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

Proceeding	92076846
Party	Plaintiff Picture Engine Company, Inc
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Date	09/06/2021
Attachments	OppositionToMotion.pdf(168026 bytes)

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

In the matter of trademark registration of:

Registrant: OpenSky Project, Inc
U.S. Trademark Registration No.: 6255115
Mark: AUCTION SNIPER
Registration Date: January 26, 2021

Petitioner: Picture Engine Company, Inc. in reference to: Cancellation No.: 92076846

vs.

Respondent: OpenSky Project, Inc

PETITIONER’S RESPONSE IN OPPOSITION
TO RESPONDENTS’ SECOND MOTION TO DISMISS

I. Introduction

1. Petitioner, Picture Engine Company, Inc. respectfully files this Response in opposition to Respondent’s Motion (Doc. #10) to dismiss the Petition to Cancel (“12(b)(6) Motion”). For clarification the words ‘Petitioner’, ‘Respondent’, and ‘Mark’ that are used in this document are from the referenced “in the matter of..” above, in addition the word ‘Petition’ below is in reference to the amended Petition to Cancel (Doc. #9). As such, this opposition document states:

2. Petitioner would like to thank the Respondent for the opportunity to add to and amend the growing pile of evidence and exhibitions of what is obvious, and the inevitable outcome of this Petition for Cancellation; That the Respondent's Mark is and always has been too generic to be a Mark, it has always been merely descriptive, and not nearly inherently distinctive nor could it be. To that end, the Board has already in the original Respondent's Registration, disclaimed the word "Auction" from the registration, this adds to the flavor of this obviousness, that the Mark could not be distinctive, is wholly generic and is merely descriptive as there is only one other word, which is just as generic. The Petition through motions and exhibits will finish the job that the Board started by disclaiming part of the Mark. This Mark is causing the Petitioner great harm in its business and to correct that, I will continue to make the Petition is bullet proof, and I will not stop until that bullet proof Petition is obvious to all involved.

II. Plaintiff's grounds for this Opposition are as follows:

1. In reference to Respondent's relevant parts of paragraph I.) : For the purposes of determining a motion to dismiss for failure to state a claim under 12(b), all of Petitioner's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to Petitioner. *Id.* "A complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In the context of cancellation proceedings before the Board, a claim is plausible on its face when

the petitioner pleads factual content that if proved, would allow the Board to conclude, or draw a reasonable inference that the petitioner has standing and a valid ground for cancellation exists.

Corporacion Habanos SA v. Rodriguez, 99 USPQ2d 1873, 1874 (TTAB 2011). Whether a petitioner can actually prove its allegations is a matter determined not upon a motion to dismiss, but rather at a final hearing or upon summary judgment. *Advanced Cardiovascular Systems*, 26 USPQ2d at 1041.

2. In reference to Respondent's relevant parts of paragraph II.) : Respondent refers to the six counts of the original Petition, as "Count I" through "Count VI" which I will maintain in this document. Most of the Respondent's paragraph II refers to the original petition, ignoring the amended Petition to cancel. The Board has not dismissed any of these counts in light of the amended Petition. If the Board continues to see a deficiency in any particular count, Petitioner respectfully asks the Board that should any portion of Respondents' Motion be granted, the opportunity to amend the Petition or file any applicable addition to motion or exhibit to address any such issues.

3. **Legal Standard** (In reference to Respondent's relevant parts of paragraph III.) : Respondent alleges: "Counts II, V and VI averred by Picture Engine in its original Petition did not even make threadbare recitals of the elements of the respective causes of action, and to the extent these grounds also are re-alleged in the Amended Petition, they should be dismissed outright by the Board."

A. For Count II) Every time the Petition includes the word “generic” or lacking in anything to “distinguish” as a whole, this also is referring to how the Mark is merely descriptive. (In Addition, see the rest of this document in all paragraphs, describing how the Mark is merely descriptive)

B. For Count V) See paragraph **II.)9.)** of this document below, Additionally The Book that was published October 4, 2016 titled “Useful Book of Gadgets, Gizmos & Apps” first edition or second addition or both, features a section on an eBay Auction Sniper, where My App “Auction Sniper for eBay” is mentioned as the most useful app for sniping on eBay. (See Exhibit A, book) below. This book is not referring to the Respondent’s product, the book is referring to MY app and products/services, This is an example of the Mark causing Unnecessary dilution.

C. For Count VI) See paragraph **II.)10.)** of this document below. Additionally every exhibit and just about ever paragraph in the Petition refers to others using the term “Auction” and “Sniper” or “Auction Sniper” in various forms in their general practice as their own or as a generic term. Including Petitioner’s use of the term long before this Mark existed. In this way, the Respondent, was never the rightful owner of the Mark. To be clear, the Petition and through this motion, both are claiming that no one is the rightful owner of the Mark, and as such, the Respondent is not the rightful owner. Again as an example that no one is the rightful owner of the term “Auction Sniper”. The use in this book (Exhibit A, book) and (Exhibit B, email) provides the best evidence that the Respondent is not the rightful owner. In

order to be the “most useful eBay sniper”, Petitioner had to have a superior product on the market for a long enough amount of time for an unsolicited Author to notice long before the Respondent filed for the Mark. The Board has already disclaimed the word “Auction” from the registration. With these things in mind; Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought.

4. (In reference to Respondent’s relevant parts of paragraph IV.) : **with respect to International Classes 35 and International Class 42,**

A.1. with respect to International class 35 As stated in the Petition paragraph 1), My Application, “Auction Sniper for eBay” is for sale in Apple’s App Store since 2013, as such, the Application itself, “Auction Sniper for eBay” is an international online auction service for use with eBay. And as stated in the Petition, the app is used “for placing a bid for an auction at the last possible minute” to be absolutely clear, this means an international online auction service featuring the automated placing of bids for international goods and services. eBay (eBay is a trademark of eBay Inc.) is an international online ordering/auction service of a very large variety of world wide merchandise and consumer goods of others of which the Petitioner’s app is a facilitator of users having access to the eBay platform. To be clear, the Respondent’s App and service is a direct competitor to the Petitioner’s app and service within the very same

international class 035. Also Petitioner has websites in association with that product and Service, besides the obvious eBay online website that the App is a platform for. The entire reason for the Petition is for relief from the Respondent's attempt to remove my products and services from that very class's definition, (class 035) including international commerce. The Respondent's attempt at obfuscating this is unclear?

A.2. Put in more context the Petitioner's App is set up for use with the "online" and "international" website 'eBay' ('eBay' is a trademark of eBay Inc.) 'eBay' is after all an international online commerce app, and the Petitioner's app directly links to the worldwide online websites of 'eBay' for use with those sites. The entire purpose of the app is to connect to **international** online 'eBay' (auction) sites to provide **International** online automated bidding auction services through/for 'eBay', if the goal of the Respondent is to show the Petitioner's app is not an **International** online platform for auction services featuring the automated placing of bids, then Respondent is arguing that the Respondent's app is not an online platform for the same purpose, as the two apps are direct competitors within the same class space (class 035)

B. with respect to International class 42) The Petitioner is claiming common use of the entire community of Auction snipers that this space (class 042) is filled with. Online Websites of other companies besides the Respondent that provide such **international** products and services while using the terms "Auction", "Sniper", "Sniping" in close associations with each other, and various forms of "Auction Sniper", see the list of exhibits and descriptions in the Petition. This is one of the many points of the Petition. That the Respondent

has not acquired, nor ever had distinction in the use of this Mark for the same **international** services in this class space.

5. (In reference to Respondent's relevant parts of paragraph V.) : with respect to Priority and Likelihood of Confusion

A. Priority The Petitioner is claiming and showing prior common law use. In Addition, the Petitioner is showing prior common law use in general by other companies/websites/individuals as far back as 1998. The Petition itself is showing this prior common law use in many places and in it's exhibits.

B. Likelihood of Confusion The Petitioner is claiming through the Petition and through this motion, that the term "Auction Sniper" that is in both the Petitioner's app name and the Respondent's app name is merely descriptive and therefore weak, and in this way the Mark does cause a likelihood of confusion. The Board has already disclaimed the word "Auction" from the registration. In both cases/apps, the obvious and dominant terms are the first two words "Auction" and "Sniper". This leaves "Sniper" or the use together, which the entire Petition and it's exhibits (along with this motion) is on the path to finish the job of showing how weak and merely descriptive the entire Mark is. (Here again the Respondent appears to try to obfuscate that the Petitioner's app is not in the same class space as the Respondent's app, This is incorrect and to what end?)

6. (In reference to Respondent's relevant parts of paragraph VI.) : **with respect to the Mark is Descriptive** The terms in the Mark are describing the very purpose of many of the services/products of many companies. These are shown in the Petition and its exhibits. (Also see Exhibit B email in this Motion) where a person is literally describing the purpose of the software in the subject title as an example of using the terms to show the purpose, rather than the name of the Petitioner's app, (and that this purpose was not working at the time, hence the email) Then separately in the body of the email using the terms as a descriptive purpose to a "tool". There is no better way to show this than to show people actually using the term. None referring to the Respondent's Mark at all.

7. (In reference to Respondent's relevant parts of paragraph VII.) : **with respect to the Mark as Generic.** The Respondent can re-read the entire Petition as every exhibit and just about every paragraph deals with and shows how generic and merely descriptive the Mark "Auction Sniper" is. This consistent use of Auction Sniper/Sniping by many companies (and people) has not in the vast majority of cases been in reference to Defendant but to the general practice either the 'verb' form "Sniping" in relation to Auctions, or 'noun' form the person/thing that does it, "Sniper" of Auctions, and in the vast majority of cases some other company that is not associated with the Defendant has used this term to describe directly or indirectly their business, if they are an "Auction Sniper" service or product. I personally have emails from 100's of people with the term "Auction Sniper" or "Auction Sniping" or "Auction bidding sniper" etc... and they are not referring to the Defendant or its products/services, but to

the general practice of Sniping, or my service in particular. The Petition did show many other companies from the past/present with this term in their names or service too.

8. (In reference to Respondent's relevant parts of paragraph **VIII.**) : **To be protectable as a trademark, a term must be distinctive ... (basically originating from a single source)**, Here the Petition shows numerous examples of the words in the Mark and the Mark itself being used by dozens of companies, and thousands of people, including the Petitioners app long before the Respondent's began the process to register the Mark. There is no amount of confusion on this point. In the inevitable conclusion of this Petition, the words in the Mark and the Mark itself was used in a descriptive way and in close association with variations of the words in the Mark long before the Respondent. That is the point of the Petition's Grounds for Cancellation and exhibits.

9. (In reference to Respondent's relevant parts of paragraph **IX.**) : **dilution by Blurring**, The Petitioner's App that has the name "Auction Sniper for eBay", and is in the same commerce space as the Respondent's app with a similar name. In this way, and in this class space, this is the definition of dilution by blurring. Since the Petitioner has been using this name before the Respondent filed for their Mark. This has caused confusion in the class space that is described in the Petition classes and Grounds for Cancellation. If the Respondent or Board is looking for an example of 'fame' in this context, An example of this, can be seen by a book in which the Petitioner's App is mentioned by name from 2016, well before the Respondent filed for the Mark. (See Exhibit A below) Another example of 'fame' in this

context is hundreds of emails by users of my app. (See Exhibit B below for an example of an email from a user of my app) Notice two things: 1) The author of the email took out the standard support email subject title to put in his/her own subject title; the author include the words “auction sniper” of their own volition. 2) The author of the email mentions using this “auction sniper” software/app/ sniping service since 2014, (that is Petitioner’s app, so there is no confusion here caused by the dilution that the Respondent’s Mark is causing) this date is before the Respondent’s registrations claim of first use in all classes.

10. (In reference to Respondent’s relevant parts of paragraph X.) : **Registrant is not the Rightful Owner.** Here, the Petition stands out again as addressing this Grounds for Cancellation, as it is showing dozens of cases where companies and thousands of individuals have used the terms for themselves and generically, including the Petitioner, both as a name or generically long before the Respondent. In that respect, the Petition is showing that no one is the rightful owner of this Mark, therefor the Registrant is not the rightful owner. As one can see from citation #1 thru #6 in exhibits of the Petition, the term “Auction”, “Sniper”, “Sniping” always in close association with each other, and many combinations such as “Auction Sniper” has been in use for more than 20 years in all types of situations "websites/individuals/ applications" This term (in it's various forms) can be described as having many and multiple examples of "generic" and in general use, and in that way, no one can claim the rightful owner of such a descriptive Mark.

III. in Conclusion

1. in Conclusion, for all of the above reasons, Petitioner respectfully prays that Respondents' Motion to Dismiss be denied. Should any portion of Respondents' Motion be granted however, Petitioner respectfully requests the opportunity to amend the Petition or file any applicable additional Motions/Exhibits to Grounds for Cancellation to address any such issues.

Respectfully submitted by: /joncarlson/ 9/6/2021

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing

“PETITIONER’S RESPONSE IN OPPOSITION TO RESPONDENTS’ SECOND MOTION TO DISMISS” and any and all exhibits/citations of this document has been served on (OpenSky Project, Inc. through NICHOLAS S KUHLMANN) by forwarding said copy via email to: (nkuhlmann@hjlawfirm.com, amueller@hjlawfirm.com).

Signature: /joncarlson/ Jon Carlson

Date: ___9/6/2021_____

EXHIBITS

A) link/description for book:

<https://www.theusefulbookofgadgets.com/the-book>

- book titled “Useful Book of Gadgets, Gizmos & Apps”
- first Published October 4, 2016 by Management Books
- ISBN 9781852527723 (ISBN10: 1852527722)
- Author: Martin Bailey

Petitioner has no association with this Author or Publisher other than the Petitioner’s app is mentioned in the book, and the Petitioner shows a link from Petitioner’s websites to this book.

B) Example email: (name and email address hidden for privacy of user)

Notice two things:

- 1) The author of email took out the standard support email subject title to put in his/her own subject title; including the words “auction sniper”
- 2) The author of the email, mentions using this “auction sniper” software/app/ sniping service since 2014, (that is my app, so there is no confusion here) this date is before the Respondent’s registrations claim of first use.

Date: October 22, 2017 at 7:22am

From: gxxxxxm@aol.com

Subject: Is the auction sniper software having issues this morning?

To: supportX001@PictureEngineCompany.com

Good morning,

I have and use Auction snipe tool for eBay on a Macbook pro using Sierra 10.12.6

This morning it has gone haywire. I had a few snipes and when I tried to open the app, it wouldn't. I was able to open it from Finder, but it started popping up snipes from 2014. I am trying to delete those.

Please advise - I'm hoping this is just a glitch that you have already found and are working to correct. I use this app all the time - first time I had these issues.

Thanks and regards,

Steve Lxxxxxx
