

ESTTA Tracking number: **ESTTA637673**

Filing date: **11/07/2014**

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	The Scripps Research Institute		
Entity	Corporation	Citizenship	California
Address	10550 North Torrey Pines Road La Jolla, CA 92037 UNITED STATES		

Attorney information	Dr. Thomas Fitting, Esq. The Scripps Research Institute 10550 North Torrey Pines Road Office of Patent Counsel, TPC8 La Jolla, CA 92037 UNITED STATES fitting@scripps.edu Phone:858-784-2937		
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Registration Subject to Cancellation

Registration No	4418343	Registration date	10/15/2013
Registrant	Tautenhahn, Ralf 8536 Via Mallorca Unit B La Jolla, CA 92037 UNITED STATES		

Goods/Services Subject to Cancellation

Class 009. First Use: 2005/12/07 First Use In Commerce: 2011/06/20 All goods and services in the class are cancelled, namely: Computer software for processing and visualization of chromatographically separated and single-spectra mass spectral data
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Grounds for Cancellation

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	XCMS		
Goods/Services	COMPUTER SOFTWARE FOR PROCESSING AND VISUALIZATION OF CHROMATOGRAPHICALLY SEPARATED MASS SPECTRAL DATA		

Attachments	ScrippsPetitionForCancellation.pdf(240499 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 USPS Express Mail Post Office to Addressee on this date.

Signature	/Thomas Fitting/
Name	Dr. Thomas Fitting, Esq.
Date	11/07/2014

In the Matter of
Trademark Registration No. 4,418,343
Published in the Official Gazette on October 15, 2013
For the Trademark XCMS

To the Director of Patents and Trademarks:

In the matter of the use-based registration of Ralf Tautenhahn (hereinafter “Tautenhahn” or “Respondent”) for the trademark XCMS, Registration No. 4,418,343, The Scripps Research Institute, a California nonprofit public benefit corporation located at 10550 North Torrey Pines Road, La Jolla, CA 92037 (hereinafter “TSRI” or “Petitioner”) believes that it will be damaged by the continuance on the Register of the mark and hereby petitions for cancellation of the same. As grounds in support of its petition, it is alleged, upon information and belief, as follows:

Preliminary Statement

1. TSRI is a world leader in biomedical research and its Center for Metabolomics is renowned for its work in Metabolomics. TSRI has spent years developing and testing XCMS and promoting it to the public. TSRI’s XCMS technology is one of the most widely used metabolomic data processing technology in the world. TSRI enjoys a strong reputation in the trade by virtue of its product with over one million downloads of its downloadable version and over five thousand subscribers in over 120 countries to its online version.
2. Since at least as early March 31, 2005, TSRI has continuously developed, marketed, and provided the framework for its XCMS computer software for processing and visualization of chromatographically separated mass spectral data in interstate commerce under the trademark XCMS.

3. TSRI continues to expand the use of the brand, building on the popular XCMS platform to include a cloud-based informatics platform.

4. TSRI's XCMS brand products and services have garnered substantial public recognition and goodwill.

5. In this petition, TSRI seeks to cancel registration of the confusingly IDENTICAL MARK, XCMS, in connection with computer software for processing and visualization of chromatographically separated and single-spectra mass spectral data in International Class 9.

THE XCMS MARK

6. TSRI is the owner of common-law rights in the trademark XCMS based on its prior and continuous use in commerce since at least as early as March 2005.

7. Since at least as early as March 31, 2005, Petitioner has offered software for processing and visualization of chromatographically separated and single-spectra mass spectral data (LC-MS data) produced in metabolomic studies for download under the mark XCMS through its website <http://metlin.scripps.edu> and on the internet at www.bioconductor.org. Since its introduction, TSRI's XCMS software product has been downloaded more than 1 million times.

8. TSRI has continued to develop its products and, in 2008, introduced XCMS², an open-source source software package that automatically searches tandem mass spectrometry (MS/MS) data against high quality experimental MS/MS data from known metabolites contained in a reference library, and in 2011 TSRI introduced metaXCMS, which performs second-order ("meta") analysis and visualization of untargeted metabolomics data from multiple sample groups representing different models of the same phenotype.

9. The use of the XCMS mark was further expanded in April 2009 to include internet services branded XCMS Online, a cloud-based informatics platform designed to process and

visualize mass-spectrometry-based, untargeted metabolomic data, while providing an intuitive interface for its products.

10. On November 7, 2011, due to the popularity of the software, and in order to exploit its own goodwill and to enable consumers to locate its products by its brand, Petitioner registered and still maintains a Web site at the <https://xcmsonline.scripps.edu> domain name. Accordingly, consumers who have come to rely on the XCMS mark as an indicator of source for Petitioner's products should be able to easily locate Petitioner's products by typing in <https://xcmsonline.scripps.edu> into their Web browser or by typing XCMS into any Internet search engine. XCMS online has more than 5,400 registered users from 120 different countries.

11. TSRI has further expanded the XCMS brand in 2013 with its latest development, XCMS server, a local version of XCMS online which provides the consumer with direct access to rapid on-site analyses. XCMS server developed with TSRI technology incorporates all of the features of XCMS online with unlimited bandwidth, storage and processing capabilities.

12. Due to the popularity of its products, and in order to exploit its own goodwill and to enable consumers to locate its products by its brand, Petitioner has maintained a Web site at the <http://www.xcmserver.com> domain name since November 20, 2013. Accordingly, consumers who have come to rely on the XCMS mark as an indicator of source for Petitioner's products should be able to easily locate Petitioner's products by typing in <http://www.xcmserver.com> into their Web browser or by typing XCMS server into any Internet search engine. TSRI licenses its XCMS server to consumers.

13. TSRI also provides instruction on XCMS software through its XCMS institute online at <https://xcmsonline.scripps.edu/institute>. The videos available online teach the basic principles of XCMS processing and visualization software for metabolite identification and analysis.

14. TSRI has expended great effort and expense in developing and promoting its XCMS brand and prominently uses the mark XCMS in the distribution, promotion and advertising of its products and services provided under the mark. The XCMS brand of products assist in a broad array of metabolite research and metabolite identification by processing chromatographically separated and single-spectra mass spectral data and providing consumers access to its repository of current and comprehensive MS/MS metabolite data.

15. As a result of promotion and expense, TSRI has valuable goodwill established in the XCMS mark.

16. Petitioner's XCMS products and related goods and services have been featured in dozens of publications highlighting Petitioner's technological advancements in its software for processing and visualization of LC/MS metabolomic data. The February 1, 2006 *Analytical Chemistry* publication XCMS: Processing Mass Spectrometry Data for Metablite Profiling Using Nonlinear Peak Alignment, Matching and Identification has been cited in over 1,070 related articles. Most recently, an article featured in the June 16, 2014 publication of *Analytical Chemistry*, Interactive XCMS Online: Simplifying Advanced Metabolomic Data Processing and Subsequent Statistical Analyses, provides scholarly insight to consumers on the latest developments in the XCMS branded platform.

17. Petitioner's goods and services offered under the XCMS mark have achieved a reputation for excellence because of the high quality of the goods and services offered.

18. Indeed, the XCMS products and related goods and services have received favorable unsolicited media coverage as well, including a 2006 article in Journal of Proteome Research for "XCMS for metabolite profiling;" a June 2012 feature of TSRI's XCMS online database in

www.separationsNOW.com; and a November 2012 feature of XCMS Online Global Metabolomic Initiatives at www.news.wustl.edu.

19. As a result of promotion, quality of product, word of mouth from consumers and unsolicited media coverage, the XCMS mark is strong and has become well-known in association with software for processing and visualization of chromatographically separated and single-spectra mass spectral data.

RESPONDENT'S TRADEMARK REGISTRATION AND USAGE

20. On March 11, 2013, long after TSRI's mark had become well-known, Respondent applied for trademark registration of the XCMS mark in connection with the following goods: "Computer software for processing and visualization of chromatographically separated and single-spectra mass spectral data" in International Class 9. Respondent's application for registration was granted and published on the Official Gazette on October 13, 2013.

21. Respondent procured its registration through fraud.

22. At the time of filing the application for trademark Registration No. 4,418,343 Respondent's knew, or had reason to believe, that the IDENTICAL XCMS mark was owned and in prior and continuous use in commerce by Petitioner for identical services or that such registration by Respondent of the IDENTICAL XCMS mark was likely to cause confusion or mistake or to deceive. Respondent willingly deceived the Trademark Office in his application for registration of the XCMS mark.

23. Respondent made knowingly inaccurate statements or knowingly misleading statements in his verified declaration that "to the best of his knowledge and belief no person, firm, corporation, or association has the right to use such mark in commerce, either in identical form

or in such near resemblance to the mark as may be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake or to deceive.”

24. Respondent further intended to deceive the Trademark Office and knowingly made false, material representations of fact in connection with the Respondent’s Specimens of Use which purport to establish Respondent’s use of the XCMS mark in commerce.

25. Respondent knew that Petitioner is the senior user of the mark in commerce for computer software for processing and visualization of chromatographically separated and single-spectra mass spectral data.

26. Respondent, who is in fact a former employee of Petitioner, was hired May 1, 2009 as a research associate to work in Petitioner’s Center for Metabolomics, where the XCMS database has been maintained since at least as early as March 2005.

27. Per the terms of his employment agreement, Respondent executed an intellectual property assignment agreement on April 30, 2009, “assigning any and all rights, title and interest to any inventions, idea, or confidential information, whether or not patentable” made or conceived by Respondent alone or in conjunction with others which “relates in any manner to the business of TSRI.”

28. Respondent, during the course of his employment from 2009-2013, assisted in updating XCMS under the direction of Petitioner and was allowed to co-author several papers, detailing Petitioner’s technological advances in the XCMS brand database, which were published under the approval of and with attribution to Petitioner.

29. At some time in mid-2013, Petitioner discovered that Respondent had attempted to fraudulently acquire certain of Petitioner’s intellectual property. On August 27, 2013, Respondent’s employment with TSRI was terminated.

30. Letters from Petitioner's counsel were forwarded to Respondent prior to his termination, in July 2013, reiterating his obligations under his employment and assignment agreements and demanding that he cease any unauthorized use of intellectual property associated with XCMS.

31. After his termination, Petitioner discovered Registration No. 4,418,343 and in June 2014, Petitioner's Counsel forwarded a letter to Respondent demanding that he voluntarily cancel his fraudulent registration for the XCMS. To Petitioner's knowledge, Respondent has ceased unauthorized use of TSRI's intellectual property, but has refused to voluntarily cancel his fraudulent registration.

32. Respondent knowingly provided misleading Specimens of Use to the Trademark Office.

33. Respondent's application states that "Specimen 1 shows the website where the current release of XCMS is maintained for download and installation." Page 2 of specimen 1 provides the URL for download and installation of the XCMS software as "http://metlin.scripps.edu/download/." The URL provided as Respondent's specimen of use is in fact Petitioner's URL: http://metlin.scripps.edu/download/. Page 1 of specimen 1, identifies Respondent as a maintainer of the site in his capacity as an employee of Petitioner, to be contacted at the domain registered by Petitioner: "rtautenh at scripps.edu." Specimen 1 is evidence of Petitioner's use in commerce of the XCMS mark, which provides to consumers access to Petitioner's XCMS software for download from its website http://metlin.scripps.edu/download/. Specimen 1 also provides to the consumers the contact information of Petitioner's employees: "csmith at scripps.edu" and "rtautenh at scripps.edu." No use by Respondent is provided in Specimen 1.

34. Respondent's application states that "Specimen 2 shows the website of an online forum where users can discuss issues related to XCMS usage." Petitioner is informed, and has reason to

believe, that the online forum is not owned or maintained by Respondent. Respondent merely posted an entry onto the owner's forum offering a tip for reporting bugs of Petitioner's web platform. No use in commerce by Respondent is provided in specimen 2.

35. Respondent applied for registration of the XCMS mark, in violation of his intellectual property assignment of rights and employment agreement.

36. Respondent intentionally deceived the Trademark Office by providing specimens of which deceitfully attempt to support Respondent's use in commerce.

37. Respondent has no legal right to the XCMS mark by virtue of Respondent's intellectual property assignment agreement. Further, Respondent has not provided a specimen of Respondent's actual and exclusive use in commerce of the XCMS mark in accordance with 37 C.F.R. §2.59(a). Respondent's registration was fraudulently obtained and is invalid.

38. Petitioner is the first user, has continued to use, and by reason of its first and continuous use of XCMS for its products, is the owner of the trademark XCMS for computer software for processing and visualization of chromatographically separated and single-spectra mass spectral data.

39. If there is a legal conflict between Petitioner's trademark rights, and Respondent's trademark rights, with respect to XCMS for computer software for processing and visualization of chromatographically separated and single spectra mass spectral data, then Petitioner, being at present the senior continuous user and legal owner of its trademark XCMS, is injured and damaged by the continuance on the Register of Registration No. 4,418,343.

LIKELIHOOD OF CONFUSION

40. Petitioner's use of the XCMS mark pre-dates the Respondent's filing date and stated first use. As noted above, Respondent's application was filed March 11, 2013, its first use in

commerce was identified as June 20, 2011, and its stated first use anywhere was identified as December 7, 2005. Respondent had no association with the XCMS mark until his employment with Petitioner in 2009 and Petitioner has continuously used the XCMS mark in commerce since at least as early as March 2005.

41. Due to the strength of TSRI's mark, the similarity between the marks, the similarity between the goods, as well as the similarity between channels of trade, Respondent's purported use and registration of the XCMS mark is likely to cause confusion in the marketplace.

42. As set forth above in paragraphs 1-19, and incorporated herein by reference, the XCMS mark is strong.

43. The XCMS marks are IDENTICAL.

44. As noted above, applicant alleges use of the mark XCMS in connection with computer software for processing and visualization of chromatographically separated and single-spectra mass spectral data in Class 9. These same services have been provided by Petitioner under the mark XCMS since at least as early as March 2005.

45. The general class of purchasers of the parties' respective products are the same.

46. The parties' services are thus similar and competing.

47. In view of the foregoing, Respondent's registration for the XCMS mark is likely to cause confusion and mistake as to the origin in Respondent's services and Petitioner is injured and damaged by the continuance on the Register of Registration No. 4,418,343.

WEREFORE, Petitioner, The Scripps Research Institute, believes and submits that it is damaged by Registration No. 4,418,343 continuing on the Register, and requests that the registration be cancelled.