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Filing date: **10/19/2011**

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

Proceeding	91201836
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, kmcknight@fenwick.com
Signature	/cle1087/
Date	10/19/2011
Attachments	REPPIFY_Class_45_Answer with Counterclaim_vs_Repify.pdf (11 pages) (24545 bytes)

Registrations Subject to the filing

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

<p>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</p>

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

<p>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</p>

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

In the matter of
Trademark Application No.: 77/982,127
Filed: December 17, 2009
Published: August 30, 2011

REPIFY, INC.,)	
Opposer/Counterclaim-Respondent,)	
)	
vs.)	
)	Opposition No. 91201836
REPPIFY LLC,)	
Applicant/Counterclaim-Petitioner)	
)	
)	

Answer to Notice of Opposition and Counterclaims

Applicant/Counterclaim-Petitioner denies that Opposer/Counterclaim-Respondent is or will be damaged by registration of Application No. 77/982,127 (“the Application”) and the contents of the Application.

1. Applicant/Counterclaim-Petitioner lacks sufficient information to admit or deny the allegations of Paragraph 1 and, on that basis, denies those allegations.

2. Applicant/Counterclaim-Petitioner lacks sufficient information to admit or deny the allegations of Paragraph 2 and, on that basis, denies those allegations.

3. Applicant/Counterclaim-Petitioner lacks sufficient information to admit or deny the allegations of Paragraph 3 and, on that basis, denies those allegations.

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 (Opposer/Counterclaim-Respondent's Marks) 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 allegations 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 denies each and every allegation of Paragraph 9.

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

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11. Applicant/Counterclaim-Petitioner admits that on December 17, 2009, it filed an intent-to use application Serial No. 77/895,974 for the mark REPPIFY for services in classes 035 and 045. 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-Petitioner'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 the allegations of Paragraph 13.

14. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 14.

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

16. Applicant/Counterclaim-Petitioner admits that with respect to the child Application Serial No. 77/982,127, it claims that it first used the mark and first used the mark in commerce at least as early as March of 2010.

17. Applicant/Counterclaim-Petitioner admits that the first use dates of Application Serial No. 77/982,127 are subsequent to Opposer/Counterclaim-Respondent's alleged first use of Opposer/Counterclaim-Respondent's Marks, but denies the remaining allegations of Paragraph 17, including that the dates of first use claimed by Opposer/Counterclaim-Respondent for either of its Marks are valid or defensible.

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.
21. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 21.
22. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 22.
23. Applicant/Counterclaim-Petitioner admits the allegations of Paragraph 23, as written, including that Opposer/Counterclaim-Respondent originally contacted Applicant/Counterclaim-Petitioner 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.
24. Applicant/Counterclaim-Petitioner admits that its mark is confusingly similar to Opposer/Counterclaim-Respondent's Marks, but denies the remaining allegations of Paragraph 24.

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.

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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.

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COUNTERCLAIM PETITION FOR CANCELLATION

Applicant/Counterclaim-Petitioner believes that it will be damaged by continued registration of Opposer/Counterclaim-Respondent's Registrations 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. 77/982,127 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 Parent Application") for registration of REPPIFY 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 035 (“Applicant/Counterclaim-Petitioner’s Services”).

5. On June 2, 2011, Applicant/Counterclaim-Petitioner filed a Request to Divide Application Serial No. 77/895,974 such that the Parent Application contains the services “Market research and market intelligence services; Business consultation and market research services in the nature of a website that rates the social and business reputation of individuals by assigning a numeric score, and that provides businesses with data about individuals' online social and business reputations in order to facilitate safe online commercial transactions and targeted marketing” in International Class 035, and the Child Application Serial No. 77/982,127 contains the services “Online service that provides ratings of individuals' social reputations based on their activities on social networking websites and that allows individuals to manage their own social reputation scores; reputation rating services, namely, providing pre-employment background screening via a website that rates the social and business reputation of individuals by assigning a numeric score, and that provides businesses with data about individuals' online social and business reputations in order to facilitate hiring decisions” in International Class 045. Applicant/Counterclaim-Petitioner concurrently filed an Amendment to Allege Use, claiming that the REPPIFY mark was first used in commerce in connection with the International Class 045 services at least as early as March 2010. The Request to Divide was completed as of June 10, 2011, and the Amendment to Allege Use was accepted as of July 15, 2011.

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6. 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 035. 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 045.

7. 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.

8. 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 dates of first use of both Marks in commerce were at least as early as October 31, 2009, and that the dates of first use anywhere were at least as early at October 9, 2009.

9. 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.

10. 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.

11. 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.

12. The PTO approved Application Serial Nos. 85/096,225 and 85/096,300 for REPIFY and REPISCORE for registration despite the existence of Applicant/Counterclaim-Petitioner's prior pending Application Nos. 77/895,974 and 77/982,127 for the confusingly

similar mark REPPIFY for similar services due to an error in the Examining Attorney's search logic.

13. 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: October 19, 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, California 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 enclosed in a sealed envelope with postage thereon fully prepaid, in the United States mail at Mountain View, California, 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

I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this 19th day of October, 2011.

/s/ Anita E. Ersoy _____
Anita E. Ersoy