

ESTTA Tracking number: **ESTTA732605**

Filing date: **03/10/2016**

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	Authentix, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	4355 Excel Parkway, Suite 100 Addison, TX 75001 UNITED STATES		

Attorney information	Jennifer S. Sickler Thompson & Knight LLP 333 Clay Street, Suite 3300 Houston, TX 77002 UNITED STATES jennifer.sickler@tklaw.com, anita.gray@tklaw.com Phone:713-653-8611		
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Applicant Information

Application No	85690000	Publication date	02/16/2016
Opposition Filing Date	03/10/2016	Opposition Period Ends	03/17/2016
International Registration No.	NONE	International Registration Date	NONE
Applicant	Authenticateit Pty Ltd Level 15 Melbourne, Victoria, 3004 AUSTRALIA		

Goods/Services Affected by Opposition


<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Electronic apparatus and systems, namely, computer hardware and software systems for use in monitoring, tracking and recording information in respect of the manufacture, transport and sale of goods and subsequent resale of goods; electronic apparatus and systems, namely, computer hardware and software systems for verifying whether goods are genuine; computer software, namely, computer software for monitoring, tracking and recording information in respect of the manufacture, transport and sale of goods and subsequent resale of goods; computer software for verifying whether goods are genuine</p>
<p>Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Verification services for checking whether goods are genuine offered across data communication networks, namely, electronic document authentication services; monitoring and tracking services for goods, namely, providing a website featuring technology that allows users to record information pertaining to the location of goods, the origin of goods and the subsequent transport and sale of goods and pertaining to current and past ownership of such goods</p>
<p>Class 045. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Verification services for checking whether</p>

goods are genuine, namely, anti-counterfeiting consulting in the fields of product and document authentication and tracking, and brand monitoring and protection, to protect against counterfeiting, tampering, and diversion, and to ensure the integrity of genuine products and documents; provision of product and document authentication and tracking information in alert notification form relating to monitored sales of goods for the purpose of protecting against counterfeiting, tampering and diversion and to ensure the integrity of genuine products and documents

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by blurring	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4426948	Application Date	03/16/2012
Registration Date	11/05/2013	Foreign Priority Date	NONE
Word Mark	AUTHENTIX		
Design Mark			
Description of Mark	The mark consists of the word "AUTHENTIX" in stylized font with a check mark overlapping the top part of the letter "x".		
Goods/Services	<p>Class 001. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Chemicals, chemical compounds, isotopically labeled chemical compounds, and biochemicals used as trace additives to indicate ownership or origin of tagged fluids and materials; chemical and biochemical reagents for non-medical purposes, namely, for use in authenticating goods in the oil and gas, banking, currency, paper, coin and bank note manufacture, pharmaceutical, alcohol, tobacco, consumer goods, medical, pharmaceutical, explosives, and agrochemical industries; chemicals for use in industry, namely, chemical markers for use in industrial oils and greases, lubricants, fuels, illuminants, gas, natural gas, and liquefied natural gas; ingestible and edible organic compounds in the nature of proteins, saccharides, oligonucleotides and DNA markers for authenticating goods for use in the manufacture of spirit drinks, pharmaceuticals, nutraceuticals and food products</p> <p>Class 002. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Polychromatic color shifting printing inks; fluorescent dyes for general industrial use, printing inks, and security coatings in the nature of colorants; dyes and inks, namely, dyes and inks used as colorants in the manufacture of markers; printing inks, coatings, pigments and dispersions for use on labels, cartons and packaging</p> <p>Class 005. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Herbicides, pesticides, and fungicides</p> <p>Class 009. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Computer software for applying anti-counterfeiting and authentication technologies to customer goods, documents, product packaging, digitally produced im-</p>		


ages, and labels for use in the field of labeling, serialization, tracing, or tracking of same; computer software for detecting counterfeits and verifying the authenticity of customer goods, documents, product packaging, digitally produced images, and labels; software used for verifying banknote fitness and bank note authentication; RFID (Radio Frequency Identification) cards; blank and encoded electronic chip cards for security, access control, and item and people tracking purposes; database management software for organization and presentation of data related to products marked for purposes of product authentication, namely, chemicals, pharmaceuticals, alcohol, petroleum products, fuels and oils, product packaging and product labeling, and for organization and presentation of data related laboratory analysis of samples for authentication, chain of custody verification, and marker identification and use; hologram apparatuses, namely, hologram writers, hologram printers, hologram readers, hologram projectors; holographs, namely, electronic machines used to apply holographic overlay and to set up and control holograms and their verification; integrated circuits for holographic recordings embedded into plastic cards; magnetically encoded credit cards; apparatus and instruments for marking and labeling of products for purposes of product authentication and chain of custody verification, namely, printers, readers, namely, bar code and optical readers, and scanners for inks, compounds, dispersion or polymer concentrates containing marking compounds; encoded micro particulates, tags and taggants of plastic, metal or silicate for use in the field of passive labeling, tracing or tracking of persons, animals and goods; encoded micro taggants of plastic, metal or silicate for use in the field of passive labeling, tracing or tracking of industrial oils and greases, lubricants, fuels, illuminants, gas, natural gas, and liquefied natural gas

Class 035. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00
Business investigations and consultation, namely, providing business investigations, analysis and consultation including field sampling and customized reporting in the fields of product marker development, product tag development and product labeling; business risk management, namely, risk analysis of product supply chains, namely, raw material and finished product distributor and supply chains, for purposes of anti-counterfeiting, anti-diversion and anti-product tampering; business management and consulting, namely, design, implementation and management of product authentication and chain of custody programs; excise tax recovery services; cost accounting, namely, providing analysis of revenue lost from counterfeiting, diversion and product tampering; business consultation in the field of tracking and tracing of packages in transit, in particular relating to verification of chain of custody of delivered parcels

Class 039. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00
Consulting services in the field of parcel product delivery

Class 042. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00
Development of new technology for others in the field of chemical identification markers; data automation and collection service using proprietary software to evaluate, analyze and collect service data; product quality control sampling; product authentication in the chemical, pharmaceutical, healthcare, alcohol, petroleum, banking, currency, consumer goods, industrial goods, agrochemicals, explosives, and tobacco industries; consulting services in the field of product labeling, product quality control sampling and laboratory analysis of samples, all in the field of product tracking, chain of custody verification and product authentication; scientific and laboratory services for engineering and product sample testing for use in anti-counterfeiting, manufacturing, quality control, and development of new technology for others in the fields of product markers for purposes of product authentication and chain of custody verification; providing consultation in the development of chemical identification markers; developing chemical identification markers

Class 045. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00
Private investigations and related consulting in connection with product counter-

	feiting, diversion, brand degradation and liability claims; private investigation services, namely, compiling chain of custody evidence for purposes of anti-counterfeiting, anti-diversion and anti-product tampering actions; consulting services, namely, consultation in the fields of product and document authentication and tracking, and brand monitoring and protection, to protect against counterfeiting, tampering, and diversion, and to ensure the integrity of genuine products and documents		
U.S. Registration No.	4426947	Application Date	02/23/2012
Registration Date	11/05/2013	Foreign Priority Date	NONE
Word Mark	AUTHENTIX		
Design Mark			
Description of Mark	The mark consists of the word "AUTHENTIX" in stylized white font with an orange check mark overlapping the top part of the letter "X". The foregoing elements appear on a solid black background.		
Goods/Services	<p>Class 035. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Business investigations and consultation, namely, providing business investigations, analysis and consultation including field sampling and customized reporting in the fields of product marker development, product tag development and product labeling; business risk management, namely, risk analysis of product supply chains, namely, raw material and finished product distributor and supply chains, for purposes of anti-counterfeiting, anti-diversion and anti-product tampering; business management and consulting, namely, design, implementation and management of product authentication and chain of custody programs; excise tax recovery services; cost accounting, namely, providing analysis of revenue lost from counterfeiting, diversion and product tampering; business consultation in the field of tracking and tracing of packages in transit, in particular relating to verification of chain of custody of delivered parcels</p> <p>Class 039. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Consulting services in the field of parcel product delivery</p> <p>Class 042. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Development of new technology for others in the field of chemical identification markers; data automation and collection service using proprietary software to evaluate, analyze and collect service data; product quality control sampling; product authentication in the chemical, pharmaceutical, healthcare, alcohol, petroleum, banking, currency, consumer goods, industrial goods, agrochemicals, explosives, and tobacco industries; consulting services in the field of product labeling, product quality control sampling and laboratory analysis of samples, all in the field of product tracking, chain of custody verification and product authentication; scientific and laboratory services for engineering and product sample testing for use in anti-counterfeiting, manufacturing, quality control, and development of new technology for others in the fields of product markers for purposes of product authentication and chain of custody verification; providing consultation in the development of chemical identification markers; developing chemical identification markers</p>		

	Class 045. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Private investigations and related consulting in connection with product counterfeiting, diversion, brand degradation and liability claims; private investigation services, namely, compiling chain of custody evidence for purposes of anti-counterfeiting, anti-diversion and anti-product tampering actions; consulting services, namely, consultation in the fields of product and document authentication and tracking, and brand monitoring and protection, to protect against counterfeiting, tampering, and diversion, and to ensure the integrity of genuine products and documents
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U.S. Registration No.	3796039	Application Date	07/06/2007
Registration Date	06/01/2010	Foreign Priority Date	NONE

Word Mark	AUTHENTIX
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: First Use: 2004/01/31 First Use In Commerce: 2004/01/31 Business consulting related to the enforcement of intellectual property rights; Business consulting services in the field of managing intellectual properties; Business risk management, namely, risk analysis of product supply chains, namely, raw material, and distributor and supply chains, for purposes of anti-counterfeiting, anti-diversion and anti-product tampering; Business management and consulting, namely, design, implementation and management of product authentication and chain of custody programs; business consulting relating to product labeling</p> <p>Class 042. First use: First Use: 2004/01/31 First Use In Commerce: 2004/01/31 Data automation and collection services using proprietary software to evaluate, analyze and collect service data; Data automation and collection services, namely, analysis of revenue loss from counterfeiting, diversion and product tampering; Product quality control sampling; Laboratory analysis of samples for the purpose of product authentication; Product authentication in the chemical, pharmaceutical, healthcare, alcohol, petroleum, currency, consumer goods, industrial goods, agrochemicals, and tobacco industries; Consulting services in the field of product labeling, product quality control sampling and laboratory analysis of samples, all in the field of product tracking, chain of custody verification and product authentication; Scientific and laboratory services for engineering and product sample testing for use in anti-counterfeiting, manufacturing, quality control and development of new technology for others in the fields of product markers for purposes of product authentication and chain of custody verification; Providing consultation in the development of chemical identification markers; Developing chemical identification markers</p> <p>Class 045. First use: First Use: 2004/01/31 First Use In Commerce: 2004/01/31 Private investigation services, namely, compiling chain of custody evidence for-</p>
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	<p>purposes of anti-counterfeiting, anti-diversion and anti-product tampering actions; Consulting and investigation services to protect others against product counterfeiting, diversion, brand degradation and liability claims; Enforcement of intellectual property rights of others by issuing cease and desist letters and advising on enforcement strategies; reviewing legal standards and practices concerning compliance with intellectual property rights of others</p>
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U.S. Registration No.	3159814	Application Date	11/13/2003
Registration Date	10/17/2006	Foreign Priority Date	NONE
Word Mark	AUTHENTIX		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2004/01/05 First Use In Commerce: 2004/01/05 Business investigation and consultation, namely providing investigation and consultation regarding analysis, field sampling, tag development and investigation services to others</p>		

U.S. Registration No.	3059466	Application Date	11/13/2003
Registration Date	02/14/2006	Foreign Priority Date	NONE
Word Mark	AUTHENTIX		

Design Mark	<h1>AUTHENTIX</h1>
Description of Mark	NONE
Goods/Services	Class 001. First use: First Use: 2003/11/19 First Use In Commerce: 2003/11/19 Chemicals used as trace additives to indicate ownership or origin of tagged fluids and substances

U.S. Registration No.	2931992	Application Date	11/13/2003
Registration Date	03/08/2005	Foreign Priority Date	NONE
Word Mark	AUTHENTIX		
Design Mark	<h1>AUTHENTIX</h1>		
Description of Mark	NONE		

Goods/Services	Class 042. First use: First Use: 2003/11/19 First Use In Commerce: 2003/11/19 Data automation and collection services using proprietary software to evaluate, analyze and collect service data, reviewing standards and practices to assure compliance with intellectual property rights of others and legal services, namely enforcement of intellectual property rights of others
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U.S. Registration No.	2922927	Application Date	11/13/2003
Registration Date	02/01/2005	Foreign Priority Date	NONE

Word Mark	AUTHENTIX
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 002. First use: First Use: 2003/11/19 First Use In Commerce: 2003/11/19 Polychromatic color shifting inks, fluorescent dyes and inks and other security-coatings, dyes and inks, namely dyes and inks used in paint
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Attachments	76710944#TMSN.png(bytes) 76710690#TMSN.png(bytes) 77223598#TMSN.png(bytes) 78327628#TMSN.png(bytes) 78327580#TMSN.png(bytes) 78327621#TMSN.png(bytes) 78327634#TMSN.png(bytes) Authentix9028NoticeofOpposition.pdf(139330 bytes)
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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	/Jennifer S. Sickler/
Name	Jennifer S. Sickler
Date	03/10/2016

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

AUTHENTIX, INC.,	§	
	§	
Opposer,	§	Opposition No. _____
	§	
vs.	§	
	§	In the matter of:
	§	U.S. Trademark Application Serial No.
Authenticateit Pty Ltd,	§	85/690,000 for AUTHENTICATEIT design
	§	
	§	
Applicant.	§	

NOTICE OF OPPOSITION

Authentix, Inc., (“Authentix” or “Opposer”) a Delaware corporation, having a business address of 4355 Excel Parkway, Suite 100, Addison, Texas 75001, believes that it has been and will continue to be damaged by Authenticateit Pty Ltd.’s (“Applicant’s”) trademark application, U.S. Trademark Application No. 85/690,000, and hereby opposes the same in all International Classes. As grounds for its opposition, Authentix alleges, upon actual knowledge with respect to itself and its own acts, and upon information and belief as to other matters:

1. Authentix, Inc., by and through its predecessors (collectively “Authentix”), is one of the world’s leading producers and providers of anti-counterfeiting and authentication products and services.

2. Authentix owns U.S. Trademark Registration No. 4,426,948 for AUTHENTIX (design) in Classes 1, 2, 5, 9, 35, 39, 42, and 45; No. 4,426,947 for AUTHENTIX (design) in Classes 35, 39, 42, and 45; No. 3,796,039 for AUTHENTIX in Classes 35, 42, and 45; No. 3,487,437 for AUTHENTIX in Class 9; No. 3,159,814 for AUTHENTIX in Class 35; No. 3,059,466 for AUTHENTIX in Class 1; No. 2,931,992 for AUTHENTIX in Class 42; and No.

2,922,927 for AUTHENTIX in Class 2. These registrations, as well as Opposer’s common law trademark rights, which extend to other goods and services, are referred to herein as the “AUTHENTIX Marks”. As a result of Authentix’s extensive use and promotion of the AUTHENTIX Marks, Authentix has developed valuable trademark rights and good will in its marks. Further, due to widespread, long-term use, the AUTHENTIX Marks have become well known within the anti-counterfeiting/ authentication industry for goods and services.

3. Since at least as early as June 1996, Opposer has used, and continues to use, the AUTHENTIX Marks in connection with the manufacture, marketing, and sale of anti-counterfeiting and authentication products and services.

4. On information and belief, the name and address of the listed owner of U.S. Trademark Application Serial No. 85/690,000 for AUTHENTICATEIT (design) is Authenticateit Pty Ltd (“Applicant”), an Australian company, having a business address of Level 15, 10 Queens Road, Melbourne, Victoria, Australia 3004.

5. According to the U.S. Patent and Trademark Office records, Applicant filed U.S. Trademark Application Serial No. 85/690,000 (the “‘000 Application”) on July 30, 2012 for authentication and anti-counterfeiting goods and services, as follows:

Class	Goods/Services
9	Electronic apparatus and systems, namely, computer hardware and software systems for use in monitoring, tracking and recording information in respect of the manufacture, transport and sale of goods and subsequent resale of goods; electronic apparatus and systems, namely, computer hardware and software systems for verifying whether goods are genuine; computer software, namely, computer software for monitoring, tracking and recording information in respect of the manufacture, transport and sale of goods and subsequent resale of goods; computer software for verifying whether goods are genuine
42	Verification services for checking whether goods are genuine offered across data communication networks, namely, electronic document authentication services; monitoring and tracking services for goods, namely, providing a website featuring technology that allows users to record information pertaining to the location of goods, the origin of goods and the subsequent transport and sale of goods and pertaining to current and past ownership of such goods

45	Verification services for checking whether goods are genuine, namely, anti-counterfeiting consulting in the fields of product and document authentication and tracking, and brand monitoring and protection, to protect against counterfeiting, tampering, and diversion, and to ensure the integrity of genuine products and documents; provision of product and document authentication and tracking information in alert notification form relating to monitored sales of goods for the purpose of protecting against counterfeiting, tampering and diversion and to ensure the integrity of genuine products and documents
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6. Applicant’s ‘000 Application is likely to cause confusion, mistake, and deception about the origin of Applicant’s goods and services, and will dilute the distinctiveness of Opposer’s AUTHENTIX Marks. Applicant’s goods and services sold under the AUTHENTICATEIT mark are identical to or closely related to Opposer’s goods and services under the AUTHENTIX Marks. Applicant’s mark begins with “AUTHENTI-” and includes a check mark symbol, the same as the AUTHENTIX design marks. Applicant’s mark is deceptively similar to Opposer’s, and Applicant’s conduct is calculated to and will cause irreparable loss, injury, and damage to Opposer’s business and its good will in the AUTHENTIX Marks.

7. Authentix has priority to the AUTHENTIX Marks based upon its valid and subsisting prior trademark registrations. In addition, Authentix has priority based upon its prior use of the AUTHENTIX Marks in commerce in connection with its products and services. Further, Authentix used the AUTHENTIX Marks in commerce before any date of first use that Applicant may establish in connection with Applicant’s AUTHENTICATEIT design mark.

8. Unless the ‘000 Application is refused, Opposer will be denied the benefits of its registrations and trademark rights.

WHEREFORE, Opposer respectfully requests that the Notice of Opposition be sustained and that Application Serial No. 85/690,000 be refused on all grounds. The Commissioner is authorized to charge Deposit Account 20-0821 (519624.009027) for the notice of opposition fee, and any additional fees required by this filing.

Dated: March 10, 2016

Respectfully submitted,

/s/ Jennifer S. Sickler

Jennifer S. Sickler

Reg. No. 36,500

THOMPSON & KNIGHT LLP

333 Clay Street, Suite 3300

Houston, Texas 77002

Phone: 713-653-8611

Fax: 832-397-8290

**ATTORNEYS FOR OPPOSER
AUTHENTIX, INC.**

CERTIFICATE OF TRANSMITTAL

I hereby certify that a true and correct copy of the foregoing Notice of Opposition is being filed electronically with the TTAB via ESTTA on this 10th day of March 2016.

/s/ Jennifer S. Sickler

Jennifer S. Sickler

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition was served by certified mail, return receipt requested, postage pre-paid, and by email on this 10th day of March, 2016, upon Applicant's attorney of record, at the correspondence address of record:

Mr. Steven A. Abreu
Sunstein Kann Murphy & Timbers LLP
125 Summer Street
Boston, Massachusetts 02110-1618
Email: trademarks@sunsteinlaw.com

/s/ Jennifer S. Sickler

Jennifer S. Sickler

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