

ESTTA Tracking number: **ESTTA581255**

Filing date: **01/10/2014**

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

Proceeding	91212652
Party	Defendant DISH Network L.L.C.
Correspondence Address	SUSAN A SMITH KENYON & KENYON LLP 1500 K STREET NW WASHINGTON, DC 20005 UNITED STATES ssmith@kenyon.com, tmdocketdc@kenyon.com, ekane@kenyon.com, jrosini@kenyon.com
Submission	Answer
Filer's Name	Susan A. Smith
Filer's e-mail	ssmith@kenyon.com, ekane@kenyon.com, tmdocketdc@kenyon.com, jrosini@kenyon.com
Signature	/Susan A. Smith/
Date	01/10/2014
Attachments	1-10-2014 Dish Answer to Notice of Opposition - 91212652 (4).pdf(24873 bytes)

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

In the Matter of Application Serial No. 85/732,379
Published in the Official Gazette on May 28, 2013

CHARTER COMMUNICATIONS, INC.,
COMCAST CORPORATION,
COX COMMUNICATIONS, INC.,
CSC HOLDINGS, LLC, and
TIME WARNER CABLE INC.,

Opposers,

v.

DISH NETWORK, L.L.C.,

Applicant.

Opposition No. 91/212,652
Mark: DISH ANYWHERE
Filed: September 18, 2012
Published: May 28, 2013

ANSWER TO NOTICE OF OPPOSITION

Applicant Dish Network, L.L.C. (“Applicant”), by and through its undersigned attorneys, hereby answers the Notice of Opposition in the above-identified proceeding. Applicant’s responses to the allegations of Opposers, Charter Communications, Inc., Comcast Corporation, Cox Communications, Inc., CSC Holdings, LLC, and Time Warner Cable Inc. (collectively, “Opposers”), are based upon actual knowledge of its own actions and information and belief with respect to all other matters. For reference, the original paragraphs in the Notice of Opposition are reproduced here, followed by Applicant’s response. The paragraph numbers below correspond to those in the Notice of Opposition.

1. Opposers and Applicant are each telecommunications companies that provide, among other things, television broadcasting services, delivery of pre-recorded video content, and a variety of interactive television services to subscribers.

Applicant's Answer

Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations pertaining to Opposers and as such denies them. Applicant admits that it provides, among other things, television broadcasting services, delivery of pre-recorded video content and a variety of interactive television services to its subscribers.

2. On September 18, 2012, Applicant filed an application to register DISH ANYWHERE, App. Ser. No. 85/732,379, covering "Non-downloadable computer software for streaming audio, video, image and data information to a variety of network devices, namely, personal computers, tablets, mobile phones, personal digital assistants (PDA), and stand-alone hardware decoders, namely, audio decoders and video decoders; non-downloadable computer software for operating hardware, translating digital signals, transmitting digital data and signals, electronic messaging, data management, hardware and network security, and access to the internet for use in wireless communications systems; non-downloadable computer software for recording, processing, receiving, reproducing, transmitting, modifying, compressing, broadcasting, merging or enhancing data for use in wireless communications" in Class 42 based upon an intent to use the term in commerce.

Applicant's Answer

Admitted.

3. On information and belief, Applicant has used the applied-for term in connection with goods, including digital video recorders and other communications equipment, and services which enable television programming and other content to be broadcast and transmitted to, or accessed from, a variety of display devices including computers, mobile devices, and televisions to subscribers.

Applicant's Answer

Applicant has used the mark DISH ANYWHERE in connection with Applicant's goods and services including smartphone and tablet software and services which enable television

programming and other content to be accessed from, a variety of display devices including computers and mobile devices; otherwise denied.

4. On information and belief, Applicant intends to use the applied-for term in connection with goods, including digital video recorders and other communications equipment, and services which enable television programming and other content to be broadcast and transmitted to, or accessed from, a variety of display devices including computers, mobile devices, and televisions to subscribers.

Applicant's Answer

A complete list of the services upon which Applicant intends to use the mark DISH ANYWHERE is provided in the Application; otherwise denied.

5. Others have used the term ANYWHERE in connection with goods and services other than Applicant's, including digital video recorders and other communications equipment, and services which enable television programming and other content to be broadcast and transmitted to, or accessed from, a variety of display devices including computers, mobile devices, and televisions to subscribers.

Applicant's Answer

Applicant lacks sufficient information to admit or deny the allegations in this paragraph and therefore denies them.

6. Applicant was aware prior to publication of the applied-for term that others had used ANYWHERE in connection with goods and services other than Applicant's, including digital video recorders and other communications equipment, and services which enable television programming and other content to be broadcast and transmitted to, or accessed from, a variety of display devices including computers, mobile devices, and televisions to subscribers.

Applicant's Answer

Denied.

7. Applicant is aware that others are continuing to use the term ANYWHERE in connection with goods and services other than Applicant's, including digital video recorders and other communications equipment, and services which enable television programming and other content to be broadcast and transmitted to, or accessed from, a variety of display devices including computers, mobile devices, and televisions to subscribers.

Applicant's Answer

Denied.

8. ANYWHERE is descriptive of the applied-for services and related goods, including digital video recorders and other communications equipment and services which enable television programming and other content to be broadcast and transmitted to, or accessed from, a variety of display devices including computers, mobile devices, and televisions to subscribers, or it is a term which has become the common name of such goods and services.

Applicant's Answer

Denied.

9. ANYWHERE has not become distinctive of Applicant's services in commerce.

Applicant's Answer

Applicant applied for the mark DISH ANYWHERE and not ANYWHERE alone;
otherwise denied.

10. ANYWHERE is so highly descriptive so as not to be capable of acquiring distinctiveness for Applicant's services.

Applicant's Answer

Applicant applied for the mark DISH ANYWHERE and not ANYWHERE alone;
otherwise denied

11. ANYWHERE does not function as a trademark but is merely informational as applied to Applicant's services.

Applicant's Answer

Applicant applied for the mark DISH ANYWHERE and not ANYWHERE alone;
otherwise denied.

12. ANYWHERE is a generic term for the applied-for services and related goods, including digital video recorders and other communications equipment and services which enable television programming and other content to be broadcast and transmitted to, or accessed from, a variety of display devices including computers, mobile devices, and televisions to subscribers.

Applicant's Answer

Applicant applied for the mark DISH ANYWHERE and not ANYWHERE alone;
otherwise denied.

13. If Applicant were granted registration of DISH ANYWHERE without a disclaimer of ANYWHERE, Applicant would obtain certain statutory rights, including *prima facie* rights, to the exclusive use of ANYWHERE, all to the damage of Opposers.

Applicant's Answer

Applicant admits that if it were granted registration of DISH ANYWHERE, Applicant would obtain certain statutory rights, including *prima facie* rights, to the exclusive use of DISH ANYWHERE in connection with the services listed in the registration; otherwise denied.

14. Registration by Applicant of Application Serial No. 85/732,379 without a disclaimer of ANYWHERE would be inconsistent with Opposers' and others' right to use ANYWHERE descriptively, informationally, or generically.

Applicant's Answer

Denied.

DEFENSES

Unclean Hands¹

3. Opposer Cox is barred from seeking the relief requested in the Notice of Opposition by virtue of unclean hands. For example, Cox has itself applied for a mark containing "anywhere" for similar services without disclaiming "anywhere."

¹ Although not currently ripe for counterclaims, to the extent the Board considers the term ANYWHERE to be descriptive and/or generic for the claimed goods and services such that a disclaimer is required, Applicant will seek to oppose Cox's application. Cox's application, which has yet to publish for opposition, similarly includes in a composite mark the term ANYWHERE for similar goods and services to the Application and do not include a disclaimer of ANYWHERE.

WHEREFORE, Applicant respectfully requests that the Notice of Opposition be dismissed and that Application Serial No. 85/732,379 proceed to registration.

Respectfully submitted,

KENYON & KENYON LLP

Dated: January 10, 2014

By: /Susan A. Smith/
James E. Rosini
Kenyon & Kenyon LLP
One Broadway
New York, NY 10004
Tel: (212) 425-7200
Fax: (212) 425-5288

Susan A. Smith
Erik C. Kane
Kenyon & Kenyon LLP
1500 K Street, NW, Suite 700
Washington, DC 20005
Tel: (202) 220-4200
Fax: (202) 220-4201

*Attorneys for Applicant
Dish Network, L.L.C.*

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served by first class mail, postage prepaid, on this 10th day of January, 2014 to:

Douglas N. Masters
Regan A. Smith
321 North Clark Street, Suite 2300
Chicago, Illinois 60654

Date: January 10, 2014

By: /Susan A. Smith/
Susan A. Smith
KENYON & KENYON LLP
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
Tel.: (202) 220-4200
Fax: (202) 220-4201

*Attorney for Applicant,
Dish Network, L.L.C.*