

TTAB

In re Registration No. : 2016977
For the Mark : Total Framework
Registered on : November 19, 1996



11-16-2001

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #66

Selections & Functions, Inc.

Petitioner,

v.

Cincom, Inc.

Registrant.

Cancellation No.

BOX TTAB - FEE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

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PETITION TO CANCEL

Selections & Functions, Inc., a corporation organized and existing under the laws of Massachusetts, with a business address of P.O. Box 505, Scituate, MA, 02066 believes that it has and will continue to be damaged by registration number 2016977 as it relates to miscellaneous services in Class 42 namely services related to computer software, and hereby petitions to cancel registration of the mark "TOTAL FRAMEWORK" for these goods and services.

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As grounds therefor, it is alleged that:

1. Registrant is an Ohio corporation known as Cincom Systems, Inc.
2. To the best of Petitioner's knowledge, the address of the current owner of the aforementioned registration is 2300 Montana Avenue, Cincinnati, OH 45211.
3. Petitioner, Selections & Functions, Inc. is the exclusive licensee of the "Framework" trademark of Borland International.
4. Petitioner and its predecessors in interest have adopted and continuously used the trademark "FRAMEWORK" for goods and services since at least 1984 in connection with the sale and licensing of object oriented computer software and related services which now fall under several classes including class 42.
5. Before Cincom filed its application for the aforementioned trademark it approached Selections & Functions with a request for a permit or license to use the trademark "Total Framework." Selections & Functions explained to Cincom in a detailed letter, through Selections & Functions lawyer William Strong, that the product is similar in description and geographic distribution and the concurrent use of tradenames would be likely to cause confusion in the marketplace.
6. In spite of the facts alleged in 5 above Cincom then proceeded to file an application to the Patent and Trademark Office. In that application Cincom declared that it did not know of any other products or services in the marketplace where a likelihood of confusion would exist.
7. Petitioner Selections & Function's product is an object oriented software product for use as an integrated business suite of applications including word processing, spread sheets,

graphics, database and idea processing, telecommunications and cross functional business applications development language and also user manuals sold together as a unit.

8. Petitioner also provides programming, data management, web hosting and other services in relationship to its product and its product's tradename.

9. The trademark "Framework" for Petitioner's product and service has been registered and used in interstate commerce since at least 1984 by Petitioner's predecessors Ashton-Tate and Borland International, Inc.

10. Petitioner currently owns the rights to the trademark in connection to the Framework product which it obtained from Borland International, Inc.

11. Registration number 1533028 was issued to Borland International, Inc. on April 4, 1989 under Class 16 (Paper Goods and Printed Matter) and has continuously been used to identify Petitioner's products and services in interstate and international commerce.

12. Registration number 1342190 was issued to Borland International under Class 9 based on an assignment from Borland's predecessor in interest Ashton-Tate Corporation and has continuously been used to identify Petitioner's products and services in interstate and international commerce.

13. From 1984 until its acquisition by Borland International, Ashton-Tate identified the earlier versions of what is now Petitioner's software product with the trademark "FRAMEWORK" and used this mark in interstate and international commerce.

14. There is no issue as to priority of use. Registrations for Petitioner's products and services issued long prior to the first date of use of Registrant, (Cincom, Inc.).

15. Petitioner has expended effort and expense in promoting its trademark "FRAMEWORK" and the goods and services sold under the mark (namely Framework,

Framework II, III, Framework IV, Framework V, Framework VI, Framework VII and Framework LX), with the result that the purchasing public, nationally and worldwide, has come to know, rely upon, and recognize the products and services by such mark. Petitioner has goodwill established in its mark.

16. If Registrant is permitted to retain the registration sought to be canceled, and thereby, the prima facie exclusive right to use in commerce of the mark "TOTAL FRAMEWORK" on the closely related goods and services sold and licensed by Petitioner, confusion in trade is likely to result from any concurrent use of Petitioner's mark and that of Registrant all to the great detriment of Petitioner.

17. Consumers of computer software and related services are likely to believe that the goods of Registrant sold under the mark "TOTAL FRAMEWORK" emanate from Petitioner and purchase or license such software instead of Petitioner's thereby resulting in loss of sales to Petitioner.

18. Continued concurrent use of the mark by Registrant and Petitioner may result in irreparable damage to Petitioner's reputation and goodwill, if the goods sold by Registrant or the services provided by Registrant are inferior, since purchasers and licensees are likely to attribute the source of Registrant's goods and services to Petitioner.

19. Continued concurrent use of the mark by Registrant and Petitioner will dilute Petitioner's trademark.

20. If Registrant is permitted to retain the registrations sought to be canceled, a cloud will be placed on Petitioner's title in and to its trademark "FRAMEWORK" and on its right to enjoy the free and exclusive use thereof in connection with the sale and licensing of its goods and services, all to the great injury of Petitioner.

21. Petitioner's predecessor in interest, Borland International, agrees that Petitioner is the rightful and lawful owner of the trademark Framework for the product and services described above.

22. Cincom applied for cancellation of the previously held by Ashton-Tate's and now Borland's "Framework" trademark in Great Britain. It is clear from this action that Cincom's intentions are to destroy Selections & Function's ability to sell Framework software worldwide and attempt to inherit the millions of Ashton-Tate's former customers by pretending to provide continuity to Ashton-Tate's and the Borland's products for independent developers' to which petitioner caters.

WHEREFORE, Petitioner deems that it will be damaged by registration number 2016977 and therefore petitions for cancellation thereof.

Selections and Functions, Inc.

By its Attorney,


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November 16, 2001

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail (Label No. ET700152725 VS) in an envelope addressed to: United States Patent and Trademark Office, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202 on November 16th, 2001.


Steve Petrov