

ESTTA Tracking number: **ESTTA730998**

Filing date: **03/02/2016**

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

Proceeding	91219607
Party	Defendant Vubiquity, Inc.
Correspondence Address	AMY B GOLDSMITH TARTER KRINSKY & DROGIN LLP 1350 BROADWAY NEW YORK, NY 10018 UNITED STATES agoldsmith@tarterkrinsky.com, docket@tarterkrinsky.com, rdouglas@tarterkrinsky.com
Submission	Answer
Filer's Name	Amy B. Goldsmith
Filer's e-mail	docket@tarterkrinsky.com, agoldsmith@tarterkrinsky.com
Signature	/Amy B. Goldsmith/
Date	03/02/2016
Attachments	Answer to Opposition.pdf(14240 bytes )

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

In the matter of Trademark Application No. 85/843,704  
Trademark: VUBIQUITY  
Filed: February 7, 2013  
Published for Opposition: August 5, 2014

---

VIEWBIQUITY, LLC,  
Opposer,

vs.

Opposition No. 91219607

VUBIQUITY, INC.  
Applicant.

---

**ANSWER TO NOTICE OF OPPOSITION**

Applicant VUBIQUITY, INC. (“Applicant”), by and through its undersigned counsel, answers the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 of the Notice of Opposition and accordingly denies the same.
2. Applicant admits the allegations of Paragraph 2 of the Notice of Opposition.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 3 of the Notice of Opposition and accordingly denies the same.
4. Applicant admits the allegations of Paragraph 4 of the Notice of Opposition.
5. Applicant denies the allegations of paragraph 5 of the Notice of Opposition.
6. Applicant denies the allegations of paragraph 6 of the Notice of Opposition.
7. Applicant denies the allegations of paragraph 7 of the Notice of Opposition.
8. Applicant denies the allegations of paragraph 8 of the Notice of Opposition.

## **AFFIRMATIVE DEFENSES**

9. There is no likelihood of confusion, mistake or deception with respect to Applicant's Mark and the services set forth in the application and Opposer's registrations because, *inter alia*, Opposer's registrations relate to the following:

US Trademark Registration No. 4037684 issued October 11, 2011

IC 9: Computer software for connecting wired or wireless devices to enterprise computing applications which allows remote access for controlling, servicing, data acquisition, data streaming, managing, and monitoring the devices or sensors via a global computer network and the exchange of information between such devices or sensors and enterprise computing applications; downloadable global computer network-based software for interactive publishing of real-time or historical information to and from devices or sensors.

IC 41: Educational services in the nature of conducting training related to computer software that allows users to connect, manage, service, supervisory control, data acquisition, data streaming and/or track wired and wireless devices, sensors, equipment and other assets; training in the usage, support and/or development of computer software; educational services in the nature of conferences in the field of advertising, marketing and business development for the remote service software market; on-line blogs featuring information and commentary in the field of the remote service software market.

IC 42. Software as a service (SAAS) services, namely, hosting software for users in connection with the management, servicing, supervisory control, data acquisition, data streaming and/or tracking of wired and wireless devices, sensors, equipment and other assets, monitoring, communicating, collecting, storing and transmitting data related to such assets; computer software development services and computer consulting services for businesses, computer consultancy services for the design, selection, implementation, modification, maintenance and use of computer software systems; technical advice related to the installation of computer software; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; computer diagnostic services; computer consultancy services in the nature of advising and assisting with the implementation, installation, configuration, modification and maintenance of computer software that allows users to connect, manage, service, supervisory control, data acquisition, data streaming and/or track wired and wireless devices, equipment and other assets

US Trademark Registration No. 3716834 issued November 24, 2009

Class 9: Surveillance equipment, namely, infrared observation systems comprised of infrared detectors; mobile video monitoring systems comprised of video monitors and video cameras; video door phones; wireless observations systems comprised of wireless video cameras and video monitors; video monitors and voice display monitors; micro video cameras; micro digital cameras and micro photographic cameras; video dome cameras; bullet cameras; pan-tilt-zoom cameras; armored cameras; anti-vandal cameras;

professional cameras; smoke detector cameras; motion detectors with built-in color video cameras and motion detectors with built-in color digital cameras; wireless digital camera incorporating clock radio; remote controls for video dome cameras, Internet Protocol cameras, digital video recorders, network video recorders, hybrid video recorders, multi-channel signal processors, multichannel video processors and multichannel satellite processors; fingerprint access control devices, namely, biometric fingerprint scanners, video monitors that are able to receive sound and video images from video cameras via the telephone, and all related accessories, namely, camera lenses, computer cables, software used in digital video recorders, network video recorders, and hybrid video recorders used to set up and control analog and digital networks of security cameras, facial recognition, license plate recognition, point of sale integration, process improvement software based on video, and other video camera software and recording applications, and power supplies.

10. In contrast, Applicant's Mark relates to the following

IC 35: Distribution of promotional materials promoting the motion pictures, movies, audio programming, and television programming of others

IC 38: Broadcasting of movies, events, television programs and music programs; provision of telecommunication access to movies, events, television programs, music, promotional materials and other video and audio content provided via a video-on-demand service; video on demand transmission services; satellite, cable, wireless, fiber optic, internet protocol television (IPTV), and global computer network transmission of movies, events, television programs and music programs and associated metadata

IC 41: Cable television programming; distribution of motion pictures, movies, audio and visual programming, and television programming; distribution of motion pictures, movies, audio and visual programming, and television programming to cable television systems; distribution of motion pictures, movies, audio and visual programming, and television programming to internet protocol television (IPTV) transmission systems

11. Applicant's services were amended to the current identification in accordance with the recommendations of the Trademark Office after the Office noted US Trademark Registration No. 4037684, and the Application was published.

12. The Applicant's services therefore are not in the same channels of trade and are not targeted to the same consumers for the same channels of trade. Applicant has been using the Mark and developing consumer recognition and goodwill therein since at least as early as March 18, 2013, such use being open, notorious and known to Opposer. Applicant's use of Applicant's Mark has not been, nor is it, nor will it mistakenly be thought by the public to derive from the same source as Opposer's services, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization or approval.

13. Applicant's Mark in its entirety and as applied to the services set forth above, which were recommended by the Trademark Office, is sufficiently distinctively different from Opposer's Mark to avoid confusion, deception or mistake as to the source or sponsorship or association of Applicant's services.

Accordingly, Applicant prays that the Notice of Opposition be dismissed.

Dated: March 2, 2016

Respectfully submitted,

Tarter Krinsky & Drogin LLP

/s/ Amy B. Goldsmith  
Amy B. Goldsmith, Esq.

1350 Broadway  
New York, NY 10018  
[agoldsmith@tarterkrinsky.com](mailto:agoldsmith@tarterkrinsky.com)  
Tel: 212-216-1135  
Fax: 212-216-8001

**Certificate of Filing**

The undersigned hereby certifies that the foregoing Answer to Notice of Opposition was filed on this 2nd day of March, 2016 through electronic means via the ESTTA website.

Tarter Krinsky & Drogin LLP

/s/ Amy B. Goldsmith \_\_\_\_\_  
Amy B. Goldsmith, attorney for  
Applicant

**Certificate of Service**

I hereby certify that a true and complete copy of the foregoing Answer to Notice of opposition has been served on Viewbiquity, LLC via its counsel Alice Sum, Esq., by mailing said copy on March 2, 2016, via First Class Mail, postage prepaid, to: Alice Sum, Esq., Fowler White Burnett, PA, 1395 Brickell Avenue, 14th Floor, Miami, FL 33131.

Tarter Krinsky & Drogin LLP

s/ Amy B. Goldsmith \_\_\_\_\_  
Amy B. Goldsmith, attorney for  
Applicant