

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

In the matter of
Trademark Application Serial No.: 85/934,543
Filed: May 16, 2013
Published: June 30, 2015
Mark: WEBNX

Express Mail mailing label No. EV518447353US

Date of Deposit 12/23/15

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Roxanne Y. Gibson

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Roxanne Y. Gibson

(Signature of Person Mailing Paper or Fee)

Cisco Technology, Inc.,)
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Opposer,)
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v.)
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WebNX, Inc.,)
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Applicant.)
_____)

Opposition No. _____

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NOTICE OF OPPOSITION

Cisco Technology, Inc., a California Corporation, having its business at 170 West Tasman Drive, San Jose, California 95134, ("Opposer"), believes that it will be damaged by the registration of the mark shown in Application Serial Number 85/934,543, and hereby opposes that application, alleging as grounds for the opposition that:

1. WebNX, Inc. ("Applicant") seeks to register WEBNX as a trademark for "Communications servers; Computer network server; Computer servers; Computer software for controlling and managing access server applications; Computer storage devices, namely, high-speed storage subsystems for storage and backup of electronic data either locally or via a telecommunications network; Internet servers; Intranet servers; Network access server hardware; Network access server operating software; Network servers; Telecommunications and data networking hardware, namely, devices for transporting and aggregating voice, data, and video communications across multiple network infrastructures and communications protocols" in International Class 9; "Operation and administration of telecommunication systems and networks

for others; Telecommunications network management services, namely, the operation and administration of telecommunication systems and networks for others” in International Class 35; “Consulting in the field of telecommunication services, namely, transmission of voice, data, and documents via telecommunications networks; Data transmission and reception services via telecommunication means; Digital network telecommunications services; Electronic exchange of data stored in databases accessible via telecommunication networks; Leasing of telecommunication equipment; Leasing of telecommunication equipment, namely, servers; Providing telecommunication connections to the internet or databases; Providing telecommunications connections to a global computer network; Providing telecommunications connections to the internet or databases; Rental of equipment for telecommunications; Rental of telecommunication equipment; Rental of telecommunication equipment servers; Rental of telecommunication facilities; Telecommunication access services; excluding deployment using X-Window protocol and/or proxy systems” in International Class 38; “Computer co-location services, namely, providing facilities for the location of computer servers with the equipment of others; Computer services, namely, providing virtual and non virtual application servers, web servers, file servers, colocation servers, load balancing servers, redundancy servers, media servers and database servers of variable capacity to third party computing and data storage facilities; Consulting in the field of telecommunications technology; Design of telecommunications apparatus and equipment; Developing and hosting a server on a global computer network for the purpose of facilitating e-commerce via such a sever; Displaying the web sites and images of others on a computer server; Hosting the software, websites and other computer applications of others on a virtual private server; Hosting the web sites of others on a computer server for a global computer network; Providing a website featuring technology that enables subscribers to transfer files to and from a file transfer protocol server; Rental of a database server (to third parties); Rental of web servers; Server hosting; Technical support services, namely, 24/7 monitoring of network systems, servers and web and database

applications and notification of related events and alerts; Technical support services, namely, technical administration of servers for others and troubleshooting in the nature of diagnosing server problems; excluding deployment using X-Window protocol and/or proxy systems” in International Class 42 (“the Application”). The Application was filed on May 16, 2013, based on Applicant’s alleged first use since December 31, 1999.

2. Opposer is the owner of numerous WEBEX and WEBEX-based marks (collectively, the “WEBEX Marks”), including, for example, the following registrations:

Trademark	Reg. No.	Full Goods Description	Filing Date	Registration Date	First Use Date (at least as early as)
WEBEX	2102292	(Int’l Class: 9) Computer software for use in conjunction with software for browsing of a global computer network, to control and automate the browser software	May 31, 1996	September 30, 1997	June 1996
WEBEX	2480416	(Int’l Class: 38) Web-based multimedia teleconferencing services	December 14, 1998	August 21, 2001	February 1999
WEBEX	2527930	(Int’l Class: 9) Computer software for transmitting information over a global computer information network	December 14, 1998	January 8, 2002	February 1999
WEBEX MEETING CENTER	2920570	(Int’l Class: 38) Multimedia communications services in real time, namely, video and audio teleconferencing, which also allows users to transmit and access electronic data, documents and software applications via the internet.	October 23, 2000	January 25, 2005	February 7, 1999

These registrations are valid and subsisting and are conclusive evidence of Opposer's exclusive right to use the WEBEX Marks in commerce in connection with the goods and services specified therein.

3. There is no issue as to priority. Opposer commenced use of the WEBEX Marks prior to the filing date of the Application and Applicant's alleged first use date. Opposer also filed WEBEX Registration Nos. 2102292, 2480416, and 2527930 prior to the filing date of the Application and Applicant's alleged first use date. WEBEX and WEBNX are visually and aurally similar. In view of the similarities of the respective marks and the related nature of the goods of the respective parties, it is alleged that Applicant's alleged WEBNX mark so resembles Opposer's WEBEX Marks as to be likely to cause confusion or mistake or to deceive, thereby causing loss, damage, and injury to Opposer and the purchasing public, and to dilute the distinctive quality of Opposer's famous WEBEX mark, thereby causing loss, damage, and injury to Opposer and the purchasing public.

4. Opposer is in the business of designing, manufacturing, marketing, selling, and providing a range of networking and telecommunications goods and services throughout the United States and worldwide. Since at least as early as February 1999, Opposer or its predecessors in interest have used the WEBEX Marks in connection with communications and networking software and services.

5. The aforementioned nationwide trademark and service mark use of the WEBEX Marks by Opposer has been valid and continuous since the date of first use of each and has not been abandoned. As a consequence of Opposer's extensive marketing, promotion, advertising, and sales activity, Opposer's WEBEX Marks have come to be identified as designators of Opposer's goods and services, and as a result, have become valuable assets of Opposer, and principal symbols of its goodwill, and WEBEX is now famous. In view of the similarity of the respective marks and the related nature of the goods of the respective parties, it is alleged that Applicant's alleged WEBNX mark so resembles Opposer's WEBEX Marks

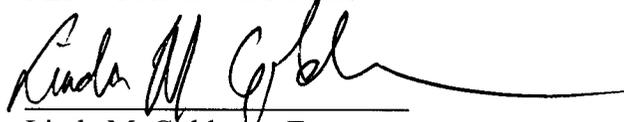
previously used in the United States, and not abandoned, as to be likely to cause confusion or mistake or to deceive, thereby causing loss, damage, and injury to Opposer and the purchasing public, and to dilute the distinctive quality of Opposer's famous WEBEX mark, thereby causing loss, damage, and injury to Opposer and the purchasing public.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that the Application be rejected.

Please charge the requisite \$1,200.00 filing fee for this Notice of Opposition and any additional fees to our Deposit Account No. 50-0261.

Date: December 23, 2015

Respectfully submitted,
FENWICK & WEST LLP



Linda M. Goldman, Esq.
Attorney for Opposer
FENWICK & WEST LLP
Silicon Valley Center
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Mountain View, CA 94041
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CERTIFICATE OF SERVICE

The undersigned declares that:

I, Anthony Olivas, am employed in the County of Santa Clara, State of California. I am over the age of 18 and not a party to this action. My business address is: Fenwick & West LLP, Silicon Valley Center, 801 California Street, Mountain View, CA 94041.

On December 23, 2015, I caused to be served the attached:

NOTICE OF OPPOSITION

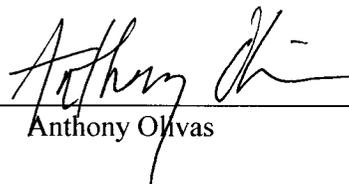
on the parties in the subject action by placing a true copy thereof as indicated below, address:

Keesonga Gore
Minott Gore, P.A.
201 S. Biscayne Boulevard, Suite 2800
Miami, FL 33131

- (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: December 23, 2015



Anthony Olivas