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

Proceeding	92059416
Party	Defendant Xeles Worldwide Corp
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Submission	Answer
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Signature	/asl/
Date	07/30/2014
Attachments	LITTERA LINE - Answer.pdf(4135847 bytes)

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

Litera Corporation, Petitioner,	)	Mark: LITTERA LINE
	)	Cancellation No. 92059416
v.	)	Reg. No. 4322704
Xeles Worldwide Corp Respondent.	)	Classes 9, 38, 41, 42

ANSWER TO PETITION FOR CANCELLATION

Respondent, by and through its attorneys identified below, for its Answer to the Petition for Cancellation, states as follows:

1. Answering paragraph 1 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore neither admits nor denies such allegations.

2. Answering paragraph 2 of the Petition for Cancellation, Respondent admits such allegations.

3. Answering paragraph 3 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore denies such allegations.

4. Answering paragraph 4 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore denies such allegations.

5. Answering paragraph 5 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore denies such allegations.

6. Answering paragraph 6 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore denies such allegations.

7. Answering paragraph 7 of the Petition for Cancellation, Respondent admits that:

- the USPTO records indicate that Respondent is identified as the owner the U.S. registration No. 2751390 for the mark LITERA for "Computer software for collaborative documents", registered on Aug. 12, 2003.
- the USPTO records indicate that Respondent is identified as the owner the U.S. registration No. 4055373 for the mark LITÉRA IDS for "computer software which allows multiple users to collaborate on a single document, which inserts digital signatures and which archives and retrieves data according to special search criteria defined by the user", registered on Nov. 15, 2011.
- the USPTO records indicate that Respondent is identified as the owner the U.S. registration No. 4332878 for the mark LITÉRA GALAXY for "computer software for custody-controlled document collaboration and workflow management", registered on May 7, 2013.
- the USPTO records indicate that Respondent is identified as the owner the U.S. registration No. 4379250 for the mark LITÉRA SECURE FILE TRANSFER for "computer software for securely sending encrypted emails and attachments, transferring large electronic files, and enabling advanced electronic signatures", registered on May 21, 2013.
- the USPTO records indicate that Respondent is identified as the owner the U.S. registration No. 4383363 for the mark LITÉRA SECURE WEB CONTENT for "computer software for securely publishing documents to the Web and preventing the same content from being copied, downloaded, saved or printed", registered on May 28, 2013.

8. Answering paragraph 8 of the Petition for Cancellation, Respondent averts that allegations call for a legal conclusion to which no response is required.

9. Answering paragraph 9 of the Petition for Cancellation, Respondent admits that the USPTO records indicate that Respondent is identified as the applicant the U.S. Serial No. 86006172 for the mark LITÉRA SYNC for "Computer software for secure file synchronization," in International Class 009.

10. Answering paragraph 10 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore denies such allegations.

11. Answering paragraph 11 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore denies such allegations.

12. Answering paragraph 12 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore denies such allegations.

13. Answering paragraph 13 of the Petition for Cancellation, Respondent admits such allegations.

14. Answering paragraph 14 of the Petition for Cancellation, Respondent admits such allegations.

15. Answering paragraph 15 of the Petition for Cancellation, Respondent re-affirms or re-denies such allegations by reference.

16. Answering paragraph 16 of the Petition for Cancellation, Respondent lacks sufficient information to admit or deny the allegations, and therefore denies such allegations.

17. Answering paragraph 17 of the Petition for Cancellation, Respondent denies such allegations.

18. Answering paragraph 18 of the Petition for Cancellation, Respondent denies such allegations.

19. Answering paragraph 19 of the Petition for Cancellation, Respondent denies such allegations, except admits that the Petitioner purports to refer to and quotes selectively from and out of context unidentified documents.

20. Answering paragraph 20 of the Petition for Cancellation, Respondent denies such allegations, except admits that the Petitioner purports to refer to and quotes selectively from and out of context unidentified documents.

21. Answering paragraph 21 of the Petition for Cancellation, Respondent denies such allegations.

22. Answering paragraph 22 of the Petition for Cancellation, Respondent denies such allegations.

23. Answering paragraph 23 of the Petition for Cancellation, Respondent denies such allegations.

24. Answering paragraph 24 of the Petition for Cancellation, Respondent denies such allegations.

25. Answering paragraph 25 of the Petition for Cancellation, Respondent denies such allegations.

26. Answering paragraph 26 of the Petition for Cancellation, Respondent re-affirms or re-denies such allegations by reference.

27. Answering paragraph 27 of the Petition for Cancellation, Respondent denies such allegations.

28. Answering paragraph 28 of the Petition for Cancellation, Respondent denies such allegations.

29. Answering paragraph 29 of the Petition for Cancellation, Respondent denies such allegations.

AFFIRMATIVE DEFENSES

1. The Petition for Cancellation is barred by estoppel. Specifically, On April 4, 2014 responding to the Office Action issued against Petitioner's U.S. Serial No. 86006172 or the mark LITÉRA SYNC, Petitioner admitted there is no likelihood of confusion between the said trademark and Respondent's U.S. Registration Nos. 4381819 and 4322704. A true and accurate printout of the response, as obtained through the on-line Trademark Status and Document Retrieval (TSDR) System of the USPTO is attached hereto as Exhibit A.
2. The Petition for Cancellation is barred by waiver.
3. The Petition for Cancellation is barred by laches.
4. The Petition for Cancellation is barred by acquiescence.
5. Petitioner failed to allege adequate legal grounds to cancel Respondent's mark.
6. Petitioner failed to state facts sufficient to cancel Respondent's mark.
7. Respondent's trademark is different from any of Petitioner's trademarks in terms of meaning, sight, sound and commercial impression.
8. Petitioner's marks coexist on the Principal Trademark Register with other LITERA- or LETTER- formative registrations for related goods and services.

9. Respondent will assert any and all other valid defenses and/or counterclaims that will be developed through the discovery and/or testimony periods in this proceeding.

Accordingly, Respondent requests that the Petition for Cancellation be dismissed.

Respectfully submitted,

Date: July 30, 2014 By:

_____
Alexander S. Lazouski
Attorney for Respondent

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Petition for Cancellation has been served on Petitioner by mailing said copy on July 30, 2014 via First Class Mail, postage prepaid to:

Rebecca L Cage
Brooks Pierce Mclendon Humphrey & Leonard LLP
Po Box 26000
Greensboro, NC 27420
United States

By:

_____
Alexander S. Lazouski
Attorney for Respondent

EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
RESPONSE TO OFFICE ACTION

In Re: Application of:

Applicant:	Litéra Corp.
Mark:	LITÉRA SYNC
App. Serial No.:	86006172
Filing Date:	July 10, 2013
Goods/Services:	IC 009: computer software for secure file synchronization
Examining Attorney:	Yatsye I. Lee
Law Office:	107
Office Action Date:	October 28, 2013

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
Attention: Trademark Examining Operation

Transmitted via TEAS

RESPONSE TO OFFICE ACTION

Dear Yatsye Lee:

This letter responds to the Office Action transmitted on October 28, 2013.

The Applicant Litéra Corp. ("Applicant" or "Litera") respectfully requests that the refusal from the Office Action be withdrawn for the reasons expressed below and that the current application ("Application") be permitted to proceed, as amended.

The Office Action raised two issues: likelihood of confusion with U.S. Registrations 4381819 and 4322704, and a claim of ownership requirement. The claim of ownership requirement is addressed below and in the electronic TEAS response. The Section 2(d) refusal is respectfully traversed below.

Claim of Ownership

The Applicant owns the cited US Registrations Nos. 2751390 (for LITERA), 4055373 (for LITÉRA IDS), 4332878 (for LITÉRA GALAXY), 4379250 (for LITÉRA SECURE FILE TRANSFER), and 4383363 (for LITÉRA SECURE WEB CONTENT). In the electronic TEAS response, the Applicant amends the Application to recite the claim of ownership suggested in the office action: "Applicant is the owner of U.S. Registration Nos. 2751390, 4055373, 4332878, and others."

Likelihood of Confusion

The Examining Attorney has refused registration of the subject mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on an alleged likelihood of confusion with Registrations No. 4381819 for LITTERA BOX and No. 4322704 for LITTERA LINE. Both registrations are listed as being owned by Xeles Worldwide Corp. ("Xeles"), a Russian corporation with a Tortola, British Virgin Islands address.

The differences between Xeles' registered marks and Applicant's currently applied-for mark are sufficient that there is no likelihood of confusion. Indeed, Xeles already argued successfully to the Office (the "Office" or the "USPTO") that Xeles' LITTERA BOX mark is not likely to be confused with the Applicant's prior LITERA registration when the Office initially objected to Xeles' application to register LITTERA BOX. As described below, many of the arguments advanced by Xeles apply here and favor allowing the Applicant's current Application.

It is well established that the determination of the issue of likelihood of confusion is based on analysis of all the probative facts in evidence relevant to the factors set forth in *In re I.E. Du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973). *See In re Strategic Partners,*

Inc., Serial No. 77903451, 2012 TTAB LEXIS 80 (TTAB Mar. 28, 2012) (precedential). Here, confusion is not likely.

I. Xeles Asserted No Likelihood of Confusion in Order to Obtain Its Registration.

Both of Xeles' cited registrations were sought through the Madrid Protocol with a request for extension of protection to the United States. When Xeles' application for LITTERA BOX (for a host of goods and services, including computer software with a variety of functions) was examined by the Office, the examiner initially refused Xeles' application due to the Applicant's (Litera's) prior registration for LITERA (for computer software for collaborative documents, digital signatures and special archiving and retrieval).

Before turning to Xeles' response to that refusal, it is notable that the current Applicant also owned at the time, and still owns, another registration with priority over Xeles' applications. Namely, the Applicant owned and owns Reg. No. 4055373 for LITÉRA IDS (for computer software which allows multiple users to collaborate on a single document, which inserts digital signatures and which archives and retrieves data according to special search criteria defined by the user). The LITÉRA IDS registration was not cited against Xeles' application, perhaps because of the different second word (i.e. IDS as compared to BOX) and in recognition of the lack of a likelihood of confusion.

In response to the Office's refusal, Xeles contended in writing on March 14, 2013 that the marks LITERA and LITTERA BOX "are readily distinguishable in terms of meaning, sight, sound and commercial impression." Ex. A at 2. Xeles' written submission is attached as Exhibit A. Specifically, Xeles asserted (i) that the marks have different meanings because both words look and sound as foreign language terms, "Litera" in Spanish means "bunk bed", and "Littera" has no Spanish translation and means "it" in Lithuanian or "letter" in Latin. *Id.* at 3. Xeles next asserted (ii) that the marks "sound distinctly different" both in the first and second words. *Id.*

Xeles asserted (iii) that prior USPTO practice favored allowing both marks. *Id.* at 3-4. Xeles then contended and presented evidence (iv) that the Principal Register was replete with active, coexisting or allowed registrations for LITERA- or LETTER-formative marks for related goods and services, *id.* at 4, demonstrating "significant dilution of marks incorporating 'LITER' or 'LETTER,'" *id.* at 13, and the corresponding weakness of that portion of the mark(s), *id.* at 14.

It is well-established that each case is decided on its own merits and that prior decisions by examining attorneys in approving other marks are not binding. *See* TMEP 1207.01(d)(vi). However, the substantive contentions and concessions advanced by Xeles are probative and support the determination that there is no likelihood of confusion between Xeles' registrations and the Applicant's applied-for mark. Put another way, although Xeles' arguments and the USPTO's prior decisions may not be controlling precedent, they are persuasive authority (or have estoppel-type effect binding upon Xeles). The same result granted before should again be adopted for this very similar situation, and the current Application should be allowed.

In addition, the very fact that Xeles made these arguments (and made them successfully) is relevant under the *Du Pont* analysis of all relevant facts. It is relevant that the owner of the cited registrations believed its LITTERA ___ formative registrations are so sufficiently different from LITERA's prior registrations that there would be no likelihood of confusion and that its applications and arguments should be approved. Xeles' actions are tantamount to a concession that the Applicant's use of additional LITERA ___ formative marks will also not likely cause confusion, at least so long as the second word is not similar to LINE or BOX. Therefore, this course of conduct and argument by the registrant favors allowing the Applicant's current Application.

II. The Marks Are Dissimilar.

To properly evaluate the similarities between marks, the marks must be viewed in their entireties. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985). Here, the marks are dissimilar in their appearances, sounds, meanings and commercial impressions.

Visually, the marks are different. The registered marks LITTERA BOX and LITTERA LINE have two t's in their first word, they lack accent marks, and they have different second words than the applied for mark LITÉRA SYNC. These differences are consistent with differences argued by Xeles and evidently deemed significant in prior USPTO practice when the Office allowed Xeles' application despite the Applicant's prior registration for LITERA. Indeed the currently applied for mark is even 'more different' from Xeles' registered marks because the currently applied for mark has the accent symbol and also uses SYNC rather than LINE, BOX or nothing at all.

Verbally, the marks are dissimilar. First, the initial words LITERA and LITTERA are pronounced differently; they are not phonetic equivalents and do not sound identical. The first word in Applicant's mark LITERA is pronounced "Li-tair´-uh." The first syllable has a short "i," the second syllable has the "ai" sound found in "fair," the last syllable is a "schwa," and the accent is on the second syllable. In contrast, according to Xeles' own prior filing, the first word of its LITTERA marks is pronounced "lit-te-ra." Ex. A at 3. Thus, unlike the Applicant's mark, the first syllable of Xeles' mark ends with a hard "t" sound, the second syllable has the "te" sound found in "tech," and, perhaps most importantly, the accent is placed on the first syllable. According to Xeles' own filing, the initial words of the marks sound dissimilar. Second, the last words of each mark (BOX and LINE as opposed to SYNC) are obviously different and sound different.

The meanings and commercial impressions of the marks are different. First, the Applicant's applied-for mark references synchronization or multiple things happening at the

same time. This contrasts with the registered marks' references to lines or boxes. Second, if one accepts Xeles' argument that LITERA and Xeles' LITTERA look and sound as foreign language marks and Xeles' translations, then bunk bed synchronization has no similar meaning to Xeles' letter box or letter line. Third, even if Litéra were translated to letter or literature (as recited in the Application), the Applied-for mark's connoted reference to synchronized literature or letters presents a very different meaning and commercial impression than Xeles' letter box (or mail receptacle) or letter line (a string of letters, braile or print type).

To the extent that the second word SYNC of the Applicant's mark is given less weight since it has been disclaimed, then Applicant's mark even more closely resembles its prior LITERA registration. Xeles expressly argued last year that its LITTERA marks were dissimilar to that prior LITERA registration, and the Office evidently agreed when granting the registrations.

Therefore, while Xeles' LITTERA BOX/LITTERA LINE marks and Applicant's LITÉRA SYNC mark share some common letters, that does not make the marks confusingly similar when considered in whole. This factor favors registration.

III. Xeles' Cited Registrations Are Weak and Narrow.

The fifth, sixth and eleventh *Du Pont* factors concern assessment of the fame of the prior mark, the number and nature of similar marks in use on similar goods, and the extent to which the applicant has the right to exclude others from use of the mark. Here, these factors demonstrate the weakness and narrowness of the cited registrations. They favor allowing registration of the Applicant's mark.

Xeles previously argued that "the register is replete with active, coexisting registrations of allowed applications for LITERA- OR LETTER-formative marks for related goods and services, owned by numerous different entities." Ex. A at 4. Xeles included a nine-page chart of

registrations and applications, *Id.* at 4-12, with registration certificates, *see* File History of Xeles' LITTERA BOX application, and quoted the TMEP for the proposition that "such registrations are 'relevant to show that the mark or a portion of the mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services.' TMEP § 1207.01(d)(iii)." Xeles submitted "that these coexisting registrations demonstrate the significant dilution of the marks incorporating 'LITER' or 'LETTER' on the register for the similar goods. . . ." Ex. A at 13.

In addition to this third party registration evidence cited by Xeles, the Applicant also owned two registrations registered or filed for before the December 1, 2011 priority date claimed in Xeles' registrations. By that time, the current Applicant already had registrations for LITERA (Reg. 2751390, August 12, 2003) and for LITÉRA IDS (Reg. 4055373, November 15, 2011).

Then, after Xeles' asserted priority date, the Office granted the Applicant three more LITÉRA ___ formative registrations. The Applicant was granted registrations for LITÉRA GALAXY (Reg. 4332878, May 7, 2013), LITÉRA SECURE FILE TRANSFER (Reg. 4379250, August 6, 2013), and LITÉRA SECURE WEB CONTENT (Reg. 4383363, August 13, 2013).

As stated in *Amstar Corp. v. Domino's Pizza, Inc., et al.*, 205 USPQ 969, 975 (5th Cir. 1980) (and as noted by Xeles in its argument), "the strength and distinctiveness of plaintiff's mark is a vital consideration in determining the scope of protection it should be accorded." Xeles posited that the "coexistence of these many registrations for marks incorporating 'LITERA' or 'LETTER' demonstrates that the field of such marks is crowded. Ex. A at 13. Accordingly, much as Xeles argued, Xeles' registrations are therefore entitled to only a narrow scope of protection for the goods of the type covered by the cited registrations. *See In re Hartz Hotel Serv., Inc., Serial No. 76692673, 2012 TTAB LEXIS 75, at *11-12, 102 U.S.P.Q.2d 1150 (TTAB Mar. 19, 2012).* As written by the TTAB recently, quoting a prior decision:

> It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.

Id. at *12 (quoting *Sure-Fit Prod. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 U.S.P.Q. 295, 297 (CCPA 1958)).

Here, Xeles chose marks "hemmed in on all sides by similar marks on similar goods" and is therefore entitled to only a narrow scope of protection for the identified goods and services. Put another way, Xeles' cited marks are weak. And, in recognition of the narrowness and weakness of Xeles' registrations, the Office granted in 2013 the Applicant the three additional registrations noted above for LITÉRA ___ formative marks.

Should the examiner have concerns about whether the marks in the prior registrations are being used or whether the registrations demonstrate such use, the Applicant is willing to confirm, beyond the claims of ownership, that it continues to use its registered marks, LITERA (Reg. 2751390), LITÉRA IDS (Reg. 4055373), LITÉRA GALAXY (Reg. 4332878), LITÉRA SECURE FILE TRANSFER (Reg. 4379250), and LITÉRA SECURE WEB CONTENT (Reg. 4383363). Indeed, a section 8 & 9 renewal of LITERA was recently filed and granted in 2013 for Applicant's LITERA registration. And, the last three marks were recently registered in 2013. Similarly, marketplace use of the third party applications or registrations cited by Xeles can be investigated and likely provided if the examiner has any concerns about establishing the weakness Xeles' marks beyond Xeles' own statements and the Applicant's own prior registrations.

In sum, the narrowness and weakness of the Xeles' registrations, in light of their dilution and being "hemmed in" favors allowance of the Applicant's applied-for mark.

IV. No Actual Confusion Is Known.

The seventh *Du Pont* factor examines the "length of time during and conditions under which there has been concurrent use without evidence of actual confusion," which has been held to be probative of the fact that confusion is unlikely to arise in future use of the mark. *Du Pont*, 476 F.2d at 1361; *Old Tyme Foods, Inc. v. Roundy's*, 961 F.2d 200, 204-05 (Fed. Cir. 1992). Here, the Applicant has been using its LITERA mark since 2003 and the applied-for mark LITÉRA SYNC since at least May 17, 2013. By contrast, Xeles obtained extensions of protection to the United States with filing dates of May 22, 2012 and a December 1, 2011 priority date. The Applicant is not aware of any confusion during this time of coexistence. This favors allowance of the Applicant's applied-for mark.

V. The Refusal Conflicts with Prior USPTO Practice.

The last *Du Pont* factor relates to "any other established fact probative of the effect of use." It is notable, again, that the USPTO allowed Xeles' two applications to register LITTERA __ formative marks while Applicant had registrations for LITERA and a LITÉRA ___ formative mark, LITÉRA IDS. Then, after the cited registrations' priority date, the Applicant applied for and the USPTO granted to the Applicant registrations for three more LITÉRA ___ formative marks: LITÉRA GALAXY, Reg. 4332878; LITÉRA SECURE FILE TRANSFER, Reg. 4379250; and LITÉRA SECURE WEB CONTENT, Reg. 4383363. As such, the Applicant submits that, based on the Office's past practice with regard to the examination of an almost identical issue, on several occasions, the Office has already determined that no likelihood of confusion exists between LITERA ___ formative marks and LITTERA___ formative marks in the general field(s) of software (without it being necessary to consider the specific natures of

each set of software[1]), and a refusal to register Applicant's mark would be inconsistent with that practice. This favors allowing the Application.

* * *

Therefore, when considering the marks as a whole, the *Du Pont* factors should be seen to line up against any likelihood of confusion and in favor of allowing the Application. The Applicant requests that the refusal be withdrawn and that the Application be permitted to proceed.

Please do not hesitate to contact me with any comments or questions.

Date: April 4, 2014

Respectfully submitted,

s/*David W. Sar/*

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[1] The specific software identified by the Xeles applications and the applied-for mark appear to be sufficiently different to favor a determination of no likelihood of confusion. However, a detailed discussion of the software seems unnecessary at this stage given Xeles' own concessions, prior USPTO practice, and the other differences between the marks set forth above. The Applicant reserves the right to explain such differences in the goods/services.