

ESTTA Tracking number: **ESTTA623345**

Filing date: **08/25/2014**

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	Avnet, Inc.		
Entity	Corporation	Citizenship	New York
Address	2211 South 47th Street Phoenix, AZ 85034 UNITED STATES		

Attorney information	Kathy Tsai Fish & Richardson, P.C. P.O. Box 1022 Minneapolis, MN 55440-1022 UNITED STATES tmdoctc@fr.com, tsai@fr.com, nagy@fr.com Phone:650-839-5070		
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Registration Subject to Cancellation

Registration No	4019288	Registration date	08/30/2011
Registrant	Exoprise Systems, Inc. 275 Wyman Street, Suite 160 Waltham, MA 02451 UNITED STATES		

Goods/Services Subject to Cancellation

<p>Class 042. First Use: 2010/12/00 First Use In Commerce: 2011/01/00 All goods and services in the class are cancelled, namely: Cloud computing featuring software for use in assessing, migrating and monitoring on-premise applications to cloud-based alternatives; Computer services, namely, remote and on-site management of cloud computing systems and applications for others; Computer services, namely, remote and on-site management of the information technology (IT) cloud computing systems of others; Consulting services in the field of cloud computing; Technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; Technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems</p>
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	CLOUDREADY
Goods/Services	education, consulting, and technical services in the field of cloud computing, datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services

Attachments	14400-0556PP1 Petition to Cancel.pdf(87724 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	/kathy tsai/
Name	Kathy Tsai
Date	08/25/2014

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

AVNET, INC.

Petitioner,

v.

EXOPRISE SYSTEMS, INC.,
Registrant.

Cancellation No.: _____

Mark: CLOUDREADY

Registration No. 4,019,288

Registered: August 30, 2011

PETITION TO CANCEL

Avnet, Inc. (“Avnet”), a New York corporation having a principal place of business at 2211 South 47th Street, Phoenix, Arizona 85034, believes it is damaged by and will continue to be damaged by registration of the mark shown in U.S. Registration No. 4,019,288 (the “Registration”) and hereby petitions to cancel the same pursuant to the provisions of 15 U.S.C. § 1064.

The grounds for cancellation are as follows:

1. Avnet is a leading distributor of electronic components and technology solutions. Through its Avnet Technology Solutions operating group, Avnet provides information technology solutions to its partners and customers, including value-added resellers, software vendors, and IT service providers. Avnet assists its partners and customers with the development and implementation of information technology and datacenter solutions in a variety of fields, including energy, finance, healthcare, government, and retail.

2. In May 2010, Avnet launched its CLOUDREADY services, an initiative that assists clients in the field of cloud computing. Under its CLOUDREADY mark, Avnet offers, and has offered since at least as early as May 2010, education, consulting, and technical services

in the field of cloud computing. As a result of its continuous use of its CLOUDREADY mark in connection with education, consulting, and technical services in the field of cloud computing since at least as early as May 2010, Avnet owns valuable common law rights in the CLOUDREADY mark.

3. On February 7, 2011, Registrant Exoprise Systems, Inc. (“Registrant”) filed an application to register CLOUDREADY as a service mark for “Cloud computing featuring software for use in assessing, migrating and monitoring on-premise applications to cloud-based alternatives; Computer services, namely, remote and on-site management of cloud computing systems and applications for others; Computer services, namely, remote and on-site management of the information technology (IT) cloud computing systems of others; Consulting services in the field of cloud computing; Technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services; Technical support services, namely, remote and on-site infrastructure management services for monitoring, administration and management of public and private cloud computing IT and application systems” in International Class 42. The Registration issued on August 30, 2011.

4. In its Registration, Registrant claims to have first used the CLOUDREADY mark in December 2010.

5. Avnet began using its CLOUDREADY mark at least as early as May 2010, before Registrant filed its application for CLOUDREADY and before Registrant’s claimed date of first use of the CLOUDREADY mark.

6. Avnet's common law rights in its distinctive CLOUDREADY mark precede Registrant's filing date and claimed date of first use and, upon information and belief, any priority date upon which Registrant may rely.

7. Avnet has priority over Registrant.

8. The services identified in the Registration are identical and highly related to the services offered by Avnet under its CLOUDREADY mark. The Registration covers, and Avnet provides under its CLOUDREADY mark, consulting services in the field of cloud computing, technical consulting services in the fields of datacenter architecture, public and private cloud computing solutions, and evaluation and implementation of internet technology and services (among other services).

9. Registrant's mark CLOUDREADY is identical to Avnet's mark CLOUDREADY.

10. Registrant's mark CLOUDREADY so resembles Avnet's mark CLOUDREADY as to be likely, when used in connection with the services identified in the Registration, to cause confusion, to cause mistake, or to deceive. Consumers are likely to believe, mistakenly, that the services Registrant claims to offer under the CLOUDREADY mark are rendered, sponsored, endorsed, or approved by Avnet, or are in some way affiliated, connected, or associated with Avnet and/or its CLOUDREADY services, all to the detriment of Avnet. Therefore, Registrant's mark should be cancelled under 15 U.S.C. §§ 1052(d) and 1064.

11. Continued registration of the CLOUDREADY mark would be a further source of damage to Avnet, as it confers upon Registrant various statutory presumptions to which it is not entitled in view of Avnet's prior use of the CLOUDREADY mark.

WHEREFORE, pursuant to Section 14 of the Lanham Act, 15 U.S.C. § 1064, Avnet respectfully requests that U.S. Registration No. 4,019,288 in International Class 42 be cancelled in its entirety.

Please charge the cancellation fee to the Deposit Account of Fish & Richardson P.C., Account No. 06-1050.

Respectfully submitted,

Date: August 25, 2014

/Kathy Tsai/
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ATTORNEYS FOR AVNET, INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the PETITION TO CANCEL has been served this 25th day of August, 2014 by First Class U.S. Mail, postage prepaid, upon Registrant Exoprise Systems, Inc. at the following addresses:

JAMIE WATT
EXOPRISE SYSTEMS, INC.
275 WYMAN ST STE 160
WALTHAM, MA 02451-1254

___/Kathy Tsai _____
Kathy Tsai