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

Proceeding	92049339
Party	Defendant Bookman, Charles, Anthony
Correspondence Address	Charles Anthony Thunderhawk 1085 Commonwealth Ave #273 Boston, MA 02215 UNITED STATES thunderhaw@thunderhawk.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Charles Bookman
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Signature	/Charles Bookman/
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Attachments	Motion to Dismiss 06-17-2008.pdf (3 pages)(214745 bytes) Court Memorandum and Order 03-31-2005.pdf (33 pages)(77269 bytes)

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

BITSTREAM, INC.,
Petitioner,

v.

CHARLES ANTHONY BOOKMAN,
Registrant.

Cancellation No.: 92049339

Registration No.: 2715836

MOTION TO DISMISS UNDER 37 C.F.R. §2.116 AND F.R.C.P. 12(b)(6)

Registrant, Charles Anthony Bookman (hereafter “Bookman”), pursuant to 37 C.F.R. §2.116 and Rule 12(b)(6) of the Federal Rules of Civil Procedure hereby moves the TTAB to dismiss the above-captioned Petition for Cancellation.

As grounds for its Petition for Cancellation, Bitstream alleges as follows:

1. “On May 12, 2008, Petitioner filed a trademark application on the Principal Register for THUNDERHAWK in International Class 009: Computer software, namely, software with data compression and caching functionality to enable enhanced Internet browsing via mobile telephones, personal digital assistants and wireless devices; and International Class 042: Providing a mobile Internet browser with data compression and caching functionality to enable enhanced Internet browsing via mobile telephones, personal digital assistants and wireless devices. This application was assigned Serial No. 77/472,223....” Petition for Cancellation at ¶14;

2. “On June 5, 2002, Registrant filed application Serial No. 78/133,290 for registration on the Principal Register for the mark THUNDERHAWK that ultimately issued in IC 035 for computer services, namely, address change notification services in the nature of posting notifications of changes of address for businesses via the Internet, and in IC 042 for Computer code conversion for others; computer consultation; computer graphics services; computer network design for others; computer programming for others; computer project management services; computer services, namely, creating and maintaining websites for others, computer services, namely, data recovery services, computer services, namely, designing and implementing web pages and web sites for others, computer services, namely, providing search

engines for obtaining data on a global computer network, computer services, namely, creating indexes of information, sites and other resources available on computer networks, computer services, namely, managing web sites for others, computer services, namely, redirecting electronic mail to changed personal electronic addresses, computer site design, computer software consultation, computer software design for others; computer software development, computer systems analysis. This application matured into Reg. No. 2,715,836 on May 13, 2003..." Petition for Cancellation at ¶15; and

3. "Petitioner is likely to be damaged by continued registration of said mark because the PTO Examining Attorney will likely refuse Petitioner's application bearing Serial No. 77/472,223 (identified above) on the grounds that, under 37 CFR §2d of the Lanham Act, there is a likelihood of confusion between the Petitioner's mark THUNDERHAWK and Registrant's mark THUNDERHAWK." Petition for Cancellation at ¶13

On October 23, 2002, Bookman filed a civil action against Bitstream for trademark infringement in the U.S. District Court for the District of Massachusetts, Civil Action No. 02-12078-NG. On March 31, 2005, the Court issued a Memorandum and Order finding that Bitstream's use of the mark THUNDERHAWK in connection with "a wireless web browser software product" did not create a likelihood of confusion with Bookman's use of the mark THUNDERHAWK in connection with "a variety of custom-tailored information technology consulting services, including analysis, programming, web design, web development, web hosting, technical training, Internet marketing, network design/implementation and database development." The Court's finding of no likelihood of confusion was based, in part, on its finding that a wireless web browser software product sold by Bitstream is substantially different than information technology consulting services provided by Bookman. A copy of the Court's Memorandum and Order is attached hereto.

In view of the prior litigation between Bookman and Bitstream and the Court's finding of no likelihood of confusion, Bitstream should be precluded from asserting that it would be damaged by U.S. Reg. No. 2,715,836 based upon a likelihood of confusion. As such, Bitstream has not set forth any grounds for cancellation of U.S. Reg. No. 2,715,836. Further, the Trademark Examining Attorney has not examined Bitstream's application and may not refuse

registration on the Principal Register. Bookman asserts that Bitstream's Petition for Cancellation is premature and it should wait until such time as the Examining Attorney refuses to register Bitstream's mark in view of U.S. Reg. No. 2,715,836.

For all of the above reasons, Bookman asserts that Bitstream's Petition for Cancellation fails to state a claim upon which relief can be granted and should be dismissed.

Respectfully submitted,

Dated: June 17, 2008

/s/ Charles Anthony Bookman
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of this document has been served upon all parties of record by first class mail, postage pre-paid, to Thomas M. Saunders, Esq., Seyfarth Shaw LLP, Two Seaport Lane, Suite 300, Boston, MA 02210-2028 on June 17, 2008.

/s/ Charles Anthony Bookman
Charles Anthony Bookman

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

CHARLES BOOKMAN, d/b/a/ THUNDER HAWK)
INTERNET SYSTEMS,)
Plaintiff,)
) Civil No. 02-12078-NG
v.)
)
BITSTREAM, INC.,)
Defendant.)

GERTNER, D.J.:

MEMORANDUM AND ORDER RE: MOTIONS FOR SUMMARY JUDGMENT ON
PLAINTIFF'S TRADEMARK INFRINGEMENT AND DAMAGES CLAIMS

March 31, 2005

I. INTRODUCTION

Plaintiff Charles Bookman ("Bookman"), the owner of a small Internet consulting business, contends that he is the senior user of the service mark "THUNDERHAWK."¹ Pursuant to the federal Lanham Act and Massachusetts trademark law, he seeks injunctive relief and damages against defendant Bitstream, Inc.

("Bitstream"), a much larger software development company, alleging its infringing use of the trademark "ThunderHawk" in connection with its wireless web browser software product. Bookman believes that Bitstream's use of the mark has resulted in consumer confusion, causing irreparable harm to his reputation and goodwill, and to his ability to control his mark and reasonably expand his services.

¹ Since service marks (which "distinguish one's services from those offered by others") and trademarks (which "distinguish one's goods from those made by others") are, for the most part, functional equivalents, "the distinction between the two types of marks is irrelevant . . . [and] cases discussing either apply." Boston Athletic Ass'n v. Sullivan, 867 F.2d 22, 23 n.1 (1st Cir. 1989).

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