

ESTTA Tracking number: **ESTTA1065184**

Filing date: **06/30/2020**

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	Information Builders, Inc.
Granted to Date of previous extension	07/01/2020
Address	TWO PENN PLAZA NEW YORK, NY 10121-2898 UNITED STATES

Attorney information	HOWARD F. MANDELBAUM MANDELBAUM SILFIN ECONOMOU LLP 222 BLOOMINGDALE ROAD SUITE 120 SUITE 120 WHITE PLAINS, NY 10605 UNITED STATES hmandelbaum@levman.com, docketing@msellp.com, uspto@dockettrak.com 9144210500
----------------------	---

Applicant Information

Application No	88673756	Publication date	03/03/2020
Opposition Filing Date	06/30/2020	Opposition Period Ends	07/01/2020
Applicant	John Wiley & Sons, Inc. 111 River Street Hoboken, NJ 07030 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Downloadable digital test preparation and test-score maximization software that analyzes and adapts practice test questions to enhance proficiency, accuracy, test scores, and performance related to diagnostic quizzes and simulated practice exams; downloadable computer software platform for digital self-study featuring suggested additional study aid resources; downloadable self-study software in the nature of a digital online exam planner that utilizes users' historical data to create a personalized exam plan and schedule for users</p>
<p>Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Online non downloadable digital test preparation and test-score maximization software that analyzes and adapts practice test questions to enhance proficiency, accuracy, test scores, and performance related to diagnostic quizzes and simulated practice exams; online non downloadable computer software platform for digital self-study featuring suggested additional study aid resources; online non downloadable self-study software in the nature of a digital online exam planner that utilizes users' historical data to create a personalized ex-</p>

am plan and schedule for users


Grounds for Opposition

Priority and likelihood of confusion


Trademark Act Section 2(d)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1652265	Application Date	08/23/1990
Registration Date	07/30/1991	Foreign Priority Date	NONE
Word Mark	FOCUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1975/03/00 First Use In Commerce: 1975/03/00 computer programs for data base management		

U.S. Registration No.	2821942	Application Date	06/30/2000
Registration Date	03/16/2004	Foreign Priority Date	NONE
Word Mark	FOCUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1975/03/00 First Use In Commerce: 1975/03/00 COMPUTER SOFTWARE FOR DATABASE MANAGEMENT; COMPUTER SOFTWARE FOR USE IN DECISION SUPPORT SYSTEMS; COMPUTER SOFTWARE FOR USE IN ENTERPRISE REPORTING AND ANALYSIS SYSTEMS AND FOR BUILDING APPLICATIONS FOR THE MANAGEMENT AND TRACKING OF DATA FOR ENTERPRISE REPORTING SYSTEMS; COMPUTER DATABASE PROGRAMS FOR USE IN CONNECTION WITH DECISION SUPPORT, ANALYSIS, AND REPORTING PROGRAMS; COMPUTER SOFTWARE DEVELOPMENT TOOLS FOR USE IN DEVELOPING DECISION SUPPORT, ANALYSIS, AND REPORTING SYSTEMS AND APPLICATIONS; COMPUTER SOFTWARE, NAMELY, CLIENT/SERVER REPORTING, ANALYSIS AND DECISION SUPPORT TOOLS; COMPUTERIZED DATABASE, REPORTING, AND ANALYSIS SOFTWARE FOR USE ON CORPORATE INTRANETWEB SITES; ENTERPRISE SERVER SOFTWARE FOR USE IN WEB BASED DATA PUBLISHING, REPORTING, AND ANALYSIS SOLUTIONS; COMPUTER SOFTWARE FOR ACCESSING DATABASES BY MEANS OF GLOBAL COMPUTER NETWORKS TO GENERATE REPORTS; SOFTWARE DEVELOPMENT TOOLS FOR MAKING REPORTING AND ANALYSIS AVAIL-		

	ABLE THROUGH GLOBAL COMPUTER NETWORK WORLDWIDE WEBSITES AND FOR EXTENDING THE FUNCTIONALITY OF ENTERPRISE REPORTING AND ANALYSIS SYSTEMS ON TO GLOBAL COMPUTER NETWORKS; AND COMPUTER SOFTWARE FOR ACCESSING AND UPDATING DATABASES THROUGH GLOBALCOMPUTER NETWORKS
--	---

U.S. Registration No.	2248562	Application Date	03/03/1997
Registration Date	06/01/1999	Foreign Priority Date	NONE
Word Mark	WEBFOCUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/04/00 First Use In Commerce: 1996/04/00 computer programs for data base management		

U.S. Registration No.	2685249	Application Date	06/30/2000
Registration Date	02/11/2003	Foreign Priority Date	NONE
Word Mark	WEBFOCUS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/04/00 First Use In Commerce: 1996/04/00 COMPUTER SOFTWARE FOR DATABASE MANAGEMENT; COMPUTER SOFTWARE FOR ACCESSING DATABASES BY MEANS OF GLOBAL COMPUTER NETWORKS TO GENERATE REPORTS; SOFTWARE DEVELOPMENT TOOLS FOR MAKING REPORTING AND ANALYSIS AVAILABLE THROUGH GLOBAL COMPUTER NETWORK WORLDWIDE WEBSITES AND		

	FOR EXTENDING THE FUNCTIONALITY OF ENTERPRISE REPORTING AND ANALYSIS SYSTEMS ON TO GLOBAL COMPUTER NETWORKS; AND COMPUTER SOFTWARE FOR ACCESSING AND UPDATING DATABASES THROUGH GLOBAL COMPUTER NETWORKS
--	--

Attachments	76083549#TMSN.png(bytes) 75250817#TMSN.png(bytes) 76081024#TMSN.png(bytes) IBI D500US Notice of Opposition.pdf(197354 bytes)
-------------	--

Signature	/HOWARD F. MANDELBAUM/
Name	HOWARD F. MANDELBAUM
Date	06/30/2020

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 trademark FOCUS. Plaintiff is also the owner of the following Patent and Trademark Office registrations:

<u>Registration No.</u>	<u>Trademark</u>
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 FOCUSME TECHNOLOGY for "Downloadable digital test preparation and test-score maximization software that analyzes and adapts practice test questions to enhance proficiency, accuracy, test scores, and performance related to diagnostic quizzes and simulated practice exams; downloadable computer software platform for digital self-study featuring suggested additional study aid resources; downloadable self-study software in the nature of a digital online exam planner that utilizes users' historical data to create a personalized exam plan and schedule for users" in Class 9 and "Online non downloadable digital test preparation and test-score maximization software that analyzes and adapts practice test questions to enhance proficiency, accuracy, test scores, and performance related to diagnostic quizzes and simulated practice exams; online non downloadable computer software platform for digital self-study featuring suggested additional study aid resources; online non

downloadable self-study software in the nature of a digital online exam planner that utilizes users' historical data to create a personalized exam plan and schedule for users" in Class 42.

9. Upon information and belief, Defendant's goods and services are so closely related to Plaintiff'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.

10. Upon information and belief, the registration by Defendant of FOCUSME TECHNOLOGY for goods and services closely related to Plaintiff'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.

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

/Howard F. Mandelbaum/
Howard F. Mandelbaum
Ira. E. Silfin
John S. Economou
Attorneys for Plaintiff
Mandelbaum Silfin Economou LLP
222 Bloomingdale Road, Suite 120
White Plains, NY 10605
(914) 421-0500