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

Proceeding	92062265
Party	Defendant Andrew Rothlein
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**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of
Trademark Registration Nos. 2879305, 4181171
Mark: ITV

ITV Rights Limited,
Petitioner,

vs.

Cancellation No. 92062265

Rothlein, Andrew, Registrant

MOTION FOR SUMMARY JUDGEMENT

In the interest of advancing forward the Cancellation proceeding No. 92062265 before the United States Patent and Trademark Office, Trademark Trial and Appeals Board, and because “there is no genuine issue of material fact and more evidence than is already available in connection with summary judgment motion could not reasonably be expected to change the result in the case” (TBMP 528.01), Andrew Rothlein (“Registrant”) requests the TTAB grant his Motion for Summary Judgment and deny the Petition for Cancellation against his mark. Registrant will use this forum to underscore the lack of basis for the Petitioner’s position, thereby seeking approval for the Motion and denial for the Petition. In an effort to address the known concerns of the Petitioner, ITV Rights Limited (“Petitioner”), Registrant will discuss in

this motion, the issues brought forth by the Petitioner in its Initial Disclosures statement, point by point and the issues anticipated to have been brought forth at later dates. Since according to the Petitioner's Initial Disclosures, many of the issues rely on information to be provided by the Registrant, it is he who is in the unique position of being able to provide that information to illuminate the facts.

BACKGROUND:

The contested mark is "ITV". Registrant has been using the mark in commerce since March 30, 2003. U.S. trademark registration was awarded in IC 42 on August 31, 2004 and in IC 41 on July 31, 2012. It is a provider of Internet content, as per its description of recited services.

The Petitioner is a going provider of television (and now Internet) content in the United Kingdom. Although it has been awarded trademark status in the UK (and possibly elsewhere), it has apparently been heretofore unsuccessful in securing trademark status in the United States that permits it to broadcast over the Internet. In that regard, Petitioner's application for registration of the contested mark, originally submitted on November 21, 2012, was issued a "Final Action" refusal on March 20, 2015 due to the likeliness of confusion with both of the Registrant's registrations. Its response to that office action was due on September 20, 2015. On September 16, 2015 it submitted a Petition for Cancellation against the Registrant's marks which had the effect of suspending the application process pending the outcome of its Petition.

The issues raised by the Petitioner in its Initial Disclosure Statement are hereby stated and addressed.

ISSUES RAISED

Petitioner contends that Registrant lacks a bona fide commercial use of the ITV mark on the services listed in the ITV registration.

In response, Registrant asks which of its services is not being used and has not been used commercially since March 30, 2003 with the mark clearly identified in conjunction with the

services? Is it among “Providing information online in the field of current events and entertainment online news reporting presentations News analysis and features distribution via the Internet News agencies, namely, gathering and dissemination of news via the Internet Providing entertainment services, namely, providing information and links to other websites in the fields of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images” or “Providing entertainment and educational services via the Internet or other communications networks, namely, providing non-downloadable virtual presentations of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images; providing information in the fields of current events, music, and sports; entertainment services, namely, providing non-downloadable information in the field of music, and commentary and articles about music; and providing information, news and commentary in the field of current events, historical events and people”? Registrant affirms that services, as stated in the “Answer to Cancellation Petition” of September 21, 2015 are and have been in continuous use since March 30, 2003. Relatedly, an interlocutory attorney of the TTAB ruled on September 30, 2009 in a Cancellation action brought by another litigant in an Opposition proceeding (91183879), where Registrant was the Opposer, that the litigant’s Motion for Leave to File an Amended Answer and Assert Counterclaim for Cancellation based essentially on non-use, was denied.

Petitioner questions the bona fide commercial use of the mark. Registrant can only describe the work put into its business to render it of bona fide commercial use. Firstly, the primary domain name of the mark (www.itv.bz), which has been procured by the Registrant and is renewed regularly, is registered with the web host under the corporate name, Pea TV, Inc. Pea TV, Inc. was incorporated on April 4, 2000 and is also the home of other segments of the Registrant’s business including www.PeasTV.com and www.PTV.bz. Not knowing to which business(es) the public would gravitate, Registrant has maintained similar or identical content on all three sites (all three have been awarded trademark registrations) with the kind of “PG” or “PG 13” features that are designed to reach a general customer base. Registrant understands and accepts that the market place will make the ultimate decision(s) regarding their acceptance, based on the various factors to which customers respond.

As might be expected in any business, the corporation has its own bank account, files tax returns, pays taxes (minimum in New York due to lack of revenues to date) and corporate fees. Other related domain names and a website maintained by the Registrant are: www.itv-itv.com and www.itvmundo.com, which point to the primary site, www.itv.bz; and www.itv125.com which points with masking to a secondary site, itself serving as another venue for public viewership. It is identified on the site with the iTV®, PTV® and Pea TV® marks and has also been the setting on which rotating advertisements are employed to direct viewers to the main sites. Viewers that log onto www.itv125.com or www.PTVPTV.com currently see, in addition to the extra web site content of iTV®, PTV® and Pea TV®, advertising for Registrant's primary ITV site, www.itv.bz.

Registrant also certifies that the web host account of www.itv.bz, Network Solutions, has been logged onto for monitoring, updating and adjusting at least ten times per week and generally more for the last three years and at least seven times per week for the last seven years. Although Registrant does not recall the frequency of log-ons prior to that, affirmation can be made that it was no less than four times per week. Among the Registrant's business responsibilities are procurement and renewal of all domain name, web host and USPTO pertinent services.

Further proof of the mark's business use is the fact that it is precisely because of its bona fide use in commerce that the Registrant is compelled to take the site down every week between sundown Friday and sundown Saturday and on religious holidays due to the prohibition on the Registrant of conducting business on those days.

Petitioner questioned the specimen's used in support of the ITV registration.

In support of the Registrant's registration and post registration requirements, specimens taken from the web sites of www.itv.bz and www.ptvptv.com were submitted to the USPTO.

Petitioner questioned the use of the domain names, www.itv.bz and www.ptvptv.com.

As explained above, with regard to the business of ITV, they are the primary and secondary web sites (www.itv.bz); and the advertising (www.ptvptv.com) forum for the primary site.

Petitioner questioned the alleged use of the ITV mark including the types of services actually offered.

Services actually offered under the mark are, as stated in the registrations' Description of Services, "Providing information online in the field of current events and entertainment online news reporting presentations News analysis and features distribution via the Internet News agencies, namely, gathering and dissemination of news via the Internet Providing entertainment services, namely, providing information and links to other websites in the fields of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images." and "Providing entertainment and educational services via the Internet or other communications networks, namely, providing non-downloadable virtual presentations of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images; providing information in the fields of current events, music, and sports; entertainment services, namely, providing non-downloadable information in the field of music, and commentary and articles about music; and providing information, news and commentary in the field of current events, historical events and people." Recited services are offered to the general public.

Petitioner questioned the dates of the provision of services offered under the ITV mark.

As stated in Registrant's "Answer to Cancellation Petition" recited services have been in continuous use, except for days of religious observances, since March 30, 2003. While the format of the services has changed with the advancement of technology (all text/graphics to some text/graphics, some video/audio), the nature of the services has remained the same.

Petitioner questioned the identity of and types of purchasers, if any, of services in connection with the ITV mark.

Registrant's web statistics do not provide information on the identity or types of viewers that favor and experience the services offered. What can be reported is the Registrant's opinion that the tiny but incrementally increasing quantity of viewers must be attracted to not having to sift through the content of much larger sites to find the news and "PG"/"PG 13" entertainment items they seek for information and/or entertainment. Registrant has been building a brand name for itself, one viewer at a time.

Petitioner questioned the channels of trade in which the ITV mark is and/or has been promoted, advertised or marketed.

As stated above, www.itv.bz is currently advertised on www.ptvptv.com.

Petitioner questioned the offering for sale, licensing, or other transfer of asserted rights in ITV as a mark or other business identifier.

In addition to making a brief, temporary offer to the Petitioner, during a time when Registrant was under the impression that litigation was to proceed no further, potential licensing has also been discussed with counsel from a prospective associate in the United States.

Petitioner questioned Registrant's communication with third parties regarding the sale, licensing or other transfer of asserted rights in ITV as a mark or other business identifier.

Other than stated above, the Registrant has held no formal talks with third party/parties in this regard but was asked casually at one point, by counsel for a media entity, about possible plans to sell part of the business to a third party. Registrant replied that there were no plans to do so.

Petitioner questioned the Registrant's policing of purported enforcement of rights in the ITV mark, including without limitation any demand letters or agreements related thereto, or any oppositions, cancellations or law suits filed or threatened.

The following is a partial list of efforts Registrant has made in that regard. It should be noted that the Registrant monitors www.USPTO.gov regularly.

January 13, 2012 serial no. 78877958 was abandoned after having been refused registration due to Registrant's mark, thereby obviating Registrant's need to oppose;

March 16, 2012 serial no. 85331200 was abandoned after having been refused registration due to likelihood of confusion with five marks, one of which was Registrant's, thereby obviating Registrant's need to oppose;

January 13, 2012 serial no. 78877958 was abandoned after applicant narrowed services due to outgoing office action in connection with Registrant's mark, thereby obviating Registrant's need to oppose; (On July 12, 2011, the examining attorney withdrew her objection to registration of the application based on Registrant's mark after the prospective recited services of the application were amended.)

June 8, 2011 serial nos. 85180453 and 85180355 were abandoned after an opposition petition brought by the Registrant;

August 15, 2011 serial no. 77201673 was abandoned after an opposition petition was brought by the Registrant.

CONCLUSION

Until he received the Discovery Conference correspondence from the Petitioner that included a Nature of Claims section, the Registrant was admittedly baffled by the allegation of abandonment against his business. Registrant knew that for years he had been diligent about keeping his business current for the viewing public on the Internet and that the services provided were in accord with those specified in the trademark filings. Noteworthy also is that

the attorneys to whom the Registrant brought the matter similarly found the allegation curious. The breakthrough came on February 8, 2016 by email when the Petitioner's Nature of Claims arrived. That section described the Registrant's web site citing a URL that had no connection to the business of the Registrant. Attached also was a screen shot that had been snapped from that URL, showing no content. The Petitioner had missed the correct web address by one letter but that was enough to have made it conceivable to believe Registrant's mark had been abandoned. Petitioner was immediately made aware of its error with the genuine presumption that withdrawal of its Petition with the information newly available would follow forthwith. The Petitioner elected instead, however, to pursue the course it had already commenced. It decided to conduct, according to its Initial Disclosures, ongoing "investigation, research and analysis of the issues".

That brings us to today and the action herewith. This Motion for Summary Judgment is designed to establish the futility of the allegations made against the Registrant by highlighting the multiple, long term facets of the bona fide commercial use of its mark. It was composed in a way that made sure to present too much information when given the option rather than just enough, as a means of showing the Board that, "more evidence than is already available in connection with summary judgment motion could not reasonably be expected to change the result in the case". In that light then, the Registrant hereby asks the Board to recognize the clear deficiency of the abandonment charge against it and to take the next consistent steps of granting its Motion for Summary Judgment and denying the Petition for Cancellation against its mark.

Respectfully submitted,

February 28, 2016

/Andrew Rothlein/
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PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing Motion for Summary Judgment has been served on Fenwick & West LLP by emailing said copy on February 28, 2016 to Connie Ellerbach at CEllerbach@Fenwick.com; Stephen Garcia at SRGarcia@Fenwick.com; Victoria Bocek at VBocek@Fenwick.com

/Andrew Rothlein/