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

Proceeding	91173573
Party	Defendant GROOVE MOBILE, INC. GROOVE MOBILE, INC. 3 RIVERSIDE DRIVE ANDOVER, MA 01810
Correspondence Address	RACHELLE A. KAGAN, ESQ. BINGHAM MCCUTCHEN LLP 150 FEDERAL ST BOSTON, MA 02110-1726
Submission	Answer
Filer's Name	Rachelle A. Dubow
Filer's e-mail	rachelle.dubow@bingham.com
Signature	/rachelle dubow/
Date	12/04/2006
Attachments	573 (3).pdf ( 11 pages )(358403 bytes )



2. Applicant admits that Opposer through its wholly-owned subsidiary and predecessor-in-interest, Groove Networks, Inc. (hereafter “Predecessor”), has adopted and used the mark GROOVE in interstate commerce; however, as to all other allegations contained in paragraph 2 of the Opposition, including the specific services with which the mark GROOVE is alleged to have been used, and the date on which Opposer’s and/or Predecessor’s use of the GROOVE mark began, Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of such allegations, and therefore denies the same.
3. Applicant admits that Opposer is the owner of record of U.S. Registration No. 2,532,924 for the mark GROOVE; however, as to all other allegations contained in paragraph 3 of the Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of such allegations, and therefore denies the same.
4. Applicant admits that Opposer is the owner of record of U.S. Registration No. 2,830,702 for the mark GROOVE; however, as to all other allegations contained in paragraph 4 of the Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of such allegations, and therefore denies the same.
5. Applicant admits that Opposer is the owner of record of U.S. Registration No. 2,489,347 for the mark GROOVE; however, as to all other allegations contained in paragraph 5 of the Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of such allegations, and therefore denies the same.

6. Applicant admits that Opposer has applied for registration for the mark GROOVE under U.S. Serial No. 78/724604. Applicant admits that Applicant's Application Nos. 78/574202 and 78/579177 have been noted as being potentially citable against Opposer's '604 application. Applicant denies all other allegations in paragraph 6 of the Opposition.
7. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 7 of the Opposition, and therefore denies the same.
8. Applicant admits that Predecessor is the owner of record of U.S. Trademark Registration No. 2,547,606 for the mark GROOVE NETWORKS and U.S. Trademark Registration No. 2,854,380 for the mark GROOVE WORKSPACE; otherwise, Applicant denies the allegations contained in paragraph 8 of the Opposition.
9. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 9 of the Opposition, and therefore denies the same.
10. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 10 of the Opposition, and therefore denies the same.
11. Applicant admits the allegations contained in paragraph 11 of the Opposition.
12. Applicant denies the allegations contained in paragraph 12 of the Opposition.
13. Applicant denies the allegations contained in paragraph 13 of the Opposition.
14. Applicant admits the allegations contained in paragraph 14 of the Opposition.

15. Applicant admits the allegations contained in paragraph 15 of the Opposition.
16. Paragraph 16 of the Opposition sets forth conclusions of law as to which no response by Applicant is required. Otherwise, Applicant denies the allegations contained in Paragraph 16 of the Opposition.
17. Paragraph 17 of the Opposition sets forth conclusions of law as to which no response by Applicant is required. Otherwise, Applicant denies the allegations contained in Paragraph 17 of the Opposition.
18. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 18 of the Opposition, and therefore denies the same.
19. Applicant admits the allegations contained in Paragraph 19 of the Opposition.
20. Applicant denies the allegations contained in Paragraph 20 of the Opposition.

#### **AFFIRMATIVE DEFENSES**

1. The Notice of Opposition fails to state any claim upon which relief can be granted.
2. There is no likelihood of confusion, mistake or deception because, *inter alia*, Applicant's GROOVE MOBILE mark is not confusingly similar to Opposer's/Predecessor's GROOVE, GROOVE WORKSPACE or GROOVE NETWORKS marks, as evidenced by the U.S. Patent and Trademark Office's publication of Applicant's GROOVE MOBILE applications in the Official Gazette on June 27, 2006.
3. There is no likelihood of confusion, mistake or deception because, *inter alia*, the services Applicant provides under the GROOVE MOBILE mark are not confusingly similar to the goods and services offered under Opposer's/Predecessor's GROOVE,

GROOVE WORKSPACE or GROOVE NETWORKS marks, as evidenced by the U.S. Patent and Trademark Office's publication of Applicant's GROOVE MOBILE applications in the Official Gazette on June 27, 2006.

4. Opposer will not be damaged by the issuance to the Applicant of the registration sought.
5. Opposer's claims are barred based on the doctrine of unclean hands.

#### **COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S REGISTRATIONS**

As grounds for cancellation, Groove Mobile, Inc., a Delaware Corporation, having its principal place of business at 24 Crosby Drive, Bedford, Massachusetts 01730 (hereinafter "Petitioner"), through its attorneys Bingham McCutchen LLP, believes it will be damaged by Registration Nos. 2,532,924 for the mark GROOVE and 2,830,702 for the

mark **groove**, as such registrations are invalid and are being used by Opposer to block Petitioner's GROOVE MOBILE applications, and hereby petitions to cancel the same.

As grounds therefore it is alleged as follows:

1. Microsoft Corporation (hereafter "Respondent") has obtained, through its predecessor-in-interest and wholly-owned subsidiary, Groove Networks, Inc. (hereafter "Predecessor"), Registration No. 2,532,924, filed on November 10, 1997, with a date of claimed first use of October 24, 2000, for the mark GROOVE in connection with "computer software used to facilitate and coordinate asynchronous interpersonal communications and collaboration among third party software programs, computer servers or processors and users sharing information;

downloadable electronic publications in the nature of reports and manuals about computer software, computer technology or electronic information” in Class 009; “printed publications in the nature of reports and manuals about computer software, computer technology or electronic information,” in Class 016; “computer and user directory listings of the development, deployment, use and distribution of software used to facilitate and coordinate asynchronous interpersonal communications and collaboration among third party software programs” in Class 035; “providing electronic storage, namely, a database containing user communications messages intended for third parties” in Class 039; “training in the use and operation of computer software used to facilitate and coordinate asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information” in Class 041; and “support services, namely, software maintenance, help desk services, and; providing electronic databases containing information in the field of development, deployment, use and distribution of software used to facilitate and coordinate asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information; computer consultation in the fields of software, networks, information systems, and high technology; documentations and development services in the fields of software, networks, information systems, and high technology” in Class 042. Predecessor filed an Amendment to Allege Use of the GROOVE mark with all such goods and services on February 15, 2001.

2. Respondent has obtained, through Predecessor, Registration No. 2,830,702, filed on October 18, 2000, with a date of claimed first use of October 24, 2000, for the mark

**groove**

in connection with “computer software used to facilitate and coordinate synchronous and asynchronous communications and collaboration among users, third party software programs, computer servers or processors; downloadable electronic publications in the nature of magazines, reports, business plans, and manuals about computer software, computer technology or electronic information” in Class 009; “printed publications in the nature of magazines, reports, business plans, and manuals about computer software, computer technology or electronic information,” in Class 016; “providing computer and user directory listings in the fields of development, deployment, use and distribution of software used to facilitate and coordinate synchronous and asynchronous interpersonal communications and collaboration among third party software programs” in Class 035; “provision of telecommunications connections to a global computer network” in Class 038; “providing electronic storage, namely, a database containing user communications messages intended for third parties” in Class 039; “training in the use and operation of computer software used to facilitate and coordinate synchronous and asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information; and of hardware containing a microprocessor or microcontroller and controllable by software or firmware” in Class 041; and “support services, namely, software maintenance, technical help desk support services, namely, troubleshooting and

maintenance of computer software problems via telephone and online; providing electronic databases containing information in the field of development, deployment, use and distribution of software used to facilitate and coordinate synchronous and asynchronous interpersonal communications and collaboration among third-party software programs, computer servers or processors and users sharing information; computer consultation in the fields of software, networks, information systems, and computer high technology; computer services, namely, consultation, development, modification and design of computer programs for others” in Class 042. Predecessor filed an Amendment to Allege Use of the

**groove**

mark with all such goods and services on September 25, 2003.

3. Upon information and belief, Predecessor was not using the GROOVE marks in connection with all of the goods and services identified in the ‘924 and ‘702 registrations at the times Predecessor filed the respective Amendments to Allege Use for the ‘924 and ‘702 registrations.
4. Predecessor knew or should have known that the Amendments to Allege Use filed by Predecessor in connection with the ‘924 and ‘702 registrations contained false and misleading statements pertaining to Predecessor’s then current use of the GROOVE marks.
5. Upon information and belief, Registration Nos. 2,532,924 and 2,830,702 were therefore fraudulently obtained by the Predecessor since the Predecessor had not used the GROOVE marks in connection with all of the goods and services identified

in the '924 and '702 registrations at the time Predecessor filed the respective Amendments to Allege Use for the '924 and '702 registrations.

**CAUSE OF ACTION - FRAUD ON THE PTO**

6. Petitioner hereby re-alleges and incorporates by reference each of the allegations set forth above as if fully set forth herein.
7. By the acts described above, Predecessor knowingly made false and misleading statements to the U.S. Patent and Trademark Office, and thus fraudulently obtained U.S. Registration Nos. 2,532,924 and 2,830,702, for the marks GROOVE and

**groove**

8. Petitioner has and will continue to be harmed by Registrant's invalid registrations inasmuch as Registrant has used its invalid registrations to assert claims in an attempt to prevent Petitioner from using and registering its marks in connection with its services.
9. Accordingly, U.S. Registrations Nos. 2,532,924 and 2,830,702, for the marks

GROOVE and **groove** should be cancelled.

WHEREFORE, Applicant prays that the Opposition be dismissed in its entirety, that registration of Application Serial No. 78/579,177 be granted to Applicant, and that U.S. Registration Nos. 2,532,924 and 2,830,702 be cancelled, together with such other and further relief as the Board may deem just and proper.

Please recognize as attorneys for Applicant in this proceeding David O. Johanson, Rachelle A. Dubow, Joshua M. Dalton (members of the Bar of the Commonwealth of Massachusetts) and the firm of Bingham McCutchen LLP, 150 Federal Street, Boston, Massachusetts 02110.

All correspondence should be addressed to David O. Johanson, Esq., of Bingham McCutchen LLP, 150 Federal Street, Boston, Massachusetts 02110.

Respectfully submitted,



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David O. Johanson  
Rachelle A. Dubow  
Joshua M. Dalton  
BINGHAM McCUTCHEN LLP  
150 Federal Street  
Boston, MA 02110  
(617) 951-8000

Dated: December 4, 2006

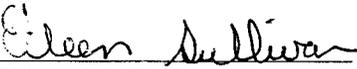
Attorneys for Applicant,  
Groove Mobile, Inc.

**CERTIFICATE OF SERVICE**

This is to certify that one copy of the Answer to Notice of Opposition, was mailed on December 4, 2006 by first-class mail, postage prepaid to Opposer's counsel in an envelope addressed as follows:

William O. Ferron, Jr.  
SEED IP Law Group PLLC  
701 Fifth Avenue, Suite 5400  
Seattle, Washington 98104

Dated: December 4, 2006

  
Eileen M. Sullivan  
Trademark Paralegal