

ESTTA Tracking number: **ESTTA134409**

Filing date: **04/09/2007**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Intuit Inc.
Granted to Date of previous extension	04/08/2007
Address	2535 Garcia Avenue Mountain View, CA 94043 UNITED STATES
Party who filed Extension of time to oppose	Intuit, Inc.
Relationship to party who filed Extension of time to oppose	Opposer's name has not changed. The previous extensions of time to oppose were filed in the name of "Intuit Inc."; this is the same name as the Opposer. The discrepancy appears to be due to a TTAB data entry error.

Correspondence information	Linda G. Henry, Esq. Fenwick & West LLP Silicon Valley Center, 801 California Street Mountain View, CA 94041-2008 UNITED STATES trademark@fenwick.com Phone:(650) 988-8500
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Applicant Information

Application No	78657790	Publication date	10/10/2006
Opposition Filing Date	04/09/2007	Opposition Period Ends	04/08/2007
Applicant	Aptuit, Inc. Three Greenwich Office Park Greenwich, CT 06831 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 016. All goods and services in the class are opposed, namely: Printed materials, namely, newsletters, pamphlets, brochures, leaflets, magazines, booklets, papers, adhesive labels, bar code labels, paper labels, shipping labels, labeling instructions, and instruction manuals for use in the fields of medical and scientific research and clinical trials</p>
<p>Class 040. All goods and services in the class are opposed, namely: Custom manufacture of pharmaceutical products and preparations, tablets, pills, capsules, caplets, liquid suspensions, drops, medical devices, medical instruments, medical apparatus, intravenous fluids, medicine bottles, medicine vials, active pharmaceutical ingredients, syringes, medical prosthetics, dental prosthetics, containers and</p>

laboratory equipment, and medical testing equipment for use in medical and scientific research and clinical trials

Class 042.

All goods and services in the class are opposed, namely: Medical and scientific research, namely, conducting clinical trials; clinical research; pharmaceutical research; product research; medical research; medical and scientific research consultation pertaining to pharmacology, toxicology, drug metabolism, pharmacokinetics, bioanalysis, and tablet compression; research of medicines and vaccines; development of pharmaceutical preparations, formulations, drug substances, drug products, active pharmaceutical ingredients, and medicines; design and testing of new products for others

Attachments	aptuit[noticeopp].pdf (12 pages)(595620 bytes)
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Signature	/lgh/
Name	Linda G. Henry, Esq.
Date	04/09/2007

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

In the matter of
Trademark Application Serial No. 78/657790
Filed: June 24, 2005
Published: October 10, 2006
Mark: APTUIT

Intuit Inc.,)	
Opposer,)	
)	Opposition No. _____
vs.)	
)	
Aptuit, Inc.)	
Applicant.)	
_____)	

BOX TTAB FEE
ASSISTANT COMMISSIONER FOR TRADEMARKS
P.O. BOX 1451
ALEXANDRIA, VIRGINIA 22313-1451

NOTICE OF OPPOSITION

Opposer, Intuit Inc., a Delaware corporation having a principal place of business at 2535 Garcia Avenue, Mountain View, California 94043, believes it will be damaged by registration of the mark shown in Application Serial Number 78/657790 and hereby opposes that application for the goods

and services in International Classes 16, 40, and 42, alleging as grounds for its opposition that:

1. As is evidenced by the publication of the mark APTUIT in the Official Gazette in the October 10, 2006 issue, Applicant Aptuit, Inc. seeks to register APTUIT as a trademark and service mark for certain goods and services in six different International Classes including:

“Printed materials, namely, newsletters, pamphlets, brochures, leaflets, magazines, booklets, papers, adhesive labels, bar code labels, paper labels, shipping labels, labeling instructions, and instruction manuals for use in the fields of medical and scientific research and clinical trials” in International Class 16;

“Custom manufacture of pharmaceutical products and preparations, tablets, pills, capsules, caplets, liquid suspensions, drops, medical devices, medical instruments, medical apparatus, intravenous fluids, medicine bottles, medicine vials, active pharmaceutical ingredients, syringes, medical prosthetics, dental prosthetics, containers and laboratory equipment, and medical testing equipment for use in medical and scientific research and clinical trials”, in International Class 40; and

“Medical and scientific research, namely, conducting clinical trials; clinical research; pharmaceutical research; product research; medical research; medical and scientific research consultation pertaining to pharmacology, toxicology, drug metabolism, pharmacokinetics, bioanalysis, and tablet compression; research of medicines and vaccines; development of pharmaceutical preparations, formulations, drug substances, drug products, active pharmaceutical ingredients, and medicines; design and testing of new products for others”, in International Class 42.

Applicant application was filed on June 24, 2005.

2. Opposer is the owner of numerous U.S. Trademark Registrations for the mark INTUIT, as follows:

INTUIT, U.S. Reg. No. 1,821,148, for “computer software for use in the field of personal and business finance and accounting and user manuals for use therewith all sold as a unit” in International Class 9, which was registered on the Principal Register on February 15, 1994;

INTUIT, U.S. Reg. No. 1,840,504, for “envelopes, blank checks, business forms, printed forms, and partially printed forms” in International Class 16, which was registered on the Principal Register on June 21, 1994;

INTUIT, U.S. Reg. No. 1,944,875, for “financial information provided by electronic means” in International Class 36, which was registered on the Principal Register on January 2, 1996;

INTUIT, U.S. Reg. No. 2,729,118 for “clothing, namely, t-shirts, jackets, dress shirts, polo shirts, hats and baseball caps” in International Class 25, which was registered on the Principal Register on June 24, 2003;

INTUIT, U.S. Reg. No. 2,729,119 for “computer software for database and data management, namely, computer software for inventory management, estimating, job costing, employee time tracking, customer relationship management, business operations management and project management and instructional manuals sold as a unit; computer software used for the electronic exchange of accounting, financial, customer, contact, product and business data; business management software for use in a variety of industries, namely real estate and property management, automotive service and repair management, construction management, health care practice management, law firm management, non-profit and public sector organization management, retail and restaurant management, and travel services management and instructional manuals sold as a unit; computer software for

use in distributing, installing and updating other applications” in International Class 9, which was registered on the Principal Register on June 24, 2003;

INTUIT, U.S. Reg. No. 2,729,121, for “online business directories featuring financial advisors, accountants, bookkeepers and third-party vendors; online ordering services in the field of financial and accounting products and services; operating online marketplaces for sellers of goods and services; dissemination of advertising for others via the Internet; association and membership services, namely promoting the interests of, and providing business referral, marketing and business management services to member accounting and business management professionals; arranging and conducting business conferences and trade shows in the fields of finance, payroll and tax preparation and processing, accounting and business management; providing business management information on a wide variety of topics via electronic means; association and membership services, namely promoting the interests of, and providing business referral, marketing and technical assistance to member software developers; online directories featuring software developers; arranging and conducting business conferences and trade shows in the field of software development; database management services by electronic means” in International Class 35, which was registered on the Principal Register on June 24, 2003;

INTUIT, U.S. Reg. No. 2,729,122 for “catalogs in the field of finance and accounting, office supplies and desktop software; endorsement and ink stamps; rubber stamps; stationery paper; address and mailing labels; binders; plastic bags for making bank deposits; business cards; cards bearing universal greetings; check holders; file boxes for storage of business and personal checks and records; tax forms” in International Class 16, which was registered on the Principal Register on June 24, 2003;

INTUIT, U.S. Reg. No. 2,729,358 for “electronic storage of files and documents; storage of electronic media, namely, images, text, audio, financial and contact data; storage services for archiving databases, images and other electronic data”, in International Class 39, which was registered on the Principal Register on June 24, 2003;

INTUIT, U.S. Reg. No. 2,729,359 for “computer software for use in tax planning, tax preparation and filing; computer software for use in professional tax practice management” in International Class 9, which was registered on the Principal Register on June 24, 2003;

INTUIT, U.S. Reg. No. 2,729,360 for “financial services namely, online banking, bill payment and payment processing by electronic means” in International Class 36, which was registered on the Principal Register on June 24, 2003;

INTUIT, U.S. Reg. No. 2,763,973 for “printing services; offset printing services; stationery printing services; customized printing of company names and logos for promotional and advertising purposes on the goods of others” in International Class 40, which was registered on the Principal Register on September 16, 2003;

INTUIT, U.S. Reg. No. 2,771,349 for “administration of employee benefits for others” in International Class 36; and for “administration of business payroll and payroll preparation services for others; tax preparation services; filing of tax assessments; promoting public awareness of tax preparation and filing services for others; business invoicing services; providing business services, namely business incorporation services in the nature of preparation and filing of incorporation applications and articles of incorporation for others” in International Class 35, which was registered on the Principal Register on October 7, 2003;

INTUIT, U.S. Reg. No. 2,771,743 for “computer software and hardware for use in transaction processing, accounting, receipt printing, customer relationship management, inventory management and operations management, all in the field of point of sale transactions and retail management, and user manuals sold as a unit therewith; cash drawers; computer printers; point of sale printers and terminals; credit card and debit card readers and scanners; bar code readers and scanners; credit card and transaction processing terminals and computer hardware” in International Class 9, which was registered on the Principal Register on October 7, 2003;

INTUIT, Reg. No. 2,890,151 for “computer software for use in the field of help desk management, namely computer software for tracking and managing information technology support requests and incident reports from users and for tracking and managing technology equipment support histories and support cost reporting; computer software for use in the field of information technology asset management, namely computer software for tracking, managing and auditing computer software licenses and compliance and for tracking and managing information on computer hardware assets, lease, user, vendor, installation and system configuration, asset purchasing and installation and deployment of computer software updates by local or remote means” in International Class 9, which was registered on the Principal Register on September 28, 2004;

INTUIT, U.S. Reg. No. 2,920,336 for “monitoring of computer systems for security purposes; computer systems security services, namely password removal and protection; security printing, namely encoding identification information on valuable documents” in International Class 45, and for “technical support services, namely troubleshooting of computer hardware and software problems, data conversion of computer program data or

information; computer software installation and setup services; computer software and systems integration services; computer services, namely, data recovery services; computer software installation and configuration support” in International Class 42, which was registered on the Principal Register on January 25, 2005;

INTUIT, U.S. Reg. No. 3,039,919 for “charitable services, namely providing volunteer services to non-profit organizations in a wide variety of fields; providing computer software, business management and financial services, tax preparation and filing services, and training and technical support to non-profit organizations, individuals and small businesses” in International Class 35, and for “philanthropic services concerning monetary donations” in International Class 36, which was registered on the Principal Register on January 10, 2006;

INTUITADVISOR, U.S. Reg. No. 2,691,439 for “providing information in the nature of advice, analysis, news, and opinions for professionals in the fields of accounting, finance, financial planning, insurance, investment, tax return preparation and tax planning; tax information and management information; all provided via computer and communications networks” in International Class 36; for “providing business management consultation services for professionals in the fields of accounting, financing planning, insurance, investment, tax return preparation and tax planning” in International Class 35; and for “providing via computer and communication networks the use of non-downloadable computer software for performing queries and transactions and transmitting and receiving information in the fields of accounting, banking, financial, financial planning, insurance, investment, tax return preparation and tax planning” in International Class 42, which was registered on the Principal Register on February 25, 2003;

INTUIT MASTER BUILDER, U.S. Reg. 2,852,474 for “computer software for use in construction management and manuals sold as a unit therewith” in International Class 9, which was registered on the Principal Register on June 15, 2004;

INTUIT PROCONNECTION, U.S. Reg. No. 2,957,901 for “providing business management consultation services for professionals in the fields of accounting, financing, financial planning, tax preparation and tax planning via computer and communications networks; providing information, advice, and analysis for professionals in the fields of business management via computer and communications networks; association membership programs for business professionals, namely, promoting the interests of business consultants, accounting professionals, tax professionals, and financial professionals; providing referrals, namely, business consultant, accounting professional, and tax professional referrals” in International Class 35 and for “financial analysis and consultation, namely, providing information, advice, and analysis, for professionals in the fields of accounting, finance, financial planning, tax preparation and tax planning information via computer and communications networks” in International Class 36, which was registered on the Principal Register on May 31, 2005;

INTUIT QUICKBASE, U.S. Reg. No. 2,729,866 for “providing data management services; enabling data management, namely, providing information and consulting in the field of data management; and data sharing services” in International Class 035 and for “enabling data management, namely, providing temporary use of non-downloadable software development tools and templates for data management; enabling data sharing, namely providing temporary use of non-downloadable software for use in sharing data with others; data hosting services; enabling data hosting services, namely,

hosting software programs for use in managing, organizing, and sharing data on a computer server on a global computer network and on internal computer networks; enabling data management, namely, technical support services, namely, trouble shooting computer database problems by telephone and via a global computer information network” in International Class 42, which was registered on the Principal Register on June 24, 2003;

INTUIT TRACK-IT!, U.S. Reg. No. 2,900,367 for “computer software for use in the field of help desk management, namely computer software for tracking and managing information technology support requests and incident reports from users and for tracking and managing technology equipment support histories and support cost reporting; computer software for use in the field of information technology asset management, namely computer software for tracking, managing and auditing computer software licenses and compliance and for tracking and managing information on computer hardware assets, lease, user, vendor, installation and system configuration, asset purchasing and installation and deployment of computer software and software updates by local or remote means” in International Class 9, which was registered on the Principal Register on November 2, 2004.

INTUIT and Design, U.S. Reg. 1,826,223 for “computer software for use in the field of personal and business finance and accounting and user manuals for use therewith all sold as a unit” in International Class 9, which was registered on the Principal Register on March 15, 1994;

INTUIT and Design, U.S. Reg. No. 1,844,395 for “envelopes, blank checks, business forms, printed forms, and partially printed forms” in International Class 16, which was registered on the Principal Register on July 12, 1994; and

INTUIT and Design, U.S. Reg. No. 1,944,876 for “financial information provided by electronic means” in International Class 36, which was registered on the Principal Register on January 2, 1996;

Said registrations are valid and subsisting and are prima facie evidence of Opposer’s exclusive right to use the INTUIT mark in commerce on the goods and services specified therein. There is no issue as to priority. Opposer commenced use of its INTUIT, INTUIT ADVISOR, INTUIT MASTER BUILDER, INTUIT PROCONNECTION, INTUIT TRACK-IT!, INTUIT QUICKBASE, and INTUIT and Design marks prior to the filing date of the APTUIT mark, which is the subject of this proceeding. Further, Opposer’s U.S. Reg. No. 1,821,148, U.S. Reg. No. 1,840,504, U.S. Reg. No. 1,944,875, U.S. Reg. No. 2,729,118, U.S. Reg. No. 2,729,119, U.S. Reg. No. 2,729,121, U.S. Reg. No. 2,729,122, U.S. Reg. No. 2,729,358, U.S. Reg. No. 2,729,359, U.S. Reg. No. 2,729,360, U.S. Reg. No. 2,763,973, U.S. Reg. No. 2,771,349, U.S. Reg. No. 2,771,743, Reg. No. 2,890,151, U.S. Reg. No. 2,920,336, U.S. Reg. No. 2,691,439, U.S. Reg. 2,852,474, U.S. Reg. No. 2,957,901, U.S. Reg. No. 2,729,866, U.S. Reg. No. 2,900,367, U.S. Reg. 1,826,223, U.S. Reg. No. 1,844,395, and U.S. Reg. No. 1,944,876 were each filed and matured to registration prior to the filing date of the APTUIT mark, which is the subject of this proceeding. In view of the similarity of the respective marks and the related nature of the goods and services of the respective parties, it is alleged that Applicant’s APTUIT mark so resembles Opposer’s registered INTUIT mark as to be likely to cause confusion or mistake or to deceive, thereby causing loss, damage, and injury to Opposer and the purchasing public, and to dilute the distinctive quality of Opposer’s INTUIT mark, thereby causing loss, damage, and injury to Opposer and the purchasing public.

3. Opposer, Intuit Inc., is in the business of designing, manufacturing, marketing, and selling throughout the United States and worldwide a range goods and services, including printed materials, adhesive labels, paper labels, price labels, receipt paper, user manuals, business forms, printed forms, brochures, leaflets, white papers, online newsletters, healthcare management software, medical expense management software, medical office management software, business management software and services, distribution management solutions, project management solutions, software for manufacturing enterprises, and product development software. Since at least as early as February 17, 1984, Opposer has marketed and sold computer software products, envelopes, blank checks, business forms, printed forms, and partially printed forms in connection with the INTUIT trade name and trademark. Since at least as early as 1992, Opposer has offered and provided, throughout the United States, accounting, financial, business, and consultation services, and has marketed and sold these services in connection with the INTUIT trade name and service mark. Since at least as early as May 2002, Opposer has marketed and sold computer hardware products in connection with the INTUIT trade name and trademark. Said nationwide and international trade name, trademark and service mark use of INTUIT by Opposer has been valid and continuous since the date of first use and has not been abandoned. As a consequence of Opposer's extensive marketing, promotion, advertising, and sales activity, Opposer's INTUIT name and mark has come to be identified as a designation of Opposer's goods and services, and as a result, the INTUIT name and mark have become valuable assets of Opposer and principal symbols of its goodwill. In view of the similarity of the respective marks and the related nature of the goods and services of the respective parties, it is alleged that Applicant's APTUIT mark so resembles

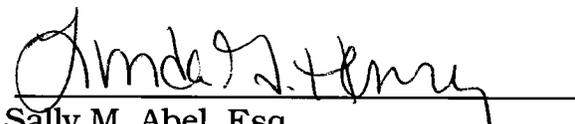
Opposer's INTUIT name and mark previously used in the United States, and not abandoned, as to be likely to cause confusion or mistake or to deceive, thereby causing loss, damage, and injury to Opposer and the purchasing public, and to dilute the value and source identifying power of Opposer's INTUIT identifier, and to disparage and falsely suggest a connection with Opposer thereby causing loss, damage, and injury to Opposer and the purchasing public.

WHEREFORE, Opposer prays that this notice of Opposition be sustained, that Applicant's Trademark Application Serial No. 78/657790 be rejected, and that Applicants be denied registration of APTUIT as a trademark and service mark for the goods and services in International Classes 16, 40, and 42 specified in that application.

This Notice of Opposition is being submitted along with the requisite \$900.00 fee to oppose the Application in three international classes, Classes 16, 40, and 42. Please charge any additional fees to our Deposit Account No. 50-0261, if necessary to file the opposition against Classes 16, 40, and 42.

Respectfully submitted,

Date: April 9, 2007



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