

ESTTA Tracking number: **ESTTA326032**

Filing date: **01/09/2010**

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	EMBARCADERO TECHNOLOGIES, INC.
Granted to Date of previous extension	01/10/2010
Address	100 California Street, 12th Floor San Francisco, CA 94111 UNITED STATES

Attorney information	Martin R. Greenstein TechMark a Law Corporation 4820 Harwood Road, 2nd Floor San Jose, CA 95124-5273 UNITED STATES MRG@TechMark.com, MPV@TechMark.com Phone:408-266-4700
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Applicant Information

Application No	77691980	Publication date	07/14/2009
Opposition Filing Date	01/09/2010	Opposition Period Ends	01/10/2010
Applicant	RStudio, Inc. 581 Boylston Street, Suite 701 Boston, MA 02116 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: Computer software for statistical computing; computer software for software applications development

Applicant Information

Application No	77691984	Publication date	07/14/2009
Opposition Filing Date	01/09/2010	Opposition Period Ends	
Applicant	RStudio, Inc. 581 Boylston Street, Suite 701 Boston, MA 02116 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Providing training in the use of computer
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software; providing training in the use of statistical methods and related computer software

Applicant Information

Application No	77691987	Publication date	07/14/2009
Opposition Filing Date	01/09/2010	Opposition Period Ends	
Applicant	RStudio, Inc. 581 Boylston Street, Suite 701 Boston, MA 02116 UNITED STATES		

Goods/Services Affected by Opposition

Class 042.

All goods and services in the class are opposed, namely: Application service provider (ASP) featuring software for statistical computing and software applications development; computer software consultation; design and development of computer software; technical support services, namely, troubleshooting of problems with computer software programs

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Lack of Bona Fide Intent to use the mark on all goods and services

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2203227	Application Date	12/31/1996
Registration Date	11/10/1998	Foreign Priority Date	NONE
Word Mark	ER/STUDIO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1997/02/28 First Use In Commerce: 1997/02/28 entity relationship modeling software for SQL databases		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ER/STUDIO - common law rights		

Goods/Services	computer software, education and training services, computer software consultation, design and development of computer software, technical support services in connection with computer software
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Attachments	75220219#TMSN.gif (1 page)(bytes) RStudio-77691980-4-7-Oppo.pdf (5 pages)(15459 bytes) ER-STUDIO Reg 2203227 TARRAbstract_2010-01-09.pdf (3 pages)(19578 bytes) ER-STUDIO Reg 2203227 AssignmentAbstract_2010-01-09.pdf (2 pages)(29332 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Martin R Greenstein/
Name	Martin R. Greenstein
Date	01/09/2010

**CERTIFICATE OF ELECTRONIC FILING AND
STANDBY AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

I hereby certify that this opposition is being filed with the TTAB via ESTTA on the date set forth below, and the \$900 (\$300 per class per application opposed) statutory filing fee paid. Please charge any deficiency or any additional fees in connection with this Opposition to TechMark's PTO Deposit Account No. 20-0330.
Date: January 9, 2010

/Martin R Greenstein/
Martin R. Greenstein

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

IN THE MATTER OF:

Appln. Ser. No. **77/691,980** for the trademark **RSTUDIO** (Class 09)

Appln. Ser. No. **77/691,984** for the trademark **RSTUDIO** (Class 41)

Appln. Ser. No. **77/691,987** for the trademark **RSTUDIO** (Class 42)

All filed March 3, 2009, and all published in the Official Gazette of July 14, 2009

EMBARCADERO TECHNOLOGIES, INC.

Opposer

v.

RSTUDIO, INC.

Applicant.

Opposition No.:

Trademark: RSTUDIO

Serial Nos.: 77/691,980

77/691,984

77/691,987

NOTICE OF OPPOSITION

EMBARCADERO TECHNOLOGIES, INC., a Delaware corporation located at 100 California St., 12th Floor, San Francisco, CA 94111 (hereafter "Embarcadero" or "Opposer") believes it is or will be damaged by registration on the Principal Register of the mark **RSTUDIO** shown in Applns. Ser. No. 77/691,980 (Class 9), No. 77/691,984 (Class 41) and No. 77/691,987 (Class 42) and hereby opposes the same.

As grounds of opposition it is alleged that:

1. Opposer Embarcadero is now and has for many years been engaged in the development, marketing, advertising, distribution and sale of various computer software products, including, among others, computer software for modeling and for software applications

development and for related services, including, among others, education and training services in the use of computer software and computer software consultation, design and development of computer software and technical support services in connection with computer software.

2. Opposer Embarcadero is the owner of the trade name and trademark ER/STUDIO, having used said name and mark continuously in interstate commerce on and in connection with computer software and related services since long prior to the March 16, 2009 filing date of Applicant's U.S. Applns. No. 77/691,980 (Class 9), No. 77/691,984 (Class 41) and No. 77/691,987 (Class 42) opposed herein.

3. Opposer Embarcadero is the also the owner of U.S. Reg. No. 2,203,227 for the mark ER/STUDIO, issued November 10, 1998 on the Principal Register of the U.S. Patent and Trademark Office and renewed on May 19, 2009. Printouts of the PTO TARR and Assignment databases are attached hereto pursuant to Rule 2.122(d), and the registration is placed in evidence.

4. A Declaration under Section 15 was filed and acknowledged for U.S. Reg. No. 2,203,227 for the mark ER/STUDIO, and Reg. No. 2,203,227 is incontestible and conclusive evidence of Opposer's exclusive rights therein as provided under the Lanham Act.

5. Applicant RStudio, Inc. ("RStudio" or "Applicant"), who is listed as a Delaware corporation and whose address is given as 581 Boylston Street, Suite 701, Boston, MA 02116, filed three applications claiming a bona fide intent to use the mark **RSTUDIO** on the goods and services listed therein on March 16, 2009, namely Applns. No. 77/691,980 (Class 9), No. 77/691,984 (Class 41) and No. 77/691,987 (Class 42), each of which was published on July 14, 2009 and each of which is opposed herein.

6. On information and belief, Applicant RStudio did not make any actual commercial or bona fide trademark use of the mark **RSTUDIO** in commerce or otherwise prior

to the March 16, 2009 filing dates of Applns. No. 77/691,980 (Class 9), No. 77/691,984 (Class 41) and No. 77/691,987 (Class 42), on the goods or services set forth therein.

7. The goods in connection with which Applicant claimed to have a bona fide intent to use the mark **RSTUDIO** are very similar to, used for the same or similar purposes, and/or are or will be advertised and promoted to and directed at the same trade channels, the same purchasers, and are or will be used in the same environment as Opposer Embarcadero's software products and related and services.

8. Simultaneous use by Applicant of the alleged mark **RSTUDIO** on the goods and services set forth in Applns. No. 77/691,980 (Class 9), No. 77/691,984 (Class 41) and No. 77/691,987 (Class 42), and Opposer Embarcadero's **ER/STUDIO** mark on its goods and related services as set forth above is likely to cause confusion, mistake or deception among purchasers, users and the public, thereby damaging Opposer.

9. Use by Applicant of the alleged mark **RSTUDIO** on the goods and services set forth in Applns. No. 77/691,980 (Class 9), No. 77/691,984 (Class 41) and No. 77/691,987 (Class 42) is likely to lead to the mistaken belief that Applicant's goods are sponsored by, affiliated with, approved by or otherwise emanate from Opposer Embarcadero, thereby damaging Opposer.

10. Upon information and belief, Applicant knew or should have known of Opposer's prior adoption and use of Opposer's **ER/STUDIO** mark and Opposer's ownership of U.S. Reg. No. 2,203,227, and therefore could not have formed the requisite good faith belief that Applicant is the owner of the mark sought to be registered, and that no other person, firm, corporation or association has the right to use said mark in commerce, and consequently knew that such use is and would be in derogation and violation of Opposer Embarcadero's rights.

11. On information and belief, Applicant did not have the requisite bona fide intent to use the mark **RSTUDIO** of Applns. No. 77/691,980 (Class 9), No. 77/691,984 (Class 41) and No. 77/691,987 (Class 42), on all of the goods and services set forth therein in commerce or otherwise at the time of filing the application opposed herein, and the applications are thus void *ab initio*.

Wherefore, Opposer requests that registration of the mark sought to be registered herein, **RSTUDIO** and Applns. No. 77/691,980 (Class 9), No. 77/691,984 (Class 41) and No. 77/691,987 (Class 42), each be denied and that this opposition be sustained as to all three applications.

The sum of \$900 (representing \$300 per class per application opposed) for the statutory fee for this Notice of Opposition has been paid at the time of filing. Any deficiency or shortfall, or any additional fees in connection with this opposition at any time should be charged to TechMark's PTO Deposit Account No. 20-0330.

Please recognize Martin R. Greenstein, Neil D. Greenstein, Mariela P. Vidolova and Lee D. Green, members in good standing of the Bar of the State of California, c/o TechMark, 4820 Harwood Road, 2nd Floor, San Jose, California 95124-5273, Tel: 408-266-4700, as Opposer Embarcadero's attorneys in connection with this opposition proceeding. All correspondence should be directed to Martin R. Greenstein.

EMBARCADERO TECHNOLOGIES, INC.
By /Martin R Greenstein/
Martin R. Greenstein
Mariela P. Vidolova
TechMark a Law Corporation
4820 Harwood Road, 2nd Floor
San Jose, CA 95124-5273
Tel: 408- 266-4700 Fax: 408-864-2044
E-Mail: MRG@TechMark.com
Attorneys for Opposer Embarcadero Technologies, Inc.

Dated: January 9, 2010

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **NOTICE OF OPPOSITION** is being served on January 9, 2010, by deposit of same in the United States Mail, first class postage prepaid, in an envelope addressed to Applicant's attorney of record, at the address shown on the US PTO website, namely:

Charles E. Weinstein, Esq.

FOLEY HOAG LLP

155 Seaport Blvd, Ste 1600

Boston, MA 02210-2600

Tel: 617-832-1000

E-Mail: CEW@foleyhoag.com

/Martin R Greenstein/

Martin R. Greenstein

Thank you for your request. Here are the latest results from the [TARR web server](#).

This page was generated by the TARR system on 2010-01-09 19:14:14 ET

Serial Number: [75220219 Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: [2203227](#)

Mark (words only): [ER/STUDIO](#)

Standard Character claim: [No](#)

Current Status: [This registration has been renewed.](#)

Date of Status: [2009-05-19](#)

Filing Date: [1996-12-31](#)

Transformed into a National Application: [No](#)

Registration Date: [1998-11-10](#)

Register: [Principal](#)

Law Office Assigned: [LAW OFFICE 102](#)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: [830 -Post Registration](#)

Date In Location: [2009-05-19](#)

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. [Embarcadero Technologies, Inc.](#)

Address:

[Embarcadero Technologies, Inc.](#)
[100 California Street, 12th Floor](#)
[San Francisco, CA 94111](#)
[United States](#)

Legal Entity Type: [Corporation](#)

State or Country of Incorporation: [Delaware](#)

GOODS AND/OR SERVICES

International Class: [009](#)

Class Status: [Active](#)

entity relationship modeling software for SQL databases

Basis: 1(a)

First Use Date: 1997-02-28

First Use in Commerce Date: 1997-02-28

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

USPTO Reference Number: [Z1230337](#)

International Registration Number: 0820310

International Registration Date: 2004-01-28

Original Filing Date with USPTO: 2004-01-28

International Registration Status: [Application For IR Registered By IB](#)

Date of International Registration Status: 2004-04-01

International Registration Renewal Date: 2014-01-28

Irregularity Reply by Date: (DATE NOT AVAILABLE)

Madrid History:

[04-08-2004 - 16:04:25 - Application For IR Registered By IB](#)

[02-03-2004 - 11:10:04 - Manually Certified](#)

[02-02-2004 - 13:01:26 - New Application For IR Received](#)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

[2009-05-19 - First renewal 10 year](#)

[2009-05-19 - Section 8 \(10-year\) accepted/ Section 9 granted](#)

[2009-05-19 - Assigned To Paralegal](#)

[2009-05-06 - TEAS Section 8 & 9 Received](#)

[2007-08-08 - Case File In TICRS](#)

[2007-07-04 - Assignment Of Ownership Not Updated Automatically](#)

[2004-10-17 - TEAS Change Of Owner Address Received](#)

[2004-01-20 - FAX RECEIVED](#)

[2004-01-20 - Section 8 \(6-year\) accepted & Section 15 acknowledged](#)

[2003-11-11 - Section 8 \(6-year\) and Section 15 Filed](#)

2003-11-11 - TEAS Section 8 & 15 Received
1998-11-10 - Registered - Principal Register
1998-08-26 - Allowed for Registration - Principal Register (SOU accepted)
1998-08-26 - Assigned To Examiner
1998-07-17 - Assigned To Examiner
1998-07-09 - Statement of use processing complete
1998-03-24 - Amendment to Use filed
1998-02-03 - Noa Mailed - SOU Required From Applicant
1997-11-11 - Published for opposition
1997-10-10 - Notice of publication
1997-09-16 - Approved for Pub - Principal Register (Initial exam)
1997-09-10 - Examiner's amendment mailed
1997-08-25 - Assigned To Examiner
1997-08-14 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Martin R. Greenstein

Correspondent

Martin R. Greenstein
TechMark a Law Corporation
4820 Harwood Road, 2nd Floor
San Jose CA 95124-5273
Phone Number: 408-266-4700
Fax Number: 408-864-2044

**United States Patent and Trademark Office**

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**Assignments on the Web > Trademark Query****Trademark Assignment Abstract of Title****Total Assignments: 3**Serial #: [75220219](#)

Filing Dt: 12/31/1996

Reg #: [2203227](#)

Reg. Dt: 11/10/1998

Registrant: Embarcadero Technologies, Inc.

Mark: ER/STUDIO

Assignment: 1Reel/ Frame: [2606/0941](#)

Received: 02/06/2003

Recorded: 02/06/2003

Pages: 5

Conveyance: MERGER

Assignor: [EMBARCADERO TECHNOLOGIES, INC.](#)

Exec Dt: 02/14/2000

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Entity Type: CORPORATION

Citizenship: DELAWARE

Assignee: [EMBARCADERO TECHNOLOGIES, INC.](#)425 MARKET STREET, SUITE 425
SAN FRANCISCO, CALIFORNIA 94105

Correspondent: HELLER EHRMAN WHITE & MCAULIFFE LLP

HAROLD J. MILSTEIN
275 MIDDLEFIELD ROAD
MENLO PARK, CALIFORNIA 94025**Assignment: 2**Reel/ Frame: [3568/0722](#)

Received: 06/26/2007

Recorded: 06/26/2007

Pages: 9

Conveyance: FIRST LIEN TRADEMARK SECURITY AGREEMENT

Assignors: [EMB HOLDING CORP.](#)

Exec Dt: 06/25/2007

Entity Type: CORPORATION

Citizenship: DELAWARE

Exec Dt: 06/25/2007

Entity Type: CORPORATION

Citizenship: DELAWARE

Exec Dt: 06/25/2007

Entity Type: CORPORATION

Citizenship: DELAWARE

[EMBARCADERO TECHNOLOGIES, INC.](#)[SHC AMBEO ACQUISITION CORP.](#)Assignee: [WELLS FARGO FOOTHILL, INC.](#)2450 COLORADO AVENUE, SUITE 3000 WEST
SANTA MONICA, CALIFORNIA 90404

Correspondent: PAUL HASTINGS JANOFSKY & WALKER LLP

515 S. FLOWER STREET, 25TH FLOOR
LOS ANGELES, CA 90071**Assignment: 3**Reel/ Frame: [3568/0984](#)

Received: 06/27/2007

Recorded: 06/27/2007

Pages: 8

Conveyance: SECOND LIEN TRADEMARK SECURITY AGREEMENT

Assignors: [EMB HOLDING CORP.](#)

Exec Dt: 06/25/2007

Entity Type: CORPORATION

Citizenship: DELAWARE

Exec Dt: 06/25/2007

Entity Type: CORPORATION

Citizenship: DELAWARE

Exec Dt: 06/25/2007

Entity Type: CORPORATION

Citizenship: DELAWARE

[EMBARCADERO TECHNOLOGIES, INC.](#)[SHC AMBEO ACQUISITION CORP.](#)Assignee: [WELLS FARGO FOOTHILL, INC., AS AGENT](#)2450 COLORADO AVENUE, SUITE 3000 WEST
SANTA MONICA, CALIFORNIA 90404

Entity Type: CORPORATION

Citizenship: CALIFORNIA

Correspondent: PAUL HASTINGS JANOFSKY & WALKER LLP
515 S. FLOWER STREET, 25TH FLOOR
LOS ANGELES, CA 90071

Search Results as of: 01/09/2010 07:12 PM

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Web interface last modified: October 18, 2008 v.2.0.2

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