

ESTTA Tracking number: **ESTTA1145593**

Filing date: **07/09/2021**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	DISH Network L.L.C.		
Entity	limited liability company	Citizenship	Colorado
Address	9601 S. MERIDIAN BLVD. ENGLEWOOD, CO 80112 UNITED STATES		

Attorney information	KATE BOHMANN ADSERO IP 8210 SOUTHPARK TERRACE LITTLETON, CO 80120 UNITED STATES Primary Email: efs@adseroip.com Secondary Email(s): kbohmanna@adseroip.com, ian@adseroip.com, TDamhoff@Adseroip.com, ameyer@adseroip.com 303-268-0066		
Docket Number	0726.161TMOP		

Registration Subject to Cancellation

Registration No.	5706741	Registration date	03/26/2019
Registrant	Onstreaming LLC 3 HUTTON CENTRE DR. 9TH FLOOR SANTA ANA, CA 92707 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2017/07/07 First Use In Commerce: 2017/07/07 All goods and services in the class are subject to cancellation, namely: Entertainment services, namely, providing on-line reviews of movies and television shows; Providing a website featuring entertainment information in the fields of movies, television and entertainment; Providing ratings for television and movie content
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Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
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Attachments	Petition for Cancellation - Onstreaming.pdf(97050 bytes) Exhibit_A.pdf(1458587 bytes) Exhibit_B.pdf(786340 bytes)
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Signature	/klb/
Name	Kate Bohmann
Date	07/09/2021

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

In re Registration No. 5706741
Mark: ONSTREAMING

DISH Network L.L.C.)	
)	
Petitioner,)	Cancellation No.
)	
v.)	
)	
Onstreaming LLC)	
)	
Registrant.)	

PETITION FOR CANCELLATION

Petitioner DISH Network L.L.C., a Colorado limited liability company, with a place of business at 9601 S. Meridian Blvd., Englewood, Colorado 80112 (“Petitioner”), seeks relief from damage caused by the continued registration of the mark shown in U.S. Registration No. 5706741 (the “Onstreaming Mark” or the “Onstreaming Registration”), and hereby petitions for cancellation of the Registration.

As grounds for cancellation, Petitioner alleges the following:

1. Petitioner is a connectivity company and a leading provider of Pay-TV goods and services.
2. Petitioner owns the pending U.S. Trademark Application Serial No. 88856170 for the mark ONSTREAM in connection with the following services:

Entertainment and education services in the nature of providing non-downloadable entertainment and education content to business customers,

namely, movies, television program series, and television programs, and on-line video clips in the fields of comedy, drama, action, adventure, sports, musicals, current events, entertainment news, documentaries, and animation accessible at apartment communities, hotels, senior living communities, hospitals, business offices, and retail locations via non-downloadable user authentication software through the designated wireless local area network (LAN) and specifically excluding entertainment services, namely, providing online reviews and rating of movies and television shows; as well as services in connection with providing a website featuring entertainment information in the fields of movies, television and entertainment; and services in connection with providing ratings for television and movie content in International Class 041.

A true and correct copy of the application status printout is attached hereto as Exhibit A.

3. On January 13, 2021, Petitioner received an Office Action refusing registration of U.S. Application Serial No. 88856170 for the mark ONSTREAM in connection with the services identified in paragraph 2 above on the grounds of likelihood of confusion with the Onstreaming Mark.

4. On July 21, 2017, Onstreaming LLC, a Wyoming limited liability company having an address of 3 Hutton Centre Dr. 9th Floor Santa Ana, California 92707 (“Onstreaming LLC”) filed U.S. Trademark Application Serial No. 87538077 on the Principal Register under Section 1(a) for the mark ONSTREAMING in connection with “Entertainment services, namely, providing on-line reviews of movies and television shows; Providing a website featuring entertainment information in the field(s) of movies, television and entertainment; Providing ratings for television and movie content” in International Class 041.

5. On March 26, 2019, U.S. Trademark Application No. 87538077 matured into U.S. Trademark Registration No. 5706741. A true and correct copy of the Onstreaming Registration is attached hereto as Exhibit B.

6. Upon information and belief, after a reasonable investigation, there exists no evidence of Onstreaming LLC’s current use of the Onstreaming Mark in the United States in connection with the services identified in Paragraph 4 above.

7. Upon information and belief, Onstreaming LLC abandoned the Onstreaming Mark in connection with the services identified in Paragraph 4 above through non-use of the Onstreaming Mark in commerce with an intent not to resume use.

8. Accordingly, U.S. Trademark Registration No. 5706741 should be cancelled based on abandonment of the mark under Section 45 of the Trademark Act, 15 U.S.C. § 1127.

9. Petitioner is and will continue to be damaged by Registration No. 5706741 under the provisions of 15 U.S.C. § 1068 because the continued registration of the Onstreaming Mark is impeding Petitioner's enjoyment of full rights in its ONSTREAM mark, including in particular, the right to register its ONSTREAM mark in connection with the goods identified in Paragraph 2 above.

WHEREFORE, Petitioner respectfully requests that this Petition for Cancellation be granted and that U.S. Trademark Registration No. 5706741 be canceled on the grounds of abandonment with an intent not to resume use.

Date: July 8, 2021

Respectfully submitted,
Adsero IP

s /KLB/

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Attorneys for Petitioner
DISH Network L.L.C.

EXHIBIT A

Generated on: This page was generated by TSDR on 2021-06-30 10:10:51 EDT

Mark: ONSTREAM

ONSTREAM

US Serial Number: 88856170

Application Filing Date: Apr. 01, 2020

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Jan. 13, 2021

Mark Information

Mark Literal Elements: ONSTREAM

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For: Entertainment and education services in the nature of providing non-downloadable entertainment and education content to business customers, namely, movies, television program series, and television programs, and on-line video clips in the fields of comedy, drama, action, adventure, sports, musicals, current events, entertainment news, documentaries, and animation accessible at apartment communities, hotels, senior living communities, hospitals, business offices, and retail locations via non-downloadable user authentication software through the designated wireless local area network (LAN) and specifically excluding entertainment services, namely, providing online reviews and rating of movies and television shows; as well as services in connection with providing a website featuring entertainment information in the fields of movies, television and entertainment; and services in connection with providing ratings for television and movie content

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: May 2019

Use in Commerce: May 2019

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: DISH Network L.L.C.

Owner Address: 9601 S. Meridian Blvd.
Englewood, COLORADO UNITED STATES 80112

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country COLORADO
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Ian L. Saffer

Docket Number: 0726.142-TM

Attorney Primary efs@adseroip.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent Ian L. Saffer
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LITTLETON, COLORADO UNITED STATES 80120

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Fax: 303-268-0065

Correspondent e- efs@adseroip.com
mail:

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 13, 2021	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jan. 13, 2021	NON-FINAL ACTION E-MAILED	6325
Jan. 13, 2021	NON-FINAL ACTION WRITTEN	82429
Jan. 07, 2021	NOTICE OF ACCEPTANCE OF AMENDMENT TO ALLEGE USE E-MAILED	
Jan. 06, 2021	USE AMENDMENT ACCEPTED	82429
Dec. 23, 2020	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Dec. 22, 2020	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Dec. 22, 2020	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Dec. 23, 2020	AMENDMENT TO USE PROCESSING COMPLETE	88889
Dec. 23, 2020	USE AMENDMENT FILED	88889
Dec. 22, 2020	TEAS AMENDMENT OF USE RECEIVED	
Jun. 26, 2020	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jun. 26, 2020	NON-FINAL ACTION E-MAILED	6325
Jun. 26, 2020	NON-FINAL ACTION WRITTEN	82429
Jun. 22, 2020	ASSIGNED TO EXAMINER	82429
Apr. 08, 2020	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 04, 2020	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: MANOR, THOMAS M

Law Office LAW OFFICE 110
Assigned:

File Location

Current Location: TMO LAW OFFICE 110 - EXAMINING
ATTORNEY ASSIGNED

Date in Location: Jan. 13, 2021

EXHIBIT B

United States of America

United States Patent and Trademark Office

Onstreaming

Reg. No. 5,706,741

Onstreaming LLC (WYOMING LIMITED LIABILITY COMPANY)

Registered Mar. 26, 2019

3 Hutton Centre Dr. 9th Floor
Santa Ana, CALIFORNIA 92707

Int. Cl.: 41

CLASS 41: Entertainment services, namely, providing on-line reviews of movies and television shows; Providing a website featuring entertainment information in the fields of movies, television and entertainment; Providing ratings for television and movie content

Service Mark

FIRST USE 7-7-2017; IN COMMERCE 7-7-2017

Principal Register

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 87-538,077, FILED 07-21-2017



Andrei Iancu

Director of the United States
Patent and Trademark Office