

ESTTA Tracking number: **ESTTA396576**

Filing date: **03/07/2011**

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	CaseCentral, Inc.
Granted to Date of previous extension	03/09/2011
Address	50 California St., Suite 200 San Francisco, CA 94111 UNITED STATES
Attorney information	William J. Frimel Heffernan Seubert & French LLP 1075 Curtis St. Menlo Park, CA 94025 UNITED STATES bill@hsfllp.com Phone:650-322-3048

**Applicant Information**

Application No	77922469	Publication date	11/09/2010
Opposition Filing Date	03/07/2011	Opposition Period Ends	03/09/2011
Applicant	NextPoint Inc. 4043 North Ravenswood Ave., Suite 317 Chicago, IL 60613 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 039. All goods and services in the class are opposed, namely: Electronic storage of data
Class 042. All goods and services in the class are opposed, namely: Providing temporary use of a web-based software application for use in grid computing capacity for litigation support services and graphical presentation services, namely, image generation, viewing and manipulation, text and metadata extraction, batch file format converting, batch data uploading and downloading, search engine and search index generation, pdf generation and support, html file previewing, and mobile/smartphone compatibility

**Grounds for Opposition**

The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	On information and belief, Applicant Nextpoint, Inc. does not use, or plan to use, the PRESERVATION CLOUD mark to identify any of its goods or services. Accordingly, registration on

	an #intent to use# basis under 15 U.S.C. Â§ 1051(b) would be improper.
--	------------------------------------------------------------------------

Attachments	Notice of Opposition - Preservation Cloud.pdf ( 5 pages )(60023 bytes )
-------------	-------------------------------------------------------------------------

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

Signature	/William J. Frimel/
Name	William J. Frimel
Date	03/07/2011

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

CASECENTRAL, INC.,	)	
	)	Mark: PRESERVATION
	)	CLOUD
Opposer,	)	
	)	Serial No.: 77/922,469
vs.	)	
	)	Opposition No. _____
NEXTPPOINT, INC.,	)	
	)	
Applicant.	)	Published in the Official
	)	Gazette on November 9, 2010
	)	

**NOTICE OF OPPOSITION**

CaseCentral, Inc. (“CaseCentral”), a corporation organized under the laws of the State of California, believes that it would be damaged by registration of the above-referenced mark, and hereby opposes the same. As grounds for its opposition, CaseCentral alleges as follows:

1. CaseCentral is a California corporation with its principal place of business at 50 California Street, San Francisco, California 94111.
2. Nextpoint is an Illinois corporation with its principal place of business at 4043 North Ravenswood Avenue, Suite 317, Chicago, Illinois 60613.
3. CaseCentral is an online litigation support software provider. On August 25, 2008, CaseCentral’s Chairman, Christopher Kruse, purchased the internet domain name [www.preservationcloud.com](http://www.preservationcloud.com).
4. In January 2010, Nextpoint, which is also in the online litigation support business, was in the process of developing what it called a “web archiving service that securely captures and indexes data from websites, blogs, Twitter and Facebook feeds”

(the “Archiving Service”). Nextpoint’s Archiving Service makes use of “cloud computing,” *i.e.*, a means whereby the internet is used to efficiently access processing power and storage on an on-demand basis, to capture and store this data.

5. Nextpoint initially contemplated using the [www.preservationcloud.com](http://www.preservationcloud.com) domain name to market the Archiving Service, and calling the product “Preservation Cloud.” However, on January 19, 2010, Nextpoint’s Chief Executive Officer, Rakesh Madhava, learned that CaseCentral’s Christopher Kruse owned the [www.preservationcloud.com](http://www.preservationcloud.com) domain name.

6. Nonetheless, apparently hoping Nextpoint could obtain the domain name, on January 28, 2010, Nextpoint applied to the United States Patent and Trademark Office (“USPTO”) to register the PRESERVATION CLOUD trademark (the “Mark”). Nextpoint sought to register the Mark in International Classes 39 and 42. Nextpoint based its application on its alleged intent to use the Mark in commerce, pursuant to 15 U.S.C. § 1051(b). To date, Nextpoint has not filed a statement verifying that it has used the Mark under 15 U.S.C. § 1051(d), and CaseCentral is not aware of any such use. In fact, on information and belief obtained from Nextpoint’s own internal e-mails, Nextpoint has no intention of using the Mark.

7. On the same date, Nextpoint applied to register two other marks, DISCOVERY CLOUD (Serial No. 77/922,478) and TRIAL CLOUD (Serial No. 77/922,489).

8. In or before March 2010, Michael Beumer, Nextpoint’s Director of Corporate Communications, attempted to buy the [www.preservationcloud.com](http://www.preservationcloud.com) domain name from CaseCentral’s Kruse under false pretenses, by contacting Kruse using

Beumer's wife's e-mail address, and not disclosing Beumer's affiliation with Nextpoint. Kruse, however, declined.

9. Upon learning of this, Nextpoint's CEO, Madhava, decided instead that Nextpoint would purchase the domain name [www.cloudpreservation.com](http://www.cloudpreservation.com), and call the Archiving Service "Cloud Preservation" rather than "Preservation Cloud."

10. Accordingly, on April 23, 2010, Nextpoint applied to the USPTO to register the CLOUD PRESERVATION trademark (Serial No. 85/021,489). On June 2, 2010, Nextpoint announced the release of the "beta," or user testing, version of the Archiving Service, under the name "Cloud Preservation" — *not* "Preservation Cloud." On August 3, 2010, Nextpoint announced Cloud Preservation's full release.

11. On June 8, 2010, Nextpoint filed an action against CaseCentral in the United States District Court for the Northern District of Illinois, *Nextpoint, Inc. v. CaseCentral, Inc.*, Case No. 10-CV-3515 (the "Nextpoint Action"). In that lawsuit, Nextpoint claimed, *inter alia*, that CaseCentral had infringed the Mark by applying to register and using the trademarks EDISCOVERY CLOUD (Serial No. 77/949,557) and CASECENTRAL EDISCOVERY CLOUD (Serial No. 77/949,540).

12. On October 27, 2010, the USPTO issued an Office Action refusing to register Nextpoint's proposed DISCOVERY CLOUD and TRIAL CLOUD marks, on the ground that those marks "merely describe[] a function or purpose of [Nextpoint's] goods and/or services," because they describe a process whereby "computer software or cloud will be used in connection with . . . [a] portion of litigation work."

13. On November 9, 2010, the USPTO published the Mark in the Trademark Official Gazette. CaseCentral obtained extensions of its time to oppose the registration of the Mark until March 9, 2011.

14. On February 16, 2011, Nextpoint filed a motion for voluntary dismissal of the Nextpoint Action. On February 22, 2011, the Court in the Nextpoint Action denied Nextpoint's motion, and ordered that Nextpoint had until March 8, 2011 to opt for either dismissing the action with prejudice or proceeding with the litigation.

15. On March 1, 2011, Nextpoint filed a motion for dismissal with prejudice of the Nextpoint Action. The Court granted Nextpoint's motion on March 4, 2011.

16. CaseCentral respectfully requests that registration of the Mark be refused on two grounds. *First*, as noted above, Nextpoint applied to register the Mark on the basis that Nextpoint intended to use it in commerce, under Section 1051(b). However, shortly after applying to register the Mark, Nextpoint decided *not* to use the Mark in commerce.

17. As described above, Nextpoint may have initially intended to call its Archiving Service "Preservation Cloud." However, in or before March 2010, in light of CaseCentral's CEO's ownership of the [www.preservationcloud.com](http://www.preservationcloud.com) domain name, Nextpoint chose to call the Archiving Service "Cloud Preservation" instead. On information and belief, Nextpoint does not use, or plan to use, the Mark to identify any of its other goods or services. Accordingly, registration on an "intent to use" basis under 15 U.S.C. § 1051(b) would be improper.

18. *Second*, under 15 U.S.C. § 1052(e)(1), the Mark does not qualify for registration, because it is merely descriptive of Nextpoint's goods and services. The phrase "Preservation Cloud," as discussed above, merely describes Nextpoint's use of *cloud* computing for the *preservation* of certain types of data found on the internet. Accordingly, registration of the Mark should be refused, for the same reasons on which

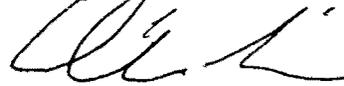
the USPTO previously relied in refusing to register Nextpoint's DISCOVERY CLOUD and TRIAL CLOUD marks.

19. CaseCentral believes it will be damaged if the Mark is registered, because the registration of the Mark will facilitate Nextpoint's assertion of rights under the Mark against CaseCentral, as attempted in the Nextpoint Action and elsewhere, and Nextpoint's claim that CaseCentral is not permitted to use the CaseCentral Marks in commerce. CaseCentral may also be damaged because registration of the Mark may affect CaseCentral's ability to use the www.preservationcloud.com domain name to promote its business.

WHEREFORE, CaseCentral respectfully requests that registration of the Mark be refused.

Date: March 7, 2011

Respectfully submitted,



---

William J. Frimel  
Heffernan Seubert & French LLP  
1075 Curtis Street  
Menlo Park, CA 94025  
Telephone: (650) 322-3048  
Facsimile: (650) 322-2976  
[bill@hsfllp.com](mailto:bill@hsfllp.com)

Attorneys for Opposer CaseCentral, Inc.