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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 BATCHTEST CORPORATION 2118 WALSH AVE, SUITE 150 SANTA CLARA, CA 95050 UNITED STATES BatchTest_TM@batchtest.com 408-454-8378
Submission	Request for Reconsideration of Non-Final Board Order
Filer's Name	Dinesh Patel
Filer's email	BatchTest_TM@batchtest.com
Signature	/Dinesh Patel/
Date	04/30/2020
Attachments	20200430 BatchTest Request for Reconsideration.pdf(127135 bytes)

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

In the Matter of Trademark Registration No. 4,499,170
For the Mark: BATCHTEST

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

PETITIONER'S MOTION FOR RECONSIDERATION

Pursuant to Trademark Rule 2.127(b) and TBMP § 518, Petitioner BatchTest Corporation ("BatchTest") respectfully moves the Board for reconsideration of its Order dated March 31, 2020, striking Two Counts of Fraud, Registrant is not the rightful owner, and False suggestion of a connection, from Petitioner's pleadings with prejudice.

INTRODUCTION AND SCOPE OF REVIEW

1. Reconsideration is sought only with respect to the decision striking two counts of fraud from Petitioner's pleadings.

2. BatchTest respectfully submits that the Board's Order has erred in its interpretation that "The two fraud claims appear to be contentions that the mark describes a feature or function of the goods and/or services rather than serving as a mark." (20 TTABVUE page 6, second paragraph.) BatchTest has not claimed that the Mark itself describes anything, and none of BatchTest's fraud claims allege Registrant's use of the Mark in a manner a design mark would be used. As such, BatchTest also respectfully submits that the Board's Order that "Functionality is not a material fact per se which can be withheld from the USPTO absent a material misrepresentation as to a design mark" does not apply to either of BatchTest's fraud claim grounds.

3. Additionally, BatchTest has not claimed in any manner that the Mark itself is "descriptive without secondary meaning". In fact, BatchTest has filed an application for registration of the same "BATCHTEST" mark on similar goods, which points to the fact that BatchTest does not find the Mark as "descriptive without secondary meaning." As such, BatchTest respectfully submits that the Board's Order has also erred in considering BatchTest's fraud claims in any connection with the Mark being "descriptive without secondary meaning".

4. BatchTest's first fraud ground claims that Registrant has not used the Mark in a manner that would constitute its use as a Trademark. BatchTest has claimed that Registrant has not used the Mark to directly associate it with the identified goods and that the Mark does not serve as an indicator of source. In its second fraud ground, BatchTest has claimed that Registrant did not use the mark at all, in any manner whatsoever, on half of the described goods.

5. BatchTest also claimed that Registrant has deliberately made false, material representation with intent to deceive the USPTO in its Statement of Use and Section 8 declaration, the latter of which was filed by Registrant after the current proceeding had begun.

STRICKEN FIRST FRAUD COUNT

6. BatchTest's first fraud ground has claimed that Registrant has not used the Mark in any manner to identify goods, described in the Statement of Use and the Section 8 Declaration as "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." (the "Goods") (16 TTABVUE 10 and 27).

7. In 16 TTABVUE 27, BatchTest has claimed that Registrant only used the Mark as label for button(s) on its "Autoware2" and "Autoware3" software (16 TTABVUE 19), such that consumers will identify the Goods as "Autoware2 or Autoware3, while only identifying some button name(s) as "BATCHTEST". The nature of functionality or feature activated by clicking of such button(s) is irrelevant. *In re Eagle Crest Inc., 96 USPQ2d 1227, 1229 (TTAB 2010)).* "The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public." BatchTest has claimed that the public will not perceive the Mark as identifying Registrant's Goods. As such, the nature of any functionality or feature, whether activated by such button(s) or whether as a part of the Goods itself, is not relevant to BatchTest's claim.

8. This is synonymous to a hypothetical case of an automaker reserving a trademark named "Cruise Control" for model name of a vehicle, but then only using it as a label on a push-button installed inside a vehicle identified as "Mustang". A consumer of such vehicle would perceive "Cruise Control" as a label for the button that activates some functionality in the vehicle, instead of perceiving the mark as model name of the vehicle. The consumer would only identify the vehicle itself as "Mustang."

9. In 16 TTABVUE 29 and 30, BatchTest has claimed that Registrant deliberately withheld true nature of its use of the Mark from examining attorney. An examining attorney, especially one lacking relevant technical expertise, would not have known from specimen provided by Registrant, that it merely shows a clickable button. An examining attorney would not be able to review a 2-dimentional image and realize that the image in fact merely depicted a clickable software button, or that clicking on that button made the Mark disappear altogether, rather than use of the Mark as a Trademark.

10. BatchTest has further claimed that despite not using the mark as a Trademark, Registrant made false, material representation with intent to deceive the USPTO in its Statement of Use and Section 8 declaration. Since BatchTest's first count of fraud claim does not relate to the mark describing a feature or function of the goods and/or services, BatchTest respectfully moves the Board for reconsideration.

STRICKEN SECOND FRAUD COUNT

11. BatchTest's second fraud ground claims that Registrant did not use the mark at all, in any manner whatsoever, on half of the described goods.

12. Registrant has identified two goods in its application for the "BATCHTEST" mark, where the second good 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").

13. BatchTest has claimed that Registrant did not use the mark in any manner whatsoever on Goods2 (16 TTABVUE 40, 41, 45, and 46), and yet Registrant knowingly filed a fraudulent Statement of Use (16 TTABVUE 43), and a fraudulent sworn Section 8 Declaration (16 TTABVUE 47) that "the mark is in use in commerce on or in connection with **all** goods/services" (no emphasis added.) In fact, Registrant filed the fraudulent Section 8 after the current proceedings had already begun.

14. BatchTest has simply provided the description and difference between "Data Acquisition software" and "Data-Processing software" in 16 TTABVUE 38 and 39 respectively, while claiming that Registrant only sells Data Acquisition software. However, the core of BatchTest's claim lies in the fact that Registrant did not use the mark at all on <u>any</u> software that matches the description of Goods2, irrespective of

whether Goods2 is considered as Data Acquisition software or Data Processing software. This is synonymous to hypothetical case of a trademark owner who sells semi-trucks but makes a sworn statement that his mark is used on buses, while in fact he uses the mark on neither of them whatsoever, or on any other similar vehicle.

15. In the current case, Registrant sold Data Acquisition software, but made a sworn statement that his mark was used on Data-Processing software, while in fact he used the mark on neither of them whatsoever, or on any software identified as Goods2. Despite not using the mark on half of the goods, Registrant made false, material representation with intent to deceive the USPTO in its Statement of Use and Section 8 declaration. Since BatchTest's second count of fraud claim does not relate to the mark describing a feature or function of the goods and/or services, BatchTest respectfully submits that it should be reconsidered independently of the first fraud claim by the Board.

CONCLUSION

16. In view thereof, BatchTest respectfully moves the Board for reconsideration, or in the alternate, for a 30-day leave to amend.

17. Additionally, the Board's Order has stricken BatchTest's fraud claims "with prejudice" even before the Discovery begins, as such, it denies BatchTest an opportunity to amend its pleading with any new or renewed fraud claim even if new information is discovered to support such claim during the Discovery. As such BatchTest respectfully moves the Board for reconsideration of its Order.

Respectfully Submitted,
BatchTest Corporation

Dated: April 30, 2020

/Dinesh Patel/

Dinesh Patel, President
BatchTest Corporation
2118 Walsh Ave, Suite 150
Santa Clara, CA 95050

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was served upon the attorney for the other party by email on April 30, 2020 at the following email address:

BACON & THOMAS, PLLC
625 Slaters Lane, Fourth Floor
Alexandria, Virginia 22314-1176
Email: mail@baconthomas.com

By: BatchTest Corporation

Signature: /Dinesh Patel/

Name: Dinesh Patel, President, BatchTest Corporation

Date: April 30, 2020