

ESTTA Tracking number: **ESTTA913142**

Filing date: **08/01/2018**

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 parties oppose registration of the indicated application.

**Opposers Information**

Name	Overland Storage, Inc.
Granted to Date of previous extension	08/01/2018
Address	9112 Spectrum Center Blvd. San Diego, CA 92123 UNITED STATES

Name	Tandberg Data Holdings Sarl
Granted to Date of previous extension	08/01/2018
Address	46A AVENUE, J.F. KENNEDY LUXEMBOURG, L-1855 LUXEMBOURG

Attorney information	Jeffrey L. Van Hoosear KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES Email: <a href="mailto:efiling@knobbe.com">efiling@knobbe.com</a> Phone: 949-760-0404
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**Applicant Information**

Application No	87976599	Publication date	04/03/2018
Opposition Filing Date	08/01/2018	Opposition Period Ends	08/01/2018
International Registration No.	NONE	International Registration Date	NONE
Applicant	TANDBERG AS Nordengveien 14 Billingstad, NO-1396 NORWAY		

**Goods/Services Affected by Opposition**

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Business advisory services in the field of computer software and hardware for teleconferencing and video conferencing for others
Class 038. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Teleconferencing and video conferencing-services, namely, provisioning of Internet-protocol based network devoted to video communications


and, namely, cloud-based video conferencing services, transmission of audio, video, data and graphicscommunications via data and telecommunication networks; electronic data interchange services; provision of telecommunication access to databases and video network

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Other	common-law rights

## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1655286	Application Date	02/22/1990
Registration Date	09/03/1991	Foreign Priority Date	NONE
Word Mark	TANDBERG DATA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1984/00/00 First Use In Commerce: 1984/00/00 tape streamers, [ video display terminals, ] cleaning cartridges for tape streamers, [ keyboards for computer terminals, ] tape duplication apparatus [ , personal computer monitors and associated processor cards sold together as a unit, video monitors, and keyboards for personalcomputers ]		

U.S. Registration No.	3996764	Application Date	11/10/2010
Registration Date	07/19/2011	Foreign Priority Date	NONE
Word Mark	TANDBERG DATA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 COMPUTER BACKUP AND DATA STORAGE SYSTEMS; HARDWARE AND SOFTWARE FOR DATA STORAGE, BACKUP AND ARCHIVING; DATA PROTECTIONAPPLIANCES PRIMARILY CONSISTING OF INTEGRATED HARDWARE AND SOFTWARE; REMOVABLE HARD DRIVE BASED COMPUTER BACKUP SYSTEMS; MAGNETIC TAPE DRIVES; TAPE AUTOLOADERSAND TAPE LIBRARIES; STORAGE MEDIA, NAMELY, BLANK TAPE AND DISK CARTRIDGES		

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	OVERLAND-TANDBERG
Goods/Services	Computer hardware and computer software for data storage and retrieval, data archiving, data management and data protection Providing electronic data storage services; providing on-line non-downloadable software for data storage and retrieval, data archiving, data management and data protection; software as a service (SAAS) services featuring software for data storage and retrieval, data archiving, data management and data protection

Attachments	85173446#TMSN.png( bytes ) 2018-08-01 Notice of Opposition - OVERLND.360M.pdf(491156 bytes )
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Signature	/Jeff Van Hoosear/
Name	Jeffrey L. Van Hoosear
Date	08/01/2018

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

OVERLAND STORAGE, INC. and TANDBERG	)	Opposition No.: _____
	)	
DATA HOLDINGS S.à.r.l.,	)	Serial No.: 87/976599
	)	Mark: TANDBERG
	)	
Opposer,	)	
	)	
v.	)	
	)	
TANDBERG AS	)	
	)	
Applicant.	)	

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**NOTICE OF OPPOSITION**

Commissioner for Trademarks  
P.O. Box 1451  
Arlington, VA 22313-1451

Dear Sir or Madam:

Pursuant to TBMP § 303.06 Overland Storage, Inc., a California corporation, having a principal place of business at 9112 Spectrum Center Blvd., San Diego, CA 92123 and Tandberg Data Holdings, S.à.r.l., a Luxembourg limited liability company with principal address of 46A Avenue J.F. Kennedy, 1855 Luxembourg, believe that they are or will be damaged by registration of the mark shown in Application Serial No. 87/976599 for the mark TANDBERG (“Applicant’s Application”), filed on September 15, 2016 by Tandberg AS, a Norwegian corporation with principal address of Nordengveien 14, Billingstad, Norway NO-1396 (“Applicant”), and hereby oppose the same. A description of Applicant’s Application is as follows:

Mark : TANDBERG  
Serial No. : 87/976599  
Classes : 35 and 38  
Services : Business advisory services in the field of computer software and hardware for teleconferencing and video conferencing for others in Class 35  
Teleconferencing and video conferencing services, namely, provisioning of Internet-protocol based network devoted to video communications and, namely, cloud-based video conferencing services, transmission of audio, video, data and graphics communications via data and telecommunication networks; electronic data interchange services; provision of telecommunication access to databases and video network in Class 38  
Filed : September 15, 2016  
Filing Basis : 1(b)  
Published : April 3, 2018

As grounds for opposition, it is alleged:

1. Overland Storage, Inc. and Tandberg Data Holdings, S.à.r.l., their predecessors-in-interest and affiliated/related companies (hereinafter collectively referred to as “Opposers”) are leaders worldwide in the field of data storage, data management, and data protection. Opposers’ strong reputations in the field of data storage, data protection, and data protection is built on their exceptional products and services.

2. Among the marks owned and used by Opposers are the marks TANDBERG DATA and OVERLAND-TANDBERG (hereinafter referred to as “Opposers’ TANDBERG Marks”). Opposers have used and promoted one or more TANDBERG Marks in the United States since at least as early as the filing date and constructive priority date of Applicant’s Application in connection with computer data storage, data management and data storage protection goods and services (“Opposers’ Goods and Services”).

3. Since prior to the filing date and constructive priority date of Applicant’s Application, Opposers have spent considerable time, effort and money in developing their reputation under

Opposers' TANDBERG Marks. As a result of this investment and the popularity and widespread commercial success of Opposers' goods and services offered in connection with the TANDBERG Marks, Opposers have developed goodwill and recognition in Opposers' TANDBERG Marks.

4. Since prior to the filing date and constructive priority date of Applicant's Application, Opposers have continuously used and promoted Opposers' TANDBERG Marks in the United States in connection with Opposers' business. By virtue of Opposers' continuous and substantial use, Opposers' TANDBERG Marks have become an identifier of Opposers and distinguish Opposers' Goods and Services from the goods and services of others. As a result, Opposers have built up, at great expense and effort, extensive and valuable goodwill in Opposers' TANDBERG Marks.

5. Opposers have extensive non-registered statutory and common law rights in Opposers' TANDBERG Marks. Opposers' common law rights in Opposers' TANDBERG Marks predate the filing date and constructive priority date of Applicant's Application. Opposers' rights in Opposers' TANDBERG Marks are prior and superior to Applicant's rights in its TANDBERG mark.

6. Opposers own and rely on United States Trademark Registration No. 1,655,286 (the '286 Registration) for the mark TANDBER DATA for "tape streamers, cleaning cartridges for tape streamers, tape duplication apparatus" in International Class 9. The '286 Registration was filed on February 22, 1990. Thus, the filing date of the '286 Registration is prior to the filing date and constructive priority date of Applicant's Application. This registration is valid, subsisting, unrevoked and uncanceled; as such it constitutes *prima facie* evidence of the validity of the registered mark and of the registration thereof, and of Opposers' ownership of the mark

shown therein. Opposers' registration also constitutes notice to the Applicant of Opposers' claim of ownership of the mark therein as provided in Sections 7(b), 22 and 33(a) of the Trademark Act. In view of the virtually identical marks and related nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resemble Opposers' TADNBERG Marks as to be likely to cause confusion or to cause mistake or deceive. A true and correct copy of a print out from the electronic database records of the PTO showing the current status and title of the registration is attached hereto as Exhibit 1.

7. Opposers own and rely on incontestable United States Trademark Registration No. 3,996,764 (the '764 Registration) for the mark TANDBERG DATA for "computer backup and data storage systems; hardware and software for data storage, backup and archiving; data protection appliances primarily consisting of integrated hardware and software; removable hard drive based computer backup systems; magnetic tape drives; tape autoloaders and tape libraries; storage media, namely, blank tape and disk cartridges" in International Class 9. The '764 Registration was filed on November 10, 2010. Thus, the filing date of the '764 Registration is prior to the filing date and constructive priority date of Applicant's Application. This registration is valid, subsisting, unrevoked and uncanceled; as such it constitutes *prima facie* evidence of the validity of the registered mark and of the registration thereof, and of Opposers' ownership of the mark shown therein. Opposers' registration also constitutes notice to Applicant of Opposers' claim of ownership of the mark shown therein. Opposers' registration also constitutes notice to Applicant of Opposers' claim of ownership of the mark therein as provided in Sections 7(b) and 33(a) of the Trademark Act. In view of the virtually identical marks and related nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resemble Opposers' TANDBERG Marks as to be likely to cause confusion or to cause

mistake or to deceive. A true and correct copy of a print out from the electronic database records of the PTO showing the current status and title of the registration is attached hereto as Exhibit 2.

8. Opposers' Federal Registrations are derived from applications filed in the PTO on dates prior to the filing of Applicant's Application. Opposers' Federal Registrations are valid and subsisting. In view of the substantial similarity of the respective marks and the related nature of the goods and services of the respective parties, it is alleged that the mark in the Applicant's Application so resembles the registered marks in Opposers's Federal Registrations, previously used in the United States and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive.

9. Opposers have non-registered statutory and common law rights in Opposers' OVERLAND-TANDBERG mark. Opposers' common law rights in Opposers' OVERLAND-TANDBERG mark predates the filing date and constructive priority date of Applicant's Application.

10. The TANDBERG mark covered under Applicant's Application is confusingly similar to Opposers' TANDBERG Marks. In addition, the goods and services covered in Applicant's Application are identical or highly related to and complimentary to Opposers' Goods and Services on which Opposers use Opposers' TANDBERG Marks. Moreover, the respective goods and services are marketed to the same consumers and potential consumers through similar channels of trade in the United States.

11. If Applicant is permitted to register the mark shown in Applicant's Application, Applicant's corresponding *prima facie* exclusive right to use the TANBERG mark in nationwide commerce will conflict with Opposers' lawful and *prima facie* and prior exclusive right to use Opposers' TANDBERG Marks nationwide.



12. Opposers will be damaged by the registration of Applicant's TANDBERG mark in that the TANDBERG mark so resembles Opposers' TANDBERG Marks in which Opposers own prior federal and common law trademark rights, as to be likely, when used in connection with the services identified in Applicant's Application, as to cause confusion, or cause to mistake or deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1502(d).

13. In view of Opposers' prior rights in its TANDBERG DATA mark, Applicant is not entitled to registration of the TANDBERG mark in connection with the highly related services pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

14. By reason of all the foregoing, Opposer believes it will be damaged by the registration of Applicant's Application.

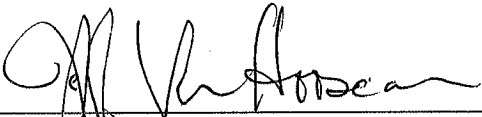
WHEREFORE, Opposer prays that Applicant's Application be rejected and stricken, that no registration be issued thereon to Applicant, and this opposition be sustained in favor of Opposer.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: August 1, 2018

By: \_\_\_\_\_

  
Jeffrey Van Hoosear  
2040 Main Street, 14<sup>th</sup> Floor  
Irvine, CA 92614  
(949) 760-0404  
Attorneys for Opposers,  
Overland Storage, Inc. and Tandberg Data  
Holdings, S.à.r.l.

TTAB Opposition No. \_\_\_\_\_  
Overland Storage, Inc. and Tandberg Data Holdings S. à.r.l. v. TANDBERG AS  
Notice of Opposition  
Serial No. 87/976599

## EXHIBIT 1



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# Typed Drawing

**Word Mark** TANDBERG DATA

**Goods and Services** IC 009. US 021 023 026 036 038. G & S: tape streamers, [ video display terminals, ] cleaning cartridges for tape streamers, [ keyboards for computer terminals, ] tape duplication apparatus [ , personal computer monitors and associated processor cards sold together as a unit, video monitors, and keyboards for personal computers ]. FIRST USE: 19840000. FIRST USE IN COMMERCE: 19840000

**Mark Drawing Code** (1) TYPED DRAWING

**Serial Number** 74031358

**Filing Date** February 22, 1990

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** June 11, 1991

**Registration Number** 1655286

**Registration Date** September 3, 1991

**Owner** (REGISTRANT) Tandberg Data A/S CORPORATION NORWAY Kjelsasveien 161 P.O. Boks 9 Korsvoll Oslo 8 NORWAY

(LAST LISTED OWNER) Tandberg Data Holdings Sarl CORPORATION LUXEMBOURG 46A AVENUE, J.F. KENNEDY LUXEMBOURG L-1855 LUXEMBOURG

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Amy Cohen Heller

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "DATA" APART FROM THE MARK AS SHOWN

**Type of Mark** TRADEMARK  
**Register** PRINCIPAL-2(F)  
**Affidavit Text** SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20110901.  
**Renewal** 2ND RENEWAL 20110901  
**Live/Dead Indicator** LIVE

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TTAB Opposition No. \_\_\_\_\_  
Overland Storage, Inc. and Tandberg Data Holdings S. à.r.l. v. TANDBERG AS  
Notice of Opposition  
Serial No. 87/976599

## EXHIBIT 2



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# TANDBERG DATA

**Word Mark**            **TANDBERG DATA**  
**Goods and Services**    IC 009. US 021 023 026 036 038. G & S: COMPUTER BACKUP AND DATA STORAGE SYSTEMS; HARDWARE AND SOFTWARE FOR DATA STORAGE, BACKUP AND ARCHIVING; DATA PROTECTION APPLIANCES PRIMARILY CONSISTING OF INTEGRATED HARDWARE AND SOFTWARE; REMOVABLE HARD DRIVE BASED COMPUTER BACKUP SYSTEMS; MAGNETIC TAPE DRIVES; TAPE AUTOLOADERS AND TAPE LIBRARIES; STORAGE MEDIA, NAMELY, BLANK TAPE AND DISK CARTRIDGES. FIRST USE: 19970000. FIRST USE IN COMMERCE: 19970000

**Standard Characters Claimed**  
**Mark Drawing Code**    (4) STANDARD CHARACTER MARK  
**Serial Number**        85173446  
**Filing Date**            November 10, 2010  
**Current Basis**         1A  
**Original Filing Basis**    1A  
**Published for Opposition**    March 29, 2011  
**Registration Number**        3996764  
**Registration Date**         July 19, 2011

**Owner** (REGISTRANT) Tandberg Data Holdings S.à.r.l. CORPORATION LUXEMBOURG Avenue J.F. Kennedy 46A Luxembourg LUXEMBOURG L-1855

**Attorney of Record** Jeffrey L. Van Hoosear

**Prior Registrations** 1655286

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "DATA" APART FROM THE MARK AS SHOWN

**Type of Mark** TRADEMARK

**Register** PRINCIPAL-2(F)

**Affidavit Text** SECT 15. SECT 8 (6-YR).

**Live/Dead Indicator** LIVE

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