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

Proceeding	91165792
Party	Defendant Phasedata Corp. Phasedata Corp. 711 S. Carson St. Suite 4a Carson City, NV 89701
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Attachments	opposition91165792answer.pdf (6 pages)

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In the matter of trademark application Serial Number: 78/433,790
Opposition No. 91165792
For the mark : PHASE
Filed June 11, 2004

Phase Forward Incorporated
V.
Phasedata Corp.

ANSWER TO OPPOSITION

USPTO
Trademark Trial and Appeal Board
P.O. BOX 1451
Alexandria, VA 22313-1451

Dear Sir/Madam:

Applicant, Phasedata Corp., respectfully submits that the opposing party's grounds for opposition of the mark are without merit. Applicant has the following response to each of Opposer's allegations:

1. Applicant is seeking to obtain, under the provisions of the Trademark Act of 1946, as amended, registration on the Principal Register of the mark PHASE (Registration No. 78,433,790) for "computer software for online database management of content, customers and orders for use by businesses in conducting e-commerce" in International Class 09 and has commenced bona fide use of PHASE in commerce since as early as January 1, 2000.

2. Applicant is entitled to Registration on the Principal Register of the mark PHASE.

3. Applicant is the owner of the federally Registered trademark PHASE ENGINE® (Registration No. 2,882,904) for “Computer software for use in communication and database management in the field of Internet commerce” in International Class 09, and has commenced bona fide use of it’s PHASE ENGINE® mark since as early as January 1, 2000.

4. Opposer’s federal trademarks reflect specific limitations as to subject matter and channels of trade. Opposer’s Registered trademark PHASE FORWARD (Registration No. 2,366,760) for “Computer software used in the management of clinical trials of pharmaceutical products and medical devices and management of data resulting therefrom” is specific to the purpose of “management of clinical trials of pharmaceutical products and medical devices”. A field totally unrelated to Applicant’s goods and services described in the trademark application for PHASE.

5,6. The same is true for Opposer’s other marks , PF PHASE FORWARD and design (Registration No. 2,580,055) and PF PHASE FORWARD and design (Registration No. 2,599,003) which very specifically state the purpose of the mark and the field for which it applies. The former being the purpose of clinical trials of pharmaceutical products and the latter being the pharmaceutical industry as directly related to the former, clinical trials. Fields totally unrelated to Applicant’s goods and services described in the trademark application for PHASE.

7. Applicant is without enough information to admit or deny the statements made regarding Opposers use in commerce of any goods or services at any time.

8. Opposer's assertion of confusion because the word "Phase" is visibly and phonetically identical to the first half of Opposer's Registered marks should be rejected.

There is much precedence in the Principal Register regarding this. Examples include:

GENERAL (Reg No. 2948419) / GENERAL MOTORS (Reg No. 1223115),
HEWLETT (Reg No. 1090055) / HEWLETT PACKARD (Reg No. 2404025),
BAUSCH (Reg No. 2603044) / BAUSCH & LOMB (Reg No. 2386200),
FORD (Reg No. 497368) / FORD MOTOR COMPANY (Reg No. 2087916),
BERKSHIRE (Reg No. 2917510) / BERKSHIRE HATHAWAY (Reg No. 2420407),
CISCO (Reg No. 2752753) / CISCO SYSTEMS (Reg No. 2959329).

The same is true for the word PHASE. One would not infer a connection and no confusion exists especially in differing markets and styles as is the case here.

Regarding Opposer's assertions of similarities and Opposer's out-of-context isolation of terms, "computer software" and "online database management" in the Applicant's identification of goods and services of the mark PHASE, the Opposer has no such reference to "online database management" in Opposer's description of goods and services in its registered marks therefore there can be no similarities and hence no confusion, mistake or deception. As for the phrase "computer software" there are 193,594 marks in the TESS with the phrase "computer software" in the description of goods and services.

It is well established that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods or channels of trade or the class of purchasers to whom sales of the goods are directed. As such it is clear that there is no justification for opposition of the mark PHASE on the basis of the identification of goods set forth in the application since the goods and services of the Opposer's marks are significantly different than the Applicant's PHASE mark.

9,10. As a response to Opposer's assertions of dilution and damage the following is offered to refute these assertions. Phasedata Corp., and its "Phase" branded software, and the Trademark Registration for PHASE does not, has not, and does not claim to have any goods, customers, market, intent or motivation in the pharmaceutical products and medical devices industry. The further definition of goods and services of the Opposer's registration of the PHASE FORWARD mark, "management of data resulting therefrom", very specifically confines the Opposer's PHASE FORWARD mark to data and data management specifically related to the acquisition of medical data from its medical industry customers. The Applicant's goods and services definition restricts use of the PHASE mark to the software used for management of content, customers and orders from Applicant's business customers conducting e-commerce. Opposer's customer base is in no way similar to Applicant's as is evident in Opposer's "About Us"¹ statement on its website in which it states "Phase Forward is the leading provider of data management solutions for clinical trials and drug safety".

As for market and customers, Opposer also states on its website "We take pride in the fact that our solutions help a world-class customer base of pharmaceutical, biotechnology, and medical device companies improve the quality of human life with each innovation" further emphasizing that their customer base is specific to pharmaceutical, biotechnology, and medical device companies as described in the goods and services description of Opposer's registered marks and hence, not now or at any time in the past, engaging customers in the business of conducting e-commerce as is specified in Applicant's application for the mark PHASE.

¹ <http://www.phaseforward.com/about.html> Phase Forward About Us statement.

11. Phasedata Corp has a specific goods and service offering, since at least January 1, 2000, branded “Phase” with the “storefront” internet address [phase.com](http://www.phase.com)² that specifically relates to the identification of goods and services of the Registered mark “PHASE”. That is: “Computer software for online database management of content, customers and orders for use by businesses in conducting e-commerce.” Opposer has no such product line using the exact word Phase and has not used the sole and specific term Phase to reference itself or any of it’s goods or services prior to June 11, 2004 therefore cannot be damaged or diluted by Applicant’s registration of the mark PHASE.

12. Through use by Applicant, PHASE and PHASE ENGINE® marks have become well-known and famous, as defined in section 43(c) of the Federal Trademark Act, 15 U.S.C §1125(c)(1), to customers and potential customers as a trademark of Applicant, and as an origin and source of the goods sold and provided by Applicant.

13. There are no similarities in the markets, business, products, services, trademark registration identification of goods and services or product names between Applicant, Phasedata Corp. and Opposer, Phase Forward Incorporated. No confusion would exist by any reasoning and rational person.

14. Phasedata Corp. is registering the mark PHASE for exclusive right to the mark for it’s specific “Phase” product line. These goods and services are exactly described in the registration application as “Computer software for online database

² <http://www.phase.com> Phase e-commerce goods and services storefront.

management of content, customers and orders for use by businesses in conducting e-commerce". The Opposer is not referred to, as a company, by the term "Phase" and has no goods or services using the exact term "Phase" and is not in the business of providing content, customer and order management service to businesses conducting e-commerce hence has no exclusive right or option, either as a matter of law or ethical business practice, to use the name "Phase" for these purposes. If the Opposer or any other created a new product line for the management of content, customers and orders targeting businesses in the e-commerce market using the brand "Phase" it would clearly infringe and inflict substantial damage and dilution upon Applicant's good name and reputation and that of Applicant's goods and services. The same cannot be said for Opposer who has no known identity or goods and services known as "Phase" and has no known goods or services as described in the Applicant's description of the PHASE mark.

15. Accordingly, Opposer's assertion of confusion, dilution and damage is without merit. Applicant requests that this opposition be rejected and the registration of the mark "PHASE" (Serial No. 78/433,790), be approved.

Dated: August 11, 2005

Signature: /Anthony Maza/
Name: Anthony Maza
President, Phasedata Corp.

<p>I hereby certify that a true and complete copy of the foregoing Answer To Opposition has been served on M. Kelly Tillery by mailing said copy on August 11, 2005, via First Class Mail, postage prepaid to: M. Kelly Tillery Pepper Hamilton LLP 3000 Two Logan Square 18th and Arch Streets Philadelphia, PA 19103-2799</p>	<p>Correspondence address: Phasedata Corp. Anthony Maza Box 7711 Jupiter, FL 33468-7711 (561) 427-7221 Fax: (561) 427-7237</p>
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