

ESTTA Tracking number: **ESTTA1060610**

Filing date: **06/08/2020**

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 has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	BatchTest Corporation		
Entity	Corporation	Citizenship	CALIFORNIA
Address	2118 Walsh Ave, Suite 150 Santa Clara, CA 95050 UNITED STATES		

Correspondence information	Dinesh Patel President BatchTest Corporation 2118 Walsh Ave, Suite 150 Santa Clara, CA 95050 UNITED STATES BatchTest_TM@BatchTest.com 408-454-8378		
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Registration Subject to Cancellation

Registration No.	5753143	Registration date	05/14/2019
Registrant	Xperiel, Inc. 188 S. Murphy Ave. Sunnyvale, CA 94086 UNITED STATES Email: Trademarks@sunsteinlaw.com		

Goods/Services Subject to Cancellation


Class 042. First Use: 2019/03/11 First Use In Commerce: 2019/03/11 All goods and services in the class are subject to cancellation, namely: Providing a website featuring temporary use of non-downloadable software that allows users to create custom computer programs; computer software development

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
Other	Lack of bona fide intent to use the mark in U.S. Commerce, pursuant to Trademark Act Section 1(b)

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application	88751781	Application Date	01/08/2020
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No.			
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	PEBBLES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2015/02/11 First Use In Commerce: 2015/02/11 Computer software for developing other computer software and graphical user interface; software and software utility for creating graphical user interface; software for assisting developers in creating program code for use in multiple application software, and user's manuals and instructional manuals sold as a unit therewith; software components, namely, controls and indicators, for creating Human-Machine-Interface, and user's manuals and instructional manuals sold as a unit therewith		

Attachments	88751781#TMSN.png(bytes) 20200608 BatchTest Petition For Cancellation - Pebbles.pdf(454829 bytes)
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Signature	/Dinesh Patel/
Name	Dinesh Patel
Date	06/08/2020

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

In re Registration of Xperiel, Inc.

Mark: PEBBLES
Reg. No.: 5753143

BATCHTEST CORPORATION)	CANCELLATION NO.
)	
Petitioner,)	
)	
V.)	
)	
Xperiel, Inc.)	
)	
Registrant.)	

PETITION FOR CANCELLATION

BatchTest Corporation (“Petitioner”), 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 PEBBLES (the “Mark”) in Registration No. 5753143 (the “Registration”), and hereby petitions to cancel the Registration.

The grounds for cancellation are as follows:

Background

1. Petitioner 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, Xperiel, Inc. (“Registrant”) is a Delaware Corporation with its principal place of business a 188 S. Murphy Ave., Sunnyvale, California 94086, USA.
3. On June 8, 2018, Registrant filed application Serial No. 87953946 (the “ ‘946 Application”) to register the Mark with the USPTO. The ‘946 Application was filed under Section 1(b) of the Trademark Act for the goods & services in Class 42, identified as “Providing a website

featuring temporary use of non-downloadable software that allows users to create custom computer programs; computer software development.”

4. Upon information and belief, Registrant did not actually use the Mark in interstate commerce prior to the filing of the ‘946 Application.

5. On April 2, 2019, Registrant filed a Statement of Use (the “SOU”) claiming the Date of First Use in commerce as March 11, 2019.

6. The Registration was issued to Registrant on May 14, 2019.

7. Prior to Registrant’s filing of the application for the Registration, Petitioner had established Common Law rights in and to the Mark through its use on goods and services in Class 9 and 42 in interstate commerce, and the Mark has been in continuous use by Petitioner until the filing of this petition.

8. Petitioner has filed Application Serial No. 88751781 (the “ ‘781 Application”) for registration of the Mark in International Class 009 and intends to also apply for registration of the Mark in Class 042.

9. Petitioner’s standing in this proceeding is also based on the fact that its pending ‘781 Application has been refused registration based on the prior-registered Registration of Registrant.

10. Petitioner had established prior Common Law in and to the Mark prior to the filing of the ‘946 Application.

11. Petitioner and Registrant are not affiliated with one another, and Registrant’s filing of the ‘946 Application was not authorized by Petitioner.

12. Petitioner has not transferred its ownership of the Mark to Registrant.

COUNT I

PRIORITY & LIKELIHOOD OF CONFUSION

13. Petitioner hereby re-alleges and incorporates by reference each and every allegation contained above as if fully set forth in detail herein.

14. The Mark in the Registration is identical in its entirety as to spelling, appearance, sound and commercial impression to Petitioner’s pre-existing use of the mark PEBBLES in goods and

services Petitioner has offered since prior to filing of the intent-to-used based '946 Application of Registrant.

15. The consumers for Registrant's products and services are about the same as the consumers for Petitioner's products and services. Registrant and Petitioner compete in the field of software tools that allow users to create their own custom software, and in the field of software development, while offering similar goods & services.

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

17. Registrant's continued use of the Mark will handicap and damage the legitimate present and future activities of Petitioner with regard to its Mark. Petitioner's '781 Application for registration of "PEBBLES" mark has also been refused due to Registrant's continued use of the Mark.

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

COUNT II

LACK OF BONA FIDE INTENT TO USE AT THE TIME APPLICATION WAS FILED

19. Petitioner hereby re-alleges and incorporates by reference each and every allegation contained above as if fully set forth in detail herein.

20. The '946 Application is based upon Registrant's bona fide intent to use the Mark in commerce under Section 1(b).

21. On information and belief, Registrant does not own any foreign trademark applications for the Mark in the '946 Application.

22. Applicants for Section 1(b) registrations are required to declare a bona fide intent to use the mark in commerce in the United States through submission of a verified statement as part of the application process.

23. As of the filing date of the '946 Application, Registrant did not have a right to file the intent-to-use application, because Registrant lacked a bona fide intention to use the Mark in commerce in the United States in connection with the goods in the '946 Application. Since Petitioner had established Common Law rights to the Mark prior to Registrant's filing of the '946 Application, at any time on or after the filing of the Application, Registrant did not have the right to file the SOU to prove use of the Mark in commerce.

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

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

26. The continued presence of the Registration on the federal trademark register constitutes an obstacle to Petitioner's intended use of the Mark in future works and in marketing materials. Furthermore, Petitioner will be damaged by Registrant's continued registration of the Mark because Petitioner's pending '781 Application has been refused registration based on Registrant's '946 Application. The Registration, thus, is causing injury and damage to Petitioner.

WHEREFORE, for the reasons set forth above, Petitioner prays that this Petition for Cancellation be sustained and that Registration No. 5753143 be cancelled. Petitioner has applied for registration of the Mark under Application Serial No. 88751781; as such Petitioner also requests that ownership of the Mark be transferred to Petitioner.

Respectfully submitted,

BatchTest Corporation

Dated: June 8, 2020

/Dinesh Patel/

Dinesh Patel

President, BatchTest Corporation

2118 Walsh Ave, Suite 150

Santa Clara, CA 95050

(408) 454-8378

Batchtest_TM@BatchTest.com

CERTIFICATE OF SERVICE

I hereby certify that on June 8, 2020, I served a true and correct copy of the foregoing document to Registrant, by mailing said copy via First Class Mail, postage prepaid to:

Xperiel, Inc.
188 S. Murphy Ave.
Sunnyvale, CA 94086
UNITED STATES

and a true and correct copy of the foregoing document to Registrant's counsel Steven A. Abreu by emailing said copy to "trademarks@sunsteinlaw.com", and by mailing said copy via First Class Mail, postage prepaid to:

STEVEN A. ABREU
Sunstein LLP
100 High Street
BOSTON, MA 02110
UNITED STATES

By: BatchTest Corporation

Signature: /Dinesh Patel/

Name: Dinesh Patel, President, BatchTest Corporation

Date: June 8, 2020