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Filing date: **06/11/2014**

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

Proceeding	91216189
Party	Defendant Verident, LLC
Correspondence Address	JEFFREY NEU KUZAS NEU, P.C. 318 NEWMAN SPRINGS RD RED BANK, NJ 07701-5639 jeff.neu@kuzasneu.com;victoria.mercer@k
Submission	Answer and Counterclaim
Filer's Name	Victoria A. Mercer
Filer's e-mail	jeff.neu@kuzasneu.com, victoria.mercer@kuzasneu.com
Signature	/Victoria A. Mercer/
Date	06/11/2014
Attachments	Thinktastic ChatPoint ClearOne TTAB Answer.pdf(134805 bytes) Exhibit A - Definition of Chat Merriam Webster.pdf(591753 bytes)

Registrations Subject to the filing

Registration No	3333223	Registration date	11/13/2007
Registrant	CLEARONE, INC. 5225 WILEY POST WAY, SUITE 500 SALT LAKE CITY, UT 84116 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 009. First Use: 2006/04/07 First Use In Commerce: 2006/04/07 All goods and services in the class are requested, namely: Electronic hardware accessories, namelyspeakers, speakerphones and microphonesand software that add two way audio conferencing capability to multiple devices
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Registration No	4276948	Registration date	01/15/2013
Registrant	ClearOne 5225 Wiley Post Way, Suite 500 Salt Lake City, UT 84116 UNITED STATES		

Goods/Services Subject to the filing

Class 009. First Use: 2012/01/09 First Use In Commerce: 2012/01/09 All goods and services in the class are requested, namely: headsets for use with telephones and computers

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

In the Matter of Trademark Application Serial No. 85901105

For the Mark: **ChatPoint**

Published in the *Official Gazette* on March 4, 2014.

ClearOne, Inc.,

Opposer,

v.

Verident, LLC, d/b/a Thinktastic Software,
LLC,

Applicant.

Opposition No. 91216189

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

Applicant, Verident, LLC d/b/a Thinktastic Software, LLC (“Applicant”), hereby submits its Answer to the Notice of Opposition filed by ClearOne, Inc., (“Opposer”) against application for registration of Applicant’s trademark CHATPOINT, Serial No. 85901105 (the “Mark”), as follows, with the following numbered paragraphs corresponding to the numbers of the paragraphs of the Notice of Opposition. Except as hereinafter expressly admitted, qualified or otherwise answered, Applicant denies each and every allegation and assertion made in Opposer’s Opposition.

ANSWER

1. Applicant admits the allegations contained in Paragraph 1. Applicant, doing business as Thinktastic Software, improves the way workplace teams communicate and collaborate. Applicant achieves this goal by offering a suite of software that integrates into and builds off of the Microsoft SharePoint platform and Microsoft Word. Under the ChatPoint brand name, Applicant provides SharePoint users with an improved ability to communicate and provide progress and status notifications in real-time. ChatPoint is available exclusively for use on the SharePoint platform and will not function on any other platform or independently.

2. Applicant admits the allegations contained in Paragraph 2.

3. Applicant is without knowledge or information sufficient to form a belief as to the allegations contained in Paragraph 3 and accordingly denies the allegations.

4. Applicant is without knowledge or information sufficient to form a belief as to the allegations contained in Paragraph 4 and accordingly denies the allegations.

5. Applicant is without knowledge or information sufficient to form a belief as to the allegations contained in Paragraph 5 and accordingly denies the allegations.

6. Applicant is without knowledge or information sufficient to form a belief as to the allegations contained in Paragraph 6 and accordingly denies the allegations.

7. Applicant is without knowledge or information sufficient to form a belief as to the allegations contained in Paragraph 7 and accordingly denies the allegations.

8. Applicant denies each and every allegation contained in Paragraph 8.

9. Applicant denies each and every allegation contained in Paragraph 9.

10. Applicant denies each and every allegation contained in Paragraph 10.

AFFIRMATIVE DEFENSES

Applicant asserts the following affirmative defenses:

11. Failure to State Claim: Opposer fails to state a claim upon which relief can be granted.
12. Generic and No Inherent Distinctiveness: Applicant alleges that Opposer's alleged marks are generic and have not obtained the level of distinctiveness sufficient to obtain relief under the Lanham Act or other applicable state and federal laws because Opposer cannot show that the primary significance in the minds of the consuming public of the word "Chat" and the term "ChatAttach" is not chat products, but rather Opposer; therefore Applicant is free to use its mark in commerce.
13. No Likelihood of Confusion: In the alternative, if the Board finds that Opposer has rights in its alleged trademarks, any and all of those rights are of narrow and limited scope because Opposer's alleged trademarks are weak, non-distinctive, and numerous third parties use similar marks. Moreover, there is no likelihood of confusion, mistake or deception because, *inter alia*, the Mark and the alleged trademarks of Opposer are not confusingly similar and their respective goods and services are unrelated, serve different purposes, and target different consumers.
14. Exclusive Use: Applicant alleges Opposer has not exclusively used marks containing the term "Chat" in commerce and has not established the right to use the marks

containing such term based on exclusive use in commerce. In fact, the term “Chat” is merely descriptive, and is used by numerous commercial entities throughout the United States.

15. Acquiescence: Applicant has been using the Mark and developing consumer recognition and goodwill therein since at least March 16, 2013, such use being open and notorious. In addition, Opposer has unreasonably delayed in asserting its rights against infringers or junior users of similar marks and/or Opposer has acquiesced to the use of similar marks. During this time, Opposer failed to take meaningful action to assert the claims on which it bases this Opposition.

16. Reservation of Rights: Applicant reserves the right to raise and assert additional affirmative defenses should additional defenses become known during the progress of this litigation.

COUNTERCLAIM TO CANCEL REGISTRATIONS

Applicant, as a result of the overreaching claims by Opposer, has been and will continue to be damaged by the continued registration of the marks shown in Registration Nos. 3333233 and 4276948 (together, the “Chat Marks”) and hereby brings these counterclaims seeking cancellation of these registrations in their entirety, and in the alternative, petitions for partial cancellation or restriction of Chat, Registration No. ‘223. As grounds for these petitions, Applicant alleges as follows:

Cancel Registrations of the Chat Marks

1. Applicant repeats and re-alleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

2. Opposer's registration for the term "Chat" (Registration No. 3333223) issued on November 13, 2007 for "electronic hardware accessories, namely speakers, speakerphones and microphones and software that add two-way audio conferencing capability to multiple devices." Opposer filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 on June 17, 2013.

3. Opposer's registration for the term "Chat" (Registration No. 4276948) issued on January 15, 2013 for "headsets for use with telephones and computers."

4. The word "chat" is not a term coined by Opposer, but is a generic term with first known usage in the 15th Century that means "to talk in an informal or familiar manner" and "to take part in an online discussion in a chat room." *See Exhibit A.*

5. Opposer has not overcome of the primary significance of the word "Chat" in the minds of consumers.

6. Therefore, Opposer's alleged Chat Marks are generic references to the goods offered under these marks, i.e. equipment whose primary function is to enable consumers to "talk in an informal or familiar manner" and "to take part in an online discussion in a chat room."

7. Opposer's alleged Chat Marks in their entirety are generic, not distinctive, and have not acquired distinctiveness; consequently, the Chat Marks have no secondary meaning and cannot function as trademarks.

8. Continued registration of the Chat Marks is inconsistent with Applicant's and third parties' rights to freely and accurately describe their goods and services.

Partial Cancellation or Restriction of Registration No. '223

9. Applicant repeats and re-alleges each and every allegation set forth in the foregoing paragraphs as if fully set forth herein.

10. The descriptions of Opposer's Chat trademark, Registration No. '223 is ambiguous and overly broad.

11. In the alternative to cancellation of Registration No. '223 in its entirety, Applicant hereby requests that the description of Registration No. '223's goods and services be modified to remove the word "software."

12. On information and belief, Opposer has not and does not provide software to consumers under the brand "Chat."

13. On information and belief, the proposed modification is accurate to the actual use by Opposer in the marketplace of the mark, Chat, Registration No. '223.

14. Applicant does not provide electronic hardware accessories, including speakers, speakerphones and microphones.

15. The requested restriction or modification of Registration No.'223 would avoid a finding of likelihood of confusion between Applicant's applied-for mark and Opposer's mark, Chat, Registration No. '223.

WHEREFORE, Applicant prays as follows:

- (a) this Opposition be dismissed;
- (b) that Registration Nos. 3333223 and 4276948 be cancelled in their entireties, or in the alternative, with regard to Registration No. 3333223, the registration be restricted by removing the word "software" from its description of goods; and

(c) a registration for Serial No. 85901105 be issued to Applicant.

Applicant is filing by credit card the statutory filing fee of \$600.00 for its counterclaim for cancellation.

Dated: June 11, 2014

Respectfully submitted,

Verident, LLC d/b/a/ Thinktastic Software, LLC

/s/ Jeffrey Neu

Jeffrey Neu, Esq.

Victoria A. Mercer, Esq.

Kuzas Neu, P.C.

318 Newman Springs Road

Red Bank, NJ 07701

732.978.4053

Attorneys for Applicant

CERTIFICATE OF SERVICE

I hereby certify that an original copy of the foregoing ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIM was served on ClearOne by depositing copies thereof in the United States Mail, first-class postage prepaid, on June 11, 2014 addressed as follows:

Margaret Niver McGann
Michael W. Young
Parsons Behle & Latimer
201 South Main Street, Suite 1800
Salt Lake City, Utah 84111

ClearOne
5225 Wiley Post Way, Suite 500
Salt Lake City, Utah 84116

By: /s/ Victoria A. Mercer
Victoria A. Mercer, Esq.

Kuzas Neu, P.C.
318 Newman Springs Road
Red Bank, NJ 07701
732.978.4053
Attorneys for Applicant

CERTIFICATE OF ELECTRONIC FILING

The undersigned certifies that this submission is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 11th day of June, 2014.

By: /s/ Victoria A. Mercer
Victoria A. Mercer, Esq.

Kuzas Neu, P.C.
318 Newman Springs Road
Red Bank, NJ 07701
732.978.4053
Attorneys for Applicant

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chat

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chat

8 ENTRIES FOUND:

- chat
- chat room
- chat show

Chat is currently in the bottom 50% of lookups on Merriam-Webster.com.
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¹chat *verb* \ˈtʃæt\
: to talk with someone in a casual way
: to talk over the Internet by sending messages back and forth in a chat room

chat-ted | chat-ting

Full Definition of CHAT [Cite!](#)

intransitive verb

1 : CHATTER, PRATTLE

Ghost Word

00:00 02:01

- MORE QUIZZES
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TOP 10 LISTS

The Dangerous Creation of

chat  *verb* \ˈtʃæt\
: to talk with someone in a casual way
: to talk over the Internet by sending messages back and forth in a chat room

chat-ted | **chat-ting**

Full Definition of CHAT 

intransitive verb

- 1** : CHATTER, PRATTLE
- 2 a** : to talk in an informal or familiar manner
b : to take part in an online discussion in a chat room

transitive verb

chiefly British : to talk to; *especially* : to talk lightly, glibly, or flirtatiously with —often used with *up*

 See **chat** defined for English-language learners »
See **chat** defined for kids »

Examples of CHAT

- We *chatted* about our plans for the summer.
- called him up to *chat*
- She stayed up all night *chatting* with her friends online.

Origin of CHAT

Middle English *chatten*, short for *chatteren*
First Known Use: 15th century

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Origin of CHAT

Middle English *chatten*, short for *chatteren*
First Known Use: 15th century

Related to CHAT

Synonyms

babble, blab, cackle, chaffer [*British*], chatter, chin [*slang*], converse, gab, gabble, gas, jabber, jaw, kibitz (*also* kibbitz), natter, palaver, patter, prate, prattle, rap, rattle, run on, schmooze (*or* shmooze), talk, twitter, visit, blow smoke, chew the fat (*also* chew the rag), shoot the breeze, talk a blue streak

Related Words

gossip, tattle; descant, discuss, expatiate; yak (*also* yack), yammer, yap

Near Antonyms

articulate, enunciate, pronounce

[more](#)

Rhymes with CHAT

bat, batt, blat, brat, cat, Cat, chert, drat, fat, flat, frat, gat, gnat, hat, mat, Matt, matte, pat, phat, plait, plat, Pratt, rat, sat, ...
[\[+\] more](#)

²chat *noun*

: a light and friendly conversation

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chat *noun*
: a light and friendly conversation
: a talk held over the Internet by people using a chat room

Full Definition of CHAT

- 1 : idle small talk : CHATTER
- 2 : light informal or familiar talk; *especially* : CONVERSATION
- 3 [imitative] : any of several songbirds (as of the genera *Cercomela*, *Granatellus*, or *Icteria*)
- 4 : online discussion in a chat room; *also* : an instance of such discussion <participate in computer *chats*>
[See chat defined for English-language learners »](#)

Examples of CHAT

- We enjoyed a *chat* over coffee.
- software used for e-mail and *chat*

First Known Use of CHAT

1530

Related to CHAT

Synonyms
backchat, cackle, causerie, chatter, chin music, chin-wag [*slang*], chitchat, confab, confabulation, gab, gabfest, gossip, jangle, jaw, natter [*chiefly British*], palaver, patter, rap, schmooze, small talk, table talk, talk, tête-à-tête

rap, schmooze, small talk, table talk, talk, tête-à-tête

Related Words

colloquy, conference, discourse, parley, powwow, symposium; debate, dialogue (*also* dialog), exchange, give-and-take; crosstalk, happy talk; yak (*also* yack), yammer, yap

[more](#)

Learn More About CHAT

- Thesaurus: All synonyms and antonyms for "chat"
- Spanish Central Translation: "chat" in Spanish
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Monday, June 9, 2014