

ESTTA Tracking number: **ESTTA581260**

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

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

Proceeding	91212678
Party	Defendant DISH Network L.L.C.
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Date	01/10/2014
Attachments	1-10-2014 Answer to Notice of Opposition - Opp 91212678 (2).pdf(67711 bytes )

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

In the Matter of Application Serial Nos. 85/732,373, 85/732,374, and 85/732,379  
Published in the Official Gazette on May 28, 2013

DIRECTV, LLC,

Opposer,

v.

DISH NETWORK, L.L.C.,

Applicant.

Opposition No. 91/212,678  
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 Opposer, DIRECTV, LLC (“Opposer”), 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 correspond to those in the Notice of Opposition.

1. On September 18, 2012 (the “Filing Date”), Applicant Dish Network, L.L.C. (“Applicant”) filed intent-to-use applications to register the mark DISH ANYWHERE for goods and services classified in Classes 9, 38, and 42 (hereinafter the “Applications”). The Applications were designated Serial Nos. 85/732,373, 85/732,374, and 85/732,379, and cover the following goods and services (hereinafter the “Goods and Services”):

Serial No.	Class	Goods/Services
85/732,373	9	<p>Digital video recorders; Electronic apparatus and devices for controlling access to pay-television services; communications equipment, namely, set-top boxes for receiving video programming; television receivers; satellite receivers; set-top boxes; universal remote controls for home electronic devices, namely, televisions, VCRs, DVD players, digital video recorders, satellite receivers, stereo receivers, and stereo amplifiers; computer hardware and 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; electronic devices, namely, digital media streaming devices; 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; computer programs utilizing radio communications networks, local communication networks, and wide area communication networks; computer programs for facilitating wireless communication; computer programs for recording, processing, receiving, reproducing, transmitting, modifying, compressing, broadcasting, merging or enhancing data for use in wireless communications; compression software for voice, data, image, graphic, audio, and video transmissions; computer application software for mobile phones and tablets, namely, software for streaming audio, video, image and data information to a variety of network devices, namely, personal computers, tablets, and mobile devices; communications software, namely, system application and operating software for residential and commercial satellite receiver systems; communications software, namely, networking software for residential and commercial audio, video and telephony systems. satellite receivers, modems, routers, hubs, cabling, and plugs, all for residential and commercial receiver systems; telecommunications equipment, namely, smartphones, wireless and mobile telephones for voice, data, image, graphic, audio, video and fax communications and electronic mail; hand-held devices for wireless access to global communications networks; PC tablets, personal digital assistants, telephones, telephone modems and radio modems; accessories for mobile phones, namely, batteries; battery chargers; electric cigarette lighter adapters for land vehicles; hands-free headsets for mobile phones and hand-held devices; carrying cases and belt clips for electronic equipment, namely, mobile phones and hand-held devices</p>
85/732,374	38	<p>Telecommunication services, namely, transmission of voice, data, images, graphics, audio, and video by means of wired and wireless networks, communications networks, and global computer information networks; transmission of television broadcasting services via satellite, cable, wireless, fiber optics, and global computer networks; providing satellite and terrestrial services for mobile users for voice, data, audio, video, and fax communications; providing computer communications and data transmission services via radio at remote locations; wireless transmission and networking of messages, communications and data; multi-channel, multi-point distribution services for the high speed, wireless transmission of voice, data, images, graphics, audio, video and faxes; providing multiple-user access to the internet, global computer networks, and electronic communications networks; providing</p>

		access to world-wide information networks; webcasting audio and visual programming via local and global communications networks; television broadcasting and webcasting audio-visual programming; television broadcasting services via the internet, global computer networks, and electronic communications networks; television broadcasting to handheld mobile devices, namely mobile phones, smartphones, laptops and tablet PC's; providing wireless telecommunications to a global computer network for internet browsing and e-mail messaging through a hand held device; audio and video broadcasting services over the Internet; satellite television broadcasting; satellite transmission services, television and radio broadcasting services; subscription television broadcasting; television transmission services; transmission of radio and television programmes by satellite; transmission of sound, video and information; video transmission over digital networks; providing access to world-wide information networks; streaming of audio and video material on the Internet. streaming of audio and video material via a global computer network; transmission of audio and video material; electronic transmission and streaming of digital media content for others via global and local computer networks; video-on-demand transmission services via wired and wireless networks, communications networks, and global computer information networks
85/732,379	42	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

Applicant's Answer

Admitted.

2. The Applications claim acquired distinctiveness in the word DISH based on Applicant's prior registrations of the mark DISH for goods in Class 9 and services in Classes 37 and 38. However, the Applications do not claim that the term ANYWHERE has acquired distinctiveness in relation to the Goods and Services, and do not disclaim exclusive rights in the word ANYWHERE.

Applicant's Answer

Admitted.

3. Media companies other than Applicant use the term ANYWHERE descriptively in connection with the transmission of media content that can be accessed on multiple devices such as television sets, computers, and mobile phones.

Applicant's Answer

Denied.

4. Media companies other than Applicant have made such descriptive use of ANYWHERE earlier than the Filing Date, and have continued to make such descriptive use of ANYWHERE to the present date.

Applicant's Answer

Denied.

5. As a result of such widespread use, the public understands the term ANYWHERE to be merely descriptive when used in connection with the transmission and streaming of television programs and other content.

Applicant's Answer

Denied.

6. The term ANYWHERE is merely descriptive with respect to the Goods and Services, and not an indicator of source.

Applicant's Answer

Denied.

7. Applicant has not made substantially exclusive use of ANYWHERE for the Goods and Services, and thus cannot claim that the phrase has acquired distinctiveness as an indicator of source for the Goods and Services.

Applicant's Answer

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

8. Because the term ANYWHERE is merely descriptive with respect to the Goods and Services, and has not acquired distinctiveness as an indicator of source for Applicant's Goods and Services, the Trademark Office should have required Applicant to disclaim exclusive rights in the term ANYWHERE as a condition to approving the Applications for registration.

Applicant's Answer

Denied.

9. Opposer provides services that are identical or closely related to many of the Goods and Services, and has an interest in using the term ANYWHERE in connection with many of the Goods and Services.

Applicant's Answer

Denied.

10. If Applicant were to obtain registration of DISH ANYWHERE without a disclaimer of the word ANYWHERE, Applicant would obtain certain statutory presumptions with respect to its use of the word ANYWHERE in commerce on or in connection with the Goods and Services, resulting in injury to Opposer.

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.

11. For the foregoing reasons, Opposer will be damaged by Applicant's registration of DISH ANYWHERE without a disclaimer of the word ANYWHERE.

Applicant's Answer

Denied.

**DEFENSE**

**Unclean Hands**

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

WHEREFORE, Applicant respectfully requests that the Notice of Opposition be dismissed and that Application Serial Nos. 85/732,373, 85/732,374, and 85/732,379 proceed to registration.

Respectfully submitted,

KENYON & KENYON LLP

Dated: January 10, 2014

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**CERTIFICATE OF SERVICE**

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

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