

ESTTA Tracking number: **ESTTA555173**

Filing date: **08/21/2013**

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

Proceeding	92051170
Party	Plaintiff O2Micro International Limited
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Date	08/21/2013
Attachments	Reply to Opp Brief.pdf(108999 bytes)

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

In Re Trademark Reg. No. 2231093)

Dated: March 9, 1999)

Mark: O2)

Class: INT. 9)

O2Micro International Limited)

Petitioner)

)

v.)

)

O2 Holdings Limited)

Respondent)

Cancellation No. 92051170

**PETITIONER'S REPLY TO RESPONDENT'S BRIEF IN OPPOSITION TO
PETITIONER'S MOTION FOR SUMMARY JUDGMENT**

TABLE OF AUTHORITIES

CASES

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Petitioner's Reply to Respondent's Statements

Petitioner maintains that there is no *genuine* dispute of material fact regarding the claims raised in Petitioner's Motion for Summary Judgment, as Respondent has demonstrated in its opposition brief that it cannot offer evidence sufficient for any reasonable jury to resolve factual matters in favor of Respondent. *Sweats Fashion, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 1562, 4 U.S.P.Q.2d 1793, 1795 (Fed. Cir. 1987) (“[a] dispute is *genuine* only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the non-movant”) (emphasis in original). Because Respondent's assertions are insufficient for any reasonable jury to resolve factual matters in Respondent's favor, Summary Judgment is warranted.

I. Abandonment

- a. SGI's filing of a Section 8 Affidavit was either made fraudulently or under a mistaken understanding of the law, as it was filed after SGI itself had retired the trademark's product line.

In reply to Respondent's assertion that the September 20, 2004 filing of the Section 8 and 15 Declarations of SGI somehow proves that the mark was not abandoned, Petitioner refers the Board to page 6, footnote 1 of Petitioner's Motion for Summary Judgment.

- b. Under *Safer*, online documents including the Wayback Machine archives are self-authenticating.

Respondent has taken the position that Petitioner's evidence comprising archived web site pages of SGI is inadmissible. Petitioner notes that under *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039, (TTAB 2010), the Board recognized that online documents are to be considered self-authenticating, just as print publications, provided that the online document identifies a date and source. The new rule under *Safer* has been applied to online archive

websites such as the Wayback Machine website service. *See, e.g., Berta Heslen-Minten v. Emma L. Petersen and Susan L. Aucoin*, Opposition No. 91192706 (TTAB 2013) (non-precedential).

Respondent's reliance on case law superseded by *Safer* is misplaced. Petitioner notes that Respondent has raised no objection to the substantive or probative nature of the archived pages, specifically, that they constitute a statement made by SGI itself that the O2 brand was considered retired when it was deemed a "Legacy Product."

Accordingly, Petitioner's evidence of SGI's retirement of the "O2" brand remains undisputed and should be given appropriate weight by the Board.

II. Respondent offers no evidence raising to a genuine dispute that its conduct amounted to naked licensing and loss of trademark rights.

Petitioner notes that Respondent has offered no evidence with regard to its claim that it did not engage in naked licensing, and rather relies solely on a legal argument that lacks sound legal basis. As such, the issue of naked licensing is properly before the Board to be decided as a matter of law. *See, e.g., FreecycleSunnyvale v. Freecycle Network*, 626 F.3d 509, 515 (9th Cir. 2010) (granting summary judgment where license agreement lacked supervision provisions and licensor actually failed to exercise control or supervision); *Barcamerica Intern. USA Trust v. Tyfield Importers, Inc.*, 289 F.3d 589, 596 (9th Cir. 2002) (same); *Stanfield v. Osborne Industries Inc.*, 52 F.3d 867, 34 U.S.P.Q.2d 1456 (10th Cir.1995) (same).

As Petitioner detailed in Petitioner's Motion for Summary Judgment, O2Holdings' naked licensing is demonstrated both by its express contractual terms that amount to naked licensing and by its conduct, consisting of a total failure to monitor, supervise, or ensure the quality or even continued use of the mark. Petitioner rests on its earlier-made legal arguments, but notes the

error in Respondent’s bizarre assertion that it had no need to exert quality control or supervision because the license to SGI stipulated how the mark was to be used. A licensor cannot agree by license to absolve itself of its duty to monitor and supervise the use of the mark—in fact, that in itself amounts to naked licensing. Similarly erroneous is Respondent’s argument that because “the use [of the mark] remained static . . . there was no need to unduly supervise.” First, Respondent would have had no way of knowing whether use of the mark remained static because Respondent has admitted that it had not been in contact with SGI and was unaware of the mark’s use. (Respondent’s Response to Petitioner’s Motion for Summary Judgment, at 3-4). Moreover, this argument misses the point— regardless of whether quality control supervision is needed when viewed through the lens of hindsight bias, the fact remains that the licensor retained throughout the term of the license a duty to exercise supervision and monitoring to avoid loss of trademark rights. Simply put, conduct that on its face amounts to naked licensing cannot be “cured” of being naked licensing just because it happens that the mark was, fortuitously, not misused during the period of licensor’s lack of supervision.

In conclusion, Petitioner requests that the Board decide the issue of naked licensing as a matter of law and conclude, based on Respondent’s contractual attempts to rid itself of its licensor duties and its actual conduct of failing to fulfill those duties, that Respondent engaged in naked licensing resulting in lost trademark rights.

CONCLUSION

Petitioner, O2Micro, respectfully requests that the Board GRANT Petitioner's Motion for Summary Judgment on all grounds raised therein, and grant such other further relief as it deems appropriate.

O2Micro International Limited

Dated: August 21, 2013

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CERTIFICATE OF SERVICE

It is hereby certified that a true and complete copy of the subject REPLY TO RESPONDENT'S OPPOSITION BRIEF TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT was served upon the Respondent via email, this 21st day of August, 2013 to the following address:

s.baker@br-tmlaw.com

By: /s/Teresa C. Tucker

Teresa C. Tucker