



## **PARTIES**

1. Opposer Black Box Corporation of Pennsylvania is a Delaware corporation having plant facilities and offices at 1000 Park Drive, Lawrence, PA 15055. Opposer BB Technologies, Inc. is a Delaware subsidiary of Black Box Corporation of Pennsylvania, having offices at 911 Washington Street, Wilmington, Delaware 19801-1545.

2. Opposer BB Technologies, Inc., through its predecessors, has obtained various trademark registrations asserted below. Opposer BB Technologies, Inc. has exclusively licensed these trademarks to Opposer Black Box Corporation of Pennsylvania.

3. Upon information and belief, Betterbox Communications Ltd. ("Applicant") is a corporation organized under the laws of the United Kingdom and has a usual place of business in Milton Keynes, England. Applicant's founder and its current manager and owner, Horatio Baoies, is a former employee of Opposers' predecessor.

## **OTHER ALLEGATIONS OF FACT**

4. Opposers have for many years, and long prior to the existence of Applicant, been continuously engaged in the sale of electric and electronic data communications products, computer peripheral products, computer connectivity products and the production and

distribution of catalogs for such products under the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks. Opposers have built up a large business in connection with these products and their "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks have become well known and highly respected in the data communications and computer equipment industries and in related fields.

5. In 1976, long prior to the existence of Applicant, Opposer Black Box Corporation of Pennsylvania, through its merged predecessor, Black Box Corporation, adopted the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks, which marks have been in continuous use in interstate commerce ever since, in connection with the sale of electric and electronic data communications products, computer peripheral products, computer connectivity products and the distribution of catalogs for such products.

6. Opposer BB Technologies, Inc. currently owns and maintains the following United States Trademark Registrations for the "BLACK BOX", "BLACK BOX and Box Design" and box design trademarks, copies of which are attached as Exhibits A, B, C, and D:

	<u>Mark</u>	<u>Reg. No.</u>	<u>Issue Date</u>	<u>Product</u>
A.	BLACK BOX	1,095,109	07/04/78	Catalog for data communication products.
B.	BLACK BOX & Design	1,343,851	06/25/85	Electric and electronic data communication apparatus; namely, interface converters and adapters, protocol converters, code converters,

switches, monitoring and diagnostic testers and test meters, modulators, demodulators, interconnecting cables, cable connectors and connector adapters, cable connector wall boxes and box covers, printers, printer connection adapters, printer interface converters and adapters, circuit boards, transformers, power supplies, automatic computer answer and response or disconnect interface converters and adapters, computer terminal and line sharing interface adapters, acoustic couplers, computer terminal timed disconnect monitors, computer and computer terminal time use monitors, computer terminal printer sharing interface converters and adapters, and structural parts for the described electric and electronic data communication apparatus.

C.	box design	1,095,108	07/04/78	Catalog for data communication products.
D.	box design	1,141,117	11/04/80	Electric and electronic data communication apparatus - namely, computer terminal and post interfaces, interface converters and adaptors, protocol converters, code converters, switches, monitoring and diagnostic testers and test meters, modulators, demodulators, interconnecting cables, cable connectors and connector adaptors, cable connector wall boxes and box covers, printers, printer connection adaptors, printer interfaces, circuit boards, transformers, power supplies, automatic computer answer and disconnect interfaces, computer terminal and line sharing interfaces, acoustic couplers, computer terminal timed disconnect monitors, computer terminal

printer sharing interfaces, and structural parts for the described electric and electronic data communication apparatus.

7. Opposer Black Box Corporation of Pennsylvania is the exclusive United States licensee of Opposer BB Technologies, Inc. for the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks listed in Paragraph 6 above.

8. In the past five (5) fiscal years alone, Opposers have sold over \$725 million of products under the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks. Sales of these products are expected to exceed \$235 million annually in the current fiscal year.

9. Opposers have extensively advertised and promoted the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks. Opposers expend approximately \$10 million per year throughout the United States in promoting the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks in catalogs, newspapers, trade journals, and at trade shows. Opposers expect to distribute over 3 million catalogs and supplements in 1997 alone, to promote the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks. Samples of Opposers' advertising and promotional materials are attached as Exhibit E. The cover and inside page of Opposers' catalog are attached hereto as Exhibit F.

10. Electronic and electric data communication products and computer peripheral products and computer connectivity products and catalogs related thereto made and sold by BLACK BOX under the registered trademarks "BLACK BOX" "BLACK BOX and Design" and box design are well and favorably known to the trade and to the public in the several states of the United States, as well as in foreign countries and such goods are understood as originating with Opposers.

11. The "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks are recognized throughout the United States by the public and business customers who associate the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks with Opposers as the source of quality data communications and computer equipment. By virtue of the arbitrary and highly distinctive nature of the marks, the long, extensive and continuous use by Opposers of the marks, and the efforts and expenditures of Opposers to advertise and promote their goods and services thereunder, the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks have become assets of substantial value to Opposers as a symbol of their quality products and their goodwill. In 1991, the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks and goodwill were valued at \$35.9 million.

12. Applicant filed Application Serial No. 75/011,373 on October 27, 1995 for the mark "BETTERBOX and Design" for COMPUTER HARDWARE, COMPUTER PERIPHERALS, COMPUTER MODEMS in Class 9. Such application was published in the Official Gazette on June 24, 1997, on page TM 187.

13. The goods recited in Applicant's application are identical or substantially similar to those offered by Opposers under their trademarks. Applicant offers these products through a catalog distribution system nearly identical to that created by Opposers that is marketed to the same consumers. The cover and inside page of Applicant's catalog are attached hereto as Exhibit G and are similar to that of Opposers.

14. Applicant's mark is a composite mark comprised of a word mark portion and a box design portion. The word mark and design portions of Applicant's mark are confusingly similar to Opposers' "BLACK BOX" and box design trademarks, respectively. Applicant's composite mark is confusingly similar to Opposers' "BLACK BOX and Box Design" trademark.

15. Applicant was founded and is currently owned and managed by a former employee of Opposers' predecessor. That former employee knew the business value of the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks. That former employee adopted trademarks substantially similar to the trademarks of Opposers with full knowledge of Opposers' trademarks, products and services. That former employee adopted the

name "BETTERBOX" and the box design to trade on the reputation and goodwill of Opposers after leaving Opposers' employ.

16. Applicant has never had any rights under the "BLACK BOX", the "BLACK BOX and Box Design" and box design trademarks.

17. The "BETTERBOX and Design" trademark of Applicant, as applied to the goods of Applicant set forth in its application, so resembles the trademark "BLACK BOX" and "BLACK BOX and Design" of Opposers, previously used by Opposers and previously registered by Opposers, as applied to the goods of Opposers, to cause confusion or to cause mistake or to deceive consumers of the products.

18. Based upon the foregoing, the registration of the mark depicted in Application Serial No. 75/011,373, filed October 27, 1995 on the Principal Register of the United States Patent and Trademark Office, will cause injury and damage to Opposers.

WHEREFORE, Opposers request that registration of Applicant's mark "BETTERBOX and Design", Application Serial No. 75/011,373 be denied and that this Opposition be sustained.

PETITIONERS hereby appoint George P. Baier (United States Patent and Trademark Office Registration No. 26,717), Michael L. Dever (United States Patent and Trademark



Office Registration No. 32,216), and Carla J. Vrsansky (United States Patent and Trademark Office Registration No. 36,958) of Buchanan Ingersoll Professional Corporation, its attorneys in the matter of the above-identified Opposition, to prosecute the Opposition, to transact all business with the Patent and Trademark Office and the United States courts connected with this Opposition and to sign its name to all papers which may hereafter be filed in connection with the Opposition and to receive the official communications relating to the same.

BLACK BOX CORPORATION OF  
PENNSYLVANIA

Date July 7, 1997

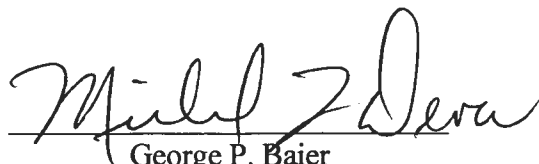
By Anna M Baird  
Anna M. Baird  
Vice President and  
Chief Financial Officer

BB TECHNOLOGIES, INC.

Date July 9, 1997

By Kenneth J. Kubacki  
Kenneth J. Kubacki  
President

Date 7/9/97



George P. Baier

Reg. No. 26,717

Michael L. Dever

Reg. No. 32,216

Carla J. Vrsansky

Reg. No. 36,958

BUCHANAN INGERSOLL

PROFESSIONAL CORPORATION

One Oxford Centre

301 Grant Street, 20th Floor

Pittsburgh, PA 15219-1410

(412) 562-1635

Attorneys for Opposers

Black Box Corporation of

Pennsylvania and its wholly owned  
subsidiary BB Technologies, Inc.

A



Int. Cl.: 16

Prior U.S. Cl.: 38

**United States Patent and Trademark Office**

Reg. No. 1,095,109  
Registered July 4, 1978

**TRADEMARK**

Principal Register

**BLACK BOX**

Expandor Incorporated (Pennsylvania corporation)  
612 Beatty Road  
Monroeville, Pa. 15146

For: CATALOG FOR DATA COMMUNICATION  
PRODUCTS, in CLASS 16 (U.S. CL. 38).  
First use Oct. 5, 1976; in commerce Oct. 5, 1976.

Ser. No. 107,330, filed Nov. 22, 1976.

B

Int. Cl.: 9

Prior U.S. Cls.: 21 and 26

United States Patent and Trademark Office

Reg. No. 1,343,851  
Registered June 25, 1985

TRADEMARK  
PRINCIPAL REGISTER



**BLACK BOX**

BLACK BOX CORPORATION (PENNSYLVANIA CORPORATION)  
MAYVIEW ROAD AT PARK DRIVE  
BOX 12800  
PITTSBURGH, PA 15241 , BY CHANGE OF  
NAME FROM EXPANDOR INCORPORATED  
(PENNSYLVANIA CORPORATION) UPPER  
ST. CLAIR, PA

FOR: ELECTRIC AND ELECTRONIC DATA COMMUNICATION APPARATUS; NAMELY, INTERFACE CONVERTERS AND ADAPTORS, PROTOCOL CONVERTERS, CODE CONVERTERS, SWITCHES, MONITORING AND DIAGNOSTIC TESTERS AND TEST METERS, MODULATORS, DEMODULATORS, INTERCONNECTING CABLES, CABLE CONNECTORS AND CONNECTOR ADAPTORS, CABLE CONNECTOR WALL BOXES AND BOX COVERS, PRINTERS, PRINTER CONNECTION ADAPTORS, PRINTER INTERFACE CONVERTERS AND ADAPTORS, CIRCUIT BOARDS, TRANSFORMERS, POWER SUPPLIES, AUTOMATIC COMPUTER ANSWER AND RESPONSE OR DISCONNECT INTERFACE CONVERTERS AND ADAPTORS, COMPUTER TERMINAL AND LINE SHARING INTERFACE ADAPTORS, ACOUSTIC COUPLERS, COMPUTER TERMINAL TIMED DISCONNECT MONITORS,

COMPUTER AND COMPUTER TERMINAL TIME USE MONITORS, COMPUTER TERMINAL PRINTER SHARING INTERFACE CONVERTERS AND ADAPTORS, AND STRUCTURAL PARTS FOR THE DESCRIBED ELECTRIC AND ELECTRONIC DATA COMMUNICATION APPARATUS, IN CLASS 9 (U.S. CLS. 21 AND 26).

FIRST USE 10-5-1976; IN COMMERCE 10-5-1976.

OWNER OF U.S. REG. NOS. 1,095,108, 1,095,109, AND 1,141,117.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BLACK BOX", APART FROM THE MARK AS SHOWN.

THIS DESIGN CONTAINS STIPPLING, WHICH IS INTENDED ONLY FOR CONTRAST PURPOSES, AND NO CLAIM IS MADE TO COLOR.

THE MARK CONSISTS OF "BLACK BOX" AND A LOGO WHICH MAY BE CONSIDERED AS AN OPTICAL ILLUSION BOX CAPABLE OF REVERSIBLE PERSPECTIVE AND ALSO CAPABLE OF APPEARING AS A MISCELLANEOUS PLANAR DESIGN.

SER. NO. 181,326, FILED 8-7-1978.

G. T. GLYNN, EXAMINING ATTORNEY

C

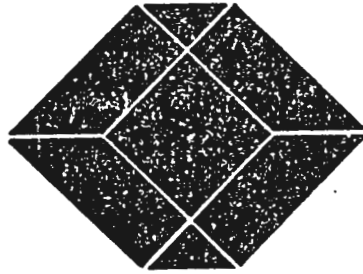
Int. Cl.: 16

Prior U.S. Cl.: 38

**United States Patent and Trademark Office**

**Reg. No. 1,095,108**  
**Registered July 4, 1978**

**TRADEMARK**  
**Principal Register**



Expandor Incorporated (Pennsylvania corporation)  
612 Beatty Road  
Monroeville, Pa. 15146

For: CATALOG FOR DATA COMMUNICATION  
PRODUCTS, in CLASS 16 (U.S. CL. 38).

First use Oct. 5, 1976; in commerce Oct. 5, 1976.

The mark is an optical illusion box design capable of  
reversible perspective. The mark is also capable of appearing  
as a miscellaneous planar design.

Ser. No. 107,325, filed Nov. 22, 1976.





ALL STATE\* LEGAL 800 222-0510 EDS11 RECYCLED

A



Int. Cl.: 9

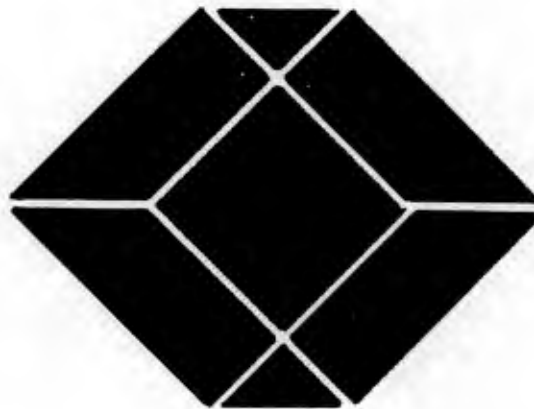
Prior U.S. Cls.: 21 and 26

United States Patent and Trademark Office

Reg. No. 1,141,117

Registered Nov. 4, 1980

**TRADEMARK**  
Principal Register



Expandor Incorporated (Pennsylvania corporation)  
400 Sainte Claire Plz.  
1121 Boyce Rd.  
Upper St. Clair, Pa. 15241

For: ELECTRIC AND ELECTRONIC DATA COMMUNICATION APPARATUS—NAMELY, COMPUTER TERMINAL AND POST INTERFACES, INTERFACE CONVERTERS AND ADAPTORS, PROTOCOL CONVERTERS, CODE CONVERTERS, SWITCHES, MONITORING AND DIAGNOSTIC TESTERS AND TEST METERS, MODULATORS, DEMODULATORS, INTERCONNECTING CABLES, CABLE CONNECTORS AND CONNECTOR ADAPTORS, CABLE CONNECTOR WALL BOXES AND BOX COVERS, PRINTERS, PRINTER CONNECTION

ADAPTORS, PRINTER INTERFACES, CIRCUIT BOARDS, TRANSFORMERS, POWER SUPPLIES, AUTOMATIC COMPUTER ANSWER AND DISCONNECT INTERFACES, COMPUTER TERMINAL AND LINE SHARING INTERFACES, ACOUSTIC COUPLERS, COMPUTER TERMINAL TIMED DISCONNECT MONITORS, COMPUTER TERMINAL PRINTER SHARING INTERFACES, AND STRUCTURAL PARTS FOR THE DESCRIBED ELECTRIC AND ELECTRONIC DATA COMMUNICATION APPARATUS, in CLASS 9 (U.S. Cls. 21 and 26).

First use Oct. 5, 1976; in commerce Oct. 5, 1976.  
Owner of U.S. Reg. Nos. 1,095,108 and 1,095,109.

Ser. No. 181,311, filed Aug. 7, 1978.

J. TINGLEY, Primary Examiner



FE



# BLACK BOX® Catalog

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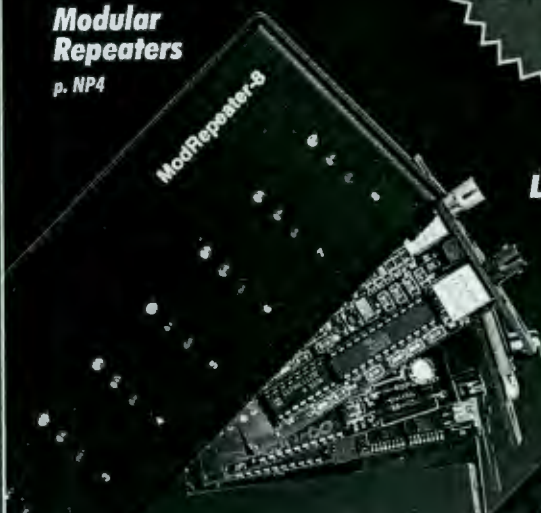
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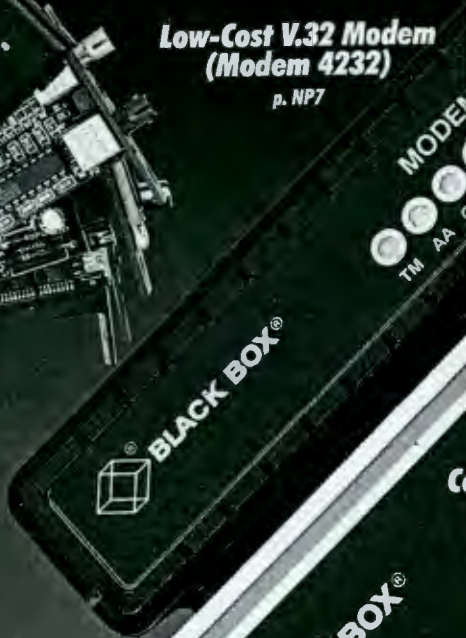
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Solutions

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Talk to an Account Manager at (412) 746-5500. Then fill out the Request for Quote form on the order form, and fax it toll-free to 1-800-321-0746.



### Money-Back Guarantees

Look at our 45-day money-back guarantee, two-month evaluations, two-year modem warranties, and lifetime cable and nonpowered switch warranties.



### Federal Buyers

Call (412) 746-5500 and press 1, then 0, to request our GSA schedule. Our contract number is: **GS00K93AGS6396PS01**. The expiration date is March 31, 1995.



### Now Get The BLACK BOX® Catalog on CD-ROM!

Order right from your PC! Use menus to page through our entire product line. Design your own network with the drawing tool. Call (412) 746-5500 (press 1, then 0) to request your Catalog on CD.



**Jeff Boetticher**  
PRESIDENT & CEO  
BLACK BOX CORPORATION

### DEAR CUSTOMER,

You've shown your faith in Black Box equipment, service, and technical support. And we're proud of your trust. In fact, we're committed to it.

We're also committed to bringing you the best new equipment—and the hot new technologies you've asked for. That's what you'll find in our New Product section, starting on the facing page.

In this issue, we're spotlighting the newest innovations in the compact, portable connectivity equipment you need to stay in touch with your business when you're on the road, or away from your office.

That's just another way Black Box is proud to serve you.

**Jeff Boetticher**

PRESIDENT & CEO, BLACK BOX CORPORATION

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By Phone: **(412) 746-5500**

By Fax: Toll-free in U.S.—1-800-321-0746  
Outside U.S.—(412) 746-0746

By Mail: Black Box Corporation, Order Department  
P.O. Box 12800, Pittsburgh, PA 15241

Tech Support: (412) 746-5500 (press 1, then 2)

Customer Relations: (412) 746-5500 (press 1, then 3)

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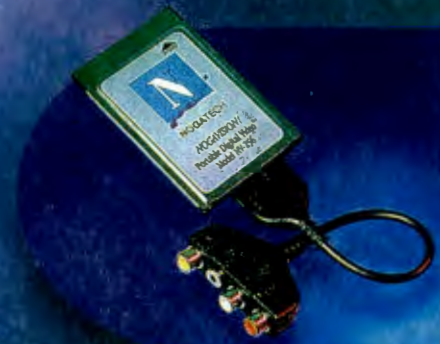
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WE COMPLY IN FULL WITH  
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# WELCOME T BETTERBOX®

Dear Datacomms user,  
 Welcome to the latest **BETTERBOX® CATALOGUE**. In this issue the largest and best so far you will find more than just another list of **NEW** products used to **SOLVE** most of your communications problems. You will find easy to understand application diagrams, ideas and several ways to contact our team members or just simply how to obtain the information you require fast.

Our Technical Support is **FREE** for you to use as many times as you like and our new **FAXBACK** facility allows you to get hold of detailed technical information on any product 24 hours a day just by using a touch tone phone. Alternatively just surf our **WEB SITE** at <http://www.betterbox.com> for the latest in product introduction and special pricing offers so attractive that you won't believe your eyes. To compliment our **ONE-STOP-SHOP** approach we are now also offering you two new services, a **TRADE COUNTER** where you can come in and see our products in a relaxed atmosphere with the help of one of our Technical specialists and an **INSTALLATION** service on all our products. Please see page 256 for further information.

Horacio Baiões, MBA  
 Managing Director



YOUR USER REFERENCE NUMBER  
 Call us for your reference number and fill it in

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 8.30am to 6.00pm Monday to Friday.

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Please send all fax orders to:

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### ORDER BY POST

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 Milton Keynes, MK11 3YY

You can now also e-mail our Technical and Sales services via the Internet on:

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[sales@betterbox.com](mailto:sales@betterbox.com) or [horacio@betterbox.com](mailto:horacio@betterbox.com)  
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 FOR OUR SALE  
 OR RETURN TERMS  
 AND CONDITIONS



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- Your order can be placed by phone, fax, mail or via the Internet.
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- As soon as identification is established simply state order code followed by quantity.
- If you need technical support before deciding which product to order, just ask to be transferred.
- Our order processing system is online so we can provide you with up to the minute stock and pricing information.

## TECHNICAL SUPPORT

- If you require, free of charge, pre or post sales Technical Support just call **01908 560200** and ask for the Technical Department.
- If you would like to have more information about a specific product, call our Technical Department and ask for a free information pack. State your user Reference Number followed by Order Code required. Alternatively call our Faxback system on 01908 570405

## TERMS AND CONDITIONS

- We accept payment by ACCESS, VISA, AMERICAN EXPRESS, DINERS CLUB INTERNATIONAL and any UK Bank cheque.
- Account - if you prefer we can open an account. Payment terms are strictly 30 days from our invoice date.

## SALE OR RETURN POLICY

- If you are not sure whether a product is suitable for your application then you can order it on a 30 day trial. Call our Technical Support team for an authorisation code.
- If you are not completely satisfied with a product we will replace it immediately, alternatively just return it within 30 days for a full refund on the equipment costs.

## BETTERBOX WARRANTY

- All our Data "T" switches and data cables (except fibre) come with a lifetime warranty. (subject to normal use).
- All other products are guaranteed for a full year on parts and labour.
- Maintenance and replacement unit contracts are available at very attractive prices.

## FAST DELIVERY? NEED IT NOW? YOU CAN HAVE IT!

We can deliver in-stock items same day any where in the UK or Ireland. Just call us for a quote.

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If your delivery address is within the postal areas listed below, and your order is placed before 12.00 noon, there will be a flat rate charge of £12.00.

LONDON: N1 to N22, NW1 to NW11, W1 to W11, E1 to E18, EC1 to EC4, SE1 to 28 and SW1 to SW20.

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### UK Main Land next day COURIER services:

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