

ESTTA Tracking number: **ESTTA245141**Filing date: **10/27/2008**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Pie Digital, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	160 Sansome Street Suite 200 San Francisco, CA 94104 UNITED STATES		

Attorney information	Tsan Abrahamson Cobalt LLP 819 Bancroft Way Berkeley, CA 94710 UNITED STATES trademarks@cobaltlaw.com, doug@cobaltlaw.com Phone:510-841-9800
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Registration Subject to Cancellation

Registration No	3019561	Registration date	11/29/2005
Registrant	Unicom Systems, Inc. 1032 Cove Way Beverly Hills, CA 90210 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 1985/04/13 First Use In Commerce: 1985/04/13

All goods and services in the class are cancelled, namely: computer software for integrating multiple applications and transactions with a common group of menus; computer software for integrating and managing a common user interface to facilitate running multiple unrelated applications under common user control; computer software for facilitating the management of and access to multiple applications and sessions by a user; computer software for managing and controlling computer system resources to facilitate load balancing, multi-tasking, performance management, session management, security, and transaction response time

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14
The mark is merely descriptive	Trademark Act section 2(e)(1)

Attachments	Petition to Cancel.pdf (8 pages)(346398 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	/Douglas A. Rothschild/
Name	Douglas A. Rothschild
Date	10/27/2008

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

In the matter of Trademark Registration

Reg. No.: 3,019,561
Registered: November 29, 2005
By: Unicom Systems, Inc.
For the Trademark: PIE

Pie Digital, Inc.,

Petitioner,

v.

Unicom Systems, Inc.,

Respondent.

Cancellation No.

PETITION TO CANCEL

Petitioner Pie Digital, Inc. ("Petitioner") is a Delaware corporation, with its principal place of business at 160 Sansome St., Suite 200, San Francisco, CA 94104.

To the best of Petitioner's knowledge, the name and address of current owner of the registration is: Unicom Systems, Inc., 1032 Cove Way, Beverly Hills, CA 90210 ("Respondent").

Petitioner believes that it will be damaged by the above-identified registration for the mark PIE, and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

I. FACTUAL BACKGROUND

1. On October 15, 2002, Respondent filed with the United States Patent and Trademark Office ("PTO") a Trademark Act §1(a) application for registration of the mark PIE for "computer software for integrating multiple applications and transactions with a common group of menus; computer software for integrating and managing a

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common user interface to facilitate running multiple unrelated applications under common user control; computer software for facilitating the management of and access to multiple applications and sessions by a user; computer software for managing and controlling computer system resources to facilitate load balancing, multi-tasking, performance management, session management, security, and transaction response time” in Class 009.

2. On March 30, 2003, the PTO issued an Office Action raising a Trademark Act Section 2(d) initial refusal and a request that Respondent must “indicate whether the letters ‘PIE’ have any significance in the relevant trade or industry or as applied to the applicant’s computer software.”

3. On September 30, 2003, Respondent’s attorney submitted a written response thereto. In its response, Respondent requested prosecution of the mark be suspended pending settlement negotiations with the owner of the mark cited against Respondent. In addition, Respondent provided the following response to the Examining Attorney’s request regarding the “meaning or significance” of the PIE mark, as follows: **“Applicant states that the letters “PIE” have no known significance in the relevant trade or industry or as applied to applicant’s computer software except as a trademark of the applicant.”**

4. By submitting to the PTO its response to the Office Action, as set forth in paragraph 3 above, Respondent affirmed, pursuant to 37 CFR §10.18, that, “all statements made . . . are true . . . believed to be true, and [are] made . . . with the knowledge that whoever . . . knowingly and willfully falsifies, [or] conceals . . . a material fact, or makes any false, fictitious or fraudulent statements or representations . . . shall be subject to the penalties set forth under 18 U.S.C. 1001.”

5. Thereafter, on November 5, 2003, a Final Office Action issued. The Final Office Action denied Respondent’s request to suspend and accepted Respondent’s statement

regarding any "meaning or significance" of the proposed PIE mark as set forth in paragraph 3 above.

6. On or about May 12, 2004, Respondent filed a Petition to Cancel the mark cited against it, bearing Cancellation No. 92043279. Following the entry of default against owner of the cited mark, on or about March 10, 2005, the TTAB cancelled the mark cited against Respondent.

7. On or about April 13, 2005, Respondent filed a written response to Office Action informing the Examining Attorney that the registration cited against Respondent had been cancelled and was no longer an obstacle to registration.

8. On November 29, 2005, Respondent's PIE mark registered on the Principal Register ("Registration").

9. On or September 19, 2005, Petitioner filed with the PTO four (4) intent-to-use-based applications for registration of the mark PIE in connection with:

Class 009: computer hardware, computer software, and computer peripherals to set up, protect, repair, and manage computers and other electronic equipment attached to a computer network; computer hardware that transfers information to or accesses information from computers and other electronic equipment; computer hardware and computer software to conduct diagnostics on a computer network and electronic equipment attached to that network, and to transfer the results of such diagnostics (U.S. Ser. Nos. 78/716,088 and 78/716,091); and

Class 042: configuring computer-network capable devices; updating of computer software for others; maintenance of computer software and computer-network capable devices; monitoring devices on a computer network for others for technical purposes; providing information in the field of computer networks and computer network-capable devices (U.S. Ser. Nos. 78/716,089 and 78/716,092).

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II. RESPONDENT'S MARK SHOULD BE CANCELLED BECAUSE IT WAS OBTAINED BY FRAUDULENT MEANS (15 U.S.C. §1064(3))

10. Petitioner hereby incorporates by reference paragraphs 1 through 9 above as though fully set forth herein.

11. Petitioner believes, pursuant to 15 U.S.C. §1064(3), that the Registration was procured fraudulently, and therefore, should be canceled.

12. Respondent obtained Registration No. 3,019,561 for the mark PIE without disclosing to the Examining Attorney that the mark PIE does in fact have meaning and significance when applied to Respondent's computer software. Namely, Respondent's PIE is an acronym for "Productivity Integrated Environment."

13. In *Daesang Corp. v. Rhee Bros., Inc.*, Civil No. AMD 03-551 (D. Md., May 13, 2005), the Court cancelled a registration because registrant failed to disclose to the PTO that the mark was geographically descriptive of the goods. The *Daesang* court stated: "It is well established that an applicant for a registration of a trademark has a duty of candor in his communications with the PTO. Consequently, there is no presumption of validity attached to a PTO registration where pertinent information is not presented to the PTO. Fraud arises, therefore . . . where the applicant fails to make full disclosure of all material facts." *Daesang Corp. v. Rhee Bros., Inc.*, Civil No. AMD 03-551 (D. Md., May 13, 2005) (citations omitted). See also *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 U.S.P.Q. 2d 1917 (TTAB 2006) (submission of a false affidavit to the PTO by applicant is grounds for cancellation of a trademark registration).

14. Upon information and belief, Respondent knew at the time it submitted its written response to the Office Action issued on March 30, 2003 that the "PIE" mark, when applied to Respondent's computer software, was an acronym for "Productivity Integrated Environment."

15. Upon information and belief, Respondent knew at the time it submitted its written response to the PTO Office Action issued on March 30, 2003, that it was withholding pertinent information about its "PIE" mark from the PTO.

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16. Upon information and belief, Respondent withheld material information from the PTO concerning the meaning and significance the mark PIE, when applied to Respondent's computer software, with an intent to induce the PTO to issue a registration to which Respondent was not entitled and, but for withholding of this material information, the PTO would not have issued a registration.

17. Respondent had the opportunity to correct its application and disclose the meaning and significance the PIE mark to the PTO when, on May 5, 2004 it submitted a written response to the second PTO Office Action (issued on November 5, 2003) and on April 13, 2005 when it submitted a written response to the PTO's Notice of Suspension (issued on May 27, 2004). Respondent thus repeatedly and knowingly withheld material information from the PTO in conjunction with its trademark application.

18. Registration No. 3,019,561 should therefore be cancelled under 15 U.S.C. §1064(3).

III. RESPONDENT'S MARK SHOULD BE CANCELLED BECAUSE IT IS MERELY DESCRIPTIVE (Lanham Act § 2(e))

19. Petitioner hereby incorporates by reference paragraphs 1 through 18 above as though fully set forth herein.

20. Respondent's mark PIE, or "Productivity Integrated Environment," when applied to the services of Respondent, is merely descriptive in that the mark describes the qualities and characteristics of Respondent's goods.

21. Petitioner is likely to be damaged by the Registration in that the prima facie effect of such Registration impairs Petitioner's right to descriptive use of this phrase.

22. Respondent is not entitled to exclusive use of "Productivity Integrated Environment" in commerce on the goods specified in the Registration.

23. Respondent's alleged mark neither functions to identity Respondent's goods nor distinguishes Respondent's goods from those offered by others.

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24. Respondent's alleged mark has not become distinctive of Respondent's goods in commerce and no customer recognition of said term as a valid mark identifying only Respondent has been achieved.

25. The Registration should, therefore, be cancelled under Section 2(e) of the Lanham Act.

IV. RESPONDENT'S MARK SHOULD BE CANCELLED BECAUSE IT HAS BEEN ABANDONED (15 U.S.C. 1064(3))

26. Petitioner hereby incorporates by reference paragraphs 1 through 25 above as though fully set forth herein.

27. Upon information and belief Respondent has abandoned the trademark PIE and has no intent to reestablish such use. Petitioner is informed and believes that Respondent ceased using the mark in connection with its goods in International Class 009 several years ago, and furthermore that Respondent has no intention of using the mark in the future.

28. Petitioner believes Respondent has abandoned the mark PIE without intent to reestablish such use. Petitioner believes it will be free to use its trademark PIE and to register same on the Principal Register only if Registration No. 3,019,561 is cancelled.

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WHEREFORE, Petitioner believes that it is and will be damaged by said Registration and prays that Registration No. 3,019,561 be cancelled. The cancellation fee in the sum of \$300.00, pursuant to 37 C.F.R. §2.6(a)(16), has been electronically tendered from the Cobalt LLP deposit account, No. 503214.

Respectfully Submitted,

COBALT LLP

Date: October 27, 2008

By:



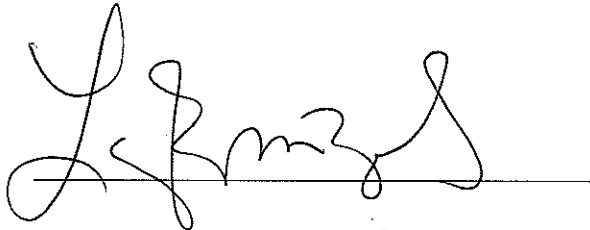
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 27th day of October, 2008, a true and correct copy of the foregoing Petition to Cancel was deposited in a U.S. Mailbox to be served upon Respondent by U.S. First Class Mail in an envelope, postage pre-paid, addressed as follows:

Unicom Systems, Inc.
1032 Cove Way
Beverly Hills, CA 90210

A handwritten signature in black ink, appearing to read 'Luz E. Gonzalez', is written over a horizontal line.

NAME: Luz E. Gonzalez