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

Proceeding	92049973
Party	Defendant Ectaco Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

ABBYY SOFTWARE LTD.	Cancellation No. 92049973
Petitioner,	
v.	Mark: LINGVOSOFT Reg. No. 3,015,325 Reg. Date: November 15, 2005
ECTACO INC.	
Registrant.	

AFFIDAVIT OF DAVID LUBINITSKY

I, David Lubinitsky, hereby declare:

1. The facts stated below are based upon my personal knowledge, and upon my review of records kept in the regular course of business. As to those matters stated on information and belief, I believe them to be true. If called as a witness, I could and would competently testify thereto.
2. Printouts from websites were obtained by accessing the described website via Internet and saving the webpage which is then submitted herein as an exhibit. Printouts of archived websites were obtained using The Internet Archive at <http://web.archive.org>, which archived webpages prior to 2007.
3. When available, Russian documents have been translated into English with English translation following the Russian document.
4. I am the Chief Executive Officer of Ectaco, Inc., the owner of Trademark LINGVOSOFT, Registration No. 3,015,325, subject of the present Cancellation. See, Exhibit 7.
5. Ectaco, Inc. is a corporation organized under the laws of the State of New York and has a principal address at 31-21 31st Street, Long Island City, NY 11106. See,

Exhibit 33.

6. As the CEO of Ectaco, Inc., my responsibilities include managing day-to-day operations of the company, including with regard to the agreements it enters into, its intellectual property, including the LINGVOSOFT mark, its finances, its marketing, and its products, including all products sold under the LINGVOSOFT mark.
7. Petitioner instituted the present cancellation proceeding seeking cancellation of Ectaco's LINGVOSOFT mark and alleging, *inter alia*, that continuous registration of this mark causes injury to the Petitioner. See, Exhibit 3.
8. I formed Ectaco, Inc. in 1990 and have been employed by this company since its formation.
9. Ectaco Inc. is a developer and manufacturer of electronic dictionaries, pocket electronic dictionaries, including the world-renowned Language Teacher and Partner dictionary line, talking dictionaries and universal translators for speech-to-speech interpretation, electronic translators, linguistic software, software for language training and handheld electronic training devices, software for speech recognition and handheld electronic speech recognition devices and other goods for training and study in linguistics.
10. Over the past 20 years Ectaco Inc. has grown into one of the most influential linguistic support developers, producers and designers in the world. Providing foreign language management solutions for personal and business use, Ectaco has received commissions and commendations from government and industry sources alike.
11. Ectaco remains at the forefront of innovation thanks to its extraordinary team of international managers, linguists, designers and programmers. This intellectual capital combined with a real commitment to customer needs and satisfaction has made Ectaco one of the most respected and recognized names in the industry.
12. LingvoSoft, Ectaco's software division, has launched in 2004 and now provides linguistic utilities and applications for a full range of computing devices currently

available to consumers, including, Windows Mobile Pocket PC, Windows, Palm OS and Symbian OS for mobile phones.

13. LINGVOSOFT is a fanciful term not found in any dictionary.
14. Trademark LINGVOSOFT was first used by Ectaco in the first half of 2004, and in March 2004, Ectaco has registered the domain name lingvosoft.com.
15. In June 2004, Ectaco started offering translation software at lingvosoft.com under the mark LINGVOSOFT. See, Exhibits 4 and 8.
16. In May 2004, translation software bearing the mark LINGVOSOFT was offered at Ectaco's Lingvobit stores. Although invoices for sale of LINGVOSOFT products in May 2004 were not found during the discovery stage, an invoice for the month of November 2004 is included as part of Confidential Exhibit 1. It is not unusual that the invoices for May-October were not found given the fact that (as stated below) LINGVOSOFT software is often distributed as a bonus added to other products. Such bonuses are not always listed on invoices.
17. On July 30, 2004, Ectaco applied for federal trademark application for the mark LINGVOSOFT. See, Exhibit 32.
18. LINGVOSOFT was allowed by the U.S. Patent and Trademark Office ("USPTO"), a Notice of Publication of the mark was issued by the USPTO on August 3, 2005, and the mark was published for opposition on August 23, 2005. See, Exhibit 9.
19. Trademark Registration Certificate No. 3,015,325 for LINGVOSOFT was issued by the USPTO on November 15, 2005. See, Exhibit 7.
20. Since 2004, Ectaco has used the mark LINGVOSOFT on various linguistic products, including software suites, dictionaries, electronic flash cards, electronic phrase books, language teaching/learning software, machine translators, picture dictionaries, speech interpreters, travel software, language support software, software bundles and handheld emulators. See, Exhibit 4.
21. Language learning and translation software sold under the LINGVOSOFT mark is often distributed as a bonus added to other products, for example, handheld

dictionaries and translators. See, Exhibit 4.

22. Since 2004, Ectaco's mark LINGVOSOFT has been continuously and exclusively used to identify translation software, language learning software, electronic voice interpreters and electronic handheld dictionaries. See, Exhibit 11.
23. LINGVOSOFT has acquired such substantial secondary meaning and good will and has become well-known among the relevant trade and public as designating Ectaco as the exclusive source of the goods set forth in Registration No. 3,015,325. For example, Smartphone magazine identified LingvoSoft Picture Dictionaries as a new product for June 2007, LingvoSoft Flash Cards for PocketPC as a new product for May 2005. See, Exhibit 10.
24. Ectaco's linguistic products sold under the mark LINGVOSOFT have been subjects of numerous trade awards. Specifically, in 2009, LingvoSoft Suite 2008 English - Spanish for Windows Mobile Pocket PC has received Best Software Award 2009 from handster.com. In 2008, LingvoSoft Talking Dictionaries for Mobile Pocket PC and LingvoSoft Talking PhraseBooks for MS Smartphone each won Best Software Awards 2008 from Smartphone & Pocket PC magazine. In 2008, LingvoSoft Dictionary English-German for Windows Mobile Pocket PC and LingvoSoft Dictionary English-Chinese for Windows Mobile Pocket PC each won Best Software Awards 2008 from handster.com. In 2008, four different LingvoSoft products were nominated for the Best Software Awards 2008 from Smartphone & Pocket PC magazine: LingvoSoft Bilingual Talking Dictionaries for Mobile Pocket PC, LingvoSoft Suites for Mobile Pocket PC, ECTACO Voice Translator for Pocket PC English-Chinese, and LingvoSoft Talking PhraseBooks for MS Smartphone. In 2007, LingvoSoft Talking Dictionary 2008 for Windows Mobile Pocket PC won Best Software Award 2007 in the Multilingual Dictionaries category from Smartphone & Pocket PC magazine. In 2007, LingvoSoft Suite 2008 for Windows Mobile Pocket PC was nominated for Best Software Awards 2007 by Smartphone & Pocket PC magazine. In 2006, LingvoSoft Talking Dictionary 2006 for Pocket PC won Users Choice Award from Ipaqchoice.com. In 2006, LingvoSoft Bilingual Talking Dictionary 2007

was chosen as Finalist 2006 in the Best Multilingual Dictionaries category by Smartphone & Pocket PC magazine. In 2006, LingvoSoft Suite 2007 for Windows Mobile Pocket PC was chosen as Finalist 2006 in the Best Educational Multilingual Dictionary category by Smartphone & Pocket PC magazine. In 2005, LingvoSoft Dictionary 2006 for Windows Mobile Pocket PC won Best Software Award 2005 in the Best Multilingual Dictionaries category from Smartphone & Pocket PC magazine. In 2005, LingvoSoft Flashcards 2006 for Windows Mobile Pocket PC were nominated for Best Software Awards 2005 by Smartphone & Pocket PC magazine. See, Exhibit 10.

25. From 2004 to date, Ectaco has had extensive advertising and promotion in U.S. commerce of the linguistic products set forth in Registration No. 3,015,325 under the mark LINGVOSOFT. See, Confidential Exhibit 1.
26. From May 2004 to date, Ectaco has had extensive sales and distribution of the linguistic products set forth in Registration No. 3,015,325 under the mark LINGVOSOFT in the United States. See, Confidential Exhibit 1.
27. In addition to the mark LINGVOSOFT, Ectaco has offered various goods and services under the marks LINGVOBIT and LINGVO COMPASS LINGVA LINGUA INTERLINGVO N E S W. See, Exhibits 28 and 29.
28. Mark LINGVOBIT has been used since at least as early as 1999. Since 1999, it has been used to identify Ectaco's store where Ectaco sells its translation and other linguistic products including products sold under the LINGVOSOFT brand. I summarized information regarding Ectaco's Lingvobit stores in Exhibit 26.
29. Mark LINGVO COMPASS LINGVA LINGUA INTERLINGVO N E S W has been used since at least April 2007. See, Exhibit 29.
30. It is my understanding that Petitioner is a developer and manufacturer of linguistic, document recognition, document conversion and data capture software products. See, Exhibit 2.
31. Upon information and belief, Petitioner has never manufactured pocket electronic dictionaries or pocket electronic translators.

32. On September 16, 1992, Russian company Фирма БИТ ("Firma BIT" in Latin transliteration) filed a trademark application Serial No. 166031 requesting registration of the term LINGVO for, *inter alia*, computer software and computer interfaces in Class 9, programming and software development in Class 42 and various services in Classes 35 and 36. See, Exhibit 21. In the resulting Trademark Registration No. 129737 (hereinafter, "the first Russian LINGVO mark") issued on July 24, 1995, however, Russian Trademark Office (also referred to as "Rospatent") excluded Class 9 goods in their entirety and at least software and programming services of Class 42. See, Exhibit 21. Thus, the first Russian LINGVO mark was never registered for use on any linguistic product or service, including, any linguistic software. Nevertheless, BIT has marked its translation software Lingvo with a symbol ®. See, Exhibit 23.
33. According to the records of the Russian Trademark Office, Firma BIT has changed its name to Аби Программное Обеспечение ("Abi Programmnoye Obyespyechniye" in Latin transliteration), a company of Moscow, Russia. On April 12, 2000, Russian Trademark Office recorded change of ownership for the first Russian LINGVO mark from Abi Programmnoye Obyespyechniye to Аби Софтвр Хаус ("Abi Software House"), also a company of Moscow, Russia. Finally, on December 25, 2002, Russian Trademark Office recorded change of ownership for the same mark from Abi Software House to НЛС Текнолджис ЛТД ("NLS Technologies Ltd"), a Cyprus company. See, Exhibit 21.
34. Upon information and belief, none of the products labeled with the LINGVO mark ever identified NLS Technologies as its manufacturer. In fact, LINGVO products sold in 2002 identified "ABBYY Software House" of Moscow, Russia, as its manufacturer; LINGVO products sold in 2003 identified "ABBYY Software" of Moscow, Russia, as its manufacturer; LINGVO products sold in 2004 and 2005 identified "Аби Софтвр" of Moscow, Russia, as its manufacturer; and LINGVO products sold in 2006 identified "ABBYY ООО Аби" of Moscow, Russia, as its manufacturer. See, Exhibit 25.
35. First Russian LINGVO mark expired on September 16, 2002. See, Exhibit 21.

36. Russian Trademark Registration No. 224996 for the second LINGVO mark issued on October 17, 2002 naming Аби Софтвер Хаус (“Аbi Software House”) of Moscow, Russia as its owner.
37. On October 10, 2003, ownership of the second Russian LINGVO mark was transferred to NLS Technologies Ltd of Cyprus.
38. Finally, on March 28, 2006, ownership of the second Russian LINGVO mark was transferred to Аби Софтвер Лтд. (“Аbi Software Ltd.”), a Cyprus company.
39. Аби Софтвер Лтд. (“Аbi Software Ltd.”) is not registered in Cyprus. Instead, ABBYY Software Ltd., i.e., the Petitioner, is registered as a Cyprus company under Registration No. 130876. See, Exhibit 27.
40. There is no record in the Russian Trademark Office with respect to the second Russian LINGVO mark that Аби Софтвер Лтд. (“Аbi Software Ltd.”) and ABBYY Software Ltd. is the same entity.
41. There is no record in Cyprus Department of Registrar of Companies and Official Receiver that Аби Софтвер Лтд. (“Аbi Software Ltd.”) and ABBYY Software Ltd. is the same entity.
42. In accordance with the international transliteration standard (ISO 9 : 1995), Аби is transliterated as “Аbi”, not “АBBYY”. In reverse, ABBYY is transliterated into Cyrillic as “АББЫЫ”, not as “Аби”. Further, word “Аби” appears to be a proper noun, while term “АBBYY” is an unknown abbreviation.
43. Company named simply “АBBYY” is not registered either in Russia, Cyprus or the United States.
44. The only element of the alleged mark LINGVO is the literal term "Lingvo" written in block letters of English or Latin alphabet and having no other distinctive design features. See, Exhibit 14.
45. In 2007, Petitioner applied for federal registrations for marks LINGVO and ABBYY LINGVO with the USPTO. See, Exhibits 34 and 35. Both applications were initially rejected and are now suspended pending the outcome of the present proceeding.

46. The term “Lingvo” is translated from Esperanto to English to mean “language” or “linguistic communications.” See, Exhibit 5.
47. Upon information and belief, when Petitioner adopted the use of the term “Lingvo” for its linguistic products, it knew that the term “Lingvo” means “language” in Esperanto. See, Exhibit 1.
48. According to various sources, e.g.,
http://www.peacefromharmony.org/?cat=ru_c&key=239 2-20 million people use Esperanto. There are multiple international organizations, associations, congresses and clubs dedicated to studying and propagation of Esperanto. Esperanto is the most widely used international language and is especially popular in the modern Internet-dependent environment. See, Exhibit 13.
49. Esperanto term “Lingvo” is a term describing a standard concept of language, speech system, system of communication and/or intercommunication. See, Exhibit 15.
50. Term "Lingvo" is a mutually transliterated term between Latin and Cyrillic alphabets, i.e., "Lingvo" and "Лингво". See, Exhibit 15.
51. Term "Lingvo", as well as English terms “Language,” “Linguist,” “Linguistics,” and “Linguistic,” etymologically ascends to the Latin term “Lingua.” Further, term “Lingvo” is a direct translation of the terms “Language,” “Lingua” and equivalent terms in other languages. See, Exhibit 30. All of these terms are related to linguistics and language studies and are elements of linguistic terminology. See, Exhibit 15.
52. Term “Lingvo” is one of over 650 commonly used Lingvo Esperanto root words. See, Exhibit 5.
53. “Lingvo” is a transliteration of a Russian lexical unit "лингво" and is an initial part of multiple Russian complex words and terms, all identified with linguistics (for example, "лингвопроцессор," in Latin transliteration "lingvoprocessor", in English – “linguistic processor”). I have compiled a table of such complex words and provided their transliterations and definitions in Exhibit 22.

54. Latin and Cyrillic terms "Lingvo" and "Лингво" constitute parts of titles or designations of various linguistic goods and services. For example, Internacia Lingvo Esperanto is an official name of the Esperanto language and a title of a textbook bearing the same name. See, Exhibit 16. Particularly, the following linguistic books have the term "lingvo" in their titles:

Munniksma F.

Internacia komerca-ekonomika vortaro en 11 lingvoj

Pekino: Ĉina Esperanto-Eldonejo, 1990, 3a eldono. 688 p.

Koutny Ilona

Angla-Esperanta-Hungara etvortaro pri Lingvo kaj Komunikado (kun ekzercoj)

Poznań: ProDruk, 2003. 140 p.

Koutny Ilona, Brosch Cyril, Jaskot Maciej, Vogt Horst

Germana-Esperanta-Pola etvortaro pri Lingvo kaj Komunikado (kun ekzercoj)

Poznań: ProDruk, 2008. 144 p.

Waringhien, G. (Gaston) Lingvo kaj vivo: esperantologiaj eseoj. Rotterdam :
Universala Esperanto-Asocio, 1989. 452p.

La internacia lingvo: (Faktoj pri esperanto) /Red. orig. en esperanto de Ivo
Lapenna.- Londono: Universala Esperanto-Asocio. Centro de Esploro
kaj Dokumentado, 1954.- 192 p.

Werner Bormann:

Mondkomerco kaj Lingvo,

Aŭtoro, Hamburg, 1993

BonaLingvo

Claude Piron:

La bona lingvo, Pro Esperanto/HEA, Vieno/Budapeŝto, 1989

DanĝLing

Ulrich Lins:

La danĝera lingvo, studo pri la persekutoj kontraŭ Esperanto,
L'omnibuso, Kioto, 1973 1a eldono
Bleicher, Gerlingen, 1988 2a eldono
eldonejo Progreso, , 1990 represo de la 2a eldono

Pri la solvo de l'problemo de internacia lingvo por komerco kaj trafiko. Zur
Lösung der Frage einer internationalen Handels- und Verkehrssprache. Amtlicher
Sitzungsbericht der Internationalen Konferenz für eine gemeinsame Hilfssprache
des Handels und Verkehrs, Venedig, 2.-4. April 1923 ,
Frankfurter Messamt, Frankfurt a.M., 1923

Ludoviko Lazaro Zamenhof:
Fundamenta Krestomatio de la lingvo Esperanto,
Hachette et Compagnie, Parizo, 1904

Bertilo Wennergren:
Landoj kaj lingvoj de la mondo

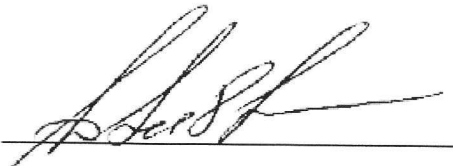
Kalocsay:
Lingvo, Stilo, Formo,
Budapest, 1931
Valdemar Langlet:
Vojaĝimpresoj,
Lingvo Internacia, 1895 1a eldono
Inko, Tyresö, 2003 2a eldono

55. A search of the catalog of the New York Public Library revealed 276 titles including the term “lingvo” in their titles. All of these titles are related to linguistics. See Exhibit 16. Similarly, Angla Lingvo - Esperanto is a title of one of many software dictionaries, see Exhibit 17, and various websites include the term “lingvo” in their domain names and offer linguistic goods and services see Exhibit 18. Finally, other linguistic goods and services providers use the term "Lingvo" or "Лингво" as at least a part of their titles.

56. Term "Lingvo" contains an international root "Lingv"/"ЛИНГВ" and their morphs "Ling"/"ЛИНГ" and "Lang" which are distinctive for linguistics.
57. Taken into consideration the above, I believe that, when used on products related to linguistics and, specifically, on linguistic software, term "Lingvo" is a generic term and cannot serve as a trademark.
58. Even if the term "Lingvo" is not generic when used in connection with linguistic products, the term is merely descriptive of such products. See, Exhibit 6.
59. Trademark Office has consistently required disclaimer of the term "language" (in both English and Latin) from trademarks used on linguistic products. See, Exhibit 24.
60. As stated above, the term "Lingvo" is translated to mean "language" in the Esperanto language. See Exhibit 5. Petitioner uses this term in connection with software featuring instruction in languages, language dictionaries and language translation services. See, Exhibit 20. Thus, language is a feature of the Petitioner's goods and services.
61. Therefore, the term "Lingvo" is a non-English equivalent of a merely descriptive English word "language", and the Petitioner's trade name merely describes a main feature of its goods and/or services.
62. Petitioner failed to develop an association in the eyes of an ordinary U.S. consumer between the term "Lingvo" and the Petitioner.
63. There are multiple linguistic products and services identified with the term "Lingvo." See, Exhibits 16-19. Petitioner could not have developed an association in the eyes of an ordinary consumer in the presence of other similar linguistic products utilizing the same term "Lingvo" in their trade names.
64. Petitioner's Russian trademark LINGVO is not a "famous foreign mark."
65. Consumers in the relevant U.S. market are not familiar with the Russian trademark LINGVO and/or do not associate with the Russian trademark LINGVO with the goods listed in Registration No. 3,015,325.

66. Search of the Smart Phone & Pocket PC Magazine website did not produce any results for the search term LINGVO. See, Exhibit 12.
67. Marks LINGVO and LINGVOSOFT coexisted in the marketplace without any notice from Petitioner to Ectaco.
68. Petitioner should have known about existence of the mark LINGVOSOFT at least since the mark was published for opposition in August 2005.
69. Petitioner knew about the existence of the mark LINGVOSOFT at least as early as the filing date of the Russian litigation against Russian company Ectaco RD. See, Exhibit 3.
70. Decision of the Russian law suit is currently on appeal at Russian Exhibit 31.
71. Products sold under the mark LINGVO meet in the market with products having the term "lingvo" in their names. See Exhibit 18.

I declare under the penalty of perjury under the laws of the State of New York and the United States of America that the foregoing is true and accurate. Executed on March 5, 2010 in the City of New York, NY USA.



David Lubinitsky