

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

Mark:	SOFTWORX)	
)	
Serial No.:	76/117,602)	
)	
Applicant:	Applied Precision, LLC)	On Notice of Appeal
)	
Filed:	August 28, 2002)	
)	
Examining Attorney:	Tom Gleason)	
	Law Office 109)	
)	
Our Ref. No.:	44182.290033)	



08-23-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #39

BOX TTAB – NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

REQUEST TO SUSPEND

Sir or Madame:

The refusal of registration for application Serial No. 76/117,602 is based solely on the Examining Attorney's opinion that there is a likelihood of confusion with prior Reg. No. 1,374,584 for the mark SOFTWORKS.

Contemporaneously herewith, Applicant has filed a Petition to Cancel Reg. No. 1,374,584. The granting of the Petition will remove the reason for refusal of registration of application Serial No. 76/117,602. A copy of the Petition, as filed, is enclosed.

Applicant requests that the Appeal for application Serial No. 76/117,602 be suspended pending the disposition of the aforementioned Petition to Cancel.

Serial No. 76/117,602

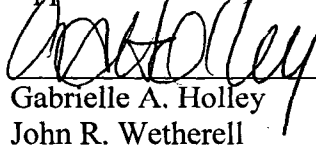
In the alternative, Applicant requests that the time to submit an appeal brief be extended for a period of 90 days. The undersigned has recently taken over the subject matter and requires the additional time to familiarize itself with the subject application, to communicate further with Applicant regarding the appeal and to prepare a brief. This is the first request for extension of time to file Applicant's appeal brief and it is submitted that such request is made in good faith and not for the purpose of unnecessary delay.

Please also note that a Substitution of Attorney has been filed for the subject application. A copy is enclosed for your reference. Please address all future correspondence regarding this appeal to the undersigned.

Respectfully submitted,

Applied Precision, LLC

By:



Gabrielle A. Holley
John R. Wetherell

Attorneys for Applicant
Pillsbury Winthrop LLP
11682 El Camino Real
Suite 200
San Diego, California 92130

Communications to:

Gabrielle A. Holley Esq.
Pillsbury Winthrop LLP
(858) 509-4006

I hereby certify that this PETITION TO CANCEL, Registration No. 1,374,584 for the mark SOFTWARES (in duplicate), (along with any papers referred to as being attached or enclosed) and a filing fee of \$300 are being deposited with the United States Postal Service as "Express Mail Post Office to Addressee," mailing label no. EV 177 689 880 US, in an envelope addressed to BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514 on August 23, 2002.

Esther J. Choe
Esther J. Choe

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


Applied Precision, LLC,)
)
 Petitioner,)
)
 v.)
)
 Softworks, Inc.)
)
 Registrant.)
)
 Our Ref. No. 44182.290034)

Cancellation No. _____
Reg. No. 1,374,584

PETITION TO CANCEL

COPY

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2900 Crystal Drive
Trademark Trial and Appeal Board
Arlington, Virginia 22202-3513


08-23-2002
U.S. Patent & TMO/TM Mail Rcpt Dt. #39

Sir or Madame:

Applied Precision, LLC (hereinafter Petitioner) is or will be damaged by the continued registration of the mark SOFTWARES, which is set forth in Reg. No. 1,374,584 and owned by Softworks, Inc. (hereinafter Registrant), and hereby requests the cancellation of the same.

As grounds for cancellation, Petitioner, by its attorneys, avers as follows:

1. On December 10, 1985, the United States Patent and Trademark Office issued Reg. No. 1,374,584. Information about this registration is submitted herewith as Exhibit A.

2. On August 28, 2000, Petitioner submitted application Ser. No. 76/117,602 to the United States Patent and Trademark Office. Information about this application is submitted herewith as Exhibit B.

3. The identification of goods in Reg. No. 1,374,584 namely, "pre-recorded computer programs," is overly-broad.

4. On information and belief, Registrant does not currently produce or market all forms of "pre-recorded computer programs," and specifically does not manufacture or market computer software for microscopy, imaging and informatics.

5. On information and belief, Registrant's products were related to data storage and management in the financial, health care and manufacturing industries.

6. On information and belief, Registrant, through intentional nonuse, has abandoned the mark set forth in Reg. No. 1,374,584.

7. Any goodwill that may have been associated with the mark set forth in Reg. No. 1,374,584 has been destroyed by Registrant's intentional abandonment and nonuse of the mark in commerce.

8. Petitioner is or will be damaged by the existence of this registration. Specifically, upon examination, the Examining Attorney is of the opinion that the mark set forth in application Ser. No. 76/117,602 consists of or comprises a mark which so resembles the mark set forth in Reg. No. 1,374,584 as to be likely to cause confusion, or to cause mistake, or to deceive, under Trademark Act Section 2(d), 15 U.S.C. 1052(d).

9. The restriction or cancellation of Reg. No. 1,374,584 to reflect actual marketplace limitations of Registrant's use of its marks will avoid any finding of likelihood of confusion as alleged by the Examining Attorney for Ser. No. 76/117,602.


WHEREFORE, Petitioner respectfully requests that Reg. No. 1,374,584 be modified under Section 18 to reflect the actual marketplace limitations of Registrant's use of the mark. In the alternative, Petitioner requests that Reg. No. 1,374,584 be cancelled.

The required filing fee is enclosed. However, in the event the enclosed fee is either inadvertently omitted or otherwise insufficient, please charge the cost to Deposit Account No. 03-3975, Order No. 044182-0290034.

Dated: 8/23/2002

Respectfully submitted,

Applied Precision, LLC

By: 
Gabrielle A. Holley
John R. Wetherell
Kimberly A. McDonnell

Attorneys for Petitioner
Pillsbury Winthrop LLP
11682 El Camino Real
Suite 200
San Diego, California 92130
(619) 234-5000



UNITED STATES PATENT AND TRADEMARK OFFICE

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Typed Drawing

Word Mark	SOFTWARES
Goods and Services	IC 009. US 038. G & S: PRE-RECORDED COMPUTER PROGRAMS. FIRST USE: 19830204. FIRST USE IN COMMERCE: 19830204
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	73423017
Filing Date	April 25, 1983
Published for Opposition	October 1, 1985
Registration Number	1374584
Registration Date	December 10, 1985
Owner	(REGISTRANT) SOFTWARES, INC. CORPORATION MARYLAND 7801 OLD BRANCH AVE. CLINTON MARYLAND 20735
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	GERALD J. FERGUSON, JR.
Type of Mark Register	TRADEMARK PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR).
Live/Dead Indicator	LIVE

FTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	TOP	HELP	PREV LIST
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Serial Number: 73423017

Registration Number: 1374584

Mark (words only): SOFTWARES

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 1991-07-08

Filing Date: 1983-04-25

Registration Date: 1985-12-10

Law Office Assigned: TME0 Law Office # 3

CURRENT APPLICANT(S)/OWNER(S)

1. SOFTWARES, INC.

Address:

SOFTWARES, INC.
7801 OLD BRANCH AVE.
CLINTON, MD 20735
United States

State or Country of Incorporation: Maryland

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

PRE-RECORDED COMPUTER PROGRAMS

International Class: 009

First Use Date: 19830204

First Use in Commerce Date: 19830204

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1991-07-08 - Section 8 (6-year) accepted & Section 15 acknowledged

1991-02-22 - Section 8 (6-year) and Section 15 Filed
1985-12-10 - Registered - Principal Register
1985-10-01 - Published for opposition
1985-08-30 - Notice of publication
1985-08-09 - Approved for Pub - Principal Register (Initial exam)
1985-06-27 - Communication received from applicant
1985-05-06 - Non-final action mailed
1983-12-22 - Non-final action mailed
1983-11-17 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

GERALD J. FERGUSON, JR. (Attorney of record)

SIXBEY, FRIEDMAN, LEEDOM & FERGUSON
SUTIE 600
2010 CORPORATE RIDGE
MCLEAN, VA 22102
United States



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

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Typed Drawing

Word Mark **SOFTWARE**

Goods and Services **IC 009. US 021 023 026 036 038. G & S: Computer software for microscopy, imaging, and informatics sold exclusively through direct sales. FIRST USE: 19990800. FIRST USE IN COMMERCE: 19990800**

Mark Drawing Code **(1) TYPED DRAWING**

Serial Number **76117602**

Filing Date **August 28, 2000**

Owner **(APPLICANT) Applied Precision, Inc. CORPORATION WASHINGTON 1040 12th Avenue N.W. Issaquah WASHINGTON 980278929**

Attorney of Record **DIANE L. GARDNER**

Type of Mark **TRADEMARK**

Register **PRINCIPAL**

Live/Dead Indicator **LIVE**

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Serial Number: 76117602

Registration Number: (NOT AVAILABLE)

Mark (words only): SOFTWORX

Current Status: Office action continuing a FINAL refusal to register has been mailed.

Date of Status: 2002-06-24

Filing Date: 2000-08-28

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: TMEG Law Office 109

CURRENT APPLICANT(S)/OWNER(S)

1. Applied Precision, Inc.

Address:

Applied Precision, Inc.
1040 12th Avenue N.W.
Issaquah, WA 980278929
United States

State or Country of Incorporation: Washington

Legal Entity Type: Corporation

GOODS AND/OR SERVICES

Computer software for microscopy, imaging, and informatics sold exclusively through direct sales

International Class: 009

First Use Date: 19990800

First Use in Commerce Date: 19990800

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2002-08-21 - TEAS Corr Address Request Received but not Processed Loc is TTAB

2002-07-31 - PAPER RECEIVED
2002-06-24 - Action denying request for reconsideration - mailed - Initial exam
2002-05-28 - Jurisdiction restored to examiner
2002-05-28 - Ex parte appeal - Instituted
2002-05-23 - EXPARTE APPEAL RECEIVED AT TTAB
2002-05-10 - PAPER RECEIVED
2002-03-22 - Communication received from applicant
2002-03-22 - PAPER RECEIVED
2001-11-09 - Final refusal mailed
2001-08-27 - Communication received from applicant
2001-08-27 - Communication received from applicant
2001-02-27 - Non-final action mailed
2001-02-22 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)

DIANE L. GARDNER (Attorney of record)

DIANE L. GARDNER
FISH & RICHARDSON P.C.
4350 LA JOLLA VILLAGE DRIVE, SUITE 500
SAN DIEGO, CALIFORNIA 92122
United States

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of

Applicant: Applied Precision, LLC

Serial No.: 76/117,602

Mark: SOFTWORX

Filing Date: August 28, 2000

Our Ref. No.: 44182.290033

COPY

SUBSTITUTION OF ATTORNEY

Applied Precision, LLC, a Delaware corporation, hereby appoints Gabrielle A. Holley, John R. Wetherell, Jonathan E. Jobe, Sean L. Collin, Tisha DeRaimo, and Sarah Forbes, of Pillsbury Winthrop LLP, 11682 El Camino Real, Suite 200, San Diego, California 92130, its attorneys, either individually or collectively to prosecute this matter, with full powers of substitution and revocation, to transact all business in the Patent and Trademark Office connected therewith, and to receive the Certificate of Registration. Please direct all correspondence and calls to Gabrielle A. Holley, telephone number (858) 509-4006.

APPLIED PRECISION, LLC

By: Ronald C. Seibert

Name: RONALD C. SEIBERT

Title: C.E.O.

Date: 8/19/2002

• 2
• •

CERTIFICATE OF MAILING VIA EXPRESS MAIL

“Express Mail” Mailing Label Number: EV 177 689 893 US

Mark: SOFTWORX

Serial No.: 76/117,602

Applicant: Applied Precision, LLC

I hereby certify that the attached REQUEST TO SUSPEND (along with any papers referred to as being attached or enclosed) is addressed to: BOX TTAB – NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, and is being deposited with the United States Postal Service “*Express Mail Post Office to Addressee*” service on the date indicated below.

August 23, 2002

(Date)

Esther J. Choe

(Depositor’s Name)



(Signature)



PILLSBURY WINTHROP^{LLP}

TTAB

11682 EL CAMINO REAL SUITE 200 SAN DIEGO, CA 92130-1593 619.234.5000 F: 858.509.4010

Gabrielle A. Holley
858.509.4006
gholley@pillsburywinthrop.com

August 23, 2002

BY EXPRESS MAIL NO. EV 177 689 893 US

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TRADEMARK TRIAL AND
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Attn: Tom Gleason, Examining Attorney
Law Office 109

Re: **Request to Suspend**
Appeal for Trademark Application Serial No. 76/291,064
Mark: SOFTWARE
Our Ref.: 044182-0290033

Dear Mr. Gleason:

On behalf of our client, Applied Precision, LLC., please find enclosed:

1. Request to Suspend;
2. a copy of Petition to Cancel Registration No. 1,374,584;
3. a copy of Substitution of Attorney;
4. Certificate of Mailing via Express Mail; and
5. a self-addressed stamped postal acknowledgement card.



PILLSBURY WINTHROP^{LLP}

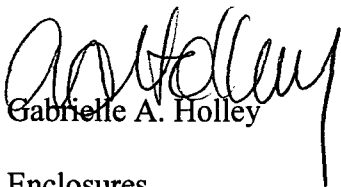
Commissioner for Trademarks

August 23, 2002

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Please acknowledge your receipt of the enclosed by date-stamping the enclosed self-addressed, stamped postcard and returning the same to us.

Respectfully submitted,


Gabrielle A. Holley

Enclosures

cc: John R. Wetherell, Ph.D. (w/o encls.)