

ESTTA Tracking number: **ESTTA1002938**

Filing date: **09/18/2019**

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	TOOLBOX TVE, LLC		
Entity	Limited Liability Company	Citizenship	Florida
Address	323 SUNNY ISLES BLVD., 7TH FLOOR SUNNY ISLES BEACH, FL 33160 UNITED STATES		

Attorney information	Rafael Perez-Pineiro The Brickell IP Group PLLC 1101 BRICKELL AVE FL 8 South Tower Miami, FL 33131 UNITED STATES rperez@brickellip.com, rguerra@brickellip.com 3057288831		
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Applicant Information

Application No	87624706	Publication date	08/20/2019
Opposition Filing Date	09/18/2019	Opposition Period Ends	09/19/2019
Applicant	Scale Computing, Inc. Suite 3E 525 S. Meridian Street Indianapolis, IN 46225 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: Hybrid cloud computing services, namely, Infrastructure as a Service (IaaS), Off-site disaster recovery as a Service (DRaaS), cloud bursting services for purposes of extending the storage and compute capabilities of local computing systems, and IT infrastructure migration and cloud storage gateway services
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Applicant Information

Application No	87624701	Publication date	08/20/2019
Opposition Filing Date	09/18/2019	Opposition Period Ends	09/19/2019
Applicant	Scale Computing, Inc. Suite 3E 525 S. Meridian Street Indianapolis, IN 46225		

UNITED STATES

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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	88419223	Application Date	05/07/2019
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CLOUD UNITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2016/01/09 First Use In Commerce: 2016/01/09 Software as a Service (SaS) for interconnection of applications, data, databases, computer systems, and application programming interfaces (APIs); governance and management of web services, APIs, and interconnected applications; consulting services in the field of interconnection of applications, data, databases, computer systems, and application programming interfaces (APIs)		

Attachments	Notice of Opposition.pdf(155485 bytes)
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Signature	/Rafael Perez-Pineiro/
Name	Rafael Perez-Pineiro
Date	09/18/2019

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

TOOLBOX TVE, LLC,)	Mark: CLOUD UNITY
)	Filed: September 27, 2017
Opposer,)	Serial No. 87/624,706
)	
v.)	Mark: HC3 CLOUD UNITY
Scale Computing, Inc.)	Filed: September 27, 2017
)	Serial No. 87/624,701
Applicant.)	
)	

NOTICE OF OPPOSITION

TOOLBOX TVE, LLC (“Opposer”), a Florida limited liability company, believes it will be damaged by registration on the Principal Register of the marks CLOUD UNITY, shown in Application Serial No. 87/624,706 (“the ’706 Application”), and HC3 CLOUD UNITY, shown in Application Serial No. 87/624,701 (“the ’701 Application”), filed by Scale Computing, Inc. (“Applicant”), both published in the Official Gazette on August 20, 2019 (“Opposed Applications”), and hereby opposes the same. Applicant’s CLOUD UNITY and HC3 CLOUD UNITY marks are collectively referred to as “Applicant’s Marks.” As grounds for this opposition, it is alleged as follows:

1. On information and belief, Applicant is a Delaware corporation having a principal place of business located at 525 S. Meridian Street, Indianapolis, Indiana 46225.
2. On May 7, 2019, Opposer filed a trademark application in International Class 42 for the mark CLOUD UNITY, shown in Application Serial No. 88/419,223 (“the ’223 Application”), in connection with “Software as a Service (SaS) for interconnection of

applications, data, databases, computer systems, and application programming interfaces (APIs); governance and management of web services, APIs, and interconnected applications; consulting services in the field of interconnection of applications, data, databases, computer systems, and application programming interfaces (APIs)” (“Opposer’s Services”). The ’223 Application sets forth a date of first use of at least as early as January 9, 2016. The specimen of use submitted on May 7, 2019 in connection with the ’223 Application was not objected to by the United States Patent and Trademark Office (“USPTO” or the “Office”).

3. By virtue of its continuous and extensive use in interstate commerce since 2016, the mark CLOUD UNITY shown in the ’223 Application filed by Opposer has acquired substantial goodwill.

4. On September 27, 2017, Applicant filed the ’706 Application in International Class 42 for the mark CLOUD UNITY in connection with “Hybrid cloud computing services, namely, Infrastructure as a Service (IaaS), Off-site disaster recovery as a Service (DRaaS), cloud bursting services for purposes of extending the storage and compute capabilities of local computing systems, and IT infrastructure migration/gateway services.” The services recited in the ’706 Application were amended during the examination of the application to read: “Hybrid cloud computing services, namely, Infrastructure as a Service (IaaS), Off-site disaster recovery as a Service (DRaaS), cloud bursting services for purposes of extending the storage and compute capabilities of local computing systems, and IT infrastructure migration and cloud storage gateway services.”

5. On September 27, 2017, Applicant filed the ’701 Application in International Class 42 for the mark H3 CLOUD UNITY in connection with “Hybrid cloud computing services, namely, Infrastructure as a Service (IaaS), Off-site disaster recovery as a Service

(DRaaS), cloud bursting services for purposes of extending the storage and compute capabilities of local computing systems, and IT infrastructure migration/gateway services.” The services recited in the ’701 Application were amended during the examination of the application to read: “Hybrid cloud computing services, namely, Infrastructure as a Service (IaaS), Off-site disaster recovery as a Service (DRaaS), cloud bursting services for purposes of extending the storage and compute capabilities of local computing systems, and IT infrastructure migration and cloud storage gateway services.”

6. The services specified for the ’701 and ’706 Applications at the time of their publication are identical (“Applicant’s Services”).

7. The Opposed Applications were filed as intent-to-use (“ITU”) trademark applications and do not set forth a date of first use. Applicant did not submit any evidence of use of Applicant’s Marks prior to the date that the Opposed Applications were approved for publication. The constructive date of first use for an ITU application is its filing date. The Opposed Applications have a constructive date of first use for Applicant’s Marks of September 27, 2019.

8. On July 20, 2019, the USPTO issued an Office Action in connection with Opposer’s ’223 Application. In the Office Action, the Office cited to the Opposed Applications and indicated that the Opposed Applications precede the filing date of the ’223 Application. Specifically, the Office stated that “[i]f the marks in the referenced applications register, applicant’s mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the marks.”

9. Prior to the filing date of the Opposed Applications and before any alleged commencement of use (there has been no allegation of use) of the marks shown in the Opposed

Applications anywhere or in commerce, Opposer has offered, sold, and provided and continue to offer, sell and provide in interstate commerce goods and services under the mark CLOUD UNITY.

10. Opposer's CLOUD UNITY mark has been prominently and extensively used and promoted in commerce nationwide since before the filing date of the Opposed Applications, or before any alleged commencement of use by Applicant of Applicant's Marks anywhere or in commerce for any of Applicant's goods or services, for and in connection with goods or services sold, provided, and marketed nationwide, said services including, but not limited to the Opposer's Services. Opposer's CLOUD UNITY mark has also been used in commerce since before the filing date of the Opposed Applications, or before any alleged commencement of use by Applicant of Applicant's Marks anywhere or in commerce for any of Applicant's Services, for and in connection with Software as a Service (SaaS) and consulting services.

11. As a result of the extensive use and promotion of Opposer's CLOUD UNITY mark by Opposer, Opposer is now and for some time has been the owner of strong and valuable common law exclusive rights and goodwill in Opposer's CLOUD UNITY mark for Opposer's Services, which rights and goodwill arose and subsisted long before the filing of the Opposed Applications or any earlier use of Applicant's Marks for any of Applicant's Services.

12. Opposer has expended considerable time, effort, and expense in using, promoting, advertising, popularizing, and making known Opposer's CLOUD UNITY mark for and in connection with Opposer's Services, with the result that Opposer has established extensive and valuable exclusive rights and goodwill in Opposer's CLOUD UNITY mark as a symbol of a source or origin of Opposer's Services.

13. Applicant's Services are related to all or part of Opposer's Services offered under

Opposer's CLOUD UNITY mark. On information and belief, Applicant's Services are or will be offered and/or provided under Applicant's Marks through the same channels of trade and advertising media and are or will be directed to the same general class of purchasers as Opposer's Services offered and provided under Opposer's CLOUD UNITY mark.

14. Applicant's Marks sought to be registered in the Opposed Applications so resembles Opposer's CLOUD UNITY mark as to be likely, when used on, for, or in connection with Applicant's Goods, to cause confusion, or to cause mistake, or to deceive.

15. Purchasers and prospective purchasers as well as the public at large are all likely to mistakenly believe that Applicant's Services offered or sold under Applicant's Marks of the Opposed Applications are produced, sponsored, endorsed, or approved by the source of Opposer's Services sold, marketed or provided under Opposer's CLOUD UNITY mark, and/or that the source of Applicant's Services is in some way affiliated, connected, or associated with the source of Opposer's Services sold, marketed or provided under Opposer's CLOUD UNITY mark, all to the detriment of and damage to Opposer and its goodwill connected with Opposer's CLOUD UNITY mark. Registration of Applicant's Marks for the goods of the Opposed Applications should, therefore, be refused under at least 15 U.S.C. § 1052(d).

16. Upon information and belief, there was no bona fide intent to use Applicant's CLOUD UNITY mark by Applicant prior to the filing of the Opposed Applications and/or there is no present bona fide intent to use Applicant's CLOUD UNITY mark by Applicant. Registration of Applicant's CLOUD UNITY mark of the '706 Application should, therefore, be refused under at least 15 U.S.C. § 1051(b).

17. Registration of Applicant's Marks would be a still further source of damage to Opposer because it would, among other things, confer upon Applicant various statutory

presumptions to which it is not entitled in view of Opposer's prior use in and with respect to Opposer's CLOUD UNITY mark and its superior rights therein under the federal Trademark Act, Title 15 of the United States Code.

COUNT I
LIKELIHOOD OF CONFUSION

18. Opposer repeats and re-alleges paragraphs 1 to 17 above as if set forth herein at length.

19. The registration of Applicant's Marks to Applicant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant's Goods are made by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), all to Opposer's irreparable damage.

COUNT II
NO BONA FIDE INTENT TO USE

20. Opposer repeats and re-alleges paragraphs 1 to 17 above as if set forth herein at length.

21. Applicant's '706 Application is void ab initio as Applicant had no good faith bona fide intent to use the CLOUD UNITY mark for Applicant's Services.

22. Applicant's actions in filing the intent to use '706 Application is insufficient to establish a bona fide intent to use the CLOUD UNITY mark as applied for.

23. Applicant has taken no steps to begin commercial use of the CLOUD UNITY mark either prior to or subsequent to the filing of the '706 Application.

24. When Applicant filed the '706 Application, Applicant had no objective bona-fide intent to use Applicant's CLOUD UNITY mark.

WHEREFORE, Opposer prays that the application for registration of Scale Computing, Inc.'s Serial Nos. 87/624,706 and 87/624,701 be denied and that this Opposition be sustained as to both applications.

Date: September 18, 2019

Respectfully submitted,

/Rafael Perez-Pineiro/
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Attorney for Opposer

CERTIFICATE OF SERVICE

This is to certify that a true and exact copy of the foregoing NOTICE OF OPPOSITION
is being served on Applicant by electronic mail to:

Daniel L. Boots
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ptodocket@bgdlegal.com
Bingham Greenebaum Doll LLP
10 West Market Street
Suite 2700
Indianapolis, Indiana 46204

Date: September 18, 2019

/Rafael Perez-Pineiro/
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