protection and Practice* (Matthew Bender 2003).

Applicant is attempting to take the doctrine of licensee estoppel into an area that neither the courts nor the treatises have envisioned.

Applicant's motion must be denied.

Subsequent to the suspension of the present opposition, the battle between the parties has escalated into a trademark infringement and unfair competition action in the U.S. District Court for the Eastern District of Pennsylvania, Civil Action 06-CV-0637, before U.S. Senior District Judge Edmund V. Ludwig. The plaintiffs are Vantage Technology Holdings, LLC (the owner of Registration 1908265) and Vantage Technologies Knowledge Assessment, LLC, (the Opposer in this opposition). The defendant is Intelius, Inc. (the Applicant and present movant). This federal litigation will develop evidence bearing on this opposition and is intended to dispose of all of the possible issues between the parties including those arising in this opposition proceeding.

The Eastern District of Pennsylvania is known as a fast track district, which compels litigation along. The Judge has ordered an initial conference for June 27, 2006. See Exhibit "A" attached. The parties have been asked to complete discovery within 120 days and will be ordered to do so, if necessary. Trial will be scheduled for as soon as possible thereafter, depending upon the Judge's schedule.

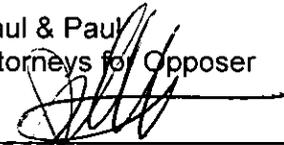
The outcome of this federal litigation should make the present opposition proceeding unnecessary. It is in the interest of judicial economy and with a view towards the *doctrine of judicial estoppel* that the present suspension remain in effect until an outcome of Civil Action 06-CV-0637 is determined.

Opposer so moves the Board to continue the suspension of this opposition proceeding.

Date: 6/14/06

Paul & Paul  
Attorneys for Opposer

by:

  
\_\_\_\_\_  
John J. Simkanich  
Regis. No. 26,036

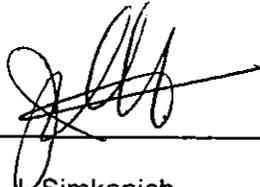
### CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that a true copy of the forgoing opposer's response in opposition to applicant's motion for judgment on the pleadings and opposers's motion for continued suspension pending the outcome of pending litigation in federal court was served upon the applicant, service being made on June 14, 2006 by postage prepaid, first class U.S. Mail, deposited with the United States Postal Service on said date and addressed to:

Steven B. Winters, Esq.  
Lane, Powell, Spears, Lubersky, L.L.P.  
1420 Fifth Avenue, Suite 4100  
Seattle, WA 98101-2338

Date: 6/14/06

by:

  
\_\_\_\_\_  
John J. Simkanich  
Paul & Paul  
Two Thousand Market Street, Suite 2900  
Philadelphia, PA 19103  
(215) 568-4900  
(Fax) 215-567-5057

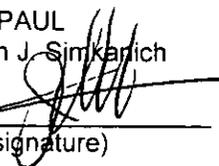
### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited in the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

on 6/14/06  
(date)

PAUL & PAUL  
by: John J. Simkanich

  
\_\_\_\_\_  
(signature)