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

Proceeding	91253555
Party	Defendant Wipro Limited
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Signature	/Naresh Kilaru/
Date	03/02/2020
Attachments	2020-03-02 Answer-Affirm Defense-Counterclaim - Notice of Opposition 91253555.pdf(125343 bytes)

Registrations Subject to the filing

Registration No.	1902494	Registration date	07/04/1995
Registrant	Hyland Software, Inc. 28500 CLEMENS ROAD WESTLAKE, OH 44145 UNITED STATES		

Goods/Services Subject to the filing

Class 009. First Use: 1991/05/00 First Use In Commerce: 1991/05/00
All goods and services in the class are requested, namely: computer software for electronic document imaging, and storage, retrieval and management of the information contained thereon

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)		
Registration No.	3010345	Registration date	11/01/2005
Registrant	Hyland Software, Inc. 28500 Clemens Road Westlake, OH 44145 UNITED STATES		

Goods/Services Subject to the filing

Class 042. First Use: 1991/05/00 First Use In Commerce: 1991/05/00
All goods and services in the class are requested, namely: DESIGN AND DEVELOPMENT OF COMPUTER SOFTWARE, CONSULTATION SERVICES IN THE FIELDS OF SELECTION, IMPLEMENTATION AND USE OF COMPUTER [HARDWARE AND] SOFTWARE SYSTEMS FOR OTHERS;

CUSTOMIZATION OF COMPUTER HARDWARE AND SOFTWARE FOR OTHERS; INSTALLATION, REPAIR, MAINTENANCE OF COMPUTER SOFTWARE; TECHNICAL SUPPORT SERVICES, namely, TROUBLESHOOTING OF COMPUTER HARDWARE AND SOFTWARE PROBLEMS

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)		
Registration No.	4895822	Registration date	02/02/2016
Registrant	Hyland Software, Inc. 28500 Clemens Road Westlake, OH 44145 UNITED STATES		

Goods/Services Subject to the filing

Class 009. First Use: 2009/12/31 First Use In Commerce: 2009/12/31 All goods and services in the class are requested, namely: Downloadable mobile applications for enterprise content management			
Registration No.	5599438	Registration date	11/06/2018
Registrant	Hyland Software, Inc. 28500 Clemens Road Westlake, OH 44145 UNITED STATES		

Goods/Services Subject to the filing

Class 009. First Use: 1991/05/00 First Use In Commerce: 1991/05/00 All goods and services in the class are requested, namely: Downloadable computer software for content services, namely, the capturing, storing, retrieving, accessing, processing, measuring and modifying of content, processes, and cases in the nature of data in electronic form and the integration with third-party computer software applications for the capturing, storing, retrieving, accessing, processing, measuring and modifying of content, processes, and cases in the nature of data in electronic form; downloadable computer software for imaging and document management; downloadable mobile application for content services, namely, the capturing, storing, retrieving, accessing, processing, measuring and modifying of content, processes, and cases in the nature of data in electronic form and the integration with third-party computer software applications for the capturing, storing, retrieving, accessing, processing, measuring and modifying of content, processes, and cases in the nature of data in electronic form; downloadable mobile application for imaging and document management			
Class 042. First Use: 1991/05/00 First Use In Commerce: 1991/05/00 All goods and services in the class are requested, namely: Design and development of non-downloadable software for content services management, namely, the capturing, storing, retrieving, accessing, processing, measuring and modifying of content, processes, and cases in the nature of data in electronic form and the integration with third-party computer software applications for the capturing, storing, retrieving, accessing, processing, measuring and modifying of content, processes, and cases in the nature of data in electronic form; consultation services in the fields of selection, implementation and use of computer software systems for others; customization of computer software for others; installation, repair, maintenance of computer software; technical support services, namely, troubleshooting of computer hardware and software problems; computer support services, namely, computer hardware, software and computer peripheral advisory and information services in the nature of consulting services in the field of design, selection implementation and use of computer hardware and software systems for others; computer hosting services, namely, cloud hosting providers services			

3. Wipro is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in Paragraph 2, and therefore denies them.

4. Wipro is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations in Paragraph 3 and therefore denies them.

5. Admitted.

6. Admitted.

7. Admitted.

8. Denied.

9. Admitted.

10. Admitted.

11. Admitted.

12. Denied.

13. Denied.

14. Denied.

15. Applicant admits that there is no affiliation or connection between Applicant and Opposer, and denies this allegation to the extent it implies that Applicant needed to seek approval from Opposer to use the BASE))) mark.

16. Denied.

17. Denied.

AFFIRMATIVE DEFENSES

18. While Applicant denies that any likelihood of confusion exists, pursuant to TBMP § 311.02(b) and 15 U.S.C. § 1068, Applicant affirmatively asserts that it is at least entitled to

registration of its mark for the restricted identification of goods and services that reads as follows:

Class 9

Customized business analytics software for harmonizing complex business operations and management processes and systems through a single module for the purpose of enabling end-users to derive maximum value out of existing systems and none of the foregoing relating to software for tracking sales, managing contacts and customer relations, tracking time, preparing and processing invoices, expense tracking, document sharing, recoding financial data, billing customers and creating websites

Class 42

Software as a services (SaaS) services featuring **customized** business analytics software for harmonizing complex business operations and management processes and systems through a single module for the purpose of enabling end-users to derive maximum value out of existing systems and none of the foregoing relating to software or consultancy services for tracking sales, managing contacts and customer relations, tracking time, preparing and processing invoices, expense tracking, document sharing, recoding financial data, billing customers and creating websites

19. Such restricted identification is sufficient to distinguish Applicant's services from Opposer's and avoid a likelihood of confusion.

20. Wipro reserves all affirmative defenses under Rule 8(c) of the Federal Rules of Civil Procedure, under the Lanham Act, and in law or in equity that may now exist or in the future be available based on discovery and further factual investigation of this case.

COUNTERCLAIM

21. Opposer has asserted various registrations in the Notice of Opposition. Because Opposer does not use its ONBASE mark in connection with customized business analytics software for harmonizing complex business operations and management processes and systems through a single module for the purpose of enabling end-users to derive maximum value out of existing systems, Opposer's registrations should be restricted accordingly.

COUNT I:

**Claim of Cancellation By Restriction
Under Section 18, U.S.C. § 1068**

22. Applicant repeats and realleges the allegations set forth in Paragraph 21 above.

23. Applicant seeks cancellation in part of Registration Nos. 1902494, 3010345, 4895822, and 5599438 in the nature of a restriction under Section 18, 15 U.S.C. § 1068, as set forth below. On information and belief, the recitation of goods and services in these registrations is overbroad because Opposer does not use its ONBASE mark in connection with customized business analytics software for harmonizing complex business operations and management processes and systems through a single module for the purpose of enabling end-users to derive maximum value out of existing systems.

24. Applicant accordingly requests that the description of goods and services for each registration be restricted in a manner that is consistent with Opposer's actual use of the mark in U.S. commerce and in a manner that avoids any likelihood of confusion with Applicant's mark. Specifically, Applicant requests that the description of goods services in Registration Nos. 1902494, 3010345, 4895822, and 5599438 be restricted so that the following language appears after the description in each class:

... none of the foregoing including customized business analytics software for harmonizing complex business operations and management processes and systems through a single module for the purpose of enabling end-users to derive maximum value out of existing systems.

25. Applicant asserts that entry of the proposed restriction will avoid any alleged likelihood of confusion between Opposer's and Applicant's marks.

26. WHEREFORE, Applicant prays that Opposer's Notice of Opposition against Applicant's Application Serial No. 87800093 be dismissed with prejudice and, to the extent needed to avoid a likelihood of confusion, enter the proposed restrictions in Registration Nos. 1902494, 3010345, 4895822, and 5599438, as set forth above.

Respectfully submitted,

Dated: March 2, 2020

/Naresh Kilaru/

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing APPLICANT'S ANSWER, AFFIRMATIVE DEFENSE, AND COUNTERCLAIM was served via email on March 2, 2020 on counsel for Opposer at the following address of record:

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