

ESTTA Tracking number: **ESTTA464703**

Filing date: **03/30/2012**

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	IQM2, Inc.		
Entity	Corporation	Citizenship	New York
Address	90-D Raynor Avenue Ronkonkoma, NY 11779 UNITED STATES		

Attorney information	Eryn Y. Deblois Campolo, Middleton & McCormick, LLP 3340 Veterans Memorial Highway Suite 400 Bohemia, NY 11716 UNITED STATES edeblois@cmmlp.com Phone:631-738-9100		
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Registration Subject to Cancellation

Registration No	3231774	Registration date	04/17/2007
Registrant	Granicus, Inc. 28 Second Street, Suite 400 San Francisco, CA 94105 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2004/06/01 First Use In Commerce: 2004/06/15 All goods and services in the class are cancelled, namely: Computer Software, for taking and editing meeting minutes, vote recording, roll-call, indexing video or audio file

Grounds for Cancellation

Genericness	Trademark Act section 23
The mark is merely descriptive	Trademark Act section 2(e)(1)

Attachments	Petition for Cancellation.pdf (5 pages)(242282 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	/Eryn Y. Deblois/
Name	Eryn Y. Deblois

Date	03/30/2012
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK AND APPEAL BOARD**

In re: Registration No. 3231774
Trademark: MINUTESMAKER
Registrant: Granicus, Inc.
International Class: 009
Registration Date: April 17, 2007

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IQM2, INC.,

Petitioner,

Cancellation No:

- against -

GRANICUS, INC.,

Registrant.

-----X

PETITION FOR CANCELLATION

Petitioner IQM2, Inc. ("Petitioner"), a corporation duly organized and existing under the laws of the State of New York, with offices at 90-D Raynor Avenue, Ronkonkoma, New York 11779, believes that it is being damaged and that it will continue to be damaged by the continued registration on the Supplemental Register of U.S. Registration No. 3231774 for the mark MINUTESMAKER, in International Class 009 ("Registrant's Mark").

As ground for cancellation, Petitioner alleges:

1. Petitioner is a corporation organized and existing under the laws of the State of New York, with offices at 90-D Raynor Avenue, Ronkonkoma, New York 11779.
2. Petitioner is in the business of developing computer software for the management meetings.
3. Petitioner has used the term "minutes maker" throughout 2003 in its research

regarding software to manage meeting minutes, and started development on its “minutes maker” software on February 14, 2004.

4. Petitioner is currently using the term “minutes maker” to describe its software to manage meeting minutes.

5. Upon information and belief, Granicus, Inc., is a corporation organized and existing under the laws of the State of California, with offices at 600 Harrison Street, Suite 120, San Francisco, California, 94107 (“Registrant”).

6. Upon information and belief, the Registrant is the owner of U.S. Registration No. 3231774 on the Supplemental Register for the mark MINUTESMAKER, in International Class 009, for “computer software, for taking and editing meeting minutes, vote recording, roll-call, indexing video or audio file.”

7. Upon information and belief, Registrant claims to have first used the mark MINUTESMAKER in commerce on June 15, 2004.

8. Registrant has threatened Petitioner’s use of the term “minutes maker”.

9. Upon information and belief, Registrant has threatened other users of the term “minutes maker” pre-dating Registrant’s first use in commerce.

10. Accordingly, Petitioner is being and will continue to be injured if the Registrant is permitted to maintain its registration.

REGISTRANT’S MARK IS GENERIC

11. The term “minutes maker” is the generic term for creating meeting minutes.

12. The term “minutes” and “maker” are defined in dictionary and glossary resources in a manner that is descriptive of the services offered in association with Registrant’s mark.

(a) Dictionary.com defines “minutes” as “the official record of the proceedings at

a meeting of a society, committee, or other group.”

(b) Dictionary.com defines “maker” as “a person or thing that makes.”

13. To grant or continue a monopoly on a generic term would be contrary to the public interest in promoting competition.

REGISTRANT’S MARK IS MERELY DESCRIPTIVE

14. The term MINUTESMAKER is highly descriptive of a person, device or mechanism for recording meetings minutes.

15. The term MINUTESMAKER conveys an immediate idea of the qualities and characteristics of Registrant’s product, and thus the term is merely descriptive.

16. Customers do not associate the mark MINUTESMAKER with a single source, and the mark has no secondary meaning.

17. The term “minutes maker” is widely used by the public, consumers, media, etc. to refer to the recording of meetings.

18. Upon information and belief, the term “minutes maker” has long been used in the software industry and on consumer products in association with Registrant’s products, namely a mechanism that records meeting minutes.

19. “Minutes maker” has been a descriptive term used in connection with recording software and devices since well prior to Registrant’s first use in commerce and its application for federal registration.

20. Registrant’s mark has been established by the records of the United States Patent and Trademark Office as a descriptive term.

21. Registrant’s application was refused registration on the Principal Register under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), because the mark is merely

descriptive of the function or purpose of the goods.

22. Registrant's application was then amended to seek registration on the Supplemental Register.

23. The United States Patent and Trademark Office also refused registration on the Principal Register for a prior application by Jesse Feiler of Philmont, New York filed on June 14, 2003, for MINUTESMAKER, Serial No. 78/262531, in International Class 009, for "computer software for creating and managing minutes of meetings" because the mark merely described the function of the goods.

24. To bestow or continue a monopoly on a descriptive term where there has been no period of exclusive use, and where the term has no secondary meaning, would be contrary to the public interest in promoting competition.

25. Registrant's mark MINUTESMAKER is descriptive of the goods recited in the Registration, and thus the registration should not exist in view of 15 U.S.C. Section 1052(e).

WHEREFORE, Petitioner requests that this Petition be granted and the U.S. Trademark Registration 3231774 be cancelled from the Supplemental Register.

Dated: Bohemia, NY
March 30, 2012

Respectfully submitted,

**CAMPOLO MIDDLETON
& MCCORMICK, LLP**

By: 
Eryn Y. Deblois, Esq.
Attorneys for Petitioner
3340 Veterans Highway, Suite 400
Bohemia, NY 11716
(631) 738-9100

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BEFORE THE TRADEMARK AND APPEAL BOARD

In re: Registration No. 3231774
Trademark: MINUTESMAKER
Registrant: Granicus, Inc.
International Class: 009
Registration Date: April 17, 2007

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IQM2, INC.,

Petitioner,

- against -

GRANICUS, INC.,

Registrant.

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **PETITION FOR CANCELLATION** was served on March 30, 2012, via U.S. First Class Mail, addressed to Registrant as follows:

Granicus, Inc.
600 Harrison Street, Suite 120
San Francisco, CA 94107

Granicus, Inc.
28 Second Street, Suite 400
San Francisco, CA 94105

And upon the below counsel of record for Registrant:

David H. Jaffer, Esq.
Pillsbury Winthrop Shaw Pittman, LLP
Intellectual Property Group
P.O. Box 10500
McLean, VA 22102

Dated: Bohemia, New York
March 30, 2012


Amanda Bruno