

**In The United States Patent and Trademark Office
Trademark Trial and Appeal Board**

TTAB

In the Matter of:

A.J. Boggs & Company

Petitioner

v.

Intrado, Inc.

Registrant

Trademark: 911.NET

Registration No. 2551269

Cancellation No. 92040559

Box TTAB No Fee
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

PETITIONER'S REPLY BRIEF

Petitioner A.J. Boggs & Company ("Petitioner") submits this brief in reply to the main brief filed by Registrant Intrado Inc. ("Registrant") filed on October 1, 2004. Petitioner submitted its main brief on August 8, 2003 which in turn was duly responded to by Registrant in its October 1, 2004 brief. To eliminate any confusion that may have been caused by the ongoing proceedings in this matter, Petitioner herein relies on its August 8, 2003 brief as its operative brief regarding its petition to cancel Registrant's "911.NET" trademark (Registration 2551269).



10-14-2004

U.S. Patent & TMOfo/TM Mail Rcpt Dt. #22

I. Registrant's Reliance on a Prior Registration to Support its Mark is Irrelevant to this Cancellation Proceeding.

In its main brief, Registrant erroneously attempts to support its 911.NET mark (Reg. No. 2551269) by asserting that Petitioner's 911.NET mark is preempted by Registrant's 9-1-1 NET registration (Reg. No. 2204802). Registrant's 9-1-1 NET registration is wholly irrelevant to this proceeding and is nothing more than a red herring argument.

The sole issue in this proceeding is whether Registrant's 911.NET mark should be cancelled because of Petitioner's prior use of its 911.NET mark. Section 2(d) of the Lanham Act bars registration of a mark that so resembles a mark previously registered with the Patent and Trademark office or previously used in the United States. *15 U.S.C. §1052(d)*. Collaterally attacking Petitioner's 911.NET mark on the basis of another registration does nothing to negate the priority Petitioner's mark holds over Registrant's 911.NET mark.

Registrant further attempts to bolster this argument by asserting that the prior 9-1-1 NET registration is "incontestable" under 15 U.S.C. §1065. Incontestable status under § 15 only protects a mark from being canceled on the basis of prior use or descriptiveness. An "incontestable" mark may be cancelled *at any time* if that mark is generic, has been abandoned, or if its registration was obtained fraudulently or contrary to the provisions of § 1054. *See, 15 U.S.C. § 1064(3)*. Even assuming that Registrant's prior registration is somehow relevant to the instant matter, it may nevertheless be cancelled in a subsequent proceeding.¹

¹ Registrant's 9-1-1 NET registration is for "communication services, namely, electronic communication systems that facilitate access to and use of emergency information by emergency administration personnel and public service access providers." The services sold under Intrado's 9-1-1 NET mark provide what are

II. Registrant Applies the Wrong Standard of "Use."

Registrant unsuccessfully attempts to overcome Petitioner's prior use of the 911.NET mark by arguing that Petitioner has not made proper use of the mark and that such use was not "interstate use." Registrant erroneously applies the wrong standard when evaluating Petitioner's evidence of use. The standard of use necessary for establishing priority for purposes of an opposition or cancellation proceeding is less than that necessary to support a registration. *See, J. Thomas McCarthy on Trademarks and Unfair Competition* § 20:16-17 (4th ed. 1996 & Supp. 1999).

As cited in Petitioner's main brief, in *Shalom Children's Wear Inc. v In-Wear* 26 U.S.P.Q. 2d 1516 (1993), the Board considered certain pre-sales activities of the opposer in determining the priority between two conflicting marks. The Board held:

Use analogous to trademark use ... is non-technical use of a trademark in connection with the promotion or sale of a product under circumstances which do not provide basis for an application to register, usually because the statutory requirement for use on or in connection with the sale of goods in commerce has not been met. Although never considered an appropriate basis for an application to register, such use has consistently been held sufficient use to establish priority rights as against subsequent users of the same or similar marks.

Id. at 1519.

Here, Petitioner has shown more than enough evidence of use sufficient to support its prior use of the 911.NET mark as shown through extensive pre-sale use of the mark. *See, Exhibit A-D of Petitioner main brief.* The invoice as entered as Exhibit D to Petitioner's main brief alone clearly provides the requisite evidence of use necessary to support a registration and certainly meets the burden of establishing priority for

commonly known as "enhanced 911" services for 911 operators and other emergency personal. It is arguable that this mark, or at least the functional portion of the mark, is a generic name for the services for which it is registered and as such, subject to cancellation under § 1064(3).

cancellation purposes. Contrary to Registrant's assertions, letterhead, stationary, and invoices bearing a trademark have always been accepted as evidence of use to support a service mark registration. *TMEP 13.01.04(c)*.

III. Conclusion

Registrant's 911.NET registration (Reg. No. 2551269) should be canceled from the Supplemental Register. Petitioner conclusively demonstrated priority in the 911.NET mark by establishing an October 23, 2000 date of first use as well as significant use analogous to trademark use well in advance of Petitioner's October 15, 2001 alleged use.

Respectfully submitted,

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October 14, 2004

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of Petitioner's Reply Brief was served upon Gordon E. R. Troy, attorney for Registrant, by first class mail to the following address: P.O. Box 368, Charlotte, VT 05445 on the date shown.

Date: October 14, 2004



Nicole Thurman

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CERTIFICATE OF EXPRESS MAILING

The undersigned certifies that Petitioner's Reply Brief, a Certificate of Service, and return postcard is being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope as Express Mail Post Office to Addressee, Mailing Label No. EV 6/2873378 US and addressed to the Commissioner for Trademarks, Box TTAB - No Fee, P.O. Box 1451, Alexandria, VA 22313-1451.

Date: October 14, 2004



Nicole Thurman