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

Proceeding	91236632
Party	Defendant Minessale, Anthony
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**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. 91236632

Anthony Minessale,

Applicant.

ANSWER

Applicant, Anthony Minessale (“Applicant”) submits the following responses to the Notice of Opposition filed by SWITCH, LTD. (“Opposer”).

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.”

ANSWER: Applicant lacks sufficient information to form a belief as to the truth of the allegations in this paragraph and therefore denies the same.

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)

SWITCHIC3 (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. Re. No. 3,942,079)

SWITCHSAFE (U.S. Reg. No. 3,946,128)

SWITCHMACROMOD (U.S. Reg. No. 3,984,966)

SWITCHCLOUD 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)

 **switch** (U.S. Reg. No. 5266044)

ANSWER: Applicant lacks sufficient information to form a belief as to the truth of the allegations in this paragraph and therefore denies the same.

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 WDM D (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).

ANSWER: Applicant lacks sufficient information to form a belief as to the truth of the allegations in this paragraph and therefore denies the same.

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**.

ANSWER: Applicant lacks sufficient information to form a belief as to the truth of the allegations in this paragraph and therefore denies the same.

5. On information and belief, on or about April 11, 2017, Applicant filed the Application to register on the Principle 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).*

ANSWER: Admitted.

6. This Notice of Opposition is being timely filed.

ANSWER: Applicant lacks sufficient information to form a belief as to the truth of the allegations in this paragraph and therefore denies the same.

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.

ANSWER: To the extent this averment calls for a legal conclusion, Applicant denies this averment. Applicant also lacks sufficient information on Opposer's actual use, if any, of Opposer's Marks and Opposer's Registrations. Applicant therefore cannot form a belief as to the truth of the allegations in this paragraph and denies the same.

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.

ANSWER: To the extent this averment calls for a legal conclusion and is vague/ambiguous, Applicant denies this averment. Applicant also lacks sufficient information on Opposer's actual use, if any, of Opposer's Marks and is therefore unable to form a belief as to whether Opposer's Marks may be considered to "resemble" or "convey the same commercial impression" as Applicant's Mark. Applicant therefore denies the averments of this paragraph 8.

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.

ANSWER: To the extent this averment calls for a legal conclusion and is vague/ambiguous, Applicant denies this averment. Applicant also lacks sufficient information on Opposer's actual use, if any, of Opposer's Marks and is therefore unable to form a belief as to whether any goods or services provided in connection with Opposer's Marks may be considered "similar and related" to Applicant's Mark and/or services provided in connection with Applicant's Mark. Applicant therefore denies the averments of this paragraph 9.

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.

ANSWER: Denied.

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).

ANSWER: Denied.

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.

ANSWER: Applicant does not have knowledge of and cannot speak to what Opposer "believes" and therefore denies the averments in this paragraph.

13. Applicant's use and registration of the Opposed Mark will damage and/or has damaged Opposer, its business, and its goodwill.

ANSWER: Denied.

WHEREFORE, Applicant denies that Opposer is entitled to any of the relief sought in its Notice of Opposition. Applicant respectfully requests that the Board dismiss this Opposition with prejudice and that Application Serial No. 87/406,710 be passed to registration.

AFFIRMATIVE DEFENSES

1. Opposer's claims are barred due to laches, estoppel, acquiescence, principles of waiver and/or prior registration.

2. Applicant is the owner of U.S. Registration No. 3,579,967,



(Applicant's "Registered Mark"). Applicant has used its "Registered Mark" in commerce for over a decade and has given Opposer constructive notice of that use by filing its U.S. trademark application with the U.S. Patent and Trademark Office in 2008. Applicant's Registered Mark includes the term "FreeSWITCH" which is identical to the Opposed Mark. Opposer's claims are therefore barred by Applicant's prior registration of the Registered Mark and the doctrines of laches, waiver, acquiescence and/or estoppel.

For all the reasons set forth herein, Opposer's Notice of Opposition should be dismissed.

Dated: October 19, 2017

s/Laura J. Grebe/
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing ANSWER has been served upon Opposer'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:

Samuel Castor
SWITCH, LTD.
7135 S. Decatur Blvd. Room 221
Las Vegas, NV 89118
IP@switch.com

Dated: October 19, 2017

By: s/Laura J. Grebe/
Laura J. Grebe