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

Proceeding	91210331
Party	Defendant ProQuest LLC
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Date	05/09/2013
Attachments	INTOTA Opp Answer-1.pdf(111571 bytes)

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

In the matter of Trademark Application

Serial No.: 85656960
By: ProQuest LLC
For the Trademark: INTOTA
Published in the *Official Gazette*: December 25, 2012

ORC International Inc.,
Opposer,

v.

ProQuest LLC

Applicant.

Opposition No. 91210331

ANSWER AND AFFIRMATIVE DEFENSES

ProQuest LLC (“Applicant”), by and through its counsel, hereby answers the Notice of Opposition by addressing each allegation and stating affirmative defenses.

Answering the first part of the preamble of the Notice of Opposition, Applicant is without knowledge or information sufficient to admit or deny ORC International Inc.’s (“Opposer”) incorporation and location, and its claim of damage, and on that basis denies such allegations. Answering the second part of the preamble, Applicant admits the current owner of the above-referenced application for INTOTA (the “Application”) is ProQuest LLC, a limited liability company, with an address of 489 E. Eisenhower Parkway, Ann Arbor, Michigan, 48106.

ANSWER

1. Answering the allegations of Paragraph 1 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 1, and on that basis, denies the allegations.

2. Answering the allegations of Paragraph 2 of the Notice of Opposition, Applicant admits it owns an application to register the mark INTOTA, filed June 20, 2012 with the U.S. Patent & Trademark Office (“PTO”), Ser. No. 85656960, for “non-downloadable software and user interface that manages the selection, circulation, acquisition, cataloging, assessment, fulfillment, reporting and discovery of library resources” in International Class 041.

3. Answering the allegations set forth in the first part of Paragraph 3 of the Notice of Opposition, Applicant admits the PTO issued an Office Action on October 5, 2012 against Applicant’s mark. Answering the remaining allegations set forth in Paragraph 3 of the Notice of Opposition, Applicant admits that the Examining Attorney set forth the quoted statements in the Office Action issued on October 5, 2012, but Applicant denies that such statements amount to “findings” and, in any case, the initial objection was overcome.

4. Answering the allegations of Paragraph 4 of the Notice of Opposition, Applicant admits that Applicant amended the description of services in the Application to “providing on-line non-downloadable software and web-based user interface that serves as a management tool to allow libraries to manage the selection, circulation, acquisition, cataloging, assessment, fulfillment, reporting, and discovery of library resources,” and that it responded substantively to the Examining Attorney’s initial objection based on Opposer’s registration.

5. Answering the allegations of Paragraph 5 of the Notice of Opposition, Applicant admits the Application was published for opposition in the *Official Gazette* on

December 25, 2012 after Applicant submitted substantive arguments in response to the Office Action and amended the identification.

6. Answering the allegations of Paragraph 6 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 6, and on that basis, denies the allegations.

7. Answering the allegations of Paragraph 7 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 7, and on that basis, denies the allegations.

8. Answering the allegations of Paragraph 8 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 8, and on that basis, denies the allegations.

9. Answering the allegations of Paragraph 9 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 9, and on that basis, denies the allegations.

10. Answering the allegations of Paragraph 10 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 10, and on that basis, denies the allegations.

11. Answering the allegations of Paragraph 11 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 11, and on that basis, denies the allegations.

12. Answering the allegations of Paragraph 12 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 12, and on that basis, denies the allegations.

13. Answering the allegations of Paragraph 13 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 13, and on that basis, denies the allegations.

14. Answering the allegations of Paragraph 14 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 14, and on that basis, denies the allegations.

15. Answering the allegations of Paragraph 15 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 15, and on that basis, denies the allegations.

16. Answering the allegations of Paragraph 16 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 16, and on that basis, denies the allegations.

17. Answering the allegations of Paragraph 17 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 17, and on that basis, denies the allegations.

18. Answering the allegations of Paragraph 18 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 18, and on that basis, denies the allegations.

19. Answering the allegations of Paragraph 19 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 19, and on that basis, denies the allegations.

20. Answering the allegations of Paragraph 20 of the Notice of Opposition, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 20, and on that basis, denies the allegations.

21. Answering the allegations of Paragraph 21 of the Notice of Opposition, including subparts a and b, Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations outlined in Paragraph 21, and on that basis, denies the allegations.

FIRST GROUND FOR RELIEF

Applicant asserts the following affirmative defenses without conceding that it has the burden of proof or burden of producing evidence with respect to any of these issues.

AFFIRMATIVE DEFENSES

Applicant asserts the following affirmative defense without conceding that it has the burden of proof or burden of producing evidence with respect to any of these issues.

On information and believe, Opposer has made attempts to falsely align its expert witness services with library management services in an attempt to create confusion where none exists and on that basis, Opposer's claims are barred by the doctrine of Unclean Hands.

Wherefore, Applicant respectfully requests that the Notice of Opposition be rejected and Applicant's Mark be allowed to proceed to registration.

Date: May 9, 2013

COBALT LLP

By: /s/ Tsan Abrahamson

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 9th day of May 2013, a true and correct copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES was served upon Opposer by U.S. First Class Mail in an envelope, postage pre-paid, addressed as follows:

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