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

Proceeding	91181512
Party	Defendant 5 Star Linux, Inc.
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1 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3 OpenTV, Inc.

4 Opposer,

5 v.

6 5 Star Linux, Inc.

7 Applicant.

Opposition No. 91181512

APPLICANT'S MOTION FOR ENTRY OF
JUDGMENT FOR THE APPLICANT

Application Serial No.: 77/082,330

Filing Date: January 12, 2007

Publication Date: August 28, 2007

8
9 Applicant and Defendant 5 Star Linux, Inc. ("5SLI"), though its counsel of record, hereby move
10 to dismiss OpenTV, Inc. ("OpenTV")'s Opposition to 5SLI's OPENPVR trademark application and for
11 entry of judgment in 5SLI's favor.

12 **I. INTRODUCTION**

13 5SLI registered the *openpvr.com* domain name in 2000 and filed its application for the mark
14 OPENPVR in 2007. OpenTV attempts to invalidate 5SLI's OPENPVR registration on the claim that it
15 has a family mark with the surname "OPEN" and that it has a common-law mark OPENTV PVR that
16 predates 5SLI's application. OpenTV, however, did not respond to 5SLI's discovery requests and did
17 not present any witness testimony to support its claims. Now the deadlines for discovery and trial have
18 passed. OpenTV has no evidence on the record to support its claims of family mark or common law
19 mark. Therefore, judgment should be entered for Applicant 5SLI.

20 **II. STATEMENT OF FACTS**

21 5SLI and its parent company, EnReach Technology, Inc., have been the owners of the domain
22 names openpvr.com, openpvr.org, and openpvr.net since 2000. Ex. A. On January 12, 2007, 5SLI filed
23 its application for the trademark "OPENPVR" (the "Application") The Application was published in
24 the Official Gazette on August 28, 2007. The OPENPVR mark covers the following goods and
25 services:

26 Audio and video receivers, signal decoder boxes, television set-top boxes and signal
27 converters; consumer electronics hardware devices for playing audio and video from a
28 computer hard disk drive and storing and playing transmissions from television and radio
broadcasts and from computer networks, namely, audio and video disk recorders, remote
controls, computer hardware and computer peripherals; computer client-server software
for use in delivering, receiving and managing integrated voice, video and data from the

Internet to display units and televisions; computer software for use in operating telecommunications devices; and user manuals and guides sold as a unit therewith. (International Class 9)

Broadcasting programs via computer networks; electronic transmission of messages and data, delivery of messages via computer networks; video broadcasting and messaging services; video-on-demand transmission services, providing multiple-user access to a global computer information network; and providing consulting in the field of telecommunications. (International Class 38)

On December 26, 2007, OpenTV filed the instant Opposition to the Application. OpenTV alleges that it has a common-law OPENTV PVR mark and “a family of ‘OPEN’ marks” and that these marks predate 5SLI’s Application in priority.

On February 8, 2007, pursuant to a stipulation, this Board granted an extension of time and set forth the following case schedule:

Event	Date
Time to answer	3/5/2008
Deadline for discovery conference	4/4/2008
Initial disclosures due	5/4/2008
Expert disclosures due	9/1/2008
Discovery closes	10/1/2008
Plaintiff’s pretrial disclosures	11/15/2008
Plaintiff’s 30-day trial period ends	12/30/2008
Defendant’s pretrial disclosures	1/14/2008
Defendant’s 30-day trial periods ends	2/28/2009
Plaintiff’s rebuttal disclosures	3/15/2009
Plaintiff’s 15-day rebuttal period ends	4/14/2009

On March 4, 2008, 5SLI filed its answer. On June 9, 2008, 5SLI served on OpenTV its First Set of Document Requests and First Set of Interrogatories by mail. Ex. B & C. The deadline for OpenTV to respond to 5SLI discovery requests was July 14, 2008. Counsel for OpenTV acknowledged the deadline in an email and asked for extension in view of OpenTV’s settlement proposal. Ex. D. 5SLI

1 did not agree to the requested extension of time. Ex. D.

2 OpenTV never responded to SSLI's discovery requests. In fact, OpenTV did not do anything in
3 this case after its settlement proposal was rejected in July 2008.

4 **III. ARGUMENT**

5 **A. There Is No Evidential Support for the Alleged "OPEN" Family Mark**

6 A "family of marks" is "a group of marks having a recognizable common characteristic, wherein
7 the marks are composed and used in such a way that the public associates not only the individual marks,
8 but the common characteristic of the family, with the trademark owner." *AM Gen. Corp. v.*
9 *Daimlerchrysler Corp.*, 311 F.3d 796, 814 (7th Cir. Ind. 2002) (internal quotations and citations
10 omitted). "Simply using a series of similar marks does not of itself establish the existence of a family.
11 There must be a recognition among the purchasing public that the common characteristic is indicative of
12 a common origin of the goods." *Id.*

13 OpenTV merely shows that it has registered several marks with the common prefix "OPEN."
14 There is no evidence whatsoever that the public associates the word "OPEN" with OpenTV. To the
15 contrary, OPEN is a highly descriptive term used widely in the industry to connote the meaning of being
16 free, non-proprietary, or decentralized (e.g., OpenID, Open System, OpenDNS, OpenOffice,
17 OpenSource) See Ex. E. None of the commonly used OPEN technology or products belonged to
18 OpenTV. Thus, OpenTV cannot claim ownership to the family mark OPEN.

19 **B. There Is No Evidence Supporting OpenTV's Claim Based on OPENTV PVR**

20 OpenTV claims that it has a common-law mark OPENTV PVR which predates the OPENPVR
21 application's filing date. There are two problems with this claim. First, there is no evidence for the
22 existence of the mark OPENTV PVR. To be sure, SSLI explicitly requested documentary proof on this
23 point through its document requests. See Ex. B, Request No. 12 ("Any and all documents relating to
24 your purported common law trademark rights in the mark OPENTV PVR"), No. 13 ("Any and all
25 documents relating to your purported use of OPENTV PVR"), No. 29 ("Any and all documents relating
26 to your purported efforts and the expenditure of considerable sums of money in connection with
27 advertising, promotional and market services relating to OPENTV PVR"), No. 30 ("Any and all
28 documents relating to your purported valuable goodwill and consumer recognition of OPENTV PVR"),

No. 31 (“Any and all documents demonstrating that OPENTV PVR is distinctive and famous”), No. 31 (“Any and all documents demonstrating that your alleged common law rights in the OPENTV PVR mark also proceed Applicant’s filing date”), No. 38 (“Any and all documents demonstrating that OPENTV PVR is distinctive for your goods and services”). OpenTV never bothered to even respond to these document requests. Thus, as a matter of fact OpenTV does not have the right to the alleged common-law mark OPENTV PVR.

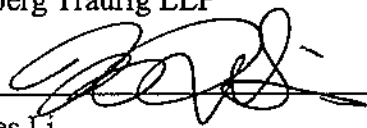
Second, even assuming *arguendo* that OpenTV has a common-law mark OPENTV PVR, which it does not, OpenTV has not presented any evidence of any potential or actual consumer confusion between OPENTV PVR and OPENPVR. Again, 5SLI has explicitly requested such evidence through its document requests. See Ex. B, Request No. 56 (“Any and all documents demonstrating that applicant’s mark resembles OPENTV PVR”), No. 57 (“Any and all documents demonstrating that Applicant’s mark’s resemblance to OPENTV PVR is likely, when applied to Applicant’s Goods and Services, to cause confusion, to cause mistake, or to deceive as to the origin, sponsorship, or approval of Applicant’s Goods and Services.”), No. 58 (“Any and all documents demonstrating the injury to Opposer, the trade and the public that would result from the Applicant’s Mark’s resemblance to OPENTV PVR”), No. 74 (“Any and all documents demonstrating that the registration of Applicant’s mark would prevent Opposer from exercising exclusive control over the goodwill and reputation associated with OpenTV PVR”). Therefore, as a matter of fact, there is no consumer confusion between OPENTV PVR and OPENPVR.

Thus, OpenTV’s opposition based on the alleged OpenTV PVR mark is baseless.

IV. CONCLUSION

The Opposer OpenTV has not provided any evidence supporting its Opposition. Judgment should be entered in favor of the Applicant 5SLI.

Respectfully submitted,
Greenberg Traurig LLP

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