

ESTTA Tracking number: **ESTTA623546**

Filing date: **08/26/2014**

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	Insight Direct USA, Inc.
Granted to Date of previous extension	08/27/2014
Address	6820 South Harl Avenue Tempe, AZ 85283 UNITED STATES
Attorney information	Joshua W. Newman REED SMITH LLP 10 S WACKER DR CHICAGO, IL, IL 60606-7453 UNITED STATES ipdocket-chi@reedsmith.com, jnewman@reedsmith.com, nborder@reedsmith.com

Applicant Information

Application No	85936462	Publication date	04/29/2014
Opposition Filing Date	08/26/2014	Opposition Period Ends	08/27/2014
Applicant	Public Insight Corporation Suite 500 Hudson, OH 44236 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. First Use: 2012/10/30 First Use In Commerce: 2012/10/30 All goods and services in the class are opposed, namely: Providing online, non-downloadable software for collecting, storing, displaying, sharing, providing access to, and analyzing public and private data; cloud computing and software-as-a-service (SaaS) services featuring software for collecting, storing, displaying, sharing, providing access to, and analyzing public and private data
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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.	4508474	Application Date	06/08/2007
Registration Date	04/08/2014	Foreign Priority Date	NONE

Word Mark	INSIGHT
Design Mark	<h1>INSIGHT</h1>
Description of Mark	NONE
Goods/Services	<p>Class 037. First use: First Use: 1991/09/00 First Use In Commerce: 1991/09/00 Installation of computer hardware, servers, and networks; maintenance and repair of computer hardware, servers, and networks</p> <p>Class 042. First use: First Use: 1991/09/00 First Use In Commerce: 1991/09/00 Consulting services in the fields of selection and implementation of computer hardware and software systems for others for voice over internet protocol (VOIP) and internet telephony; Consulting services, namely, computer software, hardware, server, network and work station selection, implementation and design for others; computer software, hardware, server and network development; Technical support, namely, testing technological functions of computer hardware, servers and networks; computer services, namely, configuration of computer hardware, software, servers and networks; installation of computer software; implementation of computer software; testing and maintenance of computer software; technical support services, namely, troubleshooting of computer hardware and software problems; maintenance of computer software; computer security services, namely, restricting access by computer networks in connection with e-mail, spam, viruses, worms, websites, or other undesired content</p>

U.S. Registration No.	3690982	Application Date	06/08/2007
Registration Date	10/06/2009	Foreign Priority Date	NONE
Word Mark	INSIGHT		
Design Mark	<h1>INSIGHT</h1>		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1989/09/00 First Use In Commerce: 1989/09/00 Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer ac-		

	<p>cessories and supplies; asset disposal services, namely, assisting in the disposal of computer hardware, software, servers, networks, and workstations; labeling, tagging, and tracking services, namely, monitoring and tracking of computer hardware, software, servers, networks, and workstations; domestic and international pricing services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others</p> <p>Class 039. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 Electronic storage of computer data</p> <p>Class 042. First use: First Use: 2002/08/00 First Use In Commerce: 2002/08/00 Computer consultation in the field of computer hardware, software, server, network and workstation analyses for performance, access, configuration, compatibility, and connectivity; Leasing of computers, computer components and computer accessories; Leasing of computers, computer components and computer accessories, and supplies, namely, leasing of computers, servers, bridge/routers, hubs, workstations, laptop computers, monitors, computer cabinets and peripherals; Remote computer back-up services; consolidation of computer data, namely, electronic manipulation of dispersed data to centralized servers to facilitate efficient data back-up and archiving</p> <p>Class 045. First use: First Use: 1997/08/00 First Use In Commerce: 1997/08/00 Licensing of computer software</p>
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U.S. Registration No.	1940956	Application Date	12/08/1994
Registration Date	12/12/1995	Foreign Priority Date	NONE
Word Mark	INSIGHT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 1994/04/14 First Use In Commerce: 1994/04/14 mail order catalog services and retail store services of microcomputers and components, including sound boards, microprocessors, mother boards, memory chips, host adaptors, disk accelerators, controllers, acceleration boards; notebook computers and components, including sound boards, microprocessors, mother boards, memory chips, host adaptors, disk accelerators, controllers, acceleration boards; computer accessories and peripherals; CD-ROM components; software and accessories; printers, accessories and supplies; monitors, both internal and external; scanners; hard drives, both internal and external; floppy drives, both internal and external; tape backup components; data storage</p>		

	and mass storage products; memory systems; power supplies; modems; sound-equipment, namely speakers, headphones, microphones and sound cards; multi-mediacomponents, namely joysticks, drives, multimedia cards, software, speakers, microphones, video card and monitors, videotapes; PCMCIA cards and jacks; networking modules and products; T-shirts
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U.S. Registration No.	4396558	Application Date	11/12/2010
Registration Date	09/03/2013	Foreign Priority Date	NONE

Word Mark	INSIGHTCLOUD
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer accessories and supplies; domestic and international price comparison services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others</p> <p>Class 036. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Financial services, namely, financing services related to computer hardware, software, server, networks, and work stations; underwriting warranty programs in the field of computer hardware, software, servers, networks, and work stations; warranty claims administration services, namely, processing warranty claims for computer hardware, software, servers, networks and work stations</p> <p>Class 039. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Electronic storage of computer data</p> <p>Class 042. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31 Computer programming services; design, development, deployment, implementation, analysis, integration, and management of computer software for others; installation, modification, maintenance, and repair of computer software; customization and computer programming services for others in the field of computer software and hardware configuration management; managed information technology services and operations for others, namely, remote and on-site management of virtual infrastructure and cloud computing systems, networking, applications and storage services of others; application service provider services, namely, hosting computer software applications of others; providing temporary use of nondownloadable computer software for managing, testing, and using multiple operating systems; providing temporary use of nondownloadable computer software for managing virtual computing infrastructure, networking and storage; providing temporary use of nondownloadable computer software for creating and maintaining scalable cloud computing applications; leasing and</p>
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	<p>rental of computer software; technical support services, namely, trouble shooting of computersoftware and computer hardware; consulting services related to virtual infrastructure and the field of cloud computing;computer systems integration services; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of Internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer consultation in the field of computer hardware, software, server, network and workstation analyses for performance, access, configuration, compatibility, and connectivity; leasing of computers, computer components and computer accessories; leasing of computers, computer components and computer accessories, and supplies, namely, leasing of computers, servers,bridge/routers, hubs, workstations, laptop computers, monitors, computer cabinets and peripherals; remote computer back-up services; consolidation of computer data, namely, electronic manipulation ofdispersed data to centralized servers to facilitate efficient data back-up and archiving</p> <p>Class 045. First use: First Use: 2011/01/31 First Use In Commerce: 2011/01/31</p> <p>Licensing of computer software</p>
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Attachments	<p>77201950#TMSN.png(bytes) 77201689#TMSN.png(bytes) 74608621#TMSN.png(bytes) 85175925#TMSN.png(bytes) Notice of Opposition.pdf(2976630 bytes)</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	/Joshua W. Newman/
Name	Joshua W. Newman
Date	08/26/2014

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

Insight Direct USA, Inc.

Opposer,

v.

Public Insight Corporation,

Applicant.

Opposition No. _____

Application No.: 85/936,462
Filing Date: May 20, 2013
Publication Date: April 29, 2014
Mark: PUBLIC INSIGHT

NOTICE OF OPPOSITION

Insight Direct USA, Inc. (“Insight”), a corporation duly organized and existing under the laws of the State of Illinois, with its principal place of business located at 6820 South Harl Ave., Tempe, Arizona, 85283, will be damaged by the registration of the above-identified mark and hereby opposes the registration, pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.101.

As grounds for opposition, Insight alleges:

1. Opposer Insight is the owner of U.S. Trademark Registration Nos. 4,508,474 for INSIGHT, registered on April 8, 2014. The mark has been in use in commerce at least as early as September 30, 1991. The registration covers the following services in Classes 37 and 42:

IC 37: Installation of computer hardware, servers, and networks; maintenance and repair of computer hardware, servers, and networks.

IC 42: Consulting services in the fields of selection and implementation of computer hardware and software systems for others for voice over internet protocol (VOIP) and internet telephony; Consulting services, namely, computer software, hardware, server, network and work station selection, implementation and design for others; computer software, hardware, server and

network development; Technical support, namely, testing technological functions of computer hardware, servers and networks; computer services, namely, configuration of computer hardware, software, servers and networks; installation of computer software; implementation of computer software; testing and maintenance of computer software; technical support services, namely, troubleshooting of computer hardware and software problems; maintenance of computer software; computer security services, namely, restricting access by computer networks in connection with e-mail, spam, viruses, worms, websites, or other undesired content.

2. Opposer Insight is the owner of U.S. Trademark Registration No. 3,690,982 for INSIGHT, registered on October 6, 2009. The mark has been in use in commerce at least as early as September 30, 1989 for the services listed in Class 35, at least as early as August 31, 2002 for the services listed in Classes 39 and 42, and at least as early as August 31, 1997 for the services listed in Class 45. The registration covers the following services in Classes 35, 39, 42 and 45:


IC 35: Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer accessories and supplies; asset disposal services, namely, assisting in the disposal of computer hardware, software, servers, networks, and workstations; labeling, tagging, and tracking services, namely, monitoring and tracking of computer hardware, software, servers, networks, and workstations; domestic and international pricing services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others.

IC 39: Electronic storage of computer data.

IC 42: Computer consultation in the field of computer hardware, software, server, network and workstation analyses for performance, access, configuration, compatibility, and connectivity; Leasing of computers, computer components and computer accessories; Leasing of computers, computer components and computer accessories, and supplies, namely, leasing of computers, servers, bridge/routers, hubs, workstations, laptop computers, monitors, computer cabinets and peripherals; Remote computer back-up services; consolidation of computer data, namely, electronic manipulation of dispersed data to centralized servers to facilitate efficient data back-up and archiving.

IC 45: Licensing of computer software.

3. Opposer Insight is the owner of U.S. Trademark Registration No. 1,940,956 for

Insight (& Design) , registered on December 12, 1995. The mark has been in use in commerce at least as early as April 14, 1994. The registration covers the following services in Class 42:

IC 42: mail order catalog services and retail store services of microcomputers and components, including sound boards, microprocessors, mother boards, memory chips, host adaptors, disk accelerators, controllers, acceleration boards; notebook computers and components, including sound boards, microprocessors, mother boards, memory chips, host adaptors, disk accelerators, controllers, acceleration boards; computer accessories and peripherals; CD-ROM components; software and accessories; printers, accessories and supplies; monitors, both internal and external; scanners; hard drives, both internal and external; floppy drives, both internal and external; tape backup components; data storage and mass storage products; memory systems; power supplies; modems; sound equipment, namely speakers, headphones, microphones and sound cards; multimedia components, namely joysticks, drives, multimedia cards, software, speakers, microphones, video card and monitors, video tapes; PCMCIA cards and jacks; networking modules and products; T-shirts.

4. Opposer Insight is the owner of U.S. Trademark Registration No. 4,396,558 for INSIGHTCLOUD, registered on September 3, 2013. The mark has been in use in commerce at least as early as January 31, 2011. The registration covers the following services in Classes 35, 36, 39, 42 and 45:

IC 35: Distributorship services and computerized on-line retail store services featuring computer hardware and software, computer components and computer accessories and supplies; domestic and international price comparison services, namely, pricing computer hardware and software, computer components and computer accessories and supplies for others; domestic and international procurement services, namely, purchasing computer hardware and software, computer components and computer accessories and supplies for others.

IC 36: Financial services, namely, financing services related to computer hardware, software, server, networks, and work stations; underwriting warranty programs in the field of computer hardware, software, servers, networks, and work stations; warranty claims administration services, namely, processing warranty claims for computer hardware, software, servers, networks and work stations.

IC 39: Electronic storage of computer data.

IC 42: Computer programming services; design, development, deployment, implementation, analysis, integration, and management of computer software for others; installation, modification, maintenance, and repair of computer software; customization and computer programming services for others in the field of computer software and hardware configuration management; managed information technology services and operations for others, namely, remote and on-site management of virtual infrastructure and cloud computing systems, networking, applications and storage services of others; application service provider services, namely, hosting computer software applications of others; providing temporary use of nondownloadable computer software for managing, testing, and using multiple operating systems; providing temporary use of nondownloadable computer software for managing virtual computing infrastructure, networking and storage; providing temporary use of nondownloadable computer software for creating and maintaining scalable cloud computing applications; leasing and rental of computer software; technical support services, namely, trouble shooting of computer software and computer hardware; consulting services related to virtual infrastructure and the field of cloud computing; computer systems integration services; technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of Internet technology and services; technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems; computer consultation in the field of computer hardware, software, server, network and workstation analyses for performance, access, configuration, compatibility, and connectivity; leasing of computers, computer components and computer accessories. leasing of computers, computer components and computer accessories, and supplies, namely, leasing of computers, servers, bridge/routers, hubs, workstations, laptop computers, monitors, computer cabinets and peripherals; remote computer back-up services; consolidation of computer data, namely, electronic manipulation of dispersed data to centralized servers to facilitate efficient data back-up and archiving.

IC 45: Licensing of computer software.

5. Opposer Insight owns all rights in and to the ‘474, ‘982, ‘956 and ‘558 registrations and the marks depicted therein. The registered marks of Opposer Insight are valid and subsisting and are prima facie evidence of Opposer Insight’s exclusive rights to use said marks in commerce on the services specified in the registrations.

6. Opposer Insight’s use of the ‘474, ‘982, ‘956 and ‘558 registrations has been valid and continuous since the dates of first use and has not been abandoned. Opposer Insight’s

INSIGHT, INSIGHT (& Design)  , and INSIGHTCLOUD marks are symbolic

of extensive good will and consumer recognition built up by Opposer Insight through substantial amounts of time and effort in advertising and promotion, and have come to identify Insight and distinguish its goods and services from those of competitors—which is of significant value to Opposer Insight.

7. Applicant Public Insight Corporation seeks to register the trademark PUBLIC INSIGHT in Class 42 for the following services:

IC 42: Providing online, non-downloadable software for collecting, storing, displaying, sharing, providing access to, and analyzing public and private data; cloud computing and software-as-a-service (SaaS) services featuring software for collecting, storing, displaying, sharing, providing access to, and analyzing public and private data.

8. Given the similarity of Applicant Public Insight Corporation's mark, and the related nature of the services and channels of trade, registration of the mark depicted in U.S. Trademark Application No. 85/936,462 will create a serious conflict with Opposer Insight's trademark use and registrations. This conflict is likely to cause confusion, mistake, or deception as to affiliation, connection, or association of Applicant Public Insight Corporation with Opposer Insight, or as to the origin, sponsorship, or approval of Applicant Public Insight Corporation's services by Opposer Insight (which they are not).

9. Based on Opposer Insight's averments herein, registration of U.S. Application No. 85/936,462 should be denied.

WHEREFORE, Opposer Insight hereby petitions the Board for an Order denying registration of the mark depicted in U.S. Application No. 85/936,462.

DATED this the 26th day of August, 2014

s/ Nina Habib Borders

Nina Habib Borders
REED SMITH LLP
1510 Page Mill Road
Palo Alto, CA 94304
Telephone: +1 650 352 0500
Facsimile: +1 650 352 0699
nborders@reedsmith.com

James T. Hultquist
Joshua W. Newman
REED SMITH LLP
10 South Wacker Drive
Chicago, IL 60606-7507
Telephone: +1 312 207-1000
Facsimile: +1 312 207-6400
jhultquist@reedsmith.com
jnewman@reedsmith.com

Counsel for Insight Direct USA, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served via First Class U.S. Mail and electronic mail on Applicant's Attorney/Correspondent of Record:

David Movius
MCDONALD HOPKINS LLC
600 Superior Avenue, East
Suite 2100
Cleveland, OH 44144

Dated: August 26, 2014



Attorney for Opposer