

ESTTA Tracking number: **ESTTA88372**

Filing date: **07/05/2006**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Automated Solutions Corporation		
Entity	Corporation	Citizenship	Ohio
Address	3401 Brecksville Road Richfield, OH 44286 UNITED STATES		

Attorney information	David A. Kunselman Goodman Weiss Miller LLP 100 Erieview Plaza, 27th Floor Cleveland, OH 44114 UNITED STATES kunselman@goodmanweissmiller.com Phone:216-696-3366
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Applicant Information

Application No	78564411	Publication date	06/06/2006
Opposition Filing Date	07/05/2006	Opposition Period Ends	07/06/2006
Applicant	Paragon Data Systems, Inc. 2218 Superior Avenue Cleveland, OH 44114 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. All goods and services in the class are opposed, namely: distribution system for unit by unit distribution and composed of computer hardware, barcode scanners, bar code readers, and other indicia marking devices, namely, laser writers, and the associated computer software for operating the distribution system
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Attachments	Notice of Opposition (78564411).pdf (9 pages)(608325 bytes)
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Signature	/s/ David A. Kunselman
Name	David A. Kunselman
Date	07/05/2006

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

In re Application No. 78564411 for the mark SCDS
filed February 2, 2005 and published June 6, 2006

AUTOMATED SOLUTIONS CORPORATION,)	
)	
Opposer,)	
)	
v.)	Opp. No. _____
)	
PARAGON DATA SYSTEMS, INC.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Automated Solutions Corporation ("Automated"), a corporation duly organized and existing under the laws of the State of Ohio, having its headquarters at 3401 Brecksville Road, Richfield, Ohio 44286, believes that it will be damaged by the registration of the mark shown in Application Serial No. 78564411 filed by Applicant Paragon Data Systems, Inc. ("Applicant") on an intent-to-use basis, and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. § 1063.

As grounds for the opposition, Automated states the following:

1. Automated is the owner of all right, title, and interest in and to the mark SCDS.
2. Applicant knew of Automated's ownership rights to, and prior use of, the SCDS mark in interstate commerce when Applicant filed its intent-to-use application for registration of the SCDS mark in connection with identical goods and services as compared to Automated's use of the SCDS mark.

3. Applicant had no *bona fide* intention to use the SCDS mark in interstate commerce and only filed its application for registration of the SCDS mark in an improper attempt to gain advantage in connection with Automated's copyright infringement suit filed against Applicant in the U.S. District Court, Northern District of Ohio, Case No. 1:05-CV-1519.

4. Automated has been using the SCDS mark in commerce since April 30, 2001 in connection with its computer software for improving efficiency and accuracy of planning, distribution, collection, and electronic signature capture of deliverable items, namely, periodical publications and supplies; software for mobile, client, and server computers to allow accessing, creating, editing, managing and processing sales and field service data; communications software, namely, system applications and operating software for transferring data to and from databases, computer programs, and computer files via public and private telecommunications and computer networks; software interfaces for automatically exchanging data with circulation management and accounting software; software for managing security of electronic communication; software to automate logistics, analyze, and present sales and field service data; computer devices, computer peripherals, and accessories used for sales and field service; downloadable computer programs and files, electronic documents, and electronically distributable marketing and training materials for sales and field service and Automated claims a nationwide priority date of April 30, 2001 for that mark. This is evidenced by Automated's application for registration of the SCDS mark filed with the United States Patent and Trademark Office, Serial No. 78889040.

5. Since prior to the filing date of Applicant's application, and prior to any use date Applicant may claim for the SCDS mark, Automated used, advertised, and promoted its SCDS mark in interstate commerce in connection with computer software for improving efficiency and

accuracy of planning, distribution, collection, and electronic signature capture of deliverable items, namely, periodical publications and supplies; software for mobile, client, and server computers to allow accessing, creating, editing, managing and processing sales and field service data; communications software, namely, system applications and operating software for transferring data to and from databases, computer programs, and computer files via public and private telecommunications and computer networks; software interfaces for automatically exchanging data with circulation management and accounting software; software for managing security of electronic communication; software to automate logistics, analyze, and present sales and field service data; computer devices, computer peripherals, and accessories used for sales and field service; downloadable computer programs and files, electronic documents, and electronically distributable marketing and training materials for sales and field service.

6. Automated has invested substantial sums of money in developing, advertising, and marketing the goods and services offered in connection with the SCDS mark. These goods and services are offered to customers throughout the United States and the world.

7. Automated's SCDS mark has been, and will continue to be, widely publicized through substantial advertising in the United States. Automated has spent a great deal in connection with such advertising, which has been disseminated through internet websites, print media, periodicals, direct mail solicitations, and promotions at trade shows among other advertising methods.

8. The public has come to associate the SCDS mark with goods and services offered by Automated of high and uniform quality.

9. Because of the substantial sales, advertising expenditures, and publicity, the SCDS mark has become well known and famous among members of the purchasing public as distinctive indicators of the goods and services offered by Automated.

10. Consumers that subscribe to Automated's goods and services, or visit Automated's internet website, are able to obtain information and assistance in connection with a wide variety of subjects, including software that Automated markets under the name SCDS.

11. Notwithstanding Automated's prior established rights in the SCDS mark, Applicant has filed an application with the United States Patent and Trademark Office to register the very same mark (Serial No. 78564411) for goods and services identical in nature to those provided by Automated, namely International Class 009.

12. The dates of Automated's first use of the SCDS mark were prior to the date on which Applicant filed its application and prior to any first use date Applicant may claim.

13. According to its application, Applicant has made no use of its alleged mark as of the filing date of the application and has filed its application on an intent-to-use basis.

FALSE STATEMENTS - 18 U.S.C. § 1001

14. Applicant knew that it was not the owner of the SCDS mark at the time it filed its intent-to-use application for registration of said trademark.

15. Applicant did not believe, and knew, that it was not entitled to use the SCDS mark in commerce at the time it filed its intent-to-use application for registration of said mark.

16. Applicant knew at the time it filed its intent-to-use application for registration of the SCDS mark that Automated was the owner of said mark and applicant knew of Automated's prior use of said mark in interstate commerce in connection with identical goods and services for which Applicant now seeks registration on an intent-to-use basis.

17. Applicant further knew that any use by it, or registration by it, of the SCDS mark would likely cause confusion, mistake, and/or deception as to the source and/or origin of Applicant's goods and services and/or that Applicant is in some way connected with, sponsored by, or affiliated with Automated, all to Automated's irreparable damage.

LIKELIHOOD OF CONFUSION – § 2(d) (15 U.S.C. § 152(d))

18. Applicant's mark is identical to Automated's SCDS mark such that the use and registration thereof is likely to cause confusion, mistake, and deception as to the source or origin of Applicant's goods and services and will injure and damage Automated and the goodwill and reputation symbolized by the SCDS mark.

19. The goods and services of Applicant are identical or so closely related to the goods and services of Automated that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods and services are those of Automated's, or that Applicant is in some way connected with or sponsored by or affiliated with Automated, all to Automated's irreparable damage.

20. Likelihood of confusion in this case is enhanced by the fame of Automated's SCDS mark and by the fact that consumers associate this mark with goods and services sold, approved, or endorsed by Automated.

21. Likelihood of confusion is enhanced by the fact that the goods and services at issue are identical, and purchasers of Applicant's goods and services are prospective purchasers of Automated's goods and services.

DECEPTION/FALSE SUGGESTION OF CONNECTION – § 2(a) (15 U.S.C. § 2(a))

22. Applicant's mark is identical to Automated's SCDS mark, and it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that Applicant's mark misdescribes the nature or origin of the goods and services, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods and services, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods and services.

23. Applicant's mark is identical to Automated's SCDS mark and creates a false suggestion that Applicant is connected with Automated in violation of Section 2(a) of the Trademark Act, because Applicant's mark points uniquely to Automated, and purchasers will assume that goods and services offered under Applicant's mark are connected with Automated.

24. Applicant's mark is deceptive in that it falsely suggests a connection with or approval by Automated.

DILUTION – § 43(d) (15 U.S.C. § 1125(d))

25. Automated's SCDS mark has been widely used and extensively advertised in the United States and, therefore, the SCDS mark has become well-known and famous as distinctive symbols of Automated's goodwill.

26. On information and belief, Applicant intends to use its mark in commerce with the willful intent to trade on Automated's reputation or to cause dilution of Automated's famous SCDS mark.

27. Automated's SCDS mark became well-known and famous before Applicant's mark was first used.

28. Applicant's mark will cause dilution of the distinctive quality of Automated's SCDS mark.

29. Use or registration of Applicant's mark will lessen the capacity of Automated's famous SCDS mark to identify and distinguish Automated's goods and services.

30. Likelihood of confusion, dilution, and deception is enhanced by the fact that Applicant's mark is identical to Automated's mark and is likely to be used in connection with the same goods and services.

31. Likelihood of confusion, dilution, and deception is enhanced by the fact that the parties' goods and services will likely be sold through the same trade channels to the same classes of prospective purchasers.

32. Use and registration of Applicant's marks will deprive Automated of the ability to protect its reputation, persona, and goodwill.

33. Use and registration of Applicant's mark for the goods and services listed in its application will tarnish the goodwill symbolized by Automated's SCDS mark.

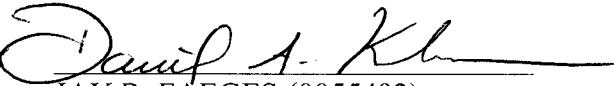
34. Likelihood of tarnishment and damage to Automated's goodwill are enhanced by the fact that prospective customers who encounter defects in the quality of Applicant's goods and services will attribute those defects to Automated, and this will tarnish Automated's reputation and goodwill.

35. By reason of the foregoing, Automated will be damaged by the registration of Applicant's mark, and registration should be refused.

WHEREFORE, Automated prays that this opposition be sustained and that Applicant's registration be denied.

Respectfully submitted,

AUTOMATED SOLUTIONS CORPORATION

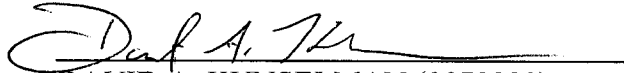
By 

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Automated Solutions Corporation*

CERTIFICATE OF SERVICE

I hereby certify that on July 5, 2006, a copy of the foregoing was filed electronically with the United States Patent and Trademark Office. Notice of this filing will be sent to all parties by operation of the electronic filing system. Parties may access this filing through the system.



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