

ESTTA Tracking number: **ESTTA845328**

Filing date: **09/12/2017**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	SWITCH, LTD.		
Entity	Limited Liability Company	Citizenship	Nevada
Address	7135 S. Decatur Blvd. Las Vegas, NV 89118 UNITED STATES		

Attorney information	Samuel Castor SWITCH, LTD. 7135 S. Decatur Blvd. Room 221 Las Vegas, NV 89118 UNITED STATES Email: IP@switch.com Phone: 7024444102		
----------------------	---	--	--

Applicant Information

Application No	87406710	Publication date	08/29/2017
Opposition Filing Date	09/12/2017	Opposition Period Ends	09/28/2017
Applicant	Minessale, Anthony 17410 Morningview Ct Brookfield, WI 53045 UNITED STATES		


Goods/Services Affected by Opposition

Class 009. First Use: 2005/11/01 First Use In Commerce: 2006/01/01 All goods and services in the class are opposed, namely: Downloadable computer software for multi-media telecommunications using audio, video and text messages, namely, software for allowing telephone communication for use with analog telephones, digital telephones, IP telephones, digital and analog telephone circuits and downloadable telecommunications software for providing voice over IP services, instant messaging and communicating over the internet
Class 042. First Use: 2005/11/01 First Use In Commerce: 2006/01/01 All goods and services in the class are opposed, namely: Software, computer technology, and IT consulting services; Telecommunications technology consultancy

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3229168	Application Date	10/27/2005
Registration Date	04/17/2007	Foreign Priority Date	NONE
Word Mark	SWITCH		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 038. First use: First Use: 2003/08/31 First Use In Commerce: 2003/08/31 Providing telecommunications connections to a global computer network</p> <p>Class 042. First use: First Use: 2003/08/31 First Use In Commerce: 2003/08/31 Colocation services, namely, providing secure environmentally-controlled facilities and technical monitoring for the computers and telecommunications equipment of others and providing secure environmentally-controlled facilities and technical monitoring of computer and telecommunications equipment for business continuity and disaster avoidance</p>		

Attachments	78742001#TMSN.png(bytes) Notice of Opposition FREESWITCH w EXHIBIT 091217.pdf(79962 bytes)
-------------	--

Signature	/Samuel Castor/
Name	Samuel Castor
Date	09/12/2017

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

In re Application No. 87/406,710

Filed: April 11, 2017

Mark: FREESWITCH

Published in the *Official Gazette* (Trademarks) on: August 29, 2017

SWITCH, LTD.,

Opposer,

Opposition No. _____

v.

Anthony Minessale,

Applicant.

NOTICE OF OPPOSITION

Switch, Ltd. (“Opposer”), a limited liability company organized and existing under the laws of Nevada, whose registered office is at 7135 S Decatur Blvd, Las Vegas, Nevada 89118, believes that it will be damaged by registration of the mark FREESWITCH (“the Opposed Mark”), shown in Application Serial No. 87/406,710 (“the Application”), applied for by Anthony Minessale, a United States citizen located at 17410 Morningview Ct., Brookfield, Wisconsin 53045 (“Applicant”), and hereby opposes the same. Opposer opposes registration on the basis of a likelihood of confusion pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), and likelihood of dilution pursuant to Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c). In support of its opposition, Opposer alleges the following:

1. Opposer is the exclusive owner of several SWITCH and SWITCH-related marks, and variations thereof, for a wide variety of goods and services including, without limitation, colocation services, namely, providing secure environmentally-controlled facilities and technical monitoring for the computers and telecommunications equipment of others (“Opposer’s Marks”). Opposer is the owner of a service mark with United States Registration Number 3229168, registered April 17, 2007, with a date of first use of August 31, 2003, in addition to many other SWITCH-related marks, all of which shall be referred to collectively as “Opposer’s Registrations.”
2. Switch owns multiple United States Trademark Registrations for its SWITCH-related marks. Each of the below marks are filed in either International Class 009 or International Class 042, or both. These registrations reflect the longevity and pervasiveness of Switch’s brand:

SWITCH (U.S. Reg. No. 3,229,168)

SWITCH T-SCIF (U.S. Reg. No. 3,547,908)

SWITCH WDMD (U.S. Reg. No. 3,540,816)

SWITCHNAP (U.S. Reg. No. 3,547,909)

SWITCHNAP WORLD (U.S. Reg. No. 3,880,400)

SWITCHFORCE (U.S. Reg. No. 3,942,121)

SWITCH MICRO-MOD (U.S. Reg. No. 4,062,244)

SWITCHSERVE (U.S. Reg. No. 4,058,546)
SWITCHMOD (U.S. Reg. No. 3,984,525)
SWITCH L.D.C. (U.S. Reg. No. 3,984,524)
SWITCHCLOUD I.C.E. (U.S. Reg. No. 4,062,248)
SWITCHSTACK (U.S. Reg. No. 4,107,725)
SWITCH IC3 (U.S. Reg. No. 4,104,345)
SWITCHCUBE (U.S. Reg. No. 4,335,332)
SWITCHSCRIBE (U.S. Reg. No. 4,217,085)
SWITCHGAUNTLET (U.S. Reg. No. 4,516,916)
SWITCHWORKS (U.S. Reg. No. 3,942,079)
SWITCHSAFE (U.S. Reg. No. 3,946,128)
SWITCHMACROMOD (U.S. Reg. No. 3,984,966)
SWITCH CLOUD AI (U.S. Reg. No. 4,050,103)
SWITCHEDUP (U.S. Reg. No. 4,062,245)
SWITCHCORE (U.S. Reg. No. 4,062,254)
SWITCHMICRO-MOD (U.S. Reg. No. 4,137,600)

 (U.S. Reg. No. 5266044)

3. Opposer's Registrations are valid and subsisting. The following Opposer's Registrations are incontestable: SWITCH (Reg. No. 3229168), SWITCH T-SCIF (Reg. No. 3547908), SWITCH WDMD (Reg. No. 3540816), SWITCHFORCE (Reg. No. 3942121), SWITCHL.D.C. (Reg. No. 3984524), SWITCHMACRO-MOD (Reg. No. 3984966), SWITCHMOD (Reg. No. 3984525), SWITCHNAP (Reg. No. 3547909), SWITCHNAP WORLD (Reg. No. 3880400), SWITCHSAFE (Reg. No. 3946128), and SWITCHWORKS (Reg. No. 3942079).
4. Given our efforts, Opposer's SWITCH trademark is famous and has been declared distinct and famous by the U.S. District Court of Nevada. We have provided a copy of the Order for your convenience, attached as **Exhibit A**.
5. On information and belief, on or about April 11, 2017, Applicant filed the Application to register on the Principal Register the service mark, FREESWITCH, in International Classes 009 and 042 in connection with *downloadable computer software for multi-media telecommunications using audio, video and text messages, namely, software for allowing telephone communication for use with analog telephones digital telephones, IP telephones, digital and analog telephone circuits and downloadable telecommunications software for providing voice over IP services, instant messaging and communicating over the internet (IC 009); for software, computer technology, and IT consulting services; and telecommunications technology consultancy (IC 042)*.
6. This Notice of Opposition is being timely filed.
7. Opposer has rights in and to Opposer's Marks and Opposer's Registrations prior to Applicant's first actual or constructive use of the Opposed Mark.
8. The Opposed Mark resembles Opposer's Marks as to be likely, when used on or in connection with Applicant's goods, to cause confusion, to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d), as amended. The Opposed Mark also conveys the same commercial impression to Opposer's Marks.
9. The services in the Application are similar and related to the services used in connection with Opposer's Marks. Applicant's use and registration of the FREESWITCH mark in connection with its services is likely to cause and/or has caused confusion, deception and/or mistake among the relevant public.

10. Applicant's use and registration of the Opposed Mark is likely to and/or has falsely suggested a connection with Opposer and Opposer's Marks. The purchasing public is likely to be led to believe or has believed that goods bearing the Opposed Mark are related, approved, licensed or sponsored by Opposer or that Applicant and its business are owned by or are affiliated with Opposer and its business.
11. If Applicant is permitted to use the Opposed Mark as specified in the Application, in international classes 009 and 042, confusion in trade resulting in damage and injury to Opposer would be accused and would result by reason of the similarity between the Opposed Mark and Opposer's Marks. Consumers familiar with Opposer's Marks would be likely to believe or caused to believe Applicant's services are provided by Opposer or provided with Opposer's authorization or approval. Any such confusion would inevitably result in lost sales for Opposer and unjust enrichment to Applicant. Furthermore, any defect, objection or fault found with Applicant's services marketed under the Opposed Mark would necessarily injure Opposer's reputation and the goodwill Opposer has established in Opposer's Marks, thereby diluting Opposer's Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. §1125(c).
12. Opposer believes it will be or has been damaged by registration of the Opposed Mark because such registration would give Applicant at least *prima facie* exclusive right to use the Opposed Mark in commerce in the United States, in derogation of Opposer's senior rights in Opposer's Marks.
13. Applicant's use and registration of the Opposed Mark will damage and/or has damaged Opposer, its business, and its goodwill.

PRAYER FOR RELIEF

WHEREFORE, Opposer believes and avers that it will be damaged by the registration of the Opposed Mark, SWITCH, and prays for judgment sustaining this opposition and refusing the registration of the Application, and that such other and further relief as is deemed just and proper be granted.

Opposer submits herewith the requisite filing fee in the amount of \$400.

Respectfully submitted,

SWITCH, LTD.

Dated: September 12, 2017

By: s/ Samuel Castor /
Samuel Castor
Deputy General Counsel
SWITCH, LTD.
7135 S. Decatur Blvd.
Las Vegas, Nevada 89118
Telephone: (702) 444-4102
IP@switch.com

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION has been served upon Applicant's Attorney by depositing a copy of the same in the United States mail, first class postage prepaid, with a courtesy copy by email, addressed to:

Laura J. Grebe
Husch Blackwell LLP
555 E. Wells St. Suite 1900
Milwaukee, Wisconsin 53202
ptomailbox@whdlaw.com

Dated: September 12, 2017

By: s/Feather Lake/
Feather Lake

1 MARK G. TRATOS, ESQ.
 Nevada Bar No. 1086
 tratosm@gtlaw.com
 2 LAURI S. THOMPSON, ESQ.
 Nevada Bar No. 6846
 3 thompsonl@gtlaw.com
 SHAUNA L. NORTON, ESQ.
 4 Nevada Bar No. 11320
 nortons@gtlaw.com
 5 GREENBERG TRAUIG, LLP
 3773 Howard Hughes Parkway
 6 Suite 400 North
 Las Vegas, Nevada 89169
 7 Telephone: (702) 792-3773
 Facsimile: (702) 792-9002
 8 *Counsel for Plaintiff*

9
 10 **UNITED STATES DISTRICT COURT**
DISTRICT OF NEVADA

11 SWITCH, LTD. a/k/a SWITCH
 12 COMMUNICATIONS GROUP, LLC,
 a Nevada limited liability company,

Case No.: 2:14-cv-01727-APG-NJK

13 Plaintiff,

**ORDER GRANTING
 STIPULATION FOR ENTRY OF
 PERMANENT INJUNCTION**

14 v.

15 FIRESPOTTER LABS a/k/a SWITCH
 16 COMMUNICATIONS, INC., a
 Delaware corporation,

17 Defendant.
 18

19
 20 This Court having reviewed and considered the Stipulation for Entry of Permanent Injunction
 21 submitted by Plaintiff Switch Ltd. aka Switch Communications Group, LLC, (“Plaintiff Switch”)
 22 and Defendant Firespotter Labs aka Switch Communications, Inc. (“Firespotter”) by and through
 23 their respective counsel of record, and for good cause appearing therefore:

24 IT IS HEREBY ORDERED, ADJUDGED AND DECREED THAT:

25 1. This Decree shall be the final judgment with prejudice of all claims each of the
 26 parties has raised against the other in this lawsuit, including all claims and counterclaims.

27 2. Plaintiff Switch designs, constructs, and operates the world’s most powerful
 28 telecommunications offerings, data centers, and service technology ecosystems.

GREENBERG TRAUIG, LLP
 3773 Howard Hughes Parkway, Suite 400 North
 Las Vegas, Nevada 89169
 Telephone: (702) 792-3773
 Facsimile: (702) 792-9002

1 3. Plaintiff Switch owns the mark SWITCH and multiple variants thereto, and has
 2 continuously been using the trademark SWITCH in connection with its data center, colocation,
 3 telecommunications, and cloud computing services in commerce since at least as early as November
 4 30, 2003.

5 4. Plaintiff Switch owns multiple U.S. federal trademark registrations for its “SWITCH”
 6 marks, including but not limited to, SWITCH (U.S. Reg. No. 3,229,168), SWITCH T-SCIF (U.S.
 7 Reg. No. 3,547,908), SWITCH WDMD (U.S. Reg. No. 3,540,816), SWITCHNAP (U.S. Reg. No.
 8 3,547,909), SWITCHNAP WORLD (U.S. Reg. No. 3,880,400), SWITCHFORCE (U.S. Reg. No.
 9 3,942,121), SWITCH MICRO-MOD (U.S. Reg. No. 4,062,244), SWITCHSERVE (U.S. Reg. No.
 10 4,058,546), SWITCHMOD (U.S. Reg. No. 3,984,525), SWITCH L.D.C. (U.S. Reg. No. 3,984,524),
 11 SWITCHCLOUD I.C.E. (U.S. Reg. No. 4,062,248), SWITCHSTACK (U.S. Reg. No. 4,107,725),
 12 SWITCH IC3 (U.S. Reg. No. 4,104,345), SWITCHCUBE (U.S. Reg. No. 4,335,332),
 13 SWITCHSCRIBE (U.S. Reg. No. 4,217,085), SWITCHGAUNTLET (U.S. Reg. No. 4,516,916)
 14 SWITCHGAUNTLET (U.S. Reg. No. 4,516,916) SWITCHWORKS (U.S. Reg. No. 3,942,079),
 15 SWITCHSAFE (U.S. Reg. No. 3,946,128), SWITCHMACROMOD (U.S. Reg. No. 3,984,966),
 16 SWITCH CLOUD AI (U.S. Reg. No. 4,050,103) SWITCHEDUP (U.S. Reg. No. 4,062,245),
 17 SWITCHCORE (U.S. Reg. No. 4,062,254), and SWITCHMICRO-MOD (U.S. Reg. No. 4,137,600)
 18 (collectively hereinafter referred to as the “Switch Marks”).

19 5. Based on Plaintiff Switch’s federal registrations and extensive use, Plaintiff Switch
 20 owns the exclusive right to use the mark SWITCH and the Switch Marks in connection with
 21 telecommunications, data center, colocation, and cloud computing services.

22 6. The extensive advertising and promotion by Plaintiff Switch of the Switch Marks
 23 throughout the United States and around the world have resulted in the SWITCH name and mark
 24 being distinctive and famous for telecommunications services, data center, colocation, and cloud
 25 computing services.

26 7. On or about October 1, 2014, Firespotter, a technology start-up company located in
 27 San Francisco, California, began providing a cloud-based telephone system under the marks
 28 SWITCH and SWITCH.CO. In connection with its services, on or around July 27, 2014, Firespotter

1 acquired the Internet domain name <switch.co> and created the corresponding website.

2 THEREFORE, IT IS FURTHER ORDERED that Plaintiff Switch’s request for Permanent
3 Injunction is GRANTED, subject to the transition period agreed upon by the parties. Firespotter, its
4 respective officers, agents, servants, employees, affiliates, and/or all persons acting in concert or
5 participation with it, are permanently enjoined (1) from using Plaintiff Switch’s SWITCH trademark,
6 the Switch Marks, or confusingly similar variations thereof, alone or in combination with any other
7 letters, words, letter strings, phrases or designs, in commerce or in connection with any business or
8 for any other purpose (including, but not limited to, on web sites and in domain names); and (2) from
9 registering, owning, leasing, selling or trafficking in any domain name containing Plaintiff Switch’s
10 Switch Marks or confusingly similar variations thereof, alone or in combination with any other
11 letters, words, phrases or designs as the SWITCH mark is a famous mark.

12 The claims Firespotter has raised in this lawsuit are DENIED with prejudice.

13 IT IS SO ORDERED this 29th day of February, 2016.

14
15 
16 United States District Court Judge

17
18 Respectfully submitted by:

19 GREENBERG TRAUIG, LLP

20 /s/ Lauri S. Thompson
21 Mark G. Tratos, Esq.
22 Lauri S. Thompson, Esq.
23 Shauna L. Norton, Esq.
24 3773 Howard Hughes Pkwy.
25 Suite 400 North
26 Las Vegas, NV 89169
27 *Attorneys for Plaintiff*
28

GREENBERG TRAUIG, LLP
3773 Howard Hughes Parkway, Suite 400 North
Las Vegas, Nevada 89169
Telephone: (702) 792-3773
Facsimile: (702) 792-9002