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

Proceeding	91209226
Party	Plaintiff Premier Systems USA, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

)	Opposition No.: 91209226 (parent)
PREMIER SYSTEMS USA, INC.)	
a California corporation,)	
Opposer/Counterclaim Registrant,)	
)	
v.)	
)	
DISH NETWORK L.L.C.)	
A Colorado limited liability company,)	
Applicant/Counterclaim Petitioner.)	

REPLY BRIEF IN SUPPORT OF OPPOSER’S MOTION FOR SUMMARY JUDGMENT

Opposer Premier Systems USA, Inc. submits this reply brief in support of its Motion for Summary Judgment to dismiss Applicant’s counterclaim, which requests that the Board narrow the goods in Opposer’s registrations. For the counterclaim to succeed, Applicant must prove that (1) the restriction requested would avoid a likelihood of confusion, and (2) Opposer is not using its mark on all the identified goods. *Eurostar Inc. v. “Euro-Star” Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (T.T.A.B. 1994). The counterclaim cannot succeed because there is no factual dispute relating to whether Opposer is using its mark on all the goods identified in the registrations. Furthermore, Applicant has submitted no relevant evidence that the requested restriction of goods would have any impact on the likelihood of confusion analysis.

I. OPPOSER’S OLLOCLIP® MARK IS IN USE WITH ALL GOODS IDENTIFIED IN ITS FEDERAL REGISTRATIONS

The evidence submitted in this matter proves that there is no genuine dispute as to any material fact regarding Opposer’s use of its OLLOCLIP® mark in connection with the goods identified in Opposer’s registrations. Applicant has provided no evidence to the contrary to support its counterclaim. *See Enbridge Inc. v. Excelebrate Energy LP*, 92 U.S.P.Q.2d 1537, 1540

(TTAB 2009) (“burden shifts to nonmoving party to demonstrate existence of issues of material fact” and nonmoving party “must proffer countering evidence . . . showing that there is a genuine factual dispute for trial.”)

A. Cameras Are Incorporated in Electronic Mobile Devices

In the goods identified in Opposer’s U.S. Reg. No. 4137064, the second phrase reads “*lenses for cameras incorporated in mobile electronic devices.*” A plain reading of the phrase conveys to the reader that the “cameras” are incorporated in the mobile electronic devices. Furthermore, the first phrase in the description of goods, “*lenses for cameras,*” also leads the reader to understand that the second phrase set forth in the goods, a subset of the first phrase, refers to “cameras” incorporated in the electronic mobile devices.

Applicant, in an attempt to manufacture a disputed fact, misconstrues the phrase “*lenses for cameras incorporated in mobile electronic devices*” by asserting that the phrase means that Opposer’s lenses are incorporated in the mobile electronic devices. (See Applicant’s Response, at 3 (second bullet point) & 11, § V(A)(2)) The description of goods in Opposer’s OLLOCLIP® registration, however, does not state that the lenses are incorporated in mobile electronic devices. Opposer’s lenses are for cameras, and there is no genuine dispute as to any material fact regarding Opposer’s use of the OLLOCLIP® mark for lenses.

B. The Word “Cameras” Includes All Types of Cameras

Opposer’s OLLOCLIP-branded lenses are for use with cameras. The word “camera” is defined as “a usually portable device containing a photosensitive surface that records images through a lens.” (Second Declaration of Gregory B. Phillips, Ex. A) Based on the evidence submitted, as well as everyday common sense knowledge, it is undisputed that mobile electronic devices, including the iPhone, Galaxy, iPad, and iPod Touch devices contain a camera.

Furthermore, in reviewing the description of goods in a trademark application, the PTO accepts broad terms for products. T.M.E.P. § 1402.03. “As long as a broad term identifies the goods or services that are intended to be covered with reasonable certainty, it will be reasonable, from a commercial viewpoint, to consider that the mark has been used for all the related goods or services that fall in the designated group.” *Id.* (citations omitted). Furthermore, “[w]hen a mark is used on a number of items that make up a homogeneous group, a term that identifies the group as a whole would be understood as encompassing products of the same general type that are commercially related.” *Id.* (citations omitted). It is an accepted and common practice in drafting the description of goods to first list a phrase that is the general product category, and then list a phrase that identifies specific goods within the general product category. *See Tri-Star Mktg., LLC v. Spumanti*, 84 U.S.P.Q.2d 1912, 1915–1916 (TTAB 2007) (“[T]here is nothing fraudulent in providing an identification of goods that includes both a broad product term and a specific product term so long as the applicant/registrant is using its mark on the specific product, and the specific product is encompassed within the broad product term . . .”). The Board in *Tri-Star* determined that registrant’s use of its mark with sparkling wine only was acceptable to support use of its mark on all the goods listed in the registration, namely “wine and sparkling wine.” *Id.*

Opposer listed “*lenses for cameras*” and then “*lenses for cameras incorporated in mobile electronic devices*.” Both phrases identify Opposer’s products—lenses. The second phrase consists of a specific product term (“cameras incorporated in mobile electronic devices”) that is encompassed in the broader product term in the first phrase (“cameras”). The evidence submitted shows that there is no genuine dispute as to any material fact regarding Opposer’s use of its OLLOCLIP® mark in connection with lenses for cameras.

Applicant argues that there is a genuine dispute as to whether Opposer uses its OLLOCLIP® mark in connection with “*lenses for cameras.*” Applicant incorrectly concludes that “[u]se in connection with ‘Lenses for cameras’ would require sale of a lens used with a digital single-lens reflex (DSLR) camera, a point-and-shoot camera, or some other ‘camera’ that is not subsumed within the portion of Opposer’s description that covers ‘lenses for cameras incorporated in mobile electronic devices.’” (See Applicant’s Response, at 10–11, § V(A)(1); see also at 3–4 (first and sixth bullet points)) Contrary to the Board’s holding in *Tri-Star*, as well as T.M.E.P. § 1402.03, Applicant’s argument here is that because a semicolon separates the phrases “*lenses for cameras*” and “*lenses for cameras incorporated in mobile electronic devices,*” then there must be different definitions for the cameras.

There is no support for this tortured construction. Applicant’s citation to *In re Midwest Gaming & Entm’t LLC*, 106 U.S.P.Q.2d 1163 (TTAB 2013), does not support this conclusion. In *In re Midwest Gaming*, the applicant argued that the cited registration’s “bar and restaurant services” should be limited to specific channels of trade and consumers because the phrase before, separated with a semicolon, reads “providing banquet and social function facilities for special occasions.” *Id.* at 1166. The Board disagreed, stating that “providing banquet and social function facilities” was a separate distinct category of services from “bar and restaurant services” and therefore, the “bar and restaurant services” were not limited to specific trade channels or consumers. *Id.* The Board’s opinion in *In re Midwest Gaming* is not pertinent here because the “cameras” listed in Opposer’s registration are not separate and distinct categories. There is no genuine dispute as to any material fact regarding Opposer’s use of its OLLOCLIP® mark in connection with lenses for cameras. Opposer sells lenses. These lenses are for use with cameras.

Thus, the identification of goods in the registration, “*lenses for cameras*,” is proper and Applicant’s counterclaim fails as a matter of law.

C. The Lenses in The OLLOCLIP® Registration Are Not Limited to a Specific Attachment Method

The “*lenses*” listed in Opposer’s OLLOCLIP® registration are “*for cameras*” and “*for cameras incorporated in mobile electronic devices*” (emphasis added). The registration’s goods do not include a limitation on how the lenses are attached to the cameras. Applicant alleges that it is disputed whether Opposer uses its OLLOCLIP-branded lenses in connection with the iPod Touch because attaching Opposer’s lens to the iPod Touch requires an adapter that Opposer sells with the lenses. (See Applicant’s Response, at 3–4 (fourth bullet point) & 5 (bullet point for “Statement 5”)) There is no evidence or legal authority to support Applicant’s conclusion that only “standalone” lenses satisfy the preposition “*for*” in the description of goods. Even “standalone” lenses, as Opposer understands the term (it was not defined by Applicant), requires some method of attaching the lens to a camera. There is no genuine dispute as to any material fact regarding Opposer’s use of its OLLOCLIP® mark in connection with lenses for cameras incorporated in an iPod Touch, which Applicant does not dispute is a mobile electronic device and is *not* a mobile phone.

D. Opposer is Using its OLLOCLIP® Mark in Connection with Cases for Mobile Electronic Devices

Applicant incorrectly states that Opposer has not submitted any evidence regarding whether Opposer used its OLLOCLIP® mark in connection with a carrying case prior to June 5, 2013. (See Applicant’s Response, at 4–5 (first bullet point regarding “Statement 3”) & 12, § V(A)(3)) In support of Opposer’s Motion, Opposer submitted a signed declaration by Patrick

O'Neill, Opposer's Chief Executive Officer, that stated that "[s]ince at least as early as January 8, 2013, Opposer has continuously used its registered OLLOCLIP® mark in interstate commerce in connection with 'Carrying cases for mobile electronic devices.'" (See O'Neill Decl., ¶ 3) Opposer also submitted with its Motion a copy of Registration Certificate No. 4380611 for the mark OLLOCLIP® in connection with "*carrying cases for mobile electronic devices*" that states the mark's first use anywhere and in interstate commerce is at least as early as January 8, 2013. (See Phillips Decl., Ex. B (submitted with Opposer's Motion))

Furthermore, in considering whether to restrict a registration pursuant to Section 18, the Board looks at the scope of Opposer's use of the mark at the time the restriction is sought (*i.e.*, Applicant's counterclaim). See T.B.M.P. § 309.03(d). Applicant filed its counterclaim on November 14 and 27, 2013. Applicant cites to an article published on June 5, 2013 that discusses Opposer's carrying cases for the iPhone and iPod Touch devices. (See Applicant's Response, at 4-5 (first bullet point regarding "Statement 3") & 12, § V(A)(3)) Applicant does not dispute that the iPhone and iPod Touch products are mobile electronic devices. The June 2013 article itself shows that Opposer was using its OLLOCLIP® mark in connection with carrying cases for mobile electronic devices prior to Applicant filing its counterclaim.

Applicant argues that carrying cases used with adapters do not constitute "*carrying cases for mobile electronic devices*," as set forth in Opposer's registration. (See Applicant's Response, at 5 (second bullet point regarding "Statement 3") & 12, § V(A)(3)) The "*carrying cases*" listed in Opposer's registration are not limited to a specific attachment method. As outlined *supra*, section I(C), there is no evidence or legal authority to support Applicant's nonsensical interpretation that only carrying cases without adapters satisfy the preposition "*for*" in the description of goods.

There is no genuine dispute as to the fact that Opposer began using and continues to use, its OLLOCLIP® mark in connection with “*carrying cases for mobile electronic devices*” months prior to the assertion of the counterclaim in this action. Thus, the counterclaim should be dismissed.

E. Relevance of Apple’s IPHONE® Registrations

Pursuant to T.B.M.P. § 528.05(d), Opposer submitted copies of registration certificates for IPHONE®, as well as printouts from Apple’s website, to show that Apple considers the iPhone a mobile electronic device rather than just a mobile phone. (See Opposer’s Motion, at 14–15) Applicant claims that Opposer is trying to broaden its rights by “bootstrapping” to Apple’s registrations, citing to *Covidien LP v. Masimo Corp.*, 109 U.S.P.Q.2d 1696 (TTAB 2013). (See Applicant’s Response, at 12–13) The Board’s decision in *Covidien* focused on whether the petitioner sufficiently pled facts regarding the description of respondent’s registered mark to survive respondent’s motion to dismiss pursuant to Fed. R. Civ. P. 12(b)(6). The holding did not address whether the iPhone or Galaxy devices are mobile electronic devices or merely mobile phones. The Board’s decision in *Covidien* is not relevant and does not raise a factual dispute here.

F. The OLLOCLIP® Mark is in Use With All The Goods Identified in The Registrations

Pursuant to Section 18, 15 U.S.C. § 1068, the Board may cancel a registration in part by deleting some of the goods in the registration only if the registrant is not using its mark on the goods that will be effectively excluded from the registration if the proposed restriction is entered. See *Eurostar*, 34 U.S.P.Q.2d at 1270. Opposer has established that there is no genuine dispute as to the fact that Opposer uses its OLLOCLIP® mark in connection with all of the goods identified

in its federal registrations and therefore, on this element alone, the counterclaim must fail as a matter of law.

II. NARROWING THE GOODS IN THE REGISTRATIONS WILL NOT AVOID A FINDING OF LIKELIHOOD OF CONFUSION

Even if Opposer's OLLOCLIP® mark were not in use with all the goods identified, Applicant's counterclaim would still fail on the other required element—that the requested restriction of goods would avoid a finding of likelihood of confusion. *Id.*

Applicant argues that Opposer has not shown that there are no genuine issues of material fact that restricting Opposer's lenses and cases for “mobile electronic devices” to “mobile phones” would not impact the likelihood of confusion analysis. (See Applicant's Response, at 13) Applicant has not disputed that (1) a mobile phone is a mobile electronic device, or (2) that Applicant's satellite, telecommunication, and broadcasters services will be rendered using mobile electronic devices. Applicant candidly admits that its proposed smartphones and accessories for mobile phones are related to Opposer's goods. *Id.*, at 16. Furthermore, Opposer submitted undisputed facts that its OLLOCLIP®-branded lenses are sold in telecommunications stores (e.g., Verizon), where telecommunication services are rendered and mobile electronic devices, including smartphones and tablets, are sold. (See Opposer's Motion, at 12) It is undisputed that the goods and services, as well as the trade channels for Applicant and Opposer are identical or related. The undisputed facts show that narrowing “mobile electronic devices” to “mobile phones” would not avoid a likelihood of confusion.

Applicant also argues that Opposer has not shown that removing “lenses for cameras” in U.S. Registration No. 4137064 would not impact the likelihood of confusion analysis. (See Applicant's Response, at 15). Applicant argues that the phrase “lenses for cameras” is overly

broad because it includes point-and-shoot and DSLR cameras that, Applicant alleges, are not used in connection with Opposer's lenses. *Id.* Removing "*lenses for cameras*" will have no effect on the likelihood of confusion analysis because determining a likelihood of confusion here would also include an analysis of the second phrase in the description of goods, namely, "*lenses for cameras incorporated in mobile electronic devices.*" As discussed in the paragraph above, Applicant plans to sell smartphones, mobile phone accessories, and services received through mobile electronic devices that are included in the phrase "*lenses for cameras incorporated in mobile electronic devices.*" Although the phrase "*lenses for cameras*" includes all cameras, Applicant does not assert that it plans to sell point-and-shoot or DSLR cameras. Accordingly, there is no issue of material fact that removing "*lenses for cameras*" is not commercially significant here because removing the phrase would not avoid a likelihood of confusion.

Finally, Applicant's survey (Bell Decl., Ex. J) is inadmissible and irrelevant in connection with Opposer's Motion. First, Opposer objects to the admissibility of the survey in connection with Opposer's Motion. The survey was not submitted here by the alleged expert, but rather was attached as an exhibit to the declaration signed by Applicant's counsel. Pursuant to Fed. R. Civ. P. 56(c)(4), "an affidavit or declaration used to support or oppose a motion must be made on personal knowledge, set out facts that would be admissible in evidence, and show that the affiant or declarant is competent to testify on the matters stated." Although Applicant's counsel has personal knowledge that the survey exists, there is no claim in the declaration that Applicant's counsel has personal knowledge regarding the principles and methods used in conducting the survey, the facts and data used in the survey, or how the survey results were calculated. Furthermore, the survey was just recently produced to Opposer on October 31, 2013, which has not provided Opposer enough time to test the credentials of the alleged expert, whether the

survey was based on sufficient facts and data, the reliability of the principles and methods used in conducting the survey, and the basis of the alleged expert's opinion pursuant to Fed. R. Evid. 702 and 703. Therefore, the Board should not consider the survey in deciding Opposer's Motion.

Second, the issue here is not whether there is a likelihood of confusion, but rather whether narrowing the goods in Opposer's registrations, as sought by Applicant, would avoid a finding of a likelihood of confusion. Applicant's survey provides no information as to whether narrowing the goods would avoid a finding of likelihood of confusion. Therefore, the survey is irrelevant and does not create a disputed material fact in connection with Opposer's Motion.

III. CONCLUSION

As a matter of law, the counterclaim cannot succeed because Opposer is using its mark on all the goods identified in the registrations, and the requested restriction would not avoid a finding of likelihood of confusion. As a result, Applicant's counterclaim is wholly without merit and should be dismissed. Opposer respectfully requests the Board grant Opposer's Motion for Summary Judgment.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: December 23, 2014


By 

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **REPLY BRIEF IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT** upon Applicant's counsel via email to the addresses listed below and a courtesy copy is being depositing with the United States Postal Service, first-class postage prepaid, on December 23, 2014, addressed as follows:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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PREMIER SYSTEMS USA, INC.)	
a California corporation,)	
Opposer/Counterclaim Registrant,)	
)	
v.)	
)	
DISH NETWORK L.L.C.)	
A Colorado limited liability company,)	
Applicant/Counterclaim Petitioner.)	

**SECOND DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF OPPOSER'S
MOTION FOR SUMMARY JUDGMENT**

I, Gregory B. Phillips, declare as follows:

1. I am a partner with Knobbe, Martens, Olson & Bear, LLP, counsel for Opposer Premier Systems USA, Inc. in the above-identified Opposition proceeding. I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify as set forth below.

2. Attached hereto as Exhibit A is a printout from the www.ahdictionary.com website showing The American Heritage Dictionary's definition for the word "camera."


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I declare that all statements made herein of my own knowledge are true and all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful, false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful, false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Dated: December 23, 2014

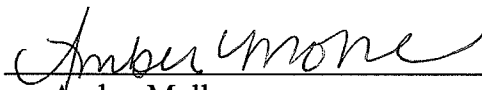
By: 
Gregory B. Phillips

19610818

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **SECOND DECLARATION OF GREGORY B. PHILLIPS IN SUPPORT OF OPPOSER'S MOTION FOR SUMMARY JUDGMENT** upon Applicant's counsel via email to the addresses listed below and a courtesy copy is being depositing with the United States Postal Service, first-class postage prepaid, on December 23, 2014, addressed as follows:

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Amber Molle
Trademark Paralegal

TTAB Opposition No. 91209226
Premier Systems USA, Inc. v. Dish Network L.L.C.

EXHIBIT A

Second Declaration of Gregory B. Phillips in Support of Opposer's Motion For Summary Judgment





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cam·er·a (kām ər-ə, kām rə)

Share:

n.
1. A usually portable device containing a photosensitive surface that records images through a lens.

2. A camera obscura.

3. *pl.* cam·er·ae (-ə-rē) A judge's private chamber.

Idioms:

in camera

Outside of the public view: *The committee met in camera to discuss the report.*

off camera

Outside the field of view of a movie camera.

on camera

Within the field of view of a movie camera.

[Late Latin, room; see CHAMBER.]

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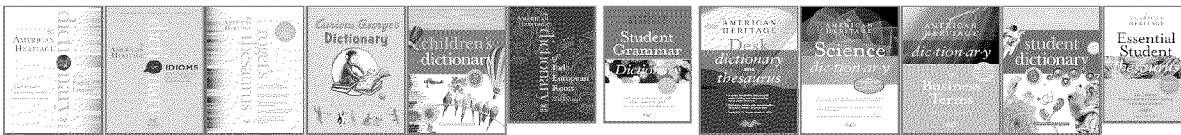
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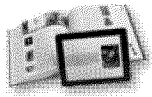
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