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

Proceeding	91174641
Party	Defendant PLMIC, LLC
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Attachments	resp to motion to amend.pdf (2 pages)(43634 bytes) amended answer to opp.pdf (5 pages)(242684 bytes)

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

PARAMETRIC TECHNOLOGY CORPORATION, **Opposer** **v.** **PLMIC, LLC,** **Applicant**	**Opp. No. 91174641**

PLMIC, LLC, **Opposer** **v.** **PARAMETRIC TECHNOLOGY CORPORATION,** **Applicant**	**Opp. No. 91177168**

RESPONSE TO MOTION TO AMEND NOTICE OF OPPOSITION TO CONFORM TO EVIDENCE

Applicant PLMIC, LLC responds to the captioned motion by filing the attached Amended Answer to Opposition.

Respectfully submitted,
PLMIC, LLC,
By its attorneys,
Sheehan Phinney Bass & Green, P.A.

January 16, 2009

By: _____

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CERTIFICATE OF SERVICE

I certify that a copy of the foregoing was mailed this date to Thomas V. Smurzynski, Esq., Lahive & Cockfield, LLP, One Post Office Square, Boston, MA 02109.

Edward A. Haffer

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

PARAMETRIC TECHNOLOGY CORPORATION, **Opposer** **v.** **PLMIC, LLC,** **Applicant**	**Opp. No. 91174641**

PLMIC, LLC, **Opposer** **v.** **PARAMETRIC TECHNOLOGY CORPORATION,** **Applicant**	**Opp. No. 91177168**

AMENDED ANSWER TO OPPOSITION

Applicant PLMIC, LLC answers as follows the Amended Notice of Opposition of Opposer Parametric Technology Corporation:

1. Opposer, since before any use by Applicant of its mark, has continuously used the mark FLEXPLM, in the field of computer software for product lifecycle management and the automation of design in formation; the establishment and control of workflows, shared workspaces and production processes in the nature of product design and creation; product configuration and data management; collaboration and process control; the visualization and digital mockup of designs, and use in software configuration and development, along with user guides sold with such software as a unit; and technical support services, namely, troubleshooting of computer software problems via telephone; updating of computer software; maintenance of

computer software, namely, error correction services for computer software; consultation and software implementation services; and product development for others.

ANSWER: As to Opposer's having used FLEXPLM before Applicant, denied. As to the remaining allegations, without sufficient information. Further answering, FLEXPLM was first used, and was first used in commerce, by Applicant's predecessor in title, Jason Silvestri, who is the sole member and managing member of Applicant. Mr. Silvestri first used FLEXPLM and first used it in commerce at least as early as March 31, 2005, and used it in connection with "cooperative advertising and marketing of products and services by way of solicitation, customer service and providing marketing information via websites on a global computer network." With respect to the March 2005 date, Mr. Silvestri posted on the Internet the availability of certain services described as FlexPLM Advertising Solutions, and attempted to sell those services to AimNet Solutions. AimNet Solutions declined to buy those particular services, but instead bought other services simultaneously offered by Mr. Silvestri relating to search engine optimization and marketing. In addition, on July 20, 2004, Mr. Silvestri purchased and registered a website domain, FlexPLM.com. He believed in good faith that such usage constituted trademark usage, and thus cited that date as the first use in commerce in the Application he filed on March 13, 2006, doing so on his own, and without having conferred with counsel. By an assignment executed on May 24, 2006, Mr. Silvestri assigned to Applicant all of his rights and interests in FLEXPLM, including his rights and interests in the pending Application. This assignment was recorded at the PTO on June 23, 2006. On information and belief based on USPTO records, Opposer's first use of FLEXPLM, and first use thereof in commerce, was (a) January 2006 in connection with the specified computer software and (b) December 2005 in connection with the specified technical support services.

2. Opposer is the owner of U.S. Trademark Application No. 76/662,967 filed July 13, 2006, for the mark FLEXPLM for

> computer software for product lifecycle management and the automation of design information; the establishment and control of workflows, shared workspaces and production processes in the nature of product design and creation; product configuration and data management; collaboration and process control; the visualization and digital mockup of designs, and use in software configuration and development, along with user guides sold with such software as a unit, in class 9;
>
> and
>
> technical support services, namely, troubleshooting of computer software problems via telephone; updating of computer software; maintenance of computer software, namely, error correction services for computer software; consultation and software implementation services; and product development for others, in class 42.

ANSWER: Admitted to the extent it accurately reflects what is a matter of record at the PTO. Denied otherwise.

3. Applicant, PLMIC, LLC, filed application Serial No. 78/835,516 on March 13, 2006 for FlexPLM for "cooperative advertising and marketing of products and services by way of solicitation, customer service and providing marketing information via websites on a global computer network." The application was published for opposition in the Official Gazette of October 31, 2006.

ANSWER: Denied that PLMIC, LLC filed such application. It was in fact filed by Mr. Silvestri, and later assigned to Applicant. *See* the Answer to ¶1. Admitted that such application was published for opposition in the Official Gazette of October 31, 2006.

4. The services recited in application Serial No. 78/835,516, are similar to the goods and services offered by Opposer under its trademark FLEXPLM.

ANSWER: Most, if not all, of the particular subject matter described by Opposer for its Class 9 uses and its Class 42 uses is subject matter with respect to which Applicant (or its predecessor in interest, Mr. Silvestri) has used the mark FLEXPLM, with Mr. Silvestri having

done so since at least as early as March 31, 2005. *See* the Answer to ¶1.

5. The mark FlexPLM sought to be registered by Applicant, when used on or in connection with the services recited in the application, will so resemble the mark, FLEXPLM, as used by Opposer, as to cause confusion, or to cause mistake, or to deceive.

ANSWER: Applicant, as the assignee of Mr. Silvestri, is the senior user of the mark and thus has priority. Any resulting confusion, mistake, or deception is the fault of Opposer, not Applicant. *See* the Answer to ¶¶1and 5.

6. Opposer will be damaged by registration of Applicant's mark, since the Applicant would obtain at least a prima facie right to the ownership and exclusive use of the mark in commerce for the services recited in the application.

ANSWER: Denied. *See* the Answers to ¶¶1 and 5.

7. Opposer will be damaged by registration of Applicant's mark since the Applicant would be in a position to raise doubts as to the extent of Opposer's right to the ownership and exclusive use of its mark.

ANSWER: Denied. *See* the Answers to ¶¶1 and 5.

8. Applicant, PLMIC, LLC, through its predecessor-in-title, filed application Serial NO. 78/835,516 on March 13, 2006, on the basis of use claiming that the mark was first used on July 13, 2003 and first used in commerce on July 20, 2004.

ANSWER: Admitted. But *see* the Answer to ¶1.

9. In fact, the mark was first put into used in commerce after the filing date of the application. The dates of first use and first use in commerce set out in the filed application were false.

ANSWER: Denied. *See* the Answer to ¶1.

AFFIRMATIVE DEFENSES

1st Opposer fails to state a claim on which relief may be granted.

2nd Even if the goods and services of Opposer and Applicant in connection with FLEXPLM are similar, Applicant, as the assignee of Mr. Silvestri, is the senior user of the mark and thus has priority. Any resulting confusion, mistake, or deception is the fault of Opposer, not Applicant.

WHEREFORE, Applicant respectfully requests the following relief:

A. An Order denying the Opposition of Parametric Technology Corporation.

B. An Order granting Applicant PLMIC, LLC its attorneys' fees.

C. An Order granting Applicant PLMIC, LLC such other relief as is just.

Respectfully submitted,
PLMIC, LLC,
By its attorneys,
Sheehan Phinney Bass & Green, P.A.

January 16, 2009

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