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Filing date: **08/31/2012**

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

Proceeding	91206211
Party	Defendant Mophie, Inc.
Correspondence Address	MICHELLE HON DONOVAN DUANE MORRIS, LLP 101 W BROADWAY STE 900 SAN DIEGO, CA 92101-8285  mhdonovan@duanemorris.com
Submission	Answer and Counterclaim
Filer's Name	Michelle Hon Donovan
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Signature	/Michelle Hon Donovan/
Date	08/31/2012
Attachments	ABM Wireless Answer, Affirmative Defenses and Counterclaim.pdf ( 16 pages ) (130524 bytes )

**Registrations Subject to the filing**

Registration No	4011446	Registration date	08/16/2011
Registrant	ABM Wireless, Inc. 205 Marcus Blvd. Hauppauge, NY 11788 UNITED STATES		

**Goods/Services Subject to the filing**

<p>Class 009. First Use: 2006/01/01 First Use In Commerce: 2006/01/01 All goods and services in the class are requested, namely: Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, headsets for cell phones, earphones, cellular phone battery chargers, batteries, memory cards, antennas, electronic data cables, carrying cases for cell phones, adapters and accessories for portable music players in the nature of carrying cases and protective covers</p>
<p>Class 035. First Use: 2006/01/01 First Use In Commerce: 2006/01/01 All goods and services in the class are requested, namely: Distributorship services and retail store services in the field of telephone handsets and telecommunication products, cellular phones and cellular phone accessories, namely, wireless equipment, chargers, batteries, memory cards, headsets, data cables, antennas, cases, navigation equipment, adaptors, accessories for portable music players; Retail store services featuring telecommunications service plans and telecommunications service activation</p>

Registration No	4051955	Registration date	11/08/2011
Registrant	ABM Wireless, Inc. 205 Marcus Blvd. Hauppauge, NY 11788 UNITED STATES		

**Goods/Services Subject to the filing**

Class 009. First Use: 2006/01/01 First Use In Commerce: 2006/01/01

All goods and services in the class are requested, namely: Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, portable media players, cell phone battery chargers, batteries, memory cards, headsets for cell phones, data electronic cables, antennas, carrying cases for cell phones, GPS navigation devices, clips, holders, adaptors and accessories for portable music players in the nature of carrying cases, media storage devices in the nature of memory cards and flash drives, hands free devices and holders thereto, headsets, earphones and data electronic cables

Class 035. First Use: 2006/01/01 First Use In Commerce: 2006/01/01

All goods and services in the class are requested, namely: Distributorship services and retail store services in the field of telephone handsets and telecommunication products, cellular phones and cellular phone accessories, namely, wireless equipment, chargers, batteries, memory cards, headsets, data cables, antennas, cases, navigation equipment, adaptors, accessories for portable music players; Retail store services featuring telecommunications service plans and telecommunications service activation

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

In re Application No. 85/448,268  
Filed: October 14, 2011

ABM Wireless, Inc.,	:	
	:	
Opposer,	:	Opposition No. 91206211
v.	:	
	:	
Mophie, Inc.,	:	
	:	
Applicant.	:	
	:	

**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION,  
AFFIRMATIVE DEFENSES AND COUNTERCLAIMS**

Mophie, Inc. (“Mophie” or “Applicant”), for its Answer to the Notice of Opposition of ABM Wireless, Inc. (“Opposer”) pleads and avers as follows:

1. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 1, and accordingly denies the same.
2. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 2, and accordingly denies the same.
3. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 3, and accordingly denies the same.
4. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 4, and accordingly denies the same.

5. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 5, and accordingly denies the same.

6. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 6, and accordingly denies the same.

7. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 7, and accordingly denies the same.

8. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 8, and accordingly denies the same.

9. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 9, and accordingly denies the same.

10. Admitted.

11. Admitted.

12. Applicant admits that Application Serial No. 85/448,268 claims a first use as early as April, 2009. Applicant is without knowledge or information sufficient to form a reasonable belief as to the remaining allegations of Paragraph 12, and accordingly denies the same.

13. Admit.

14. Denied.

15. Admit.

16. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 16, and accordingly denies the same.

17. Admit.

18. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 18, and accordingly denies the same.

19. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 19, and accordingly denies the same.

20. Denied.

21. Denied.

22. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 22, and accordingly denies the same.

23. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 23, and accordingly denies the same.

24. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 24, and accordingly denies the same.

25. Applicant is without knowledge or information sufficient to form a reasonable belief as to the allegations of Paragraph 25, and accordingly denies the same.

#### **AFFIRMATIVE DEFENSES**

26. Opposer's Notice of Opposition does not set forth a claim upon which the relief sought may be granted.

27. Opposer should be denied all relief because there is no likelihood of confusion.

28. Applicant has superior rights to use the letter "m" with a circle design. Applicant owns U.S. Registration No. 3227725 for "electronic and optical communications instruments and components, namely, FM transmitters, audio signal splitters, FM receivers, audio speakers, wireless transmitters and receivers; carrying and protective cases for audio devices, audio-visual devices, calculators and cellular telephones, portable computers" in Class 009. The priority date for this mark is as early as August 1, 2005. This precedes Opposer's alleged priority date of January 1, 2006.

29. Opposer should be denied all relief because it is before the Trademark Trial and Appeal Board with unclean hands.
30. Opposer's claim is barred on the basis of laches and/or acquiescence.
31. Opposer should be denied all relief on estoppel grounds.
32. Applicant reserves the right to raise additional defenses as may become apparent through discovery and up to the trial.

### COUNTERCLAIMS

Applicant believes that it is and will be damaged by the continued registration on the Principal Register of the marks  and , as shown in Registration Nos. 4011446 and 4051955 issued to ABM Wireless, Inc., and hereby petitions to cancel, in whole or in part, the same. As grounds therefor, Petitioner alleges as follows:

1. Applicant is a manufacture of various consumer electronics, including but not limited to the specific goods set forth in its registrations and application listed below.
2. Applicant and/or its predecessor in interest has sold these goods under the name "mophie" and the logo of the letter "m" in a shaded circle since at least as early as August 1, 2005.
3. Applicant is the owner of the mark  and U.S. Registration No. 3227725 for "electronic and optical communications instruments and components, namely, FM transmitters, audio signal splitters, FM receivers, audio speakers, wireless transmitters and receivers; carrying and protective cases for audio devices, audio-visual devices, calculators and cellular telephones, portable computers" in Class 009.

4. Applicant is also the owner of the mark  and U.S. Registration No. 3681443 for “Audio speakers; loud speakers; loud speakers and stereo systems comprised of speakers, speakers used on docking stations for portable audio devices, namely, MP3 players, and docking stations for use with audio speakers; electronic and optical communications instruments and components, namely, audio speakers, carrying and protective cases for audio devices, battery packs, namely, batteries with integrated docking for mobile electronic devices; batteries and battery chargers for use as external power sources with mobile consumer electronic products; electrical cells and batteries, namely, external power sources with integrated housing and electrical connector; cell phone battery chargers, namely, external power sources with integrated housing and electrical connector for mobile phones; and mobile telephone batteries, namely, external battery packs with integrated docking for mobile telephones” in Class 009.

5. Applicant is also the owner of the mark  and U.S. Registration No. 3681444 for “Audio speakers; loud speakers; loud speakers and stereo systems comprised of speakers, speakers used on docking stations for portable audio devices, namely, MP3 players, and docking stations for use with audio speakers; electronic and optical communications instruments and components, namely, audio speakers, carrying and protective cases for audio devices, battery packs, namely, batteries with integrated docking for mobile electronic devices; batteries and battery chargers for use as external power sources with mobile consumer electronic products; electrical cells and batteries, namely, external power sources with integrated housing and electrical connector; cell phone battery chargers, namely, external power sources with

integrated housing and electrical connector for mobile phones; and mobile telephone batteries, namely, external battery packs with integrated docking for mobile telephones” in Class 009.

6. Opposer claims that it is the owner of the following marks and registrations (collectively the “ABM Marks”):

- a.  - U.S. Registration No. 4011446 for “Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, headsets for cell phones, earphones, cellular phone battery chargers, batteries, memory cards, antennas, electronic data cables, carrying cases for cell phones, adapters and accessories for portable music players in the nature of carrying cases and protective covers” in Class 009 and “Distributorship services and retail store services in the field of telephone handsets and telecommunication products, cellular phones and cellular phone accessories, namely, wireless equipment, chargers, batteries, memory cards, headsets, data cables, antennas, cases, navigation equipment, adaptors, accessories for portable music players; Retail store services featuring telecommunications service plans and telecommunications service activation” in Class 035.
- b.  - U.S. Registration No. 4051955 for “Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, portable media players, cell phone battery chargers, batteries, memory cards, headsets for cell phones, data electronic cables, antennas, carrying cases for cell phones, GPS navigation devices, clips, holders, adaptors and accessories for portable music players in the nature of carrying cases, media

storage devices in the nature of memory cards and flash drives, hands free devices and holders thereto, headsets, earphones and data electronic cables” in Class 009 and “Distributorship services and retail store services in the field of telephone handsets and telecommunication products, cellular phones and cellular phone accessories, namely, wireless equipment, chargers, batteries, memory cards, headsets, data cables, antennas, cases, navigation equipment, adaptors, accessories for portable music players; Retail store services featuring telecommunications service plans and telecommunications service activation” in Class 035.

7. On information and belief, Opposer’s services are limited to distribution and retail store services.

8. On information and belief, Opposer has never sold any telecommunication products and cellular phone accessories under the ABM Marks.

9. Opposer has sought to oppose the registration of Applicant’s mark  (U.S. Trademark Application Serial No. 85448268) for “carrying and protective cases, namely, armbands used as a case, belt clips used as a case, holsters, hard cases, soft cases, and silicone cases for use with mobile electronic devices in the nature of mobile card readers, mobile point-of-sale terminals, mobile phones, digital audio and video players, personal digital assistants, electronic personal organizers, and cameras, and mobile computing devices in the nature of handheld computers, tablet computers and electronic notepads; peripherals and accessories, namely, battery chargers, USB cables and power converters for use with mobile electronic devices; protective screen shields for mobile electronic devices; card readers to scan information contained in smart cards, radio frequency identification cards, chip cards, credit cards, bank

cards, debit cards, licenses, identification cards and frequent buyer cards; card reader terminal for use with mobile electronic devices, to scan information contained in electronic strips of various cards, namely, credit cards, bank cards, debit cards, licenses, identification cards and frequent buyer cards; barcode scanners; computer devices and systems, namely, haptic interfaces and devices for providing haptic, force and tactile feedback with integrated audio speakers for use with mobile electronic devices; software used to generate haptic, force and tactile feedback for use with such devices and systems; and software for mobile electronic devices and computers, namely, computer software for processing electronic payments via mobile electronic devices and computers” based on its alleged prior use of the ABM Marks in Class 009.

33. Therefore, Applicant has been and will continue to be harmed as a result of the existence of U.S. Trademark Registration Nos. 4011446 and 4051955.

**COUNTERCLAIM I**  
**(Cancellation of Registration No. 4011446 – Priority)**

34. Applicant realleges paragraphs 1 through 33 and incorporates them by reference as if fully set forth herein.

35. Applicant is the owner of the mark  and U.S. Registration No. 3227725 for “electronic and optical communications instruments and components, namely, FM transmitters, audio signal splitters, FM receivers, audio speakers, wireless transmitters and receivers; carrying and protective cases for audio devices, audio-visual devices, calculators and cellular telephones, portable computers” in Class 009.

36. Applicant and/or its predecessor in interest has used the  mark as early as August 1, 2005.

37. Opposer claims to own the mark  and U.S. Registration No. 4011446 for “Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, headsets for cell phones, earphones, cellular phone battery chargers, batteries, memory cards, antennas, electronic data cables, carrying cases for cell phones, adapters and accessories for portable music players in the nature of carrying cases and protective covers” in Class 009 and “Distributorship services and retail store services in the field of telephone handsets and telecommunication products, cellular phones and cellular phone accessories, namely, wireless equipment, chargers, batteries, memory cards, headsets, data cables, antennas, cases, navigation equipment, adaptors, accessories for portable music players; Retail store services featuring telecommunications service plans and telecommunications service activation” in Class 035.

38. Opposer claims to have used this mark in commerce as early as January 1, 2006.

39. Applicant’s use date of August 1, 2005 predates Opposer’s alleged priority date of January 1, 2006.

40. Opposer’s  mark and Applicant’s  mark are substantially similar in appearance, sound and overall commercial impression.

41. The goods and services offered under the respective marks are identical and/or closely related.

42. As a result, Applicant has been and will continue to be harmed as a result of the existence of U.S. Registration No. 4011446.

**COUNTERCLAIM II**  
**(Cancellation of Registration No. 4011446 – Non-Use)**

43. Applicant realleges paragraphs 1 through 42 and incorporates them by reference as if fully set forth herein.

44. On January 28, 2011 Opposer filed an Amendment to Allege Use with a signed Declaration asserting the use of the  mark in connection with all goods in Class 009.

45. The Declaration claims a first use date as early as January 1, 2006 for Class 009.

46. U.S. Registration No. 4011446 subsequently issued based on this alleged use.

47. On information and belief, Opposer did not use, and has never used, the  mark in connection with any of the goods identified in Class 009.

48. On information and belief, Opposer has abandoned its rights to the registration with respect to Class 009, with no intent to resume use, because Opposer never used the  mark in connection with the goods in Class 009 in the United States for a period of at least three (3) years since its alleged date of first use, and Opposer does not currently offer the goods in Class 009 in the United States.

**COUNTERCLAIM III**  
**(Cancellation of Registration No. 4011446 – Fraud)**

49. Applicant realleges paragraphs 1 through 48 and incorporates them by reference as if fully set forth herein.

50. On January 28, 2011 Opposer filed an Amendment to Allege Use with a signed Declaration asserting the use of the  mark in connection with all goods in Class 009.

51. The Declaration claims a first use date as early as January 1, 2006 for Class 009.

52. On information and belief, Opposer did not use, and has never used, the  mark in connection with any of the goods identified in Class 009.

53. Opposer knew or should have known at the time of submission of the Amendment to Allege Use and Declaration, that Opposer was not actually using the alleged mark in commerce in connection with the goods identified in Class 009.

54. The Amendment to Allege Use made materially false statements about the use of the mark on all of the goods identified in Class 009.

55. The subject registration was secured through materially false statements made in Amendment to Allege Use. False statements with regard to use of the mark constitute fraud in the securing and maintenance of the registration of a federal trademark and are grounds for the cancellation thereof pursuant to 15 U.S.C. § 1064(3).

**COUNTERCLAIM IV**  
**(Cancellation of Registration No. 4051955 – Priority)**

56. Applicant realleges paragraphs 1 through 55 and incorporates them by reference as if fully set forth herein.

57. Applicant is the owner of the mark  and U.S. Registration No. 3227725 for “electronic and optical communications instruments and components, namely, FM transmitters, audio signal splitters, FM receivers, audio speakers, wireless transmitters and

receivers; carrying and protective cases for audio devices, audio-visual devices, calculators and cellular telephones, portable computers” in Class 009.

58. Applicant and/or its predecessor in interest has used the  mark as early as August 1, 2005.

59. Opposer claims to own the mark mobileistic and U.S. Registration No. 4051955 for “Telecommunication products and cellular phone accessories, namely, wireless equipment in the nature of cellular phones, portable media players, cell phone battery chargers, batteries, memory cards, headsets for cell phones, data electronic cables, antennas, carrying cases for cell phones, GPS navigation devices, clips, holders, adaptors and accessories for portable music players in the nature of carrying cases, media storage devices in the nature of memory cards and flash drives, hands free devices and holders thereto, headsets, earphones and data electronic cables” in Class 009 and “Distributorship services and retail store services in the field of telephone handsets and telecommunication products, cellular phones and cellular phone accessories, namely, wireless equipment, chargers, batteries, memory cards, headsets, data cables, antennas, cases, navigation equipment, adaptors, accessories for portable music players; Retail store services featuring telecommunications service plans and telecommunications service activation” in Class 035.

60. Opposer claims to have used this mark in commerce as early as January 1, 2006.

61. Applicant’s use date of August 1, 2005 predates Opposer’s alleged priority date of January 1, 2006.

62. Opposer's mobileistic mark and Applicant's  mark are substantially similar in appearance, sound and overall commercial impression.

63. The goods and services offered under the respective marks are identical and/or closely related.

64. As a result, Applicant has been and will continue to be harmed as a result of the existence of U.S. Registration No. 4051955.

**COUNTERCLAIM V**  
**(Cancellation of Registration No. 4051955 – Non-Use)**

65. Applicant realleges paragraphs 1 through 64 and incorporates them by reference as if fully set forth herein.

66. On January 28, 2011 Opposer filed an Amendment to Allege Use with a signed Declaration asserting the use of the mobileistic mark in connection with all goods in Class 009.

67. The Declaration claims a first use date as early as January 1, 2006 for Class 009.

68. On information and belief, Opposer did not use, and has never used, the mobileistic mark in connection with any of the goods identified in Class 009.

69. U.S. Registration No. 4051955 subsequently issued based on this alleged use.

70. On information and belief, Opposer did not use, and has never used, the mobileistic mark in connection with any of the goods identified in Class 009.

71. On information and belief, Opposer has abandoned its rights to the registration with respect to Class 009, with no intent to resume use, because Opposer never used the

 mark in connection with the goods in Class 009 in the United States for a period of at least three (3) years since its alleged date of first use, and Opposer does not currently offer the goods in Class 009 in the United States.

**COUNTERCLAIM VI  
(Cancellation of Registration No. 4051955 – Fraud)**

72. Applicant realleges paragraphs 1 through 71 and incorporates them by reference as if fully set forth herein.

73. On January 28, 2011 Opposer filed an Amendment to Allege Use with a signed Declaration asserting the use of the  mark in connection with all goods in Class 009.

74. The Declaration claims a first use date as early as January 1, 2006 for Class 009.

75. On information and belief, Opposer did not use, and has never used, the  mark in connection with any of the goods identified in Class 009.

76. Opposer knew or should have known at the time of submission of the Amendment to Allege Use and Declaration, that Opposer was not actually using the alleged mark in commerce in connection with the goods identified in Class 009.

77. The Amendment to Allege Use made materially false statements about the use of the mark on all of the goods identified in Class 009.

78. The subject registration was secured through materially false statements made in Amendment to Allege Use. False statements with regard to use of the mark constitute fraud in the securing and maintenance of the registration of a federal trademark and are grounds for the cancellation thereof pursuant to 15 U.S.C. § 1064(3).

**PRAYER FOR RELIEF**

WHEREFORE, Applicant requests that:

- (1) Opposition No. 91206211 be dismissed and that a Certificate of Registration be issued to Applicant;
- (2) U.S. Trademark Registration Nos. 4011446 and 4051955 be canceled in their entirety; and/or
- (3) Class 009 be canceled from U.S. Trademark Registration Nos. 4011446 and 4051955.

Dated: August 31, 2012

Respectfully submitted,

DUANE MORRIS LLP

By: /Michelle Hon Donovan /  
Michelle Hon Donovan, Esq.

Attorneys for Petitioner  
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**Certificate of Service**

The undersigned hereby certifies that a true and correct copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS is being deposited with the United States Postal Service, with sufficient postage as first class mail in an envelope address to Registrant at:

Brian A. Bloom  
CERTILMAN BALIN ADLER & HYMAN, LLP  
90 Merrick Avenue, 9th Floor  
East Meadow, NY 11554

On the August 31, 2012.

\_\_\_\_\_  
/Michelle Hon Donovan/

**Certificate of Electronic Filing**

The undersigned hereby certifies that the original of the Petition for Partial Cancellation was filed with the Trademark Trial and Appeal Board by electronic filing through the Electronic System for the Trademark Trial and Appeals at <http://estta.uspto.gov> on the date indicated below.

On the August 31, 2012

\_\_\_\_\_  
/Michelle Hon Donovan/