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

In re: Registration No. 3,009,990 #76539434
Trademark: ENTELLECT
Registered November 1, 2005

INTELLECT TECHNICAL SOLUTIONS, INC.

Petitioner,

v.

MILENA SONI,

Respondent.

Cancellation No.: 92050920

NOTICE OF FILING UNDER SEAL

Commissioner for Trademarks
2900 Crystal Drive, Arlington
Virginia 22202-3514

Petitioner Intellect Technical Solutions, Inc., through undersigned attorney, hereby gives notice of filing Exhibit A to Petitioner's Motion for Leave to File Amended Petition to Cancel under seal as a Confidential Document pursuant to Section 8 of the Terms of Order of the approved Protective Agreement in place in the proceeding.

Date: 3/10/2010

Respectfully submitted,

William G. Giltinan
Carlton Fields, P.A.
P.O. Box 3239
Tampa, FL 33601-3239
(813) 223-7000
Attorney for Petitioner



03-10-2010

Registration No.: 3,009,990
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CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing Notice of Filing Under Seal on Respondent's counsel at the following addresses:

Surjit P. Soni
Ronald E. Perez
WooSoon Choe
The Soni Law Firm
35 N. Lake Ave. #720
Pasadena, CA 91101

via First Class United States Mail, postage prepaid, and deposited with the United States Postal Service on March 10, 2010.

Dated: March 10, 2010



William G. Giltinan

EXPRESS MAIL CERTIFICATE

"EXPRESS MAIL" MAILING LABEL NO.: EV528198063US

DATE OF DEPOSIT: March 10, 2010

ATTORNEY DOCKET NO.: 50006/35697

I HEREBY CERTIFY that the enclosed Petitioner's Motion for Leave to File Amended Petition to Cancel, Exhibit B – First Amended Petition for Cancellation and Notice of Filing Exhibit A Under Seal, check payable to the Direct United States Patent and Trademark Office in the amount of \$300 and return receipt postcard are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, postage prepaid, on the dated indicated above and is addressed to Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514.

The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the processing the above filings without specific authorization, or credit any overpayment, to Deposit Account No. 03-0683.



Attorney

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Registered November 1, 2005

INTELLECT TECHNICAL SOLUTIONS, INC.

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MILENA SONI,

Respondent.

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**PETITIONER'S MOTION FOR LEAVE TO FILE
AMENDED PETITION TO CANCEL**

Petitioner, Intellect Technical Solutions, Inc. ("Intellect"), hereby moves the Board for an Order permitting it to file an Amended Petition for Cancellation pursuant to Fed.R.Civ.P. 15(a), 37 C.F.R. § 2.115, and TBMP § 507.02 to include additional grounds for cancellation of the Registrant's registration in International Classes 35 and 41, and to add grounds for cancellation of the Registrant's registration in International Class 44. Payment for cancellation of one additional class is being provided with this motion. Petitioner hereby authorizes the payment of any additional fees due in connection with this motion or the Amended Petition to Cancel from Deposit Account number 03-0683. Petitioner has conferred in good faith with Respondent's counsel, and the parties have been unable to resolve the issues raised by this motion. Accordingly, Petitioner has been advised that Respondent opposes this motion.

Subsequent to Petitioner's filing of its Petition to Cancel on May 6, 2009, Petitioner has obtained additional information and evidence regarding the Registrant's non-use of the registered

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mark "ENTELLECT." In support of Petitioner's Motion, Petitioner notes that the additional grounds for cancellation set forth in the proposed Amended Petition for Cancellation are based upon information revealed as a result of the testimony of Respondent in a deposition taken on February 9, 2010.

Pursuant to Fed.R.Civ.P. 15(a), leave to amend must be freely given "when justice so requires." Accordingly, "the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties." TBMP § 507.02. "This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint." *Id.* Petitioner respectfully submits that permitting Petitioner to amend its Petition to Cancel will not prejudice Respondent insofar as the additional claims are based on information previously known to Respondent but only recently learned by Petitioner through the discovery process. Petitioner respectfully submits that this Motion is timely as the information was not learned until the deposition of Respondent and subject to the availability of the transcript of that deposition. Petitioner also respectfully argues that justice requires allowing Petitioner to amend the Petition to Cancel based on the newly discovered information as doing so will allow a full and complete resolution of all of the claims in this proceeding, and because the facts supporting the new claims were not available to Petitioner prior to Respondent's deposition.

The sworn deposition of Respondent, Milena Soni was taken on February 9, 2010. Exhibit A¹ attached hereto contains excerpted pages from the final deposition transcript, which was received by Respondent on March 3, 2010. In her deposition, Respondent revealed that the services she has

¹ Pursuant to section 8 of the Terms of Order of the approved Protective Agreement in place in this proceeding, all deposition transcripts "shall be considered protected for 30 days following the date of service of the transcript." p. 7. Accordingly, as this motion is being filed within the 30 day window, Exhibit A is being filed under seal and designated as "Confidential" pursuant to the Protective Agreement.

provided in connection with the registered mark have been limited to referring persons to a third party for motivational assessment testing. See Exh. A, p. 27, ll. 3-9; p. 31, ll. 1-13; p. 70, ll. 1-14; p. 80, l. 16-p. 81, l. 3; p. 122, l. 17- p. 125, l. 1; p. 138, ll. 5-13. Mrs. Soni further testified that her only use of mark has been by word of mouth, on letterhead, and on business cards. Id. p. 36, l. 14-p. 37, l. 19; p. 48, l. 16-p. 50, l. 9; p. 55, ll. 1-5. She also testified that her operations have been geographically limited, thereby raising questions as to whether the mark has been used in interstate commerce. Id. p. 51, ll. 2-4; p. 53, ll. 10-21; p. 70, l. 15-p. 71, l. 1. Petitioner respectfully argues that this information provides a sufficient basis for amending the Petition to Cancel to add allegations of non-use of the ENTELLECT mark in connection with the services recited in the registration, both in the classes identified in the initial filing and in the remaining class, which was not addressed in that filing. Petitioner further argues that, to the extent the registrant was not using the services on the date of first use cited in the registration, the registration is void *ab initio*. 15 U.S.C. § 1051(a); Intermed Communications, Inc. v. Chaney, 197 USPQ 501 (TTAB 1977); *see also* Parametric Technology Corp. v. PLMIC, LLC, Opp. No. 91174641 at 25 (TTAB 2010) (non-precedential; “[b]ecause [Defendant] was not rendering its identified services at the time it filed its use-based application, [Defendant’s] application is void *ab initio*.”).

Since the Cancellation Proceeding is still in the pre-trial state, prior to any testimony having been taken, and because the proposed amendments are based on facts already known to Respondent, Respondent will not be prejudiced and Leave to Amend should be allowed. By allowing Petitioner to amend its Petition to Cancel, the Board will also be permitting full adjudication of the merits of this dispute. Justice requires that all of these issues be fully adjudicated at this time. See, e.g., Space Base, Inc. v. Stadis Corp., 17 USPQ 2d 1216 n1 (TTAB 1990).

Petitioner attaches hereto as Exhibit B a copy of the proposed Amended Petition to Cancel pursuant to TBMP § 507.01.

With entry of this Amended Petition for Cancellation, Petitioner requests cancellation of Respondent's registration in an additional class. Petitioner is required to pay the additional fee amount to add that class to the Petition for Cancellation as set forth in 37 C.F.R. § 2.6(a)(16). Petitioner has submitted payment in the amount of \$300 for the cost of adding one additional class (Intl. Class 44) to this cancellation proceeding and authorizes payment from deposit account 03-0683 for any additional fees or underpayments that may be required in connection with filing of this motion or the amended petition.

WHEREFORE, Petitioner respectfully requests that the Board grant this Motion for Leave to File the attached Amended Petition for Cancellation.

Respectfully submitted,

Date: _____

3/10/2010



William G. Giltinan
Carlton Fields, P.A.
P.O. Box 3239
Tampa, FL 33601-3239
(813) 223-7000
Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing Petitioner's Petition to Amend Petition for Cancellation on Respondent's counsel at the following addresses:

Surjit P. Soni
Ronald E. Perez
WooSoon Choe
The Soni Law Firm
35 N. Lake Ave. #720
Pasadena, CA 91101

via First Class United States Mail, postage prepaid, and deposited with the United States Postal Service on March 10, 2010.

Dated: March 10, 2010



William G. Giltinan

EXHIBIT A

CONFIDENTIAL DOCUMENT

FILED UNDER SEAL

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v.

MILENA SONI,

Respondent.

Cancellation No.: 92050920

FIRST AMENDED PETITION FOR CANCELLATION

Assistant Commissioner for Trademarks

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Petitioner, believing that it is or will be damaged by the continued registration of the above-identified trademark, hereby petitions to cancel the same, alleging as follows:

1. Petitioner, Intellect Technical Solutions, Inc., is a corporation of the State of Florida having an address of 5404 Cypress Center Dr., Suite 150, Tampa, Florida 33609.
2. Respondent, Milena Soni, on information and belief, is an individual having offices or residing at 972 Linda Vista Avenue, Pasadena, California 91103.
3. Respondent obtained registration of the service mark ENTELLECT in International Classes 35, 41, and 44 on November 1, 2005, as registration number 3,009,990 (the '990 registration), said registration issuing from application serial number 76539434, filed under section 1A based on actual use in commerce.

4. On information and belief, Respondent is the current owner of the '990 registration.

5. Respondent, in her registration, represents that she uses the mark in connection with:

Employment counseling and recruiting, Business Consultation, Business management and consultation, Business management consultation, Personnel management consultation, Psychological testing for the selection of personnel

in International Class 35, with a date of first use of May 1, 2002.

6. Respondent, in her registration, represents that she uses the mark in connection with "Career counseling" in International Class 41, with a first use date of May 1, 2002.

7. Respondent, in her registration, represents that she uses the mark in connection with:

Psychological counseling, Psychological consultation, Psychological testing services, Psychological testing

in International Class 44, with a date of first use of May 1, 2002.

8. On information and belief, the services offered by Respondent are limited to referring people to a third party who administers motivational assessment tests.

9. On information and belief, within the United States, Respondent's services are limited to the geographic regions of the greater Los Angeles and San Francisco areas in California.

10. On information and belief, Respondent's use of the term ENTELLECT has been limited to use on business cards and letterhead and word-of-mouth communications.

11. On information and belief, Respondent does not provide, and has never provided, the services recited in the '990 Registration for International Class 35.

12. On information and belief, Respondent does not provide, and has never provided, the services recited in the '990 Registration for International Class 41.

13. On information and belief, Respondent does not provide, and has never provided, the services recited in the '990 Registration for International Class 44.

14. On information and belief the Respondent has not used the ENTELLECT mark in commerce in connection with the services recited in the '990 Registration for International Class 35.

15. On information and belief the Respondent has not used the ENTELLECT mark in commerce in connection with the services recited in the '990 Registration for International Class 41.

16. On information and belief the Respondent has not used the ENTELLECT mark in commerce in connection with the services recited in the '990 Registration for International Class 44.

17. On information and belief, to the extent Respondent may have used the ENTELLECT mark in commerce, Respondent has long since abandoned it.

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18. Petitioner filed an application on January 3, 2008, as Application Serial No. 77/363,060 for registration of its mark INTELLECT, for use in connection with:

Employment hiring, recruiting, placement, staffing and career networking services, namely recruiting and placing information technology professionals and staffing application development and information technology infrastructure positions

in International Class 35, with a first use date of December 31, 1997, and for use in connection with:

Consulting services in the field of computer-based information systems for businesses, namely providing software development, quality assurance, project management and infrastructure consulting services

in International Class 42, with a first use date of December 31, 1997.

19. Petitioner subsequently divided application 77/363,060 into two applications, after which the parent application (77/363,060) retained the services identified in International Class 35 and the child application (77/975,757) retained the services identified in International Class 42.

20. Child application (77/957,757) issued as registration number 3,546,884 on December 16, 2008.

21. The Examining Attorney rejected the parent application (77/363,060), citing a likelihood of confusion between Respondent's registration and Petitioner's application.

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22. Petitioner subsequently amended the description of services in the parent application to "Placement services, namely placing information technology professionals into information technology positions."

23. The Examining Attorney maintained and made the rejection of parent application (77/363,060) final, again citing a likelihood of confusion with Respondent's registration.

24. Petitioner has been using its INTELLECT as a service mark and trade name for recruiting and placement services since at least as early as December 31, 1997, more than four years prior to the date of first use of Respondent's mark.

25. Petitioner will be injured by the continued registration of the trademark ENTELLECT by Respondent in that Petitioner's own application for registration of a similar mark has been refused registration as being confusingly similar, thereby depriving Petitioner from benefiting from the use and registration of said mark.

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WHEREFORE, Petitioner prays that Registration No. 3,009,990 be declared void *ab initio* based on non-use, or in the alternative be cancelled based on non-use, prior use by Petitioner, or abandonment, and that this Petition for Cancellation be sustained in favor of Petitioner.

Date: _____

3/10/2010

Respectfully submitted,



William G. Giltinan
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