

ESTTA Tracking number: **ESTTA649088**

Filing date: **01/09/2015**

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 | The Foundry Group LLC |
| Granted to Date of previous extension | 01/10/2015 |
| Address | 399 Bradford Street, Suite 100 Redwood City, CA 94063 UNITED STATES |
| Attorney information | Scott L. Harper Harper Washam LLP 1700 Pacific Avenue, Suite 3600 Dallas, TX 75201 UNITED STATES trademarks@harperwasham.com, scott.harper@harperwasham.com Phone:214-389-8985 |

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 86277982 | Publication date | 11/11/2014 |
| Opposition Filing Date | 01/09/2015 | Opposition Period Ends | 01/10/2015 |
| Applicant | MODIO EHF KIRKJUTORG 6 101 REYKJAVIK, ICELAND | | |

Goods/Services Affected by Opposition

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| <p>Class 009. First Use: 2014/05/13 First Use In Commerce: 2014/05/13 All goods and services in the class are opposed, namely: downloadable computer software for designing and modeling of three-dimensional printable products in the nature of toys, models, figurines, dolls, jewelry, accessories, hobby models and consumer products for personal and commercial use; downloadable software applications for use with three-dimensional printers; data and image processing software for making three-dimensional models; computer software, namely, software tools for graphic computing of three-dimensional images, models and data for making three-dimensional models; computer application software for handheld computers, namely, software for creating and manipulating three-dimensional images, models and data for making three-dimensional models</p> |
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Applicant Information

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|------------------------|----------------------------|------------------------|------------|
| Application No | 86277983 | Publication date | 11/11/2014 |
| Opposition Filing Date | 01/09/2015 | Opposition Period Ends | |
| Applicant | MODIO EHF. KIRKJUTORG 6 | | |

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| | 101 REYKJAVIK, ICELAND |
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Grounds for Opposition

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|--------------------------------------|-----------------------------|
| False suggestion of a connection | Trademark Act section 2(a) |
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Mark Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 3036825 | Application Date | 07/13/2004 |
| Registration Date | 12/27/2005 | Foreign Priority Date | NONE |
| Word Mark | MODO | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 2004/09/24 First Use In Commerce: 2004/09/24 software for 3D content creation | | |

| | |
|-------------|--|
| Attachments | 78449869#TMSN.png(bytes) Notice of Opposition.pdf(1396071 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 First Class Mail on this date.

| | |
|-----------|-------------------|
| Signature | /scott l. harper/ |
| Name | Scott L. Harper |
| Date | 01/09/2015 |

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

In the matter of Application Serial No. 86/277,982
For the Mark: MODIO
Owner: MODIO ehf.
Filed: 05/11/2014
Published in the
Trademark Official Gazette on: 11/11/2014

In the matter of Application Serial No. 86/277,983
For the Mark: MODIO (design)
Owner: MODIO ehf.
Filed: 05/11/2014
Published in the
Trademark Official Gazette on: 11/11/2014

THE FOUNDRY GROUP, LLC

Opposer,

v.

MODIO ehf.

Owner.

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Opposition No. _____

Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

The Foundry Group, LLC, a California limited liability company, located and doing business at 399 Bradford Street, Suite 100, Redwood City, CA 94063 ("Opposer") believes that it is and will continue to be damaged by registration of the marks MODIO

and MODIO (design) (collectively hereafter the “MODIO marks”) in the name of Modio efh (“Owner”) for the marks shown in the above-identified applications, and hereby oppose same.

A request for an extension of time to oppose was filed on December 10, 2014 and granted, extending the time to file an opposition to registration of the MODIO marks to January 10, 2015.

As grounds for this Opposition, it is alleged that:

1. Opposer is the owner of U.S. Registration No. 3,036,825, registered on December 27, 2005, for the mark MODO for use in connection with “software for 3D content creation” in Class 9. Opposer has used the mark MODO in connection with its software goods with first use and first use in commerce since at least as early as September 24, 2004. This registration is incontestable, valid and subsisting, uncanceled and unrevoked. A copy of the certificate issued by the United States Patent & Trademark Office for U.S. Registration No. 3,036,825 is attached as Exhibit A.

2. Opposer has expended considerable time, effort, and expense in advertising and promoting the MODO mark and the goods associated with it throughout the United States, with the result that the purchasing public has come to know and recognize the goods of Opposer by the MODO mark. Opposer has exceedingly valuable goodwill established in its MODO mark.

3. On May 11, 2014, Modio, Inc. filed an application for registration of the mark MODIO, Application Serial No. 86/277,982, with a current description of goods, as published for opposition, reciting “downloadable computer software for designing and

modeling of three-dimensional printable products in the nature of toys, models, figurines, dolls, jewelry, accessories, hobby models and consumer products for personal and commercial use; downloadable software applications for use with three-dimensional printers; data and image processing software for making three-dimensional models; computer software, namely, software tools for graphic computing of three-dimensional images, models and data for making three-dimensional models; computer application software for handheld computers, namely, software for creating and manipulating three-dimensional images, models and data for making three-dimensional models” in Class 9. Owner alleges a first use of the MODIO mark in connection with the described goods of at least as early as May 13, 2014.

4. On May 11, 2014, Modio, Inc. filed an application for registration of the



mark MODIO (design), the drawing of which appears as in Application Serial No. 86/277,983, as published for opposition, reciting “downloadable computer software for designing and modeling of three-dimensional printable products in the nature of toys, models, figurines, dolls, jewelry, accessories, hobby models and consumer products for personal and commercial use; downloadable software applications for use with three-dimensional printers; data and image processing software for making three-dimensional models; computer software, namely, software tools for graphic computing of three-dimensional images, models and data for making three-dimensional models; computer application software for handheld computers, namely, software for creating and manipulating three-dimensional images, models and data for making three-dimensional

models” in Class 9. Owner alleges a first use of the MODIO (design) mark in connection with the described goods of at least as early as May 13, 2014.

5. On information and belief, the original applicant for the MODIO marks, Modio Inc., assigned the entire interest and goodwill in the MODIO marks and ownership of corresponding U.S. trademark applications U.S. Serial No. 86/277,982 and U.S. Serial No. 86/277,983 to Modio ehf., a corporation of Iceland, with an address at Kirkjutorg 6, 101 Reykjavik, Iceland, as set forth at Reel 005371/Frame 0286 as recorded on September 30, 2014 in the assignment records maintained at the Assignments Branch of the United States Patent & Trademark Office, a copy of which is attached as Exhibit B. Upon information and belief, the assignment of U.S. Serial No. 86/277,982 and U.S. Serial No. 86/277,983 from Modio, Inc. to Modio ehf. was effective as of September 30, 2014.

6. There is no issue as to priority. Opposer used, filed, and registered the MODO mark in connection with its goods long prior to Owner’s May 11, 2014 filing date and alleged earliest date of first use declared as May 13, 2014 for each of the MODIO marks.

7. Upon information and belief, neither Owner nor the original applicant, Modio, Inc., used the MODIO marks prior to Opposer’s first use of MODO.

8. Owner’s MODIO marks are similar to Opposer’s senior MODO mark.

9. Because the purchasing public has come to recognize and associate the services of Opposer by the MODO mark, Owner’s proposed MODIO marks would be

recognized as uniquely and unmistakably identifying or suggesting a connection to Opposer.

10. Opposer is not connected with the activities performed or goods or services sold (or intended to be sold) by Owner under its MODIO marks.

11. The fame and reputation of Opposer is such that, if Owner's MODIO marks are used with Owner's designated goods, a connection with Opposer will be presumed.

12. Through extensive use and promotion of the MODO mark by Opposer, Opposer's MODO mark has become distinctive and famous and it was famous prior to the filing date of Owner's applications for the MODIO marks.

13. Owner's goods are identical and/or commercially related to Opposer's goods. Owner's goods travel, or are likely to travel, in the same channels of trade, and/or be sold in the same types of outlets, and/or be purchased by the same class of consumers and/or be found in the same overlapping marketing environments as the goods of Opposer.

14. Owner's MODIO marks in Application Nos. 86/277,982 and 86/277,983 so resemble Opposer's MODO mark and the goods identified therewith are so closely related to the goods of Opposer to be likely, when used in connection with the Owner's goods, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

15. Owner's MODIO marks in Application Nos. 86/277,982 and 86/277,983 so resemble Opposer's MODO mark and the goods identified therewith are so closely

related to the goods of Opposer to be likely, when used in connection with the Owner's goods, to falsely suggest a connection with Opposer in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

16. Owner's MODIO marks in Application Nos. 86/277,982 and 86/277,983 are likely to cause, and will cause, dilution of the distinctive value of Opposer's MODO mark in violation of Section 43(c) of the Lanham Act, 15 USC § 1125(c).

17. If Owner were granted the registrations herein opposed, it would obtain at least a *prima facie* exclusive right to use of the MODIO marks in connection with the designated goods. Such registrations would be a source of injury and damage to Opposer's prior and established rights in its MODO mark.

WHEREFORE, Opposer respectfully requests that registration of the MODIO marks, set forth in U.S. Application Serial Nos. 86/277,982 and 86/277,983, be refused and that this opposition be sustained.

This Notice of Opposition is accompanied by a payment in the amount of \$600.00 for payment of the required fee.

January 9, 2015

Respectfully submitted,

By: _____


Scott L. Harper
Texas State Bar No. 00795038
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Dallas, TX 75201
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E: scott.harper@harperwasham.com

Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Notice of Opposition was served upon the following on January 9th, 2015, via first-class United States mail and/or electronic mail upon the following:

Via First Class U.S. mail

Modio efh.
Kirkjutorg 6
101 Reykjavik
Iceland

Applicant/Owner

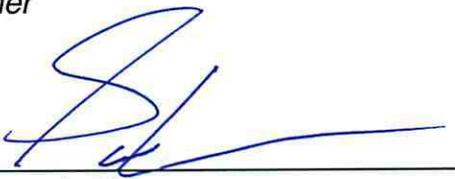
and,

Via First Class U.S. mail and electronic mail

Mr. David Sipiora
Kilpatrick Townsend & Stockton LLP
1400 Wewatta Street, Suite 600
Denver, CO 80202
Email: dsipiora@kilpatricktownsend.com

Ms. Ann Lamport Hammitte
Lando & Anastasi, LLP
Cambridge, MA 02142
Email: alhtrademarks@lalaw.com

Attorneys/Agents for Applicant/Owner



Scott L. Harper

EXHIBIT A

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 3,036,825

United States Patent and Trademark Office

Registered Dec. 27, 2005

**TRADEMARK
PRINCIPAL REGISTER**

MODO

LUXOLOGY, LLC (CALIFORNIA LTD LIAB CO)
1670 SOUTH AMPHLETT BLVD., SUITE 214
SAN MATEO, CA 94402

FOR: SOFTWARE FOR 3D CONTENT CREA-
TION, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

FIRST USE 9-24-2004; IN COMMERCE 9-24-2004.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

THE ENGLISH TRANSLATION OF THE WORD
MODO IN THE MARK IS WAY.

SN 78-449,869, FILED 7-13-2004.

SUE LAWRENCE, EXAMINING ATTORNEY

EXHIBIT B

TRADEMARK ASSIGNMENT COVER SHEET

Electronic Version v1.1
Stylesheet Version v1.2

ETAS ID: TM318448

| | | | |
|---|--|-----------------------|-----------------------|
| SUBMISSION TYPE: | NEW ASSIGNMENT | | |
| NATURE OF CONVEYANCE: | ASSIGNMENT OF THE ENTIRE INTEREST AND THE GOODWILL | | |
| CONVEYING PARTY DATA | | | |
| Name | Formerly | Execution Date | Entity Type |
| Modio Inc. | | 09/30/2014 | CORPORATION: DELAWARE |
| RECEIVING PARTY DATA | | | |
| Name: | Modio ehf. | | |
| Street Address: | Kirkjutorg 6 | | |
| City: | 101 Reykjavik | | |
| State/Country: | ICELAND | | |
| Entity Type: | CORPORATION: ICELAND | | |
| PROPERTY NUMBERS Total: 2 | | | |
| Property Type | Number | Word Mark | |
| Serial Number: | 86277982 | MODIO | |
| Serial Number: | 86277983 | MODIO | |
| CORRESPONDENCE DATA | | | |
| Fax Number: | 6173957070 | | |
| <i>Correspondence will be sent to the e-mail address first; if that is unsuccessful, it will be sent using a fax number, if provided; if that is unsuccessful, it will be sent via US Mail.</i> | | | |
| Phone: | 617-395-7000 | | |
| Email: | alhtrademarks@lalaw.com | | |
| Correspondent Name: | Ann Lamport Hammitte | | |
| Address Line 1: | One Main Street, 11th Floor | | |
| Address Line 2: | Lando & Anastasi, LLP | | |
| Address Line 4: | Cambridge, MASSACHUSETTS 02142 | | |
| ATTORNEY DOCKET NUMBER: | A2123-2000 | | |
| NAME OF SUBMITTER: | Ann Lamport Hammitte | | |
| SIGNATURE: | //alh// | | |
| DATE SIGNED: | 09/30/2014 | | |
| Total Attachments: 1 | | | |
| source=(A2123) ModioTrademark Assignment#page1.tif | | | |

CH \$65.00 86277982

TRADEMARK ASSIGNMENT

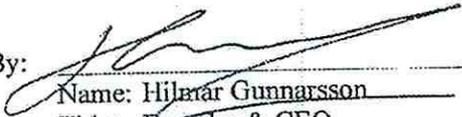
WHEREAS, Modio Inc., a Delaware corporation having an address at Kirkjutorg 6, 101 Reykjavik, Iceland, is owner of the marks MODIO, U.S. Application No. 86/277,982 and MODIO (and Design), U.S. Application No. 86/277,983 (hereinafter, "the Marks"); and

WHEREAS Modio ehf., a corporation of Iceland having an address at Kirkjutorg 6, 101 Reykjavik, Iceland, is the successor to the applicant's business, or that portion of the business to which the Marks pertains, and is desirous of acquiring the Marks and U.S. applications thereof.

NOW, therefore, for good and valuable consideration, receipt of which is hereby acknowledged, Modio Inc. does hereby assign and confirm the assignment unto Modio ehf. all right, title and interest in and to said Marks, together with the business or that portion of the business to which the Marks pertain, the good will of the business symbolized by the Marks, the existing U.S. and any subsequent international applications therefor, and the right to recover for past infringement.

Modio Inc.

Date: 9/30/14

By: 
Name: Hilmar Gunnarsson
Title: Founder & CEO

WITNESS 1:

Date: 9/30/14

By: Haraldur D. Thorvaldsson
Name:

WITNESS 2:

Date: 9/30/14

By: Torki Asgeirsson
Name: