ESTTA Tracking number: **ESTTA1020636**

Filing date: **12/06/2019**

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

Proceeding	91240636
Party	Plaintiff Information Builders, Inc.
Correspondence Address	HOWARD F MANDELBAUM MANDELBAUM SILFIN ECONOMOU LLP 222 BLOOMINGDALE RD STE 203 WHITE PLAINS, NY 10605 UNITED STATES hmandelbaum@msellp.com, docketing@msellp.com 914-421-0500
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Ira E. Silfin
Filer's email	isilfin@msellp.com, docketing@msellp.com
Signature	/Ira E. Silfin/
Date	12/06/2019
Attachments	191206 Amended Petition for Cancellation.pdf(274752 bytes)

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

Information Builders, Inc.,	Opposition No. 91240636 Cancellation No. 92068353
Plaintiff,	Serial No. 87545631 NFOCUS
v.	Serial No. 87546877 NFOCUS SOLUTIONS
SWMG Productions, Inc.,	Reg. No. 4248979 NFOCUS SOLUTIONS BRIDGING THE GAP
Defendant.	

AMENDED PETITION TO CANCEL

Plaintiff, Information Builders, Inc., a corporation of the State of New York, having a principal place of business at 2 Penn Plaza, New York, New York 10121-2898, believes that it will be damaged by registration of the mark identified above, and hereby petitions to cancel this registration.

The grounds for the petition are as follows:

1. Plaintiff produces, markets and/or licenses computer software for database management, for use in decision support systems, and for information control, reporting, and networking, including designing, building, and maintaining databases, recording, processing, analyzing and displaying data and information in a wide variety of industries and other fields, and provides to its customers support services including education in

the use of software, and technical support and consultation in connection with implementation and installation of the software.

2. Since 1975, Plaintiff has been marketing its software under the trademark FOCUS to computer users in a wide variety of industries and providing consulting services in connection with its FOCUS software for use in the management of business, and Plaintiff has registered its trademark in the Patent and Trademark Office under Nos. 1,652,265 and 2,821,942.

3. In the early 1980's, Plaintiff began marketing its software under various additional trademarks which include the word FOCUS. Plaintiff is also the owner of the following Patent and Trademark Office registrations:

Registration No.	**Trademark**
2,248,562	WEBFOCUS
2,685,249	WEBFOCUS

4. Plaintiff sells computerized instruction and training courses, accompanied by related printed materials, for teaching the use of FOCUS software.

5. Plaintiff renders consulting services in connection with its FOCUS software for use in the management of business.

6. Plaintiff has published a magazine entitled FOCUS SYSTEMS JOURNAL, and newsletters entitled FOCUS NEWS and FOCUS FLASH, distributed to computer users, as well as an online magazine

entitled “The FOCUS Quarterly”, and currently publishes WEBFOCUS Journal.

7. Plaintiff established “The Focus Users Group” (FUSE) for its customers, and now holds annual conferences at which representatives of those who use FOCUS software attend educational workshops, see product demonstrations, and otherwise exchange information about FOCUS software.

8. Defendant, SWMG Productions, Inc. DBA NFOCUS Solutions’ Registration No. 4,248,979 covers the trademark and service mark NFOCUS SOLUTIONS BRIDGING THE GAP and Design for “computer software for use in data collection, tracking, and impact/outcome measurement for the public sector” in class 9, and “technology services, namely, providing temporary use of on-line nondownloadable software for tracking and measuring the impact of programs and services offered by public schools, nonprofit organizations, and government agencies” in Class 42.

9. Defendant alleged a date of first use of October 28, 2011, and a date of first use in commerce of November 18, 2011.

10. Because Plaintiff first used its trademarks in 1975, Plaintiff has priority of use over Defendant.

11. Upon information and belief, Defendant’s goods and services are so closely related to Plaintiff’s and Plaintiff's licensee's software, the printed and online materials distributed

by Plaintiff, and Plaintiff's services, that use of similar marks on the respective goods and services of the parties is likely to cause confusion or mistake, or to deceive purchasers as to the origin or sponsorship of the goods and services.

12. Upon information and belief, the registration by Defendant of NFOCUS SOLUTIONS BRIDGING THE GAP and Design for goods and services closely related to Plaintiff's and Plaintiff's licensee's goods and services threatens to impair Plaintiff's free use of its trademark, and will result in injury to the good will Plaintiff has acquired with respect to its trademark, all to Plaintiff's damage.

13. Defendant has admitted that "Defendant's software services are primarily web-based and only small components of each software product may be downloadable to mobile devices and/or desktop computers." On information and belief, Defendant does not distribute physical copies of the software under the trademark in the applications.

14. Because Defendant does not distribute software, there was no bona fide use of defendant's marks in commerce prior to the filing of the use-based applications for registration under Trademark Act § 1(a), 15 U.S.C. § 1051(a). Therefore, its registration in class 9 should be canceled.

WHEREFORE, Plaintiff prays that this petition for cancellation be sustained, and that U.S. Trademark and Service Mark Registration No. 4,248,979 be cancelled.

Dated: December 6, 2019

Ira E. Silfin
Mandelbaum Silfin Economou LLP
222 Bloomingdale Road, Suite 120
White Plains, NY 10605
(914) 421-0500

Attorneys for Plaintiff

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing AMENDED PETITION TO CANCEL has been forwarded on December 6, 2019 by email to:

Michael F Campillo
Venjuris PC

at

mcampillo@venjuris.com
aroberts@nfocus.com
dray@nfocus.com
emistarz@nfocus.com

/IES/
_____
Ira E. Silfin