

ESTTA Tracking number: **ESTTA490870**

Filing date: **08/24/2012**

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	The Minister for the Cabinet Office
Granted to Date of previous extension	08/26/2012
Address	70 Whitehall London, SW1A2AS UNITED KINGDOM

Domestic Representative	Mark Lerner Attorney for Opposer Satterlee Stephens Burke & Burke LLP 230 Park Avenue Suite 1130 New York, NY 10169-0079 UNITED STATES mlerner@ssbb.com,mwilliams@ssbb.com Phone:212-818-9200
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Applicant Information

Application No	77664852	Publication date	02/28/2012
Opposition Filing Date	08/24/2012	Opposition Period Ends	08/26/2012
Applicant	Itility, L.L.C. 40824 Manor House Road Leesburg, VA 20175 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2008/06/00 First Use In Commerce: 2008/06/00 All goods and services in the class are opposed, namely: Business management and consultation
Class 042. First Use: 2002/03/00 First Use In Commerce: 2002/03/00 All goods and services in the class are opposed, namely: Consulting in the field of information technology

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2028252	Application Date	05/22/1995
Registration Date	01/07/1997	Foreign Priority Date	NONE

Word Mark	ITIL
Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: data processing equipment, namely, computers and computer peripherals; computer programs for use in supervision and support of both data processing services and the activities and means to deliver data processing services</p> <p>Class 016. First use: printed materials, namely, manuals, hand books and study catalogs relating to the management of information technology services</p> <p>Class 035. First use: business organization consultancy and data processing services</p> <p>Class 041. First use: providing courses in the field of computers and data processing</p> <p>Class 042. First use: computer programming for others; computer system analysis for others; rental of computers and computer programs; consultation in the field of information technology</p>

U.S. Registration No.	2921901	Application Date	11/17/2000
Registration Date	02/01/2005	Foreign Priority Date	NONE

Word Mark	ITIL
Design Mark	

Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 1995/00/00 First Use In Commerce: 1997/00/00 Blank machine readable computer media, namely, floppy disks, hard disks and CD-ROM; software used to set up, operate and manage information technology systems; electronic publications, namely, books, magazines and manuals featuring information about the operation and management of information technology systems recorded on CD-ROM, audio tapes and video tapes</p> <p>Class 016. First use: First Use: 1995/00/00 First Use In Commerce: 1997/00/00 Publications, namely, printed guides, directories and instructional and teaching material, all in the field of information technology</p> <p>Class 042. First use: First Use: 1995/00/00 First Use In Commerce: 1997/00/00 Providing on-line databases featuring information about the operation and management of information technology systems</p>

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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/mark lerner/
Name	Mark Lerner
Date	08/24/2012

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

In the Matter of Trademark Application
Serial No. 77664852 Filed February 6, 2009
for the Trademark ITILITY
Published on February 28, 2012

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The Minister for the Cabinet Office :
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 : **NOTICE OF OPPOSITION**
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 : Opposer, :
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 : v. :
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 : Itility, L.L.C. :
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 : Applicant. :
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In the matter of the application of Itility, L.L.C. (hereinafter “Applicant”) for registration of the service mark ITILITY, application Serial No. 77664852, The Minister for the Cabinet Office, a government department of Her Majesty’s Government of the United Kingdom with a place of business at 70 Whitehall, London, United Kingdom SW1 A2AS (the “UK Cabinet Office” or “Opposer”), believes that it will be damaged by registration of the mark and hereby opposes the same. As grounds for opposition, it is alleged, upon information and belief, as follows:

1. In this opposition, Opposer, owner of the registered mark ITIL (Registration Nos. 2028252 and 2921901) seeks to prevent registration of the confusingly similar mark ITILITY in connection with “Business management and consultation” in International Class 35 and “Consulting in the field of information technology” in International Class 42.
2. Opposer has obtained the necessary extensions of time in which to file this Notice of Opposition.

The UK Cabinet Office's ITIL Marks

3. The UK Cabinet Office is the owner of the registered mark ITIL (Registration Nos. 2028252 and 2921901) ("ITIL Mark").
4. The registration for ITIL (Reg. No. 2028252) in International Classes 9, 16, 35, 41, and 42 was granted January 7, 1997 based on an application filed May 22, 1995 and on the foreign Registration No. 512209, granted on February 28, 1992 to Opposer by the Benelux Office for Intellectual Property. Said registration was renewed on April 24, 2007.
5. The registration of ITIL (Registration No. 2921901) in International Classes 9, 16, and 42 was granted February 1, 2005 based on an application filed November 17, 2000. The date of first use of this mark was 1995 and its first use in commerce was 1997.
6. The registrations for the ITIL Mark are valid and subsisting. Both registrations are incontestable under Sections 15 and 33 of the Lanham Act, 15 U.S.C. §§ 1065, 1115(b).
7. The UK Cabinet Office's registrations for the ITIL Mark together cover the following goods and services:
 - a. Data processing equipment, namely, computers and computer peripherals; computer programs for use in supervision and support of both data processing services and the activities and means to deliver data processing services; blank machine readable computer media, namely, floppy disks, hard disks and CD-ROM; software used to set up, operate and manage information technology systems; electronic publications, namely, books, magazines and manuals featuring information about the operation and management of information

technology systems recorded on CD-ROM, audio tapes and video tapes in Class 9;

- b. Publications, namely, printed guides, directories and instructional and teaching material, all in the field of information technology; printed materials, namely, manuals, hand books and study catalogs relating to the management of information technology services in Class 16;
- c. Business organization consultancy and data processing services in Class 35;
- d. Providing courses in the field of computers and data processing in Class 41; and
- e. Providing on-line databases featuring information about the operation and management of information technology systems; computer programming for others; computer system analysis for others; rental of computers and computer programs; consultation in the field of information technology in Class 42.

8. For over two decades, the UK Cabinet Office has used the ITIL Mark extensively throughout the world in connection with foregoing goods and services, all of which are held to the highest standards of quality controlled by and originating from the UK Cabinet Office. Opposer has invested in and built substantial goodwill in its ITIL Mark, which is widely recognized for superior goods and services in the field of information technology and data processing. ITIL[®] is the gold standard for information technology processes, and Opposer is recognized as a global leader in the field.

9. The ITIL[®] products and services provide flexible, practical and effective tools and guidance for identifying, planning, delivery and supporting information technology services to businesses and other organizations worldwide. Under the ITIL[®] brand, Opposer provides the foundation for quality information technology service management through documented, proven processes that cover the entire service lifecycle. Opposer offers training under ITIL[®] through hundreds of accredited training organizations, which are licensed to provide such instruction.

10. ITIL[®] products and services have been used by such companies as the Walt Disney Company for its global theme parks and resort operations, and by NASA.

Likelihood of Confusion

11. The filing of the applications for the ITIL Mark by Opposer precedes the filing of Applicant's application to register the mark ITILITY, as set forth in the materials filed by Applicant with the U.S. Patent and Trademark Office.

12. In its application, Applicant alleges that it has not used its ITILITY mark prior to June 2008 in connection with the services in International Class 35 and not before March 2002 in connection with the International Class 42 services.

13. Opposer's use in commerce of the ITIL Mark, since at least 1997, precedes Applicant's claimed use of its confusingly similar mark by eleven years in International Class 35 and at least five years in International Class 42.

14. Opposer is thus the senior user.

15. Due to the similarity between Applicant's mark and the ITIL Mark, the marks nearly identical services, as well as the similarity between their channels of trade, Applicant's registration and continued use of ITILITY is likely to cause confusion in the

marketplace and thereby cause harm to Opposer and to its title in the ITIL Mark. For these reasons, Applicant should not be granted registration of its mark.

16. Applicant's mark ITILITY is very similar to Opposer's ITIL Mark. The first two syllables of ITILITY are identical to ITIL. This similarity between the marks is sufficient to cause confusion for consumers as to the source of the goods and services offered under these marks. Indeed, Applicant's addition of the commonly-used suffix "ITY" to its mark causes ITILITY to connote merely the state or quality of "ITIL" and thus demonstrates that ITIL, in fact, is the dominant portion of the mark and that the parties' marks therefore create nearly the same commercial impression.

17. Due to its similarity to Opposer's marks, Applicant's mark is likely to lead consumers to mistakenly believe that Applicant's services, which are identical to Opposer's services, originate with, are authorized or sponsored by, or have some affiliation with Opposer and its goods and services, to the detriment of Opposer and its rights and interests in its registered ITIL Mark.

18. In addition, since Opposer is the senior registrant, Applicant is charged with adopting a mark that is not similar. With a world of available options, Applicant chose merely to add "ITY" to Opposer's registered mark. Given the longstanding, worldwide renown of ITIL[®] products and services, Applicant's selection of the mark ITILITY, which is a minor variation of Opposer's non-obvious, fanciful ITIL Mark, for services identical to Opposer's services, evidences Applicant's bad faith and intent to trade on Opposer's goodwill and pass off its services as if they are affiliated with Opposer and its services.

19. As noted above, Applicant uses its mark for, and its application covers, “business management and consultation” and “consulting in the field of information technology.”

20. Opposer has been using its ITIL Mark in connection with, and its registrations cover, among other goods and services, “business organization consultancy” and “consultation in the field of information technology.”

21. The parties’ marks thus cover the identical and directly competitive services.

22. Moreover, for over fifteen years in the United States alone, Opposer has been using its ITIL Mark in connection with other services and products, all highly regarded and well-known, for the information technology needs of businesses and governmental organizations. The goods and other services Opposer has long offered under the ITIL[®] brand are therefore closely related to Applicant’s services.

23. Given the close similarity between the marks, and the identical services offered under them, even sophisticated purchasers of business and informational technology consulting services are likely to be misled and confused if Applicant’s mark were to register and Applicant continues to use the ITILITY mark for its services.

24. As further demonstration of the likelihood of confusion, in its application for ITILITY, Applicant did not specifically limit the channels of trade for its services, which must therefore be assumed to be offered through all available channels. Thus, the channels of trade Opposer uses for its ITIL Mark’s goods and services must be encroached upon and overlapped by the channels of trade Applicant uses for identical services bearing the confusingly similar ITILITY mark. Applicant’s services, in whole or in part, therefore directly compete for

CERTIFICATE OF MAIL BY FIRST CLASS MAIL AND EXPRESS MAIL

I, Peter Carey, hereby certify that the forgoing Notice of Opposition was served on Applicant by depositing a true and correct copy with the United States Postal Service as U.S. First Class Mail, postage prepaid, in an envelope addressed to Theodore A. Breiner, Esq., Breiner & Briener, L.L.C., PO Box 320160, Alexandria, Virginia 22320-4160. The foregoing service on Applicant was deposited on the 24th day of August, 2012.



Peter Carey