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

Proceeding	92049903
Party	Plaintiff DIRECTV, Inc.
Correspondence Address	Nancy V. Stephens Foster Pepper PLLC 1111 3rd Avenue, Suite 3400 Seattle, WA 98101 UNITED STATES stepn@foster.com
Submission	Motion for Summary Judgment
Filer's Name	Nancy V. Stephens
Filer's e-mail	stepn@foster.com
Signature	/Nancy V. Stephens/
Date	05/15/2009
Attachments	GODISH SJ.PDF (15 pages)(617666 bytes)

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

In the matter of Trademark Registration No. 3072886

Filed: August 31, 2004

Trademark: GODISH and Design

Registered: March 28, 2006

DIRECTV, Inc.,

Petitioner,

v.

GoDish.com, Ltd.,

Respondent.

Cancellation No. 92049903

Registration No. 3072886

PETITIONER'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Petitioner DIRECTV, Inc., hereby moves for summary judgment granting its petition to cancel the registration of the mark "GODISH and Design" Registration No. 3072886. The Commissioner for Trademarks of the United States Patent and Trademark Office ("USPTO") determined a clear error was made in allowing the mark to be published which eventually led to the registration of the mark. This determination was not refuted by the Examining Attorney yet publication was not withdrawn and the mark was eventually allowed to register. Accordingly, the Petitioner respectfully submits as it is entitled to summary judgment on the grounds Registration No. 3072886 is void *ab initio* as there is no genuine issue as to any material fact that Registration No. 3072886 was published and registered in error.

Respondent's Registration History

Respondent's application was filed on August 31, 2004 on the basis of use (15 U.S.C. §1051(a)), and assigned Serial No. 78476558 ("Respondent's Application"). An Office Action issued in connection with Respondent's Application on March 30, 2005 indicating in part that, "The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d)." On October 11, 2005, Petitioner submitted a Letter of Protest to the Assistant Commissioner for Trademarks contesting the registration of Serial No. 78476558 on the basis of its prior registered marks which contained the same design presented in Respondent's mark and covering identical goods. [Exhibit "A"] The examination of Respondent's Application was completed sometime between September 30, 2005 and December 14, 2005. Respondent's Application was published on January 3, 2006.

Letter of Protest Granted

On February 2, 2006, Petitioner received a letter dated January 27, 2006 from the Commissioner for Trademarks authored by Jessie N. Roberts, Administrator for Trademark Classification and Practice. The letter stated, "the (October 11, 2005) Letter of Protest is hereby Granted." Further, the letter stated, "The Commissioner for Trademark has determined that a clear error was made in allowing this mark to be published. Accordingly, jurisdiction over the application has been restored to the Examining Attorney and the evidence attached to your Letter of Protest has been made of Record." Information regarding the Granting of the Letter of Protest was posted to the Trademark Document Retrieval database on January 24, 2006. [Exhibit "B"]

Petitioner continued to monitor the status of the application since the letter indicated that though the jurisdiction had been returned to the Examining Attorney, “further research by the Examining Attorney may indicate a refusal is inappropriate.” The mark was not “re-published” between January 24, 2006 and March 28, 2006. On March 28, 2006 the mark was registered.

On May 9, 2006 Petitioner’s counsel contacted Jessie Roberts inquiring as to why the mark was registered and subsequent inquiries were made after that time. On September 5, 2008, Petitioner took the only action available to Petitioner to correct the USPTO error without the assistance of the USPTO and filed its Petition to Cancel Respondent’s mark.

Respondent’s Mark was Erroneously Published

Respondent’s mark should have been withdrawn from publication after the Acting Deputy Commissioner for Trademark Operations determined that the publication of Respondent’s application constituted clear error and instructions were sent to the Examining Attorney.

Though Petitioner filed its Letter of Protest a full two months before the publication of Respondent’s Application, as the Letter of Protest was not granted until after publication, TMEP 1715.03 (Letters of Protest Filed After Publication) is instructive. TMEP 1715.03 states, “when a letter of protest is filed within 30 days after the date of publication, the Administrator will make an initial determination of whether publication of the mark constituted clear error, *i.e.*, whether the protestor presents *prima facie* evidence that supports a refusal of registration.” (Citing, *In re BPJ Enterprises Lt d.*, 7 USPQ2d 1375 (Comm’r Pats. 1988)).

In the instant case, the Administrator determined that the protestor (Petitioner) presented *prima facie* evidence supporting a refusal of the registration. A Memorandum was sent to the

Examining Attorney explaining, “It has been determined, by the Acting Deputy Commissioner for Trademark Operations, that a clear error has been made in allowing this mark to be published.”¹ The Memorandum further indicated that jurisdiction had been restored to the Examining Attorney and directing that if his further research, “indicates that a refusal is inappropriate, any decision to republish the mark rather than to issue a refusal to register the mark *must be made with the approval of the Administrator for Trademark Policy and Procedures*” (emphasis added). [See Memorandum included in Exhibit “B”]

There is no indication in the record for Respondent’s Registration that evidence presented in the Letter of Protest was ever considered by the Examining Attorney or that the Examining Attorney conducted any research leading to a conclusion that a refusal was inappropriate. It is possible no search was conducted by the Examining Attorney which uncovered Petitioner’s conflicting mark as the design codes for the nearly identical design marks may have been different. In the Memorandum from Jessie Roberts to Lynne Beresford and the subsequent Memorandum to Tom Vlcek the Managing Attorney for Law Office 155, Ms. Roberts states, “It should be noted that the “swoosh” design in protestor’s registrations was assigned a different design search code from the one assigned to the same design element in applicant’s mark. Further, there is no indication whatsoever that approval was granted by the Administrator for Trademark Policy and Procedures to register the mark which would have been required since its registration qualifies as, “action on the mark other than the refusal of the registration.” [See referenced memorandums included in Exhibit “B”] Further, it is a matter of law that the Examining Attorney has no involvement in decisions regarding a Letter of Protest.

¹ The Administrator considered Petitioner’s design element  and Respondent’s  and found them similar when used in connection with satellite broadcasting services.

In re BPJ Enterprises Lt d., 7 USPQ2d 1375. “The Office of the Director has been given broad discretion to make this determination objectively.” *Ibid.*

Conclusion

Petitioner prays that its Motion for Summary be granted as there is no genuine issue as to any material fact that Respondent’s mark was erroneously published. Petitioner’s Petition to Cancel stated the same facts herein presented and included copies of the same evidence. All relevant information is not only contained in Petitioner’s original pleading but is also contained in the USPTO records and therefore known and available to Respondent and a matter of public record. Petitioner respectfully submits that it is entitled to judgment as a matter of law and requests Registration No. 3072886 be cancelled as a matter of law and that proper USPTO procedure be followed regarding its further review.

DATED: May 15, 2009

Respectfully Submitted,

/Nancy V. Stephens/

Nancy V. Stephens

Attorney for Petitioner DIRECTV, Inc.

FOSTER PEPPER PLLC

1111 Third Avenue, Suite 3400

Seattle, Washington, 98101

CERTIFICATE OF SERVICE BY FIRST-CLASS MAIL

On May 15, 2009, I deposited in the United States Mail a properly addressed, postage prepaid envelope containing a true copy of this document served on:

John P. Courtney
Andrews & Kurth LLP
600 Travis, Suite 4200
Houston, TX 77002

I declare under the penalty of perjury of the State of Washington that the foregoing is true and correct.

DATED: May 15, 2009

FOSTER PEPPER PLLC

Elizabeth Whitney



October 11, 2005

VIA EXPRESS MAIL NO EL005955866US:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: **LETTER OF PROTEST**
U.S. Trademark Application Serial No. 78-476558
Mark: **GODISH** and **DESIGN** in Class 38 by GoDish.com Ltd.

Ladies and Gentlemen:

We write this Letter of Protest to bring your attention to Registration No. 2601497 by DIRECTV, Inc. for the Cyclone Design which should be cited against the pending application for GODISH and Design filed August 31, 2004, claiming a first use date of August 1, 2001. In addition, we also wish to draw attention to prior registrations and applications for other DIRECTV marks containing the Cyclone design which we believe impact the ability to grant registration to the mark GODISH and Design, some of which are pictured below.



Serial #78-476558



Reg. #2639279



Reg. #2601497



Shown as used.



Reg. #2715585

Registration No. 2601497 covers, among other goods and services, satellite television broadcasting services, broadcasting programs via a global computer network, providing and processing interactive access to information via an electronic communication network, electronic transmission of messages and data, and video broadcasting and messaging services in Int'l class 38. Both marks compete in the same channels of trade. The

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Washington

Assistant Commissioner for Trademarks
October 11, 2005
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GODISH mark is used by GODISH.COM, Ltd., a distributor of satellite television services provided by the Dish Network. The Dish Network is DIRECTV, Inc.'s largest competitor in the satellite television market.

The design used in the GODISH mark is nearly identical to the Cyclone design employed by DIRECTV, Inc. in conjunction with its goods and services since 1994. Over the past 11 years DIRECTV has cultivated a family of marks used in conjunction with its satellite television broadcasting services and other related goods and services. In addition to Registration Numbers 2715585, 2601497, 2639279 pictured above, DIRECTV is the owner of U.S. Trademark Registration Numbers 1989358, 2372271, 2525509, 2618102, 2618103, 2628178, 2738513, 2740757, 2820253, 2939061 and 2965464 all of which incorporate the Cyclone Design. DIRECTV also holds pending U.S. applications that incorporate the Cyclone design, see Serial Numbers 78-564081 and 76-342841.

We contend there is a strong likelihood of confusion between the prior registrations and applications owned by DIRECTV, Inc. for the Cyclone Design and the subject application for GODISH and Design. Through over 10 years of widespread advertising of the trademark DIRECTV and nationwide distribution of DIRECTV service, DIRECTV and its trademarks DIRECTV and Cyclone Design are well known in the United States and should be entitled to a broad scope of protection.

The applicant has applied to register GODISH with a design nearly identical to the DIRECTV Cyclone Design in connection with satellite television broadcasting services. These services are identical to services covered by DIRECTV Cyclone Design registrations. We believe the scope of coverage for the DIRECTV marks should extend to all goods and services within the telecommunications industry, they should at least be entitled to exclusive protection for the narrowly defined subset of class 38 services, "satellite television broadcast services."

The similarity in appearance between DIRECTV, Inc.'s family of Cyclone marks and the design used on the GODISH mark will tend to cause a likelihood of confusion between the two marks. Consumers encountering the subject applicant's mark will likely assume the GODISH and Design mark is either owned by DIRECTV, Inc. or used with their permission. The fact the marks both appear in a rectangle increases the opportunity for confusion as does the fact the two parties are direct competitors.

Please direct this Letter of Protest to the Director of the Trademark Examining Operation. Additionally, please direct any correspondence in connection with this Letter of Protest to my attention. If you should have any questions regarding this matter, please do not hesitate to contact me.

Very truly yours,

FOSTER PEPPER & SHEFELMAN



Nancy W. Stephens

Enclosures:

CERTIFICATE OF MAILING BY EXPRESS MAIL UNDER 37 CFR 1.10

“Express Mail” mailing label number EL005955866US

I hereby certify that this correspondence is being deposited with the United States Postal Service “Express Mail Post Office to Addressee” service under 37 CFR 1.10 on October 11, 2005, and is addressed to BOX RESPONSE NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Very truly yours,

FOSTER PEPPER & SHEFELMAN
PLLC

Adena Davis

Enclosed

CC:

EL005955866US



EL005955866US

POST OFFICE TO ADDRESSEE

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FROM: (PLEASE PRINT)
FOSTER PEPPER & SHEFELMAN PLLC
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Nancy Stephens
93483-1

PHONE (206) 447-8925

TO: (PLEASE PRINT)
ASSISTANT COMMISSIONER
FOR TRADE MARKS
2900 CRYSTAL DR
ARLINGTON VA 22202-3514

50588656.1

Docket No.: _____ Date: 10/11/05
Atty: Nancy Stephens S.N./Reg. No.: 78-476558
Applicant: DIRACON, Inc Int'l Classes: 38
Mark: GODDIT and DESIGN USE
Opposition No.: _____ ITU

The following have been received in the U.S. Patent and Trademark Office on the date stamped hereon via Certified Mail / Express Mail No. EL 005955866 US

- Certificate of Express Mailing Under 37 CFR 1.10
- Transmittal Letter of Intent Drawing of the Mark
- TM/SM Application Specimens/Facsimiles
- Declaration / Oath / Affidavit Change of Address
- Check for \$ _____ (# _____)
- _____
- _____

USPTO USE ONLY



Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
www.uspto.gov

MEMORANDUM:

DATE:

TO: Daniel S. Brody
Examining Attorney
Law Office 115

FROM: Jessie N. Roberts
Administrator for Trademark
Classification and Practice

SUBJECT: Letter of Protest concerning Application Serial No. 78476558

The above-referenced Letter of Protest contains the following objection:

The existence of Reg. Nos. 2601497 and 2715585 for a "swoosh" design used in connection with satellite broadcasting and other related services.

The following evidence was submitted and is attached hereto:

Information concerning Reg. Nos. 2601497 and 2715585 may be found in the Office records of TICRS, TRAM and X-Search.

This application was published for Opposition on January 3, 2006. It has been determined, by the Acting Deputy Commissioner for Trademark Operations, that a clear error has been made in allowing this mark to be published. Jurisdiction has been restored to the Examining Attorney to take appropriate action in accordance with the evidence contained herein. TMEP Section 1715.03.

If further research by the Examining Attorney indicates that a refusal is inappropriate, any decision to republish the mark rather than to issue a refusal to register the mark must be made with the approval of the Administrator for Trademark Policy and Procedures.

This memorandum and the attached evidence has been entered into the record. A copy must be mailed to the applicant upon return of the file to the Law Office.

The attached Office action has been prepared pursuant to a Letter of Protest that was filed concerning Serial No. 78476558. It has been approved for mailing by the undersigned.

Daniel S. Brody
Examining Attorney
Law Office 115

(Date)

Tom Vlcek
Managing Attorney
Law Office 115

(Date)

Sharon Marsh
Acting Administrator for Trademark
Policy and Procedures

(Date)

MEMORANDUM:

DATE:

TO: Tom Vlcek
Managing Attorney
Law Office 115

FROM: Jessie N. Roberts
Administrator for Trademark
Classification and Practice

SUBJECT: Restoration of Jurisdiction in Serial No. 78476558

Jurisdiction has been restored to the Examining Attorney by the Commissioner for Trademarks. Please have the Examining Attorney assigned to this case prepare an Office action in keeping with the information presented in the Letter of Protest for review by the Administrator for Trademark Policy and Procedures. It should be noted that the "swoosh" design in protestor's registrations was assigned a different design search code from the one assigned to the same design element in applicant's mark.

MEMORANDUM:

DATE:

TO: Lynne Beresford
Commissioner for Trademarks

FROM: Jessie N. Roberts
Administrator for Trademark
Classification and Practice

SUBJECT: Serial No. 78476558

Restoration of jurisdiction to the Examining Attorney is requested in trademark application Serial No. 78476558 under 37 C.F.R. Section 2.84(a).

JURISDICTION RESTORED

Lynne Beresford
Commissioner for Trademarks

(Date)

MEMORANDUM:

DATE:

TO: Lynne Beresford
Commissioner for Trademarks

FROM: Jessie N. Roberts
Administrator for Trademark
Classification and Practice

SUBJECT: Letter of Protest filed in reference to Trademark
Application Serial No. 78476558 for the mark
GO DISH & design

I recommend that this Letter of Protest be granted and jurisdiction be restored to the Examining Attorney for further action consistent with the information presented in the Letter of Protest.

Protestor's registrations incorporate a "swoosh" design that is highly similar that the one in applicant's mark. The services are identical. It should be noted that the "swoosh" design in protestor's registrations was assigned a different design search code from the one assigned to the same design element in applicant's mark.

If you are in agreement with my determination, please sign off on the enclosed Request for Jurisdiction. If you disagree with my determination, please return the application file to me and I will issue a denial letter to the protestor.