

ESTTA Tracking number: **ESTTA685286**

Filing date: **07/22/2015**

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	Jordan Older
Granted to Date of previous extension	07/22/2015
Address	1126 Via Arroyo Court Ventura, CA 93003 UNITED STATES

Correspondence information	Jordan Older 1126 Via Arroyo Court Ventura, CA 93003 UNITED STATES venturait@gmail.com Phone:805 644 9981
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**Applicant Information**

Application No	86426812	Publication date	03/24/2015
Opposition Filing Date	07/22/2015	Opposition Period Ends	07/22/2015
Applicant	Qualtrics, LLC 400 Qualtrics Drive, #100 Provo, UT 84604 UNITED STATES		

**Goods/Services Affected by Opposition**

<p>Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Computer services, namely, hosting and maintaining an on-line web site for others for conducting consumer surveys and analyzing resulting data; computer services, namely, hosting and maintaining an on-line web site for others for conducting business research and surveys and analyzing resulting data; hosting on-line web facilities for others for conducting consumer surveys and analyzing resulting data; hosting on-line web facilities for others for conducting business research and surveys and analyzing resulting data</p>
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
Other	Their application is only intent to use and my finalized registrations have been in use since before 1998. I coined the term Vocalize for use on the Internet 17 years ago in 1998 when I was the first ever registrar and owner of the vocalize.com domain name registration. No one else had ever

	<p>had a website named Vocalize or used the term Vocalize for a service before that time, since the Internet was only less than 4 years old. The domain was purchased to be used for voice instruction and to make a social network who's feature takes surveys and quizzes on an online hosted website for voice teachers and related people and for voice over IP telephone research and development. This is proven by doing a simple search in the Internet archives (Way Back Machine.) I also have own the registration to vocalize.org since 2003. I was the first to register this domain name as well. Qualtrics has been in negotiations to purchase my domain name vocalize.com and my related trademark registrations since they first contacted me in June of 2014. Additionally they have stated many times they the gave up and abandoned their interest in using the domain and mark: "I spoke with my management team afterwards, and they said they weren't interested in buying the domain from you anymore." - 11/11/14 and "My name is Kylan Lundeen. I wanted to reach out to you regarding www.vocalize.com. The company I work for [QUALTRICS, LLC] is thinking about launching a new product sometime next year and is exploring the idea of using "Vocalize" as the name of the product. As a first step, we thought we'd check to see if the domain is for sale." - 9/2/14</p>
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4742690	Application Date	09/03/2014
Registration Date	05/26/2015	Foreign Priority Date	NONE
Word Mark	VOCALIZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1998/03/25 First Use In Commerce: 1998/03/25 Online advertising and promotional services Class 045. First use: First Use: 1998/03/25 First Use In Commerce: 1998/03/25 On-line social networking services		
U.S. Registration	4738030	Application Date	07/29/2014

No.			
Registration Date	05/19/2015	Foreign Priority Date	NONE
Word Mark	VOCALIZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1998/03/25 First Use In Commerce: 1998/03/25 Computer hardware and software used for the control of voice controlled information and communication devices</p> <p>Class 038. First use: First Use: 1998/03/25 First Use In Commerce: 1998/03/25 Voice over internet protocol (VOIP) services</p> <p>Class 044. First use: First Use: 1998/03/25 First Use In Commerce: 1998/03/25 Voice and sound therapy services</p>		

U.S. Application No.	86427515	Application Date	10/17/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	VOCALIZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1998/03/25 First Use In Commerce: 1998/03/25 Providing temporary use of on-line non-downloadable software for social networking, profiles, chatting, instant messaging, email, polls, surveys, research, forums, videos, quizzes, events, music, ecommerce, shopping, file sharing, blogging, research surveys, and advertising</p>		

Related Proceedings	Opposition No. 91222824
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Attachments	86384658#TMSN.png( bytes ) 86351698#TMSN.png( bytes ) 86427515#TMSN.png( bytes ) vocalize notice of opposition july 22 2015 86426812.pdf(180543 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	/Jordan Older/
Name	Jordan Older
Date	07/22/2015

July 22, 2015

**Dear USPTO:**

Thank you for taking the time to carefully review my opposition. This is a serious matter and the plaintiff, Qualtrics, LLC, has been very tricky and deceptive, and has admitted in writing (and apologized) to acting in bad faith, in their more than year-long attempt to steal my business name, VOCALIZE, and rights to my company website domain name.

I am opposing their applications because I have prior use and their (1B) intent to use applications will confuse my customers, prevent me from fully using my company name, domain name, and trademark, and dilute my ability to get full value and use from my own registered trademarks that I've been using since before 1998. Additionally, as you see below they notified me in writing that they gave up use and abandoned use of the word and domain name Vocalize multiple times and I already own the trademark registration for VOCALIZE in Utah, where Qualtrics is located, in the same and additional classes (see last page of pleading below.)

I coined the term Vocalize for use on the Internet 17 years ago in 1998 when I was the first ever registrar and owner of the vocalize.com domain name registration. No one else had ever had a website named Vocalize or used the term Vocalize for a service before that time, since the Internet was only less than 4 years old. The domain was purchased to be used for voice instruction and to make a social network for voice teachers and related people and for voice over IP telephone research and development. This is proven by doing a simple search in the Internet archives (Way Back Machine.) I also have own the registration to vocalize.org since 2003. I was the first to register this domain name as well.

Qualtrics has been in negotiations to purchase my domain name vocalize.com and my related trademark registrations since they first contacted me in June of 2014:

86384658	4742690	VOCALIZE	TSDR LIVE (registration)
86351698	4738030	VOCALIZE	TSDR LIVE (registration)
86427515		VOCALIZE	TSDR LIVE (application)

In 2014 during negotiations to purchase my domain name and trademarks to it, Qualtrics notified me, in writing more than once, that they were no longer interested in and not going to use the mark Vocalize and were going to use a different mark/domain.

Given this information I started the application to protect my intellectual property by registering trademarks for Vocalize, which have been granted registrations, listed above, already by the USPTO.

Only after discovering my trademark applications did Qualtrics, once again, become interested in using Vocalize and make additional offers to buy the domain name from me and they also made their own trademark (1B intent to use) registrations.

Given that Qualtrics has never used the mark prior to them trying to buy it from me in September of 2014 and I have owned it and been continuously using it for 17 years (since 1998) I am opposing this application because if Qualtrics application is successful it will confuse my customers and the general public as to who "is" Vocalize and it will also dilute the distinctive quality of the mark and prevent me from receiving full use and value of my intellectual property.

Additionally, based on emails from Qualtrics, I believe that they are trying to "STRONG-ARM" me (FORCE ME) into selling the domain name to them at a lower price by making two 1B trademark registrations for marks they have never used in commerce. Qualtrics is a large company worth, in some estimates, up to 1.2 Billion Dollars so this wouldn't be the first time a large company has tried to intimidate an average citizen with limited financial resources. They can easily choose another name that is free instead of going after my name that I've used for 17 years.

On August 2014 they wrote as to why they decided not to purchase:

#####  
QUALTRICS EMAIL DATED August 29, 2014 at 3:43PM PDT  
#####

>Dear Jordan,

>  
>  
>

>My apologies for the way things ended. Unfortunately I have no choice but to do as directed. You negotiated in good faith and I felt that we had reach a price that everyone would be happy with. My client's management group tried to insert themselves into the >negotiation and then the deal fell apart.

#####

Again, in August of 2014 they notified me that they were not going to purchase the domain and trademarks:

#####  
QUALTRICS EMAIL DATED August 29, 2014 at 3:43PM PDT  
#####

>Dear Jordan,

>  
>  
>

>It is not going to happen then.

#####

They also said they were not interested in the trademarks again in October of 2014 as evidenced by this email from Qualtrics on October 17, 2014:

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#####  
EMAIL FROM QUALTRICS DATED OCTOBER 17, 2014 at 1:21PM PDT  
#####  
>"Mr. Older,  
>  
>This email is a final attempt in good faith to purchase your domain name and related property as we  
have discussed for several weeks. If you do not re-engage in reasonable negotiations with us for this  
purchase by early next week, my client will regrettably walk away >and move on with its business. We  
hope you will carefully consider this opportunity."  
#####
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As shown above, Qualtrics clearly notified me that they were no longer going to use Vocalize trademarks in business.

Email received from Qualtrics shows that they were only thinking of using Vocalize oas of September 2nd, 2014 at 3:30PM PDT.

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#####  
EMAIL FROM QUALTRICS DATED SEPTEMBER 2, 2014 at 3:30PM PDT  
#####  
>Hi Jordan,  
>  
>My name is Kylan Lundeen. I wanted to reach out to you regarding www.vocalize.com. The company  
I work for is thinking about launching a new product sometime next year and is exploring the idea of  
using "Vocalize" as the name of the product. As a first step, we >thought we'd check to see if the  
domain is for sale.  
#####
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Finally in November of 2014, they said they were (once again) not going to purchase the domain nor trademarks for Vocalize from me.

#####  
EMAIL FROM QUALTRICS DATED NOVEMBER 11, 2014 at 7:48AM PST  
#####

>Hi Jordan,

>

>Thank you for your note. The reason we were interested in purchasing your domain was for a product launch that has already passed now. It was simply going to be part of our launch and marketing message at that time. I was really trying to close the deal before >then, but unfortunately it didn't happen in time. I spoke with my management team afterwards, and they said they weren't interested in buying the domain from you anymore.

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So, based on all this information from Qualtrics' own emails (non use and multiple notices of abandonment of the trademarks for Vocalize), I respectfully request that the powers that be at the USPTO cancel this and any other "Vocalize" trademark applications made by Qualtrics because their registrations will confuse my customer and the general public and they will dilute the use and value of my intellectual property and company names and, by their own admittance in emails above where they apologized, they have been acting in bad faith trying to force me to sell my domain name by making trademark registrations.

Best regards,

Jordan Older  
/Jordan Older/

1126 Via Arroyo Court  
Ventura, CA 93003 USA  
Tel 805 644 9981  
venturait@gmail.com



**Francine Giani**  
*Executive Director*  
 Department of Commerce

**Gary Herbert**  
*Governor*  
 State of Utah

**Kathy Berg**  
*Director*  
 Division of Corporations  
 & Commercial Code

**JORDAN OLDER**  
 1126 VIA ARROYO  
 VENTURA CA 93003

**Mark Title:**  
**VOCALIZE (TEXT ONLY)**  
**Access ID: 5361141**



State of Utah  
 Department of Commerce  
 Division of Corporations & Commercial Code

**CERTIFICATE OF TRADEMARK**  
**VOCALIZE (TEXT ONLY)**

Registration Number: 9294372-0190  
 Registration Date: 01/27/2015  
 Expiration Date: 01/27/2020 (unless timely renewed)  
 Applicant/Owner: JORDAN OLDER  
 Applicant/Owner Address: 1126 Via Arroyo Ventura Ca 93003  
 Description: THE WORD "VOCALIZE".  
 Goods/services: Scientific, technology service, research / Scientific, nautical, surveying, electric  
 Education; providing of trainin / Advertising; business management  
 Telecommunications. / Personal and social services  
 Date first used in Utah: 01/01/1998  
 Date of first use: 01/01/1998  
 Federal Application Filed?: Yes / 86384658 / Pending

The design mark image is available at the Division

This certifies that the above has been filed and approved in the office of the Division, which hereby issues this Certification thereof.

**KATHY BERG**  
 Division Director