

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: <a href="mailto:usa.ogc.trademark.docket@xerox.com">usa.ogc.trademark.docket@xerox.com</a> Secondary Email(s): <a href="mailto:margaret.walker@xerox.com">margaret.walker@xerox.com</a> 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**

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**

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

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:

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