

ESTTA Tracking number: **ESTTA759843**

Filing date: **07/21/2016**

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	Recommind, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	580 California Street Seventh Floor San Francisco, CA 94104 UNITED STATES		

Attorney information	Jennifer Lee Taylor Morrison & Foerster LLP 425 Market Street San Francisco, CA 94105 UNITED STATES jtaylor@mofo.com, slarson@mofo.com, aphillips@mofo.com, ggabriel@mofo.com, tmdocket@mofo.com
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Applicant Information

Application No	86634265	Publication date	06/21/2016
Opposition Filing Date	07/21/2016	Opposition Period Ends	07/21/2016
Applicants	Maura Grossman Apt. 1A New York, NY 10075 UNITED STATES Gordon V. Cormack Apt. 305 Waterloo, Ontario, N2L5C8 CANADA		

Goods/Services Affected by Opposition

Class 009. First Use: 2014/01/15 First Use In Commerce: 2014/01/15 All goods and services in the class are opposed, namely: Computer software for reviewing, analyzing, categorizing, prioritizing and storing electronic documents for law firm and corporate departments; computer software for technology-assisted review of electronic documents; computer software forelectronic document and information management; computer software for searching, processing, culling, organizing, filtering, prioritizing, analyzing, reviewing, coding, printing and producing electronic documents in the field of legal discovery
Class 041. First Use: 2014/01/15 First Use In Commerce: 2014/01/15 All goods and services in the class are opposed, namely: Educational services, namely, conducting symposia, seminars, conferences, and workshops in the field of legal discoveryand technology-assisted review of electronic documents and development and dissemination of scholarly materials in connection therewith; publication of articles relating to legal discovery and technology-assisted review of electronic documents, books, and journals
Class 042. First Use: 2014/01/15 First Use In Commerce: 2014/01/15

All goods and services in the class are opposed, namely: Research and development of new technology and theory for others in the field of legal discovery and development and dissemination of scholarly materials in connection therewith; Providing temporary use of on-line non-downloadable software for reviewing, analyzing, categorizing, prioritizing and storing electronic documents for law firm and corporate departments; data conversion of electronic information; providing temporary use of on-line non-downloadable software for technology-assisted review of electronic documents; providing temporary use of on-line non-downloadable software for electronic document and information management; providing temporary use of on-line non-downloadable computer software for preserving, collecting, processing, culling, filtering, searching, organizing, prioritizing, analyzing, reviewing, coding, printing, producing, and presenting electronic documents in the field of legal discovery; data conversion of electronic information

Class 045. First Use: 2014/01/15 First Use In Commerce: 2014/01/15

All goods and services in the class are opposed, namely: Litigation support services; Legal services, namely, providing customized information through the review of documents for investigation or litigation; Litigation support services, namely, conducting technology-assisted review of electronic documents and electronic legal discovery in the nature of preserving, collecting, processing, culling, filtering, searching, organizing, prioritizing, analyzing, reviewing, coding, printing, producing, and presenting e-mails and other electronically stored information that could be relevant in a lawsuit or government investigation

Grounds for Opposition

The mark is merely descriptive	Trademark Act Section 2(e)(1)
The mark is generic	Trademark Act Sections 1, 2 and 45
The mark is not inherently distinctive and has not acquired distinctiveness	Trademark Act Sections 1, 2 and 45; and Section 2(f)

Attachments	CAL - Notice of Opposition our ref. 60232-6015.501.pdf(444078 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	/Jennifer Lee Taylor/
Name	Jennifer Lee Taylor
Date	07/21/2016

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

RECOMMIND, INC.,

Opposer,

vs.

GORDON V. CORMACK and MAURA
GROSSMAN,

Applicants.

Opposition No.:

Application Serial No.: 86/634,265

Mark: CAL

Published: June 21, 2016

NOTICE OF OPPOSITION

Box TTAB FEE
Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

Recommind, Inc. (“Opposer”), a corporation having its principal place of business at 580 California Street, Seventh Floor, San Francisco, 94104, believes that it will be damaged by the registration of the CAL mark in Application Serial No. 86/634,265, filed by Gordon V. Cormack and Maura Grossman (“Applicants”), for “Computer software for reviewing, analyzing, categorizing, prioritizing and storing electronic documents for law firm and corporate departments; computer software for technology-assisted review of electronic documents; computer software for electronic document and information management; computer software for searching, processing, culling, organizing, filtering, prioritizing, analyzing, reviewing, coding, printing and producing electronic documents in the field of legal discovery,” in Class 9, “Educational services, namely, conducting symposia, seminars, conferences, and workshops in the field of legal discovery and technology-assisted review of electronic documents and

development and dissemination of scholarly materials in connection therewith; publication of articles relating to legal discovery and technology-assisted review of electronic documents, books, and journals,” in Class 41, “Research and development of new technology and theory for others in the field of legal discovery and development and dissemination of scholarly materials in connection therewith; Providing temporary use of on-line non-downloadable software for reviewing, analyzing, categorizing, prioritizing and storing electronic documents for law firm and corporate departments; data conversion of electronic information; providing temporary use of on-line non-downloadable software for technology-assisted review of electronic documents; providing temporary use of on-line non-downloadable software for electronic document and information management; providing temporary use of on-line non-downloadable computer software for preserving, collecting, processing, culling, filtering, searching, organizing, prioritizing, analyzing, reviewing, coding, printing, producing, and presenting electronic documents in the field of legal discovery; data conversion of electronic information,” in Class 42, and “Litigation support services; Legal services, namely, providing customized information through the review of documents for investigation or litigation; Litigation support services, namely, conducting technology-assisted review of electronic documents and electronic legal discovery in the nature of preserving, collecting, processing, culling, filtering, searching, organizing, prioritizing, analyzing, reviewing, coding, printing, producing, and presenting e-mails and other electronically stored information that could be relevant in a lawsuit or government investigation,” in Class 45.

As grounds for the opposition, it is alleged as follows:

1. Opposer provides various software-as-a-service platforms for use in the fields of e-discovery, regulatory compliance, records management, and data retention. Opposer’s

software applications rely on various predictive coding methodologies to assist users in reviewing large volumes of documents. These predictive coding methodologies are commonly referred to as technology-assisted review (“TAR”) of electronically stored information.

2. Applicants filed Application Serial No. 86/634,265 for the CAL mark on May 19, 2015. In their application, Applicants claimed a first use anywhere and a first use in commerce date of January 15, 2014. The application was published in the *Official Gazette* on June 21, 2016.

3. By the application herein opposed, Applicants seek to register the CAL mark for “Computer software for reviewing, analyzing, categorizing, prioritizing and storing electronic documents for law firm and corporate departments; computer software for technology-assisted review of electronic documents; computer software for electronic document and information management; computer software for searching, processing, culling, organizing, filtering, prioritizing, analyzing, reviewing, coding, printing and producing electronic documents in the field of legal discovery,” in Class 9, “Educational services, namely, conducting symposia, seminars, conferences, and workshops in the field of legal discovery and technology-assisted review of electronic documents and development and dissemination of scholarly materials in connection therewith; publication of articles relating to legal discovery and technology-assisted review of electronic documents, books, and journals,” in Class 41, “Research and development of new technology and theory for others in the field of legal discovery and development and dissemination of scholarly materials in connection therewith; Providing temporary use of on-line non-downloadable software for reviewing, analyzing, categorizing, prioritizing and storing electronic documents for law firm and corporate departments; data conversion of electronic information; providing temporary use of on-line non-downloadable software for technology-

assisted review of electronic documents; providing temporary use of on-line non-downloadable software for electronic document and information management; providing temporary use of on-line non-downloadable computer software for preserving, collecting, processing, culling, filtering, searching, organizing, prioritizing, analyzing, reviewing, coding, printing, producing, and presenting electronic documents in the field of legal discovery; data conversion of electronic information,” in Class 42, and “Litigation support services; Legal services, namely, providing customized information through the review of documents for investigation or litigation; Litigation support services, namely, conducting technology-assisted review of electronic documents and electronic legal discovery in the nature of preserving, collecting, processing, culling, filtering, searching, organizing, prioritizing, analyzing, reviewing, coding, printing, producing, and presenting e-mails and other electronically stored information that could be relevant in a lawsuit or government investigation,” in Class 45.

4. Applicants’ alleged mark “CAL” is a commonly used acronym for “continuous active learning,” which is the category name of a particular method of predictive coding used in the area of technology-assisted review of electronically stored information.

5. “CAL” is not capable of distinguishing Applicants’ goods and services because it the generic name of, or in the alternative, so highly descriptive of a type of predictive coding that it is incapable of acquiring distinctiveness as a trademark.

6. Opposer and others in the e-discovery industry have a present and prospective right to use the term “CAL” generically and/or descriptively in their business to refer to predictive coding used for technology-assisted review of electronically stored information.

7. In view of the fact that allowing registration of Applicants’ mark would preclude e-discovery companies, including Opposer, from referring to the “CAL” coding methodology by

the common, generic name for that coding methodology, Opposer would thereby be injured by Applicants' intended registration of the CAL mark in Application Serial No. 86/634,265.

Filing Fee: The USPTO is authorized to charge \$1,200.00 for the Notice of Opposition to Application Serial No. 86/634,265 to Morrison & Foerster LLP's Deposit Account 03-1952 (Reference No. 60232-6015.501).

WHEREFORE, Opposer prays that Application Serial No. 86/634,265 be rejected, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

Dated: July 21, 2016

By:  _____

Jennifer Lee Taylor
Attorney for Opposer
Recommind, Inc.

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PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

I further declare that on July 21, 2016, I served a copy of:

NOTICE OF OPPOSITION

on the following by placing a true copy thereof enclosed in a sealed envelope addressed as follows for collection and mailing at Morrison & Foerster LLP, 425 Market Street, San Francisco, California, 94105, in accordance with Morrison & Foerster's ordinary business practices:

**Patricia L. Werner
Bryan Cave LLP
1290 Avenue Of The Americas
New York, New York 10104-0101**

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 21st day of July, 2016.

Grace Gabriel
(typed)


(signature)