

ESTTA Tracking number: **ESTTA863726**

Filing date: **12/11/2017**

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

Proceeding.	91233313
Applicant	Plaintiff Bned Loudcloud, LLC
Other Party	Defendant LoudCloud
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	Yes

Motion for Suspension in View of Civil Proceeding With Consent

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Bned Loudcloud, LLC hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Bned Loudcloud, LLC has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Bned Loudcloud, LLC has provided an email address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address of record by Email on this date.

Respectfully submitted,

/Jacqueline Lesser/

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12/11/2017

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON NEXT PAGE OF THIS FORM.)

I. (a) PLAINTIFFS

BNED LOUDCLOUD, LLC

(b) County of Residence of First Listed Plaintiff Somerset County, NJ (EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorneys (Firm Name, Address, and Telephone Number) Gerald J. Ferguson, Lesley Grossberg and Nancy Frandsen Baker & Hostetler LLP- 45 Rockefeller Plaza, 11th Floor, New York, NY 10111- (212) 589-4238

DEFENDANTS

LOUDCLOUD CORPORATION

County of Residence of First Listed Defendant Los Angeles County, CA (IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE TRACT OF LAND INVOLVED.

Attorneys (If Known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- 1 U.S. Government Plaintiff, 2 U.S. Government Defendant, 3 Federal Question (U.S. Government Not a Party), 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

Table with columns for Plaintiff (PTF) and Defendant (DEF) citizenship and business location. Includes categories like Citizen of This State, Citizen of Another State, and Foreign Nation.

IV. NATURE OF SUIT (Place an "X" in One Box Only)

Large table with categories: CONTRACT, REAL PROPERTY, CIVIL RIGHTS, PRISONER PETITIONS, TORTS, FORFEITURE/PENALTY, LABOR, IMMIGRATION, BANKRUPTCY, SOCIAL SECURITY, FEDERAL TAX SUITS, OTHER STATUTES.

V. ORIGIN (Place an "X" in One Box Only)

- 1 Original Proceeding, 2 Removed from State Court, 3 Remanded from Appellate Court, 4 Reinstated or Reopened, 5 Transferred from Another District (specify), 6 Multidistrict Litigation - Transfer, 8 Multidistrict Litigation - Direct File

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity): Lanham Act, 15 U.S.C. § 1051 et seq. Brief description of cause: trademark infringement, trademark dilution, unfair competition

VII. REQUESTED IN COMPLAINT:

CHECK IF THIS IS A CLASS ACTION UNDER RULE 23, F.R.Cv.P. DEMAND \$ CHECK YES only if demanded in complaint: JURY DEMAND: X Yes No

VIII. RELATED CASE(S) IF ANY

(See instructions): JUDGE DOCKET NUMBER

DATE SIGNATURE OF ATTORNEY OF RECORD



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**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF NEW JERSEY
TRENTON VICINAGE**

BNED LOUDCLOUD, LLC,

Plaintiff,

v.

LOUDCLOUD CORPORATION,

Defendant.

Civil Action No.: _____

JURY TRIAL DEMANDED

**COMPLAINT FOR TRADEMARK INFRINGEMENT, UNFAIR COMPETITION, AND
DILUTION BY TARNISHMENT**

Plaintiff, BNED LoudCloud, LLC, by its undersigned counsel, brings this action for trademark infringement, unfair competition, and dilution by tarnishment against Defendant, LoudCloud Corporation, by filing this complaint and alleges as follows:

PARTIES

1. Plaintiff BNED LoudCloud, LLC (“Plaintiff”) is a Delaware limited liability company, with its principal place of business at 120 Mountain View Blvd., Basking Ridge, NJ 07920.

2. Defendant LoudCloud Corporation (“Defendant”) is a California corporation with its principal place of business at 5011 S. Normandie Ave, Los Angeles, CA 90037.

JURISDICTION AND VENUE

3. This Court has subject matter jurisdiction over this action under 15 U.S.C. § 1121 and pursuant to 28 U.S.C. §§ 1331 and 1338(a) because it involves claims arising under the Lanham Act, 15 U.S.C. § 1051 *et seq.* This Court has supplemental jurisdiction over Plaintiff's state statutory and common law claims under 28 U.S.C. § 1367.

4. Upon information and belief, Defendant has conducted and continues to conduct business within the State of New Jersey and is subject to the personal jurisdiction of this Court under New Jersey's long-arm statute. Defendant offers information about its mobile app and links to download that mobile app on its website www.getloudcloud.com, and offers downloadable software applications through third party platforms such as Google Play and Apple's App Store that can be downloaded in New Jersey. Furthermore, Defendant's mobile app is aimed at New Jersey residents, in that it offers specific information about medical marijuana dispensaries located in New Jersey that may only be patronized by residents of New Jersey. Upon information and belief, Defendant's mobile app has been downloaded and used in New Jersey by residents of New Jersey.

5. Venue in this judicial district is appropriate pursuant to 28 U.S.C. § 1391(b)(2) because Defendant has committed acts of trademark infringement, unfair competition, and dilution by tarnishment in this District.

BACKGROUND

6. Founded in 2010, Plaintiff LoudCloud provides learning management system services and competency-based learning platform services to educational institutions and students that are highly adaptive, customizable, and offer cloud-based solutions to promote online classroom interactions at both the K-12 and higher education levels. Plaintiff is a well-

known provider of educational services through innovative software solutions that provide a full range of educational services to college campuses, and other educational venues, including provision of educational content and behavioral analytic data to faculty and students.

7. Since at least as early as 2010, years prior to Defendant filing an intent-to-use trademark application in 2016, Plaintiff and its predecessor in interest has offered its products and services under the trademark LOUDCLOUD to students, faculty, education administrators and educational institutions.

8. Plaintiff owns all right, title and interest in and to U.S. Trademark Registration No. 4095476 for the trademark LOUDCLOUD for analyzing educational tests scores and data for others; analyzing of educational test scores and data for others; business education and training services, namely, developing, and facilitating customized in-company leadership and executive development programs, providing executive coaching services, and providing public and in-company keynote presentations to business leaders; computer education training; computer education training services; conducting after school tutoring programs; educating at university or colleges; education services in the nature of courses at the university level; educational course monitoring, namely, tracking student performance; educational examination services; educational services, namely, conducting distance learning instruction at the secondary, college and graduate levels; educational services, namely, conducting distance learning instruction at the university level; educational services, namely, developing and conducting training courses and distribution of training materials in connection therewith for subject matters as requested by customers; educational services, namely, the offering of web based and classroom training for certification of teachers and continuing education for teachers and principals; information on education; providing courses of instruction at the undergraduate and

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