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

Proceeding	91253736
Party	Defendant Nexsan Technologies
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Date	03/09/2020
Attachments	Nexsan Answer to Opposition No. 91253736.pdf(151600 bytes )

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

In the Matter of Application:

Serial No.: 86/948,640

Mark: UNITY

For: Computer hardware and software, namely, an enterprise-class data storage system with the ability to store data in block and file formats and provide enterprise file sync and share with mobile access and secure archive, for use by information technology departments in connection with management, storage, sharing and archiving of corporate data, none of the foregoing including communications transceivers or transceiver software or firmware, computer hardware, or software to allow users to access, store, and share information between public safety entities (International Class 9)

Published: December 31, 2019

Dell Inc. and EMC Corporation,

Opposers,

v.

Nexsan Technologies,

Applicant.

Opposition No. 91253736

Commissioner for Trademarks  
United States Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**ANSWER TO NOTICE OF OPPOSITION**

For its Answer to the Notice of Opposition (the "Notice") filed by Dell Inc. and EMC Corporation (collectively, "Opposers"), Nexsan Technologies Incorporated ("Applicant") responds with the following numbered answers to the numbered grounds and counts contained in

the Notice as follows. Applicant denies each and every allegation by Opposers not expressly admitted herein.

1. Applicant admits that Dell Inc. is a Delaware corporation, however, Applicant is without knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations of Paragraph 1 of the Notice and therefore otherwise denies the same.
2. Applicant admits that EMC Corporation is a Massachusetts corporation with a place of business at 176 South Street, Hopkinton, Massachusetts 01748, however, Applicant is without knowledge or information sufficient to form a belief as to the truth of the remainder of the allegations of Paragraph 2 of the Notice and therefore otherwise denies the same.
3. Applicant admits that Applicant is a Delaware corporation with an address at 900 E. Hamilton Avenue, Suite 230, Campbell, California 95008.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 of the Notice and therefore denies the same.
5. Applicant denies the allegations of Paragraph 5 of the Notice.
6. Applicant admits the allegations of Paragraph 6 of the Notice.
7. Applicant admits the allegations of Paragraph 7 of the Notice.
8. Applicant admits that on May 4, 2017, Applicant filed an Amendment to Allege Use, however Applicant alleged a first use in commerce date of *at least as early as* September 30, 2016, and therefore otherwise denies the remainder of the allegations of Paragraph 8 of the Notice.
9. Applicant admits the allegations of Paragraph 9 of the Notice.
10. Exhibit A and Exhibit B speak for themselves, thus no response is required. To the extent a response is required, Applicant admits that the *Oxford English Dictionary* defines “unity”

as “the fact or quality of being single or unitary; oneness, singleness,” among other definitions, including but not limited to “[s]enses relating to union, harmony, or agreement...[t]he quality or condition of being of one mind, feeling, opinion, purpose, or action,” and that the *Merriam-Webster Dictionary* defines “unity” as “the quality or state of not being multiple” or “a totality of related parts; an entity that is complex or systematic whole,” among other definitions, including but not limited to “a condition of harmony: accord.”

11. Exhibit C speaks for itself and appears to be a true and correct screenshot of <https://www.nexsan.com/products/unified-storage-unity/>, and thus no response is required. To the extent a response is required, Applicant admits that Applicant has described, “Nexsan Unity is unified storage with built in integration to offload data...” Applicant otherwise denies the remainder of the allegations of Paragraph 11 of the Notice.
12. Exhibit D speaks for itself and appears to be a true and correct screenshot of the webpage <https://www.nexsan.com/press-releases/nexsan-announces-unity-first-unified-storage-solution-with-secure-enterprise-file-sync-and-share-for-superior-performance-business-continuity-and-data-mobility/>. Applicant otherwise denies the remainder of the allegations of Paragraph 12 of the Notice.
13. Applicant admits that Exhibit E discusses “unified storage,” appears to have been published on October 11, 2010, and appears to be a true and correct screen shot of <https://www.cnet.com/news/is-it-unified-or-un-unified-storage/>. Applicant otherwise denies the remainder of the allegations of Paragraph 13 of the Notice.
14. Applicant admits that Exhibit F appears to be a true and correct copy of <https://www.storagereview.com/node/3427> and appears to have been published on or about

March 18, 2013. Applicant otherwise denies the remainder of the allegations of Paragraph 14 of the Notice.

15. Applicant denies the allegations of Paragraph 15 of the Notice.
16. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 16 of the Notice and therefore denies the same.
17. No response is required to Paragraph 17 of the Notice. To the extent a response is required, Applicant denies the allegations of Paragraph 17 of the Notice.
18. Applicant denies the allegations of Paragraph 18 of the Notice.
19. Applicant denies the allegations of Paragraph 19 of the Notice.
20. Applicant denies the allegations of Paragraph 20 of the Notice.
21. Applicant denies the allegations of Paragraph 21 of the Notice.
22. Applicant denies the allegations of Paragraph 22 of the Notice.
23. Applicant denies the allegations of Paragraph 23 of the Notice.

### **AFFIRMATIVE DEFENSES**

Applicant undertakes the burden of proof only as to those defenses deemed affirmative defenses by law, regardless of how such defenses are named below. Applicant expressly reserves the right to plead additional affirmative and other defenses should any such defenses become known through discovery. As and for its affirmative defenses, Applicant states as follows:

#### **First Affirmative Defense**

The Notice fails to state claim upon which relief can be granted. Opposers filed the Notice under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1), but has failed to allege adequately that UNITY is descriptive of the goods identified in Application Serial No. 86/948,640.

Opposers have alleged that “unified storage” is descriptive of the goods identified in Application Serial No. 86/948,640, but Applicant does not seek registration for the mark UNIFIED STORAGE. As demonstrated in Opposers’ own Exhibit C, Applicant itself describes, “Nexsan Unity is unified storage with built in integration to offload data,” using UNITY as the trademark of the product and “unified storage” to describe the product.

### **Second Affirmative Defense**

The Notice is barred by the doctrine of estoppel. Opposers applied for registration of the marks UNITY, EMC UNITY, and DELL EMC UNITY in connection with the same goods and/or services and as part of those applications, have alleged that UNITY is a valid trademark which ought to be registered to them in connection with those goods and/or services. Opposer EMC Corporation filed Application Serial No. 87/020,119 on April 29, 2016, to register the mark UNITY in connection with “Computer hardware for midrange data management and data storage; computer software for midrange data management and data storage” in International Class 9, “Customization of computer hardware for midrange data management and data storage” in International Class 37, and “Computer services, namely, computer consultation, customization of computer software, computer hardware and software design and development, deployment and installation of computer software, all in the field of midrange data management and data storage” in International Class 42. On the same day which Opposer EMC Corporation filed Application Serial No. 87/020,119, it also sent a cease and desist letter to Applicant, claiming prior trademark rights in the UNITY mark. In a prior opposition (Opposition No. 91230537) against Applicant’s application for the mark NEXSAN UNITY (Application Serial No. 86/948,652), Opposer EMC Corporation alleged that “[a]t least as early as May 2014...EMC began using the term UNITY for use in connection with products and services related to data storage systems that help simplify and

modernize mid-size companies' data centers (the 'Unity Products')” and that “EMC continued to market its UNITY Products in connection with the UNITY and EMC UNITY marks (the 'UNITY Marks’).” The USPTO Trademark Trial and Appeal Board suspended Opposition No. 91230537, pending the decision in a related civil action in the United States District Court for the District of Massachusetts, Case No. 1:16-cv-10847-WGY, in which the judge determined that Applicant, Nexsan, has priority over EMC to the UNITY trademark in relation to computer data storage and associated technologies. Opposers cannot now allege that UNITY is descriptive merely because the prior attempt to assert priority failed.

#### **Third Affirmative Defense**

The Notice is barred by the doctrine of waiver as a result of Opposers' own acts and/or omissions. Opposers had ample opportunity to allege that the mark UNITY is descriptive of the goods identified in Application Serial No. 86/948,640 during Opposition No. 91230537 and during Case No. 1:16-cv-10847-WGY in the District Court for the District of Massachusetts.

#### **Fourth Affirmative Defense**

The Notice is barred by the doctrines of laches and acquiescence as a result of Opposers' own acts and/or omissions. Opposers had ample opportunity to allege that the mark UNITY is descriptive of the goods identified in Application Serial No. 86/948,640 during Opposition No. 91230537 and during case no. 1:16-cv-10847-WGY in the District Court for the District of Massachusetts.

#### **Fifth Affirmative Defense**

For the reasons stated in the prior paragraphs, the Notice is barred by the doctrine of unclean hands.

WHEREFORE, Applicant prays for relief as follows:

That this Opposition be dismissed and that the trademark Application Serial No. 86/948,640 be allowed to register.

Dated: March 9, 2020  
Boston, Massachusetts

NEXSAN TECHNOLOGIES INCORPORATED

By its attorneys,



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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition has been served on March 9, 2020, to counsel for Opposers, Elizabeth Brenckman and R. David Hosp, by electronic mail to ebrenckman@orrick.com, dhosp@orrick.com, ipprosecution@orrick.com, and mweddington@orrick.com.



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Katherine W. Soule