

3. Application 76/078,462 for the mark DUPLEX and design is based upon a date of first use of at least as early as October 29, 1998.

4. Registration of application 76/078,462 for the mark DUPLEX and design has been refused under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) based upon a likelihood of confusion with Registration No. 2,437,992.

5. Registration No. 2,437,992, sought to be cancelled, claims a date of first use of February 1, 1999. A copy of Registration No. 2,437,992 is attached hereto as Exhibit B.

6. There is no issue as to priority of use. Petitioner used its mark prior to the first date of use alleged by Registrant, and such use by Petitioner has been continuous.

7. Petitioner has expended considerable effort and expense promoting its mark DUPLEX and design and the goods sold thereunder, with the result that the purchasing public has come to know, rely upon, and recognize the products of Petitioner by such mark. Petitioner has valuable goodwill established in the mark DUPLEX and design.

8. Registration No. 2,437,992 covers computer programs for use in document publishing and document management publishing applications; computer programs for managing workgroup collaboration, namely, computer programs for allowing documents to be sent to multiple users within a workgroup for review, amendment and tracking of changes made by others. Such goods are closely related to those of Petitioner.

9. If Registrant is permitted to retain Registration No. 2,437,992, and thereby the *prima facie* exclusive right to use in commerce of its mark on goods closely related to the goods sold by Petitioner, confusion within the meaning of Section 2(d) of the Trademark Act is likely to result from any concurrent use of Petitioner's mark, all to the detriment of Petitioner, who has expended considerable sums and effort in promoting its mark.

10. Purchasers are likely to consider the goods of the Registrant sold under its mark as emanating from Petitioner, and purchase such goods, resulting in loss of sales to Petitioner.

11. Concurrent use of its mark by Registrant will result in irreparable damage to Petitioner's reputation and goodwill, if goods sold by Registrant are inferior to Petitioner's goods, since purchasers are likely to attribute the source of the Registrant's goods to Petitioner.

12. If Registrant is permitted to retain Registration No. 2,437,992, a cloud will be placed upon Petitioner's title in and to its mark DUPLEX and design, and upon its right to enjoy the free and exclusive use thereof in connection with the sale of its goods, all to the detriment of Petitioner.

13. Prior to Registrant's alleged date of first use, Petitioner continuously used its mark DUPLEX and design in connection with optical scanners and related goods. Petitioner has expended considerable time, effort, and money in creating goodwill and public acceptance for its goods. By reason of this long, continuous, extensive and exclusive use of its mark, Petitioner enjoyed, and today enjoys, valuable goodwill in its famous mark DUPLEX and design, which became famous prior to Registrant's alleged date of first use. Consumers recognize the distinctive mark DUPLEX and design as uniquely identifying Petitioner as the owner of the mark, even when encountering the mark apart from Petitioner's goods.

14. Continued maintenance of Registration No. 2,437,992 will cause dilution of the distinctive quality of Petitioner's mark and will blur the distinctiveness of Petitioner's famous mark. Continued maintenance of Registrant's mark will cause a substantial number of consumers, upon seeing use of the mark, to be reminded of Petitioner's famous mark and associate Registrant and its use with Petitioner and its famous mark, or will associate Petitioner's goods with an inappropriate and incorrect source. Continued contemporaneous use and registration by Registrant will dilute and impair Petitioner's rights and otherwise lessen the capability of Petitioner's famous mark DUPLEX and design to identify and distinguish its goods and services. Such continued contemporaneous use and registration will eventually result in a lack of designation and

indication of origin, and a loss of distinctiveness and exclusivity of Petitioner's famous mark DUPLEX and design.

15. In view of the close resemblance of Registrant's mark to Petitioner's mark, continued maintenance of Registration No. 2,437,992 will damage Petitioner by causing dilution to the distinctive and famous quality of Petitioner's mark DUPLEX and design in violation of Section 43(c) of the Trademark Act (15 U.S.C. § 1125(c)).

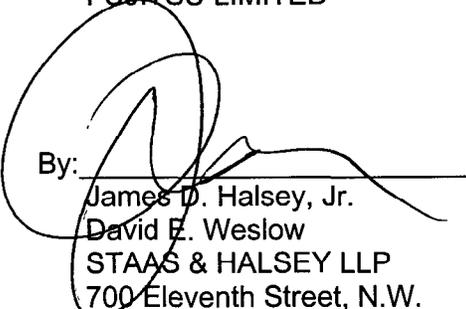
WHEREFORE, Petitioner alleges that it is or will be damaged by Registration No. 2,437,992, and hereby petitions for cancellation thereof.

To the best of Petitioner's knowledge, the name and address of the current owner of Registration No. 2,437,992 is Xyvision Enterprise Solutions, Inc., 30 New Crossing Road, Reading, MA 01867.

This Petition for Cancellation is being submitted in duplicate along with the requisite \$300.00 fee. The Commissioner is hereby authorized to charge any additional fees that may be required and to credit any overpayment to our Deposit Account No. 19-3935.

Respectfully submitted,
FUJITSU LIMITED

Date: 1/16/03

By: 

James D. Halsey, Jr.
David E. Weslow
STAAS & HALSEY LLP
700 Eleventh Street, N.W.
Suite 500
Washington, D.C. 20001
(202) 434-1500

Attorneys for FUJITSU LIMITED

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-01-15 16:08:11 ET

Serial Number: 76078462

Registration Number: (NOT AVAILABLE)

Mark



(words only): DUPLEX

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2002-07-10

Filing Date: 2000-06-27

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 105

Attorney Assigned:
BROWN BRIAN D Employee Location

Current Location: L5D -TMEG Law Office 105 - Docket Clerk

Date In Location: 2002-11-22

CURRENT APPLICANT(S)/OWNER(S)

1. FUJITSU LIMITED

Address:
FUJITSU LIMITED
1-1, Kamikodanaka 4-chomeNakahara-ku, Kawasaki-shi
Kanagawa-ken,
Japan
State or Country of Incorporation: Japan
Legal Entity Type: Corporation

GOODS AND/OR SERVICES

OPTICAL SCANNERS

International Class: 009

First Use Date: 1998-10-29

First Use in Commerce Date: 1998-10-29

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: "DUPLEX"

PROSECUTION HISTORY

2002-07-10 - Non-final action mailed

2001-10-22 - Letter of suspension mailed

2001-07-12 - Communication received from applicant

2001-01-12 - Non-final action mailed

2001-01-10 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

James D. Halsey, Jr. (Attorney of record)

JAMES D. HALSEY, JR.
STAAS & HALSEY LLP
700 11TH ST NW
WASHINGTON DC 20001
United States

Domestic Representative

JAMES D. HALSEY, JR.

EXHIBIT B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION TO REGISTER ON PRINCIPAL
REGISTER OF ACT OF 1946

Mark: MISCELLANEOUS DESIGN

Int. Class: 9

Applicant: Xyvision Enterprise Solutions, Inc.
30 New Crossing Road
Reading, Massachusetts 01867-3254

Corporation organized under the laws of the state of Delaware

Assistant Commissioner
for Trademarks
BOX NEW APP FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

The above identified applicant has adopted and is using the trademark shown in the accompanying drawing for:

(computer programs for use in managing information transmitted over computer networks) (computer programs for input, editing and manipulation of text and graphics) (computer programs for use in document publishing and document management publishing applications)

and requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946.

The trademark was first used in connection with the goods at least as early as February 1, 1999, was first used in interstate commerce at least as early as February 1, 1999, and is now in use in such commerce.

The mark is used on labels which are affixed to the goods and on packaging for the goods and three (3) specimens showing the mark as actually used are presented herewith.

The undersigned declares that she is an officer of applicant corporation and is authorized to execute this application on behalf of said corporation; she believes said corporation to be the owner of the trademark sought to be registered; that to the best of her knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive; and that the facts set forth in this application are true.

The undersigned declares that all statements made herein on applicant's own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom.

The undersigned hereby appoints the following, all members of the bar of the Commonwealth of Massachusetts, as its attorneys, with power to appoint and revoke appointment of associate attorney(s) or agent(s), to prosecute this application for registration, to make alterations and amendments therein, to receive the certificate, and

to transact all business in the Patent and Trademark Office connected therewith.

<u>Attorney</u>	<u>Reg. No.</u>
Michael J. Bevilacqua	31,091
Barbara A. Barakat	32,190
James B. Lampert	24,564

Please direct all correspondence to Michael J. Bevilacqua at:

Hale and Dorr LLP
60 State Street
Boston, MA 02109
(617) 526-6448

XYVISION ENTERPRISE SOLUTIONS, INC.

Date: 3-01-99

By:



Wendy Darland
Vice President of Finance

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Xyvision Enterprise Solutions, Inc.
30 New Crossing Road
Reading, Massachusetts 01867-3254

Serial No.:

Express Mail No:
EL110240683US

Filed: March 8, 1999

Class: 9

For: MISCELLANEOUS DESIGN

Assistant Commissioner
for Trademarks
BOX NEW APP FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

FEE VALUE ACCOUNTABILITY	
DEPOSIT ACCOUNT NO.	
08-0219	
FEE CODE	VALUE FURNISHED
301	245

EXPRESS MAIL TRANSMITTAL
LETTER FOR TRADEMARK APPLICATION AND
CERTIFICATE OF MAILING

Pursuant to 35 U.S.C. 21(a) as amended by Public Law 97-247 and 37 C.F.R. §1.10, the above applicant encloses for filing the attached Trademark Application.

For the filing fee, the Patent and Trademark Office is authorized to charge \$245.00 to Hale and Dorr LLP's Deposit Order Account No. 08-0219. The Patent and Trademark Office is also authorized to credit any overpayment or charge any deficit in connection with this mark to Hale and Dorr LLP's Deposit Order Account No. 08-0219. For the purposes of charging the deposit account, a duplicate copy of this transmittal letter is enclosed.

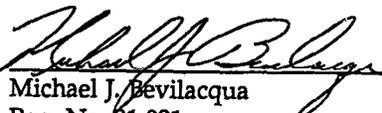
The Express Mail Letter and Application are being filed on March 8, 1999, by mailing said documents and three specimens of the mark as it appears in interstate commerce to BOX NEW APP FEE, Assistant Commissioner for Trademarks, 2900 Crystal

Drive, Arlington, Virginia 22202-3513, via the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. §1.10. The Express Mail Label No. appears in the heading of this paper which is attached to the Trademark Application pursuant to 37 C.F.R. §1.10(b).

All correspondence concerning this Application should be mailed to: Michael J. Bevilacqua, c/o Hale and Dorr LLP, 60 State Street, Boston, Massachusetts 02109.

Respectfully submitted,

HALE AND DORR LLP

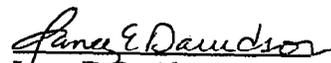

Michael J. Bevilacqua
Reg. No. 31,091

60 State Street
Boston, Massachusetts 02109
(617) 526-6000
March 8, 1999

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.10

"Express Mail" Mailing Label No.: EL110240683US
Date of Deposit: March 8, 1999

I hereby certify that these documents and specimens are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. §1.10) on the date indicated above, and are addressed to BOX NEW APP FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.


Janey E. Davidson

March 8, 1999