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

Proceeding	91215222
Party	Defendant GSMA Ltd.
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Attachments	2014.04.14 GSMA's Answer, Affirmative Defenses and Counterclaims.pdf(278360 bytes)

Registrations Subject to the filing

Registration No	3533730	Registration date	11/18/2008
Registrant	DELSON GROUP INC 1218 BUBB ROAD CUPERTINO, CA 95014 GERMANY		
Grounds for filing	The registered mark has become the generic name for the goods.		
	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

<p>Class 041. First Use: 2004/10/15 First Use In Commerce: 2005/02/18 All goods and services in the class are requested, namely: Organizing, conducting and arranging conferences, congresses, exhibitions, seminars, symposia and workshops in the fields of mobile wireless communications; provision of educational services, namely, classes, conferences, congresses, exhibitions, seminars, symposia and workshops in the fields of mobile wireless communications; training services in the fields of mobile wireless communications</p>

Registration No	2982473	Registration date	08/02/2005
Registrant	DELSON GROUP INC 1218 BUBB ROAD CUPERTINO, CA 95014 GERMANY		
Grounds for filing	The registered mark has become the generic name for the goods.		
	The registered mark has been abandoned.		
	The registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.		

Goods/Services Subject to the filing

Class 035. First Use: 2004/10/15 First Use In Commerce: 2005/02/18

All goods and services in the class are requested, namely: ORGANIZING AND CONDUCTING BUSINESS CONFERENCES, TRADE SHOWS AND EXHIBITIONS IN THE FIELD OF MOBILE WIRELESS COMMUNICATIONS

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

DELSON GROUP, INC.,)	Opposition No. 91215222
)	
Opposer/Counterclaim Respondent,)	TM: MOBILE WORLD CAPITAL
)	(Serial No. 79112842)
v.)	
)	<u>Counterclaims:</u>
GSMA LTD.,)	
)	TM: MOBILE WORLD CONGRESS
Applicant/Counterclaim Petitioner.)	(Reg. No. 3533730)
)	
)	TM: WORLD MOBILE CONGRESS
)	(Reg. No. 2982473)

**APPLICANT GSMA LTD.’S ANSWER, AFFIRMATIVE
DEFENSES, AND COUNTERCLAIMS TO OPPOSER DELSON
GROUP, INC.’S NOTICE OF OPPOSITION**

In accordance with 37 C.F.R. § 2.106, Applicant/Counterclaim Petitioner GSMA Ltd. (“GSMA”) sets forth the following Answer, Affirmative Defenses, and Counterclaims to Opposer/Counterclaim Respondent Delson Group, Inc.’s (“Delson Group”) Notice of Opposition (the “Notice”). Except as otherwise expressly admitted, GSMA denies each and every allegation contained in the Notice.

As to the first unnumbered paragraph on page 1 of the Notice, this paragraph consists of conclusions of law to which no response is required.

As to the second unnumbered paragraph on pages 1-2 of the Notice, GSMA admits that the online records of the California Secretary of State Business Search show that Delson Group is a corporation organized under the laws of the state of Delaware, with a business address at 1218 Bubb Road, Cupertino, California 95014. GSMA further admits that it is a wholly-owned subsidiary of the GSM Association, a global trade association with a place of business located in London, the United Kingdom. GSMA also admits that is a non-profit corporation, duly

organized and existing under the laws of the state of Georgia, with its principal place of business at 1000 Abernathy Road, Suite 450, Atlanta, Georgia 30328. GSMA is without sufficient knowledge or information to form a belief as to the truth of the allegation concerning Delson Group's business activities and therefore denies the same. GSMA denies all remaining allegations contained in the second unnumbered paragraph on pages 1-2 of the Notice.

As to the third unnumbered paragraph on pages 2-3 of the Notice, GSMA admits that this unnumbered paragraph contains the filing particulars for its application to register the MOBILE WORLD CAPITAL mark (Serial No. 79112842).

1. GSMA is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 1 and therefore denies the same.

2. GSMA is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 2 and therefore denies the same.

3. GSMA admits that the online records of the United States Patent and Trademark Office ("USPTO") show that Delson Group applied to register the term "world wireless congress" on July 6, 2001 and that the USPTO issued Registration No. 2558973 for that term to Delson Group, with the word "wireless" disclaimed, on April 9, 2002. GSMA is without sufficient knowledge or information to form a belief as to the truth of the statements made by Delson Group in prosecuting its application to register the term "world wireless congress" (including the accuracy of the first use date listed by Delson Group), and therefore denies the same.

4. GSMA admits that the online records of the USPTO show that Delson Group applied to register the term "global mobile congress" on December 11, 2002 and that the USPTO issued Registration No. 2809615 for that term to Delson Group on the Supplemental Register on January 27, 2004. GSMA is without sufficient knowledge or information to form a belief as to

the truth of the statements made by Delson Group in prosecuting its application to register the term “global mobile congress” (including the accuracy of the first use date listed by Delson Group), and therefore denies the same.

5. GSMA admits that the online records of the USPTO show that Delson Group applied to register the term “world mobile congress” on July 10, 2004 and that the USPTO issued Certificate of Registration No. 2982473 for that term to Delson Group, on the Supplemental Register and with the word “congress” disclaimed, on August 2, 2005. GSMA is without sufficient knowledge or information to form a belief as to the truth of the statements made by Delson Group in prosecuting its application to register the term “world mobile congress” (including the accuracy of the first use date listed by Delson Group), and therefore denies the same.

6. GSMA admits that the online records of the USPTO show that Delson Group applied to register the term “mobile world congress” on April 3, 2008, and that the USPTO issued Certificate of Registration No. 3533730 for that term to Delson Group on the basis of Delson Group’s claim of acquired distinctiveness and with the phrase “world congress” disclaimed, on November 18, 2008. GSMA is without sufficient knowledge or information to form a belief as to the truth of the statements made by Delson Group in prosecuting its application to register the term “mobile world congress” (including the accuracy of the first use date listed by Delson Group), and therefore denies the same.

7. GSMA is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 7 and therefore denies the same.

8. GSMA denies that the terms “mobile world congress,” “world mobile congress,” and “world wireless congress” constitute a family of marks. GSMA is without sufficient

knowledge or information to form a belief as to the truth of the remaining allegations contained in Paragraph 8 and therefore denies the same.

9. GSMA is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 9 (including the accuracy of the first use date stated by Delson Group), and therefore denies the same.

10. GSMA admits that it is a wholly-owned subsidiary of the GSM Association, a global trade association. GSMA further admits that it facilitates, organizes, and manages conferences related to the mobile communications industry. GSMA also admits that its flagship annual conference, then called the 3GSM World Congress, was held annually in Cannes, France through 2006. GSMA denies all remaining allegations contained in Paragraph 10.

11. GSMA admits that its flagship annual conference since 2007 has been, and continues to be, held in Barcelona, Spain and that GSMA changed the name of this conference from 3GSM World Congress to the GSMA Mobile World Congress in 2007. GSMA further admits that the GSM Association registered the www.mobileworldcongress.com domain name in January 2007 and that GSMA began its marketing and advertising efforts for the conference under its new GSMA Mobile World Congress name that same year. GSMA also admits that, on June 13, 2007, GSM Conference Services Limited filed a Request for Extension of Protection to the United States of the GSM ASSOCIATION MOBILE WORLD CONGRESS (and design) mark under application Serial No. 79042100. GSMA denies all remaining allegations contained in Paragraph 11.

12. GSMA admits that, in June 2008, GSMA (then known as GSMC Limited) filed a federal lawsuit against Delson Group in the United States District Court for the Northern District of Georgia as a result of Delson Group's use of GSMA's conference name and other indicia suggesting that Delson Group's conference was the same as, or sponsored or endorsed by,

GSMA in Delson Group's advertising for its own worldwide mobile conference, which it referred to alternately as the "World Mobile Congress" and the "Mobile World Congress." GSMA denies all remaining allegations contained in Paragraph 12.

13. GSMA denies the allegations contained in Paragraph 13.

14. GSMA admits that the Trademark Examining Attorney assigned to review GSM Conference Services Limited's application to register the GSM ASSOCIATION MOBILE WORLD CONGRESS (and design) mark issued an office action in connection with the application on August 16, 2008. GSMA further states that the office action speaks for itself and that the office action is not at issue in the present proceeding. GSMA denies all remaining allegations contained in Paragraph 14.

15. GSMA (then GSMC Limited) admits that it chose not to respond to the August 16, 2008 office action. GSMA further admits that the application to register the GSM ASSOCIATION MOBILE WORLD CONGRESS (and design) mark was deemed abandoned by the USPTO because GSMA (then GSMC Limited) chose not to respond to the office action. GSMA further states that the office action is not at issue in the present proceeding. GSMA denies all remaining allegations contained in Paragraph 15.

16. GSMA admits that a representative of the company communicated with a representative of Delson Group in 2008 to discuss the possibility of a worldwide resolution of the parties' dispute, but that this discussion ultimately was not successful. GSMA denies all remaining allegations contained in Paragraph 16.

17. GSMA states that the 2008 federal lawsuit resulted in a final judgment and permanent injunction issued on October 21, 2008 in favor of GSMA and against Delson Group, and that this judgment and injunction enjoins Delson Group from "advertising, promoting, or marketing conference or event services under the name Mobile World Congress, World Mobile

Congress, or any other similar name.” GSMA further states that the judgment and injunction remains active and valid as of the filing date of this Answer. GSMA admits that a representative of the company previously communicated with a representative of Delson Group regarding the judgment and injunction and its terms. GSMA denies all remaining allegations contained in Paragraph 17.

18. GSMA admits that GSM Association is the registrant of record of the www.mobileworldcongress.com and www.mobileworldlive.com domain names. GSMA denies all remaining allegations contained in Paragraph 18.

19. GSMA admits that it changed the name of its flagship annual conference from 3GSM World Congress to the GSMA Mobile World Congress in 2007. GSMA further admits that it began its marketing and advertising efforts for the conference under its new GSMA Mobile World Congress name that same year. GSMA denies all remaining allegations contained in Paragraph 19.

20. GSMA admits that, in May 2012, Delson Group filed a federal lawsuit against GSMA and GSM Association in the United States District Court for the Northern District of California, claiming trademark rights in the terms “mobile world congress” and “world mobile congress,” the very terms at issue in the 2008 federal lawsuit between the parties and the very terms covered by the 2008 final judgment and injunction. GSMA further admits that GSMA and GSM Association filed a motion to dismiss in response to the 2012 federal lawsuit, which the district court granted on August 6, 2012, entering judgment in favor of GSMA and GSM Association the same day. GSMA further admits that Delson Group noticed its appeal of the district court’s judgment in August 2012, and that the appeal is now fully briefed and argued, awaiting a decision by the U.S. Court of Appeals for the Ninth Circuit. GSMA denies all remaining allegations contained in Paragraph 20.

21. GSMA admits that the <http://mobileworldcapital.com/en/page/49> webpage contains the statement, “A fundamental pillar of Mobile World Capital Barcelona is the Mobile World Congress, the world’s leading event of its type, bringing together in Barcelona the mobile telecommunication sector’s top companies and professionals.” GSMA denies all remaining allegations contained in Paragraph 21.

22. GSMA denies the allegations contained in Paragraph 22.

23. GSMA denies the allegations contained in Paragraph 23.

24. GSMA is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 24 and therefore denies the same.

25. GSMA is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 25 and therefore denies the same.

26. GSMA denies the allegations contained in Paragraph 26.

27. GSMA denies the allegations contained in Paragraph 27.

28. GSMA denies the allegations contained in Paragraph 28.

29. GSMA denies the allegations contained in Paragraph 29.

30. GSMA denies the allegations contained in Paragraph 30.

31. GSMA denies the allegations contained in Paragraph 31.

32. GSMA denies the allegations contained in Paragraph 32.

33. GSMA denies the allegations contained in Paragraph 33.

34. GSMA denies the allegation that Delson Group “has built very strong goodwill in its family marks worldwide.” GSMA is without sufficient knowledge or information to form a belief as to the truth of the remaining allegations contained in Paragraph 34 and therefore denies the same.

As to the unnumbered paragraph on page 12 of the Notice, to the extent any response is required, GSMA denies the allegations contained in this paragraph.

AFFIRMATIVE DEFENSES

By asserting each of the below Affirmative Defenses, GSMA does not in any way concede that it has the burden of proof as to each Affirmative Defense.

1. The Notice fails to state any claim upon which relief can be granted.
2. Delson Group lacks standing to maintain this opposition action.
3. As discussed in additional detail in GSMA's Counterclaims, Delson Group's Registration No. 3533730 of the term "mobile world congress" is invalid as a result of fraudulent misrepresentations made by Delson Group to the USPTO. Despite the fact that Delson Group's purported rights in the term "mobile world congress" are directly the subject of the 2008 Final Judgment (defined below), federal litigation, and multiple pending proceedings before the Board, *see* Cancellation No. 92056084 and Opposition No. 91207134, Delson Group's President, Willie W. Lu, submitted a Combined Declaration of Use and Incontestability under Sections 8 & 15 of the Lanham Act on November 25, 2013, representing to the USPTO that (1) Delson Group was using the term "mobile world congress" lawfully in commerce on or in connection with all services covered by the registration; (2) Delson Group had lawfully used the term "mobile world congress" in commerce continuously for the five consecutive years predating execution of the Declaration; (3) no final decision adverse to Delson Group's claim of ownership to the registered term existed; and (4) no proceeding involving Delson Group's purported rights in the term "mobile world congress" was pending in either the USPTO or the federal courts. In light of the 2008 Final Judgment and the parties' ongoing federal litigation and Board proceedings, Mr. Lu's November 25, 2013 statements to the USPTO on behalf of Delson Group were false representations of material fact, Delson Group knew that these misrepresentations to the USPTO

were false at the time Delson Group's President signed the Declaration and submitted it to the USPTO, and Delson Group had an intent to deceive the USPTO in doing so. In accepting and acknowledging Delson Group's Combined Sections 8 and 15 Declaration, the USPTO reasonably relied on Delson Group's above material misrepresentations. Therefore, because Delson Group knowingly made false, material representations of fact in connection with the maintenance of its Registration No. 3533730 of the term "mobile world congress," with the intent to deceive the USPTO, Delson Group's registration was fraudulently maintained and the registration is invalid.

4. Delson Group has abandoned its rights in the terms "mobile world congress" and "world mobile congress," to the extent any trademark rights ever existed.

5. Delson Group has no *bona fide* use in commerce of the terms "mobile world congress" and "world mobile congress," as it is enjoined by federal court order from using these terms in commerce as trademarks.

6. Alternatively, the terms "mobile world congress," "world mobile congress," "global mobile congress," and "world wireless congress" are generic and incapable of trademark protection.

7. Alternatively, GSMA's MOBILE WORLD CAPITAL mark is inherently distinctive and/or acquired distinctiveness and secondary meaning at an earlier date than did Delson Group's WORLD MOBILE CONGRESS mark, to the extent Delson Group's WORLD MOBILE CONGRESS mark has acquired secondary meaning at all.

8. Delson Group filed its Notice for improper purposes.

9. Delson Group's claims are barred, in whole or in part, by the doctrine of unclean hands.

10. GSMA reserves the right to assert any additional affirmative defenses, including those that may be identified during the course of investigation and discovery.

GSMA respectfully requests that Delson Group's Notice be dismissed with prejudice.

COUNTERCLAIMS

GSMA is damaged by the continued registration of the "mobile world congress" term that is the subject of Registration No. 3533730 and the "world mobile congress" term that is the subject of Registration No. 2982473 and states the following for its Counterclaims against Delson Group:

Facts Common to All Claims for Relief

1. GSMA is a non-profit corporation, duly organized and existing under the laws of the state of Georgia, with its principal place of business at 1000 Abernathy Road, Suite 450, Atlanta, Georgia 30328.

2. GSMA facilitates, organizes, and manages conferences related to the mobile communications industry. It is a wholly-owned subsidiary of the GSM Association, a global trade association that unites nearly 800 of the world's mobile phone operators, whose networks span across more than 220 countries worldwide, with over 230 companies in the broader mobile ecosystem.

3. GSMA's flagship annual conference, the GSMA Mobile World Congress, is held in Barcelona, Spain, and includes exhibitions, keynote sessions, educational seminars, and the GSM Association annual board meeting. The GSMA Mobile World Congress is the largest annual mobile communications conference and exhibition and one of the largest "business-to-business" events held in the world. GSMA advertises and promotes the GSMA Mobile World Congress throughout the United States and accepts sponsorships and exhibition fees for the GSMA Mobile World Congress event from entities in the United States.

4. Previously called the “3GSM World Congress,” GSMA changed the name of the conference to the “GSMA Mobile World Congress” beginning with the 2008 annual conference.

5. In preparation for the 2008 conference, GSMA adopted a new logo, depicted below, and began its advertising and marketing efforts under the “GSMA Mobile World Congress” name and logo in mid-2007:



6. The 2008 GSMA Mobile World Congress hosted over 55,000 attendees. Keynote speeches were given at the conference by the CEOs of major mobile service providers, manufacturers, and suppliers, including AT&T Mobility, Cisco, Qualcomm, and Nokia.

7. Most recently, the 2014 GSMA Mobile World Congress hosted over 85,000 attendees from 200 countries, of which more than 4,500 were company CEOs and more than 50% of which were C-level executives.

8. Delson Group is a corporation, organized and existing under the laws of the state of Delaware, having its principal place of business at 1218 Bubb Road, Cupertino, California 95014.

9. On July 10, 2004, Delson Group applied to register the term “world mobile congress.” The registration issued on the Supplemental Register on August 2, 2005, covering “organizing and conducting business conferences, trade shows and exhibitions in the field of mobile wireless communications” in Class 35, and was assigned Registration No. 2982473 (the “World Mobile Congress Registration”). The World Mobile Congress Registration disclaims the term “congress.”

10. On April 3, 2008, Delson Group applied to register the term “mobile world congress.” The registration issued on November 18, 2008, covering “organizing, conducting and

arranging conferences, congresses, exhibitions, seminars, symposia and workshops in the fields of mobile wireless communications; provision of educational services, namely, classes, conferences, congresses, exhibitions, seminars, symposia and workshops in the fields of mobile wireless communications; training services in the fields of mobile wireless communications” in Class 41, and was assigned Registration No. 3533730 (the “Mobile World Congress Registration”) (collectively with the World Mobile Congress Registration, the “Delson Group Registrations”). The Mobile World Congress Registration disclaims the term “world congress.”

11. In June 2008, GSMA (then known as GSMC Limited) filed a federal lawsuit against Delson Group in the United States District Court for the Northern District of Georgia as a result of Delson Group’s use of GSMA’s conference name and other indicia suggesting that Delson Group’s conference was the same as, or sponsored or endorsed by, GSMA in Delson Group’s advertising for its own worldwide mobile conference, which it referred to alternately as the “World Mobile Congress” and the “Mobile World Congress.”

12. The 2008 federal lawsuit resulted in a final judgment and permanent injunction issued on October 21, 2008 in favor of GSMA and against Delson Group (the “Final Judgment”). A copy of the federal court’s 2008 Final Judgment is attached as **Exhibit A**.

13. Among other things, the 2008 Final Judgment enjoins Delson Group from “advertising, promoting, or marketing conference or event services under the name Mobile World Congress, World Mobile Congress, or any other similar name.” Exhibit A, ¶ 2(a).

14. In May 2012, Delson Group filed a federal lawsuit against GSMA and GSM Association in the United States District Court for the Northern District of California, claiming trademark rights in the terms “mobile world congress” and “world mobile congress,” the very terms at issue in the 2008 federal lawsuit and the very terms covered by the 2008 Final Judgment.

15. GSMA and GSM Association filed a motion to dismiss in response to the 2012 federal lawsuit, which the district court granted on August 6, 2012, entering judgment in favor of GSMA and GSM Association the same day. A copy of the district court's 2012 judgment is attached as **Exhibit B**.

16. Delson Group thereafter noticed its appeal of the district court's dismissal of the 2012 federal lawsuit to the U.S. Court of Appeals for the Ninth Circuit. That appeal has been fully briefed and argued, and now awaits a decision from the Ninth Circuit.

COUNT I

Abandonment By Unlawful Use

17. GSMA repeats and incorporates by reference the allegations set forth in paragraphs 1-16.

18. Section 45 of the Lanham Act, 15 U.S.C. § 1127, defines the term "use in commerce" as "the bona fide use of a mark in the ordinary course of trade" and further defines the term "use" in the context of abandonment as "bona fide use."

19. The Final Judgment entered by the federal court on October 21, 2008 enjoins Delson Group from "advertising, promoting, or marketing conference or event services under the name Mobile World Congress, World Mobile Congress, or any other similar name." Exhibit A, ¶ 2(a).

20. Since entry of the 2008 Final Judgment on October 21, 2008, Delson Group has continued advertising, promoting, and marketing conference and event services under the Mobile World Congress and World Mobile Congress names, in direct contravention of the federal court's permanent injunction.

21. Delson Group's continued use of the Mobile World Congress and World Mobile Congress names after entry of the federal court's Final Judgment has not constituted lawful use

in commerce and therefore cannot satisfy the required “bona fide use of a mark in the ordinary course of trade” necessary to maintain valid federal trademark registrations.

22. Lack of bona fide use of the Mobile World Congress and World Mobile Congress names by Delson Group for more than three consecutive years is prima facie evidence of abandonment of any trademark rights Delson Group may have had in these names.

23. Furthermore, it is a legal impossibility for Delson Group to have any legitimate intent to resume bona fide use of the Mobile World Congress and World Mobile Congress names because the permanent injunction contained in the 2008 Final Judgment, which currently remains in effect, enjoins Delson Group from making the use in commerce required to maintain its federal trademark registrations of these names.

24. Consequently, to the extent Delson Group had any trademark rights in the Mobile World Congress and World Mobile Congress names, those rights have been abandoned.

25. GSMA and Delson Group are direct competitors in the mobile communications industry and GSMA has an interest in using the terms “mobile world congress” and “world mobile congress” in connection with conferences targeted to the mobile communications industry and attended by industry participants worldwide. GSMA therefore is being damaged by the continued registration of those terms on the Principal and Supplemental Registers.

COUNT II

Delson Group’s Registration of the Term “Mobile World Congress” Was Maintained Fraudulently, Thereby Invalidating the Registration

26. GSMA repeats and incorporates by reference the allegations set forth in paragraphs 1-16.

27. On August 24, 2012, GSMA petitioned the Trademark Trial and Appeal Board (“Board”) to cancel Delson Group’s Registration No. 3533730 of the term “mobile world

congress” on the basis of various alternative grounds, including abandonment by unlawful use, genericness, lack of secondary meaning/mere descriptiveness, and likelihood of confusion.

28. The Board assigned this proceeding Cancellation No. 92056084. As of the filing date of this counterclaim, this cancellation proceeding remains ongoing and currently is suspended pending the Ninth Circuit’s disposition of the appeal in the federal civil action between GSMA and Delson Group.

29. On April 29, 2013, GSMA filed its answer and counterclaims in Opposition No. 91207134, which was instituted by Delson Group against GSMA’s application to register the MOBILE WORLD LIVE & design mark. For its counterclaims in this opposition proceeding, GSMA sought to cancel Delson Group’s Registration No. 3533730 of the term “mobile world congress” on the basis of various alternative grounds, including abandonment by unlawful use, genericness, lack of secondary meaning/mere descriptiveness, and likelihood of confusion.

30. As of the filing date of this counterclaim, Opposition No. 91207134 (including the counterclaims asserted by GSMA in that proceeding) remains ongoing and currently is suspended pending the Ninth Circuit’s disposition of the appeal in the federal civil action between GSMA and Delson Group.

31. On November 25, 2013, despite the existence of the 2008 Final Judgment, the ongoing Board proceedings, and the federal litigation between Delson Group and GSMA, all of which directly involve Delson Group’s purported rights in the term “mobile world congress,” Delson Group’s President, Willie W. Lu, submitted a Combined Declaration of Use and Incontestability under Sections 8 & 15 of the Lanham Act (the “Declaration”) for Registration No. 3533730 of the term “mobile world congress.”

32. Delson Group submitted the Declaration through the USPTO’s online TEAS filing system, which prominently states: “WARNING: Registration Subject to Cancellation for

Fraudulent Statements. You must ensure that statements made in filings to the USPTO are accurate, as inaccuracies may result in the cancellation of a trademark registration.”

33. In submitting this Declaration, Delson Group represented to the USPTO that (1) Delson Group was using the term “mobile world congress” lawfully in commerce on or in connection with the services covered by the registration; (2) Delson Group had lawfully used the term “mobile world congress” in commerce continuously for five consecutive years prior to the date on which the Declaration was executed; (3) no final decision adverse to Delson Group’s claim of ownership to the registered term existed; and (4) no proceeding involving Delson Group’s purported rights in the term “mobile world congress” was pending in either the USPTO or the federal courts.

34. In light of the 2008 Final Judgment, the parties’ ongoing federal litigation, and the multiple active Board proceedings directly involving Delson Group’s purported rights in the term “mobile world congress,” Delson Group’s November 25, 2013 statements to the USPTO constitute false representations of material facts.

35. The misrepresentations to the USPTO are material because the USPTO would not have accepted and acknowledged Delson Group’s Declaration had the USPTO been aware of the 2008 Final Judgment and of Delson Group’s directly-related pending federal district court and Board disputes with GSMA concerning Delson Group’s purported rights in the term “mobile world congress.”

36. In light of the 2008 Final Judgment, the parties’ ongoing federal litigation, and the Board proceedings directly placing at issue Delson Group’s purported rights in the term “mobile world congress,” the President of Delson Group, Willie W. Lu, knew that his representations to the USPTO were false at the time he signed the Declaration and submitted it to the USPTO.

37. In submitting the Declaration to the USPTO and falsely stating in that Declaration that (1) Delson Group was using the term “mobile world congress” lawfully in commerce on or in connection with the services covered by the registration (ignoring the existence of the 2008 Final Judgment, which explicitly prohibits such use); (2) Delson Group had lawfully used the term “mobile world congress” in commerce continuously for five consecutive years after the date of registration (again ignoring the existence of the 2008 Final Judgment, which predates Delson Group’s registration date); (3) no final decision adverse to Delson Group’s claim of ownership to the registered term existed (*see* 2008 Final Judgment); and (4) no proceeding involving Delson Group’s purported rights in the term “mobile world congress” was pending in either the USPTO or the federal courts (ignoring the pending federal litigation and the multiple cancellation proceedings directly involving this very registration), Delson Group acted willfully and with an intent to deceive the USPTO.

38. In accepting and acknowledging Delson Group’s Declaration, the USPTO reasonably relied on each of the material misrepresentations set forth in Paragraph 37.

39. Therefore, Delson Group knowingly made false, material representations of fact in connection with the maintenance of its MOBILE WORLD CONGRESS registration, with the intent to deceive the USPTO.

40. GSMA and Delson Group are direct competitors in the mobile communications industry and GSMA has an interest in using the term “mobile world congress” in connection with conferences targeted to the mobile communications industry and attended by industry participants worldwide. GSMA therefore is being damaged by the continued registration of that term on the Principal Register as a proximate result of the USPTO’s reasonable reliance on Delson Group’s fraudulent misrepresentations to the USPTO. Among other things, Delson Group is relying on its fraudulently maintained Registration No. 3533730 of the term “mobile

world congress” to assert rights against GSMA in both federal and Board proceedings, including Cancellation No. 92056084 and Opposition Nos. 91207134 and 91215222.

41. Consequently, pursuant to Section 14(3) of the Lanham Act, 15 U.S.C. § 1064(3), Delson Group’s Registration No. 3533730 should be cancelled on the ground that the registration was maintained fraudulently.

COUNT III

In the Alternative, Genericness

42. GSMA repeats and incorporates by reference the allegations set forth in paragraphs 1-16.

43. In accordance with T.B.M.P. § 309.03(a)(2), the allegations contained within each of the paragraphs in this Count are made in the alternative and solely for purposes of this Count of the Counterclaims.

44. The terms “mobile world congress” and “world mobile congress” are generic and incapable of trademark protection.

45. The terms “mobile world congress” and “world mobile congress” are widely used by consumers, third party competitors, industry participants, and the media to refer to categories of conferences such as those offered by Delson Group in connection with the terms at issue.

46. The primary significance of the terms “mobile world congress” and “world mobile congress” to the relevant public is as the category of conferences targeted to the mobile communications industry and attended by industry participants worldwide.

47. To the extent that the terms “mobile world congress” and “world mobile congress” ever were distinctive, these terms have become generic and are therefore unprotectable and unregistrable under 15 U.S.C. § 1064(3).

48. GSMA and Delson Group are direct competitors in the mobile communications industry and GSMA has an interest in using the terms “mobile world congress” and “world mobile congress” in connection with conferences targeted to the mobile communications industry and attended by industry participants worldwide. GSMA therefore is being damaged by the continued registration of those terms on the Principal and Supplemental Registers.

COUNT IV

In the Alternative and Hypothetically, Likelihood of Confusion

49. GSMA repeats and incorporates by reference the allegations set forth in paragraphs 1-16.

50. In accordance with T.B.M.P. § 309.03(a)(2), the allegations contained within each of the paragraphs in this Count are made in the alternative, hypothetically, and solely for purposes of this Count of the Counterclaims.

51. GSMA’s use of the MOBILE WORLD CONGRESS mark predates Delson Group’s use of its WORLD MOBILE CONGRESS mark because GSMA’s MOBILE WORLD CONGRESS mark acquired distinctiveness and secondary meaning at an earlier date than did Delson Group’s WORLD MOBILE CONGRESS mark, to the extent Delson Group’s WORLD MOBILE CONGRESS mark has acquired secondary meaning at all.

52. GSMA has used its MOBILE WORLD CONGRESS trademark in commerce since mid-2007, and the mark serves as a distinctive indicator of the origin of services provided by GSMA.

53. GSMA has expended considerable monetary and other resources in developing consumer brand recognition for its MOBILE WORLD CONGRESS mark. As a result of the widespread advertising and promotion by GSMA, the MOBILE WORLD CONGRESS mark has acquired a high degree of recognition and distinctiveness as a symbol of the quality services

offered by GSMA. Consumers are familiar with and identify the MOBILE WORLD CONGRESS mark with GSMA and, by reason of this identification, services associated with the MOBILE WORLD CONGRESS mark are understood by the relevant public and trade to be marketed and offered under GSMA's authority and control or otherwise derived from GSMA.

54. The services recited in Delson Group's registration of its WORLD MOBILE CONGRESS mark are identical to the services GSMA provides in intrastate and interstate commerce in connection with its MOBILE WORLD CONGRESS mark, and which it provided prior to the time Delson Group's WORLD MOBILE CONGRESS mark acquired secondary meaning, to the extent Delson Group's WORLD MOBILE CONGRESS mark has acquired secondary meaning at all.

55. GSMA is suffering ongoing damage as a result of the registration of Delson Group's WORLD MOBILE CONGRESS mark because the mark so resemble GSMA's MOBILE WORLD CONGRESS mark as to be likely to cause consumer confusion, mistake, and deception, particularly in view of the fact that the parties' services are identical.

Conclusion

56. For each of the foregoing reasons, GSMA respectfully requests that the Board sustain these Counterclaims in GSMA's favor and cancel Registration Nos. 3533730 and 2982473.

57. The required fee in the amount of \$600.00 is being electronically submitted with these Counterclaims. The Commissioner is authorized to debit Kilpatrick Townsend & Stockton LLP's deposit account no. 20-1430 if there is any deficiency in the required fee.

[Signature on following page]

This 14th day of April, 2014.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Sabina A. Vayner", with a long horizontal flourish extending to the right.

William H. Brewster

Sabina A. Vayner

Kilpatrick Townsend & Stockton LLP

1100 Peachtree Street, Suite 2800

Atlanta, Georgia 30309-4528

Telephone: (404) 815-6500

Facsimile: (404) 815-6555

Attorneys for GSMA Ltd.

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

DELSON GROUP, INC.,)
) **Opposition No. 91215222**
)
Opposer/Counterclaim Respondent,)
) TM: MOBILE WORLD CAPITAL
) (Serial No. 79112842)
v.)
) Counterclaims:
)
GSMA LTD.,)
)
) TM: MOBILE WORLD CONGRESS
Applicant/Counterclaim Petitioner.) (Reg. No. 3533730)
)
)
) TM: WORLD MOBILE CONGRESS
) (Reg. No. 2982473)

CERTIFICATE OF SERVICE

This is to certify that, on April 14, 2014, a true and correct copy of the foregoing **Applicant GSMA Ltd.’s Answer, Affirmative Defenses, and Counterclaims to Opposer Delson Group, Inc.’s Notice of Opposition** was served on Opposer/Counterclaim Respondent Delson Group, Inc. via first-class mail, postage pre-paid, and addressed as follows:

Willie W. Lu
President
DELSON GROUP, INC.
1218 Bubb Road
Cupertino, CA 95014



Sabina A. Vayner
Attorney GSMA Ltd.

CERTIFICATE OF TRANSMITTAL

This is to certify that a true and correct copy of the attached **Applicant GSMA Ltd.’s Answer, Affirmative Defenses, and Counterclaims to Opposer Delson Group, Inc.’s Notice of Opposition** is being filed electronically with the TTAB via ESTTA on April 14, 2014.



Sabina A. Vayner
Attorney for GSMA Ltd.

EXHIBIT A

FILED IN CHAMBERS
U.S.D.C. Atlanta

OCT 21 2008

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION

JAMES N. HATTEN, Clerk
[Signature]
Deputy Clerk

GSMC Limited)	
)	
Plaintiff,)	
v.)	Civil Action No.:
)	1:08-CV-2092-ODE
Delson Group, Inc.,)	
)	
Defendant.)	

FINAL JUDGMENT

In accordance with the Court's August 27, 2008 Order [#7], it is hereby ORDERED that:

1. Judgment is hereby entered in favor of Plaintiff and against Defendant as to all counts of Plaintiff's Complaint.
2. Defendant and all its agents, officers, employees, representatives, successors, assigns, attorneys, and all other persons acting for, with, by, through, or under authority from Defendant, or in concert or participation with Defendant, and each of them, are hereby enjoined from:
 - (a) advertising, promoting, or marketing conference or event services under the name Mobile World Congress, World Mobile Congress, or any other similar name;

(b) advertising, promoting, or marketing conference or event services using any logo, font, color scheme or other indicia identical or similar to the logo, font, or color scheme used by Plaintiff in connection with its GSMA Mobile World Congress;

(c) using any false descriptions or representations or any false designations of origin in any advertising, promotion, or marketing;

(d) expressly or by implication representing in any advertising, promotion, or marketing that services offered by Defendant are affiliated with, or authorized, licensed, endorsed or sponsored by Plaintiff or any of its subsidiaries, affiliates or related companies;

(e) making or engaging in any false descriptions, false designations, or false representations in any advertising, promotion, or marketing in violation of Section 43(a) of the Lanham Act or state law; and

(f) otherwise unfairly competing with Plaintiff in any manner whatsoever involving Defendant's advertising, promotion, or marketing of any event or conference.

SO ORDERED, this 20 day of October 2008.



ORINDA D. EVANS
UNITED STATES DISTRICT JUDGE

Prepared by:

s/ Alex S. Fonoroff

William H. Brewster (Ga. Bar No. 080422)

Alex S. Fonoroff (GA Bar No. 267457)

Lauren A. Linder (Ga. Bar No. 443276)

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Attorneys for Plaintiff GSMC Limited

EXHIBIT B

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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

DELSON GROUP, INC.,

Plaintiff,

No. C 12-02358 JSW

v.

GSM ASSOCIATION and GSMA LTD.,

Defendants.

JUDGMENT

Pursuant to the Order granting the motion to dismiss based on lack of subject matter jurisdiction filed by defendants GSM Association and GSMA Ltd., this action is DISMISSED. The Clerk is directed to close the file.

IT IS SO ORDERED.

Dated: August 6, 2012



JEFFREY S. WHITE
UNITED STATES DISTRICT JUDGE