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

In the matter of Application Serial No. 74-681, 194)
 For the mark: INTERNET WORLD)
 Date Filed: May 24, 1995)
)
 NOVELL, INC.)
)
 v.)
)
 INTERNET WORLD MEDIA, INC.)
)

NOTICE OF OPPOSITION



01-09-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #01

Opposer, Novell, Inc. ("Novell"), a Delaware corporation located and doing business at 1800 South Novell Place, Provo, Utah 84606 believes that it will be damaged by the above-identified registration, and hereby opposes the same.

The grounds for opposition are:

1. Opposer has adopted and is using in interstate commerce the marks NETWORKLD® and NETWORKLD® & Design for arranging and conducting trade shows in the field of computer networking, in International Class 35. Opposer's NETWORKLD marks were first used in connection with the described products and services at least as early as February 14, 1986, and were used in interstate commerce at least as early as February 14, 1986. Opposer has been, and is now, using the NETWORKLD marks in connection with the sale of products and services throughout the United States and internationally. Opposer's marks symbolize extensive goodwill and consumer recognition built by Opposer through substantial amounts of time and effort in advertising and promotion.

2. Opposer is the owner of U.S. Trademark Registration No. 1,868,562 registered on December 20, 1994, for "arranging and conducting trade shows in the field of computer networking."

A copy of that registration is attached as Exhibit 1. Opposer's registration for the NETWORKLD

mark is valid, has become incontestable, and is conclusive evidence of Opposer's exclusive right to use the mark in commerce in connection with the products and services specified.¹

3. Opposer is the owner of U.S. Trademark Registration No. 1,880,017 registered on February 21, 1995, for "arranging and conducting trade shows in the field of computer networking." A copy of that registration is attached as Exhibit 2. Opposer's registration for the NETWORLD & Design mark is valid, has become incontestable, and is conclusive evidence of Opposer's exclusive right to use the mark in commerce in connection with the products and services specified.

4. Opposer and/or its licensees also are known to and do embed the registered NETWORLD marks in other marks employed or licensed in connection with the marketing and distribution of Opposer's products and related services, including the mark "NETWORLD + INTEROP." This embedding is intended to and does permit consumers readily to identify other products and services as having the same source, sponsorship and/or approval. Thus the embedding of the NETWORLD marks, and marks in which the NETWORLD marks are embedded, have come to be associated with Opposer, its computer related product offerings, certifications and trade shows.

5. Opposer enters into contractual relations with others pursuant to which those others are licensed to use Opposer's NETWORLD marks, and marks in which the NETWORLD marks are embedded, in connection with computer related products and trade shows.

6. Applicant has applied to register the term "INTERNET WORLD" for, inter alia, "arranging and conducting trade shows, conferences and exhibitions concerning the development and

¹ Due to a clerical error within the PTO, this mark is listed as canceled in the PTO TESS Database. The registration has not been cancelled and this error is being corrected.

use of information technologies” in International Class 35, as recited in Application Serial No. 74,681,194 and published for opposition in the Official Gazette on 09/11/01.

7. Applicant seeks to register the INTERNET WORLD mark for use in connection with goods and/or services that are similar to the products and services in connection with which Opposer employs and licenses its NETWORLD marks and marks in which its NETWORLD marks are embedded.

8. Opposer’s use and registration of its NETWORLD marks as described herein has priority over Applicant’s use and/or application for registration of its INTERNET WORLD mark.

9. Applicant’s INTERNET WORLD mark is similar to and derivative of Opposer’s NETWORLD marks in pronunciation.

10. Applicant’s INTERNET WORLD mark is similar to and derivative of Opposer’s NETWORLD marks in appearance.

11. Applicant’s INTERNET WORLD mark conforms to Opposer’s practice of embedding its registered NETWORLD marks in other marks employed or licensed by Opposer.

12. Applicant’s INTERNET WORLD mark so resembles Opposer’s registered NETWORLD marks as to be likely to cause confusion, or to cause mistake, or to deceive, to Opposer’s injury.

13. The conformity of Applicant’s INTERNET WORLD mark to Opposer’s practice of embedding its registered NETWORLD marks in other marks employed or licensed by Opposer is likely to cause confusion, or to cause mistake, or to deceive, to Opposer’s injury.

14. Applicant’s registration and use of INTERNET WORLD in connection with Applicant’s goods and/or services will dilute the value of Opposer’s NETWORLD marks and

registrations, to Opposer's injury, in part by impairing Opposer's ability to promote and identify other computer related products, services or trade shows by the use of marks in which Opposer's NETWORLD marks are embedded.

15. If Applicant is granted a registration for the mark "INTERNET WORLD" then Applicant would obtain thereby at least a prima facie right to the exclusive use of that mark, which would redound to Opposer's damage and injury.

16. Due to the confusing similarity of Applicant's proposed mark "INTERNET WORLD" to Opposer's NETWORLD marks and registrations, the registration and use by Applicant of INTERNET WORLD in connection with Applicant's goods and/or services is likely to cause confusion, deception and mistake, and therefore Applicant should not be permitted to register its INTERNET WORLD mark.

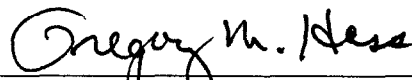
17. Due to the conformity of Applicant's INTERNET WORLD mark to Opposer's practice of embedding its registered NETWORLD marks in other marks employed or licensed by Opposer, the registration and use by Applicant of INTERNET WORLD in connection with Applicant's goods and/or services is likely to cause confusion, deception and mistake, and therefore Applicant should not be permitted to register its INTERNET WORLD mark.

18. Due to the confusing similarity of Applicant's proposed mark INTERNET WORLD to that class of marks employed or licensed by Opposer, in which the Opposer's registered NETWORLD marks are embedded, the registration and use by Applicant of INTERNET WORLD in connection with Applicant's goods and/or services is likely to cause confusion, deception and mistake, and therefore Applicant should not be permitted to register its INTERNET WORLD mark.

WHEREFORE, Opposer believes that it would be damaged by said registration, and that Section 2 of the Lanham Act, 15 U.S.C. § 1052, authorizes rejection of Applicant's application for registration, and prays that this Opposition be sustained in favor of Opposer, that said Application Serial No. 74-681,194 be rejected, and that no registration be issued thereon to Applicant.

DATED this 9th day of January, 2002.

Opposer Novell, Inc., by its Attorneys



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Int. Cl.: 35

Prior U.S. Cl.: 101

United States Patent and Trademark Office **Reg. No. 1,868,562**
Registered Dec. 20, 1994

**SERVICE MARK
PRINCIPAL REGISTER**

NETWORLD

**NOVELL, INC. (DELAWARE CORPORATION)
122 EAST 1700 SOUTH
PROVO, UT 846066194**

**FIRST USE 2-14-1986; IN COMMERCE
2-14-1986.**

SER. NO. 74-475,108, FILED 12-30-1993.

**FOR: ARRANGING AND CONDUCTING
TRADE SHOWS IN THE FIELD OF COMPUT-
ER NETWORKING, IN CLASS 35 (U.S. CL. 101).**

**ANNA W. MANVILLE, EXAMINING ATTOR-
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SER. NO. 74-488,102, FILED 2-4-1994.

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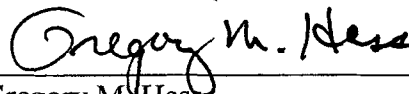
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DATED this 9th day of January, 2002.

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