

ESTTA Tracking number: **ESTTA753615**

Filing date: **06/21/2016**

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

Proceeding	91227791
Party	Defendant Tivoli, LLC
Correspondence Address	NICHOLAS D MYERS MYERS BERSTEIN LLP 4 EXECUTIVE CIRCLE, STE 100 IRVINE, CA 92614 UNITED STATES nicholas@mybelaw.com, timothy@mybelaw.com, admin@mybelaw.com, m.quizon@mybelaw.com
Submission	Answer
Filer's Name	Timothy A. Schneider
Filer's e-mail	nicholas@mybelaw.com, david@mybelaw.com, timothy@mybelaw.com, admin@mybelaw.com, shannon@mybelaw.com
Signature	/Timothy A. Schneider/
Date	06/21/2016
Attachments	2016-06-21 Answer to Opposition 91227791.pdf(312370 bytes )

1 Nicholas D. Myers (CA State Bar No. 251809)  
David A. Berstein (CA State Bar No. 204472)  
2 Timothy A. Schneider (CA State Bar No. 300816)  
MYERS BERSTEIN LLP  
3 4 Executive Circle, Suite 100  
Irvine, California 92614  
4 Telephone: (949)825-5590  
[nicholas@mybelaw.com](mailto:nicholas@mybelaw.com)

5 Attorneys for Applicant Tivoli, LLC

7 UNITED STATES PATENT AND TRADEMARK OFFICE  
8 TRADEMARK TRIAL AND APPEAL BOARD

10 In the Matter of App. No. 86326210

11 TiVo Brands LLC,

12 Opposer,

13 v.

14 Tivoli, LLC,

15 Applicant.

Opposition No.: 91227791

**APPLICANT TIVOLI, LLC's ANSWER  
TO NOTICE OF OPPOSITION**

17 **ANSWER TO NOTICE OF OPPOSITION**

18 Applicant, Tivoli, LLC ("Applicant"), by and through its attorneys, MYERS  
19 BERSTEIN LLP, hereby answers the Notice of Opposition (the "Notice") filed by  
20 Opposer, TiVo Brands LLC ("Opposer"), as follows, addressing the numbered grounds  
21 for opposition seriatim:

22 1. Applicant is without sufficient information or knowledge to form a belief as to the  
23 truth of the allegations contained in Paragraph One of the Notice and, upon that basis,  
24 denies the allegations therein.

25 2. Applicant is without sufficient information or knowledge to form a belief as to the  
26 truth of the allegations contained in Paragraph Two of the Notice and, upon that basis,  
27 denies the allegations therein.

28 ///

1 3. Applicant admits that there are documents attached to Opposer’s Notice. As to all  
2 other allegations contained in Paragraph Three of the Notice, Applicant is without  
3 sufficient information or knowledge to form a belief as to the truth of the allegations and,  
4 upon that basis, denies the allegations therein.

5 4. Applicant denies the allegations contained in Paragraph Four of the Notice.

6 5. Applicant is without sufficient information or knowledge to form a belief as to the  
7 truth of the allegations contained in Paragraph Five of the Notice and, upon that basis,  
8 denies the allegations therein.

9 6. Applicant denies the allegations contained in Paragraph Six of the Notice.

10 7. Applicant admits the allegations contained in Paragraph Seven of the Notice.

11 8. Applicant admits the allegations contained in Paragraph Eight of the Notice.

12 9. As Paragraph Nine of the Notice does not contain any substantive allegations and  
13 purports to reallege and incorporate Paragraphs One through Eight, inclusive, of the  
14 Notice, Applicant hereby incorporates its answers to Paragraphs One through Eight,  
15 respectively, in response to Paragraph Nine.

16 10. Applicant is without sufficient information or knowledge to form a belief as to the  
17 truth of the allegations contained in Paragraph Ten of the Notice and, upon that basis,  
18 denies the allegations therein.

19 11. Applicant denies the allegations contained in Paragraph Eleven of the Notice.

20 12. Applicant denies the allegations contained in Paragraph Twelve of the Notice.

21 13. Applicant denies the allegations contained in Paragraph Thirteen of the Notice.

22 14. Applicant denies the allegations contained in Paragraph Fourteen of the Notice.

23 15. Applicant denies the allegations contained in Paragraph Fifteen of the Notice.

24 16. Applicant admits that “TiVo is not affiliated or connected with Applicant or its  
25 goods.” As to all other allegations contained in Paragraph Sixteen of the Notice,  
26 Applicant denies all other allegations.

27 ///

28 ///

1 17. Applicant admits that “TiVo has no control over the nature and quality of the goods  
2 or services that will be offered under the TIVOTAPE Mark.” As to all other allegations  
3 contained in Paragraph Seventeen of the Notice, Applicant denies all other allegations.

4 18. Applicant denies the allegations contained in Paragraph Eighteen of the Notice.

5 19. As Paragraph Nineteen of the Notice does not contain any substantive allegations  
6 and purports to reallege and incorporate Paragraphs One through Eighteen, inclusive, of  
7 the Notice, Applicant hereby incorporates its answers to Paragraphs One through  
8 Eighteen, respectively, in response to Paragraph Nineteen.

9 20. Applicant is without sufficient information or knowledge to form a belief as to the  
10 truth of the allegations contained in Paragraph Twenty of the Notice and, upon that basis,  
11 denies the allegations therein.

12 21. Applicant is without sufficient information or knowledge to form a belief as to the  
13 truth of the allegations contained in Paragraph Twenty-One of the Notice and, upon that  
14 basis, denies the allegations therein.

15 22. Applicant is without sufficient information or knowledge to form a belief as to the  
16 truth of the allegations contained in Paragraph Twenty-Two of the Notice and, upon that  
17 basis, denies the allegations therein.

18 23. Applicant is without sufficient information or knowledge to form a belief as to the  
19 truth of the allegations contained in Paragraph Twenty-Three of the Notice and, upon that  
20 basis, denies the allegations therein.

21 24. Applicant is without sufficient information or knowledge to form a belief as to the  
22 truth of the allegations contained in Paragraph Twenty-Four of the Notice and, upon that  
23 basis, denies the allegations therein.

24 25. Applicant is without sufficient information or knowledge to form a belief as to the  
25 truth of the allegations contained in Paragraph Twenty-Five of the Notice and, upon that  
26 basis, denies the allegations therein.

27 ///

28 ///

1 26. Applicant is without sufficient information or knowledge to form a belief as to the  
2 truth of the allegations contained in Paragraph Twenty-Six of the Notice and, upon that  
3 basis, denies the allegations therein.

4 27. Applicant denies the allegations contained in Paragraph Twenty-Seven of the  
5 Notice.

6 28. As to the allegations contained in Paragraph Twenty-Eight of the Notice, Applicant  
7 denies the allegations insofar as they concern the Applicant herein. As to the remaining  
8 allegations contained in Paragraph Twenty-Seven of the Notice, Applicant is without  
9 sufficient information or knowledge to form a belief as to the truth of the allegations  
10 contained and, upon that basis, denies the allegations therein.

11 29. Applicant denies the allegations contained in Paragraph Twenty-Nine of the  
12 Notice.

13 **AFFIRMATIVE DEFENSES**

14 **Failure to State Grounds for Opposition**

15 1. Applicant is informed and believes, and thereon alleges, that the facts set forth in  
16 the Notice are insufficient to justify denial of its Application.

17 ***Morehouse Defense***

18 2. Applicant is informed and believes, and thereon alleges, that Opposer has failed to  
19 object to Applicant's registrations of marks substantially similar to the application [2008  
20 Registration No. 3531631 for TIVOLED; 1975 Registration No. 1013476 for TIVOLI;  
21 1978 Registration No. 1106595 for TIVOLI (stylized); and 1980 Registration No.  
22 1143207 for TIVOLI (stylized)], all of which Opposer would find similar to its marks,  
23 "particularly by [the] inclusion of the entire TIVO mark as its prefix" [see Paragraph 27  
24 of the Notice], and, thus, the registration of the application, TIVOTAPE, for substantially  
25 similar goods causes no injury to Opposer.

26 ///

27 ///

28 ///

1 **Laches**

2 3. Applicant is informed and believes, and thereon alleges, that Opposer has failed to  
3 object to Applicant's registrations of marks substantially similar to the application [2008  
4 Registration No. 3531631 for TIVOLED; 1975 Registration No. 1013476 for TIVOLI;  
5 1978 Registration No. 1106595 for TIVOLI (stylized); and 1980 Registration No.  
6 1143207 for TIVOLI (stylized)], all of which Opposer would find similar to its marks,  
7 "particularly by [the] inclusion of the entire TIVO mark as its prefix" [see Paragraph 27  
8 of the Notice], and, thus, Opposer has unreasonably delayed in taking legal action to the  
9 detriment of Applicant whom relied on and was prejudiced by such inaction, constituting  
10 laches.

11 **Equitable Estoppel**

12 4. Applicant is informed and believes, and thereon alleges, that Opposer has failed to  
13 object to Applicant's registrations of marks substantially similar to the application [2008  
14 Registration No. 3531631 for TIVOLED; 1975 Registration No. 1013476 for TIVOLI;  
15 1978 Registration No. 1106595 for TIVOLI (stylized); and 1980 Registration No.  
16 1143207 for TIVOLI (stylized)], all of which Opposer would find similar to its marks,  
17 "particularly by [the] inclusion of the entire TIVO mark as its prefix" [see Paragraph 27  
18 of the Notice], and, thus, Opposer has unreasonably delayed in taking legal action to the  
19 detriment of Applicant whom relied on and was prejudiced by such inaction, constituting  
20 estoppel.

21 **Acquiescence**

22 5. Applicant is informed and believes, and thereon alleges, that Opposer has failed to  
23 object to Applicant's registrations of marks substantially similar to the application [2008  
24 Registration No. 3531631 for TIVOLED; 1975 Registration No. 1013476 for TIVOLI;  
25 1978 Registration No. 1106595 for TIVOLI (stylized); and 1980 Registration No.  
26 1143207 for TIVOLI (stylized)], all of which Opposer would find similar to its marks,  
27 "particularly by [the] inclusion of the entire TIVO mark as its prefix" [see Paragraph 27  
28 of the Notice], and, thus, Opposer, by such inaction, has given its tacit assent that such

1 marks, and the application, do not present a threat of likelihood of confusion or dilution  
2 of its trademark rights, constituting acquiescence.

3 **Abandonment**

4 6. Applicant is informed and believes, and thereon alleges, that Opposer has failed to  
5 protect, police, and/or control its rights from widespread use, and/or failed to exercise  
6 quality control resulting in abandonment of its trademark rights.

7 **No Famous Marks**

8 7. Applicant is informed and believes, and thereon alleges, that Opposer has failed to  
9 obtain and/or maintain the level of fame, notoriety, and distinctiveness sufficient to obtain  
10 relief as a famous mark.

11 **Lack of Causation of Harm to Famous Mark**

12 8. Applicant is informed and believes, and thereon alleges, that Opposer has failed to  
13 and cannot establish that Applicant's alleged use creates a likelihood of impairment to  
14 the distinctiveness of any alleged famous mark owned by Opposer, and Opposer cannot  
15 establish the requisite causation to establish harm.

16 THEREFORE, Applicant requests that this Notice and opposition proceeding be  
17 dismissed with prejudice and Applicant's application be allowed to mature to registration.  
18 Service has been made on Opposer's counsel as shown in the attached certificate of  
19 service.

20  
21 Dated: June 21, 2016

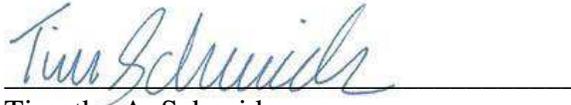
MYERS BERSTEIN LLP

22  
23 

24 Nicholas D. Myers  
25 David A. Berstein  
26 Timothy A. Schneider  
27 Attorney for Applicant  
28 Tivoli, LLC

**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that the attached **APPLICANT TIVOLI, LLC's ANSWER TO NOTICE OF OPPOSITION**, was filed electronically with the Trademark Trial and Appeal Board on June 21, 2016



Timothy A. Schneider  
Attorney for Applicant  
Tivoli, LLC

MYERS BERSTEIN LLP  
4 EXECUTIVE CIRCLE, SUITE 100  
IRVINE, CALIFORNIA 92614

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**PROOF OF SERVICE**

I am employed in the County of Orange, State of California. I am over the age of 18 and am not a party to the within action. My business address is 4 Executive Circle, Suite 100, Irvine, California 92614.

On June 21, 2016, I caused the foregoing document(s) described as: **APPLICANT TIVOLI, LLC's ANSWER TO NOTICE OF OPPOSITION**, to be served on the interested parties in this action by enclosing a true and correct copy of the original in a sealed envelope addressed as follows:

**Attorneys for Opposer TiVo Brands LLC**

Thomas M. Hadid  
John Paul Oleksiuk  
Anne H. Peck  
Cooley LLP  
1299 Pennsylvania Avenue, NW, Suite 700  
Washington, D.C. 20004  
T: 650.849.7007  
E: [thadid@cooley.com](mailto:thadid@cooley.com)

BY MAIL: I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at Irvine, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in the affidavit.

Executed on June 21, 2016 at Irvine, California.

(State) I declare under penalty of perjury that the foregoing is true and correct.

  
\_\_\_\_\_  
Timothy A. Schneider

MYERS BERSTEIN LLP  
4 EXECUTIVE CIRCLE, SUITE 100  
IRVINE, CALIFORNIA 92614