

ESTTA Tracking number: **ESTTA1094213**

Filing date: **11/09/2020**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | | | |
|---------|--|-------------|----------|
| Name | Xerox Corporation | | |
| Entity | Corporation | Citizenship | New York |
| Address | 201 MERRITT 7 NORWALK, CT 06851-1056 UNITED STATES | | |

| | |
|----------------------|--|
| Attorney information | MARGARET W. WALKER 201 MERRITT 7 NORWALK, CT 06851-1056 UNITED STATES Primary Email: usa.ogc.trademark.docket@xerox.com Secondary Email(s): margaret.walker@xerox.com 203-849-2319 |
| Docket Number | |

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No. | 88956163 | Publication date | 10/20/2020 |
| Opposition Filing Date | 11/09/2020 | Opposition Period Ends | 11/19/2020 |
| Applicant | Twisted X, Inc. 1200 SOUTH FM 51, SUITE E DECATUR, TX 76234 UNITED STATES | | |

Goods/Services Affected by Opposition

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|---|
| Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Footwear |
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Grounds for Opposition

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|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
|--------------------------------------|----------------------------|

Mark Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2075858 | Application Date | 09/26/1996 |
| Registration Date | 07/01/1997 | Foreign Priority Date | NONE |
| Word Mark | XEROX | | |
| Design Mark | | | |

| | |
|---------------------|---|
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 1961/00/00 First Use In Commerce: 1961/00/00 clothing, namely, jackets, sweaters, shirts, vests, pants, shorts, hats, scarves, ties, gloves, socks and shoes |

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|-------------|---|
| Attachments | Application No. 88956163 in Class 25 for the Trademark ZEROX in the name of Twisted X, Inc.pdf(422926 bytes) |
|-------------|---|

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|-----------|----------------------|
| Signature | /Margaret W. Walker/ |
| Name | Margaret W. Walker |
| Date | 11/09/2020 |

Application No. 88956163 in Class **25** for the Trademark “**ZEROX**” in the name of Twisted X, Inc.

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

Application No. 88956163 in Class **25** for the Trademark “**ZEROX**” in the name of Twisted X, Inc.

-And -

Opposition thereto by Xerox Corporation of the address 201 Merritt 7, Norwalk, Connecticut 06851-1056, United States of America.

We, Xerox Corporation, a corporation organized under the laws of the State of New York, United States of America of the address, 201 Merritt 7, Norwalk, Connecticut 06851-1056, United States of America [hereinafter “Opponent”] hereby give notice of the Opponent’s intention to oppose Application No. 88956163 in Class 25 for the mark “**ZEROX**” [hereinafter “Impugned Mark”] in the name of Twisted X, Inc. [hereinafter referred to as the “Applicant”] advertised in United States Trademark Official Gazette Publication Published on October 20, 2020 for “*Footwear*” [hereinafter “impugned goods”].

The grounds of Opposition are under:

1. The Opponent (Xerox Corporation), a corporation organized under the laws of the State of New York, United States of America is an \$11 billion technology and services concern and the world’s leading document management enterprise.
2. The Opponent offers the world’s most widely established, accepted and trusted array of innovative document solutions, services and systems, including color and black and white printers, digital printers, publishing systems, multifunction devices, digital copiers, laser and solid ink network printers, copiers, facsimile machines, toner, paper, ink, associated supplies, software and support specially designed for offices and production printing environments.
3. The Opponent is a Fortune 500 Company with operations spread over 160 countries with over 35,300 employees worldwide serving small and mid-size businesses, large enterprises, governments and graphic communications providers.

4. The Opponent has a huge business globally in the fields as aforesaid, which is carried out under its extremely well-known and iconic trade and service mark **“XEROX”**. The association of the Opponent with the trade and service mark **“XEROX”** dates as far back as 1948. The term specifically relates to US Patent No. 2,297,691 obtained by Mr. Chester Carlson for electrophotography (later called Xerography) in 1942 and the procurement of a license to the Carlson patent by the Haloid Company in 1947 to develop and market a copying machine based on the Carlson patent. The Haloid Company then coined and registered a trademark for the word **“XEROX”** for the new copiers in 1948, at a time when no such word was known or in use. Ever since its adoption, the Opponent has extensively and continuously used the trademark **“XEROX”** across the world, including in the United States of America.
5. The Haloid Company changed its name to Haloid Xerox in 1958 and finally to Xerox Corporation in 1961.
6. The trademark **“XEROX”** apart from being the trade and service mark of the Opponent is also an integral and conspicuous part of its trading style, so much so that the Opponent, its business, goods and/or services are themselves readily recognized by mere reference made to them as **“XEROX”**. Consequently, all references to the Opponent hereinafter also include references to **“XEROX”**.
7. The trademark **“XEROX”** has all the trappings of an invented mark as it has been uniquely adopted by conjoining the Greek words for 'dry' and 'writing'. Therefore, by reasons of its invention, it is not only inherently distinctive, but also entitled to the highest level of protection including across all classes of goods or services.
8. The trademark **“XEROX”** is a highly distinctive mark not only on account of its inherent distinctiveness and invented nature but also equally on account of its acquired reputation due to extensive use. Hence, the Opponent is the legitimate proprietor of the trademark and tradename **“XEROX”** and has an indelible history that has resulted from honest adoption, uninterrupted use, large-scale promotion, established goodwill and well-known character of its trademark and tradename.
9. It is submitted that the Opponent’s trademark **“XEROX”** and tradename enjoys global presence as the Opponent has administrative, manufacturing, engineering, assembly and customer operations spread across the world. The Opponent’s operations under their well-known trademark **“XEROX”**

are widespread geographically spanning several countries *inter alia* United States of America, Canada, Egypt, Ireland, India, Netherlands, Spain, United Kingdom, France, Angola, Argentina, Austria, Belarus, Belgium, Brazil, Bulgaria, Chile, Colombia, Costa Rica, Croatia, Curacao, Czech Republic, Denmark, Dominican Republic, Ecuador, Egypt, El Salvador, Finland, Germany, Greece, Guatemala, Hungary, Ireland, Israel, Italy, Jamaica, Kazakhstan, Latvia, Mexico, Morocco, Netherlands, Nicaragua, Norway, Panama, Paraguay, Peru, Philippines, Poland, Portugal, Romania, Russia, Slovak Republic, Slovenia, South African, Spain, Sweden, Switzerland, Turkey, Uganda, Ukraine, United Arab Emirates, Uruguay, Uzbekistan, Venezuela, Yugoslavia, Hong Kong, China, Indonesia, Philippines, South Korea, Taiwan, Australia, Japan, Malaysia, New Zealand, Singapore, South Korea, Taiwan, Thailand, Vietnam.

10. The goods of the Opponent under the trademark “**XEROX**” are extensively manufactured, marketed and sold around the globe and various countries of the world including United States with sales running into several millions of dollars annually. The Opponent has also been spending huge amounts of money and has put in unparalleled efforts to advertise and promote its products and services under the trademark and tradename “**XEROX**”. The Opponent also maintains the website <http://www.xerox.com> that, details the background of the Opponent apart from explaining and listing the products and services sold or rendered by the Opponent under their trademark and tradename “**XEROX**”. The said website is a further extension of the Opponent’s intellectual property rights in the trademark “**XEROX**”. This website is freely accessible to one and all and has served in making consumers worldwide aware of the high-quality products and services under the trademark “**XEROX**” of the Opponent.

OPPONENT’S INTELLECTUAL PROPERTY RIGHTS

11. The Opponent being the legitimate proprietor and long-standing user of the trademark and tradename “**XEROX**”, has acquired statutory and common law rights in the said mark across the world including in the United States. It is thus entitled to the exclusive and proprietary use thereof and any use by a third party of the said trademark would amount to violation of the Opponent’s established rights in the trademark “**XEROX**”. The Opponent is also the registered proprietor of the trademark “**XEROX**” in respect of goods/services in various classes in the United States. An indicative list of some such registrations is as follows:

| Trademark | Registration | International | Registration Number |
|-----------|--------------|-----------------|---------------------|
| “XEROX” | 30 May 1950 | 16 | 525717 |
| “XEROX” | 16 Jun 1953 | 1 | 576118 |
| “XEROX” | 22 Sep 1953 | 3 | 580296 |
| “XEROX” | 06 Jul 1971 | 41 | 916047 |
| “XEROX” | 17 Apr 1973 | 9 | 957267 |
| “XEROX” | 07 Jan 1975 | 9 | 1000990 |
| “XEROX” | 01 Apr 1975 | 37,42 | 1008036 |
| “XEROX” | 13 May 1975 | 35 | 1010557 |
| “XEROX” | 22 Oct 1991 | 16 | 1661698 |
| “XEROX” | 29 Oct 1991 | 9 | 1662340 |
| “XEROX” | 01 Jul 1997 | 25 | 2075858 |
| “XEROX” | 19 Oct 2010 | 2,9,16,35,37,42 | 3864431 |
| “XEROX” | 09 Aug 2016 | 36,41 | 5016441 |

The aforementioned registrations confer upon the Opponent the exclusive right to use the trademark “XEROX” to the exclusion of others and to restrain the use and/or registration of any identical and/or deceptively similar mark.

CASE AGAINST THE APPLICANT:

12. The impugned mark “ZEROX” filed on June 9, 2020 under United States Trademark Application No. 88956163 in class 25, filed in the name of Twisted X, Inc. This “ZEROX” trademark application was filed on in connection with International Class 025: *Footwear*. The “ZEROX” mark is phonetically and conceptually similar to the Opponent’s prior registered and well-known mark “XEROX” in connection with International Class 25: *clothing, namely, jackets, sweaters, shirts, vests, pants, shorts, hats, scarves, ties, gloves, socks and shoes*. The adoption and unauthorized use of a deceptively similar mark would undoubtedly result in the reduced ability of the public to identify the Opponent’s trademark “XEROX” with its goods and services. Any use of the mark “ZEROX” violates the Opponent’s statutory and common law rights in the Opponent’s mark “XEROX” and will result in dilution of the Opponent’s well-known stature.

13. It is submitted that any use or registration of the impugned mark would result in dilution of the well-known repute and stature of the Opponent’s trademark “XEROX”. Opponent’s trademark enjoys established reputation and goodwill in the United States and the use, if any of the impugned mark by the Applicant without due cause and the attempted registration of the

impugned mark would take unfair advantage of and would be detrimental to the distinctive character of the Opponent's trademark. The exclusivity of the Opponent's trademark would be diluted if third parties such as the Applicant are allowed to register similar marks. It would also result in flooding of markets with several third-party goods under similar/identical marks. In view thereof, the impugned mark ought to be refused registration. Thus, the learned Registrar is humbly requested to refuse registration of the impugned trademark in exercise of its discretion.

14. In light of the above stated facts and circumstances, it is prayed that:
- i) The impugned mark in class 25 under Application number 88956163 be refused registration.
 - ii) The instant opposition be allowed.

Respectfully,

/Margaret W. Walker/
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Associate General IP Counsel
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