

ESTTA Tracking number: **ESTTA582036**

Filing date: **01/15/2014**

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	Integrated Voting Solutions, Inc.		
Entity	Corporation	Citizenship	California
Address	1931 G Street Fresno, CA 93706 UNITED STATES		

Attorney information	Andrew B. Chen Blue Capital Law Firm, PC 600 Anton Blvd., Ste. 1000 Costa Mesa, CA 92626 UNITED STATES achen@bluecapitallaw.com Phone:714-839-3800
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### Registrations Subject to Cancellation

Registration No	3955717	Registration date	05/03/2011
Registrant	ADVANCED BALLOT SOLUTIONS LLC 11208 JOHN GAULT BOULEVARD OMAHA, NE 68137 GERMANY		

### Goods/Services Subject to Cancellation

Class 009. First Use: 2010/07/00 First Use In Commerce: 2010/07/00  
All goods and services in the class are cancelled, namely: computer hardware and software for ballot printing, processing, tracking and verification

### Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)		
Priority and likelihood of confusion	Trademark Act section 2(d)		
Registration No	4154535	Registration date	06/05/2012
Registrant	ADVANCED BALLOT SOLUTIONS LLC 11208 JOHN GAULT BOULEVARD OMAHA, NE 68137 GERMANY		

### Goods/Services Subject to Cancellation

Class 035. First Use: 2010/08/31 First Use In Commerce: 2010/08/31  
All goods and services in the class are cancelled, namely: election data processing services, namely, processing of election ballots

### Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)

### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	85893143	Application Date	04/02/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INTEGRAVOTE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2005/10/01 First Use In Commerce: 2005/10/01  Computer system and software for automating vote by mail processing service incorporating ballot printing, inserting, preparing absentee ballots, mail tracking and data processing</p> <p>Class 035. First use: First Use: 2005/10/01 First Use In Commerce: 2005/10/01  Business services, namely, providing automated vote by mail processing service incorporating ballot printing, inserting, preparing abasentee ballots, mail tracking and data processing</p>		

Attachments	85893143#TMSN.jpeg( bytes ) TTAB Petition for Cancellation '717 Reg.pdf(29250 bytes ) TTAB Petition for Cancellation '535 Reg.pdf(29421 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 B. Chen/
Name	Andrew B. Chen
Date	01/15/2014

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

_____	)	<b>Cancellation No.</b>
Integrated Voting Solutions, Inc.,	)	
	)	
Petitioner,	)	
	)	
vs.	)	Re: U.S. TM Reg. No. 3,955,717
	)	Mark: INTEGRA-VOTE
Advanced Ballot Solutions LLC,	)	
	)	
Respondent.	)	
_____	)	

PETITION FOR CANCELLATION

Petitioner Integrated Voting Solutions, Inc. (“Petitioner”) believes that it is and will continue to be damaged by U.S. Trademark Registration No. 3,955,717 (“the ‘717 registration”) for the mark INTEGRA-VOTE and hereby petitions to cancel the ‘717 registration.

**PARTIES**

1. Petitioner Integrated Voting Solutions, Inc. (“Petitioner”) is a corporation duly organized and existing under the laws of the State of California and having a principal place of business at 1931 G Street, Fresno, California 93706.

2. Petitioner is informed and believes that Respondent Advanced Ballot Solutions, LLC is a limited liability company organized under the laws of the State of Delaware with its principal place of business at 1909 East Ray Road, Suite 9-154, Chandler, Arizona 85225. Upon information and belief, ABS is a wholly owned subsidiary of Election Systems and Software, LLC (“ES&S”). Respondent, a competitor

of Petitioner IVS, provides election-related products and services throughout the United States.

## **BACKGROUND**

3. IVS was founded in 2004 and specializes in election products and services such as ballot printing, absentee and vote-by-mail production and mailing, sample ballot and mailing, voter information cards and pamphlets, tax notices, and insert printing. Since its inception, IVS has steadily grown to become a nationwide presence in providing election products and services to jurisdictions across the United States.

4. Petitioner operates under and by way of the trademark INTEGRAVOTE as its domain name, integravote.com, continuously since October 2004, to identify its website on the Internet.

5. Petitioner filed trademark application for the INTEGRAVOTE on January 28, 2005, U.S. Trademark Application Serial No. 78/555,625 (“the ‘625 application”). The ‘625 application was filed under Section 1(b). The application was allowed and granted registration to the Principal Register pending the submittal of a Statement of Use and proper specimen. A six (6) month extension was submitted to the USPTO. Due to a clerical error, the specimen as used in commerce was not submitted to the USPTO and the application went abandoned.

6. Nevertheless, IVS has continuously used the trademark INTEGRAVOTE to identify a line of absentee ballot inkjetting and mailing products and services offered by Petitioner since 2005. The INTEGRAVOTE mark was used to advertise and identify Petitioner’s products throughout the United States.

7. Petitioner has invested substantial sums of money and countless hours of labor, promoting, marketing, and advertising its services in connection with its INTEGRAVOTE mark. Since the time of the adoption of the INTEGRAVOTE mark,

Petitioner's commercial use of its mark has been exclusive and continuous. Through such exclusive and continuous use, sales of its innovative products and services, careful planning and protection of its image and reputation, Petitioner's INTEGRAVOTE mark has become recognized by relevant consumers as exclusively identifying and designating Petitioner's products and services.

8. Petitioner is informed and believes that Respondent was co-founded by Mr. Val Guyett and Mr. John Latsko. Further, on information and belief, Messers. Guyett and Latsko each have approximately ten (10) years of experience in the elections marketplace. Petitioner has attended the same trade shows attended by Messers. Guyett and Latsko in which Petitioner advertised and presented its INTEGRAVOTE products.

9. Further, Petitioner and Respondent competitively bid for the same projects over the years, for example, in Florida in and around 2007-13.

10. Despite Petitioner's use of the domain name "integravote.com" for almost four and half years and the fact that Respondent had actual knowledge of Petitioner's INTEGRAVOTE products, Respondent registered for domain name integravote.net on February 5, 2010.

11. On information and belief, Mr. Latsko was responsible for selecting the integravote.net domain name and knew that integravote.com was the domain name of Petitioner, one of its competitors in the election marketplace.

12. Further, Respondent was not advertising any product or services with the INTEGRAVOTE mark. Indeed, Respondent's integravote.net domain redirects visitors to its website [www.advancedballotsystems.com](http://www.advancedballotsystems.com). Visitors are not notified that they are being redirected to Respondent ABS's website.

13. Two (2) weeks after Respondent selected its confusingly similar domain name, Respondent sought registration for the mark "INTEGRA-VOTE" on February 19, 2010. Surprisingly, Respondent did not file the trademark application for its selected

domain name “INTEGRAVOTE” but rather a slightly different mark, “INTEGRA-VOTE.”

14. On information and belief, Respondent had actual knowledge of IVS’s senior rights to the INTEGRAVOTE mark, yet Respondent ABS still sought registration for a confusingly similar mark, INTEGRA-VOTE. Respondent failed to disclose IVS’s senior rights to INTEGRAVOTE to the U.S. Patent and Trademark Office during the prosecution of their mark INTEGRA-VOTE.

15. On information and belief, in or around late 2011, Respondent was acquired by Election Systems and Software, LLC (“ES&S”). ES&S had numerous business dealing with Petitioner for the last ten (10) years and had actual knowledge of Integrated Voting Solutions, Inc. and INTEGRAVOTE. For example, sometime in or around May to December 2005, Petitioner and ES&S executed a non-disclosure agreement (NDA) prior to Petitioner’s presentation at ES&S’s office in Omaha, Nebraska. Petitioner’s presentation was directed to Petitioner’s products and services, including Petitioner’s INTEGRAVOTE products. Also, Petitioner’s employee sent an email to ES&S providing two MICROSOFT EXCEL files entitled INTEGRAVOTE ballot order and work order instruction sheets on September 20, 2006.

16. Despite ES&S’s knowledge of Petitioner and Petitioner’s mark, ES&S has demonstrated a reckless disregard of third party’s intellectual property rights. Despite this actual knowledge, ES&S posted a new header on each of the webpages for each of its product lines entitled “Integrated Voting Solutions” in early 2013. (See Exhibit A). On information and belief, ES&S had the specific intent to cause consumer confusion and divert business away from Petitioner.

17. When Petitioner discovered that ES&S had put Petitioner’s company name on its product pages, Petitioner sent a cease and desist letter to ES&S. ES&S initially refused to remove Petitioner’s company name from its webpages but ultimately relented.

## COUNT I

### **Fraud on the U.S. Patent and Trademark Office**

18. Petitioner re-alleges and incorporates by reference all preceding paragraphs as though fully set forth herein.

19. Upon information and belief, at the time Respondent filed its application for registration of the INTEGRA-VOTE mark, Respondent possessed the knowledge that Petitioner IVS had used the term INTEGRAVOTE as its trademark and domain name before Respondent's adoption and use of its mark INTEGRA-VOTE.

20. On February 19, 2010, Respondent ABS filed a trademark application with the USPTO for registration of the term INTEGRA-VOTE in connection with computer hardware and software for ballot printing, processing, tracking and verification, U.S. Trademark Application Serial No. 77/940,322 ("the '322 application").

21. In connection with the '322 application, Respondent ABS submitted its oath, pursuant to 18 U.S.C. § 1001, that to the best of its knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.

22. Respondent ABS's oath accompanying the '322 application was signed by William O. Ferron, Jr., Respondent's attorney who had the authority to bind Respondent as set forth in 37 C.F.R. §2.193(e)(1).

23. Despite the knowledge that Petitioner possessed senior rights to the INTEGRAVOTE mark, or some substantially similar variation thereof, and despite its belief that the use of the INTEGRAVOTE mark would likely cause confusion, Respondent willfully failed to correct the misrepresentation made in its oath accompanying the '322 application. Respondent had a duty to disclose this information

to the U.S. Patent and Trademark Office (“USPTO”), even after the ‘322 application was filed, but failed to do so.

24. Respondent ABS’s willful failure to correct its misrepresentation in connection with the ‘322 application constitutes fraud because Respondent ABS intended and knew that the USPTO would rely upon such misrepresentation in conferring a substantial benefit upon Respondent ABS, namely, the issuance of a federal trademark registration, to which Respondent ABS knew it was not entitled.

25. In reliance on Respondent’s oath in connection with the ‘322 application, the USPTO issued to Respondent Registration No. 3,955,717 (“the ‘717 registration”) on May 3, 2011.

26. Based on Respondent’s fraud on the USPTO, the ‘717 registration should be canceled.

## **COUNT II**

### **Priority and Likelihood of Confusion**

27. Petitioner re-alleges and incorporates by reference all preceding paragraphs as though fully set forth herein.

28. Petitioner’s dates of use of its INTEGRAVOTE mark are prior to the date of filing of Respondent’s ‘322 application and the date of Respondent’s claimed date of first use.

29. In view of the similarity of Petitioner’s and Respondent’s marks, identical channels of trade, and identical goods offered for sale by the respective parties, Respondent’s INTEGRA-VOTE mark is so similar to Petitioner’s INTEGRAVOTE mark that it is likely to cause confusion, mistake, or deceive as to source by suggesting that Respondent’s goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Petitioner.



**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing PETITION FOR CANCELLATION filed before the TTAB has been served on Respondent Advanced Ballot Solutions, LLC, by mailing said copy on January 15, 2014, via First Class Mail, postage prepaid to:

Advanced Ballot Solutions, LLC  
11208 John Galt Blvd.  
Omaha, NE 68137

Dated: January 15, 2014

By: /Andrew B. Chen/  
Andrew B. Chen, Esq.  
BLUE CAPITAL LAW FIRM, P.C.  
600 Anton Blvd., Ste. 1000  
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Attorney for Respondents  
Integrated Voting Solutions, Inc.

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

_____	)	<b>Cancellation No.</b>
Integrated Voting Solutions, Inc.,	)	
	)	
Petitioner,	)	
	)	
vs.	)	Re: U.S. TM Reg. No. 4,154,535
	)	Mark: INTEGRA-VOTE
Advanced Ballot Solutions LLC,	)	
	)	
Respondent.	)	
_____	)	

PETITION FOR CANCELLATION

Petitioner Integrated Voting Solutions, Inc. (“Petitioner”) believes that it is and will continue to be damaged by U.S. Trademark Registration No. 4,154,535 (“the ‘535 registration”) for the mark INTEGRA-VOTE and hereby petitions to cancel the ‘535 registration.

**PARTIES**

1. Petitioner Integrated Voting Solutions, Inc. (“Petitioner”) is a corporation duly organized and existing under the laws of the State of California and having a principal place of business at 1931 G Street, Fresno, California 93706.

2. Petitioner is informed and believes that Respondent Advanced Ballot Solutions, LLC is a limited liability company organized under the laws of the State of Delaware with its principal place of business at 1909 East Ray Road, Suite 9-154, Chandler, Arizona 85225. Upon information and belief, ABS is a wholly owned subsidiary of Election Systems and Software, LLC (“ES&S”). Respondent, a competitor

of Petitioner IVS, provides election-related products and services throughout the United States.

## **BACKGROUND**

3. IVS was founded in 2004 and specializes in election products and services such as ballot printing, absentee and vote-by-mail production and mailing, sample ballot and mailing, voter information cards and pamphlets, tax notices, and insert printing. Since its inception, IVS has steadily grown to become a nationwide presence in providing election products and services to jurisdictions across the United States.

4. Petitioner operates under and by way of the trademark INTEGRAVOTE as its domain name, [integravote.com](http://integravote.com), continuously since October 2004, to identify its website on the Internet.

5. Petitioner filed trademark application for the INTEGRAVOTE on January 28, 2005, U.S. Trademark Application Serial No. 78/555,625 (“the ‘625 application”). The ‘625 application was filed under Section 1(b). The application was allowed and granted registration to the Principal Register pending the submittal of a Statement of Use and proper specimen. A six (6) month extension was submitted to the USPTO. Due to a clerical error, the specimen as used in commerce was not submitted to the USPTO and the application went abandoned.

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20. On February 19, 2010, Respondent ABS filed a trademark application with the USPTO for registration of the term INTEGRA-VOTE in connection with computer hardware and software for ballot printing, processing, tracking and verification, U.S. Trademark Application Serial No. 77/940,327 ("the '327 application").

21. In connection with the '327 application, Respondent ABS submitted its oath, pursuant to 18 U.S.C. § 1001, that to the best of its knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.

22. Respondent ABS's oath accompanying the '327 application was signed by William O. Ferron, Jr., Respondent's attorney who had the authority to bind Respondent as set forth in 37 C.F.R. §2.193(e)(1).

23. Despite the knowledge that Petitioner possessed senior rights to the INTEGRAVOTE mark, or some substantially similar variation thereof, and despite its belief that the use of the INTEGRAVOTE mark would likely cause confusion, Respondent willfully failed to correct the misrepresentation made in its oath accompanying the '327 application. Respondent had a duty to disclose this information

to the U.S. Patent and Trademark Office (“USPTO”), even after the ‘327 application was filed, but failed to do so.

24. Respondent ABS’s willful failure to correct its misrepresentation in connection with the ‘327 application constitutes fraud because Respondent ABS intended and knew that the USPTO would rely upon such misrepresentation in conferring a substantial benefit upon Respondent ABS, namely, the issuance of a federal trademark registration, to which Respondent ABS knew it was not entitled.

25. In reliance on Respondent’s oath in connection with the ‘327 application, the USPTO issued to Respondent Registration No. 4,154,535 (“the ‘535 registration”) on May 3, 2011.

26. Based on Respondent’s fraud on the USPTO, the ‘535 registration should be canceled.

## **COUNT II**

### **Priority and Likelihood of Confusion**

27. Petitioner re-alleges and incorporates by reference all preceding paragraphs as though fully set forth herein.

28. Petitioner’s dates of use of its INTEGRAVOTE mark are prior to the date of filing of Respondent’s ‘327 application and the date of Respondent’s claimed date of first use.

29. In view of the similarity of Petitioner’s and Respondent’s marks, identical channels of trade, and identical goods offered for sale by the respective parties, Respondent’s INTEGRA-VOTE mark is so similar to Petitioner’s INTEGRAVOTE mark that it is likely to cause confusion, mistake, or deceive as to source by suggesting that Respondent’s goods are associated with or approved, endorsed, affiliated, authorized or sponsored by Petitioner.



**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing PETITION FOR CANCELLATION filed before the TTAB has been served on Respondent Advanced Ballot Solutions, LLC, by mailing said copy on January 15, 2014, via First Class Mail, postage prepaid to:

Advanced Ballot Solutions, LLC  
11208 John Galt Blvd.  
Omaha, NE 68137

Dated: January 15, 2014

By: /Andrew B. Chen/  
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Attorney for Respondents  
Integrated Voting Solutions, Inc.