

ESTTA Tracking number: **ESTTA689720**

Filing date: **08/14/2015**

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	Kamal Karmakar		
Entity	Individual	Citizenship	INDIA
Address	P.O. Box 502586 Dubai, 73000 UNITED ARAB EMIRATES		

Attorney information	Bruce Margulies Neifeld IP Law, PC 4813-B Eisenhower Ave. Alexandria, VA 22304 UNITED STATES bmargulies@neifeld.com Phone:7034150012 ext 102		
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Registration Subject to Cancellation

Registration No	4657862	Registration date	12/16/2014
International Registration No.	NONE	International Registration Date	NONE
Registrant	Vend Limited 12 Heather Street, Parnell Auckland, NEW ZEALAND		

Goods/Services Subject to Cancellation

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Computer software, namely, business management software, business administration software, point-of-sale software, inventory management software, customer management software, customer loyalty software, financial transactions software, electronic funds transfer and payment software, sales management software, stock management software, product management software, supply chain management software, purchase order software, stock-take software, data management software and hardware integration software; computer software for the provision of point-of-sale transactions, inventory management and customer management; downloadable computer software for the provision of point-of-sale transactions, inventory management and customer management; computer application software for the provision of point-of-sale transactions, inventory management and customer management</p>
<p>Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Business management services; business administration services; data collection, management and processing services relating to business management; compilation of information into computer databases; inventory control and management services, including computerized inventory control and management; advisory, consultancy and information services for the aforesaid</p>
<p>Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are cancelled, namely: Financial transaction services,</p>

namely, electronic funds transfer; financial payment services, namely, providing secure commercial transactions and payment options; providing electronic processing of electronic funds transfer, credit card, debit card, electronic check and electronic payments; bill payment administration services; on-line bill payment services provided through a website or secure internet connection; advisory, consultancy and information services for the aforesaid

Class 039. First Use: 0 First Use In Commerce: 0
All goods and services in the class are cancelled, namely: Electronic storage of data; advisory, consultancy and information services for the aforesaid

Class 042. First Use: 0 First Use In Commerce: 0
All goods and services in the class are cancelled, namely: Rental of software; providing an on-line website featuring and providing temporary use of non-downloadable computer software and software applications for use in relation to the provision of business management and administration, point-of-sale transactions, inventory management and customer management; design and development of computer software and computer software for user interface design; technical support services for computer software, namely, installation, maintenance, and repair of computer software and troubleshooting of computer software problems; computer software security services, namely, programming and software installation, repair, maintenance and updating services; advisory, consultancy and information services for the aforesaid

Grounds for Cancellation

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	86542141	Application Date	02/22/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	IVEND		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2004/02/16 First Use In Commerce: 2004/02/16 COMPUTER SOFTWARE FOR COMPUTER SYSTEM AND APPLICATION DEVELOPMENT, DEPLOYMENT AND MANAGEMENT</p> <p>Class 042. First use: First Use: 2004/02/16 First Use In Commerce: 2004/02/16 COMPUTER SERVICES, COMPUTER PROGRAMMING SERVICES, COMPUTER CONSULTANCY AND TECHNICAL SUPPORT; ARRANGING and CONDUCTING CONFERENCES AND EXHIBITIONS ALL RELATING TO COMPUTING</p>		

U.S. Registration No.	4635313	Application Date	08/05/2013
Registration Date	11/11/2014	Foreign Priority Date	NONE
Word Mark	IVEND POS		
Design Mark	iVend POS		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2004/02/16 First Use In Commerce: 2004/02/16</p> <p>Computer operating system programs and utility software; computer application software for wireless telecommunications for use with wireless devices; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; software for allowing communication and interaction between phones, mobile devices, televisions, videogame consoles, media players, computers, digital media hubs, and audiovisual devices; computer software for use by computer network administrators to deploy and manage application software and network server software; computer network server software for managing user content on computer networks and global computer networks; computer software for managing secure communications over computer networks and global computer networks; computer software for developing, managing and operating intranet sites; computer network operating software and utility software; computer software development tools for network servers and applications; computer software for inventorying and monitoring computer hardware and software assets and use within an organization; computer application programs and operating system programs for use with communications servers; computer programs for managing communications and data exchange between computers and electronic devices; operating systems software for use in playing electronic games; computer hardware and peripherals; computer keyboards; computer mice and wireless computer mice; wireless communications devices, namely, mobile phones, cellular telephones, personal digital assistants, and hand-held computers; hardware for telecommunications for connecting devices via in-home phone and electrical wiring, namely, computer networks hubs, computer servers, set-top boxes, computer switches and computer routers designed to provide in-home voice over internet protocol (VOIP) communications; computer and video game systems devices, namely, electronic sensor devices, cameras, projectors, headphones, and microphones</p>		

U.S. Registration No.	4635314	Application Date	08/05/2013
Registration Date	11/11/2014	Foreign Priority Date	NONE
Word Mark	IVEND RETAIL		
Design Mark	iVend Retail		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2004/02/16 First Use In Commerce: 2004/02/16		

	<p>Computer operating system programs and utility software; computer application software for wireless telecommunications for use with wireless devices; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; software for allowing communication and interaction between phones, mobile devices, televisions, videogame consoles, media players, computers, digital media hubs, and audiovisual devices; computer software for use by computer network administrators to deploy and manage application software and network server software; computer network server software for managing user content on computer networks and global computer networks; computer software for managing secure communications over computer networks and global computer networks; computer software for developing, managing and operating intranet sites; computer network operating software and utility software; computer software development tools for network servers and applications; computer software for inventorying and monitoring computer hardware and software assets and use within an organization; computer application programs and operating system programs for use with communications servers; computer programs for managing communications and data exchange between computers and electronic devices; operating systems software for use in playing electronic games; computer hardware and peripherals; computer keyboards; computer mice and wireless computer mice; wireless communications devices, namely, mobile phones, cellular telephones, personal digital assistants, and hand-held computers; hardware for telecommunications for connecting devices via in-home phone and electrical wiring, namely, computer networks hubs, computer servers, set-top boxes, computer switches and computer routers designed to provide in-home voice over internet protocol (VOIP) communications; computer and video game systems devices, namely, electronic sensor devices, cameras, projectors, headphones, and microphones</p>
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Attachments	<p>86542141#TMSN.png(bytes) 86028301#TMSN.png(bytes) 86028310#TMSN.png(bytes) PetitionToCancel_8-11-2015c.pdf(72767 bytes)</p>
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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	/BruceMargulies/
Name	Bruce Margulies
Date	08/14/2015

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

In the matter of Trademark Registration No. 4657862

Petition to Cancel No: Filed herewith

For the mark “VEND (and design)”

Kamal Karmakar,

Petitioner

v.

Vend Limited,

Registrant

PETITION TO CANCEL

Kamal Karmakar, with an address at P.O. Box 502586, Dubai 73000, UNITED ARAB EMIRATES (“Petitioner”) believes he is damaged by registration of the mark shown in Registration No. 4657862 (the “Petitioned Registration”), filed by Vend Limited, 12 Heather Street, Parnell, Auckland, NEW ZEALAND (“Registrant”) and petitions to cancel the same. The required fee for the filing of this Petition to cancel is submitted herewith. If any additional fees are due, please charge said fees to Deposit Account No: 50-2106.

The grounds for the petition to cancel are as follows:

COUNT 1 - Priority and Likelihood of Confusion Merely Descriptive: Trademark Act

Section 2(d)

1. Prior to the filing date and first alleged use of the Petitioned Registration, Petitioner has been and now is engaged in the development and practice of selling goods comprising, among other goods:

“COMPUTER SOFTWARE FOR COMPUTER SYSTEM AND APPLICATION DEVELOPMENT, DEPLOYMENT AND MANAGEMENT” in class 009, for “Technical support services, namely, troubleshooting in the nature of the repair of computer hardware” in class 037, and for “COMPUTER SERVICES, COMPUTER PROGRAMMING SERVICES, COMPUTER CONSULTANCY AND TECHNICAL SUPPORT; ARRANGING and CONDUCTING CONFERENCES AND EXHIBITIONS ALL RELATING TO COMPUTING” in class 042; and “Computer operating system programs and utility software; computer application software for wireless telecommunications for use with wireless devices; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; software for allowing communication and interaction between phones, mobile devices, televisions, video game consoles, media players, computers, digital media hubs, and audiovisual devices; computer software for use by computer network administrators to deploy and manage application software and network server software; computer network server software for managing user content on computer networks and global computer networks; computer software for managing secure communications over computer networks and global computer networks; computer software for developing, managing and

operating intranet sites; computer network operating software and utility software; computer software development tools for network servers and applications; computer software for inventorying and monitoring computer hardware and software assets and use within an organization; computer application programs and operating system programs for use with communications servers; computer programs for managing communications and data exchange between computers and electronic devices; operating systems software for use in playing electronic games; computer hardware and peripherals; computer keyboards; computer mice and wireless computer mice; wireless communications devices, namely, mobile phones, cellular telephones, personal digital assistants, and hand-held computers; hardware for telecommunications for connecting devices via in-home phone and electrical wiring, namely, computer networks hubs, computer servers, set-top boxes, computer switches and computer routers designed to provide in-home voice over internet protocol (VOIP) communications; computer and video game systems devices, namely, electronic sensor devices, cameras, projectors, headphones, and microphones” in class 009.

2. Since at least as early as February 16, 2004, Petitioner has promoted its goods/services using common law trademarks containing “IVEND”, “IVEND POS”, and “IVEND RETAIL”.

3. Petitioner is owner of US trademark Application No. 86542141 for “IVEND”, filed February 22, 2015, with a date of first use at least as early as February 16, 2004 for “COMPUTER SOFTWARE FOR COMPUTER SYSTEM AND APPLICATION DEVELOPMENT, DEPLOYMENT AND MANAGEMENT” in class 009, for “Technical

support services, namely, troubleshooting in the nature of the repair of computer hardware” in class 037, and for “COMPUTER SERVICES, COMPUTER PROGRAMMING SERVICES, COMPUTER CONSULTANCY AND TECHNICAL SUPPORT; ARRANGING and CONDUCTING CONFERENCES AND EXHIBITIONS ALL RELATING TO COMPUTING” in class 042.

4. Petitioner is owner of US trademark Registration No. 4635313 for “IVEND POS”, registered November 11, 2014, with a date of first use of at least as early as February 16, 2004 for “Computer operating system programs and utility software; computer application software for wireless telecommunications for use with wireless devices; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; software for allowing communication and interaction between phones, mobile devices, televisions, video game consoles, media players, computers, digital media hubs, and audiovisual devices; computer software for use by computer network administrators to deploy and manage application software and network server software; computer network server software for managing user content on computer networks and global computer networks; computer software for managing secure communications over computer networks and global computer networks; computer software for developing, managing and operating intranet sites; computer network operating software and utility software; computer software development tools for network servers and applications; computer software for inventorying and monitoring computer hardware and software assets and use within an organization; computer application programs and

operating system programs for use with communications servers; computer programs for managing communications and data exchange between computers and electronic devices; operating systems software for use in playing electronic games; computer hardware and peripherals; computer keyboards; computer mice and wireless computer mice; wireless communications devices, namely, mobile phones, cellular telephones, personal digital assistants, and hand-held computers; hardware for telecommunications for connecting devices via in-home phone and electrical wiring, namely, computer networks hubs, computer servers, set-top boxes, computer switches and computer routers designed to provide in-home voice over internet protocol (VOIP) communications; computer and video game systems devices, namely, electronic sensor devices, cameras, projectors, headphones, and microphones” in class 009.

5. Petitioner is owner of US trademark Registration No. 4635314 for “IVEND RETAIL”, registered November 11, 2014, with a date of first use of at least as early as February 16, 2004 for “Computer operating system programs and utility software; computer application software for wireless telecommunications for use with wireless devices; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks; software for allowing communication and interaction between phones, mobile devices, televisions, video game consoles, media players, computers, digital media hubs, and audiovisual devices; computer software for use by computer network administrators to deploy and manage application software and network server software; computer network server software for managing user content on computer networks and global computer networks; computer software

for managing secure communications over computer networks and global computer networks; computer software for developing, managing and operating intranet sites; computer network operating software and utility software; computer software development tools for network servers and applications; computer software for inventorying and monitoring computer hardware and software assets and use within an organization; computer application programs and operating system programs for use with communications servers; computer programs for managing communications and data exchange between computers and electronic devices; operating systems software for use in playing electronic games; computer hardware and peripherals; computer keyboards; computer mice and wireless computer mice; wireless communications devices, namely, mobile phones, cellular telephones, personal digital assistants, and hand-held computers; hardware for telecommunications for connecting devices via in-home phone and electrical wiring, namely, computer networks hubs, computer servers, set-top boxes, computer switches and computer routers designed to provide in-home voice over internet protocol (VOIP) communications; computer and video game systems devices, namely, electronic sensor devices, cameras, projectors, headphones, and microphones” in class 009.

6. As a result of Petitioner’s advertising and sales, which utilize Petitioner’s common law and federal US trademark application and registrations (“Petitioner’s Marks”), Petitioner has developed a significant amount of value and goodwill in Petitioner’s common law and federal US trademarks.

7. Petitioner has invested substantial monetary and other resources in Petitioner’s Marks,

which through advertising and promotion has resulted in tremendous value and recognition of Petitioner's Marks.

8. Registrant has registered the mark "VEND (and design)" on the Supplemental Register as Registration no. 4657862 on December 16, 2014, claiming priority to October 5, 2012 for "Computer software, namely, business management software, business administration software, point-of-sale software, inventory management software, customer management software, customer loyalty software, financial transactions software, electronic funds transfer and payment software, sales management software, stock management software, product management software, supply chain management software, purchase order software, stock-take software, data management software and hardware integration software; computer software for the provision of point-of-sale transactions, inventory management and customer management; downloadable computer software for the provision of point-of-sale transactions, inventory management and customer management; computer application software for the provision of point-of-sale transactions, inventory management and customer management" in class 009, "Business management services; business administration services; data collection, management and processing services relating to business management; compilation of information into computer databases; inventory control and management services, including computerized inventory control and management; advisory, consultancy and information services for the aforesaid" in class 035, "Financial transaction services, namely, electronic funds transfer; financial payment services, namely, providing secure commercial transactions and payment options; providing electronic processing of electronic funds transfer, credit card, debit card, electronic check and electronic

payments; bill payment administration services; online bill payment services provided through a website or secure internet connection; advisory, consultancy and information services for the aforesaid” in class 036, “Electronic storage of data; advisory, consultancy and information services for the aforesaid” in class 039, and “Rental of software; providing an online website featuring and providing temporary use of non-downloadable computer software and software applications for use in relation to the provision of business management and administration, point-of-sale transactions, inventory management and customer management; design and development of computer software and computer software for user interface design; technical support services for computer software, namely, installation, maintenance, and repair of computer software and troubleshooting of computer software problems; computer software security services, namely, programming and software installation, repair, maintenance and updating services; advisory, consultancy and information services for the aforesaid” in class 042.

9. There is no issue as to priority. Registrant acquired no rights in Registration no. 4657862 before Petitioner acquired rights in Petitioner’s Marks.

10. Petitioner uses Petitioner’s Marks to offer closely related services and products as those listed in Registration no. 4657862 . As such, Registrant’s planned or actual use of its “VEND (and design)” mark in connection with the goods/service listed in Registration no. 4657862 is likely to cause confusion with Petitioner’s Marks.. Petitioner’s Marks and Registration no. 4657862 both have “VEND” in common, which constitutes a distinctive aspect of each mark. In addition, the goods/services in Petitioner’s Marks and the goods/services in Registration no.

4657862 operate through the same channels of trade.

11. In view of the similarity and related nature between the goods/services in Registration no. 4657862 and the goods/services of Petitioner's Marks, Registrant's use of the trademark in Registration no. 4657862 is likely to result in confusion, mistake, or deception with Petitioner's Marks, or in the belief that Registrant or its services are in some way legitimately connected with, licensed or approved by Petitioner.

12. Accordingly, Registrant's proposed use of the goods/services in Registration no. 4657862 suggests that Registrant is planning to trade off the valuable goodwill that Petitioner has developed in Petitioner's Marks. Accordingly, Petitioner will be damaged by Registration no. 4657862 because consumers will be likely to believe, falsely, that Registrant's services are authorized, sponsored or approved by Petitioner or that Registrant is otherwise affiliated or connected with Petitioner, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

13. Registration no. 4657862 will damage Petitioner because Registrant's use of Registration no. 4657862 would be confusingly similar to Petitioner's Mark being used on closely related goods/services. As such, Applicant's proposed or actual use of the goods/services in Registration no. 4657862 is likely to cause confusion, deception, and/or mistake among the consuming public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

14. Petitioner will be further damaged by Registration no. 4657862 because such

registration will support and assist Registrant in the confusing and misleading use of the “VEND (and design)” mark, and will give color of exclusive statutory rights to Registrant in violation and derogation of the prior and superior rights of Petitioner.

15. Petitioner’s first use of Petitioner’s Marks predate the actual date of first use in commerce or any claim of priority in the United States of Registration no. 4657862.

16. Petitioner’s use of Petitioner’s Marks has been valid and continuous since any effective date of Registration no. 4657862 and has not been abandoned.

17. Registrant’s use and registration of Registration no. 4657862 is without Petitioner’s consent.

18. The registration of Registration no. 4657862 for the goods/services stated in Registration no. 4657862 would be inconsistent with Petitioner’s rights in Petitioner Marks, and will cause damage to Petitioner.

COUNT 2 - Merely Descriptive: Trademark Act Section 2(d), 15 USC Section 1052(e)

19. Petitioner realleges and incorporates by reference herein all paragraphs of this Complaint as if fully repeated herein.

20. On April 22, 2014, the USPTO issued an office action in Application No. 85896586,

which matured into Registration no. 4657862, rejecting Application No. 85896586 as being merely descriptive.

21. Following the April 22, 2014 rejection, Registrant amended Application No. 85896586 to the Supplemental Register.

22. Registrant's "IVEND (and design)" Mark merely describes a feature, purpose or use of applicant's goods and/or services.

23. Registrant's "IVEND (and design)" Mark immediately conveys knowledge of a quality, feature, function, or characteristic of Registrant's claimed goods/services.

24. Registrant's "IVEND (and design)" Mark, when used on or in connection with the goods/services of Registrant, is merely descriptive.

WHEREFORE, Registration No. 4657862 by Registrant of the mark “VEND (and design)” is damaging to Petitioner and should be withdrawn.

WHEREFORE, Registrant’s “IVEND (and design)” Mark in Registration No. 4657862 is merely deceptive.

Petitioner prays that Registration No. 4657862 be withdrawn, and that this Petition to Cancel be sustained in favor of Petitioner.

Respectfully submitted,

/BruceMargulies/

8/14/2015

Bruce T. Margulies
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Alexandria, VA 22304
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Attorney of Record for Petitioner

Date

Certificate of Service

I certify that on the date noted below, I caused a copy of the foregoing Petition to Cancel to be transmitted by First Class U.S. Mail to the Registrant at the following address:

PAUL A. MCLEAN
DLA PIPER LLP (US)
2000 UNIVERSITY AVE
EAST PALO ALTO, CALIFORNIA 94303-2214
UNITED STATES

8/14/2015
Date

/BruceMargulies/
Bruce T. Margulies

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