

ESTTA Tracking number: **ESTTA187148**

Filing date: **01/16/2008**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	The DIRECTV Group, Inc.
Granted to Date of previous extension	01/16/2008
Address	2250 East Imperial Highway El Segundo, CA 90245-0956 UNITED STATES
Party who filed Extension of time to oppose	Digital Networks North America, Inc.
Relationship to party who filed Extension of time to oppose	Digital Networks North America, Inc. has assigned all trademarks, and related goodwill and business, at issue to The DIRECTV Group, Inc., as evidenced by the assignment recorded in the U.S. Patent and Trademark Office at Reel/ Frame 3697/0575. The extension was filed prior to the assignment. As such, the extension was made for the benefit of the owner of the trademarks, who is now The DIRECTV Group, Inc.

Attorney information	Caroline L. Keller Pillsbury Winthrop Shaw Pittman LLP 725 South Figueroa Street Suite 2800 Los Angeles, CA 90017 UNITED STATES la-tmdocketing@pillsburylaw.com, cwblair@directv.com, tsuzuki@directv.com Phone:213-488-7100
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**Applicant Information**

Application No	77135858	Publication date	09/18/2007
Opposition Filing Date	01/16/2008	Opposition Period Ends	01/16/2008
Applicant	Applian Technologies 20 Vineyard Avenue San Anselmo, CA 94960 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. First Use: 2006/06/03 First Use In Commerce: 2006/06/03 All goods and services in the class are opposed, namely: Downloadable software for converting audio and video files to other formats
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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Dilution	Trademark Act section 43(c)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2402559	Application Date	08/06/1998
Registration Date	11/07/2000	Foreign Priority Date	NONE
Word Mark	REPLAYTV		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1999/04/19 First Use In Commerce: 1999/04/19 Units attached to television sets which can be programmed to record specific television programs or search for programs that meet pre-programmed criteria, record such programs digitally and play them back on demand		

U.S. Registration No.	2879475	Application Date	07/26/2003
Registration Date	08/31/2004	Foreign Priority Date	NONE
Word Mark	MY R REPLAYTV		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2000/11/00 First Use In Commerce: 2000/11/00 Via an on-line network, providing personalized, interactive information regarding television programs for use by consumers, and providing information regarding television programs which can be used to control programmable digital television recording and playback devices		

U.S. Registration No.	2865216	Application Date	07/26/2003
Registration Date	07/20/2004	Foreign Priority Date	NONE
Word Mark	MYREPLAYTV		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2000/11/00 First Use In Commerce: 2000/11/00 Via an on-line network, providing personalized, interactive information regarding television programs for use by consumers, and providing information regarding television programs which can be used to control programmable digital television recording and playback devices		

U.S. Registration No.	3006092	Application Date	03/02/2000
Registration Date	10/11/2005	Foreign Priority Date	NONE
Word Mark	R REPLAYTV		
Design Mark			

Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 2001/10/00 First Use In Commerce: 2001/10/00 UNITS, NAMELY PERSONAL VIDEO RECORDERS ATTACHED TO TELEVISION SETS WHICH CAN BE PROGRAMMED TO RECORD SPECIFIC TELEVISION PROGRAMS, OR SEARCH FOR FILMED ENTERTAINMENT PROGRAMMING THAT MEET PRE-PROGRAMMED CRITERIA, RECORD SUCH FILMED ENTERTAINMENT DIGITALLY AND ALLOW THE VIEWER TO VIEW THEM ON DEMAND WITH ALL GOODS</p> <p>Class 038. First use: First Use: 2001/10/00 First Use In Commerce: 2001/10/00 TRANSMISSION SERVICES IN THE NATURE PROVIDING PERSONALIZED AND INTERACTIVE TELEVISION VIEWING, PROGRAMMING AND RECORDING SERVICES, AND PROVIDING TELEVISION PROGRAMMING INFORMATION ACCESS FOR USE WITH PROGRAMMABLE DIGITAL TELEVISION RECORDING AND PLAYBACK DEVICE</p>

U.S. Registration No.	2481355	Application Date	05/10/1999
Registration Date	08/28/2001	Foreign Priority Date	NONE
Word Mark	REPLAY		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1999/04/20 First Use In Commerce: 1999/04/20 Units attached to television sets which can be programmed to record specific television programs or search for programs that meet pre-programmed criteria, record such programs digitally and play them back on demand</p>		

U.S. Registration No.	3011668	Application Date	09/17/1999
Registration Date	11/01/2005	Foreign Priority Date	NONE
Word Mark	REPLAY ZONE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2000/12/31 First Use In Commerce: 2000/12/31 units attached to television sets which can be programmed to record specific television programs or search for programs that meet pre-programmed criteria, record such programs digitally and play them back on demand</p> <p>Class 038. First use: First Use: 2000/12/31 First Use In Commerce: 2000/12/31 providing interactive television viewing, recording and transmission services, and providing access to television programming information for use with a programmable digital television recording and playback device, and providing user access to the global computer network to enable e-commerce</p>		

U.S. Application No.	77176574	Application Date	05/09/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	REPLAYTV		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1999/04/19 First Use In Commerce: 1999/04/19 software for recording specific television programs, searching for television programs and recording such television programs, storing the recorded programs, and playing the recorded programs back on demand

Related Proceedings	Related oppositions concurrently filed for serial numbers 77/135,827 and 77/135,723
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Attachments	75531929#TMSN.gif ( 1 page )( bytes ) 78279293#TMSN.gif ( 1 page )( bytes ) 75933285#TMSN.jpeg ( 1 page )( bytes ) 75701971#TMSN.gif ( 1 page )( bytes ) 75802131#TMSN.gif ( 1 page )( bytes ) 77176574#TMSN.jpeg ( 1 page )( bytes ) replayconv_Page_01.tiff ( 1 page )(0 bytes ) replayconv_Page_02.tiff ( 1 page )(0 bytes ) replayconv_Page_03.tiff ( 1 page )(0 bytes ) replayconv_Page_04.tiff ( 1 page )(0 bytes ) replayconv_Page_05.tiff ( 1 page )(0 bytes ) replayconv_Page_06.tiff ( 1 page )(0 bytes ) replayconv_Page_07.tiff ( 1 page )(0 bytes ) replayconv_Page_08.tiff ( 1 page )(0 bytes ) replayconv_Page_09.tiff ( 1 page )(0 bytes ) replayconv_Page_10.tiff ( 1 page )(0 bytes ) replayconv_Page_11.tiff ( 1 page )(0 bytes ) replayconv_Page_12.tiff ( 1 page )(0 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/clk/
Name	Caroline L. Keller
Date	01/16/2008



As grounds for opposition, Opposer, by its attorneys, alleges as follows:

1. Opposer owns the trade names and marks REPLAYTV, REPLAY ZONE and REPLAY and variations thereof (the “Opposer’s Marks”) for and in connection with a variety of goods and services, including software for recording and playing television programs, providing interactive television viewing, recording and transmission services, providing user access to the global computer network to enable e-commerce, and units attached to television sets which can be programmed to record and play back on demand television programs (the “Opposer’s Goods”).

2. Opposer, in conjunction with its predecessors in interest, has continuously used and is using in commerce the trade names and marks REPLAYTV and REPLAY since at least as early as 1999 and the trade name and mark REPLAY ZONE at least as early as 2000 in connection with the Opposer’s Goods.

3. Opposer owns a number of registrations for and including the marks REPLAYTV, REPLAY ZONE and REPLAY, including U.S. Trademark Registrations No. 2,402,559, 2,879,475, 2,865,216, 3,006,092, 2,481,355 and 3,011,668 which were assigned to Opposer by previous owner Digital Networks North America, Inc. as evidenced in the assignment documents attached as Exhibit A.

4. Opposer owns pending trademark application Serial No. 77/176,574 (the “Pending REPLAYTV Application”) for registration of the mark REPLAYTV for “software for recording specific television programs, searching for television programs and recording such television programs, storing the recorded programs, and playing the recorded programs back on demand” in International Class 9 (the “Pending REPLAYTV Application Goods”), which was assigned to Opposer by previous owner Digital

Networks North America, Inc. as evidenced in the assignment documents attached as Exhibit A. The REPLAYTV trademark has been used in commerce by Opposer and/or its predecessors in interest in connection with the Pending REPLAYTV Application Goods since at least as early as April 19, 1999.

5. Opposer and its predecessors in interest have provided the Opposer's Goods under the Opposer's Marks throughout the United States. As a result of the high quality of the Opposer's Goods and the extensive promotion and public acceptance thereof, Opposer and its predecessors in interest have gained significant and valuable goodwill in the Opposer's Marks.

6. The public recognizes the Opposer's Marks to identify the Opposer's Goods and to distinguish them from the goods and services of others. The Opposer's Marks function as indicators of origin of the Opposer's Goods, and as such, are the exclusive property right of Opposer.

7. On March 20, 2007, Applicant submitted application Serial No. 77/135,858 to the United States Patent and Trademark Office for the mark REPLAY CONVERTER, in connection with "Downloadable software for recording online audio and video files" in International Class 9.

8. On September 18, 2007, application Serial No. 77/135,858 was published for opposition.

9. Applicant submitted a date of first use of December 30, 2005 and a date of first use in commerce of December 30, 2005 in connection with application Serial No. 77/135,858.

10. The Opposer's Marks, including the mark REPLAYTV set forth in the Pending REPLAYTV Application, were first used in commerce prior to any actual use or constructive use of the mark REPLAY CONVERTER, set forth in application Serial No. 77/135,858.

11. Opposer will be damaged by the registration of the mark REPLAY CONVERTER, as set forth in application Serial No. 77/135,858, in that the mark so resembles the Opposer's Marks as to be likely, when applied to the goods of Applicant, to cause confusion, mistake, and deception, with consequent irreparable damages to Opposer's business and goodwill and otherwise will improperly give the appearance of exclusive statutory ownership rights in marks incorporating the Opposer's Marks to Applicant in violation of § 2(d) of the Lanham Act, as amended (15 U.S.C. § 1052(d)), and derogation of the prior and superior rights of Opposer.

12. Opposer also will be damaged by the registration of the mark REPLAY CONVERTER, as set forth in application Serial No. 77/135,858, in that said mark will dilute the Opposer's Marks in violation of § 43(c) of the Lanham Act (15 U.S.C. § 1125(c)).

13. By reason of the foregoing, Opposer believes it will be irreparably damaged by the registration of the REPLAY CONVERTER mark as set forth in application Serial No. 77/135,858.

14. Registration should, therefore, be refused pursuant to § 2(d) of the Lanham Act. (15 U.S.C. § 1052(d)), on the grounds that the application to register REPLAY CONVERTER, application Serial No. 77/135,858, so resembles Opposer's Marks as to cause confusion, mistake or deception and under § 43 (c) of the Lanham Act

(15 U.S.C. § 1152(c)), and on grounds that said application dilutes the value of the Opposer's Marks.

WHEREFORE, Opposer requests that this opposition be sustained and that the application by Applicant to register the mark REPLAY CONVERTER, application Serial No. 77/135,858, be refused.

Opposer will submit payment with the online filing of the Notice, pursuant to 37 C.F.R. § 2.6(a)(7), in an amount totaling three hundred dollars (\$300.00) in payment of the requisite fee for filing this Notice of Opposition against the application. Please charge any additional amounts to the undersigned Attorney's Deposit Account No. 03-3975.

Respectfully submitted,



By: Caroline L. Keller  
Pillsbury Winthrop Shaw Pittman LLP  
725 South Figueroa Street, Suite 2800  
Los Angeles, California 90017-5406  
(213) 488-7100

Dated: Los Angeles, California  
January 16, 2008

Attorney for Opposer  
DIRECTV, Inc.

**EXHIBIT A**

**CORRECTED TRADEMARK ASSIGNMENT**

Whereby on December 12, 2007 Digital Networks North America, Inc. (hereinafter the Assignor) assigned to The DirecTV Group, Inc. (hereinafter the Assignee) a number of trademark registrations and applications in a Trademark Assignment (hereinafter the Original Assignment), and

Whereby Assignor and Assignee desire to correct the listing of trademarks which were assigned;

Now, therefore, in consideration of One Dollar (\$1.00) and other good and valuable consideration in hand paid, the receipt and sufficiency of which are hereby acknowledged,

**Digital Networks North America, Inc.**

(hereinafter the Assignor) agrees that Assignor assigned and hereby does assign, transfer and set over to

**The DirecTV Group, Inc.**

(hereinafter the Assignee) effective as of December 12, 2007, the date of the Original Assignment, its entire right, title and interest in and to the Trademarks throughout the world that are listed on the attached Schedule 1, as well as the associated Trademark Registrations and Applications for Registration listed in the appended Schedule 1, together with all of the goodwill associated with, and symbolized by, the Trademarks, to have and to hold forever for the sole and exclusive use and benefit of Assignee and its assigns. The interests transferred by Assignor to Assignee include all common law rights associated with the Trademarks by virtue of their use in commerce, including all rights to sue and recover for past infringement of the trademarks, and also including all renewals of the listed Registrations or of any Registrations resulting from the listed Applications for Registration.

This Agreement may be executed in one or more counterparts for the convenience of the parties hereto, all of which together will constitute one and the same instrument. Facsimile transmission of any signed original document, and retransmission of any facsimile transmission, shall be the same as delivery of any original document. At the request of any party, the other parties will confirm facsimile transmitted signatures by signing an original document.

[Signature page follows]

Assignor  
Digital Networks North America, Inc.

Signature: David Meisels

Name: David Meisels

Title: General Counsel

Date: 1/15/08

Assignee  
The DirecTV Group, Inc.

Signature: Keith U. Lanam

Name: Keith U. Lanam

Title: Senior Vice President

Date: JANUARY 15, 2008

THIS IS THE SIGNATURE PAGE TO TRADEMARK ASSIGNMENT

SCHEDULE 1

ReplayTV Trademark List

#	Country	Application No.	Filing Date	Reg. No.	Reg. Date	Mark Name
1	Austria	AM5104/2001	3/23/1999	203200	4/17/2002	REPLAYTV
2	Benelux	112194	3/23/1999	200233	11/1/2002	REPLAYTV
3	Canada	1007602	3/5/1999	558401	2/25/2002	REPLAYTV
4	France	13124892	3/23/1999	13124892	3/15/2002	REPLAYTV
5	Italy	RM2002C002437	3/23/1999			REPLAYTV
6	Japan	23107/99	3/17/1999	4453936	2/16/2001	REPLAYTV
7	Portugal	358777	9/14/2001			REPLAYTV
8	US	75/531929	8/6/1998	2402559	11/7/2000	REPLAYTV
9	US	78/279293	7/26/2003	2879475	8/31/2004	MY (R) REPLAYTV (AND DESIGN)
10	US	78/279290	7/26/2003	2865216	7/20/2004	MYREPLAYTV
11	US	75/701968	5/10/1999	2338455	4/4/2000	QUICKSKIP
12	US	75/933285	3/2/2000	3006092	10/11/2005	R REPLAYTV (AND DESIGN)
13	US	75/701971	5/10/1999	2481355	8/28/2001	REPLAY (AND DESIGN)
14	US	75/802131	9/17/1999	3011668	11/1/2005	REPLAY ZONE
15	US	77/176574	5/9/2007			REPLAYTV



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*Electronic Trademark Assignment System*

## Confirmation Receipt

Your assignment has been received by the USPTO.  
The coversheet of the assignment is displayed below:

<b>TRADEMARK ASSIGNMENT</b>
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Electronic Version v1.1  
Stylesheet Version v1.1

<b>SUBMISSION TYPE:</b>	NEW ASSIGNMENT		
<b>NATURE OF CONVEYANCE:</b>	NUNC PRO TUNC ASSIGNMENT		
<b>EFFECTIVE DATE:</b>	12/12/2007		
<b>CONVEYING PARTY DATA</b>			
<b>Name</b>	<b>Formerly</b>	<b>Execution Date</b>	<b>Entity Type</b>
Digital Networks North America, Inc.		01/15/2008	CORPORATION: DELAWARE
<b>RECEIVING PARTY DATA</b>			
<b>Name:</b>	The DIRECTV Group, Inc.		
<b>Street Address:</b>	2230 East Imperial Hwy		
<b>City:</b>	El Segundo		
<b>State/Country:</b>	CALIFORNIA		
<b>Postal Code:</b>	90245		
<b>Entity Type:</b>	CORPORATION: DELAWARE		
<b>PROPERTY NUMBERS Total: 8</b>			
<b>Property Type</b>	<b>Number</b>	<b>Word Mark</b>	
<b>Serial Number:</b>	77176574	REPLAYTV	
<b>Registration Number:</b>	3011668	REPLAY ZONE	
<b>Registration</b>	2481355	REPLAY	

<b>Number:</b>		
<b>Registration Number:</b>	3006092	R REPLAYTV
<b>Registration Number:</b>	2338455	QUICKSKIP
<b>Registration Number:</b>	2865216	MYREPLAYTV
<b>Registration Number:</b>	2879475	MY R REPLAYTV
<b>Registration Number:</b>	2402559	REPLAYTV

  

<b>CORRESPONDENCE DATA</b>	
<b>Fax Number:</b>	(310)964-4884
<i>Correspondence will be sent via US Mail when the fax attempt is unsuccessful.</i>	
<b>Email:</b>	tsuzuki@directv.com
<b>Correspondent Name:</b>	Takehiko Suzuki
<b>Address Line 1:</b>	2230 East Imperial Hwy
<b>Address Line 4:</b>	El Segundo, CALIFORNIA 90245

  

<b>NAME OF SUBMITTER:</b>	Caroline Keller, Attorney of Assignee
<b>Signature:</b>	/clk/
<b>Date:</b>	01/16/2008

  

<b>Total Attachments: 3</b> source=REPLAYTV - TM Assignment#page1.tif source=REPLAYTV - TM Assignment#page2.tif source=REPLAYTV - TM Assignment#page3.tif
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<b>RECEIPT INFORMATION</b>	
<b>ETAS ID:</b>	TM104728
<b>Receipt Date:</b>	01/16/2008
<b>Fee Amount:</b>	\$215

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**CERTIFICATE OF SERVICE**

Opposition No. \_\_\_\_\_; Serial No. 77/135858

I hereby certify that a true and copy of the foregoing **Notice of Opposition** has been served on Applian Technologies by mailing said copy on January 16, 2008 via United States First Class Mail, postage prepaid, to:

Applian Technologies  
Attn: Legal Department  
20 Vineyard Ave  
San Anselmo, CA 94960-2917

  
\_\_\_\_\_  
Margaret Garcia