

ESTTA Tracking number: **ESTTA825006**

Filing date: **06/05/2017**

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	Zendesk, Inc.
Granted to Date of previous extension	06/04/2017
Address	1019 Market Street San Francisco, CA 94103 UNITED STATES

Attorney information	Thomas M. Hadid Cooley LLP 1299 Pennsylvania Ave., NW Suite 700 Washington, DC 20004 UNITED STATES trademarks@cooley.com, thadid@cooley.com, peckah@cooley.com, vbocek@cooley.com Phone:3108836448
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Applicant Information

Application No	87105279	Publication date	12/06/2016
Opposition Filing Date	06/05/2017	Opposition Period Ends	06/04/2017
Applicant	GAVS TECHNOLOGIES N.A. INC. 10901 W. 120th Ave., Suite 110, Broomfield, CO 800213419 UNITED STATES		

Goods/Services Affected by Opposition

Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Information technology consulting services

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.	3818497	Application Date	01/16/2009
Registration Date	07/13/2010	Foreign Priority Date	07/17/2008
Word Mark	ZENDESK		

Design Mark	<h1>ZENDESK</h1>		
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 [Recorded and downloadable computer software, namely, computer software for business management, database management, customer service management and management of customer relations; software for electronic communications] * Recorded and downloadable computer software, namely, computer software for business information and communications management, business database management, customer service management and management of customer relations all of the foregoing directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; software for electronic communications within businesses and between businesses and their customers, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality *</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Assistance in business management and business administration; compilation and systematization of information into computer databases; business information provided through local and global computer networks; rental of advertising space on the internet; [retail store and] on-line retail store services featuring computer software</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Telecommunications, namely, transmission of communications, information and data through local and global computer networks; communication services, namely, transmission of voice, audio, visual images and data by local and global computer networks; rental of access time to global computer networks, namely, providing telecommunications access to databases relating to management of customer relationships</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 [Computer programming; design, development and customization of computer software; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships] * Computer programming in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; design, development and customization of computer software in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality *</p>		

U.S. Registration No.	4390500	Application Date	05/16/2012
Registration Date	08/27/2013	Foreign Priority Date	NONE

Word Mark	ZENDESK
Design Mark	
Description of Mark	The mark consists of a lotus flower with seven leaves and a heart center and the word "zendesk" to the right of the flower.
Goods/Services	<p>Class 009. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Recorded and downloadable computer software, namely, computer software for business information and communications management, business database management, customer service management and management of customer relations all of the foregoing directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; software for electronic communications within businesses and between businesses and their customers, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality</p> <p>Class 035. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Business management consulting; compilation and systemization of information into computer databases; business information provided through local and global computer networks</p> <p>Class 038. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet</p> <p>Class 042. First use: First Use: 2008/07/06 First Use In Commerce: 2008/07/06 Computer programming in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; design, development and customization of computer software in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality</p>

Attachments	79068289#TMSN.png(bytes) 85627163#TMSN.png(bytes) Zendesk - Notice of Oppositon re ZDESK.pdf(42363 bytes)
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Signature	/Thomas M. Hadid/
Name	Thomas M. Hadid
Date	06/05/2017

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

In the Matter of Application Serial No. 87/105,279
For the Trademark ZDESK
Published in the *Official Gazette* on December 6, 2016

ZENDESK, INC.,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
GAVS TECHNOLOGIES N.A. INC.,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer Zendesk, Inc. (“Zendesk”), a Delaware corporation with a principal address at 1019 Market Street, San Francisco, California 94103, will be damaged by the issuance of a registration for the mark ZDESK (the “Applicant’s Mark”), as applied for in Application Serial No. 87/105,279, filed on July 15, 2016, by Applicant Gavs Technologies N.A. Inc., a New Jersey corporation with a principal address of 10901 West 120th Avenue, Suite 110, Broomfield, Colorado 80021 (“Applicant”). Zendesk, having previously been granted extensions of time to oppose Applicant’s Mark, hereby timely opposes the same.

As grounds for its opposition, Zendesk alleges as follows.

1. Zendesk is a public company providing scalable customer and employee service and engagement software and support designed to improve customer relationships through higher customer engagement and better customer insights. In particular, Zendesk’s web-based software and mobile applications allow businesses to engage their customers to develop long-standing, loyal relationships by helping those businesses to better answer consumers’ questions

and resolve issues through a variety of channels, including but not limited to email, chat, voice, social media, and websites. Moreover, Zendesk solutions amalgamate the information garnered from these consumer interactions and assists its customers in amalgamating and analyzing that data so customers can track progress as well as set and meet performance and sales goals. In addition, Zendesk has also developed solutions to improve relationships among employees, including but not limited to among Human Resources and Information Technology departments. (Altogether referred to as the “ZENDESK Goods and Services.”) Through the excellence of its products and services and Zendesk’s promotion of these offerings, Zendesk has come to serve over 101,000 businesses in the United States and abroad, with over 500,000 unique U.S.-based visitors each month. Zendesk had revenues of over \$312 million in 2016 alone (a 49% increase from the prior year), and its customer base includes famous and highly recognizable brands and institutions, including but not limited to, Uber, L’Oreal, Shopify, Box, the University of Southern California, the FCC, Vodafone, Xerox, and Groupon.

2. Zendesk has marketed and sold the Zendesk Goods and Services under the ZENDESK trademark (the “ZENDESK Mark”) since 2008.

3. Zendesk owns the following valid and subsisting United States registrations for the ZENDESK Mark:

- ZENDESK, U.S. Reg. No. 3,818,497, issued on July 13, 2010, for:

Class 09: Recorded and downloadable computer software, namely, computer software for business information and communications management, business database management, customer service management and management of customer relations all of the foregoing directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; software for electronic communications within businesses and between businesses and their customers, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality

Class 35: Assistance in business management and business administration; compilation and systematization of information into computer databases; business information provided through local and global computer networks; rental of advertising space on the internet; on-line retail store services featuring computer software

Class 38: Telecommunications, namely, transmission of communications, information and data through local and global computer networks; communication services, namely, transmission of voice, audio, visual images and data by local and global computer networks; rental of access time to global computer networks, namely, providing telecommunications access to databases relating to management of customer relationships

Class 42: Computer programming in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; design, development and customization of computer software in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality



- ZENDESK and Design (), U.S. Reg. No. 4,390,500, issued on August 27, 2013, for:

Class 09: Recorded and downloadable computer software, namely, computer software for business information and communications management, business database management, customer service management and management of customer relations all of the foregoing directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; software for electronic communications within businesses and between businesses and their customers, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality

Class 35: Recorded and downloadable computer software, namely, computer software for business information and communications management, business database management, customer service management and management of customer relations all of the foregoing directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; software for electronic communications within businesses and between

businesses and their customers, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality

Class 38: Telecommunication services, namely, transmission of voice, data, graphics, images, audio and video by means of telecommunications networks, wireless communication networks, and the Internet

Class 42: Computer programming in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; design, development and customization of computer software in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality

4. On July 15, 2016, nearly a decade after Zendesk began use of the ZENDESK Mark in the United States, Applicant filed an application to register the mark ZDESK on an intent to use basis in connection with “[i]nformation technology consulting services” (the “ZDESK Application”).

5. The ZENDESK Mark is known among consumers of customer service, consumer engagement, employee management (including but not limited to within information technology departments), and telecommunications software and related services.

6. Zendesk began using the ZENDESK Mark and filed applications resulting in federal registrations for its ZENDESK Mark well prior to the filing date of the ZDESK Application and, on information and belief, well prior to any actual use of Applicant’s Mark.

7. The ZENDESK Mark is inherently distinctive and strong.

8. Applicant's Mark will appear to the consuming public to be shorthand for the ZENDESK Mark. The parties' respective marks are, overall, confusingly similar in sight, sound, and commercial impression.

9. As described in the ZDESK Application, Applicant's Mark is intended for use in connection with services directly overlapping and highly related to those Zendesk offers under the ZENDESK Mark.

10. Upon information and belief, Applicant's targeted customer base overlaps with the consumers of Zendesk's Goods and Services.

11. As Applicant's description of services contains no restrictions or limitations as to Applicant's channels of trade, it should be assumed that Applicant's Mark, like the ZENDESK Mark, will be used in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant's intended channels of trade for its ZDESK Mark services overlap with channels of trade used by Zendesk in marketing, selling, and otherwise distributing its goods and services marketed under the ZENDESK Mark.

12. If Applicant is permitted to register Applicant's Mark for the services specified in the Application herein opposed, confusion resulting in damage and injury to Zendesk would occur. Persons familiar with the ZENDESK Mark would likely perceive Applicant's services as associated with, affiliated with, or sponsored by Zendesk. Such confusion would inevitably result in damage to Zendesk.

13. Zendesk's customers and the relevant public are likely to misapprehend Applicant's Mark as a Zendesk mark rather than a mark of Applicant and/or believe in error that services offered under the Applicant's Mark are offered by, in association with, or under license from Zendesk.

14. Any defect, objection to, or fault found with Applicant's services marketed under Applicant's Mark would necessarily reflect on and seriously injure the reputation that Zendesk has established for the ZENDESK Goods and Services.

15. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use that mark, all to the detriment of Zendesk. As such, for the reasons set forth herein, registration of Applicant's Mark should be denied pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

WHEREFORE, based on the foregoing, Opposer requests that the Board sustain this Opposition and that registration of Application Serial No. 87/105,279 be refused.

COOLEY LLP

Date: June 5, 2017

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