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

SOURCE TRANSLATION &
OPTIMIZATION,
a sole proprietorship,
Opposer

v.

EMARKMONITOR INC.
a Delaware Corporation,
Applicant

In the matter of
Application Serial No. 75/895,205
For the mark: PATENT BUSTER

Published in the Official Gazette
on March 11, 2003

Opposition No.



NOTICE OF OPPOSITIC

04-08-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #30

NOTICE OF OPPOSITION

Opposer, Source Translation & Optimization, is a sole proprietorship with a mailing address of P.O. Box 475847, San Francisco, CA 94147.

Applicant, eMarkMonitor, is a Delaware Corporation whose mailing address is 1101 West River Street, Suite 201, Boise, Idaho, 83702.

Opposer believes that it will be damaged by registration of the mark PATENT BUSTER as shown in Application Serial No. 75/895,205 for services in International Class 42, and hereby opposes the same.

The grounds for opposition are as follows:

Count I - Likelihood of Confusion

1. Opposer has used the marks PATENTBUSTER, PATENT BUSTS and BUST PATENTS since at least 1997 in connection with providing discussions, news, software and databases in the field of patents prior to any use of the PATENT BUSTER mark by Applicant. In October 1999, Opposer registered the Internet domain name "bustpatents.com", which is still actively used.

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2. Opposer intends to continue use of the above marks in connection with the services and software described in Paragraph 1 above.

3. Through news articles, stories and profiles published throughout the United States, and by virtue of the high quality of its services, Opposer has garnered a valuable reputation for its PATENTBUSTER, PATENT BUSTS and BUST PATENTS marks.

4. Through the above means, Opposer has developed extensive goodwill throughout the United States with respect to its PATENTBUSTER, PATENT BUSTS and BUST PATENTS marks.

5. As a result of the above uses, Opposer has become identified with the PATENTBUSTER, PATENT BUSTS and BUST PATENTS marks in the minds of consumers, and has developed substantial common law rights in these marks. The first result from searching the Google database, using the phrase "patent busting", is a link to the Opposer's web site, www.bustpatents.com.

6. Applicant filed Application Serial No. 75/895,205 on January 12, 2000 seeking to register the mark PATENT BUSTER as a service mark in International Class 42 for "providing temporary use of on-line downloadable search engine software for searching patents and industry-related technology and information; providing information in the field of patents and industry-related technology; and providing association services, namely, promoting the interests of those in the patent field", and in International Class 9 for "downloadable search engine software for searching patents and industry-related technology and information".

7. Priority is not an issue. While Applicant filed Application Serial No. 75/895,205 as an intent-to-use application on January 12, 2000, Opposer has been using the PATENTBUSTER, PATENT BUSTS and BUST PATENTS marks since at least 1997, preceding any use by Applicant.

8. The mark proposed for registration by Applicant in Application Serial No. 75/895,205 is similar in appearance, connotation, sound and commercial impression to the marks used by Opposer in connection with its services, described in Paragraphs 1 above.

9. The services and software described in Application Serial No. 75/895,205 are closely related to Opposer's services described in Paragraph 1 above.

10. Upon information and belief, Opposer avers that the services recited in Application Serial No. 75/895,205 are advertised and provided in similar channels of trade and to similar customers as Opposer's services.

11. Applicant's use of the mark PATENT BUSTER in connection with the services recited in Application Serial No. 75/895,205 interferes with Opposer's use of its PATENTBUSTER, PATENT BUSTING and BUST PATENTS marks and is likely to cause the public to believe that the services of Applicant originate with Opposer, or vice versa, or that Applicant is owned or controlled by or in some manner affiliated or associated with Opposer, or vice versa, and is otherwise likely to cause confusion, cause mistake or deceive.

12. Any defect, inadequacy or deficiency found in Applicant's services and software marketed under the PATENT BUSTER mark would reflect negatively upon and seriously injure the

reputation and goodwill associated with the services marketed by Opposer and provided in connection with its PATENTBUSTER, PATENT BUSTING and BUST PATENTS marks.

13. If Applicant is granted a registration based on Application Serial No. 75/895,205, Applicant would thereby obtain at least a prima facie exclusive right to use the PATENT BUSTER mark. Any such registration would be a source of damage and injury to Opposer and its customers.

Count II – Descriptiveness

14. Opposer has used the terms PATENTBUSTER, PATENT BUSTS and BUST PATENTS in a descriptive sense since at least 1997 in discussions, news, software and databases in the field of patents prior to any use of the PATENT BUSTER mark by Applicant. In October 1999, Opposer registered the Internet domain name “bustpatents.com”.

15. Opposer uses and intends to continue using the above terms in a descriptive sense in connection with patent research and analysis services.

16. News articles, stories and profiles widely published throughout the United States, use the terms PATENTBUSTER, PATENT BUSTS and BUST PATENTS in a descriptive sense in connection with patent research.

17. Applicant filed Application Serial No. 75/895,205 on January 12, 2000 seeking to register the mark PATENT BUSTER as a service mark in International Class 42 for "providing temporary use of on-line downloadable search engine software for searching patents and industry-related technology and information; providing information in the field of patents and industry-related

technology; and providing association services, namely, promoting the interests of those in the patent field", and in International Class 9 for "downloadable search engine software for searching patents and industry-related technology and information".

18. Upon information and belief, the services performed by Applicant in connection with the PATENT BUSTER mark are commonly referred to as "patent busting". A search of the Google database using the phrase "patent busting" returns links to over 5,000 Web pages.

19. Upon information and belief, individuals performing the services performed by Applicant are commonly referred to as "patent busters".

20. Upon information and belief, Applicant's PATENT BUSTER mark is merely descriptive of the services for which Applicant intends to use the mark to describe.

21. Upon information and belief, Applicant's PATENT BUSTER mark has not acquired any distinctiveness in connection with its' services as listed in Application Serial No. 75/895,205.

22. In July of 2000, Opposer filed a similar Notice of Opposition against the mark PATENT BUSTERS (Application Serial No. 75/685,533, Opposition No. 119,494). Application Serial No. 75/685,533 was later abandoned by the applicant.

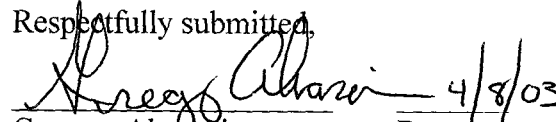
23. Applicant's mark, being merely descriptive of Applicant's goods with which it is used, is not registerable, pursuant to Section 2(e) of the Lanham Act, 15 USC §1052(e).

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WHEREFORE, Opposer prays that Application Serial No. 75/895,205 be rejected, that no registration be issued thereon to Applicant, that registration of the mark PATENT BUSTER in International Class 42 for the services specified therein be denied and refused, and that this opposition be sustained in favor of Opposer.

A duplicate copy of this Notice of Opposition and the fee of \$300.00 pursuant to 37 C.F.R. § 2.6(a)(17) are enclosed herewith.

Respectfully submitted,


Gregory Aharonian

4/8/03
Date

Owner
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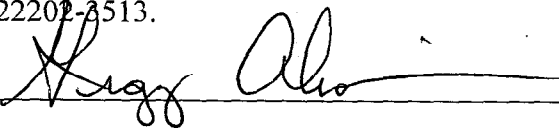
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Date of Deposit APRIL 8, 2003

I hereby certify that this document is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to Box TTAB - Fee, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

By: 

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