

ESTTA Tracking number: **ESTTA253341**

Filing date: **12/05/2008**

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

## Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

### Petitioner Information

Name	Software602, Inc.		
Entity	Corporation	Citizenship	Florida
Address	500 Osceola Ave. Jacksonville, FL 32250 UNITED STATES		

Attorney information	Evan Anderson, Esq. Patel & Alunit, P.C. 16830 Ventura Blvd. Suite 360 Encino, CA 91436 UNITED STATES evan@patelalunit.com, john@patelalunit.com Phone:(818) 380-1900		
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### Registration Subject to Cancellation

Registration No	2815750	Registration date	02/17/2004
Registrant	Black Ice Software, Inc. 20 Broad St Nashua, NH 03064 UNITED STATES		

### Goods/Services Subject to Cancellation

Class 009. First Use: 2003/04/02 First Use In Commerce: 2003/04/02  
All goods and services in the class are cancelled, namely: Computer Software for attaching files in portable document format file format to an e-mail

### Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)

### Mark Cited by Petitioner as Basis for Cancellation

U.S. Application No.		Application Date	
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	NONE		

Goods/Services	
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Attachments	TTAB - Petition to Cancel - PRINT2PDF.pdf ( 5 pages )(46575 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/evananderson/
Name	Evan Anderson, Esq.
Date	12/05/2008

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Software602, Inc.	)	
	)	
	)	
Petitioner,	)	Cancellation No. _____
	)	
v.	)	Registration No. 2815750
	)	
Black Ice Software, Inc.	)	
	)	
Registrant.	)	

**PETITION TO CANCEL**

Petitioners, Software602, Inc., a Florida corporation, whose principal place of business is located at 500 Osceola Avenue, Jacksonville Beach, FL 32250, hereby petitions to cancel registration number 2815750 (PRINT2PDF), registered on February 17, 2004, and owned by Black Ice Software, Inc., a New Hampshire corporation, whose principal mailing address is 20 Broad St., Nashua, NH 03064.

As grounds in support of its petition to cancel, Petitioners assert as follows:

**COUNT ONE**

**Likelihood of Confusion**

1. Petitioner is the trademark owner of U.S. Serial No. 77625384 for the trademark PRINT2PDF used in connection with computer software and downloadable computer

software for converting and creating portable document format (PDF). Opposer's effective priority filing date was December 3, 2008.

2. Registrant is the registered trademark owner of U.S. Registration No. 2815750 for the trademark PRINT2PDF used in connection with computer software for attaching files in portable document format file format to an e-mail. Opposer's effective priority filing date was May 16, 2002.
3. There is a dispute as to priority. Registrant has an effective filing date of May 16, 2002 and claims first use in commerce as of April 2, 2003. Petitioner has an effective filing date of December 3, 2008 and claims first use in commerce as of May 24, 2001. Therefore, Petitioner has earlier common law right in the PRINT2PDF mark.
4. By the end of 2001, Petitioner had already established a customer base in connection with the PRINT2PDF mark and product line that totaled in excess of 4,000 customers. Therefore, Petitioner has earlier common law rights in the PRINT2PDF mark.
5. Registrant's Mark is identical to Petitioner's PRINT2PDF mark. As both marks are filed as word marks only, it is indisputable that the dominant feature of the mark is the PRINT2PDF wording.
6. Registrant's Products are also nearly identical to those offered by Petitioner under its PRINT2PDF mark. In fact, Registrant's Products directly compete with Petitioner's. Consequently, Registrant's Products are highly related to Petitioner's Product line associated with the PRINT2PDF mark and flow in the same or related channels of trade.

7. Registrant's continued use of the PRINT2PDF trademark will likely cause confusion among the relevant consuming public and will likely cause the relevant consuming public to mistakenly conclude that Registrant's goods are associated with Petitioner, when in fact they are not.
8. Registrant's continued use of the PRINT2PDF trademark is likely to cause injury to Petitioner's business reputation and to injure and impair Petitioner's rights in the PRINT2PDF trademark by causing confusion, mistake, and/or deception as to the respective rights of the parties as to the source or sponsorship of such goods.
9. Through extensive use, advertising, marketing and promotion of Petitioner's marks, Petitioner has built up, at great expense and effort, a valuable reputation and goodwill symbolized by its strong and distinctive mark.

## **COUNT TWO**

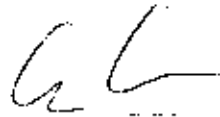
### **Descriptiveness**

10. In the alternative and in the event that the Registrant's registration is not cancelled under COUNT ONE, Petitioner, upon information and belief, alleges that the mark PRINT2PDF is descriptive and not registerable on the Principal Register.
11. Registrant's PRINT2PDF trademark identifies a feature, ingredient, purpose or goal of the Registrant's product, and is ineligible for trademark protection in the Principal Register. Specifically, Petitioner's product's purpose is to "convert and create portable format documents."
12. The process of "converting and creating portable document formats" is commonly referred to in the computer industry as the "print to .pdf" process.

13. Registrant's PRINT2PDF trademark therefore simply describes the purpose, goal, and function of its' product line.

WHEREFORE, Petitioners prays that this cancellation be sustained under COUNT ONE, and in the alternative, should such remedy be denied, that registration no. 2815750 be cancelled on the Principal Register.

By



Evan G. Anderson  
Patel & Alunit, PC  
16830 Ventura Blvd.  
Suite 360  
Encino, CA 91436  
(818) 380-1900

Attorney for Petitioner

**PROOF OF SERVICE BY MAIL**

I am more than eighteen years old and not a party to this action. My business address is Patel & Almit, P.C., 16830 Ventura Blvd., Suite 360, Encino, California 91436. On December 5, 2008, I served the following documents:

PETITION TO CANCEL.

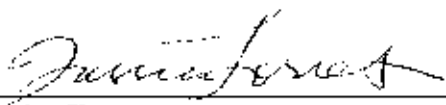
on the interested parties in this action by placing true and correct copies thereof in sealed envelope(s) addressed as follows:

Andrew P. Cernota, Esq.  
100 Main Street  
Suite 2  
P.O. Box 3445  
Nashua, NH 03061-3445

I am employed in the county from which the mailing occurred. On the date indicated above, I placed the sealed envelope(s) for collection and express mailing at this firm's office business address indicated above. I am readily familiar with this firm's practice for the collection and processing of correspondence for mailing with the United States Postal Service. Under that practice, the firm's correspondence would be deposited with the United States Postal Service on this same date with postage thereon fully prepaid in the ordinary course of business.

I declare under penalty of perjury that the following is true and correct.

Executed on 12/5/08 at Encino, California.

  
\_\_\_\_\_  
Jessica Torres