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

Proceeding	91240636
Party	Plaintiff Information Builders, Inc.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	12/06/2019
Attachments	191206 Amended Notice of Opposition.pdf(273011 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 NOTICE OF OPPOSITION

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 marks identified above, and hereby opposes such registration.

The grounds for the opposition are as follows:

1. Plaintiff is a business intelligence company that 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 seeks to register NFOCUS and Design, and NFOCUS SOLUTIONS and Design for "Computer software for use in data collection, tracking, and impact/outcome measurement for the public sector" in Class 9 and "Providing temporary use of on-line non-downloadable 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 dates of first use and dates of first use in commerce of November 30, 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 of the goods and services.

12. Upon information and belief, the registration by Defendant of NFOCUS and Design, and NFOCUS SOLUTIONS and Design

for goods and services closely related to Plaintiff's and Plaintiff's licensee's goods and services will 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 denied that it distributes software under the trademarks in the applications by download or over the internet for download. On information and belief, Defendant has not and does not distribute physical copies of the software under the trademarks in the applications.

14. Because Defendant has not and 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 applications to register the trademarks in class 9 should be rejected.

WHEREFORE, Plaintiff prays that the registrations for which application has been made be disallowed, and that this opposition be sustained.

Dated: December 6, 2019

/s/ IES

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 NOTICE OF OPPOSITION has been forwarded on December 6, 2019 by email to:

Michael F Campillo
Venjuris PC

at

mcampillo@venjuris.com
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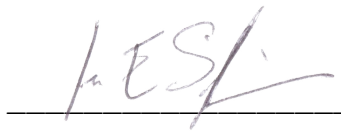

Ira E. Silfin