

ESTTA Tracking number: **ESTTA731817**

Filing date: **03/07/2016**

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	PN, LLC
Granted to Date of previous extension	03/09/2016
Address	102 NE 2nd Street PMB #171 Boca Raton, FL 33432 UNITED STATES

Attorney information	Scott Austin VLP Law Group LLP 101 NE Third Avenue Suite 1500 FT LAUDERDALE, FL 33301 UNITED STATES saustin@vlpawgroup.com Phone:2168707954
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Applicant Information

Application No	86667197	Publication date	11/10/2015
Opposition Filing Date	03/07/2016	Opposition Period Ends	03/09/2016
Applicant	Connect Studios, Inc. 85 Garfield Avenue Cranston, RI 02908 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Software as a service (SAAS) services featuring software for service-based companies namely, sales lead management, compliance engines, account management, billing, collections, inventory control, product ordering and reporting tools
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86711994	Application Date	07/31/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PN		

Design Mark	<h1>PN</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2005/03/14 First Use In Commerce: 2005/03/14 Computer software that provides web-based access to applications and services through a web operating system or portal interface Class 042. First use: First Use: 2003/01/23 First Use In Commerce: 2005/03/14 Computer consultation; Computer consultation in the field of computer security; Computer programming

Attachments	86711994#TMSN.png(bytes) PN, LLC Notice of Opposition with Exhibits A through E.pdf(703279 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	/Scott R. Austin/
Name	Scott R. Austin
Date	03/07/2016

To the best of Opposer's knowledge, the name and address of Applicant is Connect Studios, Inc., 85 Garfield Avenue, Cranston, Rhode Island 02908.

1. Opposer, PN, LLC, is engaged in providing computer software that provides web-based access to applications and services through a web operating system or portal interface, as well as computer consultation, computer consultation in the field of computer security and computer programming services.

2. Since at least as early as 2005, and continuously since that time, Opposer's mark "PN" has been used by Opposer on a web site built upon the domain name "pn.com" owned by Opposer, located at www.pn.com as the Internet address where the mark has been used to identify Opposer's software and computer consulting services for computer software and security, as well as its computer programming services.

3. Opposer is the owner of a pending application for U.S. trademark registration ("Opposer's Application") filed July 31, 2015 (Ser. No. 86/711,994) for the standard character word mark PN ("Opposer's PN Mark") to be used as a source identifier for "Computer software that provides web-based access to applications and services through a web operating system or portal interface" in International Class 9 having a first use date at least as early as March 14, 2005, and "Computer consultation; Computer consultation in the field of computer security; Computer programming" services in International Class 42 having a first use date at least as early as January 23, 2003. A current printout of the information from the Trademark Electronic Search System (TESS) electronic database records of the USPTO showing the current status and applicant data of Opposer's Application is attached hereto as Exhibit A.

4. Opposer is also the owner of established common law rights in and to Opposer's

PN Mark, established to serve clients globally through the World Wide Web portion of the Internet using the domain name pn.com, the URL or Internet address www.pn.com, and the use of the mark to identify the software and computer consulting, security and programming services displayed as content on its web site located at the pn.com domain name at which Opposer uses the mark in commerce.

5. As a result of its widespread, continuous and exclusive use of Opposer's PN Mark to identify its software and computer consulting, security and programming services and Opposer as their source, Opposer owns valid and subsisting federal statutory and common law rights to Opposer's PN Mark.

6. Opposer's PN Mark is distinctive to both the consuming public and Opposer's trade.

7. Opposer has expended substantial time, money and resources marketing, advertising and promoting the software and computer consulting, security and programming services sold under Opposer's PN Mark including through Opposer's marketing, website, online advertising and promotional efforts under Opposer's PN Mark.

8. Opposer is also the owner of US Trademark Registrations for marks used to identify a broad array of computing services that Opposer has provided over many years as follows: PAUL.COM (Reg. No. 4,546,055) registered June 10, 2014, for "Computer software consulting; computer security consulting; computer programming" in International Class 42, having a first use date at least as early as February 1994; PAUL DOT COM (Reg. No. 4,546,054) registered June 10, 2014, for "Computer software consulting; computer security consulting; computer programming" in International Class 42 having a first use date at least as early as

February 1994; and IDENTIFICATION.COM (Reg. No. 2,922,662) registered February 1, 2005, for among other things “Providing authentication of identity; issuance and management of digital certificates for authentication or encryption of a digital communication, or authentication of a digital signature in an electronic transaction or communication, over the Internet and other computer network and providing technical and customer support in connection therewith; development, design, implementation, testing, analysis, and consulting services in the field of security, access, authorization, authentication encryption, and identification systems for computers, computer hardware and computer networks; development, integration and operation of computer systems to support issuance and management of digital certificates; creation and implementation of procedures and practices for issuance and management of digital certificates; computer related services, namely, managed computer network and Internet security services, namely, public key infrastructure ("PKI") verification, authentication, distribution and management, digital certificate issuance, verification, and management, and enterprise software integration; computer consultation regarding computer networks and internal computer networks, security services for computer networks and internal computer networks, namely, designing fire walls for others; computer software consultation services for the development of software applications; designing and programming computer controlled communications systems.” in International Class 42, having a first use date at least as early as April 2003. A copy of the Certificate of Registration from the electronic database records of the USPTO for each of Opposer’s respective registrations is set forth in attached Exhibits B, C and D.

9. Upon information and belief, Applicant Connect Studios, Inc., with an address at 85 Garfield Avenue, Cranston, Rhode Island 02908, on June 18, 2015, filed U.S. Trademark

Application Ser. No. 86/667,197, to register the proposed mark PN (words plus design) for “software as a service (SAAS) services featuring software for service-based companies namely, sales lead management, compliance engines, account management, billing, collections, inventory control, product ordering and reporting tools” in International Class 42 (hereinafter “Applicant’s Proposed PN Mark”).

10. A review of the application history of Applicant’s Proposed PN Mark shows that it was filed on an intent-to-use basis under Section 1(B) of the Trademark Act. Applicant’s mark, therefore, has yet to be used in commerce. A current printout of the information from the TESS electronic database records of the USPTO showing the current status and applicant data of Applicant’s Proposed PN Mark is attached hereto as Exhibit E.

11. Opposer’s priority of use of its mark is established based on the first use date in Opposer’s Application, which provides that it first used its mark anywhere at common law at least as early as January 23, 2003, and in interstate commerce at least as early as March 14, 2005. This serves as evidence of Opposer’s priority and exclusive right to use Opposer’s PN Mark in commerce on the services specified in Opposer’s Application.

12. Opposer's PN Mark has priority over Applicant’s Proposed PN Mark because Opposer's use dates predate by over a decade the Applicant's filing date or any other date on which the Applicant may rely for purposes of priority.

13. Applicant’s Proposed PN Mark, , although stylized and appearing below a small infinity symbol, is essentially identical and thus confusingly similar to Opposer’s PN Mark, therefore, denying to Opposer the benefits of its mark in excluding confusingly similar uses.

14. The software and software services covered by the Applicant's Application are similar to the software and computer consulting, security and programming services Opposer offers under Opposer's PN Mark.

15. In view of the fact that the respective marks are essentially identical and the goods and services provided by the respective parties are very similar and include related services in the same International Class 42 it is alleged that Applicant's Proposed PN Mark so resembles Opposer's PN Mark, as to be likely to cause confusion, or to cause mistake, or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

16. The services purported to be provided by the Applicant include services which third parties may assume emanated from or are affiliated with or approved by Opposer, specifically, computer software, software services and computer programming services, and thus there is substantial likelihood of confusion of the relevant portion of the public who are exposed both to the Applicant's services and the services of Opposer. The Applicant's Proposed PN Mark, as the newcomer, will be seen as a deliberate "stylized" variation of Opposer's PN Mark and domain name, intended to indicate an association, affiliation or approval from the same source and thus is further likely to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer prays that Application Serial No. 86/667,197 be refused registration as Opposer believes and avers that it will be damaged by the registration of Serial No. 86/667,197, filed June 18, 2015, as aforesaid and requests that Applicant be required to answer the allegations of this Notice of Opposition and that the opposition to Applicant's Application be sustained.

The undersigned Opposer in the above-entitled cause hereby appoints Scott R. Austin and Brian M. Davis, members of the bar in the states of Florida and North Carolina, respectively, its attorneys with full power of substitution and revocation to prosecute this Opposition and to transact all business in the United States Patent and Trademark Office in connection therewith.

Respectfully submitted,

Date: March 7, 2016

/Scott R. Austin/
Scott R. Austin
Attorney for Opposer

VLP Law Group LLP
101 NE Third Avenue
Suite 1500
Fort Lauderdale, FL 33301
Telephone: (954) 204-3744
Facsimile: (954) 320-0233

CERTIFICATE OF SERVICE

I hereby certify that on March 7, 2016 I caused a true and correct copy of the foregoing Notice of Opposition to be served by United States First Class Mail, post prepaid, upon the following attorney of record for Applicant:

Karen A. Buchanan, Esq.
Buchanan Law LLC
400 Putnam Pike, Ste. J256
Smithfield, RI 02917-2408

Date of Mailing: March 7, 2016

Printed Name: Scott R. Austin

Signature: /Scott R. Austin/ _____

EXHIBIT A



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PN

Word Mark PN

Goods and Services IC 009. US 021 023 026 036 038. G & S: Computer software that provides web-based access to applications and services through a web operating system or portal interface. FIRST USE: 20050314. FIRST USE IN COMMERCE: 20050314

IC 042. US 100 101. G & S: Computer consultation; Computer consultation in the field of computer security; Computer programming. FIRST USE: 20030123. FIRST USE IN COMMERCE: 20050314

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 86711994

Filing Date July 31, 2015

Current Basis 1A

Original Filing Basis 1A

Owner (APPLICANT) PN, LLC LIMITED LIABILITY COMPANY DELAWARE #171 102 NE 2nd Street Boca Raton FLORIDA 33432

Attorney of Record Scott R. Austin

Type of Mark TRADEMARK. SERVICE MARK

Register PRINCIPAL

**Live/Dead
Indicator**

LIVE

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EXHIBIT B

United States of America

United States Patent and Trademark Office

PAUL.COM

Reg. No. 4,546,055

Registered June 10, 2014

Int. Cl.: 42

SERVICE MARK

PRINCIPAL REGISTER

PN, LLC (DELAWARE LIMITED LIABILITY COMPANY)
971
103 NE 2ND STREET
BOCA RATON, FL 33432

FOR: COMPUTER SOFTWARE CONSULTING, COMPUTER SECURITY CONSULTING,
COMPUTER PROGRAMMING, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 2-10-1994; IN COMMERCE 2-10-1994.

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

SER. NO. 85-772,105, FILED 11-5-2012.

DAVID BLON, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

EXHIBIT C

United States of America

United States Patent and Trademark Office

PAUL DOT COM

Reg. No. 4,546,054

Registered June 10, 2014

Int. Cl.: 42

SERVICE MARK

PRINCIPAL REGISTER

PN, LLC (DELAWARE LIMITED LIABILITY COMPANY)
971
103 NE 2ND STREET
BOCA RATON, FL 33432

FOR: COMPUTER SOFTWARE CONSULTING, COMPUTER SECURITY CONSULTING,
COMPUTER PROGRAMMING, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 2-10-1994; IN COMMERCE 2-10-1994.

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

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "DOT COM", APART FROM THE MARK AS SHOWN.

SER. NO. 85-772,096, FILED 11-5-2012.

DAVID ELTON, EXAMINING ATTORNEY



Michelle K. Lee

Deputy Director of the United States
Patent and Trademark Office

EXHIBIT D

Int. Cls.: 9 and 42

Prior U.S. Cls.: 21, 23, 26, 36, 38, 100 and 101

United States Patent and Trademark Office

Reg. No. 2,922,662

Registered Feb. 1, 2005

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**

IDENTIFICATION.COM

IDENTIFICATION.COM, LLC (FLORIDA LTD
LIAB CO)

C/O ARNSTEIN & LEHR

515 N. FLAGLER DRIVE SUITE 500

WEST PALM BEACH, FL 33411

FOR: COMPUTER SOFTWARE IN THE FIELD OF CRYPTOGRAPHIC NETWORK SECURITY AND DATA SECURITY FUNCTIONS; COMPUTER SOFTWARE FOR INTEGRATION OF INFORMATION LOGIC AND DATA BETWEEN COMPUTER NETWORKS; COMPUTER SOFTWARE FOR AUTOMATING A PROCESS FOR AUTHENTICATION OF IDENTITY USING EXISTING DATABASES IN CONNECTION WITH THE ISSUANCE AND MANAGEMENT OF DIGITAL CERTIFICATES USED FOR AUTHENTICATION OR ENCRYPTION OF DIGITAL COMMUNICATIONS, OR AUTHENTICATION OF A DIGITAL SIGNATURE IN AN ELECTRONIC TRANSACTION OR COMMUNICATION, OVER THE INTERNET AND OTHER COMPUTER NETWORKS; COMPUTER SOFTWARE, NAMELY ENCRYPTION SOFTWARE TO ENABLE SECURE TRANSMISSION OF DIGITAL INFORMATION, NAMELY, CONFIDENTIAL, FINANCIAL AND CREDIT CARD INFORMATION OVER THE INTERNET AS WELL AS OVER OTHER MODES OF COMMUNICATION BETWEEN COMPUTING DEVICES; COMPUTER SOFTWARE TO INTEGRATE MANAGED SECURITY SERVICES, NAMELY PUBLIC KEY INFRASTRUCTURE (PKI) SERVICES, DIGITAL CERTIFICATE ISSUANCE, VERIFICATION, AND MANAGEMENT, AND ENTERPRISE SOFTWARE INTEGRATION, WITH EXISTING COMMUNICATIONS NETWORKS, SOFTWARE, AND SERVICES, DOWNLOADABLE ELECTRONIC PUBLICATIONS IN THE NATURE OF A NEWSLETTER IN THE FIELD OF INFORMATION TECHNOLOGY, IN CLASS 9 (U.S. CLS. 21, 23, 25, 36 AND 38).

FIRST USE 4-30-2003; IN COMMERCE 4-30-2003.

FOR: PROVIDING AUTHENTICATION OF IDENTITY; ISSUANCE AND MANAGEMENT OF DIGITAL CERTIFICATES FOR AUTHENTICATION OR ENCRYPTION OF A DIGITAL COMMUNICATION, OR AUTHENTICATION OF A DIGITAL SIGNATURE IN AN ELECTRONIC TRANSACTION OR COMMUNICATION, OVER THE INTERNET AND OTHER COMPUTER NETWORK AND PROVIDING TECHNICAL AND CUSTOMER SUPPORT IN CONNECTION THEREWITH; DEVELOPMENT, DESIGN, IMPLEMENTATION, TESTING, ANALYSIS, AND CONSULTING SERVICES IN THE FIELD OF SECURITY, ACCESS, AUTHORIZATION, AUTHENTICATION, ENCRYPTION, AND IDENTIFICATION SYSTEMS FOR COMPUTERS, COMPUTER HARDWARE AND COMPUTER NETWORKS; DEVELOPMENT, INTEGRATION AND OPERATION OF COMPUTER SYSTEMS TO SUPPORT ISSUANCE AND MANAGEMENT OF DIGITAL CERTIFICATES; CREATION AND IMPLEMENTATION OF PROCEDURES AND PRACTICES FOR ISSUANCE AND MANAGEMENT OF DIGITAL CERTIFICATES; COMPUTER RELATED SERVICES, NAMELY, MANAGED COMPUTER NETWORK AND INTERNET SECURITY SERVICES, NAMELY, PUBLIC KEY INFRASTRUCTURE ("PKI") VERIFICATION, AUTHENTICATION, DISTRIBUTION AND MANAGEMENT, DIGITAL CERTIFICATE ISSUANCE, VERIFICATION, AND MANAGEMENT, AND ENTERPRISE SOFTWARE INTEGRATION; COMPUTER CONSULTATION REGARDING COMPUTER NETWORKS AND INTERNAL COMPUTER NETWORKS, SECURITY SERVICES FOR COMPUTER NETWORKS AND INTERNAL COMPUTER NETWORKS, NAMELY, DESIGNING FIRE WALLS FOR OTHERS; COMPUTER SOFTWARE CONSULTATION SERVICES FOR THE DEVELOPMENT OF SOFTWARE APPLICATIONS; DESIGNING AND PROGRAMMING COMPUTER CONTROLLED COMMUNICATIONS SYSTEMS, IN CLASS 42 (U.S. CLS. 100 AND 101).

FIRST USE 4-30-2003; IN COMMERCE 4-30-2003.

EXHIBIT E



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Word Mark PN

Goods and Services IC 042. US 100 101. G & S: Software as a service (SAAS) services featuring software for service-based companies namely, sales lead management, compliance engines, account management, billing, collections, inventory control, product ordering and reporting tools

Mark

Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design

Search Code 24.17.12 - Infinity symbols

Serial Number 86667197

Filing Date June 18, 2015

Current Basis 1B

Original Filing Basis 1B

Published for Opposition November 10, 2015

Owner (APPLICANT) Connect Studios, Inc. CORPORATION DELAWARE 85 Garfield Avenue Cranston RHODE ISLAND 02908

Attorney of Record Karen A. Buchanan

Description of Mark Color is not claimed as a feature of the mark. The mark consists of the letter "p" and the letter "n" below an infinity symbol.

Type of Mark SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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