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Filing date: **05/08/2022**

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	Motus, LLC
Granted to date of previous extension	05/08/2022
Address	1 BEACON STREET FLOOR 15 BOSTON, MA 02108 UNITED STATES
Attorney information	SUZANN MOSKOWITZ THE MOSKOWITZ FIRM LLC 24870 FAIRMOUNT BLVD BEACHWOOD, OH 44122 UNITED STATES Primary email: <a href="mailto:suzann@themoskowitzfirm.com">suzann@themoskowitzfirm.com</a> Secondary email(s): <a href="mailto:admin@themoskowitzfirm.com">admin@themoskowitzfirm.com</a> 2163391111
Docket no.	346

**Applicant information**

Application no.	88742826	Publication date	11/09/2021
Opposition filing date	05/08/2022	Opposition period ends	05/08/2022
Applicant	MODOS TECHNOLOGIES, INC. 4645 VOLUNTEER RD. DAVIE, FL 33331 UNITED STATES		

**Goods/services affected by opposition**

<p>Class 009. First Use: Nov 1, 2019 First Use In Commerce: Nov 1, 2019 All goods and services in the class are opposed, namely: Downloadable computer software for booking, facilitating and managing the renting or sharing of motor vehicles; Downloadable computer software for listing and searching for transportation services, booking transportation services and dispatching vehicles of others to customers and arranging for drop off and pick up of vehicles to customers; Downloadable computer software for use in scheduling, planning, organizing, managing, searching and allowing users to perform electronic business transactions and make payments for the use of motor vehicles of others; Downloadable computer software for use in arranging transportation reservations, and for use in scheduling, planning, organizing, managing, enabling payment for and renting the use of motor vehicles, and for scheduling, maintaining vehicle inventory and reservations, and enabling communication with vehicle owners and renters; Downloadable computer software for organizing, administering and managing the sharing and renting of motor vehicles; Downloadable computer programs for use in managing transportation reservation services and motor vehicle sharing services;</p>
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Downloadable computer programs for use in scheduling, planning, organizing, managing and providing the temporary use of motor vehicles
Class 035. First Use: Nov 1, 2019 First Use In Commerce: Nov 1, 2019 All goods and services in the class are opposed, namely: Operating an online marketplace featuring motor vehicles available for rent; inventory management services
Class 036. First Use: Nov 1, 2019 First Use In Commerce: Nov 1, 2019 All goods and services in the class are opposed, namely: Insurance underwriting and administration in the field of vehicular insurance, providing premiums and coverage based on usage, experience, and other primary data gathered; Providing vehicular insurance underwriting to a group of members for coverage on a per-use basis for both owned and third-party assets; Providing information about insurance; Financing related to automobiles; providing financing information in the field of automobiles
Class 039. First Use: Nov 1, 2019 First Use In Commerce: Nov 1, 2019 All goods and services in the class are opposed, namely: Motor vehicle rental and sharing services, namely, scheduling, planning, organizing, managing and providing the temporary use of motor vehicles; Transportation reservation services; motor vehicle rental and sharing services, namely, providing temporary use of motor vehicles; management, administration and organization of motor vehicle sharing services, namely, scheduling, planning, organizing, managing and providing the temporary use of motor vehicles; vehicle rental reservation services; motor vehicle sharing services, namely, providing temporary use of motor vehicles; providing a website featuring information regarding transportation reservation and rental services and vehicle booking information, advisory and consultancy services relating to the foregoing; providing a website for the booking of vehicle rentals; providing an online searchable computer database featuring information on motor vehicles of others and their availability for rent; providing information and reviews on motor vehicle rentals relating to the vehicle, vehicle owner and vehicle renters; travel agency services, namely, making reservations and bookings for transportation; providing online reservation, booking and listing of motor vehicle rentals; providing information on the rental of motor vehicles
Class 042. First Use: Nov 1, 2019 First Use In Commerce: Nov 1, 2019 All goods and services in the class are opposed, namely: Application service provider services, namely, hosting an online platform and website for booking, facilitating, and managing the renting and sharing of motor vehicles; software-as-a-service services featuring software for booking, facilitating, and managing the renting and sharing of motor vehicles; providing temporary use of non-downloadable software for booking, facilitating, and managing the renting and sharing of motor vehicles; Providing temporary use of non-downloadable software for listing and searching for transportation services, booking transportation services and dispatching vehicles to customers and arranging for drop off and pick up of vehicles to customers; providing temporary use of non-downloadable computer programs for use in scheduling, planning, organizing, and managing the temporary use of motor vehicles; application service provider services featuring temporary use of on-line non-downloadable computer programs for use in transportation reservation services and for scheduling, planning, organizing, and managing the temporary use of motor vehicles, for scheduling and maintaining inventory, and for use in enabling communication with vehicle owners and renters; computer services, namely, providing and maintaining temporary use of on-line non-downloadable computer software platforms for organizing, administration and management of motor vehicle renting and sharing; computer services, namely, creating an online community for registered users to participate in discussions about motor vehicle renting and sharing services and to engage in social, business, and community networking in the field of motor vehicle renting and sharing


## Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)

## Marks cited by opposer as basis for opposition

U.S. registration no.	4819183	Application date	06/27/2014
Register	Principal		

Registration date	09/22/2015	Foreign priority date	NONE
Word mark	MOTUS		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: Oct 20, 2014 First Use In Commerce: Oct 20, 2014 Software used on mobile devices for tracking vehicle mileage for purposes of reimbursement</p> <p>Class 035. First use: First Use: Jul 18, 2014 First Use In Commerce: Jul 18, 2014 Administering vehicle reimbursement and expense management programs; business management of expense management and vehicle reimbursement programs for purposes of reimbursing employees for business use of personal assets or the personal use of business assets; business expense management services</p> <p>Class 042. First use: First Use: Jul 18, 2014 First Use In Commerce: Jul 18, 2014 Development of vehicle reimbursement programs and expense management solutions or programs, namely, computer software development services for others for purposes of employee expense reimbursement</p>		

U.S. registration no.	6193383	Application date	02/18/2020
Register	Principal		
Registration date	11/10/2020	Foreign priority date	NONE
Word mark	MOTUS		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: Dec 2014 First Use In Commerce: Dec 2014		

	<p>Downloadable software used on mobile devices for tracking and managing vehicle and device information, namely, mileage for purposes of reimbursement and field worker activity tracking; Downloadable mobile applications for reimbursement, calculation, administering, and tracking vehicle mileage, telecommunications expenses, and business expenses; Downloadable mobile apps for collecting vehicle information, insurance policy and coverage information, discounts and payment on fuel and related discount programs; downloadable cloud-based software for vehicle and mobile device information analysis, device procurement, discounts and payment on fuel and related discount programs</p> <p>Class 035. First use: First Use: Dec 2014 First Use In Commerce: Dec 2014  Business management of reimbursement programs for others for purposes of reimbursing employees for business use of personal assets or tracking personal use of business assets; Business management consultation services, conducting marketing studies; data collection and statistical analysis for business purposes in the fields of food, beverage, manufacturing, construction, building materials, machinery, electronics, electrical equipment, chemicals, plastics, rubber, retail, business services, restaurants, automotive transportation, textiles, insurance, mining, oil and gas production, consumer products, banking and financial services, technology, utilities and other industries where job duties are performed in the field; Business consultancy services, namely, consulting in the field of managed mobility services (MMS) and telecom expense management (TEM); business management of logistics for others, namely, consulting in the fields of mobile device management (MDM), mobile application management (MAM), device as a services (DaaS), and IoT device and expense management; Administration of mobile worker discount, procurement and rewards programs for enabling employee participants to purchase mobility-related goods and services; Business administration of consumer loyalty programs, namely, fuel card programs; administration of insurance discount programs in the nature of administration of a customer loyalty program which provides discounts on insurance; Fuel card programs in the nature of providing discount and incentive award programs for customers through issuance and processing of loyalty points for purchase of a company's goods and services</p> <p>Class 041. First use: First Use: Dec 2014 First Use In Commerce: Dec 2014  Driver safety and training programs; administration of corporate-based driver safety and driving risk management programs in the nature of providing driver safety training</p> <p>Class 042. First use: First Use: Dec 2014 First Use In Commerce: Dec 2014  Computer software development services for others for purposes of employee expense reimbursement in the fields of vehicle reimbursement programs and expense management solutions; Providing on-line non-downloadable software for collecting, editing, organizing, compiling, comparing, modifying, transmitting, and storing data and information in the field of business vehicles and mobility expenses; providing on-line non-downloadable software for tracking and management of insurance policy and coverage information; Providing on-line non-downloadable software for collecting, editing, organizing, compiling, comparing, modifying, transmitting, and storing data and information in the field of telecommunications expenses; providing temporary use of non-downloadable cloud-based software for vehicle and mobile device information analysis, device procurement, discounts and payment on fuel and related discount programs; Providing an interactive website featuring technology that enables users to access information and reports concerning business vehicles, insurance policy and coverage information and recommendations, devices and expenses for business purposes</p>
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Related proceedings	Registration No: 6143144 - Cancellation
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Attachments	86322332#TMSN.png( bytes ) 88800610#TMSN.png( bytes ) 88742826 MODOS - TTAB Notice of Opposition- 05082022.pdf(117718 bytes )
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Signature	/Suzann R. Moskowitz/
Name	SUZANN MOSKOWITZ
Date	05/08/2022

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

<b>MOTUS LLC</b>	)	
	)	Opposition No:
Opposer,	)	
v.	)	<b>Application Serial No:</b> 88742826
<b>MODOS TECHNOLOGIES, INC.</b>	)	<b>Mark:</b> MODUS (stylized)
	)	
Applicant.	)	<b>Classes:</b> 09, 35, 36, 39, 42

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**NOTICE OF OPPOSITION**

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1. Motus LLC (“Opposer”), a Delaware limited liability company with its place of business at 1 Beacon Street, Floor 15, Boston, MA 02108, believes it will be damaged by the registration of the mark MODOS, Serial. No. 88742826 (“Applicant’s Mark”), and hereby opposes the same and requests that registration to Applicant be refused.

2. To the best of Opposer’s knowledge, Applicant Modus Technologies, Inc.’s mailing address is 4645 Volunteer Road, Davie, Florida 33331. Petitioner does not know Respondent’s e-mail address, but Respondent’s counsel’s e-mail address is kckline@duanemorris.com.

3. Petitioner will be damaged by the registration of Applicant’s Mark. As grounds for Opposition, Opposer, by and through its undersigned counsel, states as follows:

4. Opposer is a company in the business of workforce management which develops and distributes mobile workforce management solutions, vehicle reimbursement, fleet, and mobile and global positioning system (GPS) solutions.

5. Opposer is the owner of U.S. Trademark Registration No. 4,819,183 for the mark “MOTUS” for “software used on mobile devices for tracking vehicle mileage for purposes of reimbursement” in Class 9, “administering vehicle reimbursement and expense management

programs; business management of expense management and vehicle reimbursement programs for purposes of reimbursing employees for business use of personal assets or the personal use of business assets; business expense management services,” in Class 35, and “development of vehicle reimbursement programs and expense management solutions or programs, namely, computer software development services for others for purposes of employee expense reimbursement” in Class 42. (The “4,819,183 Mark”).

6. Opposer is owner of U.S. Trademark Registration No 6,193,383 for the mark “MOTUS” for “Downloadable software used on mobile devices for tracking and managing vehicle and device information, namely, mileage for purposes of reimbursement and field worker activity tracking; Downloadable mobile applications for reimbursement, calculation, administering, and tracking vehicle mileage, telecommunications expenses, and business expenses; Downloadable mobile apps for collecting vehicle information, insurance policy and coverage information, discounts and payment on fuel and related discount programs; downloadable cloud-based software for vehicle and mobile device information analysis, device procurement, discounts and payment on fuel and related discount programs” in Class 9, “Business management of reimbursement programs for others for purposes of reimbursing employees for business use of personal assets or tracking personal use of business assets; Business management consultation services, conducting marketing studies; data collection and statistical analysis for business purposes in the fields of food, beverage, manufacturing, construction, building materials, machinery, electronics, electrical equipment, chemicals, plastics, rubber, retail, business services, restaurants, automotive transportation, textiles, insurance, mining, oil and gas production, consumer products, banking and financial services, technology, utilities and other industries where job duties are performed in the field; Business consultancy services, namely, consulting in the field of managed mobility services

(MMS) and telecom expense management (TEM); business management of logistics for others, namely, consulting in the fields of mobile device management (MDM), mobile application management (MAM), device as a services (DaaS), and IoT device and expense management; Administration of mobile worker discount, procurement and rewards programs for enabling employee participants to purchase mobility-related goods and services; Business administration of consumer loyalty programs, namely, fuel card programs; administration of insurance discount programs in the nature of administration of a customer loyalty program which provides discounts on insurance; Fuel card programs in the nature of providing discount and incentive award programs for customers through issuance and processing of loyalty points for purchase of a company's goods and services" in Class 35, "Driver safety and training programs; administration of corporate-based driver safety and driving risk management programs in the nature of providing driver safety training" in Class 41 and "Computer software development services for others for purposes of employee expense reimbursement in the fields of vehicle reimbursement programs and expense management solutions; Providing on-line non-downloadable software for collecting, editing, organizing, compiling, comparing, modifying, transmitting, and storing data and information in the field of business vehicles and mobility expenses; providing on-line non-downloadable software for tracking and management of insurance policy and coverage information; Providing on-line non-downloadable software for collecting, editing, organizing, compiling, comparing, modifying, transmitting, and storing data and information in the field of telecommunications expenses ; providing temporary use of non-downloadable cloud-based software for vehicle and mobile device information analysis, device procurement, discounts and payment on fuel and related discount programs; Providing an interactive website featuring technology that enables users to access information and reports concerning business vehicles, insurance policy and coverage information

and recommendations, devices and expenses for business purposes” in Class 42 (The “6,193,383 Mark”)(collectively with the 4,819,183 Mark, “Opposer’s Marks”)

7. Opposer has continuously used Opposer’s Marks since at least as early as December 2014.

### **Likelihood of Confusion and Dilution**

8. Opposer repeats and incorporates all foregoing allegations as if fully set forth herein.

9. MOTUS is inherently distinctive as applied to Opposer’s goods and services.

10. Opposer has spent substantial time, effort, and money to market its goods and services under Opposer’s Marks. As a result, Opposer has developed extremely valuable goodwill throughout the United States and the world with respect to Opposer’s Marks.

11. Despite Opposer’s prior use of and long prior common law and statutory rights, Applicant adopted and filed an application for registration of the stylized mark MODOS for goods and services in Classes: 09, 35, 36, 39, and 42, as set forth in the Notice of Publication for the subject application.

12. Applicant’s mark was published for opposition on 11/09/21. Opposer filed for an Extensions of Time to Opposer on 11/10/2021, 01/09/2022, and 3/07/2022 and the Trademark Trial and Appeal Board granted an extension until 05/08/2022.

13. Applicant’s Mark is substantially or highly similar to MOTUS in sound, appearance, and commercial impression.

14. The goods and services set forth in the subject applications are closely related and could reasonably be expected to originate from the same source, such that many consumers who encounter Applicant’s Mark in connection with software and related services for management,

administration, scheduling, planning, organizing, managing related to the use of motor vehicles are likely to think that Applicant or the goods and services under Applicant's Mark are authorized by, sponsored by, licensed by, affiliated with, or related to the company that offers Opposer's goods and services.

15. The goods and services set forth in the subject applications are likely to be offered in similar channels of trade to similar customers.

16. Opposer's Marks have priority over Applicant's Mark.

17. As a result, Applicant's Mark, if used in conjunction with the services set forth in the subject application, is likely to cause confusion, mistake, or to deceive as to the origin, source, sponsorship, or affiliation of Applicant's goods and services.

18. Applicant's Mark so resembles Opposer's Marks, as to be likely, when applied to the goods and services set forth in Applicant's application, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).

19. Applicant's Mark so resembles Opposer's Marks, as to be likely, when applied to the goods and services set forth in Applicant's application to falsely suggest a connection with the Opposer within the meaning of 15 U.S.C. § 1052(a).

20. Opposer will be damaged by registration of Applicant's Mark because such use will be likely to cause dilution of Opposer's Marks, which enjoy widespread recognition by the general public, within the meaning of 15 U.S.C. § 1125(c)(1).

### **Fraud**

21. Opposer repeats and incorporates all foregoing allegations as if fully set forth herein.

22. Applicant obtained the Notice of Publication by committing fraud on the United States Patent and Mark Office (“USPTO”) in connection with its Amendment to Allege Use as filed in connection with Application 88,742,826 (the “Application”).

23. In its Amendment to Allege Use for the Application, filed August 24, 2021, the Applicant declared that the MODOS mark “was first used anywhere by the Applicant on or in connection with such goods and services, at least as early as November 1, 2019 and first used in commerce at least as early as November 1, 2019.”

24. Upon information and belief, Applicant was not using the MODOS mark on or in connection with all of the goods and services in the Application as of November 1, 2019.

25. Upon information and belief, the statements made by Sascha Doering as CEO of Modos Technologies, Inc. in the filing of the mark Application Serial No. 88,742,826 were false and, Doering knew these statements were false and Doering made these statements with the intent to deceive the USPTO. Doering signed and filed the mark Application declaring that: (i) “all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true,” and that (ii) “willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom.”

26. The USPTO relied on and accepted Doering’s sworn statements made in its Mark Application and approved the MODOS for publication.

27. As a direct result of the false, fraudulent, and material statements made by the Applicant in its Application, the USPTO allowed the MODOS mark to be approved for publication.

28. Applicant will be damaged by the registration of Applicant’s Mark.

WHEREFORE, Opposer respectfully prays that this Opposition be sustained and that registration to Applicant be refused.

Dated: May 8, 2022

Respectfully submitted,

A handwritten signature in black ink that reads "Suzann Moskowitz". The signature is written in a cursive style with a large initial 'S'.

by: \_\_\_\_\_

Suzann Moskowitz  
The Moskowitz Firm  
24870 Fairmount Blvd.  
Beachwood, OH 44122  
[Suzann@themoskowitzfirm.com](mailto:Suzann@themoskowitzfirm.com)  
Tel: 216-339-1111  
*Counsel for Opposer*

**CERTIFICATE OF SERVICE**

I hereby certify that on this 8th day of May, 2022, I caused a true and correct copy of the foregoing Notice of Opposition to be served upon Modos Technologies, Inc. by emailing attorney of record Karen C. Kline at kckline@duanemorris.com.

A handwritten signature in cursive script that reads "Suzann Moskowitz".

by: \_\_\_\_\_

Suzann Moskowitz