

ESTTA Tracking number: **ESTTA254011**

Filing date: **12/09/2008**

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	Apex, LLC		
Entity	LLC	Citizenship	RI
Address	100 Main St. Pawtucket, RI 02860 UNITED STATES		

Correspondence information	Andrew Gates Apex, LLC 100 Main St. Pawtucket, RI 02860 UNITED STATES theapexcompanies@gmail.com
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**Registration Subject to Cancellation**

Registration No	2791691	Registration date	12/09/2003
Registrant	APEX LEARNING INC. 110-110TH AVENUE NE, SUITE 385 BELLEVUE, WA 98004 UNITED STATES		

**Goods/Services Subject to Cancellation**

<p>Class 041. First Use: 2000/02/24 First Use In Commerce: 2000/02/24 All goods and services in the class are cancelled, namely: On-line educational services, namely, providing courses of instruction and interactive courses of instruction at the grade school, high school, college, graduate and vocational school levels in a variety of academic subjects and in connection with test preparation via a global computer network and in connection with training and professional development for teachers and educational counselors and administrators, and preparation and distribution of course materials and tests in connection therewith; publication of textbooks, educational and instructional course materials and tests distributed via a global computer network; online educational testing, namely, preparing, administering and scoring educational tests, and assessment and counseling services based on the test results; providing an online interactive website by means of a global computer network for the transfer and dissemination of grade school, high school, college, graduate and vocational school educational and instructional materials, tests and information to and among multiple users; providing an online interactive website by means of a global computer network for the transfer and dissemination of educational and instructional materials, tests and information to and among multiple users in connection with training and professional development for teachers and educational counselors and administrators; and providing interactive computer databases in the fields of education and educational training, instruction and testing at the grade school, high school, college, graduate and vocational school levels in a wide variety of subjects and in connection with training and professional development for teachers and educational counselors and administrators, but not such services used for the promotion of curriculum reform and new teaching methods and tools focusing on the improvement of educational systems, or directed towards students with special needs, or teachers, counselors and administrators specializing therein</p>
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## Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Related Proceedings	92049479
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## Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	77588760	Application Date	10/08/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	APEX UNIVERSITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1994/00/00 First Use In Commerce: 1995/01/01 Arranging of seminars; Educational demonstrations; Educational services, namely, providing classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest		

U.S. Application No.	77588785	Application Date	10/08/2008
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 041. First use: First Use: 1951/00/00 First Use In Commerce: 1951/00/00 Arranging of seminars; Educational demonstrations; Educational services, namely, providing classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest		
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U.S. Registration No.	1847961	Application Date	08/27/1993
Registration Date	08/02/1994	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1942/09/00 First Use In Commerce: 1942/09/00 retail department store services		

U.S. Registration No.	2155905	Application Date	05/25/1994
Registration Date	05/12/1998	Foreign Priority Date	NONE
Word Mark	APEX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 037. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 automotive repair and maintenance services Class 042. First use: First Use: 1924/00/00 First Use In Commerce: 1924/00/00 retail automobile parts and accessories stores		

U.S. Registration No.	2562812	Application Date	08/23/1999
Registration Date	04/23/2002	Foreign Priority Date	NONE
Word Mark	APEX ONLINE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/11/01 First Use In Commerce: 1996/11/01 Retail store, mail order purchase and computerized on-line retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, housewares, bathroom accessories, living room and bedroom		

	accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men# s and ladies# accessories, shoes, athletic footwear, novelties, food and Christmas items
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U.S. Registration No.	2657639	Application Date	11/01/1999
Registration Date	12/10/2002	Foreign Priority Date	NONE
Word Mark	APEX MALL		
Design Mark	<b>APEX MALL</b>		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1966/00/00 First Use In Commerce: 1966/00/00 SHOPPING MALL SERVICES AND LEASING OF SHOPPING MALL SPACE		

U.S. Registration No.	2443933	Application Date	08/23/1999
Registration Date	04/17/2001	Foreign Priority Date	NONE
Word Mark	APEX STORES		
Design Mark	<b>APEX STORES</b>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1996/11/01 First Use In Commerce: 1996/11/01 Retail store, mail order purchase and computerized on-line retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, housewares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic footwear, novelties, food and Christmas items		

U.S. Registration	2918976	Application Date	10/27/2003
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No.			
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	APEX ADVANTAGE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 040. First use: First Use: 1996/12/01 First Use In Commerce: 2002/09/01 CUSTOM FINISHING AND EMBELLISHMENT OF PROMOTIONAL ITEMS, NAMELY, EMBROIDERY, EMBOSSING, ENGRAVING, CUSTOMIZED PRINTING, IMPRINTING, SCREEN PRINTING AND PAD PRINTING WITH COMPANY NAMES, LOGOS, MONOGRAMS, WORDS, AND/OR PICTURES FOR PROMOTIONAL AND ADVERTISING PURPOSES ON THE GOODS OF OTHERS, NAMELY, SPORTSWEAR, APPAREL AND OTHER PRODUCTS		

U.S. Registration No.	3244685	Application Date	07/12/2006
Registration Date	05/22/2007	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		
Design Mark	 <p style="text-align: center; font-size: 2em; font-weight: bold;">APEX COMPANIES</p>		
Description of Mark	NONE		
Goods/Services	Class 040. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving, customized printing, imprinting, screen printing and pad printing with company names, logos, monograms, words, and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products		

U.S. Registration No.	3356317	Application Date	07/12/2006
Registration Date	12/18/2007	Foreign Priority Date	NONE
Word Mark	APEX COMPANIES		

Design Mark	<b>APEX COMPANIES</b>
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 2002/09/01 First Use In Commerce: 2002/09/01 Computer services, namely, creating indexes of information, sites, and other resources available on computer networks; computer services, namely, providing search engines for obtaining data on a global computer network

Attachments	77588760#TMSN.jpeg ( 1 page )( bytes ) 77588785#TMSN.jpeg ( 1 page )( bytes ) 75781411#TMSN.gif ( 1 page )( bytes ) 75836787#TMSN.gif ( 1 page )( bytes ) 75781412#TMSN.gif ( 1 page )( bytes ) 78928036#TMSN.jpeg ( 1 page )( bytes ) 78928010#TMSN.jpeg ( 1 page )( bytes ) Petition for Cancellation 2791691.pdf ( 9 pages )(4026803 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	/Andrew Gates/
Name	Andrew Gates
Date	12/09/2008

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

In the matter of Registration No. 2,791,691  
Date of Issue: December 9, 2003

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<b>APEX, LLC</b>		)	
	<b>Petitioner</b>	)	
<b>v.</b>		)	<b>Cancellation No.:</b>
		)	
<b>APEX LEARNING, INC.</b>		)	
	<b>Registrant</b>	)	
<hr/>		)	

**PETITION FOR CANCELLATION**

Apex, LLC, a limited liability company organized and existing under the laws of the State of Rhode Island, having a business address of 100 Main Street, Pawtucket, Rhode Island 02860 (“Apex”), believes that it will be damaged by Registration No. 2,791,691 for the mark “APEX LEARNING” as it relates to goods in Class 41, namely, On-line educational services, namely, providing courses of instruction and interactive courses of instruction at the grade school, high school, college, graduate and vocational school levels in a variety of academic subjects and in connection with test preparation via a global computer network and in connection with training and professional development for teachers and educational counselors and administrators, and preparation and distribution of course materials and tests in connection therewith; publication of textbooks, educational and instructional course materials and tests distributed via a global computer network; online educational testing, namely, preparing, administering and scoring educational tests, and assessment and counseling services based on the test results; providing an online interactive website by means of a global computer network for the transfer and

dissemination of grade school, high school, college, graduate and vocational school educational and instructional materials, tests and information to and among multiple users; providing an online interactive website by means of a global computer network for the transfer and dissemination of educational and instructional materials, tests and information to and among multiple users in connection with training and professional development for teachers and educational counselors and administrators. and providing interactive computer databases in the fields of education and educational training, instruction and testing at the grade school, high school, college, graduate and vocational school levels in a wide variety of subjects and in connection with training and professional development for teachers and educational counselors and administrators, but not such services used for the promotion of curriculum reform and new teaching methods and tools focusing on the improvement of educational systems, or directed towards students with special needs, or teachers, counselors and administrators specializing therein, and hereby petitions to cancel the registration of said mark for these goods.

The grounds for cancellation are as follows:

**Apex and its Marks**

1. Since at least as early as 1924, Petitioner and its predecessors and their affiliates (collectively, "Apex") have used the mark "APEX" and other marks incorporating the word "APEX" (collectively the "Apex Marks"). Over the past 84 years, Apex has used the Apex Marks on and in connection with various manufacturing, automotive, wholesale, retail, on-line retail and information services, real estate development, real estate management, advertising and marketing businesses and educational services, among others.

2. Petitioner is the owner of common law rights in the mark "APEX", as a result of the continuous use of the APEX mark by Apex since at least as early as 1924. This includes,

without limitation, use of the APEX mark in connection with a wide variety of online services and educational services.

3. Petitioner owns the following U.S. registrations and applications for its APEX trademarks and service marks, among others:

<u>Mark</u>	<u>Registration No./ Serial No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
APEX UNIVERSITY	77/588,760		Arranging of seminars; Educational demonstrations; Educational services, namely, providing classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest (Class 41)
APEX	77/588,785		Arranging of seminars; Educational demonstrations; Educational services, namely, providing classes, seminars, workshops, training and instruction in the fields of personal and professional topics of interest (Class 41)
APEX	1,847,961	8/2/1994	Retail department store services (Class 42)
APEX	2,155,905	5/12/1998	Automotive repair and maintenance services (Class 37); retail automobile parts and accessories stores (Class 42)
APEX ONLINE	2,562,812	4/23/2002	Retail store, mail order purchase and computerized online retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, house wares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic foot wear, novelties, food

<u>Mark</u>	<u>Registration No./ Serial No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
			and Christmas items (Class 35)
APEX MALL	2,657,639	12/10/2002	Shopping mall services and leasing of shopping mall space (Class 36)
APEX STORES	2,443,933	4/17/2001	Retail store, mail order purchase and computerized online retail services, featuring, domestics, furniture, bedding, kitchenware, major appliances, small appliances, house wares, bathroom accessories, living room and bedroom accessories, table top accessories, flatware, power equipment, electronics, photography, jewelry, cosmetics, toys, giftware, music and video, gardening, handbags, sporting goods, clocks, luggage, home office, grills, clothing, men's and ladies' accessories, shoes, athletic foot wear, novelties, food and Christmas items (Class 35)
APEX ADVANTAGE	2,918,976	1/18/2005	Custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving customized printing, imprinting, screen printing and pad printing with company names, logos, monograms, words and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products (Class 40)
APEX COMPANIES	3,244,685	5/22/2007	Custom finishing and embellishment of promotional items, namely, embroidery, embossing, engraving customized printing, imprinting, screen printing and pad printing with company names, logos, monograms, words and/or pictures for promotional and advertising purposes on the goods of others, namely, sportswear, apparel and other products (Class 40)
APEX COMPANIES	3,356,317	12/18/2007	Computer services, namely, creating

<u>Mark</u>	<u>Registration No./ Serial No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
			indexes of information, sites and other resources available on computer networks; computer services, namely, providing search engines for obtaining data on a global computer network (Class 42)

4. Registration No. 1,847,961 for the mark APEX, and Registration No. 2,155,905 for the mark APEX have been renewed pursuant to the provisions of the Lanham Act, and are incontestable.

5. Registration No. 2,562,812 for the mark APEX ONLINE and Registration No. 2,443,933 for the mark APEX STORES are incontestable.

6. Apex has spent a considerable amount of money, time and energy in connection with the advertising, marketing and promotion of products and services bearing the APEX trademark. As a result, the APEX trademark has become famous, and the public has come to identify the APEX trademark with Apex.

#### Registrant and its Marks

7. Upon information and belief, Apex Learning, Inc. ("Registrant") is a Washington corporation with an address at 110-110<sup>th</sup> Avenue, N.E., Suite 385, Bellevue, Washington 98004.

8. Registrant is the record owner of the following U.S. Trademark Registration for the mark APEX LEARNING:

<u>Registration No.</u>	<u>Issue Date</u>	<u>Goods and Services</u>
2,791,691	12/9/2003	On-line educational services, namely, providing

	<p>courses of instruction and interactive courses of instruction at the grade school, high school, college, graduate and vocational school levels in a variety of academic subjects and in connection with test preparation via a global computer network and in connection with training and professional development for teachers and educational counselors and administrators, and preparation and distribution of course materials and tests in connection therewith; publication of textbooks, educational and instructional course materials and tests distributed via a global computer network; online educational testing, namely, preparing, administering and scoring educational tests, and assessment and counseling services based on the test results; providing an online interactive website by means of a global computer network for the transfer and dissemination of grade school, high school, college, graduate and vocational school educational and instructional materials, tests and information to and among multiple users; providing an online interactive website by means of a global computer network for the transfer and dissemination of educational and instructional materials, tests and information to and among multiple users in connection with training and professional development for teachers and educational counselors and administrators. and providing interactive computer databases in the fields of education and educational training, instruction and testing at the grade school, high school, college, graduate and vocational school levels in a wide variety of subjects and in connection with training and professional development for teachers and educational counselors and administrators, but not such services used for the promotion of curriculum reform and new teaching methods and tools focusing on the improvement of educational systems, or directed towards students with special needs, or teachers, counselors and administrators specializing therein in class 41.</p>
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**COUNT I: LIKELIHOOD OF CONFUSION**

9. Apex repeats and incorporates herein by reference the averments in the preceding paragraphs.

10. Registrant's Apex Learning mark is very similar in appearance and commercial impression to Apex's Apex Marks.

11. The goods and services listed in Registration No. 2,791,691 are closely related to those of Apex, in particular, to Apex's retail, online, marketing, advertising and educational services and products and services provided via those services.

12. On information and belief, Apex is the prior user of the APEX mark. Consequently, Registrant's date of first use for their mark is subsequent to Apex's actual date of first use of its Apex Marks for the identical or closely related goods and services.

13. In light of the foregoing, Registrant's Apex Learning trademark for the goods recited in the registration sought to be cancelled is confusingly similar to Apex's Apex Marks and is likely to cause confusion or mistake, and to deceive the public into believing that Registrant's goods originate or are in some manner sponsored, licensed, associated or otherwise authorized by Apex in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

#### **COUNT II: DILUTION**

14. Apex repeats and incorporates herein by reference the averments in the preceding paragraphs.

15. Apex is damaged and will continue to be damaged because Registrant's continued use and registration of the Apex Learning mark dilutes the distinctive quality of Apex's Apex Marks.

**PRAYER FOR RELIEF**

WHEREFORE, Apex respectfully requests that Registration No. 2,791,691, be cancelled as it relates to goods and services in Class 41.

The filing fee of \$300 for this Petition to Cancel is being submitted electronically with this Petition.

APEX, LLC

By:   
Andrew A. Gates, Manager

Dated: December 9, 2008

