

ESTTA Tracking number: **ESTTA429009**

Filing date: **09/06/2011**

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

Proceeding	91200893
Party	Defendant REPPIFY LLC
Correspondence Address	LINDA GOLDMAN FENWICK & WEST LLP 801 CALIFORNIA ST MOUNTAIN VIEW, CA 94041-1990 trademark@fenwick.com
Submission	Answer and Counterclaim
Filer's Name	Connie L. Ellerbach
Filer's e-mail	trademarks@fenwick.com
Signature	/cle 1087/
Date	09/06/2011
Attachments	REPPIFY Answer and CounterClaim.pdf (10 pages)(22074 bytes)

Registrations Subject to the filing

Registration No	3937819	Registration date	03/29/2011
Registrant	Repify, Inc. P.O. Box 230603 Montgomery, AL 361230603 UNITED STATES		

Goods/Services Subject to the filing

Class 045. First Use: 2009/10/09 First Use In Commerce: 2009/10/31
All goods and services in the class are requested, namely: providing an interactive web site that facilitates the verification of a person's background credentials to verify the trustworthiness of individuals across a wide range of subject areas; providing an interactive web site that facilitates the verification of a person's background credentials to verify an individual's trustworthiness, reliability, dependability and integrity across online and wireless environments

Registration No	3937828	Registration date	03/29/2011
Registrant	Repify, Inc. P.O. Box 230603 Montgomery, AL 361230603 UNITED STATES		

Goods/Services Subject to the filing

Class 045. First Use: 2009/10/09 First Use In Commerce: 2009/10/31
All goods and services in the class are requested, namely: providing an interactive web site that facilitates the verification of a person's background credentials to verify the trustworthiness of individuals across a wide range of subject areas; providing an interactive web site that facilitates the verification of a person's background credentials to verify an individual's trustworthiness, reliability, dependability and integrity across online and wireless environments

4. Applicant/Counterclaim-Petitioner lacks sufficient information to admit or deny the allegations of Paragraph 4 and, on that basis, denies those allegations.

5. Applicant/Counterclaim-Petitioner admits that U.S. Reg. No. 3,937,819 for REPIFY and in U.S. Reg. No. 3,937,828 for REPISCORE include alleged dates of first use and first use in interstate commerce of October 9, 2009, and October 31, 2009, respectively, but denies the remaining allegation of Paragraph 5, including that such alleged dates of first use are valid or defensible.

6. Applicant/Counterclaim-Petitioner lacks sufficient information to admit or deny the allegations of Paragraph 6 and, on that basis, denies those allegations.

7. Applicant/Counterclaim-Petitioner lacks sufficient information to admit or deny the allegations of Paragraph 7 and, on that basis, denies those allegations.

8. Applicant/Counterclaim-Petitioner lacks sufficient information to admit or deny the allegations of Paragraph 8 and, on that basis, denies those allegations.

9. Applicant/Counterclaim-Petitioner admits that it has not yet filed a Statement of Use with respect to the Application. Applicant/Counterclaim-Petitioner denies the remaining allegations of Paragraph 9.

10. Applicant/Counterclaim-Petitioner denies each and every allegation of Paragraph 10.

11. Applicant/Counterclaim-Petitioner admits that on December 17, 2009, it filed an intent-to-use application for registration of the mark REPIFY, that the application was given

Serial No. 77/895,974, and was published for opposition in the Official Gazette on July 19, 2011. Applicant/Counterclaim-Petitioner denies the remaining allegations of Paragraph 11 to the extent that such allegations suggest that Opposer/Counterclaim-Respondent owned trademark rights that predated Applicant/Counterclaim-Respondent's rights as of the filing date of the Application.

12. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 12.

13. Applicant/Counterclaim-Petitioner admits that it has not yet filed a Statement of Use with respect to the Application. Applicant/Counterclaim-Petitioner denies the remaining allegations of Paragraph 13.

14. Applicant/Counterclaim-Petitioner admits that the filing date of its Application is subsequent to Opposer's alleged date of first use of Opposer/Counterclaim-Petitioner's Marks, but denies the remaining allegations of Paragraph 14, including that the dates of first use claimed by Opposer/Counterclaim-Petitioner for either of its Marks are valid or defensible.

15. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 15.

16. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 16.

17. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 17.

18. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 18.

19. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 19.

20. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 20, as written, including that Opposer/Counterclaim-Respondent originally contacted Applicant

regarding the likelihood of confusion between the parties' respective marks, that Opposer/Counterclaim-Respondent has failed to take any action to address the likelihood of confusion between the marks, and Opposer/Counterclaim-Respondent has continued to pursue its applications, and to maintain the resulting registrations, in bad faith.

21. Applicant/Counterclaim-Petitioner admits that its mark is confusingly similar to Opposer/Counterclaim-Respondent's marks, but denies the remaining allegations of Paragraph 21.

FIRST AFFIRMATIVE DEFENSE

1. The Notice of Opposition fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

2. Opposer/Counterclaim-Respondent's claims are barred, in whole or in part, by the doctrines of acquiescence and estoppel.

THIRD AFFIRMATIVE DEFENSE

3. Opposer/Counterclaim-Respondent's claims are barred, in whole or in part, by the doctrine of unclean hands.

FOURTH AFFIRMATIVE DEFENSE

4. Opposer/Counterclaim-Respondent's claims are barred, in whole or in part, by the lack of sufficient secondary meaning in the Opposer/Counterclaim-Respondent's marks in question in this matter.

///

FIFTH AFFIRMATIVE DEFENSE

5. Opposer/Counterclaim-Respondent's claims are barred, in whole or in part, by Opposer/Counterclaim-Respondent's failure to maintain the trademark significance/secondary meaning for the marks upon which it has based its claims in this matter.

SIXTH AFFIRMATIVE DEFENSE

6. Applicant/Counterclaim-Petitioner reserves the right to assert any and all other affirmative defenses of which it becomes aware during the pendency of this matter.

WHEREFORE, Applicant/Counterclaim-Petitioner prays that Opposer/Counterclaim-Respondent's Notice of Opposition be dismissed and that judgment be entered in favor of Applicant.

COUNTERCLAIM PETITION FOR CANCELLATION

Applicant/Counterclaim-Petitioner believes that it will be damaged by continued registration of Opposer/Counterclaim-Respondent's Registration Nos. 3,937,819 and 3,937,828 for REPIFY and REPISCORE ("Repify's Registrations") for the respective services covered by those Registrations.

As grounds for its Petition to Cancel, Applicant/Counterclaim-Petitioner alleges:

1. Opposer/Counterclaim-Respondent has asserted its Registrations against registration of Applicant/Counterclaim-Petitioner's application for Serial No. 77/895,974 for REPPIFY.

///

Count I

Repify, Inc.'s Registrations Were Fraudulently Procured

2. Applicant/Counterclaim-Petitioner is engaged in the business of online reputation rating and job applicant screening services currently in use by employee recruiters worldwide.

3. Applicant/Counterclaim-Petitioner has invested a great deal of time and money in promoting its business, and is continuing to spend substantial amounts of time and money in the promotion of same.

4. On December 17, 2009, Applicant/Counterclaim-Petitioner (formerly Buzz Brands LLC) filed Application Serial No. 77/895,974 (“the Application”) for registration of REPIFY on the Principal Register for “market research and market intelligence services; Reputation rating services; Providing a website that features an online platform for rating the reputation of individuals by assigning a numeric score, where businesses can obtain data about individuals for hiring, ensuring safe online transactions, targeted marketing and other purposes, and where individuals can manage their own reputation scores” in International Class 35 (“Applicant/Counterclaim-Petitioner’s Services”).

5. On July 29, 2010, Opposer/Counterclaim-Respondent filed Application Serial Nos. 85/096,225 and 85/096,300 for registration of REPIFY and REPISCORE, both for “providing a web based platform that models a trustworthy index for individuals across a wide range of domains and subject areas; providing a web-based platform that provides the evaluation of an individual's trustworthiness, reliability, dependability and integrity across online and wireless environments” in International Class 35. These applications matured into Registration Nos. 3,937,819 and 3,937,828 (“the Registrations”) on March 29, 2011, for the following

services, and are the subject of this petition: “providing an interactive web site that facilitates the verification of a person's background credentials to verify the trustworthiness of individuals across a wide range of subject areas; providing an interactive web site that facilitates the verification of a person's background credentials to verify an individual's trustworthiness, reliability, dependability and integrity across online and wireless environments” in International Class 45.

6. The correspondent listed on the Registrations is Susan Daly Stearns of Susan Daly Stearns, LLC, with an address of P.O. Box 215, Bend, Oregon 97709.

7. On July 29, 2010, Susan Daly Stearns submitted sworn declarations to the United States Patent and Trademark Office (“PTO”) in connection with Application Serial Nos. 85/096,225 and 85/096,300 in which she declared under oath, being warned that willful false statements and the like may jeopardize the validity of the applications, that “[t]he applicant is using the mark in commerce, or the applicant’s related company or licensee is using the mark in commerce, or the applicant’s predecessor in interest used the mark in commerce, on or in connection with the identified goods and/or services.” Susan Daly Stearns further declared that the date of first use in commerce was at least as early as October 31, 2009, and that the date of first use anywhere was at least as early as October 9, 2009.

8. Upon information and belief, Opposer/Counterclaim-Respondent was not using the marks REPIFY or REPISCORE on or in connection with the services listed in the Registrations when it filed the applications on July 29, 2010, and was not using the marks REPIFY or REPISCORE on or in connection with the services listed in the Registrations as of its

claimed first use in commerce date of October 31, 2009, or its claimed first use anywhere date of October 9, 2009.

9. Upon information and belief, the declarations alleging use of the REPIFY and REPISCORE marks in Application Serial Nos. 85/096,225 and 85/096,300 were made in bad faith and in an attempt to perpetrate a fraud upon the PTO because Opposer/Counterclaim-Respondent knew or should have known that it was not using the marks REPIFY and REPISCORE in connection with all the services identified in the applications as of its claimed first use dates.

10. Reasonably relying on the truth of such materially false statement, the PTO approved Application Serial Nos. 85/096,225 and 85/096,300 for registration, resulting in Registration Nos. 3,937,819 and 3,937,828, both issuing on March 29, 2011.

11. The PTO approved Application Serial Nos. 85/096,225 and 85/096,300 for REPIFY and REPISCORE for registration despite the existence of Opposer/Counterclaim-Respondent's prior pending Application No. 77/895,974 for the confusingly similar mark REPPIFY for similar services due to an error in the Examining Attorney's search logic.

12. Upon information and belief, the conduct of Opposer/Counterclaim-Respondent constitutes fraud on the PTO and therefore Registration Nos. 3,937,819 and 3,937,828 should be cancelled.

WHEREFORE, Applicant/Counterclaim-Petitioner prays that this Petition to Cancel be granted, that Opposer/Counterclaim-Respondent's Registrations Nos. 3,937,819 and 3,937,828 be cancelled, and that Applicant/Counterclaim-Petitioner be accorded such further relief as provided for by law and the rules of practice in trademark cases.

A duplicate copy of this Petition and a check in the sum of \$600.00 in payment of the governmental filing fee are enclosed. Should additional fees be required, please charge them to the deposit account of Fenwick & West, 500261.

Respectfully submitted,

Dated: September 6, 2011

/s/ Connie L. Ellerbach

Connie L. Ellerbach, Esq.

Attorney for Applicant

FENWICK & WEST LLP

Silicon Valley Center

801 California Street

Mountain View, CA 94041

(650) 988-8500

trademarks@fenwick.com

PROOF OF SERVICE BY MAIL

I declare that:

I am employed in the County of Mountain View, California.

I am over the age of eighteen years and not a party to the within cause; my business address is 801 California Street, Mountain View, CA 94041. On the date indicated below, I served the within **Answer to Notice of Opposition and Counterclaims** on the interested parties in said cause, by placing a true copy thereof as indicated below addressed as follows:

Repify, Inc.
c/o B. Anna McCoy
Alleman Hall McCoy Russell & Tuttle LLP
806 S.W. Broadway, Suite 600
Portland, Oregon 97204

- (XX) BY U.S. MAIL:** I am familiar with our business practices for collecting and processing of mail for the United States Postal Service. Mail placed by me within the office for collection for the United States Postal Service would normally be deposited with the United States Postal Services that day in the ordinary course of business. The envelope(s) bearing the address(es) above was sealed and placed for collection and mailing on the date below following our ordinary business practices.
- () BY PERSONAL SERVICE:** I caused such envelope(s) to be delivered by hand on the office(s) of the addressee(s).
- () BY FEDERAL EXPRESS:** I caused such envelope(s) to be delivered to Federal Express for overnight courier service to the office(s) of the addressee(s).
- () BY FACSIMILE:** I caused a copy of such document(s) to be sent via facsimile transmission to the office(s) of the party(s) stated above and was transmitted without error.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

Date: September 6, 2011

/s/ Deborah A. Shaw
Deborah A. Shaw