

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

In the Matter of Application:

Serial No. : 79/028,778
Filed : December 28, 2005
Mark : MOBISTAX
Published : July 31, 2007

Telefonica, S.A.,)
Opposer,)
v.)
Forest Interactive Pty Limited,)
Applicant.)

Opposition No. 91178699



08-31-2007

ANSWER TO NOTICE OF OPPOSITION

U.S. Patent & TMO/TM Mail Rpt Dt #11

By its undersigned attorney, Applicant Forest Interactive Pty Limited hereby answers the hereinbelow repeated allegations of Opposer as follows:

1) Opposer is a world leader in the telecommunications, media and entertainment industries and is also involved in media and contact center activities.

Answer

Applicant is without knowledge or information sufficient to form a belief as to the truth of this averment.

2) Opposer has achieved registration in the USPO of the mark MOVISTAR for use in connection with goods and services falling into wide variety of International Classes.

Of particular relevance to this Notice of Opposition, Opposer has achieved registration of the MOVISTAR mark in connection with the following goods and services:

International Class 9 - SCIENTIFIC, NAUTICAL, SURVEYING, PHOTOGRAPHIC, CINEMATOGRAPHIC, OPTICAL, WEIGHING, MEASURING, SIGNALING, CHECKING, LIFE-SAVING AND TEACHING APPARATUS AND INSTRUMENTS, NAMELY, CAMERAS, DIGITAL CAMERAS, MOVIE CAMERAS, MOTION PICTURE CAMERAS, SCALES, TELESCOPES, MICROSCOPES, FIBER OPTICS; APPARATUS AND INSTRUMENTS FOR CONDUCTING, SWITCHING, TRANSFORMING, ACCUMULATING, REGULATING OR CONTROLLING ELECTRICITY, NAMELY, ELECTRICAL TRANSFORMERS, INTEGRATED CIRCUITS, BATTERIES, ELECTRIC WIRES, MICROCIRCUITS, CIRCUIT BOARDS, BATTERY CHARGERS; APPARATUS FOR RECORDING, TRANSMISSION OR REPRODUCTION OF SOUND OR IMAGES, NAMELY, TAPE RECORDERS, VIDEO AND AUDIO CASSETTE RECORDERS, CD-ROM AND DVD RECORDERS AND PLAYERS, PERSONAL STEREOS, MOVIE PROJECTORS, DIGITAL PROJECTORS, TELEVISIONS, RADIOS, PAGERS, REMOTE E-MAIL TRANSCEIVERS; BLANK MAGNETIC DATA CARRIERS AND RECORDING DISCS, PRERECORDED MAGNETIC DATA CARRIERS AND RECORDING DISCS FEATURING ENTERTAINMENT, NEWS, INSTRUCTION IN THE FIELDS OF ELECTRONIC EQUIPMENT, TELECOMMUNICATIONS, SPEECH, COMMUNICATION, DATA COMMUNICATION, INFORMATION IN THE FIELDS OF ELECTRONIC EQUIPMENT, TELECOMMUNICATIONS, SPEECH, COMMUNICATION, DATA COMMUNICATION, FICTION AND NON-FICTION WORKS IN A WIDE VARIETY OF SUBJECTS AND THE FIELDS OF ELECTRONIC EQUIPMENT, TELECOMMUNICATIONS, SPEECH, COMMUNICATION, DATA COMMUNICATION; AUTOMATIC VENDING MACHINES AND MECHANISMS FOR COIN-OPERATED VENDING APPARATUS; CASH REGISTERS, CALCULATORS; DATA PROCESSING EQUIPMENT, NAMELY, DATA STORAGE DEVICES, NAMELY, COMPUTER DISK DRIVES, OPTICAL DATA RECORDERS, ELECTROMAGNETIC DATA RECORDERS, NETWORK SERVERS; COMPUTER MONITORS AND DISPLAYS, MICROPROCESSORS, COMPUTER INPUT DEVICES, NAMELY, BAR CODE SCANNERS, MICE, TRACKBALLS, KEYBOARDS, SPEECH AND VIDEO RECOGNITION INPUTS, TOUCHPADS, MICROPHONES, OPTICAL IMAGING DEVICES. MAGNETICALLY ENCODED IDENTIFICATION CARDS, COMPUTER AND RECORDED COMPUTER PROGRAMS FOR TELECOMMUNICATION SERVICES, NAMELY FOR TRACKING USAGE OF TELECOMMUNICATION SERVICES AND DEVICES, BILLING TELECOMMUNICATION SERVICES, COMPARING TELECOMMUNICATIONS SERVICES AND DEVICES, OPERATION OF TELECOMMUNICATIONS SERVICES AND DEVICES, TO OPERATE TELECOMMUNICATIONS COMPUTER HARDWARE, TELECOMMUNICATIONS DEVICES AND NETWORK PERIPHERALS, TO PROVIDE REMOTE ACCESS TO TELECOMMUNICATIONS NETWORKS, AND TO MANAGE, DIRECT, ROUTE, TRANSMIT AND RECEIVE TELEPHONE CALLS, ELECTRONIC MESSAGES, AND AUDIO AND DATA SIGNALS OVER COMPUTER NETWORKS AND

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TELECOMMUNICATIONS ACCESS LINES; PRERECORDED MULTIMEDIA SOFTWARE FOR TELECOMMUNICATION SERVICES, NAMELY FOR TRACKING USAGE OF TELECOMMUNICATION SERVICES AND DEVICES, BILLING TELECOMMUNICATION SERVICES, COMPARING TELECOMMUNICATIONS SERVICES AND DEVICES, OPERATION OF TELECOMMUNICATIONS SERVICES AND DEVICES, TO OPERATE TELECOMMUNICATIONS COMPUTER HARDWARE, TELECOMMUNICATIONS DEVICES AND NETWORK PERIPHERALS, TO PROVIDE REMOTE ACCESS TO TELECOMMUNICATIONS NETWORKS, AND TO MANAGE, DIRECT, ROUTE, TRANSMIT AND RECEIVE TELEPHONE CALLS, ELECTRONIC MESSAGES, AND AUDIO AND DATA SIGNALS OVER COMPUTER NETWORKS AND TELECOMMUNICATIONS ACCESS LINES; COMPUTER PERIPHERAL DEVICES, NAMELY, MICE, KEYBOARDS, COMPUTER PRINTERS; FIRE EXTINGUISHERS; DIGITAL TELEPHONE SWITCHING EQUIPMENT AND PARTS THEREFOR, NAMELY, ROUTERS, SWITCHES FOR HOME AND OFFICE USE; DATA PROCESSING DEVICES, NAMELY COMPUTERS AND COMPUTER HARDWARE, MAGNETICALLY ENCODED IDENTIFICATION CARDS. COMPUTERS AND COMPUTER SOFTWARE WHICH FACILITATES SEARCH FOR AND TRANSFERRING INFORMATION ACROSS GLOBAL COMPUTER COMMUNICATION NETWORKS AND FOR THE EXECUTION OF BUSINESS TRANSACTIONS USING GLOBAL COMPUTER COMMUNICATION NETWORKS, COMPUTERS, SWITCHBOARDS, COMPUTER MONITORS, COMPUTER MODEMS, TELEVISIONS, COMPUTER KEYBOARDS AND MICE, TELEPHONE, TELEGRAPH, TELEPHONY AND MESSAGE TRANSMISSION AND RECEPTION DEVICES AND INSTRUMENTS, NAMELY, LAND-LINE TELEPHONES, ANSWERING MACHINES, RADIO TELEPHONES, FAX MACHINES, MOBILE TELEPHONES, AND PRIVATE BRANCH EXCHANGES FOR USE IN THE FIELD OF TELECOMMUNICATIONS, FOR HOME AND OFFICE USE, CELLULAR PHONE HOLDERS, PHONE BEEPER HOLDERS, CD STORAGE WALLETS, EYEGASS CASES, SPORTING HELMETS; (emphasis added)

International Class 16 - PRINTED MATTER, NAMELY, VISITOR'S CARDS, LEAFLETS, MAGAZINES, AND CATALOGS RELATING TO THE TELECOMMUNICATION INDUSTRY AND TELECOMMUNICATION PRODUCTS; (emphasis added)

International Class 25 - ARTICLES OF OUTER CLOTHING AND UNDERWEAR, NAMELY, SHIRTS, SHORTS, PANTS, SKIRTS, WIND-RESISTANT JACKETS, JACKETS, COATS, SWEATERS, VESTS, SOCKS, HOSIERY, SCARVES, TIES, BELTS, GLOVES, MITTENS, HATS, AND CAPS, WARM-UP SUITS, SWEATSHIRTS, SWEATPANTS, T-SHIRTS, POLO SHIRTS, GOLF SHIRTS, SPORT SHIRTS, KNIT SHIRTS, WOVEN SHIRTS, TANK TOPS, BATHING SUITS, TIGHTS, ROBES, NIGHT SHIRTS, NIGHTGOWNS, PAJAMAS, BLOUSES, DRESSES, ROMPERS, SPORT JERSEYS, ATHLETIC UNIFORMS, OVERALLS, UNDERWEAR, RAINWEAR, SLEEPWEAR, HEADWEAR; FOOTWEAR, NAMELY, ATHLETIC SHOES, SLIPPERS, BOOTS, SANDALS; INFANTS' CLOTHING, NAMELY, PRAMSUITS, SNOWSUITS, OVERALLS, COVERALLS, SNAP SIDE SHIRTS, PULLOVER SHIRTS, KNIT GOWNS, SWEATERS, CREEPERS, BUNTING BAGS, KNIT LEGGING SETS, SUN SUITS, SUN

DRESSES, PAJAMAS, SHIRTS, SHORTS, JACKETS, COATS, BATHING SUITS, SKIRTS, BLOUSES, DRESSES, ROMPERS, MITTENS, GLOVES, HOSIERY, SOCKS, TIGHTS, ROBES, SCARVES, TIES, SWEATSHIRTS, SWEATPANTS, KNIT SHIRTS, WOVEN SHIRTS, T-SHIRTS, POLO SHIRTS, TANK TOPS, VESTS, PANTS, UNDERWEAR, RAINWEAR, SLEEPWEAR), FOOTWEAR, HEADGEAR, NAMELY, HATS AND CAPS; (emphasis added) and

International Class 41 - ENTERTAINMENT SERVICES, NAMELY, PRODUCTION OF TELEVISION, RADIO, CABLE TELEVISION, CABLE RADIO PROGRAMS, MOTION PICTURES, COMEDY, MUSICAL AND DRAMATIC SERIES, DOCUMENTARIES, SPORTING EVENTS THAT WILL BE DELIVERED VIA TELEVISION, RADIO, CABLE TELEVISION, CABLE RADIO, SATELLITE AND THE INTERNET; MUSIC AND BOOK PUBLISHING SERVICES; EDUCATIONAL SERVICES, NAMELY TRAINING AND REINFORCEMENT OF TRAINING, THROUGH SEMINARS, MEETINGS, WORKSHOPS, AND INTERNET WEB SITE ACTIVITIES IN THE FIELDS OF ELECTRONIC EQUIPMENT, TELECOMMUNICATIONS, SPEECH, COMMUNICATION, DATA COMMUNICATION; CONDUCTING, ARRANGING AND ORGANIZING SPORTING, EDUCATIONAL, ENTERTAINMENT AND CULTURAL EVENTS IN THE FIELDS OF ELECTRONIC EQUIPMENT, TELECOMMUNICATIONS, SPEECH, COMMUNICATION, DATA COMMUNICATION. (emphasis added)

Answer

Applicant admits that MOVISTAR is registered in the United States, including registrations (numbers 2,790,337 and 2,930,460) which relate to the listed goods and services (subject to correction of any clerical errors in the included listing of goods and services which, as listed in this Answer, have been copied from the U.S. Patent and Trademark Office website). Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining averments of this paragraph.

3) Opposer's U.S. Registration No. 2,930,460 for the mark MOVISTAR was registered on March 8, 2005, and covers goods and services in International Classes 1-15, 17-34, and 36-41. A copy of the certified copy of this registration is attached hereto as

Exhibit A and shows the current status and title of the registration. Opposer's U.S. Registration No. 2,790,337 for the mark MOVISTAR was registered on December 9, 2003, and covers goods in International Class 16. A copy of the certified copy of this registration is attached hereto as Exhibit B and shows the current status and title of this registration. Collectively these registrations will be referred to as the "MOVISTAR Registrations".

Answer

Applicant admits that U.S. Registration Nos. 2,790,337 and 2,930,460 relate to MOVISTAR and were registered on the dates indicated and identify goods and services in the classes indicated, except that Applicant denies that U.S. Registration No. 2,930,460 includes goods in International Class 38. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining averments of this paragraph.

4) The MOVISTAR Registrations both have registration dates that predate the December 28, 2005, Section 66(a) priority filing date of the Applicant's application Serial No. 79/028,778 for the MOBISTAX mark.

Answer

Admitted.

5) The Applicant's application for the MOBISTAX mark covers:

International Class 9 - COMPUTER GAME SOFTWARE FOR COMMUNICATION DEVICES; COMPUTER GAME SOFTWARE AND PROGRAMS ENABLING USER TO PLAY GAMES WITH MOBILE PHONES; ELECTRONIC MULTIPLAYER AND MULTIUSER COMPUTER GAME PROGRAMS AND SOFTWARE; COMPUTER

SOFTWARE AND PROGRAMS ENABLING USERS OF COMMUNICATION DEVICES TO SIMULTANEOUSLY ACCESS DATABASES AND GLOBAL COMPUTER NETWORKS; SOFTWARE ENABLING TRANSFER OF DATA BETWEEN MOBILE COMMUNICATION APPARATUS;

International Class 16 - PAPER ARTICLES, NAMELY, PRINTED VISUALS IN THE NATURE OF PROMOTIONAL MATERIAL, PRINTED ADVERTISING SIGNS AND ADVERTISING INSERTS USED WITH FOLDERS AND BINDERS, NEWSLETTERS IN THE FIELD OF COMPUTER GAMES WHICH CAN BE PLAYED WITH MOBILE PHONES, ADVERTISING PAMPHLETS, POSTERS, STATIONERY, NOTE PADS, PRINTED PAPER SIGNS, BANNERS AND STICKERS;

International Class 25 - CLOTHING AND HEADGEAR, NAMELY CAPS AND T-SHIRTS;

International Class 41 - ENTERTAINMENT SERVICES, NAMELY, PROVIDING ON-LINE REVIEWS OF VIRTUAL REALITY GAMES; and

International Class 42 - COMPUTER PROGRAMMING SERVICES; SOFTWARE DESIGN AND CONSULTANCY SERVICES; INFORMATION TECHNOLOGY AND INTERNET CONSULTANCY SERVICES; DEVELOPMENT OF COMPUTER AND VIRTUAL GAMING PROGRAMS.

Answer

Admitted (subject to the correction of any clerical errors).

6) The MOBISTAX mark sought to be registered by Applicant is confusingly similar to Opposer's MOVISTAR mark for goods and services that are identical to and/or closely related to Opposer's goods and services.

Answer

Denied.

7) The MOBISTAX mark, when applied to the proposed goods and services of Applicant, so resembles Opposer's MOVISTAR marks as to be likely to cause confusion,

or to cause mistake, or to deceive, all to Opposer's irreparable damage and injury within the meaning of Section 2(d) of the Trademark Act.

Answer

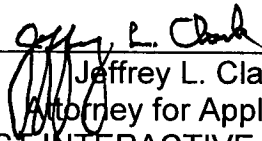
Denied.

WHEREFORE, Applicant prays that this opposition be dismissed and that a registration issue for Applicant's MOBISTAX trademark.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By _____



Jeffrey L. Clark

Attorney for Applicant,

FOREST INTERACTIVE PTY LIMITED

August 29, 2007

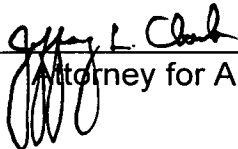
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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** was served on counsel for Opposer by placing a copy of the same in the United States Mail, postage prepaid, first class, addressed to:

Sean S. Swidler
Dermot J. Horgan
IpHorgan, Ltd.
1130 W. Lake Cook Road, Suite 240
Buffalo Grove, IL 60089

on this 29th day of August, 2007.



Attorney for Applicant