

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

The Linux Foundation,

Petitioner

v.

Synadia Communications Inc.,

Registrant

Cancellation No.: _____

Mark: NATS.IO

Registration No.: 6216925

International Class: 009

PETITION FOR CANCELLATION

Petitioner, The Linux Foundation, a 501(c)(6) non-profit organization organized under the laws of Oregon, with an address of 548 Market Street, PMB 57274, San Francisco, CA 94104-5401 (hereinafter "Petitioner") believes that it is and will continue to be damaged by Registration No. 6216925, registered in the name of Synadia Communications Inc., a corporation organized under the laws of Delaware, with an address of 10250 Constellation Boulevard, Los Angeles, CA 90067 (hereinafter "Registrant" or "Synadia"), and hereby petitions to cancel said Registration under the provisions of Section 14 of the Trademark Act of 1946, 15 U.S.C. § 1064 on grounds that: (a) the mark has been abandoned by Registrant; (b) Petitioner is the rightful owner of the mark, and therefore Registrant is not the rightful owner of the mark for the identified goods and services in the Registration; (c) the Registration is being used by

Registrant so as to misrepresent the source of the goods and services on or in connection with which the mark is used; and (d) the Registration was obtained through fraud on the United States Patent and Trademark Office.

FACTS

PETITIONER

1. Petitioner is a non-profit member-services organization focused on enabling and supporting open collaboration on software, hardware, standards, and data.

Petitioner's Cloud Native Computing Foundation ("CNCF") sub-foundation provides support, oversight and direction for fast-growing, cloud native open source software projects. The CNCF currently hosts over 200 such projects.

THE RELATIONSHIP BETWEEN PETITIONER AND REGISTRANT

2. In 2015, Apcera, Inc. ("Apcera") a corporation organized under the laws of Delaware, with an address of 140 New Montgomery St., Suite 1500, San Francisco, CA 94105, approached the CNCF about becoming a member of the CNCF. On December 3, 2015, Apcera joined CNCF as a "Silver" member. See true and correct copy of Cloud Native Computing Foundation Directed Fund Participation Agreement with Apcera ("CNCF Participation Agreement with Apcera"), attached hereto as Exhibit A. Apcera was the original applicant for the Registration that is the subject matter of this Petition for Cancellation. Registrant Synadia, the successor in interest to the Nats project and the NATS.IO Registration, also executed a CNCF Participation Agreement on August 8, 2018. See true and correct copy of Cloud Native Computing Foundation Participation Agreement with Synadia ("CNCF Participation

Agreement with Synadia”), attached hereto as Exhibit B. Synadia also signed the Linux Foundation Membership Agreement. See Exhibit B.

3. The CNCF Participation Agreement with Synadia states that “Members will enjoy the rights and undertake the obligations described in the CNCF Charter.” See CNCF Charter,

<https://github.com/cncf/foundation/blob/85515ccf26403c9c261de0efee7b0802931ffbd/charter.md>. Paragraph 2(a)(ii) of the Charter provided that for all CNCF-hosted

software development projects, the CNCF would “[e]nsure that the [software] technologies’ brand (trademark and logo) is being cared for and used appropriately by members of the community, with a specific emphasis on uniform user experience and high levels of application compatibility.” Paragraph 11 of the CNCF Charter also provided that “[a]ny project that is added to the CNCF must have ownership of its trademark and logo assets transferred to [CNCF’s parent] the Linux Foundation.”

Section 3 of the LF Membership Agreement states “Member [Synadia] agrees to comply with the charters of any specific project that it chooses to contribute to.” See Exhibit B. By signing the CNCF Participation Agreement with Synadia and the LF Membership Agreement, Synadia agreed to these rules and obligations with regard to the marks and logos for any project added to the CNCF.

4. On Jan 18, 2018, Synadia requested, and CNCF accepted, adding an open source development project called “Nats” into CNCF. See Nats project proposal and vote: <https://github.com/cncf/toc/pull/81> and CNCF blog post announcing acceptance of the Nats project as a CNCF project: <https://www.cncf.io/blog/2018/03/15/cncf-to-host-nats/>. As part of adding Nats to the CNCF as a CNCF project, the domain

“nats.io” was transferred to the CNCF’s parent, the Linux Foundation, on March 22, 2018, pursuant to the obligations of the CNCF Participation Agreement with Synadia and the LF Membership Agreement that Synadia had signed. See true and correct copy of Namecheap.com Order Summary (Order# 33726600) attached hereto as Exhibit C. As the result of that domain name transfer, the Linux Foundation, through its sub-foundation the CNCF, became the host of the Nats project, and pursuant to the CNCF Participation Agreement, became the steward of the Nats project and all intellectual property – including trademarks – for that project. This stewardship included CNCF providing “a neutral home for collaboration ... [whereby] [a]ll aspects of the project are governed by the CNCF.” See CNCF Charter, <https://github.com/cncf/foundation/blob/85515ccf26403c9c261de0efee7b0802931ffbd/charter.md> ¶ 9(b)(i)a. Thus, by transferring the Nats project to the CNCF, the CNCF became the source of the goods and services of the Nats project, and Synadia was obligated to transfer to CNCF all trademark and logo assets for that project.

5. In light of the fact that Registrant was under an obligation to transfer the marks associated with the Nats project under the terms of the CNCF Participation Agreements with both with Apcera and Synadia, Registrant sought reimbursement from Petitioner for costs associated with applying for registration of the mark (as well as an associated stylized mark for NATS, Reg. No. 6216924, Registered December 8, 2020), from the date when the Nats project was transferred over to Petitioner until the issuance of the Notice of Allowance. To that end, the Petitioner paid Registrant the amount of \$10,000.00 for “Legal - Trademark” representing the costs of the two

marks that Petitioner was obligated to transfer to Petitioner. See true and correct copy of Record of Payment to Synadia attached hereto as Exhibit M.

6. The “open source” software development model refers to a community-based approach to creating software, through open collaboration, inclusiveness, transparency and frequent public updates. See <https://www.ibm.com/think/topics/open-source>. In that development model, it is the host of the project that becomes associated as the source of the goods and services associated with that project, even if other persons or entities beyond the host also contribute to the development of the project.

THE REGISTRATION

7. On October 11, 2016, Apcera filed an Intent To Use (ITU) U.S. trademark application for NATS, in standard characters, which application was assigned Application Serial No. 87199408 (the “NATS Application”). See true and correct copy of TSDR Record attached hereto as Exhibit D.
8. On January 23, 2017, the USPTO issued a Priority Action, preliminarily refusing registration of the NATS Application on the grounds that the identification of goods and services was unacceptable because it was indefinite. See true and correct copy of the Priority Action attached hereto as Exhibit E.
9. On May 15, 2017, the Registrant responded to the Priority Action, narrowing the identification of the goods and services, and on June 7, 2017 the U.S.P.T.O. published the NATS Application for opposition. See true and correct copy of the Notice of Publication attached hereto as Exhibit F.

10. On December 12, 2017, an opposition was filed against the NATS Application by the Washington Nationals Baseball Club, LLC (“Washington Nats”) in the Trademark Trial and Appeal Board (“TTAB”), No. 91238567. See true and correct copy of the Opposition attached hereto as Exhibit G. The TTAB instituted an Opposition Proceeding against the NATS Application on the same date. See true and correct copy of Notice of Institution attached hereto as Exhibit H.
11. On February 10, 2020, the TTAB dismissed, without prejudice, the Washington Nats’ Opposition to the NATS Application. The dismissal was the result of Registrant amending the mark to “NATS.IO” in standard characters together with a disclaimer of “.IO.” See true and correct copy of the Board Decision: Opposition Dismissed without Prejudice attached hereto as Exhibit I.
12. On March 24, 2020, a Notice of Allowance was issued for the amended mark, with a 6-month response period set for Registrant to provide a Statement of Use (SOU). See true and correct copy of the Notice of Allowance attached hereto as Exhibit J. On September 24, 2020 – the last day of the 6-month period for providing an SOU, Registrant filed an SOU, averring a date of first use anywhere of the NATS.IO mark of June 9, 2019, as well as a date of first use in commerce of the same date, June 9, 2019. See true and correct copy of the Statement of Use attached hereto as Exhibit K. The SOU was accompanied by a Specimen purporting to show use in commerce by the Registrant: a copy of a web page – entitled “NATS.io Server” at the URL <https://nats.io/download/nats-io/nats-server/>. See true and correct copy of the Specimen of Use attached hereto as Exhibit L. Registrant – who was listed as the mark’s owner by assignment in the Statement of Use – was indicated in the

Specimen of Use as a “Supporter” of the software at that URL. But the Specimen of Use, in the lower right-hand corner of that specimen, indicated that the mark and the website upon which the mark was used, was associated with the CNCF, a sub-foundation of Petitioner.

13. The Second-Level Domain (SLD) and Top-Level Domain (TLD) combination of “nats.io” associated with the Specimen of Use filed by Registrant has been owned by Petitioner since March 27, 2018. See Exhibit C. Therefore, both the ownership records for the website from which the Specimen of Use was pulled, as well as the branding information on that very website, indicate that that website is associated with goods and services offered by Petitioner’s sub-foundation, the CNCF, and not the Registrant.
14. On information and belief, at the time of its filing of the Statement of Use, Registrant knew that the domain name nats.io was owned by the Linux Foundation and the marks of the CNCF were associated with the goods and services offered at that domain name, such that members of the general public encountering the Nats project and the nats.io website in connection with software understood the mark to identify the CNCF, not Registrant.
15. On information and belief, Registrant misrepresented the nature of its use in commerce of the mark and misrepresented its rights to the Mark at the time it submitted its Statement of Use and Specimen, and continued to prosecute the trademark application leading to the Registration that is the subject of this Petition.
16. On information and belief, the aforementioned false statements were made with the intent to induce authorized agents of the USPTO to grant said Registration, and

reasonably relying on the truth of said false statements, the USPTO, did, in fact, grant said Registration to Registrant.

THE BASES FOR CANCELLATION

17. Petitioner requests cancellation of the Registrant's mark on the following bases:

- a. Abandonment. By transferring the nats.io domain to CNCF in March of 2018, and by ceding control of that domain and the Nats software development project to the CNCF at that time, Registrant abandoned the use of the mark as an indicia that Registrant was the source of goods and services that were associated with the Nats project, and CNCF has continuously over the past seven years been the source of goods and services with customers and users of the Nats software project associate with the NATS.IO mark.
- b. Registrant is not the Rightful Owner of the Mark for the Identified Goods and Services in the Registration. Both the Registrant, and the initial applicant for the mark who was Registrant's predecessor in interest in the mark, signed a legal obligation to transfer the mark to Petitioner, and Petitioner paid the costs for registration of the mark as of the date that the Nats project was transferred over to Petitioner. In order to determine who is the rightful owner of a mark and therefore who under 15 U.S.C. § 1051(a)(1) is entitled to register a mark, the TTAB must examine: (a) the parties' statements and actions at the time a purported ownership transfer of the mark occurred and (b) the legal framework courts and commentators have developed to deal with the special circumstances that arise in ownership disputes regarding a mark. See

Wonderbread 5 v. Gilles, Cancellation No. 92052150 (June 30, 2015) at pp. 12-26. As such, Petitioner is the rightful owner of the mark, and Registrant, under 15 U.S.C. § 1051(a)(1), did not have a right to register the mark .

- c. The Registration is Being Used by Registrant so as to Misrepresent the Source of the Goods and Services on or in Connection with which the Mark is Used. Registrant misrepresented the source of goods and services associated with the mark when Registrant filed a Specimen of Use which was from a website owned and controlled by Petitioner and which included Petitioner's name and mark establishing that Petitioner was the source of goods and services associated with the Statement of Use. Therefore, on information and belief, the Registration misrepresented the source of the goods and services in the Registration – by indicating that Registrant was the source of those goods/services rather than Petitioner – and Registrant is not entitled to continued registration of the NATS.IO mark pursuant to Sec. 14(3) of the Trademark Act, 15 U.S.C.A. § 1064(3) and therefore the mark should be cancelled.
- d. Fraud on the USPTO. Petitioner misrepresented to the USPTO the source of the goods and services associated with the mark when Petitioner filed a Statement of Use and a Specimen for that use which was not associated with any good or services of theirs, but instead goods or services associated with Petitioner. Therefore, on information and belief, the Registration was obtained fraudulently – as the result of submission of a Specimen of Use which did not represent use of the registered mark by Registrant – and Registrant is not

entitled to continued registration of the NATS.IO mark pursuant to Sec. 14(3) of the Trademark Act, 15 U.S.C.A. § 1064(3) and therefore the mark should be cancelled.

18. Therefore, on information and belief, while Registrant may currently use the NATS.IO mark, it does so non-exclusively pursuant to Petitioner's published trademark usage guidelines, see <https://www.linuxfoundation.org/legal/trademark-usage>, Registrant is not entitled to continued registration of the NATS.IO mark pursuant to Sec. 14(3) of the Trademark Act, 15 U.S.C.A. § 1064(3) based on such use, and the Registration should be cancelled.
19. Petitioner reserves the right to amend this Petition to allege other claims in the event that discovery of information indicates they are appropriate.
20. The Petitioner has been and will continue to be damaged by continuance of the Registration, in that the Petitioner is now currently – and has for over seven years – been using the identical mark for the identical goods and services in the Registration, Registrant agreed to assign the mark, and the NATS open source community views the CNCF as the true owner of the mark, and continued registration of the mark in the name of Registrant will harm that community by causing confusion as to the source of the goods and services offered to the NATS open source community by Petitioner .

WHEREFORE, the Petitioner asserts that it will be damaged by the continued registration of the NATS.IO Registration and requests that this Petition be sustained and that Trademark Reg. No. 6216925 be cancelled.

Dated: April 23, 2025

Respectfully Submitted:

The Linux Foundation

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