

ESTTA Tracking number: **ESTTA310601**

Filing date: **10/08/2009**

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

Proceeding	91191724
Party	Defendant XM Satellite Radio Inc.
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Signature	/Nancy Lapidus/
Date	10/08/2009
Attachments	Shokrola v. XM.Answer.AffDef.CCL.pdf (7 pages)(257564 bytes)

Registration Subject to the filing

Registration No	3153229	Registration date	10/10/2006
Registrant	SHOKROLA, GEORGE 11414 THURSTON CIRCLE LOS ANGELES, CA 90049 UNITED STATES		

Goods/Services Subject to the filing

<p>Class 009. First Use: 1997/01/01 First Use In Commerce: 1997/01/01 All goods and services in the class are requested, namely: Computer accessories, namely, computer hardware; video game software, video game accessories, namely game consoles and electronic gaming consoles; blank DVD's and CD-ROM's for sound or video recording; digital cameras; headphones, audio speakers; television sets; computer monitors; VCR players; CD changer; cellular telephone; cellular accessories, namely, cell phone battery chargers, earphones; wireless accessories, namely, wireless earphones; computer devices, namely, computer storage jump drives, biometric security software, digital computer input scanner, USB hardware, printers, visual display unit, modems, and computer storage software; electronic computer mouse; MP3 and MP4 players, namely, media players; flash drives; flash memory card; USB flash drives; and memory cards</p>
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

GEORGE SHOKROLA)
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 Opposer)
)
 v.) Opposition No. 91191724
)
 XM SATELLITE RADIO INC.)
)
 Applicant)

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION,
AFFIRMATIVE DEFENSES AND COUNTERCLAIMS

Applicant, XM Satellite Radio Inc., responds to the grounds for opposition set forth in the Notice of Opposition filed by Opposer George Shokrola as follows:

1. Answering the allegations in ¶ 1 of the Notice of Opposition, Applicant admits that it filed an application seeking registration of the mark XM MP3 & Design for "digital audio radio receivers, parts and accessories, namely, headphones, remote controllers, adapter kits comprising an antenna, DC power adapter and cable used for connecting the receiver to car audio apparatus, and adapter kits comprising an antenna, AC power adapter and cable used for connecting the receiver to home audio apparatus," in International Class 9, on August 4, 2008, based on Applicant's bona fide intent to use that mark in interstate commerce, which was assigned Serial No. 77/537,996. Except as thus stated, Applicant denies the allegations of ¶ 1 of the Notice of Opposition.

2. Applicant admits the allegation in ¶ 2 of the Notice of Opposition.

3. Applicant denies the allegation in ¶ 3 of the Notice of Opposition.

4. Answering the allegations in ¶ 4 of the Notice of Opposition, Applicant admits that Application Serial No. 77/537,996 was published for opposition on March 3, 2009 and that Opposer filed requests for extension of time to oppose Application Serial No.

77/537,996. Except as thus stated, Applicant denies the allegations in ¶ 4 of the Notice of Opposition.

5. Answering the allegations in ¶ 5 of the Notice of Opposition, Applicant admits only that the U.S. Patent and Trademark Office record for U.S. Registration No. 3,153,229 states as follows: the filing date of the application that matured to U.S. Registration No. 3,153,229 is April 24, 2005; the applicant identified in U.S. Registration No. 3,153,229 claimed first use of said mark as of January 1, 1997; the current description of goods in U.S. Registration No. 3,153,229 reads as follows: "Computer accessories, namely, computer hardware; video game software, video game accessories, namely game consoles and electronic gaming consoles; blank DVD's and CD-ROM's for sound or video recording; digital cameras; headphones, audio speakers; television sets; computer monitors; VCR players; CD changer; cellular telephone; cellular accessories, namely, cell phone battery chargers, earphones; wireless accessories, namely, wireless earphones; computer devices, namely, computer storage jump drives, biometric security software, digital computer input scanner, USB hardware, printers, visual display unit, modems, and computer storage software; electronic computer mouse; MP3 and MP4 players, namely, media players; flash drives; flash memory card; USB flash drives; and memory cards," in International Class 9; and Registration No. 3,153,229 issued October 10, 2006. Except as thus stated, Applicant denies the allegations in ¶ 5 of the Notice of Opposition.

6. Answering the allegations in ¶ 6 of the Notice of Opposition, Applicant denies that the mark shown in Registration No. 3,153,229 is currently in use in interstate commerce for all goods listed in Registration No. 3,153,229. Except as thus stated, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 6 of the Notice of Opposition and therefore denies same.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 7 of the Notice of Opposition and therefore denies same.

8. Answering the allegations in ¶ 8 of the Notice of Opposition, Applicant admits that the August 4, 2008 filing date of U.S. Application No. 77/537,996 is subsequent to: (a) the filing date set forth in the U.S. Patent and Trademark Office record for the application that matured to Registration No. 3,153,229, and (b) the registration date set forth in the U.S. Patent and Trademark Office record for Registration No. 3,153,229. Except as thus stated, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 8 of the Notice of Opposition and therefore denies same.

9. Answering the allegations in ¶ 9 of the Notice of Opposition, Applicant admits that the date of first use of the mark shown in Application No. 77/537,996 is subsequent to: (a) the filing date set forth in the U.S. Patent and Trademark Office record for the application that matured to Registration No. 3,153,229, and (b) the registration date set forth in the U.S. Patent and Trademark Office record for Registration No. 3,153,229. Except as thus stated, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 9 of the Notice of Opposition and therefore denies same.

10. Applicant denies the allegations in ¶ 10 of the Notice of Opposition.

11. No responsive pleading is required to the portions of ¶ 11 of the Notice of Opposition which assert legal conclusions rather than an allegation of fact. Except as thus stated, Applicant denies the allegations in ¶ 11 of the Notice of Opposition.

12. No responsive pleading is required to the portions of ¶ 12 of the Notice of Opposition which assert legal conclusions rather than an allegation of fact. Except as thus stated, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 12 of the Notice of Opposition and therefore denies same.

13. No responsive pleading is required to the portions of ¶ 13 of the Notice of Opposition which assert legal conclusions rather than an allegation of fact. Except as thus stated, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 13 of the Notice of Opposition and therefore denies same.

14. No responsive pleading is required to the erroneous legal conclusion in ¶ 14 of the Notice of Opposition that registration of the mark shown in the opposed application is likely to cause confusion. Except as thus stated, Applicant denies the allegations in ¶ 14 of the Notice of Opposition.

15. Applicant denies the allegations in ¶ 15 of the Notice of Opposition.

16. Applicant expressly denies any and all allegations in the Notice of Opposition not expressly admitted above.

FIRST AFFIRMATIVE DEFENSE

17. Opposer has abandoned its rights in the mark shown in Registration No. 3,153,229 and is precluded from opposing Application Serial No 77/537,996.

18. Applicant reserves the right to move for leave to assert any additional affirmative defense(s) subsequently disclosed by discovery in this proceeding, further case investigation or otherwise.

COUNTERCLAIM FOR CANCELLATION OF REGISTRATION NO. 3,153,229

19. Opposer asserts ownership of Registration No. 3,153,229 of the mark XMMICRO for “computer accessories, namely, computer hardware; video game software, video game accessories, namely game consoles and electronic gaming consoles; blank DVD's and CD-ROM's for sound or video recording; digital cameras; headphones, audio speakers; television sets; computer monitors; VCR players; CD changer; cellular telephone; cellular accessories, namely, cell phone battery chargers, earphones; wireless accessories, namely, wireless earphones; computer devices, namely, computer storage jump drives,

biometric security software, digital computer input scanner, USB hardware, printers, visual display unit, modems, and computer storage software; electronic computer mouse; MP3 and MP4 players, namely, media players; flash drives; flash memory card; USB flash drives; and memory cards,” in International Class 9, which issued on October 10, 2006.

20. On August 31, 2009, Opposer filed a Notice of Opposition against Application Serial No. 77/537,996, asserting likelihood of confusion based on Registration No. 3,153,229.

21. On information and belief, Opposer has discontinued use of the mark shown in Registration No. 3,153,229 in connection with all of the goods listed therein with no intent to resume use of said mark for said goods.

22. On information and belief, Opposer has thus abandoned its rights in the mark XMMICRO for the goods listed in Registration No. 3,153,229 within the meaning of Section 45 of the Lanham Act, 15 U.S.C. § 1127.

23. Accordingly, Registration No. 3,153,229 is invalid as a matter of law and subject to cancellation pursuant to Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3).

24. For the reasons set forth above, Applicant is being damaged by the continued existence of Registration No. 3,153,229.

25. Applicant reserves the right to move for leave to assert any additional counterclaim(s) subsequently disclosed by discovery in this proceeding, further case investigation or otherwise.

WHEREFORE, Applicant prays that the Notice of Opposition be dismissed in its entirety with prejudice and judgment be entered cancelling Registration No. 3,153,229.

The Commissioner for Trademarks is authorized to deduct the necessary filing fees for this counterclaim for cancellation from Howrey LLP Deposit Account No. 08-3038.

Respectfully submitted,

XM SATELLITE RADIO INC.

Date: October 8, 2009

By: *Nancy Lapidus*

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CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing Applicant's Answer to Notice of Opposition, Affirmative Defenses and Counterclaims was served on the following counsel for Opposer via United States mail, first class, postage prepaid, this 8th day of October, 2009:

Marc E. Hankin
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Los Angeles, CA 90049-2435

Nancy Lapidus