

ESTTA Tracking number: **ESTTA357305**

Filing date: **07/11/2010**

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	Qwest Communications International Inc.		
Entity	Corporation	Citizenship	Delaware
Address	1801 California Street Denver, CO 80202 UNITED STATES		

Attorney information	Gretchen Testerman Qwest Law Dept 1801 California Street Suite 900 Denver, CO 80202 UNITED STATES teas@qwest.com Phone:303-383-6485		
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### Registration Subject to Cancellation

Registration No	2968170	Registration date	07/12/2005
Registrant	OPTOQUEST CO., LTD. 1-19-2 Asamadai Ageo-shi, 362-0073 JAPAN		

### Goods/Services Subject to Cancellation

<p>Class 009. First Use: 2001/10/09 First Use In Commerce: 2002/03/19 All goods and services in the class are cancelled, namely: Optical communications components, namely, optical multiplexers/demultiplexers, optical wavelength filters, optical isolators, optical circulators, polarization beam combiners, optical splitters, polarization controllers, optical delay lines, optical attenuators, optical fibers with a lens, and optical wave plates; Optical power meters and detectors, namely, optical pulse-duration monitors, polarization monitors, polarization-dependent meters and detectors, and photocurrent sensors; Laser beam sources, namely, tunable laser sources and pulse-width compressors; Optical fiber related equipment, namely, spools for storing optical fibers and winding devices for optical fibers; Optical waveguide plates, namely, plastic optical waveguides</p>
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### Grounds for Cancellation

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

### Marks Cited by Petitioner as Basis for Cancellation

U.S. Registration No.	1966694	Application Date	03/06/1995
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Registration Date	04/09/1996	Foreign Priority Date	NONE
Word Mark	QWEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1981/04/28 First Use In Commerce: 1985/10/30 telecommunication services, namely the electronic transmission of voice, data, and messages		

U.S. Registration No.	2210992	Application Date	11/04/1997
Registration Date	12/15/1998	Foreign Priority Date	NONE
Word Mark	QWEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 1997/10/06 First Use In Commerce: 1997/10/06 TELECOMMUNICATION SERVICES, NAMELY, LONG DISTANCE TELEPHONE SERVICES, AND ELECTRONIC TRANSMISSION OF VOICE, DATA AND MESSAGES		

U.S. Registration No.	2727556	Application Date	03/24/2000
Registration Date	06/17/2003	Foreign Priority Date	NONE
Word Mark	QWEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/08/00 First Use In Commerce: 2000/08/00		

	COMPUTER SOFTWARE, NAMELY ELECTRONIC MAIL SOFTWARE FOR SENDING, RECEIVING AND MANAGING ELECTRONIC MAIL MESSAGES
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U.S. Application No.	78124398	Application Date	04/26/2002
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	QWEST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/06/30 First Use In Commerce: 2000/06/30 House mark for a full line of telecommunication equipment and telecommunications software; and magnetically encoded prepaid telephone calling cards and credit cards		

Attachments	75384354#TMSN.gif ( 1 page )( bytes ) 76008697#TMSN.gif ( 1 page )( bytes ) Optoquest.pdf ( 17 pages )(461208 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	/glt/
Name	Gretchen Testerman
Date	07/11/2010



1. Petitioner and its affiliated companies (including, but not limited to, Qwest Corporation and Qwest Communications Corporation) are now and, for many years past, have been continuously engaged in the business of advertising, promoting and selling a wide variety of telecommunication related services and goods.
2. Petitioner is the owner of U.S. Registration No. 1,966,694, registered April 9, 1996, for the mark QWEST for “telecommunications services, namely the electronic transmission of voice, data and messages,” in class 38. This registration is valid, subsisting, incontestable and in full force and effect. As such, the registration serves as evidence of Petitioner’s exclusive right to use the mark. True copy of this registration is attached as Exhibit A.
3. Since at least as early as 1981, Petitioner and its affiliated companies have continuously used the mark QWEST in connection with “telecommunication services, namely, the electronic transmission of voice data and messages.”
4. Petitioner is the owner of U.S. Registration No. 2,210,992, registered December 15, 1998, for the mark QWEST for “telecommunications services, namely, long distance telephone services and electronic transmission of voice, data and messages” in class 38. This registration is valid, subsisting, incontestable and in full force and effect. As such, the registration serves as evidence of Petitioner’s exclusive right to use the mark. True copy of this registration is attached as Exhibit B.
5. Petitioner and its affiliated companies have continuously used the mark QWEST in connection with “telecommunication services, namely, long distance telephone services and electronic transmission of voice, data and messages” since at least as early as October 6, 1997.

6. Petitioner is the owner of U.S. Registration No. 78358255 for the mark QWEST for “Computer software, namely electronic mail software for sending, receiving and managing electronic mail messages” in class 9. This registration is valid, subsisting, and in full force and effect. As such the registration serves as evidence of Petitioner’s exclusive right to use the mark. True copy of this registration is attached as Exhibit C.
7. Petitioner and its affiliated companies have continuously used the mark QWEST in connection with “Computer software, namely electronic mail software for sending, receiving and managing electronic mail messages” since as least as early as August 2000.
8. Petitioner is the owner of U.S. Application No. 78124398 for the mark QWEST in connection with, inter alia, a “housemark for a full line of telecommunications equipment and telecommunications software” in class 9. The application was filed on April 24, 2002 claiming a first use date of June 30, 2000 and is shown in Exhibit D.
9. On October 29, 2002, Respondent filed an application to register the mark OPTOQUEST for certain goods in class 9. The registration issued on July 12, 2005 in connection with the following goods: Optical communications components, namely optical multiplexers/demultiplexers, optical wavelength filters, optical isolators, optical circulators, polarization beam combiners, optical splitters, polarization controllers, optical delay lines, optical attenuators, optical fibers with a lens and optical wave plates; Optical power meters and detectors, namely, optical pulse-duration monitors, polarization monitors, polarization-dependent meters and detectors, and photocurrent sensors; Laser beam sources, namely, tunable laser

sources and pulse-width compressors; Optical fiber related equipment, namely, spools for storing optical fibers and winding devices for optical fibers; Optical waveguide plates, namely plastic optical waveguides.

10. Prior to Respondent's claimed first use date in commerce of March 19, 2002, Petitioner has continuously used the mark QWEST in commerce in connection with telecommunication related goods and services.
11. Prior to the filing of the registration herein challenged, Respondent had knowledge of Petitioner's QWEST registered marks.
12. Prior to the filing date of the registration herein challenged, Respondent had knowledge that Petitioner used the mark QWEST in connection with telecommunications goods and services in the United States.
13. Upon information and belief, the "OPTO" portion of Respondent's mark refers to OPTICAL and is therefore descriptive of some or all aspects of the goods Respondent provides under its mark. Accordingly, the predominant and distinctive portion of Respondent's mark is the term "QUEST."
14. Respondent's mark OPTOQUEST, is highly similar in sound, meaning and appearance to Petitioner's QWEST trademarks, and will be used on goods that are closely related to the goods and services on which Petitioner uses its registered QWEST marks. Based on the similarity of the marks and the named goods and services, the public is likely to associate the goods offered by Respondent under the mark OPTOQUEST with Petitioner or Petitioner's goods and services, or to believe

that Respondent's goods are sponsored, endorsed or licensed by Petitioner, or that there is some relationship between Respondent and Petitioner.

15. The goods of Respondent as noted in the subject registration and the goods and services of the Petitioner as listed in the registrations and application attached as Exhibits A-D are closely related. They each involve telecommunications-related goods and services.
16. The goods of Respondent and the goods and services of the Petitioner may be promoted and sold to the same customers through the same channels of trade.
17. Petitioner invests, on average, hundreds of millions of dollars per year in advertising and marketing its services and its advertisements have won national recognition. As a result of such use, Petitioner's QWEST marks are famous and distinctive marks well known to purchasers, and acquired such fame prior to Respondent's filing date and claimed first use date.
18. Petitioner will be damaged by registration of Respondent's mark because the mark has and/or is likely to cause dilution of the distinctive quality of Petitioner's famous QWEST marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).
19. Petitioner is likely to be damaged by the registration sought by Respondent because such registration will support and assist Respondent in the confusing and misleading use of Respondent's mark sought to be registered, and will give color of exclusive statutory rights to Respondent in violation and derogation of the prior and superior rights of Petitioner.
20. For the reasons set forth above, any use of the mark OPTOQUEST by Respondent is likely to cause confusion, cause mistake or deceive the public, and cause the public to

believe that the goods sold under the OPTOQUEST mark emanate from or are otherwise sponsored by or endorsed by Petitioner, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, Petitioner respectfully prays that the registration sought by Respondent be canceled, and that this Petition to Cancel be sustained.

Respectfully submitted,

QWEST COMMUNICATIONS  
INTERNATIONAL INC.

Date: July 11, 2010

By: Gretchen L. Testerman  
Gretchen L. Testerman  
1801 California Street – Suite 900  
Denver, Colorado 80202  
Telephone: (303) 383-6485  
Email: [Gretchen.testerman@qwest.com](mailto:Gretchen.testerman@qwest.com)  
Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on July 11, 2010, a true and correct copy of the foregoing PETITION TO CANCEL was served via mail upon respondent:

Optoquest Co. Ltd  
1-19-2 Asamadai  
Ageo-shi  
Japan 362-0073

Date: July 11, 2010

By: Gretchen L Testerman  
Gretchen L Testerman

# **EXHIBIT A**

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**Typed Drawing**

<b>Word Mark</b>	QWEST
<b>Goods and Services</b>	IC 038. US 100 101 104. G & S: telecommunication services, namely the electronic transmission of voice, data, and messages. FIRST USE: 19810428. FIRST USE IN COMMERCE: 19851030
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	74656899
<b>Filing Date</b>	March 6, 1995
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	January 16, 1996
<b>Registration Number</b>	1966694
<b>Registration Date</b>	April 9, 1996
<b>Owner</b>	(REGISTRANT) Qwest Communications Corporation CORPORATION DELAWARE 555 Seventeenth Street Suite 1000 Denver COLORADO 80202  (LAST LISTED OWNER) QWEST COMMUNICATIONS INTERNATIONAL INC CORPORATION BY ASSIGNMENT DELAWARE 1801 CALIFORNIA ST. DENVER COLORADO 80202
<b>Assignment Recorded</b>	ASSIGNMENT RECORDED
<b>Attorney of Record</b>	Christine P. Searls, Gretchen L. Prochaska, David R. Halvorson
<b>Type of Mark</b>	SERVICE MARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	SECT 8 (6-YR). SECTION 8(10-YR) 20050907.

**Renewal** 1ST RENEWAL 20050907  
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# **EXHIBIT B**



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# Qwest

<b>Word Mark</b>	QWEST
<b>Goods and Services</b>	IC 038. US 100 101 104. G & S: TELECOMMUNICATION SERVICES, NAMELY, LONG DISTANCE TELEPHONE SERVICES, AND ELECTRONIC TRANSMISSION OF VOICE, DATA AND MESSAGES. FIRST USE: 19971006. FIRST USE IN COMMERCE: 19971006
<b>Mark Drawing Code</b>	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
<b>Serial Number</b>	75384354
<b>Filing Date</b>	November 4, 1997
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	September 22, 1998
<b>Registration Number</b>	2210992
<b>Registration Date</b>	December 15, 1998
<b>Owner</b>	(REGISTRANT) Qwest Communications International Inc. CORPORATION DELAWARE 1801 CALIFORNIA ST. DENVER COLORADO 80202
<b>Attorney of Record</b>	Christine P. Searls
<b>Prior</b>	

**Registrations** 1966694;1979485;AND OTHERS  
**Type of Mark** SERVICE MARK  
**Register** PRINCIPAL  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20071222.  
**Renewal** 1ST RENEWAL 20071222  
**Live/Dead Indicator** LIVE

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**Typed Drawing**

<b>Word Mark</b>	QWEST
<b>Goods and Services</b>	IC 009. US 021 023 026 036 038. G & S: COMPUTER SOFTWARE, NAMELY ELECTRONIC MAIL SOFTWARE FOR SENDING, RECEIVING AND MANAGING ELECTRONIC MAIL MESSAGES. FIRST USE: 20000800. FIRST USE IN COMMERCE: 20000800
<b>Mark Drawing Code</b>	(1) TYPED DRAWING
<b>Serial Number</b>	76008697
<b>Filing Date</b>	March 24, 2000
<b>Current Filing Basis</b>	1A
<b>Original Filing Basis</b>	1B
<b>Published for Opposition</b>	February 12, 2002
<b>Registration Number</b>	2727556
<b>Registration Date</b>	June 17, 2003
<b>Owner</b>	(REGISTRANT) Qwest Communications International Inc. CORPORATION DELAWARE 1801 California Street Denver COLORADO 80202
<b>Attorney of Record</b>	Christine P. Searls, Gretchen L. Prochaska Testerman
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR).
<b>Live/Dead Indicator</b>	LIVE

# **EXHIBIT D**



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**Typed Drawing**

**Word Mark** QWEST  
**Goods and Services** IC 009. US 021 023 026 036 038. G & S: House mark for a full line of telecommunication equipment and telecommunications software; and magnetically encoded prepaid telephone calling cards and credit cards. FIRST USE: 20000630. FIRST USE IN COMMERCE: 20000630  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 78124398  
**Filing Date** April 26, 2002  
**Current Filing Basis** 1A  
**Original Filing Basis** 1A  
**Owner** (APPLICANT) Qwest Communications International Inc. CORPORATION DELAWARE 1801 California Street Denver COLORADO 80202  
**Attorney of Record** Christine P. Searls, Gretchen L. Prochaska, David R. Halvorson  
**Prior Registrations** 2727556;2871999;3385279;AND OTHERS  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

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