

ESTTA Tracking number: **ESTTA765613**

Filing date: **08/19/2016**

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	Smartrac IP B.V.		
Entity	limited liability company	Citizenship	The Netherlands
Address	Strawinskylaan 851 NL-1077 XX Amsterdam, NETHERLANDS		

Domestic Representative	Cynthia A. Moyer Attorney Fredrikson & Byron, P.A. 200 South Sixth Street Suite 4000 Minneapolis, MN 55402 UNITED STATES cmoyer@fredlaw.com, lrand@fredlaw.com, ip@fredlaw.com, lmyers@fredlaw.com Phone:612-492-7167
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Registration Subject to Cancellation

Registration No	5005230	Registration date	07/19/2016
Registrant	Imagequix, Inc. 3523 Pelham Road Greenville, SC 29615 UNITED STATES		

Goods/Services Subject to Cancellation

Class 042. First Use: 2016/05/03 First Use In Commerce: 2016/05/03 All goods and services in the class are cancelled, namely: Providing on-line non-downloadable software for administration and management of digital image capture, namely, storing, organizing, viewing, editing and identifying captured digital images
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute	Trademark Act Sections 14(3) and 2(a)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.	86325975	Application Date	07/01/2014
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	SMART COSMOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 software applications, namely, operating software for operating encoding apparatus, reading apparatus, monitors, and screens, all for use with radio frequency identification apparatuses; software applications, namely, operating software for encoding apparatus and reading apparatus, and monitors and screens therefore, for cash registers, calculating machines, data processing equipment and computers, for transponder cards and chip cards, for programmable radio frequency identification (RFID) transponders in the form of contact or non-contact chip cards with an integrated microchip for access systems and fare payment systems in the field of identification applications and air ticket applications, for electronic key transponders with an integrated microchip for access systems in the field of cashless payment systems and customer acquisition and identification, for disc-type tag transponder labels in the nature of transponder ski pass tickets with an integrated microchip for parking systems for use in the leisure industry, and for industrial applications, for adhesive laminate inlay transponders with an integrated microchip for use in access systems, and automatic fare-collection systems, for adhesive laminate inlay transponders with an integrated microchip for use as air tickets for identification purposes, for transponders in the form of pre-embossed or pre-laminated chip cards with an integrated microchip for use in the production of combination cards for access systems, for automatic fare collection, identification systems, electronic money exchanges, cashless sales systems and portable database systems, for transponders in the form of programmed devices for implanting under the skin for identifying animals, for transponders in the form of attachable signboard tags with an integrated microchip for identifying trees, telegraph poles and similar objects, and for use in the art sector to identify works of arts, copies of the original and restored works of art, for transponder tags in the form of contact and non-contact paper labels with an integrated microchip for use in the management of supply chains, in production supervision, luggage identification, express parcel services, and goods transport services, for use in preventing fraud and the identification of works of art, and for transponder tags in the form of adhesive labels with an integrated microchip for identifying industrial gas cylinders; all the aforesaid products other than for the field of polyurethane, injection moulding and extrusion; all the aforesaid goods other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animals</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 Scientific research and industrial research in the field of design, manufacture and application of radio frequency identification (RFID) and near field communication (NFC) apparatus, including transponders, and the processing, authentication, encryption, transmission and storage of data generated by such devices; Scientific research and industrial research in the field of security, access, authorization, authentication, encryption, and identification of data related to systems</p>		

	<p>which involve NFC tags, NFC capable devices, namely, NFC enabled cell phones, smart phones and tablets; computer programming in the field of mobile applications, which handle data assigned to RFID tags or NFC tags, including cloud computing software for such applications; technological consultancy in the field of troubleshooting of computer software for use in issuance and management of digital certificates or encryption of authentication and identification data used in NFC tags and RFID tags including digital credentials and document authentication data; electrical and electronic engineering, namely, planning, design and operation of computer data bases, which store information, related to a plurality of RFID tags or NFC tags; electrical and electronic engineering, namely, development, integration and operation of computer systems and cloud computing solutions to support issuance and management of digital certificates for NFC tags and NFC enabled devices, namely, NFC enabled cell phones, smart phones and tablets; programming services, development, customization and installation of computer software applications for operating RFID apparatus and NFC tags and for processing, transferring via networks and storing data related to the aforementioned devices; programming services, development, customization and installation of computer software applications for the issuance and management of digital certificates for RFID tags, NFC tags and NFC enabled devices, programming services, development, customization and installation of computer software applications for providing extended storage mechanisms of digital product data assigned to NFC tags or RFID tags; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused automated workflow capabilities triggered by any type of user or reader interaction with the tags; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused analytical services to include analysis of past interactions and projections of future interactions; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused advertising and commercial brand management services; programming, development and application of programs and software, in particular for databases, which databases store data related to a plurality of radio frequency identification apparatus; all of the aforesaid products other than for the field of polyurethane, injection molding and extrusion; all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animals</p>
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Attachments	86325975#TMSN.png(bytes) Advotec Smartrac v. Imagequix Smart Tag Petition to Cancel.pdf(61987 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	/Cynthia A. Moyer/
Name	Cynthia A. Moyer
Date	08/19/2016

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

In the Matter of
U.S. Reg. No.: 5005230
For the Mark: SMART TAG
Date Registered: July 19, 2016

Smartrac IP B.V.,

Cancellation No. _____

Petitioner,

v.

Imagequix, Inc.,

Registrant.

PETITION TO CANCEL

Petitioner, Smartrac IP B.V. believes that it is or will be damaged by Registration No. 5005230, and hereby petitions to cancel the same. The grounds for cancellation are as follows:

1. Petitioner is a limited liability company organized under the laws of The Netherlands, with its principal place of business located at Strawinskylaan 851, NL-1077 XX, Amsterdam, The Netherlands.
2. On information and belief, Registrant Imagequix, Inc. is a corporation organized under the laws of South Carolina, with its principal place of business located at 3523 Pelham Road, Greenville, South Carolina 29615.
3. Petitioner is the owner of the common law trademark SMART COSMOS, and owner of U.S. Application No. 86325975 for the trademark SMART COSMOS, filed on July 1,

2014 (together Petitioner's "Mark"), for the following goods:

IC 009: software applications, namely, operating software for operating encoding apparatus, reading apparatus, monitors, and screens, all for use with radio frequency identification apparatuses; software applications, namely, operating software for encoding apparatus and reading apparatus, and monitors and screens therefore, for cash registers, calculating machines, data processing equipment and computers, for transponder cards and chip cards, for programmable radio frequency identification (RFID) transponders in the form of contact or non-contact chip cards with an integrated microchip for access systems and fare payment systems in the field of identification applications and air ticket applications, for electronic key transponders with an integrated microchip for access systems in the field of cashless payment systems and customer acquisition and identification, for disc-type tag transponder labels in the nature of transponder ski pass tickets with an integrated microchip for parking systems for use in the leisure industry, and for industrial applications, for adhesive laminate inlay transponders with an integrated microchip for use in access systems, and automatic fare-collection systems, for adhesive laminate inlay transponders with an integrated microchip for use as air tickets for identification purposes, for transponders in the form of pre-embossed or pre-laminated chip cards with an integrated microchip for use in the production of combination cards for access systems, for automatic fare collection, identification systems, electronic money exchanges, cashless sales systems and portable database systems, for transponders in the form of programmed devices for implanting under the skin for identifying animals, for transponders in the form of attachable signboard tags with an integrated microchip for identifying trees, telegraph poles and similar objects, and for use in the art sector to identify works of arts, copies of the original and restored works of art, for transponder tags in the form of contact and non-contact paper labels with an integrated microchip for use in the management of supply chains, in production supervision, luggage identification, express parcel services, and goods transport services, for use in preventing fraud and the identification of works of art, and for transponder tags in the form of adhesive labels with an integrated microchip for identifying industrial gas cylinders; all the aforesaid products other than for the field of polyurethane, injection moulding and extrusion; all the aforesaid goods other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animals

IC 042: Scientific research and industrial research in the field of design, manufacture and application of radio frequency identification (RFID) and near field communication (NFC) apparatus, including transponders, and the processing, authentication, encryption, transmission and storage of data generated by such devices; Scientific research and industrial research in the field of security, access, authorization, authentication, encryption, and identification of data related to systems which involve NFC tags, NFC capable devices, namely, NFC enabled cell phones, smart phones and tablets; computer programming in the field of mobile applications, which handle data assigned to RFID tags or NFC tags, including cloud computing software for such applications; technological consultancy in the field of troubleshooting of computer software for use in

issuance and management of digital certificates or encryption of authentication and identification data used in NFC tags and RFID tags including digital credentials and document authentication data; electrical and electronic engineering, namely, planning, design and operation of computer data bases, which store information, related to a plurality of RFID tags or NFC tags; electrical and electronic engineering, namely, development, integration and operation of computer systems and cloud computing solutions to support issuance and management of digital certificates for NFC tags and NFC enabled devices, namely, NFC enabled cell phones, smart phones and tablets; programming services, development, customization and installation of computer software applications for operating RFID apparatus and NFC tags and for processing, transferring via networks and storing data related to the aforementioned devices; programming services, development, customization and installation of computer software applications for the issuance and management of digital certificates for RFID tags, NFC tags and NFC enabled devices, programming services, development, customization and installation of computer software applications for providing extended storage mechanisms of digital product data assigned to NFC tags or RFID tags; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused automated workflow capabilities triggered by any type of user or reader interaction with the tags; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused analytical services to include analysis of past interactions and projections of future interactions; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused advertising and commercial brand management services; programming, development and application of programs and software, in particular for databases, which databases store data related to a plurality of radio frequency identification apparatus; all of the aforesaid products other than for the field of polyurethane, injection molding and extrusion; all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animals

4. On January 2, 2015, Registrant filed an intent-to-use application to register the mark SMART TAG, Application Serial No. 86508652. The Registrant subsequently amended the filing basis to an actual use application, citing a date of first use of May 3, 2016, and a date of first use in commerce of May 3, 2016.

5. On July 19, 2016, the United States Patent and Trademark Office issued Registration No. 5005230 for the mark to be used with the following goods:

IC 042: Providing on-line non-downloadable software for administration and management of digital image capture, namely, storing, organizing, viewing, editing and identifying captured digital images..

6. Petitioner's priority date for its Mark is long before any date of use or constructive date of use by Registrant of its mark.

7. Petitioner's Mark is inherently distinctive and is a strong mark and should be accorded the broad protection given to strong marks.

8. Use by Registrant of its mark is likely to cause confusion, mistake, or deception as to the source of origin, sponsorship, or approval of Registrant's goods in that purchasers or others are likely to believe that Registrant's goods are Petitioner's goods, or are in some way legitimately connected with, licensed by, or approved by Petitioner. Use by Registrant of its mark will continue to lessen the capacity of Petitioner's Mark to identify and distinguish goods made by Petitioner.

9. Use by Registrant of its mark is without Petitioner's consent or permission.

10. Registrant's trademark is so similar to Petitioner's Mark as to be likely to falsely suggest a connection between Registrant and Petitioner.

WHEREFORE, Petitioner believes that it will be damaged by the subject registration and prays that it be cancelled.

Please address all communications to Cynthia A. Moyer and Laura Myers, Fredrikson & Byron, P.A., 200 South Sixth Street, Suite 4000, Minneapolis, Minnesota 55402-1425.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the Petition to Cancel was served by First Class Mail, this 19th day of August, 2016, on:

The Registrant, Imagequix Inc., 3523 Pelham Road, Greenville, South Carolina 29615;
and

The correspondent of record, Douglas W. Kim, McNair Law Firm, P.A., P.O. Box 447,
Greenville, South Carolina 29602

/Cynthia A. Moyer/

Cynthia A. Moyer

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Generated on: This page was generated by TSDR on 2016-08-19 15:00:22 EDT

Mark: SMART COSMOS

SMART COSMOS

US Serial Number: 86325975

Application Filing Date: Jul. 01, 2014

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Published for Opposition

A pending trademark application has been examined by the Office and has been published in a way that provides an opportunity for the public to oppose its registration.

Status: Application has been published for opposition. The opposition period begins on the date of publication.

Status Date: Jul. 05, 2016

Publication Date: Jul. 05, 2016

Mark Information

Mark Literal Elements: SMART COSMOS

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "SMART"

Related Properties Information

Claimed Ownership of US Registrations: 3302678

Foreign Information

Foreign Registration Number: 013210414

Foreign Registration Date: Jan. 15, 2015

Foreign Application/Registration Country: EUROPEAN UNION

Foreign Expiration Date: Aug. 29, 2024

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: software applications, namely, operating software for operating encoding apparatus, reading apparatus, monitors, and screens, all for use with radio frequency identification apparatuses; software applications, namely, operating software for encoding apparatus and reading apparatus, and monitors and screens therefore, for cash registers, calculating machines, data processing equipment and computers, for transponder cards and chip cards, for programmable radio frequency identification (RFID) transponders in the form of contact or non-contact chip cards with an integrated microchip for access systems and fare payment systems in the field of identification applications and air ticket applications, for electronic key transponders with an integrated microchip for access systems in the field of cashless payment systems and customer acquisition and identification, for disc-type tag transponder labels in the nature of transponder ski pass tickets with an integrated microchip for parking systems for use in the leisure industry, and for industrial applications, for adhesive laminate inlay transponders with an integrated microchip for use in access systems, and automatic fare-collection systems, for adhesive laminate inlay transponders with an integrated microchip for use as air tickets for identification

purposes, for transponders in the form of pre-embossed or pre-laminated chip cards with an integrated microchip for use in the production of combination cards for access systems, for automatic fare collection, identification systems, electronic money exchanges, cashless sales systems and portable database systems, for transponders in the form of programmed devices for implanting under the skin for identifying animals, for transponders in the form of attachable signboard tags with an integrated microchip for identifying trees, telegraph poles and similar objects, and for use in the art sector to identify works of arts, copies of the original and restored works of art, for transponder tags in the form of contact and non-contact paper labels with an integrated microchip for use in the management of supply chains, in production supervision, luggage identification, express parcel services, and goods transport services, for use in preventing fraud and the identification of works of art, and for transponder tags in the form of adhesive labels with an integrated microchip for identifying industrial gas cylinders; all the aforesaid products other than for the field of polyurethane, injection moulding and extrusion; all the aforesaid goods other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animals

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 44(e)

For: Scientific research and industrial research in the field of design, manufacture and application of radio frequency identification (RFID) and near field communication (NFC) apparatus, including transponders, and the processing, authentication, encryption, transmission and storage of data generated by such devices; Scientific research and industrial research in the field of security, access, authorization, authentication, encryption, and identification of data related to systems which involve NFC tags, NFC capable devices, namely, NFC enabled cell phones, smart phones and tablets; computer programming in the field of mobile applications, which handle data assigned to RFID tags or NFC tags, including cloud computing software for such applications; technological consultancy in the field of troubleshooting of computer software for use in issuance and management of digital certificates or encryption of authentication and identification data used in NFC tags and RFID tags including digital credentials and document authentication data; electrical and electronic engineering, namely, planning, design and operation of computer data bases, which store information, related to a plurality of RFID tags or NFC tags; electrical and electronic engineering, namely, development, integration and operation of computer systems and cloud computing solutions to support issuance and management of digital certificates for NFC tags and NFC enabled devices, namely, NFC enabled cell phones, smart phones and tablets; programming services, development, customization and installation of computer software applications for operating RFID apparatus and NFC tags and for processing, transferring via networks and storing data related to the aforementioned devices; programming services, development, customization and installation of computer software applications for the issuance and management of digital certificates for RFID tags, NFC tags and NFC enabled devices, programming services, development, customization and installation of computer software applications for providing extended storage mechanisms of digital product data assigned to NFC tags or RFID tags; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused automated workflow capabilities triggered by any type of user or reader interaction with the tags; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused analytical services to include analysis of past interactions and projections of future interactions; programming services, development, customization and installation of computer software applications for providing NFC tag or RFID tag focused advertising and commercial brand management services; programming, development and application of programs and software, in particular for databases, which databases store data related to a plurality of radio frequency identification apparatus; all of the aforesaid products other than for the field of polyurethane, injection molding and extrusion; all the aforesaid goods/services other than in the field of measuring and determining the position, orientation and/or movement of objects, persons or animals

International Class(es): 042 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No

Currently Use: No

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: Yes

Amended 44E: Yes

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Smartrac IP B.V.

Owner Address: Strawinskylaan 851
1077 XX Amsterdam NETHERLANDS

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country Where Organized: NETHERLANDS

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Dean R. Karau

Docket Number: 50463

Attorney Primary Email Address: ip@fredlaw.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: DEAN R. KARAU
FREDRIKSON & BYRON, P.A.
200 S 6TH ST STE 4000
MINNEAPOLIS, MINNESOTA UNITED STATES 55402-1425

Phone: 6124927178

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Correspondent e-mail: ip@fredlaw.com dkarau@fredlaw.com lrand@fredlaw.com aw.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jul. 27, 2016	CHANGES/CORRECTIONS AFTER PUB APPROVAL ENTERED	67832
Jul. 27, 2016	ASSIGNED TO PETITION STAFF	67832
Jul. 15, 2016	TEAS POST PUBLICATION AMENDMENT RECEIVED	1111
Jul. 05, 2016	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 05, 2016	PUBLISHED FOR OPPOSITION	
Jun. 15, 2016	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jun. 01, 2016	1(B) BASIS DELETED; NEW BASIS REQUESTED	61813
May 03, 2016	NOTICE OF ALLOWANCE CANCELLED	61813
Jun. 01, 2016	PETITION TO DIRECTOR - CHANGE BASIS - GRANTED	67832
May 27, 2016	TEAS RESPONSE TO PETITION TO DIRECTOR INQUIRY	
May 17, 2016	PETITION INQUIRY LETTER MAILED	
May 16, 2016	ASSIGNED TO PETITION STAFF	67832
Apr. 27, 2016	TEAS PETITION TO AMEND BASIS RECEIVED	1111
Nov. 03, 2015	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Sep. 08, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Sep. 08, 2015	PUBLISHED FOR OPPOSITION	
Aug. 19, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 06, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	70138
Jul. 31, 2015	ASSIGNED TO LIE	70138
Jul. 21, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jul. 11, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jul. 10, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jul. 10, 2015	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Jun. 18, 2015	NOTIFICATION OF SUBSEQUENT FINAL EMAILED	
Jun. 18, 2015	SUBSEQUENT FINAL EMAILED	
Jun. 18, 2015	SUBSEQUENT FINAL REFUSAL WRITTEN	83706
May 11, 2015	NOTIFICATION OF FINAL REFUSAL EMAILED	
May 11, 2015	FINAL REFUSAL E-MAILED	
May 11, 2015	FINAL REFUSAL WRITTEN	83706
Apr. 13, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Apr. 13, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Apr. 13, 2015	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 17, 2014	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Oct. 17, 2014	NON-FINAL ACTION E-MAILED	6325
Oct. 17, 2014	NON-FINAL ACTION WRITTEN	83706
Oct. 09, 2014	ASSIGNED TO EXAMINER	83706
Sep. 29, 2014	TEAS AMENDMENT ENTERED BEFORE ATTORNEY ASSIGNED	88889
Sep. 29, 2014	TEAS VOLUNTARY AMENDMENT RECEIVED	
Aug. 28, 2014	TEAS AMENDMENT ENTERED BEFORE ATTORNEY ASSIGNED	88889
Aug. 28, 2014	TEAS VOLUNTARY AMENDMENT RECEIVED	

Jul. 08, 2014 NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM

Jul. 04, 2014 NEW APPLICATION ENTERED IN TRAM

TM Staff and Location Information

TM Staff Information

TM Attorney: ROACH, APRIL K

Law Office Assigned: LAW OFFICE 115

File Location

Current Location: INTENT TO USE SECTION

Date in Location: Jul. 27, 2016