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

In the Matter of Registration No. 1,464,373
Issued: November 10, 1987
Mark: IMPOSER

QUAD/GRAPHICS, INC.,)

Petitioner,)

v.)

POLYCHROME SYSTEMS, INC.,)

Respondent.)

) Cancellation No.

U.S. Patent & TMO/TM Mail Rpt Dt. DP 900



05-24-2002

TRADEMARK TRIAL AND
APPEAL BOARD
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PETITION FOR CANCELLATION

Petitioner, Quad/Graphics, Inc. ("Petitioner"), a corporation organized and existing under the laws of the State of Wisconsin and having a principal place of business at N63 W23075 Main Street, Sussex, Wisconsin 53089, believes that it is and will continue to be damaged by Registration 1,464,373, issued November 10, 1987, for the mark IMPOSER (the "Registered Mark"), and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner alleges:

1. Petitioner is currently using and has since at least as early as 1991 used the mark IMPOZE for planning and information management software for the printing and publishing industries offered and sold in interstate commerce in the United States ("Petitioner's Mark").
2. Petitioner is the owner of U.S. Trademark Application Serial No. 78/079,036 ("Petitioner's Application") for the mark IMPOZE for planning and information management software for the printing and publishing industries ("the Goods"). A true copy of Petitioner's Application is attached as Exhibit A hereto.

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3. By virtue of its long and extensive use of Petitioner's Mark by Petitioner and its predecessor in interest and their associated advertising programs, Petitioner's Mark is widely known throughout the United States, entitling Petitioner to a broad scope of protection, and to hold itself out to the public and trade as having the exclusive right to use Petitioner's Mark in connection with the Goods.

4. Petitioner and its predecessor in interest have made and continue to make substantial annual sales under Petitioner's Mark and have invested and continue to invest substantial amounts of money and effort in advertising and promoting the Goods under Petitioner's Mark.

5. Petitioner has investigated Respondent's use of the Registered Mark and, after reasonable investigation concludes that neither Respondent nor any other party is using the Registered Mark.

6. Petitioner has been informed by Respondent that Respondent assigned the Registered Mark to Technical Services International. Respondent also informed Petitioner that Technical Services International is located in Pennsylvania but Respondent did not provide an address for this company or any other details regarding the assignment of the Registered Mark. Petitioner was able to locate a Dun & Bradstreet listing for this company from 1993, a copy of which is attached as Exhibit B hereto. Petitioner does not, however, believe that this information is current, and was unable to locate that company. Moreover, it does not appear that any such assignment has been recorded. The address of the last known owner, Polychrome Systems, Inc., is 401 Merritt 7, Norwalk, CT 06851.

7. Petitioner is further injured by the presence of the Registered Mark on the Principal Register because Petitioner's Application has been refused on the basis that Petitioner's Mark is confusingly similar to the Registered Mark under § 2(d) of the Lanham Act.

8. A duplicate copy of this Petition for Cancellation is enclosed herewith.

9. The required fee of \$1200.00 is submitted herewith.

WHEREFORE, for the foregoing reasons, Petitioner respectfully prays that Registration No. 1,464,373 be cancelled.

Respectfully submitted,

By: 

Billie Jean Smith
Judith L. Grubner
Lori S. Meddings
MICHAEL BEST & FRIEDRICH LLP
100 East Wisconsin Avenue, Suite 3300
Milwaukee, WI 53202
Telephone: (414) 271-6560

Attorneys for Petitioner
Quad/Graphics, Inc.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date indicated and is addressed to the Assistant Commissioner for Trademarks, Box TTAB/FEE, 2900 Crystal Drive, Arlington, VA 22202-3513.

Date: 5-21-02

Signature: Karen Brandt
Karen Brandt

PTO Form 1478 (Rev 9/98)
OMB Control #0651-0009 (Exp. 08/31/2002)

~TRADEMARK/SERVICE MARK Application~

*** To the Commissioner for Trademarks ***

<DOCUMENT INFORMATION>
<TRADEMARK/SERVICEMARK APPLICATION>
<VERSION 1.23>

<APPLICANT INFORMATION>

<NAME> Quad/Graphics, Inc.
<STREET> N63 W23075 Main Street
<CITY> Sussex
<STATE> WI
<COUNTRY> USA
<ZIP/POSTAL CODE> 53089

<APPLICANT ENTITY INFORMATION>

<CORPORATION: STATE/COUNTRY OF INCORPORATION> Wisconsin

<TRADEMARK/SERVICEMARK INFORMATION>

<MARK> IMPOZE
<TYPED FORM> Yes

~ Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq., as amended). ~

<BASIS FOR FILING AND GOODS/SERVICES INFORMATION>

<USE IN COMMERCE: SECTION 1(a)> Yes

~ Applicant is using or is using through a related company the mark in commerce on or in connection with the below-identified goods/services. (15 U.S.C. Section 1051(a), as amended.). Applicant attaches one SPECIMEN for each class showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services. ~

<SPECIMEN> Yes

<SPECIMEN DESCRIPTION> An instruction manual which is packaged with the product

<INTERNATIONAL CLASS NUMBER> 009

<LISTING OF GOODS AND/OR SERVICES> Planning and information management software for the printing and publishing industries

<FIRST USE ANYWHERE DATE> 01/01/1991

<FIRST USE IN COMMERCE DATE> 01/01/1991

<ATTORNEY INFORMATION>

<NAME> Billie Jean Smith
<STREET> 100 East Wisconsin Avenue
<CITY> Milwaukee
<STATE> WI

<COUNTRY> USA
<ZIP/POSTAL CODE> 53202-4108
<E-MAIL ADDRESS> bjsmith@mbf-law.com
<AUTHORIZE E-MAIL COMMUNICATION> Yes
<FIRM NAME> Michael Best & Friedrich LLP
<TELEPHONE NUMBER> (414) 271-6560
<FAX NUMBER> (414) 277-0656
<ATTORNEY DOCKET NUMBER> 077047/9439
<OTHER APPOINTED ATTORNEY(S)> Patricia A. Motta, Emily C. Canedo and Lori S. Meddings

<FEE INFORMATION>
<TOTAL FEES PAID> 325
<NUMBER OF CLASSES PAID> 1
<NUMBER OF CLASSES> 1

<DEPOSIT ACCOUNT INFORMATION>
<DEPOSIT ACCOUNT NUMBER> 133080
~ The U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to the deposit account listed above. ~
<NAME OF PERSON AUTHORIZING ACCOUNT ACTIVITY> Billie Jean Smith
<COMPANY/FIRM NAME> Michael Best & Friedrich LLP

<LAW OFFICE INFORMATION>
~ The USPTO is authorized to communicate with the applicant's attorney at the below e-mail address ~
<E-MAIL ADDRESS FOR CORRESPONDENCE> bjsmith@mbf-law.com

<SIGNATURE AND OTHER INFORMATION>
~ **PTO-Application Declaration:** The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. ~

<SIGNATURE> /billie jean smith/
<DATE> 08/14/2001
<NAME> Billie Jean Smith
<TITLE> Attorney for Applicant

The information collected on this form allows the USPTO to determine whether a mark may be registered on the Principal or Supplemental register, and provides notice of an applicant's claim of ownership of the mark. Responses to the request for information are required to obtain the benefit of a registration on the Principal or Supplemental register, 15 U.S.C. §§1051 et seq. and 37 C.F.R. Part 2. All information collected will be made public. Gathering and providing the information will require an estimated 12 or 18 minutes (depending if the application is based on an intent to use the

mark in commerce, use of the mark in commerce, or a foreign application or registration). Please direct comments on the time needed to complete this form, and/or suggestions for reducing this burden to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington D.C. 20231. Please note that the PTO may not conduct or sponsor a collection of information using a form that does not display a valid OMB control number.

Drawing Page

Date/Time Stamp: Tuesday, 08-14-2001 08:19:28 EDT

Applicant:

Quad/Graphics, Inc.
N63 W23075 Main Street
Sussex, WI 53089
USA

Date of First Use Anywhere: 01/01/1991

Date of First Use In Commerce: 01/01/1991

Goods and Services:

Planning and information management software for the printing and publishing industries

Mark:

IMPOZE

IMPOZETM

Magazine Makeup and Producti



