ESTTA Tracking number: **ESTTA719982**

Filing date: **01/12/2016**

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

Proceeding	92057631
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Date	01/12/2016
Attachments	XOpen's Reply Brief.pdf(29197 bytes)

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

X/Open Company Limited, Petitioner, v. Chong Teck Choy, an individual, Registrant.	In Re: Reg. No.: 4,098,948 Registered: November 29, 2011 Mark: XIUNIX Cancellation No. 92057631

X/OPEN'S REPLY BRIEF

I. PRELIMINARY STATEMENT

Chong Teck Choy's trial brief makes extremely clear that it has no evidence or legal support to defend its registration. Its laches claim is unavailing; it cannot explain its misrepresentation of use of XIUNIX at the time of filing the application; it cannot provide evidence that the XIUNIX mark is in actual use; and it cannot defend the fraud claim. Further, it is without dispute that X/Open has met its burden of proof of likelihood of confusion. Consequently, the registration for XIUNIX should be cancelled. The following arguments are tailored to respond to the points made in Chong Teck Choy's opposition papers.

II. ARGUMENT

A. The Affirmative Defense of Laches Does Not Apply

Laches is not a proper affirmative defense in this action. As a matter of procedure, Chong Teck Choy has no right to the affirmative defense of laches because the defense was not raised in its Answer. TBMP 311.02(c); Fed. R. Civ. P. 12(b). Even in the unlikely event that the Board

still considers a laches defense, as a legal matter it does not apply to actions based on fraud or non-use. *Ava Ruha Corp. v. Mother's Nutritional Ctr., Inc.* 113 USPQ 2d 1575, 1580 (TTAB 2015); *Hornby v. TJX Companies, Inc.*, 87 USPQ 2d 1411, 1419 (TTAB 2008). Although – if properly pleaded – the defense is, in principle, available as a defense against likelihood of confusion claims – proof of laches requires admissible evidence of (1) an undue or unreasonable delay, as well as (2) prejudice to the defendant. *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F. 3d 1359, 58 USPQ 2d 1460, 1462-1463 (Fed. Cir. 2001). Putting aside Chong Teck Choy's failure to plead laches, and putting aside the question of an undue or unreasonable delay in commencing this cancellation, there is absolutely no evidence that Chong Teck Choy suffered any prejudice since there has been no use of the mark. Tellingly, Chong Teck Choy does not even address prejudice in its papers because doing so would draw attention to the very fact that XIUNIX has not been used.

B. Chong Teck Choy Cannot Attack the UNIX Trademark

Chong Teck Choy is using its opposition papers to attempt to resurrect its failed collateral attack of the UNIX registrations. Chong Teck Choy has not timely pleaded cancellation of the UNIX marks, and the Board dismissed with prejudice Chong Teck Choy's wrongly filed companion cancellation actions, holding these two actions untimely filed compulsory counterclaims. [1] Further, Chong Teck Choy has misstated Steven Nunn's testimony and takes it out of context. Mr. Nunn has stated that the UNIX mark is licensed with an operating system software product. Nunn Tr. p. 14, lines 7 -8; Nunn Tr. p. 16, lines 7 -8. The mark is licensed for use on hardware and software. Nunn Tr. p. 19, lines 1-2.

[1] See, Board Order, dated 7/27/2005 Dkt. 8; Cancellations Nos. 92060287 and 92060293, both of these actions, attacking the UNIX registrations were dismissed with prejudice.

C. **The XIUNIX Registration is Void Ab Initio**

Chong Teck Choy submitted no relevant or admissible evidence of use of the XIUNIX mark on the services covered by the underlying application. When a website page is used as the specimen, use of the mark in commerce is established by the display of the mark on the website in association with the claimed services. C.F.R. 1301.04(a). For a use-based application, if there is no use at the filing date, the application is void. *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1362, 90 USPQ 2d 1301, 1307 (Fed. Cir. 2009); *Larry Harmon Pictures Corp. v. Williams Rest. Corp.*, 929 F. 2d 662, 18 USPQ 2d 1292, 1293 (Fed. Cir. 1991). Moreover, an applicant is required to both "offer" and "provide" the services in question on the date the application is filed. *Couture v. Playdom, Inc.*, 778 F. 3d 1379, 113 USPQ 2d 2042, 2044 (Fed. Cir. 2015).

Contrary to the Registrant's position, registration of a domain name, alone, does not constitute use in commerce. *In re Eilberg*, 49 USPQ 2d 1959 (TTAB 1998). The specimen of use – merely a landing page with links to public, governmental websites, rather a website used to offer the claimed services is not sufficient to prove use. For there to be an actual service, there must have been an "open and notorious public offering of the services to those for whom the services are intended." *Aycock Eng'g, Inc.*, 560 F.3d 1350, at 1362, 90 USPQ 2d at 1307 (Fed. Cir. 2009); *See also*, TMEP 1301.04(b). There is no record of either the offering or the provision of the services as of the date of the filing of the use-based application.

Chong Teck Choy now (improperly) claims that its own discovery responses submitted with the Notice of Reliance is proof of use. Chong Teck Choy simply cannot submit its own interrogatory responses as evidence of the use of the mark. 37 C.F.R. §2.120(j)(5). Such out of court statements offered for the truth of the matters asserted are nothing more than hearsay. Fed. R. Civ. P. 801 (c); 37 C.F.R. §101.02 (a). Moreover, these same responses (used by X/Open,

properly as admissions against interest) reveal the complete lack of use of the mark. Chong Teck Choy could not identify any U.S. customer for services under XIUNIX; could not identify the location of any sales of XIUNIX; and could not produce any evidence of the use of the mark on the services covered. See Notice of Reliance ¶¶ 15, 16; Exhibits 15 -16.

Accordingly, there is no relevant record evidence of use. Assertions made in the Registrant's brief are not recognized as evidence. *In re Jackson International Trading Co.*, 103 USPQ 2d 1417, 1420 (TTAB 2012); *citing*, *In re Simulations Publications, Inc.*, 521 F. 2d 797, 187 USPQ 147, 148 (CCPA 1975). The physical and largely irrelevant evidence of "use" proffered in this case only highlights the Registrant's lack of use of the mark. *See*, Supplemental Response to Interrogatory No. 18; Notice of Reliance ¶ 7; Exhibits 7, 13 – 18. The Registrant's inability to identify any purchaser of its services, or a location of sales is persuasive evidence of the lack of use of the mark. *See, e.g., Nationstar Mortg. LLC v. Ahmad*, 112 USPQ 2d 1361, 1373 (TTAB 2014).

D. The Record Establishes Fraud

This is not a case where a registrant mistakenly filed an application with inaccurate wording in the specification. Chong Teck Choy committed fraud on the USPTO office by filing the subject use-based application without any actual use of the mark on any of the applied-for services. The evidence of record includes:

1. The application, which contains claims of use of the mark on a laundry list of services, with a date of first use of July 4th – the date of the application, and the date of a federal U.S. holiday. [2]

2. Chong Teck Choy has no record of its first customer, no record of any geographic areas where services in U.S. commerce were rendered and has been unable to produce any evidence of use of the mark in U.S. commerce. See Notice of Reliance ¶¶ 6 – 9.

[2] Petitioner requests that the Board take judicial notice of the July 4th federal holiday.

3. The only documents produced by the Registrant are invoices from the Registrant for limited services rendered from an extraterritorial location to customers in that location, and documents that show the mark on products not covered the U.S. application.

4. The specimen of "use" is a landing page with links to government websites, and nothing that suggests the ability to offer services. There is no evidence of any sale of services through the website.

5. The XIUNIX mark was registered based on use in commerce as of the filing date on all of the services listed in the application, even though the mark was not used on any of the services. *Nationstar Mortg. LLC v. Ahmad*, 112 USPQ 2d at 1365

6. The statements made in trademark filings are presumed to be made with intent, and that intent has not been rebutted by any testimony, or submission of evidence of use. *Id.*

7. Chong Teck Choy did not attempt to correct the services listed in the underlying application prior to publication of the mark. *University Games Corp. v. 20Q.net Inc.*, 87 USPQ 2d 1465 (TTAB 2008).

E. The Record Establishes a Likelihood of Confusion

There is a preponderance of evidence of the likelihood of confusion. Chong Teck Choy has offered no relevant and admissible evidence to rebut X/Open's evidence. For Chong Teck Choy to state that there is currently no actual confusion in the marketplace is irrelevant. The test employed by the Board is of the likelihood of confusion, not actual confusion in the marketplace. Interestingly, the cases cited by Chong Teck Choy are federal court cases, which look at market conditions in a likelihood of confusion case.[3] Plainly, there could be no actual confusion – since the Registrant has not made use of the XIUNIX mark in U.S. commerce.

Chong Teck Choy concedes that X/Open uses both an "X" and UNIX as its trademark, but suggests that since there is no combined registration for "X" and UNIX, confusion is unlikely. The test for likelihood of confusion is not based on a side-by-side comparison, but by a review of the marks in their entireties based on sight, sound and meaning. In evaluating the

[3] *See Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., Inc,*. 875 F.2d 1026, 1029, 10 USPQ 2d 1961 (2d Cir. 1989); *First Savings Bank F.S.B. v. First Bank Systems, Inc.*, 101 F3d at 645, 653 910 USPQ 2d 1865, 1870 (10th Cir. 1996); *General Mills, Inc. v. Kellogg Co.*, 824 F.2d 622, 627 3 USPQ 2d 1442 (8th Cir. 1987); *Luigino's Inc. v. Stouffer Corp*., 50 USPQ 2d 1047.

similarities between the marks, emphasis must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the trademarks. *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013). Not only is there a visual similarity between the marks, but there is a virtual identical aural similarity, as Chong Teck Choy concedes, stating that the pronunciation of the mark is HUE NIX, as compared with Petitioner's YOU NIX. Thus, if there is even the slightest difference in sound, it is without any distinction. Further, not only does the undisputed fame of the UNIX mark entitle it to broad protection (Nunn Tr. p, 48, lines 14-25; Nunn Tr. p. 72, lines 10-21), but Chong Teck Choy's services, without question overlap with X/Open's goods and services.

III. CONCLUSION

For the forgoing reasons, it is respectfully requested that this Cancellation be sustained, and Chong Teck Choy's registration be cancelled.

Dated: January 12, 2016

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CERTIFICATE OF SERVICE

I hereby certify that on January 12, 2016, a true and correct copy of the foregoing **REPLY BRIEF** was placed in the United States Mail, addressed to:

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/s/ Jacqueline M. Lesser
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