

ESTTA Tracking number: **ESTTA660653**

Filing date: **03/12/2015**

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	Xperiel, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	989 Asilomar Terrace Sunnyvale, CA 94086 UNITED STATES		

Attorney information	Steven A Abreu Sunstein Kann Murphy & Timbers LLP 125 Summer Street Boston, MA 02110 UNITED STATES sabreu@sunsteinlaw.com Phone:6174439292
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Registration Subject to Cancellation

Registration No	3886603	Registration date	12/07/2010
Registrant	Passport Software, Inc. 3801 West Lake Ave. Suite 301 Glenview, IL 60026 UNITED STATES		

Goods/Services Subject to Cancellation

<p>Class 042. First Use: 2008/09/15 First Use In Commerce: 2008/10/01 All goods and services in the class are cancelled, namely: Advisory services in the field of product development and quality improvement of software; Application service provider(ASP) featuring software for use business accounting and management; Application service provider (ASP), namely, hosting computer software applications of others; Application service provider featuring software for providing an on-line database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports; Application service provider, namely, providing, hosting, managing, developing, and maintaining applications, software, websites, and databases in the fields of personal productivity, wireless communication, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobileelectronic devices; Computer network design and computer software design for the business accounting and management; Computer service, acting as an applicationservice provider in the field of knowledge management to host computer application software for creating searchable databases of information and data to allow users to perform, on-line, the collecting and analyzing of different types of opinion surveys; Computer service, namely,acting as an application service provider in the field of knowledge management to host computer application software for creating searchable databases of information and data; Computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for searching and retrieving informationfrom databases and computer networks; Computer service, namely, acting as an application service provider in the field of knowledge management to host computerapplication software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer software consultancy; Computer software consultation; Computer software design for others; Computer software design, computer programming, or main-</p>

tenance of computer software; Computer software development; Consultancy in the field of software design; Consultation services in the fields of selection, implementation and use of computer hardware and software systems for others; Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; Customization of computer hardware and software; Data automation and collection service using proprietary software to evaluate, analyze and collect service data; Design and development of computer hardware and software; Design and development of on-line computer software systems; Design, development and implementation of software; Development, updating and maintenance of software and data bases; Installation of computer software; Maintenance of computer software; Periodic upgrading of computer software for others; Providing on-line non-downloadable software for business accounting and management; Technical support services, namely, troubleshooting of computer hardware and software problems; Technical support services, namely, troubleshooting of computer software problems; Technical support, namely, providing back-up computer programs and facilities; Up-dating of computer software; Updating of computer software for others

Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l. Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Abandonment	Trademark Act section 14

Attachments	Petition to Cancel REALWORLD registration.pdf(60415 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 Overnight Courier on this date.

Signature	/Steven Abreu/
Name	Steven A Abreu
Date	03/12/2015

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

In the Matter of Trademark:

Registration No.: 3,886,603
Registration date: Dec. 7, 2010
Mark: REALWORLD
Registrant: Passport Software, Inc.

Xperiel, Inc.

Petitioner,

v.

Passport Software, Inc.

Registrant.

Petition for Cancellation

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Sir or Madam:

Xperiel, Inc. ("Petitioner"), a corporation organized and existing under the laws of the State of Delaware and having its principal place of business at 989 Asilomar Terrace, Sunnyvale, California 94086, believes that it has been and will be damaged by Registration No. 3,886,603 and hereby petitions to cancel said registration under 15 U.S.C. §1064 and §1068, as amended, on the following grounds:

1. Registrant, Passport Software, Inc. ("Registrant") is a corporation organized under the laws of the States of Illinois, and has a business address of 3801 West Lake Ave., Suite 301, Glenview, Illinois, 60026.

2. Registrant is the owner of Registration No. 3,886,603 for the mark REALWORLD for the following Class 42 services:

- a. Advisory services in the field of product development and quality improvement of software;
- b. Application service provider (ASP) featuring software for use business accounting and management;
- c. Application service provider (ASP), namely, hosting computer software applications of others;
- d. Application service provider featuring software for providing an on-line database in the field of transaction processing to upload transactional data, provide statistical analysis, and produce notifications and reports;
- e. Application service provider, namely, providing, hosting, managing, developing, and maintaining applications, software, websites, and databases in the fields of personal productivity, wireless communication, mobile information access, and remote data management for wireless delivery of content to handheld computers, laptops and mobile electronic devices;
- f. Computer network design and computer software design for the business accounting and management;

- g. Computer service, acting as an application service provider in the field of knowledge management to host computer application software for creating searchable databases of information and data to allow users to perform, on-line, the collecting and analyzing of different types of opinion surveys;
- h. Computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for creating searchable databases of information and data;
- i. Computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for searching and retrieving information from databases and computer networks;
- j. Computer service, 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;
- k. Computer software consultancy;
- l. Computer software consultation;
- m. Computer software design for others;
- n. Computer software design, computer programming, or maintenance of computer software;
- o. Computer software development;
- p. Consultancy in the field of software design;

- q. Consultation services in the fields of selection, implementation and use of computer hardware and software systems for others;
- r. Consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others;
- s. Customization of computer hardware and software;
- t. Data automation and collection service using proprietary software to evaluate, analyze and collect service data;
- u. Design and development of computer hardware and software;
- v. Design and development of on-line computer software systems;
- w. Design, development and implementation of software;
- x. Development, updating and maintenance of software and data bases;
- y. Installation of computer software;
- z. Maintenance of computer software;
- aa. Periodic upgrading of computer software for others;
- bb. Providing on-line non-downloadable software for business accounting and management;
- cc. Technical support services, namely, troubleshooting of computer hardware and software problems;
- dd. Technical support services, namely, troubleshooting of computer software problems;
- ee. Technical support, namely, providing back-up computer programs and facilities;
- ff. Up-dating of computer software; and

gg. Updating of computer software for others," in class 42.

3. Registration No. 3,886,603 is resulting from Application No. 77/221,253, filed July 3, 2007, and registered on Dec. 7, 2010. Registration is based on use of the mark in commerce in the United States.

4. Petitioner, Xperiel, Inc. is engaged in the development of computer application software for use by brand owners for promotional purposes and for consulting services related to application software in Class 42.

5. On January 27, 2015, Petitioner filed an application to register REAL WORLD WEB with the USPTO. The application was assigned Ser. No. 86/176,100.

6. Petitioner's application was refused registration because of a likelihood of confusion with the mark in U.S. Reg. No. 3,886,803. Because Registrant's registration, No. 3,886,803 has been cited against Petitioner's application as a ground for refusal, Petitioner has been harmed by Registrant's registration and will continue to be so harmed.

7. Registration No. 3,886,803, was registered on December 7, 2010, which is more than three years and less than five years from the date of this petition.

Total Abandonment

8. On information and belief, Registrant has abandoned use of the REALWORLD mark entirely.

9. Registrant has transitioned to use of the mark PASSPORT BUSINESS SOLUTIONS for services previously provided under the REALWORLD mark.

10. Any further use of REALWORLD made by Registrant is token use, made merely to reserve an interest in the mark and does not suffice to maintain Registrant's rights in REALWORLD.

11. On information and belief, Registrant has no intent to resume use in commerce of the mark REALWORLD in the United States in connection with the goods listed in the registration.

12. Abandonment is a basis of cancellation of a US trademark registration pursuant to 15 USC §1064 (3).

Partial Abandonment

13. Registrants' service description contains thirty-three separate service descriptions in Class 42 each separated by semi-colons.

14. Registrant has never provided services under the REALWORLD mark for each and every one of the services listed in its registration and thus, rights in the mark have been abandoned for the services which have never been provided or do not continue to be provided.

15. Upon information and belief the Registrant has never provided and does not now provide advisory services in the field of product development for others under the REALWORLD trademark.

16. Upon information and belief the Registrant has never provided and does not now provide advisory services in the field of quality improvement of software for others under the REALWORLD trademark.

17. Upon information and belief the Registrant has never provided and does not now provide application service provider services for others under the REALWORLD trademark.

18. Upon information and belief the Registrant has never provided and does not now provide advisory services in the field of product development for others under the REALWORLD trademark.

19. Upon information and belief the Registrant does not provide hosting, managing, developing or maintenance of applications, software, website or databases in the field of personal productivity, wireless communications, mobile information access and remote data management for wireless delivery of content for others under the REALWORLD trademark.

20. Upon information and belief the Registrant does not provide computer network design for others under the REALWORLD trademark.

21. Upon information and belief the Registrant does not provide computer software consultancy or consultation for others under the REALWORLD trademark.

22. Upon information and belief the Registrant does not provide computer software design for others under the REALWORLD trademark.

23. Upon information and belief the Registrant does not provide computer programming for others under the REALWORLD trademark.

24. Upon information and belief the Registrant does not provide computer maintenance for others under the REALWORLD trademark.

25. Upon information and belief the Registrant does not provide consultation services in the fields of selection, implementation and use of computer hardware and software systems for others under the REALWORLD trademark.

26. Upon information and belief the Registrant does not provide customization of computer hardware and software for others under the REALWORLD trademark.

27. Upon information and belief the Registrant does not provide design and development of computer hardware for others under the REALWORLD trademark.

28. Upon information and belief the Registrant does not provide design and development of computer software for others under the REALWORLD trademark.

29. Upon information and belief the Registrant does not provide design, development and implementation of software for others under the REALWORLD trademark.

30. Upon information and belief the Registrant does not provide development, updating and maintenance of software and data bases for others under the REALWORLD trademark.

31. Upon information and belief the Registrant does not provide installation of computer software for others under the REALWORLD trademark.

32. Upon information and belief the Registrant does not provide maintenance of computer software for others under the REALWORLD trademark.

33. Upon information and belief the Registrant does not provide periodic upgrading of computer software for others under the REALWORLD trademark.

34. Upon information and belief the Registrant does not provide technical support services, namely, troubleshooting of computer hardware and software problems for others under the REALWORLD trademark.

35. Upon information and belief the Registrant does not provide technical support namely, providing back-up computer programs and facilities for others under the REALWORLD trademark.

36. Upon information and belief the Registrant does not provide updating of computer software for others under the REALWORLD trademark.

37. The Petitioner requests that if the Board find that the mark has not been abandoned completely, that the registration be limited under 15 USC §1068 to the services on which the mark is actually being used.

Fraud

38. The Registrant attested to use of the mark REALWORLD on all the services listed in Paragraph 2 in a Statement of Use signed by John A. Miller on March 8, 2010.

39. As of March 8, 2010, the mark REALWORLD was not in use on all the services listed in the Statement of Use.

40. Registrant, through President and Signatory John A. Miller, knew that the mark was not in use on all the services listed.

41. Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application with intent to deceive the USPTO.

42. The registration with respect to the un-used services was procured on the basis of fraud against the Trademark Office by submitting a knowingly false Statement of Use to the USPTO on March 8, 2010.

Petition

43. Wherefore, Petitioner prays that the present petition be granted and registration of the REALWORLD mark be cancelled in whole or part.

Dated: March 12, 2015

Xperiel, Inc.

By its attorneys,



Steven A. Abreu, Esq.
Sunstein Kann Murphy & Timbers LLP
125 Summer Street
Boston, MA 02110-1618
617-443-9292

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Petition for Cancellation has been served on Mr. John A. Miller, correspondent of record for Registrant, by overnight mail on March 12, 2015, to John Miller, Passport Software, Inc. 181 Waukegan Road, Ste. 200, Northfield, IL 60093.



Steven A. Abreu, Esq.