

ESTTA Tracking number: **ESTTA866905**

Filing date: **12/22/2017**

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

Proceeding	92066968
Party	Plaintiff Software Freedom Law Center
Correspondence Address	DANIEL BYRNES SOFTWARE FREEDOM LAW CENTER 1995 BROADWAY 17TH FLOOR NEW YORK, NY 10023 UNITED STATES Email: dbyrnes@softwarefreedom.org
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Daniel Byrnes
Filer's email	dbyrnes@softwarefreedom.org
Signature	/Daniel Byrnes/
Date	12/22/2017
Attachments	sflc-motion-to-amend-pleadings.pdf(698980 bytes)

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

In the Matter of Registration No. 4,212,971

For the mark: SOFTWARE FREEDOM CONSERVANCY

Registered: September 25, 2012

----- X

Software Freedom Law Center, Inc.,

Petitioner,

v.

Software Freedom Conservancy, Inc.,

Registrant.

Cancellation No. 92066968

----- X

**PETITIONER’S MOTION FOR LEAVE TO AMEND AND TO TOLL THE TIME TO
RESPOND TO REGISTRANT’S MOTION FOR SUMMARY JUDGMENT**

Software Freedom Law Center, Inc., (“Petitioner”) moves this Board for leave to amend its Petition for Cancellation as to Registration 4,212,971 to plead a second ground for cancellation based on fraud, and to toll the time to respond to the Motion for Summary Judgment filed by Software Freedom Conservancy, Inc. (“Registrant”) on December 11, 2017. Leave to amend is warranted because the declarations of Software Freedom Conservancy, Inc. (“Registrant”) giving rise to this Motion were made after Petitioner filed its original Petition for Cancellation on September 22, 2017. This Motion for Leave to Amend is germane to Registrant’s pending Motion for Summary Judgment: three of the four affirmative defenses upon which Registrant relies will be rendered moot by the amended petition since laches, acquiescence and estoppel are not available as affirmative defenses to

claims of fraud. Consequently, Petitioner also moves this Board to toll Petitioner's time to respond to Registrant's Motion for Summary Judgment pending the Board's decision on Petitioner's motion to amend. Attached to this motion is Petitioner's proposed Amended Petition.

BACKGROUND

Petitioner filed its Petition for Cancellation on September 22, 2017. In it, Petitioner alleged in paragraph 32 that:

Registrant swore in both the Application and Response that "to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive."

In its Answer, dated November 2, 2017, Registrant responded: "Admitted, except that the statement was made by signatory, not the Registrant." The signatory was Registrant's general counsel, Anthony K. Sebro, Jr. Registrant's pleading indicates that its general counsel was not speaking for it in making these false statements.

However, on December 11, 2017, four days after the opening of discovery, Registrant filed a Motion for Summary Judgment accompanied by a declaration by Bradley M. Kuhn in support. Mr. Kuhn, Registrant's Executive Director stated in paragraphs 18 and 20 of his declaration:

18. On September 2, 2011, Software Freedom Conservancy offered the position of General Counsel to Anthony K. Sebro, Jr., which he subsequently accepted. Sebro is currently the General Counsel for Conservancy.

20. The first task that I assigned Sebro after he was hired was to review the trademark portfolio of Conservancy. Specifically, I asked Sebro to register trademarks

for any key brands and names that we and our projects were already using. This instruction led to Sebro filing an application for the subject SOFTWARE FREEDOM CONSERVANCY trademark on November 29, 2011, which ultimately issued as Reg. No. 4,212,971. It was published for opposition on July 10, 2012.

Petitioner now has evidence sufficient to allege, when taken together with the rest of the pleadings, that the fraud occurred deliberately by instruction of Mr. Kuhn, who had actual knowledge of the falsity of the declaration made in Registrant's application for the SOFTWARE FREEDOM CONSERVANCY Mark. Registrant's admission of this vital link between members of Registrant's board of directors, executive director and general counsel had not yet been obtained by Petitioner through discovery, as Registrant had filed its Motion for Summary Judgment just a few days after refusing to schedule the initial discovery conference before the December 7th deadline set by the board and before Petitioner had a chance to serve any discovery requests.

Registrant also submitted applications to the USPTO for two new trademarks on November 2, 2017 – the same day that Registrant filed its Answer with the TTAB in the instant action (Attachment 1). Registrant applied on a Section 1(b) intent-to-use basis for the word mark “The Software Conservancy” and for a design mark that includes the literal element “The Software Conservancy” in the same international classes and for the same goods and services as Registrant's contested SOFTWARE FREEDOM CONSERVANCY Mark. Registrant's sworn declaration before the TTAB that it has intent to use trademarks that omit the term “Freedom” but are otherwise the same as the mark that Registrant currently claims to own, evinces bad faith in Registrant's application.

This evidence shows that Registrant obtained the SOFTWARE FREEDOM CONSERVANCY mark by fraud, and Petitioner now requests that the Board grant Petitioner leave to amend its pleadings accordingly. Petitioner also requests that the Board toll the time to respond to Registrant's Motion for Summary Judgment pending the Board's decision on Petitioner's Motion to Amend.

ARGUMENT

Rule 15(a) of the Federal Rules of Civil Procedure provides that leave should be freely given to amend the pleadings when justice so requires. Petitioner is moving promptly to amend its petition after acquiring “information which would serve as the basis for an additional claim” from Registrant’s Answer, filings with the USPTO and Motion for Summary Judgment, as required by TBMP § 314. This first request by Petitioner to amend its pleadings is made in good faith and causes no undue prejudice or delay.

Petitioner should be granted leave to amend its pleadings during the suspension of the proceedings following Registrant’s Motion for Summary Judgment because Petitioner’s amendment would render moot most, if not all, of Registrant’s Motion and is therefore germane to it: “Examples of papers which are or may be germane to a motion for summary judgment include ... a motion for leave to amend a party’s pleading...” TBMP § 528.03.

CONCLUSION

Petitioner has shown good cause for the Board to grant leave to amend its petition and requests that such leave be granted and the attached Amended Petition be entered. Petitioner further requests that Petitioner’s time to respond to Registrant’s Motion for Summary Judgment be tolled pending the Board’s decision on Petitioner’s motion to amend its Petition.

Dated: December 22, 2017

New York, New York

Respectfully submitted,

/S/
Daniel Byrnes
Attorney for Petitioner
Software Freedom Law Center

1995 Broadway, 17th Floor
New York, New York 10023

dbyrnes@softwarefreedom.org

ATTACHMENT 1

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 87670034

Filing Date: 11/02/2017

NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	THE SOFTWARE CONSERVANCY
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	THE SOFTWARE CONSERVANCY
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Software Freedom Conservancy, Inc.
*STREET	137 Montague Street STE 380
*CITY	Brooklyn
*STATE (Required for U.S. applicants)	New York
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants)	11201-3548
PHONE	212-461-3245
EMAIL ADDRESS	trademark@sfconservancy.org
WEBSITE ADDRESS	https://sfconservancy.org
LEGAL ENTITY INFORMATION	
*TYPE	CORPORATION
* STATE/COUNTRY OF INCORPORATION	New York
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	009
	Downloadable cloud-computing software for media file

*IDENTIFICATION	management, object-oriented software engineering, messaging, software development tools, operating system utilities, operating system emulation, inventory management, graphics modeling, Braille displays, implementation of dynamic languages, print services, browser automation, operating systems programs in the field of education, and computer operating system tools for use in embedded systems, provided freely and openly licensed for the public good.
*FILING BASIS	SECTION 1(b)
*INTERNATIONAL CLASS	035
*IDENTIFICATION	Charitable services, namely, promoting public awareness of free, libre and open source software projects, and developing and defending the same
*FILING BASIS	SECTION 1(b)
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
ATTORNEY INFORMATION	
NAME	Anthony K. Sebro, Jr.
ATTORNEY DOCKET NUMBER	SFC0006
FIRM NAME	Software Freedom Conservancy
STREET	137 Montague Street STE 380
CITY	Brooklyn
STATE	New York
COUNTRY	United States
ZIP/POSTAL CODE	11201-3548
PHONE	212-461-3245
EMAIL ADDRESS	trademark@sfconservancy.org
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	
*NAME	Anthony K. Sebro, Jr.
FIRM NAME	Software Freedom Conservancy
*STREET	137 Montague Street STE 380
*CITY	Brooklyn
*STATE (Required for U.S. addresses)	New York

* COUNTRY	United States
* ZIP/POSTAL CODE	11201-3548
PHONE	212-461-3245
* EMAIL ADDRESS	trademark@sfconservancy.org;tony@sfconservancy.org
* AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
APPLICATION FILING OPTION	TEAS Plus
NUMBER OF CLASSES	2
FEE PER CLASS	225
* TOTAL FEE PAID	450
SIGNATURE INFORMATION	
* SIGNATURE	/aks/
* SIGNATORY'S NAME	Anthony K. Sebro, Jr.
* SIGNATORY'S POSITION	Attorney of Record, New York bar member
SIGNATORY'S PHONE NUMBER	212-461-3245
* DATE SIGNED	11/02/2017

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 87670034

Filing Date: 11/02/2017

To the Commissioner for Trademarks:

MARK: THE SOFTWARE CONSERVANCY (Standard Characters, see [mark](#))
The mark in your application is THE SOFTWARE CONSERVANCY.

The applicant, Software Freedom Conservancy, Inc., a corporation of New York, having an address of
137 Montague Street STE 380
Brooklyn, New York 11201-3548
United States
212-461-3245(phone)
trademark@sfconservancy.org (not authorized)

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 009: Downloadable cloud-computing software for media file management, object-oriented software engineering, messaging, software development tools, operating system utilities, operating system emulation, inventory management, graphics modeling, Braille displays, implementation of dynamic languages, print services, browser automation, operating systems programs in the field of education, and computer operating system tools for use in embedded systems, provided freely and openly licensed for the public good.
Intent to Use: The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services. (15 U.S.C. Section 1051(b)).

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 035: Charitable services, namely, promoting public awareness of free, libre and open source software projects, and developing and defending the same
Intent to Use: The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services. (15 U.S.C. Section 1051(b)).

For informational purposes only, applicant's website address is: <https://sfconservancy.org>

The applicant's current Attorney Information:

Anthony K. Sebro, Jr. of Software Freedom Conservancy 137 Montague Street STE 380
Brooklyn, New York 11201-3548
United States
212-461-3245(phone)
trademark@sfconservancy.org (authorized)

The attorney docket/reference number is SFC0006.

The applicant's current Correspondence Information:

Anthony K. Sebro, Jr.
Software Freedom Conservancy
137 Montague Street STE 380
Brooklyn, New York 11201-3548
212-461-3245(phone)
trademark@sfconservancy.org;tony@sfconservancy.org (authorized)

E-mail Authorization: I authorize the USPTO to send e-mail correspondence concerning the application to the applicant or the applicant's attorney, or the applicant's domestic representative at the e-mail address provided in this application. I understand that a valid e-mail address

must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in the loss of TEAS Plus status and a requirement to submit an additional processing fee of \$125 per international class of goods/services.

A fee payment in the amount of \$450 has been submitted with the application, representing payment for 2 class(es).

Declaration

Basis:

If the applicant is filing the application based on use in commerce under 15 U.S.C. § 1051(a):

- The signatory believes that the applicant is the owner of the trademark/service mark sought to be registered;
- The mark is in use in commerce on or in connection with the goods/services in the application;
- The specimen(s) shows the mark as used on or in connection with the goods/services in the application; and
- To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.

AND/OR

If the applicant is filing the application based on an intent to use the mark in commerce under 15 U.S.C. § 1051(b), § 1126(d), and/or § 1126(e):

- The signatory believes that the applicant is entitled to use the mark in commerce;
- The applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application; and
- To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.

To the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.

To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /aks/ Date: 11/02/2017

Signatory's Name: Anthony K. Sebro, Jr.

Signatory's Position: Attorney of Record, New York bar member

Signatory's Phone Number: 212-461-3245

Payment Sale Number: 87670034

Payment Accounting Date: 11/03/2017

Serial Number: 87670034

Internet Transmission Date: Thu Nov 02 18:19:16 EDT 2017

TEAS Stamp: USPTO/FTK-XXX.XX.XXX.XX-2017110218191634

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THE SOFTWARE CONSERVANCY

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 87670106

Filing Date: 11/02/2017

*NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.*

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	\\TICRS\EXPORT17\IMAGEOUT\17\876\701\87670106\xml1\FTK0002.JPG
*SPECIAL FORM	YES
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	THE SOFTWARE CONSERVANCY
*COLOR MARK	NO
*COLOR(S) CLAIMED (If applicable)	
*DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of a stylized drawing of a tree with a graphic model of a binary tree depicted in the tree's foliage, with the words "the software conservancy" centered below.
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	894 x 686
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Software Freedom Conservancy, Inc.
*STREET	137 Montague Street STE 380
*CITY	Brooklyn
*STATE (Required for U.S. applicants)	New York
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants)	11201-3548
PHONE	212-461-3245
EMAIL ADDRESS	trademark@sfconservancy.org
WEBSITE ADDRESS	https://sfconservancy.org

LEGAL ENTITY INFORMATION	
*TYPE	CORPORATION
* STATE/COUNTRY OF INCORPORATION	New York
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	009
*IDENTIFICATION	Downloadable computer software for media file management, object-oriented software engineering, messaging, software development tools, operating system utilities, operating system emulation, inventory management, graphics modeling, Braille displays, implementation of dynamic languages, print services, browser automation, operating systems programs in the field of education, and computer operating system tools for use in embedded systems, provided freely and openly licensed for the public good
*FILING BASIS	SECTION 1(b)
*INTERNATIONAL CLASS	035
*IDENTIFICATION	Charitable services, namely, promoting public awareness of free, libre and open source software projects, and developing and defending the same
*FILING BASIS	SECTION 1(b)
ADDITIONAL STATEMENTS SECTION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
* CONSENT (NAME/LIKENESS) (if applicable)	
* CONCURRENT USE CLAIM (if applicable)	
ATTORNEY INFORMATION	
NAME	Anthony K. Sebro, Jr.
ATTORNEY DOCKET NUMBER	SFC0007
FIRM NAME	Software Freedom Conservancy
STREET	137 Montague Street STE 380
CITY	Brooklyn
STATE	New York
COUNTRY	United States
ZIP/POSTAL CODE	11201-3548
PHONE	212-461-3245
EMAIL ADDRESS	trademark@sfconservancy.org
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	

*NAME	Anthony K. Sebro, Jr.
FIRM NAME	Software Freedom Conservancy
*STREET	137 Montague Street STE 380
*CITY	Brooklyn
*STATE (Required for U.S. addresses)	New York
*COUNTRY	United States
*ZIP/POSTAL CODE	11201-3548
PHONE	212-461-3245
*EMAIL ADDRESS	trademark@sfconservancy.org;tony@sfconservancy.org
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
APPLICATION FILING OPTION	TEAS Plus
NUMBER OF CLASSES	2
FEE PER CLASS	225
*TOTAL FEE PAID	450
SIGNATURE INFORMATION	
* SIGNATURE	/aks/
* SIGNATORY'S NAME	Anthony K. Sebro, Jr.
* SIGNATORY'S POSITION	Attorney of Record, New York bar member
SIGNATORY'S PHONE NUMBER	212-461-3245
* DATE SIGNED	11/02/2017

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 87670106

Filing Date: 11/02/2017

To the Commissioner for Trademarks:

MARK: THE SOFTWARE CONSERVANCY (stylized and/or with design, see [mark](#))

The mark in your application is THE SOFTWARE CONSERVANCY.

The mark consists of a stylized drawing of a tree with a graphic model of a binary tree depicted in the tree's foliage, with the words "the software conservancy" centered below.

The applicant, Software Freedom Conservancy, Inc., a corporation of New York, having an address of
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Brooklyn, New York 11201-3548
United States
212-461-3245(phone)
trademark@sfconservancy.org (not authorized)

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 009: Downloadable computer software for media file management, object-oriented software engineering, messaging, software development tools, operating system utilities, operating system emulation, inventory management, graphics modeling, Braille displays, implementation of dynamic languages, print services, browser automation, operating systems programs in the field of education, and computer operating system tools for use in embedded systems, provided freely and openly licensed for the public good
Intent to Use: The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services. (15 U.S.C. Section 1051(b)).

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 035: Charitable services, namely, promoting public awareness of free, libre and open source software projects, and developing and defending the same
Intent to Use: The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services. (15 U.S.C. Section 1051(b)).

For informational purposes only, applicant's website address is: <https://sfconservancy.org>

The applicant's current Attorney Information:

Anthony K. Sebro, Jr. of Software Freedom Conservancy 137 Montague Street STE 380
Brooklyn, New York 11201-3548
United States
212-461-3245(phone)
trademark@sfconservancy.org (authorized)

The attorney docket/reference number is SFC0007.

The applicant's current Correspondence Information:

Anthony K. Sebro, Jr.
Software Freedom Conservancy
137 Montague Street STE 380
Brooklyn, New York 11201-3548
212-461-3245(phone)

trademark@sfconservancy.org;tony@sfconservancy.org (authorized)

E-mail Authorization: I authorize the USPTO to send e-mail correspondence concerning the application to the applicant or the applicant's attorney, or the applicant's domestic representative at the e-mail address provided in this application. I understand that a valid e-mail address must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in the loss of TEAS Plus status and a requirement to submit an additional processing fee of \$125 per international class of goods/services.

A fee payment in the amount of \$450 has been submitted with the application, representing payment for 2 class(es).

Declaration

Basis:

If the applicant is filing the application based on use in commerce under 15 U.S.C. § 1051(a):

- The signatory believes that the applicant is the owner of the trademark/service mark sought to be registered;
- The mark is in use in commerce on or in connection with the goods/services in the application;
- The specimen(s) shows the mark as used on or in connection with the goods/services in the application; and
- To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.

AND/OR

If the applicant is filing the application based on an intent to use the mark in commerce under 15 U.S.C. § 1051(b), § 1126(d), and/or § 1126(e):

- The signatory believes that the applicant is entitled to use the mark in commerce;
 - The applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application; and
 - To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.
- To the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.
- To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.
- The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /aks/ Date: 11/02/2017

Signatory's Name: Anthony K. Sebro, Jr.

Signatory's Position: Attorney of Record, New York bar member

Signatory's Phone Number: 212-461-3245

Payment Sale Number: 87670106

Payment Accounting Date: 11/03/2017

Serial Number: 87670106

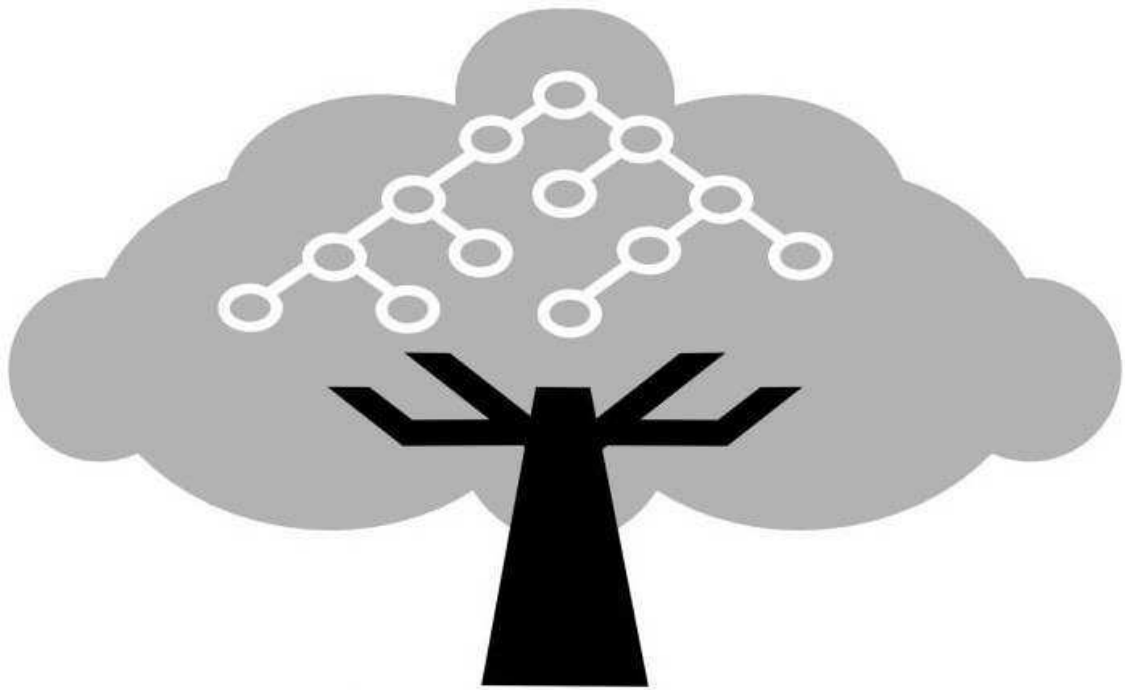
Internet Transmission Date: Thu Nov 02 19:00:20 EDT 2017

TEAS Stamp: USPTO/FTK-XXX.XX.XXX.XX-2017110219002045

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CC-5488-20171102182108704136



the software
conservancy

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

In the Matter of Registration No. 4,212,971

For the mark: SOFTWARE FREEDOM CONSERVANCY

Registered: September 25, 2012

----- X

Software Freedom Law Center, Inc.,

Petitioner,

v.

Software Freedom Conservancy, Inc.,

Registrant.

Cancellation No. 92066968

----- X

FIRST AMENDED PETITION FOR CANCELLATION

Software Freedom Law Center (“Petitioner”), a 501(c)(3) tax exempt not-for-profit corporation having its principal place of business at 1995 Broadway, 17th Floor, New York, NY 10023, believes that it has been and will continue to be damaged by U.S. Trademark Registration No. 4,212,971 for the mark SOFTWARE FREEDOM CONSERVANCY, and hereby petitions to cancel the same pursuant to Section 14 of the Lanham Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1064.

As grounds for cancellation, Petitioner alleges as follows:

1. Petitioner is a not-for-profit law firm that provides pro-bono legal services to protect and advance free and open source software (FOSS).
2. Petitioner is the owner of valid and subsisting United States Trademark Registration No.

3,913,979 on the Principal Register in the United States Patent and Trademark Office (“USPTO”) for the service mark SOFTWARE FREEDOM LAW CENTER (herinafter “SOFTWARE FREEDOM LAW CENTER Mark”) for LEGAL SERVICES, which issued on February 1, 2011, and has become incontestable within the meaning of Section 15 of the Lanham Act, 15 U.S.C. § 1065. Attached as Exhibit 1 is a true and correct printout from the USPTO electronic database showing the current status and title of the registration as of September 22, 2017.

3. Petitioner has used the SOFTWARE FREEDOM LAW CENTER Mark in interstate commerce in the United States continuously since February 9, 2005 in connection with the provision of legal services.

4. As a result of widespread, continuous, and exclusive use of the SOFTWARE FREEDOM LAW CENTER Mark to identify its legal services and the Petitioner as their source, Petitioner owns valid and subsisting federal statutory and common law rights to the SOFTWARE FREEDOM LAW CENTER Mark.

5. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark is distinctive to both the consuming public and Petitioner's trade.

6. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark is symbolic of extensive goodwill established by Petitioner, and has acquired a high degree of recognition through continued use and expenditures of time, effort, and money, and serves as a unique identifier of the services offered by Petitioner.

7. Upon information and belief, Registrant, Software Freedom Conservancy, with an address at 137 Montague Street Suite 380, Brooklyn, New York 11201, and an email address at tony@softwareconservancy.org, is the current listed owner of Registration No. 4,212,971 for the mark SOFTWARE FREEDOM CONSERVANCY, in connection with “Downloadable computer software for media file management, object-oriented software engineering, messaging, software development tools,

operating system utilities, operating system emulation, inventory management, graphics modeling, Braille displays, implementation of dynamic languages, print services, browser automation, operating systems programs in the field of education, and computer operating system tools for use in embedded systems, provided freely and openly licensed use for the public good” in International Class 9, and “Charitable services, namely, promoting public awareness of free, libre and open source software projects, and developing and defending the same” in International Class 35. That trademark registration, based on an application filed on November 29, 2011, was issued on September 25, 2012 and bears a first-use date of September 17, 2005.

8. Petitioner's SOFTWARE FREEDOM LAW CENTER Mark has priority over Registrant's mark because Petitioner's first-use and registration dates for the SOFTWARE FREEDOM LAW CENTER Mark predate the filing date of Registrant's application for Registration No. 4,212,971 or any other date on which the Registrant may rely for purposes of priority.

9. Karen M. Sandler, an attorney employed by Petitioner from on or about October 31, 2005 through on or about June 21, 2011, filed the application for the SOFTWARE FREEDOM LAW CENTER Mark with the USPTO on Petitioner's behalf on June 17, 2010.

10. Registrant was established by employees of Petitioner. Registrant's articles of incorporation were filed on March 20, 2006. It was created as a legal entity separate from Petitioner in order to provide free financial and administrative services to FOSS projects and developers.

11. At its formation, all of Registrant's board members were employees of Petitioner. Eben Moglen, President, Chairman of the Board, and Director of Petitioner, chaired the Board of Registrant. Registrant's business address was the address of Petitioner. All Registrant's expenses were paid for out of the budget of Petitioner. Employees of Petitioner, including Karen M. Sandler and Bradley M. Kuhn, were appointed as officers of Registrant.

12. Having created, paid for, and devoted its resources, including employees and office space, to

Registrant, Petitioner had a right to use the SOFTWARE FREEDOM CONSERVANCY Mark. There was no implied exclusivity in Registrant's use of the SOFTWARE FREEDOM CONSERVANCY Mark.

13. Upon information and belief, Karen M. Sandler and Bradley M. Kuhn, have continuously served as Registrant's officers since leaving the employ of Petitioner.

14. Bradley M. Kuhn was employed by Petitioner from March 2005 to September 30, 2010.

15. Bradley M. Kuhn was appointed as the executive director of Registrant on October 4, 2010.

16. After January 20, 2011, Petitioner and Registrant had no board members in common.

17. After June 21, 2011, Registrant and Petitioner had no officers or employees in common.

FIRST GROUND FOR CANCELLATION – LIKELIHOOD OF CONFUSION

18. Petitioner hereby incorporates by reference paragraphs 1 through 17 as if fully stated here.

19. Registrant's SOFTWARE FREEDOM CONSERVANCY Mark is confusingly similar to Petitioner's SOFTWARE FREEDOM LAW CENTER Mark. Both marks incorporate the identical element "Software Freedom" at the beginning of the mark, followed by a descriptive noun or compound noun. The appearance and sound of the two marks are initially identical when read or pronounced. These first two identical words thus comprise the dominant portion of each of the marks both in terms of their salience as well as in the number of letters.

20. There are no other registered trademarks on the primary register of the USPTO that incorporate the element "Software Freedom" other than those of Petitioner and Registrant.

21. The services provided by Petitioner and Registrant are related in significant ways: both entities offer support services for FOSS projects and developers.

22. Registrant's services with which it uses the SOFTWARE FREEDOM CONSERVANCY Mark are offered to the same class of consumers as Petitioner's services with which it uses the SOFTWARE FREEDOM LAW CENTER Mark, namely FOSS projects and developers.

23. There have been several instances of actual confusion between Petitioner's and Registrant's marks, including on websites, message boards, in phone calls to Petitioner, and in donation queries, and such confusion is likely to continue to occur.

24. Actual confusion has been acknowledged by Karen M. Sandler and Bradley M. Kuhn during public podcasts recorded while employed by Petitioner.

25. Registrant's registration should be canceled because it consists of or comprises a mark which so resembles Petitioner's previously used and registered SOFTWARE FREEDOM LAW CENTER Mark as to be likely, when used in connection with Registrant's goods and services, to cause confusion, mistake, or deception within the meaning of 15 U.S.C § 1052(d), and to cause damage to Petitioner thereby.

SECOND GROUND FOR CANCELLATION – FRAUD

26. Petitioner hereby incorporates by reference paragraphs 1 through 25 as if fully stated here.

27. Karen M. Sandler, an attorney, was employed by Petitioner at the time Petitioner registered the SOFTWARE FREEDOM LAW CENTER Mark, and was the attorney of record on behalf of Petitioner in its application and filings for the SOFTWARE FREEDOM LAW CENTER Mark with the USPTO.

28. Karen M. Sandler declared in Petitioner's application for the SOFTWARE FREEDOM LAW CENTER trademark that first date of Petitioner's use of the mark was “at least as early as 02/09/2005”.

29. Karen M. Sandler signed a declaration stating in part that she was “properly authorized to execute this application on behalf of the applicant” and “that all statements made on information and belief are believed to be true” when filing Petitioner's application for the SOFTWARE FREEDOM LAW CENTER Mark on June 17, 2010.

30. On November 29, 2011 Registrant filed a Trademark Application (the “Application”) for the SOFTWARE FREEDOM CONSERVANCY Mark with the USPTO under 15 U.S.C. Section 1051(a) which included a declaration signed by Registrant's general counsel Anthony K. Sebro, Jr. attesting to

the truth of the statements made in the Application and acknowledging “that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom... .”

31. On April 10, 2012 Registrant filed a Response to Office Action (the “Response”) in relation to the Application with the U.S. Trademark Office which included a declaration signed by Registrant's general counsel attesting to the truth of the statements made in the Response and acknowledging “that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom... .”

32. The Secretary of Registrant's Board of Directors at the time Registration filed the Application and Response was Karen M. Sandler.

33. Bradley M. Kuhn was the President and Chairperson of Registrant's Board of Directors, as well as the Executive Director of Registrant at the time Registrant filed the Application and Response.

34. Registrant, through its board of directors and executive director, instructed its general counsel to apply for the SOFTWARE FREEDOM CONSERVANCY Mark.

35. Registrant declared, through its general counsel, in both the Application and Response that “to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”

36. As of October 12, 2011, Registrant began providing legal advice and services in connection with the SOFTWARE FREEDOM CONSERVANCY Mark, as its website shows.

37. Registrant provided legal services in connection with the SOFTWARE FREEDOM

CONSERVANCY Mark at the time Registrant applied for the mark.

38. Registrant did not disclose to the USPTO, in either its Application or Response, that Registrant provided legal advice and services in connection with the SOFTWARE FREEDOM CONSERVANCY Mark.

39. Registrant had actual knowledge that Petitioner provided legal services in connection with the SOFTWARE FREEDOM LAW CENTER Mark at the time Registrant applied for the SOFTWARE FREEDOM CONSERVANCY Mark.

40. Registrant used the broad term “defending” to describe its charitable services in regards to “free, libre and open source software projects” and did not adequately specify to the USPTO that Registrant provided legal services. The Registrant did not list class 45 as it should have, as that would have alerted the examining attorney to confusion with the SOFTWARE FREEDOM LAW CENTER Mark.

41. Registrant knew that the statements it made in paragraph 35 above in its Application and Response were false at the time they were made because Registrant knew that Petitioner's rights in the SOFTWARE FREEDOM LAW CENTER Mark predated any rights that Respondent could assert in its SOFTWARE FREEDOM CONSERVANCY Mark.

42. Registrant knew that the statements it made in paragraph 35 above in its Application and Response were false at the time they were made because Registrant knew that Petitioner had rights to the SOFTWARE FREEDOM CONSERVANCY Mark.

43. Registrant knew that the statements it made in paragraph 35 above in its Application and Response were false at the time they were made because Registrant knew that there was actual confusion between Petitioner's SOFTWARE FREEDOM LAW CENTER Mark and Registrant's SOFTWARE FREEDOM CONSERVANCY Mark in connection with the services provided by Petitioner.

44. Registrant's willful failure to disclose to the USPTO in its Application that it provided legal advice and services in connection with the SOFTWARE FREEDOM CONSERVANCY Mark, and its decision to instead use the broad term "defending" to describe its activities evinces Registrant's bad faith and that it intended to obtain a trademark registration to which it was not entitled because Registrant knew Petitioner was using the confusingly similar mark SOFTWARE FREEDOM LAW CENTER for legal services.

45. Registrant's willful failure to disclose in its Application and Response that it had knowledge of actual confusion between Petitioner's and Registrant's marks and that Petitioner had prior legal rights to a mark that is confusingly similar to Registrant's mark evinces Registrant's bad faith and that it intended to obtain a trademark registration to which it was not entitled.

46. The USPTO examining attorney relied on the false statements that Registrant made in paragraph 35 above in its Application and Response in deciding whether or not to grant Registrant registration of the SOFTWARE FREEDOM CONSERVANCY Mark.

47. The USPTO examining attorney relied on Registrant's false identification of its goods and services in its Application and Response as being adequate to provide public notice and to enable the examining attorney to reach an informed judgment concerning the likelihood of confusion.

48. On November 2, 2017, the same day that Registrant filed its Answer in the instant action, Registrant filed trademark applications on a Section 1(b) intent-to-use basis for the word mark THE SOFTWARE CONSERVANCY (serial number 87670034), and for a design mark with the literal element THE SOFTWARE CONSERVANCY (serial number 87670106) ("THE SOFTWARE CONSERVANCY Marks").

49. Registrant applied for THE SOFTWARE CONSERVANCY Marks in the identical international classes and for the identical goods/services as the SOFTWARE FREEDOM CONSERVANCY Mark.

50. Registrant declared, inter alia, through its general counsel, Anthony K. Sebro, Jr., in its

applications for THE SOFTWARE CONSERVANCY Marks, that “the applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application.”

51. Registrant’s SOFTWARE FREEDOM CONSERVANCY Mark should be canceled because Registrant fraudulently obtained registration of its mark from the USPTO.

WHEREFORE, Petitioner respectfully prays that its cancellation be sustained and that Registrant's Registration no. 4,212,971 be canceled in its entirety and that this Court grant such other and further relief as it shall deem just.

Dated: December 22, 2017

New York, New York

Respectfully submitted,

/S/

Daniel Byrnes
Attorney for Petitioner
Software Freedom Law Center
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New York, New York 10023

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EXHIBIT 1

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Mark: SOFTWARE FREEDOM LAW CENTER

Software Freedom Law Center

US Serial Number: 85065598

Application Filing Date: Jun. 17, 2010

US Registration Number: 3913979

Registration Date: Feb. 01, 2011

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Apr. 02, 2016

Publication Date: Nov. 16, 2010

Mark Information

Mark Literal Elements: SOFTWARE FREEDOM LAW CENTER

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: "SOFTWARE" AND "LAW CENTER"

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: Legal services

International Class(es): 045 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 09, 2005

Use in Commerce: Feb. 09, 2005

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Software Freedom Law Center

Owner Address: FL 17
1995 Broadway

New York, NEW YORK 10023
UNITED STATES

Legal Entity Type: CORPORATION

State or Country: NEW YORK
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: MISHI CHOUDHARY

Attorney Primary Email Address: MISHI@SOFTWAREFREEDOM.ORG

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: MISHI CHOUDHARY
1995 BROADWAY FLOOR 17
NEW YORK, NEW YORK 10023
UNITED STATES

Phone: 2124611912

Correspondent e-mail: MISHI@SOFTWAREFREEDOM.ORG MISHI@SOFTWAREFREEDOM.ORG

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Apr. 02, 2016	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Apr. 02, 2016	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70132
Apr. 02, 2016	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70132
Feb. 03, 2016	TEAS SECTION 8 & 15 RECEIVED	
Feb. 01, 2016	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Feb. 01, 2011	REGISTERED-PRINCIPAL REGISTER	
Nov. 16, 2010	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Nov. 16, 2010	PUBLISHED FOR OPPOSITION	
Oct. 13, 2010	LAW OFFICE PUBLICATION REVIEW COMPLETED	68171
Oct. 13, 2010	ASSIGNED TO LIE	68171
Sep. 29, 2010	APPROVED FOR PUB - PRINCIPAL REGISTER	
Sep. 29, 2010	EXAMINER'S AMENDMENT ENTERED	88888
Sep. 29, 2010	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Sep. 29, 2010	EXAMINERS AMENDMENT E-MAILED	6328
Sep. 29, 2010	EXAMINERS AMENDMENT -WRITTEN	82104
Sep. 24, 2010	ASSIGNED TO EXAMINER	82104
Jun. 21, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 21, 2010	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMEG LAW OFFICE 103

Date in Location: Apr. 02, 2016

United States of America

United States Patent and Trademark Office

Software Freedom Law Center

Reg. No. 3,913,979

Registered Feb. 1, 2011

Int. Cl.: 45

SERVICE MARK

PRINCIPAL REGISTER

SOFTWARE FREEDOM LAW CENTER (NEW YORK CORPORATION)

FL 17

1995 BROADWAY

NEW YORK, NY 10023

FOR: LEGAL SERVICES, IN CLASS 45 (U.S. CLS. 100 AND 101).

FIRST USE 2-9-2005; IN COMMERCE 2-9-2005.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SOFTWARE" AND "LAW CENTER", APART FROM THE MARK AS SHOWN.

SER. NO. 85-065,598, FILED 6-17-2010.

Laurie Kaufman, Examining Attorney



David J. Kyffers

Director of the United States Patent and Trademark Office

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Motion to Amend Petition, Amended Petition has been served on Software Freedom Conservancy by forwarding said copy on December 22, 2017, via email to:

Pamela S. Chestek
Chestek Legal
PO Box 2492
Raleigh, NC 27602

pamela@chesteklegal.com

By: /S/
Daniel Byrnes