

ESTTA Tracking number: **ESTTA1021848**

Filing date: **12/11/2019**

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

| | |
|------------------------|---|
| Proceeding | 92070823 |
| Party | Plaintiff ICWare Systems, Inc. dba BatchTest Corporation |
| Correspondence Address | DINESH PATEL ICWARE SYSTEMS INC DBA BATCHTEST CORPORATION 2118 WALSH AVE, SUITE 150 SANTA CLARA, CA 95050 UNITED STATES BatchTest_TM@batchtest.com 408-454-8378 |
| Submission | Motion to Amend Pleading/Amended Pleading |
| Filer's Name | Dinesh Patel |
| Filer's email | BatchTest_TM@batchtest.com |
| Signature | /Dinesh Patel/ |
| Date | 12/11/2019 |
| Attachments | 20191211 BatchTest 2nd Amended Petition For Cancellation.pdf(159309 bytes) |

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

In re Registration of ASSOCIATED RESEARCH, INC.

Mark: BatchTEST
Reg. No.: 4499170

| | | |
|---------------------------|---|---------------------------|
| ICWARE SYSTEMS INC. |) | CANCELLATION NO. 92070823 |
| dba BATCHTEST CORPORATION |) | |
| |) | |
| Petitioner, |) | |
| |) | |
| V. |) | |
| |) | |
| IKONIX USA LLC. |) | |
| |) | |
| Registrant. |) | |

SECOND AMENDED PETITION FOR CANCELLATION

ICware Systems, Inc. dba BatchTest Corporation (“BatchTest”), a California corporation with an address at 2118 Walsh Ave, Suite 150, Santa Clara, California 95050, USA, believes that it has been and will continue to be damaged by the continued registration of the trademark BATCHTEST (the “Mark”) in Registration No. 4499170 (the “Registration”), and hereby petitions to cancel the Registration.

The grounds for cancellation are as follows:

Background

1. BatchTest is a designer, producer, and marketer of electronic boards & devices, Integrated Systems, Software, and other related products and services in the fields of Automation, Medical Devices, Secure Communications, Embedded Systems, and Contract Manufacturing.
2. Upon information and belief, IKONIX USA LLC (“Registrant”) is a Delaware limited liability company with its principal place of business at 28105 North Keith Dr., Lake Forest, Illinois 60045, USA.

3. Upon information and belief, ASSOCIATED RESEARCH, INC. (“ARI”) is an Illinois corporation on and before March 18, 2014, with its principal place of business at 13860 W. Laurel Drive, Lake Forest, Illinois 60045, USA.

4. ARI is Registrant’s predecessor-in-interest. ASSOCIATED RESEARCH is a division, and assumed name of Registrant.

5. Mr. Thomas J. Moore of Bacon & Thomas, PLLC, 625 SLATERS LN FL4, Alexandria, VA 22314-1169, is listed as Attorney of Record on the Registration.

6. “Dinesh Patel, ICware Systems”, a sole proprietor (“DP-ICware”), is BatchTest’s immediate predecessor-in-interest. DP-ICware had first used the Mark on or before September 5, 2007, and delivered a software product with the Mark displayed on it, to a client in year 2007. DP-ICware had used the Mark for goods and services in commerce in Classes 9 and 42 until he transferred and assigned the BATCHTEST mark, the ICware Systems name and business, together with the goodwill associated with the Mark and business, to BatchTest in 2008. All relevant specimens are attached in 13 TTABVUE as Exhibit “A”.

7. Prior to filing of the application for the Registration, BatchTest had established Common Law rights in and to the Mark through its use on goods and services in Classes 9 and 42 in interstate commerce, and the Mark has been in continuous use by BatchTest since the said application was filed. BatchTest has applied for registration of the Mark in International Class 009 (Application Serial No. 88723304) and intends to also apply in Classes 41 and 42. Numerous evidences of continuous use of the Mark in commerce by Petitioner between 2007 and 2019 are attached in 13 TTABVUE as Exhibit “B”.

8. The Mark has also been BatchTest’s domain name since December 31, 2010 and serving as one of the channels of its advertising and commerce. BatchTest has also done business with the Mark as its assumed trade name since approximately March 2011. “BatchTest Corporation” is BatchTest’s official trade name and identity. In fact, a simple Google search on April 22, 2019 on the internet for “BATCHTEST” showed numerous website links pointing to BatchTest and its products and services, whereas none of them pointed to Registrant or any of its products in as many as the first 10 pages of the search with approximately 100 website links. Similar searches on Microsoft’s Bing or Yahoo search engines also reveal numerous website links to BatchTest and its

products and services showing at the top Result of a “WHOIS” query on official ICANN is attached in 13 TTABVUE as Exhibit “C”.

9. BatchTest filed a Fictitious Business Name on February 20, 2012, dba “BatchTest Corporation” (13 TTABVUE, Exhibit D.)

10. On November 21, 2012, Registrant’s predecessor-in-interest ARI filed application Serial No. 85784793 (the “Application”) to register the Mark with the USPTO. The Application was filed under Section 1(b) of the Trademark Act for the goods & services in Class 9 “Software for use in testing electrical safety products to ensure compliance with regulations, and to set up electrical safety products for their intended use, and to analyze the results of the tests of electrical safety products; computer software for recording test data, archiving test data, importing test data into a spreadsheet or database, logging test data, statistically analyzing test data, and reviewing test data.”

11. The Application was filed under section 1(b) (intent-to-use) basis. Upon information and belief, ARI did not actually use the Mark in interstate commerce prior to filing the Application.

12. On October 24, 2013, ARI filed a Statement of Use (the “SOU”) claiming the Date of First Use in commerce as July 8, 2013.

13. The Registration was issued to ARI on March 18, 2014.

14. On June 19, 2017, ARI assigned the Registration to Registrant. The assignment was recorded at the U.S. Patent and Trademark Office on June 20, 2017 at Reel: 006086 Frame: 0752.

15. On July 26, 2019, Registrant filed a Section 8 Declaration (the “Sec8-Declaration”).

16. National Instruments (“NI”) is a reputed American multinational company and one of the largest companies in the world in the field of test engineering and automation. NI LabVIEW is software used by engineers, scientists, physicists, and mathematicians in the world for more than 20 years.

17. BatchTest has been a business partner of NI for over 8 years and also advertises its business on NI website.

18. Registrant advertises at least its software drivers on NI website.

19. Autoware2, and Autoware3 are two different versions of a software product of Registrant, Autoware3 is the successor of Autoware2. Autoware2 and Autoware3 were created

using NI LabVIEW. Upon information and belief, Registrant does not use the Mark on any of its products except for Autoware2 and Autoware3.

COUNT I

FRAUD ON THE USPTO

20. BatchTest incorporates paragraphs 1 - 19 by reference.

Registrant's trademarks history and frauds

21. Registrant and its predecessor-in-interest ARI have a long history of frequently and deliberately committing frauds in improper use of the "®" symbol in commerce, with intention to deceive the public:

- a. For several years starting with 2014 or earlier, ARI was fraudulently using "PROVOLT®" mark in commerce to deceive public, when no such mark was registered. More importantly, ARI and Registrant blatantly ignored an examining attorney's advisory dated February 23, 2015 against "IMPROPER USE OF REGISTRATION NOTICE" and continued the said fraudulent use for several more years in deceiving the public until late 2018.
- b. For the past almost 20 years, Registrant and/or ARI have been fraudulently using "ASSOCIATED RESEARCH, INC.®" mark, no such registration has existed since 1990.
- c. ARI was fraudulently using "HYAMP®" mark during 2001-2002, and presumably a long prior to that, considering that it was already manufacturing equipment with "HYAMP®" mark in 2001 or prior when no such mark was applied-for or registered.
- d. Since at least 2014, Registrant and/or ARI have been fraudulently using variation(s) of "autoware®" mark in commerce, even though Registrant and/or ARI did not own registration for it with standard character claim.
- e. For almost past 5 years, Registrant and/or ARI have been fraudulently using "autoware3®" mark, no such mark has been ever been applied-for or registered.
- f. ARI was fraudulently using "Prompt & HOLD®" mark for well over a year between 2015 and 2016; no such trademark has ever been applied-for or registered.

g. ARI was fraudulently using “FAILCHEK®” mark for months before receiving its registration in 2015.

22. ARI and Registrant collectively filed approximately 56 or more trademark applications with the USPTO since at least 1943. As such, ARI and Registrant collectively have a very long history and experience of at least 75 years in filing many trademark applications.

23. Since at least 1986, ARI and Registrant collectively filed approximately 43 trademark applications with the USPTO using representation of its current attorney, Mr. Moore. In other words, Registrant and ARI collectively have a long history of using Mr. Moore’s legal representation in defending and filing for trademarks.

24. And yet ARI, having the additional benefit of guidance from Mr. Moore, failed to do its due diligence in conducting a very basic and simple Common Law Search on the internet before filing the Application. BatchTest has been operating its website at www.BatchTest.com since at least 2011, which was also easily searchable on the internet through Google before Registrant filed the Application. The BatchTest website has shown the Mark as BatchTest’s trademark and tradename since at least 2011.

25. In fact, ARI with representation of Mr. Moore also failed in conducting a thorough search on the USPTO database. Over a year prior to ARI’s filing of the Application, BatchTest had filed a trademark application for mark “LVremote” (Application Serial Number 85237986) using its assumed trade name “BatchTest Corporation”, which includes a specimen that shows the Mark as BatchTest’s trade name, and clearly shows a claim of the Mark as BatchTest’s trademark.

First Ground: Fraudulent procurement and maintenance of a mark that does not constitute trademark use

26. At least as early as 2002, ARI and its counsel Mr. Moore knew the difference between clearly identifying a feature of a product, and a product itself, as goods. In applications for marks “VERI-CHEK” (Reg. Number 2706729) and “CAL-ALERT” (Reg. Number 2706730), ARI was required by examining attorney Ms. Angela Micheli to disclaim “electrical measuring instruments” and required to clearly identify the goods as “electronic self-verification feature” (for “VERI-CHEK”) and “Re-calibration warning signal” (for “CAL-ALERT”) which “sold as a component of electrical safety

compliance testing apparatus.” In fact, ARI was also required to make similar amendment to the goods for mark “SmartGFI” (Reg. Number 2698931) by examining attorney Ms. Daniel Capshaw on June 19, 2002. In other words, at least as early as 2002, ARI and its counsel Mr. Moore also knew that identifier of a function or a technology could not be trademarked, and that a feature of a product as goods had to be accurately identified in a trademark application.

27. ARI and Registrant have used the Mark as mere labels for interactive software control(s)/indicator(s) which identify associated software function (“Functionality-Labels”), rather than use of the Mark to identify source of the software itself. As such, ARI’s and Registrant’s alleged use of the Mark does not constitute trademark use sufficient to support trademark rights.

28. Since ARI or Registrant were creators of relevant goods, they knew that they were not making a valid use of the Mark as a trademark, yet they knowingly made false statements to the USPTO, and deceptively held back the true nature of their usage of the Mark, in order to procure or maintain the registration.

29. Use of the Mark as Functionality-Labels would not have been obvious to the examining attorney or the trademark specialist from the specimens. In fact they would not have realized that ARI’s and/or Registrant’s use of the Mark did not constitute trademark use without actually examining the software on which the Mark was allegedly used.

30. ARI and Registrant knowingly withheld use of the Mark as Functionality-Labels from the USPTO; it was not an isolated case of an inadvertent mistake or misbelief, but a calculated and aggressive strategy with intent to fraud the USPTO in order to procure and maintain the Registration to which they were not entitled. ARI and Registrant have a history of deliberately and frequently deceiving the USPTO in this regard; besides for “VERI-CHEK”, “CAL-ALERT”, and “SmartGFI” marks as referenced in paragraph 26 above, the following is a list of trademark registrations (the “Functionality-Marks”) in which Registrant and/or its predecessor(s)-in-interest have registered and/or maintained identifiers of mere functionality of its product(s) as trademarks since 2008:

- a. 3629571 (for mark “RAMP-HI”),
- b. 3629572 (for mark “CHARGE-LO”),
- c. 4476340 (for mark “ACTIVE LINK”),
- d. 4136250 (for mark “DUALCHEK”),

- e. 4122484 (for mark "SMARTVOLT"),
- f. 4122485 (for mark "SMARTCONFIG"),
- g. 4122486 (for mark "SMARTDETECT"),
- h. 4499170 (for mark "BATCHTEST"),**
- i. 4814417 (for mark "FAILCHEK"),
- j. 5590497 (for mark "PROVOLT"), and
- k. 5828816 (for mark "ACTIVE LINK")

31. Despite being well experienced in filing trademarks and having the additional benefit of guidance from its counsel Mr. Moore, ARI or Registrant have falsely and knowingly identified product functionality as goods in every case of the Functionality-Marks applications.

32. In every case of the Functionality-Marks, ARI and/or Registrant used the mark as merely label(s) of interactive firmware or software control(s) or parameter(s), or menu-item(s) on its product(s). As such, the actual use of each of the Functionality-Marks by ARI and/or Registrant will be perceived as identifying a functionality of the product, and not the overall finished product without regard to any of its particular technology features. In other words, ARI and Registrant have not made a valid use of the Functionality-Marks as trademarks in commerce.

33. As early as 2002, ARI knew that it could not amend identification of the goods to include any goods that were not within the scope of goods once they were set forth in the applications. In order to work around that restriction, ARI started a pattern of trademarking several functionality or features of one good, as if each of the functionality or feature identified a separate good instead of a component of the good. Registrant has now continued the said pattern. In doing so, ARI and Registrant knowingly and frequently made fraudulent and deceiving statements to the USPTO, to unlawfully reserve the Functionality-Marks, specifically the BATCHTEST mark, for a broadened scope of goods to which they were not entitled. One of the marks unlawfully registered by ARI in the said pattern is "BATCHTEST", which was in prior use by BatchTest and it is also BatchTest's business identity, as such BatchTest is being harmed by its registration.

34. Upon information and belief, none of the Functionality-Marks as a whole, or in part, has been used by Registrant or its predecessor-in-interest as a model name of its product(s). Registrant or ARI used the Functionality-Marks as alleged in paragraph 32 above.

35. The USPTO relied upon Respondent's knowingly false and deceptive statements in issuing and maintaining the Registration. Had the USPTO known the true facts, the USPTO would not have issued or allowed the Registration. Therefore, BatchTest respectfully requests that the Registration be cancelled due to fraud upon the USPTO.

Second ground: Fraudulent Allegation of Use and Section 8 filing

36. ARI and Registrant have not used the Mark on all goods as identified in the SOU and the Sec8-Declaration.

37. The SOU contains ARI's sworn statement that "Applicant... is using the mark in commerce", and that "The mark is in use in commerce on or in connection with all of the goods/services", where one of the two goods is identified as "computer software for recording test data, archiving test data, importing test data into a spreadsheet or database, logging test data, statistically analyzing test data, and reviewing test data" ("Goods2"), and that the Mark was used in commerce on "07/08/2013, and is now in use in such commerce."

38. The description of Goods2 describes functionality involving data-processing of "test data", such data is specifically identified for use in test(s), or generated or available after running test(s). More specifically, Goods2 only refers to processing of test data which is available after completion of test(s), in other words Goods2 is described as data-processing software specifically for data generated or available after running test(s), and it only incorporates after-test functionality.

39. Core functionality of data-acquisition software is to acquire data and it does not involve any "test-data" specifically identified for use in test(s). Since the description of Goods2 contains no such functionality, it is not data-acquisition software. As such, any use of the Mark by ARI on data-acquisition software would not constitute a valid use of the Mark on Goods2.

40. ARI did not make a valid use of the Mark on any data acquisition software prior to filing the SOU.

41. Upon information and belief, ARI did not make a valid use of the Mark on any data-processing software matching description of Goods2 prior to filing the SOU. ARI was allegedly selling data-acquisition software, and not Goods2.

42. As such, ARI did not make a valid use of the Mark on Goods2 prior to filing the SOU.

43. Therefore ARI knowingly made a false statement in the SOU as to valid use of the Mark in commerce on Goods2, and ARI did so with the intent to procure a registration to which ARI was not entitled, and ARI was successful in procuring favorable examination, allowance, and publication of the Application.

44. The Sec8-Declaration has Registrant's sworn statement that "the mark is in use in commerce on or in connection with all goods/services", where one of the goods is identified as Goods2.

45. Registrant or ARI did not make a valid use of the Mark on any data-acquisition software prior to filing the Sec8-Declaration.

46. Upon information and belief, Registrant did not make a valid use of the Mark on any data-processing software matching description of Goods2 prior to filing the Sec8-Declaration. ARI was allegedly selling data-acquisition software, and not Goods2.

47. As such, Registrant did not make a valid use of the Mark on Goods2 prior to filing the Sec8-Declaration.

48. Therefore Registrant knowingly made false statements in the Sec8-Declaration as to valid use of the Mark in commerce on Goods2, and Registrant did so with the intent to maintain the Registration to which it was not entitled, and Registrant was successful in procuring favorable examination and maintenance of the Registration.

49. BatchTest repeats and realleges paragraph 35.

COUNT II

REGISTRANT IS NOT THE RIGHTFUL OWNER

50. BatchTest incorporates paragraphs 1 - 49 by reference.

51. As alleged in paragraph 7, BatchTest was the prior user of the Mark. As such, BatchTest was the rightful owner of the Mark in Classes 9 and 42 based on Common Law before ARI filed the Application and the SOU, in other words the underlying application.

52. ARI was not the first individual or entity to use the Mark in commerce. As alleged in paragraph 51 above, BatchTest was the rightful owner of the Mark prior to filing of the Application and the SOU. BatchTest has never transferred ownership of the Mark, or authorized use of the

Mark, to ARI or Registrant. As such ARI was not the rightful owner of the Mark at the time it filed the Application and the SOU, in other words the underlying application. Therefore, the SOU filed by ARI is void *ab initio* and the resulting Registration is invalid.

53. As alleged in paragraph 52 above, ARI was never the rightful owner of the Mark and the Registration is invalid. Therefore, ARI's assignment of the Mark to Registrant is also void *ab initio*, and as such Registrant is not the rightful owner of the Mark.

54. The Registration creates a legal presumption that Registrant has valid and exclusive rights in the Mark for goods and services identified in the Registration.

55. For the reasons set forth above, Registrant is not entitled to the Registration or to the legal presumptions that the Registration creates.

56. The continued presence of the Registration on the federal trademark register constitutes an obstacle to BatchTest's intended use of the Mark in future works and in marketing materials. Furthermore, BatchTest will be damaged by Registrant's continued registration of the Mark because the Registration will likely block BatchTest's registration of the Mark, which is stated in paragraph 7 above. The Registration, thus, is causing injury and damage to BatchTest.

COUNT III

PRIORITY & LIKELIHOOD OF CONFUSION:

MARK RESEMBLES BATCHTEST'S TRADE NAME AND MARK

57. BatchTest incorporates paragraphs 1 - 56 by reference.

58. BatchTest has done business with the Mark as its trade name since approximately March 2011. As such, the Mark in the Registration is identical to BatchTest's pre-existing trade name.

59. The Mark in the Registration is identical in its entirety as to spelling, appearance, sound and commercial impression to BatchTest's pre-existing use of mark BATCHTEST in goods and services BatchTest has offered since 2007 (13 TTABVUE Exhibits "A" and "B".)

60. The consumers for Registrant's products and services are the same as the consumers for BatchTest's products and services. Registrant and BatchTest compete in the same specialized field of software for industrial automated testing while offering very similar goods & services under

International Class 009. In fact, Registrant's software is also made using LabVIEW and it lists its LabVIEW software drivers on National Instruments website; BatchTest has been a National Instruments Alliance Partner for the past 8 years and also offers LabVIEW software based products & services, some of which are listed on the same National Instruments website, the evidence is attached in 13 TTABVUE as Exhibit "E".

61. Because Registrant's registered Mark is identical to the Mark used by BatchTest, and the goods and services identified in the Registration are very similar, or virtually the same as certain goods and services provided by BatchTest under the Mark, there is a likelihood of confusion in the marketplace and ongoing damage to BatchTest, when the Mark is used in connection with their respective goods and services.

62. Registrant's continued use of the Mark will handicap and damage the legitimate present and future activities of BatchTest with regard to its Mark.

63. Therefore, Registrant's use of the Mark is likely to cause confusion with BatchTest's use of the Mark, and because BatchTest has prior use of the Mark, BatchTest respectfully requests that the Registration be canceled.

COUNT IV

FALSE SUGGESTION OF A CONNECTION

64. BatchTest incorporates paragraphs 1 - 63 by reference.

65. As alleged in paragraphs 7-9, the Mark is BatchTest's trademark and trade name, as such its business identity, since prior to filing of the Application. To the best of BatchTest's knowledge, no other individual or entity uses the Mark as its trade name. As such, the Mark in the Registration is identical to BatchTest's identity.

66. Customers of Registrant would recognize the Mark as that of BatchTest's because it uniquely and unmistakably points to BatchTest. A simple Google search on April 22, 2019 for "BATCHEST" showed BatchTest's business listing at the top in addition to numerous website links pointing to BatchTest and its products and services, whereas none of the website links pointed to Registrant or any of its products in as many as first 10 pages of the search with approximately 100 website links. Similar searches on Microsoft's Bing or Yahoo search engines also reveal numerous

website links to BatchTest and its business, products, and services showing at the top. Furthermore, Registrant uses the Mark as mere labels for interactive software control buttons or indicators on approximately three locations on its software in an obscure fashion. A label on an interactive software control or indicator would be viewed by users simply as identifier of its associated functionality, and not as a trademark identifying source of the software. Since only BatchTest uses the Mark as its identity, as trade name and trademark, purchasers of Registrant's product(s) would assume that the Mark and associated functionality are offered by BatchTest who offers very similar software products, especially when a user searched the internet for the Mark.

67. BatchTest is not connected with the activities performed by the Registrant under the Mark. Other than the BATCHTEST mark, Registrant does not own any other trademark application or trademark registration in the United States that includes the Mark in whole or in part BATCHTEST.

68. Use of the Mark by BatchTest is of sufficient fame, such that when Registrant uses the Mark on its product(s), purchasers would presume a connection with BatchTest. In addition to BatchTest's fame in use of the Mark as alleged in paragraph 66 above, BatchTest has also built a reputation on NI domain as a business alliance partner of over 8 years, and as a technology innovator on its LabVIEW platform; in fact, BatchTest had also been invited by NI to an elite "LabVIEW Roadmap" team. Purchasers of BatchTest's and Registrant's relevant products are generally quite familiar with NI. Registrant's software associated with the Mark is made using LabVIEW, and Registrant also offers LabVIEW software code to its purchasers while advertising "Customize Autoware3 to fit your needs." Users customizing Registrant's software using LabVIEW would associate Registrant's use of the Mark with BatchTest because a widely used download software, which is shipped with every copy of LabVIEW, indicates BatchTest as the source of the Mark. Furthermore, since both BatchTest and Registrant use the same channel, NI website, to advertise their software or software drivers, purchasers would presume a connection with BatchTest due to its above mentioned reputation.

69. Therefore, Registrant's use of the Mark creates a false association with BatchTest's goods and services, and because BatchTest has prior use of the Mark, BatchTest respectfully requests that the Registration be canceled.

WHEREFORE, for the reasons set forth above, BatchTest prays that this Petition for Cancellation be sustained and that Registration No. 4499170 be cancelled. BatchTest has applied for registration of the Mark under Application Serial No. 88723304; as such BatchTest also requests that ownership of the Mark be transferred to BatchTest.

Respectfully submitted,

ICware Systems, Inc. dba BatchTest Corporation

Dated: December 11, 2019

/Dinesh Patel/

Dinesh Patel

President, BatchTest Corporation

2118 Walsh Ave, Suite 150

Santa Clara, CA 95050

(408) 454-8378

Batchtest_TM@BatchTest.com

