

ESTTA Tracking number: **ESTTA538616**

Filing date: **05/17/2013**

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	Dropbox, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	185 Berry St., 4th Floor San Francisco, CA 94107 UNITED STATES		

Attorney information	John L. Slafsky Wilson Sonsini Goodrich & Rosati 650 Page Mill Road Palo Alto, CA 94304 UNITED STATES jslafsky@wsgr.com, trademarks@wsgr.com Phone:650-493-9300		
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Registrations Subject to Cancellation

Registration No	3429191	Registration date	05/20/2008
Registrant	BOX, INC. 4440 El Camino Real Los Altos, CA 94022 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are cancelled, namely: Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information
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Grounds for Cancellation

Abandonment	Trademark Act section 14		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	3612423	Registration date	04/28/2009
Registrant	BOX, INC. 4440 El Camino Real Los Altos, CA 94022 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are cancelled, namely: On-line journals, namely, blogs discussing technology and business

Grounds for Cancellation

Abandonment	Trademark Act section 14		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	3722965	Registration date	12/08/2009
Registrant	BOX, INC. 4440 El Camino Real Los Altos, CA 94022 UNITED STATES		

Goods/Services Subject to Cancellation

Class 035. First Use: 2009/06/01 First Use In Commerce: 2009/06/01
All goods and services in the class are cancelled, namely: advertising the goods and services of others via the Internet

Grounds for Cancellation

Abandonment	Trademark Act section 14		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	4102899	Registration date	02/21/2012
Registrant	BOX, INC. 4440 El Camino Real Los Altos, CA 94022 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2005/01/01 First Use In Commerce: 2005/01/01
All goods and services in the class are cancelled, namely: Computer software for online management of business content in the field of cloud computing services; computer software, namely, downloadable programs and mobile device software for the collecting, editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information; computer software, namely, software development tools for content management in a cloud; computer software for tracking changes and modifications to software and for managing software development projects; computer software, namely, application interfaces, plugins, and protocol interfaces and computer software development tools for design and development of open-source and proprietary software programs; computer software for cloud content management; computer programs for running development programs and application programs in a common development environment; computer software for use as a tool for automating, personalizing, designing and updating web sites, website templates, web site graphics, text and animation for a global computer network, internal and external computer networks, and/or local and/or wide area computer networks; computer software for providing access to, providing information to, and obtaining information from computer networks for cloud content management

Class 041. First Use: 2005/01/01 First Use In Commerce: 2005/01/01
All goods and services in the class are cancelled, namely: On-line journals, namely, blogs discussing technology and business

Class 042. First Use: 2005/01/01 First Use In Commerce: 2005/01/01
All goods and services in the class are cancelled, namely: Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collecting, editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information; computer services, namely, providing customized on-line web pages featuring user-defined information; application service provider of cloud computing services, namely, hosting web based applications for cloud content management of business content; application service provider, namely, providing non-downloadable computer programs for running development programs and application programs in a common development environment

Grounds for Cancellation

Abandonment	Trademark Act section 14		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	3604221	Registration date	04/07/2009
Registrant	BOX, INC. 4440 El Camino Real Los Altos, CA 94022 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 2007/11/01 First Use In Commerce: 2007/11/01 All goods and services in the class are cancelled, namely: Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information, computer services, namely, providing customized on-line web pages featuring user-defined information, the web pages providing an interface for the collection

Grounds for Cancellation

Abandonment	Trademark Act section 14		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	4006458	Registration date	08/02/2011
Registrant	BOX, INC. 4440 El Camino Real Los Altos, CA 94022 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2007/11/01 First Use In Commerce: 2007/11/01 All goods and services in the class are cancelled, namely: Computer Software, namely, software development tools; computer software for tracking changes and modifications to software and for managing software development projects; computer software, namely, application interfaces, plugins, and protocol interfaces and computer software development tools for design and development of open-source and proprietary software programs
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Grounds for Cancellation

Abandonment	Trademark Act section 14		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	3618747	Registration date	05/12/2009
Registrant	BOX, INC. 4440 El Camino Real Los Altos, CA 94022 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are cancelled, namely: On-line journals, namely, blogs discussing technology and business
Class 042. First Use: 2007/01/01 First Use In Commerce: 2007/01/01 All goods and services in the class are cancelled, namely: Computer services, namely, acting as an

application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information

Grounds for Cancellation

Abandonment	Trademark Act section 14		
The mark is merely descriptive	Trademark Act section 2(e)(1)		
Registration No	2650384	Registration date	11/12/2002
Registrant	BOX, INC. 4440 El Camino Real Los Altos, CA 94022 UNITED STATES		

Goods/Services Subject to Cancellation

Class 039. First Use: 2000/08/00 First Use In Commerce: 2000/08/00
All goods and services in the class are cancelled, namely: electronic storage of remote computer data

Grounds for Cancellation

Abandonment	Trademark Act section 14
Related Proceedings	Opposition No. 91200450
Attachments	Consolidated Petition for Cancellation.pdf(991762 bytes)

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	/John L. Slafsky/
Name	John L. Slafsky
Date	05/17/2013

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

DROPBOX, INC.,)
) Cancellation No.:
)
) Petitioner,) **CONSOLIDATED**
) **PETITION FOR CANCELLATION**
)
) v.)
)
) BOX, INC.,)
)
) Respondent.)
)
)

Petitioner Dropbox, Inc. (“Petitioner”) believes that it has been and will be damaged by Registration Nos. 3429191, 3612423, 3722965, 4102899, 3604221, 4006458, 3618747, and 2650384 because, among other reasons, Respondent Box, Inc. (“Respondent”) has relied upon and asserted the registrations in its opposition against Petitioner’s application to register the mark DROPBOX (Opposition No. 91200450). Petitioner hereby petitions, pursuant to TBMP § 306, to cancel the registrations, as follows:

I. PARTIES

1. Petitioner is a Delaware corporation with its principal place of business in San Francisco, California. Petitioner is a leading provider of software and services for storing, accessing, and sharing materials online, with over 100 million users.

2. Petitioner is informed and believes, and therefore alleges, that Respondent is a California corporation offering online file storage and content management services for businesses.

II. PETITIONER'S TRADEMARK

3. Petitioner has rights to the DROPBOX mark dating back to at least as early as January 2004.

4. On September 1, 2009, Petitioner filed with the United States Patent and Trademark Office ("USPTO") an intent-to-use trademark application to register the mark DROPBOX (Serial No. 77/817716) (the "Application") with the following identification of goods and recitation of services:

Int. Cl. 9: Computer software and downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of life sciences research or software for uploading or transferring advertising programs and media advertising communications.

Int. Cl. 39: Storage of electronic media, namely, data, documents, files, text, photos, images, graphics, music, audio, video, and multimedia content.

Int. Cl. 42: Providing temporary use of non-downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of biomedical research or software for uploading or transferring advertising programs and media advertising communications; hosting of digital content on the internet.

5. On June 29, 2011, Respondent filed a Notice of Opposition (Opposition No. 91200450) against the Application. Respondent alleged prior use of various BOX-related marks and a likelihood of confusion arising from Petitioner's application to register the DROPBOX mark. The opposition proceeding is suspended.

III. RESPONDENT'S REGISTRATIONS

6. Petitioner is informed and believes, and therefore alleges, that Respondent is the record owner of the following federal trademark registrations: Registration Nos. 3429191, 3612423, and 3722965 for the mark BOX; Registration No. 4102899 for the stylized mark BOX; Registration Nos. 3604221 and 4006458 for the mark OPENBOX; Registration No. 3618747 for the mark BOX.NET; and Registration No. 2650384 for FETCHBOX. Respondent is also the owner of trademark applications pending at the USPTO.

7. According to public records of the USPTO, the current information regarding Registration No. 3429191 is as follows:

Registered owner:	Box, Inc.
Mark:	BOX
Last listed address:	4440 El Camino Real Los Altos, CA 94022 United States
Registration date:	May 20, 2008
International Class:	42
Services:	Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information.

This Registration is referred to hereinafter as "Registration No. 1."

8. According to public records of the USPTO, the current information regarding Registration No. 3612423 is as follows:

Registered owner:	Box, Inc.
Mark:	BOX
Last listed address:	4440 El Camino Real Los Altos, CA 94022 United States
Registration date:	April 28, 2009
International Class:	41

Services: On-line journals, namely, blogs discussing technology and business.

This Registration is referred to hereinafter as “Registration No. 2.”

9. According to public records of the USPTO, the current information regarding

Registration No. 3722965 is as follows:

Registered owner: Box, Inc.
Mark: BOX
Last listed address: 4440 El Camino Real
Los Altos, CA 94022
United States
Registration date: December 8, 2009
International Class: 35
Services: Advertising the goods and services of others via the Internet.

This Registration is referred to hereinafter as “Registration No. 3.”

10. According to public records of the USPTO, the current information regarding

Registration No. 4102899 is as follows:

Registered owner: Box, Inc.
Mark: BOX in stylized form
Last listed address: 4440 El Camino Real
Los Altos, CA 94022
United States
Registration date: February 21, 2012
International Class: 9, 41, 42
Goods and services: Int. Cl. 9: Computer software for online management of business content in the field of cloud computing services; computer software, namely, downloadable programs and mobile device software for the collecting, editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information; computer software, namely, software development tools for content management in a cloud; computer software for tracking changes and modifications to software and for managing software development projects; computer software, namely, application interfaces, plugins, and protocol interfaces and computer software development tools for design and development of open-source and proprietary software programs; computer software for cloud content management; computer programs for running development programs and application programs in a common development environment; computer software for use as a

tool for automating, personalizing, designing and updating web sites, website templates, web site graphics, text and animation for a global computer network, internal and external computer networks, and/or local and/or wide area computer networks; computer software for providing access to, providing information to, and obtaining information from computer networks for cloud content management.

Int. Cl. 41: On-line journals, namely, blogs discussing technology and business.

Int. Cl. 42: Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collecting, editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information; computer services, namely, providing customized on-line web pages featuring user-defined information; application service provider of cloud computing services, namely, hosting web based applications for cloud content management of business content; application service provider, namely, providing non-downloadable computer programs for running development programs and application programs in a common development environment.

This Registration is referred to hereinafter as “Registration No. 4.”

11. According to public records of the USPTO, the current information regarding

Registration No. 3604221 is as follows:

Registered owner:	Box, Inc.
Mark:	OPENBOX
Last listed address:	4440 El Camino Real Los Altos, CA 94022 United States
Registration date:	April 7, 2009
International Class:	42
Services:	Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information, computer services, namely, providing customized on-line web pages featuring user-defined information, the web pages providing an interface for the collection.

This Registration is referred to hereinafter as “Registration No. 5.”

12. According to public records of the USPTO, the current information regarding

Registration No. 4006458 is as follows:

Registered owner: Box, Inc.
Mark: OPENBOX
Last listed address: 4440 El Camino Real
Los Altos, CA 94022
United States
Registration date: August 2, 2011
International Class: 9
Goods: Computer software, namely, software development tools; computer software for tracking changes and modifications to software and for managing software development projects; computer software, namely, application interfaces, plugins, and protocol interfaces and computer software development tools for design and development of open-source and proprietary software programs.

This Registration is referred to hereinafter as “Registration No. 6.”

13. According to public records of the USPTO, the current information regarding

Registration No. 3618747 is as follows:

Registered owner: Box, Inc.
Mark: BOX.NET
Last listed address: 4440 El Camino Real
Los Altos, CA 94022
United States
Registration date: May 12, 2009
International Class: 41, 42
Services: Int. Cl. 41: On-line journals, namely, blogs discussing technology and business.

Int. Cl. 42: Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information.

This Registration is referred to hereinafter as “Registration No. 7.”

14. According to public records of the USPTO, the current information regarding

Registration No. 2650384 is as follows:

Registered owner: Box, Inc.
Mark: FETCHBOX
Last listed address: 4440 El Camino Real
Los Altos, CA 94022
United States
Registration date: November 12, 2002
International Class: 39
Services: electronic storage of remote computer data

This Registration is referred to hereinafter as “Registration No. 8.” All of the above-cited registrations are hereinafter referred to collectively as the “Registrations.”

IV. PETITIONER’S CLAIMS AGAINST THE REGISTRATIONS

A. RESPONDENT’S MARKS ARE MERELY DESCRIPTIVE

15. Petitioner repeats and realleges each and every allegation contained in paragraphs 1 through 14 as if fully set forth herein.

16. Petitioner has ascertained that the marks in the Registrations are not sufficiently distinctive to merit registration on the USPTO’s Principal Register.

17. The term “box” has been and is commonly used to refer generally to a receptacle or container for storage.

18. On information and belief, purchasers and potential purchasers of Respondent’s goods and services understand the term “box” as primarily describing a container or receptacle – real or virtual – for storage of documents, audio, video, data and information.

19. On information and belief, Respondent purports to use the BOX trademark in Registration No. 1 for computer services including the storage of data and information and ancillary services.

20. The trademark in Registration No. 1 does not identify or distinguish Registrant's services or the source of such services. Accordingly, the mark in Registration No. 1 is descriptive.

21. On information and belief, Respondent purports to use the BOX trademark in Registration No. 2 for on-line journals, namely, blogs discussing technology and business. In fact, these blogs are primarily focused on topics related to storage. These services are related, incidental and ancillary to Respondent's primary goods and services, namely, providing computer software and services for the storage of data and information.

22. The trademark in Registration No. 2 does not identify or distinguish Registrant's services or the source of such services. Accordingly, the mark in Registration No. 2 is descriptive.

23. On information and belief, Respondent purports to use the BOX trademark in Registration No. 4 for computer software and services for the storage of data and information, and related ancillary goods and services.

24. The trademark in Registration No. 4 does not identify or distinguish Registrant's goods and services or the source of such goods and services. Accordingly, the mark in Registration No. 4 is descriptive.

25. On information and belief, Respondent purports to use the OPENBOX trademark in Registration No. 5 for computer services for the storage of data and information, and related ancillary services.

26. On information and belief, the term "open" has been and is commonly used to refer generally to accessibility. Accordingly, the term "openbox" is descriptive.

27. The trademark in Registration No. 5 does not identify or distinguish Registrant's services or the source of such services. Accordingly, the mark in Registration No. 5 is descriptive.

28. On information and belief, Respondent purports to use the OPENBOX trademark in Registration No. 6 for computer software development tools. These goods are related and ancillary to Respondent's primary goods and services, namely, providing computer services and software for the storage of data and information.

29. The trademark in Registration No. 6 does not identify or distinguish Registrant's goods or the source of such goods. Accordingly, the mark in Registration No. 6 is descriptive.

30. On information and belief, Respondent purports to use the BOX.NET trademark in Registration No. 7 for computer services for storage of data and information, and related ancillary goods and services.

31. The trademark in Registration No. 7 is a combination of the descriptive term "box" with the generic top-level domain suffix ".net." As stated in the Trademark Manual of Examining Procedure, generic top-level domains "generally serve no source-indicating function," and "their addition to an otherwise unregistrable mark typically cannot render it registrable."

32. The trademark in Registration No. 7 does not identify or distinguish Registrant's goods and services or the source of such goods and services. Accordingly, the mark in Registration No. 7 is descriptive.

33. Respondent has not demonstrated, and cannot demonstrate, acquired distinctiveness for any of the Registrations.

B. ABANDONMENT

34. Petitioner repeats and realleges each and every allegation contained in paragraphs 1 through 33 as if fully set forth herein.

35. As set forth in detail below, Respondent has abandoned the marks in a number of the Registrations.

36. Registration No. 3 was issued to Respondent on December 8, 2009 for the mark BOX for advertising the goods and services of others via the Internet.

37. On information and belief, Respondent does not now use, nor has it ever used, the trademark in Registration No. 3 to advertise the goods and services of others via the Internet.

38. On information and belief, Respondent does not have any intent to use the trademark in Registration No. 3 for the services recited in the registration.

39. On information and belief, Respondent has abandoned the trademark that is the subject of Registration No. 3.

40. Registration No. 5 was issued to Respondent on April 7, 2009, for the mark OPENBOX for providing various computer services in the field of knowledge management.

41. On information and belief, Respondent does not now use the trademark in Registration No. 5 in connection with the services recited in the registration.

42. On information and belief, Respondent does not have any intent to use the trademark in Registration No. 5 for the services recited in the registration.

43. On information and belief, Respondent has abandoned the trademark that is the subject of Registration No. 5.

44. Registration No. 6 was issued to Respondent on August 2, 2011 for the mark OPENBOX for computer software, namely, software development tools, and related goods.

45. On information and belief, Respondent does not now use the trademark in Registration No. 6 in connection with the goods identified in the registration.

46. On information and belief, Respondent does not have any intent to use the trademark in Registration No. 6 in connection with the goods identified in the registration.

47. On information and belief, Respondent has abandoned the trademark that is the subject of Registration No. 6.

48. Registration No. 7 was issued to Respondent on May 12, 2009, for the mark BOX.NET for on-line journals, namely, blogs discussing technology and business, and computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information.

49. On information and belief, Respondent does not now use the trademark that is the subject of Registration No. 7 in connection with the services recited in the registration.

50. On information and belief, Respondent does not have any intent to use the trademark that is the subject of Registration No. 7 in connection with the services recited in the registration.

51. On information and belief, Respondent has abandoned the trademark that is the subject of Registration No. 7.

52. According to the public records of the USPTO, Registration No. 8 was originally registered by Fetchbox, LLC on November 12, 2002, for the mark FETCHBOX for use with electronic storage of remote computer data.

53. Respondent acquired Registration No. 8 on June 15, 2011, days before initiating its opposition to Petitioner's application to register its DROPBOX mark.

54. On information and belief, Respondent does not now use, nor has it ever used, the trademark that is the subject of Registration No. 8 in connection with the services recited in the registration.

55. On information and belief, Respondent does not have any intent to use the trademark that is the subject of Registration No. 8 in connection with the services recited in the registration.

56. On information and belief, Respondent has abandoned the trademark that is the subject of Registration No. 8.

V. DAMAGE TO PETITIONER

57. Petitioner has been and will be damaged by the continued registration of the marks in the Registrations because, among other reasons, Respondent has relied upon and asserted the marks in the Registrations in its opposition against Petitioner's application to register the mark DROPBOX (Opposition No. 91200450). Continued registration of the marks in the Registrations will also damage and injure Petitioner and others because, among other reasons, the Registrations adversely affect the ability of third parties to use the term "box" to accurately refer to goods and services related to storage.

VI. REQUEST FOR RELIEF

WHEREFORE, Petitioner prays that the Registrations be cancelled in their entirety and that this Consolidated Petition for Cancellation be sustained in favor of the Petitioner. Petitioner also prays that this cancellation proceeding be consolidated with Opposition No. 91200450.

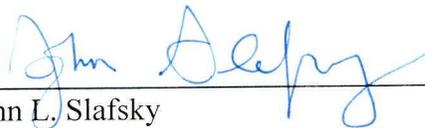
Petitioner authorizes payment of the required filing fee of \$3,300.00 from its counsel's USPTO Deposit Account. Please charge the fee to Deposit Account No. 232415. Please address all USPTO communications regarding this Consolidated Petition to Petitioner's attorneys:

John L. Slafsky
Wilson Sonsini Goodrich & Rosati
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Dated: May 17, 2013

Respectfully submitted,

WILSON SONSINI GOODRICH & ROSATI
Professional Corporation

By: 
John L. Slafsky

Attorneys for Petitioner
DROPBOX, INC.

CERTIFICATE OF SERVICE BY MAIL

I, Elvira Minjarez, declare:

I am employed in Santa Clara County. I am over the age of 18 years and not a party to the within action. My business address is Wilson Sonsini Goodrich & Rosati, 650 Page Mill Road, Palo Alto, California 94304-1050.

I am readily familiar with Wilson Sonsini Goodrich & Rosati's practice for collection and processing of correspondence for mailing with the United States Postal Service. In the ordinary course of business, correspondence would be deposited with the United States Postal Service on this date.

On this date, I served these **CONSOLIDATED PETITION FOR CANCELLATION** on each person listed below, by placing the document described above in an envelope addressed as indicated below, which I sealed. I placed the envelope for collection and mailing with the United States Postal Service on this day, following ordinary business practices at Wilson Sonsini Goodrich & Rosati.

Brian R. Coleman
Perkins Coie, LLP
3150 Porter Drive
Palo Alto, CA 94304

I declare under penalty of perjury that the foregoing is true and correct. Executed at Palo Alto, California on May 17, 2013.


Elvira Minjarez