

ESTTA Tracking number: **ESTTA789060**

Filing date: **12/14/2016**

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	ReviMedia, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	44 Wall Street Suite 505 New York, NY 10005 UNITED STATES		

Attorney information	Joshua M. Gerben, Esq. Gerben Law Firm, PLLC 1050 Connecticut Ave NW Suite 500 Washington, DC 20036 UNITED STATES jgerben@gerbenlawfirm.com Phone:202-294-2287		
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Applicant Information

Application No	79172036	Publication date	11/29/2016
Opposition Filing Date	12/14/2016	Opposition Period Ends	12/29/2016
International Registration No.	1263734	International Registration Date	03/30/2015
Applicant	manroland web systems GmbH Alois-Senefelder-Allee 1 GERMANY		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Data processing equipment, computers; computer software for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; data processing apparatus and data processing equipment for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; blank storage apparatus for computer data, namely, blank digital storage media; software used for processing data for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; information technology and audiovisual equipment for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access, namely, computer networking hardware; blank USB flash drives; blank compact discs, Blank DVDs, and digital recording media in the nature of DVD recording apparatus; blank electronic, machine-readable and optical data carriers; data processing programs, software and software interfaces for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access, namely, industrial process control software; graphic inputscreens and graphic interfaces in the form of computer programs for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance

ance and remote access; computer screens and process computers; data processing equipment, electronic sensors and control and regulating software for use in printing machines and printing installations, for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; pressure measuring instruments for printing machines for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; electronic apparatus in the nature of image processors for use in processing and editing images, lines, texts, and layouts for the purpose of for the computer-aided manufacture of printing plates for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; apparatus for recording, transmission or reproduction of images or information; none of the foregoing goods include electrical power distribution and management hardware for computers, computer servers and other electrically powered devices

Class 035. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Advertising; business management; business administration; providing office functions; business management regarding top production control and production monitoring of machines and industrial installations, in particular of installations for producing printed matter

Class 042. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Design and development of computer hardware and computer software for connecting computer networks engaged in pre-stage printer production processes and printing processes, for dispatch and administration of printer processes, and for integration of machine default systems for printing machines into open workflows for digitized print production, for use by publishing companies and print works companies; design of software applications for linking print works to print clients and print work suppliers via the internet and for handling print jobs, for use by publishing companies and print works companies

Grounds for Opposition

Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)
Other	Void ab Initio for Lack of Bona Fide Intent to Use

Attachments	PX and Design Opposition_ Dec 14.pdf(125525 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	/Joshua M. Gerben/
Name	Joshua M. Gerben, Esq.
Date	12/14/2016

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

ReviMedia, Inc.

Opposer,

v.

Manroland web systems GmbH,

Applicant,

Opposition No.: _____

Mark: PX and Design

Application Serial No: 79/172036

NOTICE OF OPPOSITION

ReviMedia, Inc. (hereinafter referred to as “Opposer”), a Delaware corporation, believes that it will be damaged by the registration of the mark shown in Application Serial No. 79/172036 and hereby opposes this application. The application was filed by Manroland web systems GmbH, a German limited liability company (hereinafter referred to as “Applicant”), and was published in the Official Gazette on November 29, 2016.

As grounds for the opposition, Opposer alleges as follows:

1. Opposer filed the PX.COM and Design mark (the “Opposer’s Mark”) on October 5, 2015, ser. no. 86/777862 (“Opposer’s Application”) for advertising and website services featuring lead generation resources in International Classes 35 and 42 (“Opposer’s Services”).
2. The Applicant filed an extension of protection under Section 66(a) on March 30, 2015 for PX and Design (the “Applicant’s Mark”) for:

IC 009 -Data processing equipment, computers; computer software for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; data processing apparatus and data processing equipment for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; blank storage apparatus for computer

data, namely, blank digital storage media; software used for processing data for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; information technology and audiovisual equipment for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access, namely, computer networking hardware; blank USB flash drives; blank compact discs, Blank DVDs, and digital recording media in the nature of DVD recording apparatus; blank electronic, machine-readable and optical data carriers; data processing programs, software and software interfaces for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access, namely, industrial process control software; graphic input screens and graphic interfaces in the form of computer programs for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; computer screens and process computers; data processing equipment, electronic sensors and control and regulating software for use in printing machines and printing installations, for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; pressure measuring instruments for printing machines for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; electronic apparatus in the nature of image processors for use in processing and editing images, lines, texts, and layouts for the purpose of for the computer-aided manufacture of printing plates for production management and control of webfed, sheetfed and digital printing presses and printing plants as well as remote maintenance and remote access; apparatus for recording, transmission or reproduction of images or information; none of the foregoing goods include electrical power distribution and management hardware for computers, computer servers and other electrically powered devices

IC 035 - Advertising; business management; business administration; providing office functions; business management regarding to production control and production monitoring of machines and industrial installations, in particular of installations for producing printed matter

IC 042 - Design and development of computer hardware and computer software for connecting computer networks engaged in pre-stage printer production processes and printing processes, for dispatch and administration of printer processes, and for integration of machine

default systems for printing machines into open workflows for digitized print production, for use by publishing companies and print works companies; design of software applications for linking print works to print clients and print work suppliers via the internet and for handling print jobs, for use by publishing companies and print works companies

(collectively “Applicant’s Goods and Services”) and was assigned Serial Number 79/172036 (the “Applicant’s Application”).

3. On July 29, 2016, a USPTO Trademark Examining Attorney suspended Opposer’s Application because the Trademark Examining Attorney was concerned that the Applicant’s Mark and Opposer’s, if co-existing, could cause confusion in the marketplace.

4. Because the registration of Applicant’s Mark presumably gives it at least a *prima facie* exclusive right in Applicant’s Mark, Opposer maintains that its legal use and registration of the PX.COM and Design mark will be impaired by the registration of Applicant’s Mark and thus, Opposer believes it will be damaged.

**COUNT 1: APPLICATION VOID AB INITIO FOR
LACK OF BONA FIDE INTENT TO USE TRADEMARK**

5. Upon information and belief, Applicant did not have a *bona fide* intent to use the PX and Design mark on all of Applicant’s Goods and Services when it filed the Applicant’s Application, a requirement for extension of protection for a Madrid Protocol filing.

6. Upon information and belief, Applicant has taken no business activities with respect to Applicant’s Mark.

7. Upon information and belief, Applicant has engaged in no business planning with respect to Applicant’s Mark.

8. Upon information and belief, Applicant has no documents that would support its alleged *bona fide* intent to use Applicant’s Mark in commerce.

9. Applicant is an active company in Germany, but, according to its website, does not and has not offered any kind of advertising, business management, business administration or other services.

10. Upon information and belief, Applicant is not planning to significantly change its current business model to accommodate “Advertising; business management; business administration; providing office functions.”

11. In view of the fact that Applicant had no bona fide intent to use the PX and Design mark on all of Applicant’s Goods and Services when it filed its application, the Applicant’s Application is *void ab initio* and therefore should be refused registration under the Lanham Act.

12. If Applicant is granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration would be a source of damage and injury to Opposer.

**COUNT 2: FRAUD ON THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

13. Upon information and belief, Opposer alleges that Applicant’s Application was approved for publication based on a fraudulent sworn statement filed with Applicant’s Application on November 29, 2016, in which it was stated that Applicant had “a bona fide intention to use or use through the applicant’s related company or licensee the mark in commerce on or in connection with the goods/services in the application.” Upon information and belief, said statement was false. Opposer alleges that Applicant did not have a *bona fide* intent to use Applicant’s Mark on all of Applicant’s Goods or Services. Said statement was made by an authorized agent of Applicant with the knowledge that said statement was false. Said false statement was made with the intent to induce the United States Patent and Trademark Office Examining Attorney to grant registration, and,

reasonably relying on said false statement, the United States Patent and Trademark Office published Applicant's Application to the Original Gazette.

14. Applicant is an active company in Germany, but, according to its website, does not and has not offered any kind of advertising, business management, business administration or other services.

15. Upon information and belief, Applicant is not planning to significantly change its current business model to accommodate "Advertising; business management; business administration; providing office functions," services listed in Applicant's Application.

16. In view of the above, Applicant is not entitled to federal registration of Applicant's Mark because Applicant's Application is *void ab initio* for lack of a *bona fide* intent-to-use the mark in commerce and because Applicant secured publication of Applicant's Application through knowingly perpetrating fraud on the USPTO by signing false affidavits in connection with Applicant's Application.

17. By reason of all the foregoing, Opposer will be gravely damaged by the registration of Applicant's mark.

WHEREFORE, by its undersigned attorney, ReviMedia, Inc. respectfully requests that this Notice of Opposition be sustained and that registration of the mark PX and Design, Serial No. 79/172036, be refused.

Dated: December 14, 2016

Respectfully submitted,



Joshua M. Gerben, Esq.
Eric J. Perrott, Esq.
Attorneys for Opposer
Gerben Law Firm, PLLC
1050 Connecticut Ave NW

Suite 500
Washington, DC 20036
Phone: 202.294.2287
Email: jgerben@gerbenlawfirm.com
eperrott@gerbenlawfirm.com

CERTIFICATE OF SERVICE

I hereby certify that on December 14, 2016, a true and correct copy of the foregoing Opposer's Notice of Opposition has being served by First Class mail, return receipt requested on Opposer as shown in the correspondence record in the Office, as follows:

L. Jeremy Craft and Andrew W. Chu
CRAFT CHU PLLC
1445 North Loop West, Suite 410
Houston, TEXAS UNITED STATES 77008

Dated: December 14, 2016



Josh Gerben, Esq.
Attorney for Opposer
1050 Connecticut Ave NW
Suite 500
Washington, DC 20036
Phone: 202.294.2287
Fax: 202.315.3386
Email: jgerben@gerbenlawfirm.com