

Exhibits

TTAB

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

CERTIFICATE OF MAILING

I certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on June 24, 2003.

Marta I. Burgin
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In the Matter of Application
Serial No. 78/081,731 published in the
Official Gazette on
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06-26-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

THE CHAMBER OF COMMERCE)
OF THE UNITED STATES OF AMERICA)

Opposer,)

v.)

UNITED STATES HISPANIC)
CHAMBER OF COMMERCE)
FOUNDATION,)

Applicant.)

Opposition No. 91156321

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ANSWER

Applicant UNITED STATES HISPANIC CHAMBER OF COMMERCE
FOUNDATION, for its Answer to Opposer THE CHAMBER OF COMMERCE OF THE
UNITED STATES OF AMERICA's Notice of Opposition, states:

I.1. Applicant admits that the records of the Patent & Trademark Office reflect the registration numbers as set forth in Paragraph I.1 and that the registration speaks for itself as to ownership of the registrations and the services for which each mark is registered.

I.2. Denied.

I.3. Denied.

II.1. Applicant is without sufficient information to admit or deny the allegations of Paragraph II.1 and therefore denies the same.

II.2. Applicant is without sufficient information to admit or deny the allegations of Paragraph II.2 and therefore denies the same.

II.3. Denied.

II.4. Applicant admits that it has not used its design mark at any time prior to the date of first use alleged in its application.

II.5. Denied.

III.1. Admitted.

III.2. Denied.

III.3. Denied.

III.4. Denied.

AFFIRMATIVE DEFENSES

Applicant asserts the following affirmative defenses:

1. *Laches*: Opposer unreasonably delayed the assertion of its rights against Applicant, which delay has caused material prejudice to Applicant. Applicant's parent company has been known throughout the United States as UNITED STATES HISPANIC CHAMBER OF COMMERCE since at least 1979 and has peacefully co-existed with Opposer as a national chamber of commerce since that time. Such use and peaceful coexistence has inured to the benefit of Applicant. Further, Applicant and Opposer are within close proximity of one another (Applicant and Opposer's offices are within .87 miles/3 minutes of one another in Washington, D.C. as noted at Tab 1). Finally, Applicant has used the design mark at issue throughout the United States since June of 2001 and applied to federally register the design mark at issue in August of 2001. Nevertheless, Opposer made no objection until August of 2002. Opposer's unreasonable delay in objecting to Applicant's during this long period of time has caused material prejudice to Applicant, who has built a considerable amount of goodwill in UNITED STATES HISPANIC CHAMBER OF COMMERCE and the design mark at issue and has spent a considerable amount of monetary resources to promote these marks. Given the Applicant and Opposer's long-time co-existence in close proximity of each other, Applicant notes this is an exceptional case and respectfully requests that the Board considers this defense as it relates to Applicant's use of its mark.

2. *Estoppel*: Applicant's parent corporation has been known throughout the United States as UNITED STATES HISPANIC CHAMBER OF COMMERCE since at least 1979 and has peacefully co-existed with Opposer as a national chamber of commerce since that time.

Such use and peaceful coexistence has inured to the benefit of Applicant. Further, Applicant has used the design mark at issue throughout the United States since June of 2001 and applied to federally register the design mark at issue in August of 2001. Nevertheless, Opposer made no objection until August of 2002. Given their close proximity (Applicant and Opposer's offices are within .87 miles/3 minutes of one another in Washington, D.C. as noted at Tab 1), Opposer's inaction and failure to object to Applicant's use of UNITED STATES HISPANIC CHAMBER OF COMMERCE and the design mark at issue between 1979 and July of 2002 led Applicant to rely upon this inaction and reasonably infer that rights would not be asserted against it. Due to this reliance, Applicant will be materially prejudiced if the delayed assertion of Opposer's rights is permitted since Applicant has built a considerable amount of goodwill in UNITED STATES HISPANIC CHAMBER OF COMMERCE and the design mark at issue and has spent a considerable amount of monetary resources to promote these marks. Given the Applicant and Opposer's long-time co-existence in close proximity of each other, Applicant notes this is an exceptional case and respectfully requests that the Board considers this defense as it relates to Applicant's use of its mark.

3. *Acquiescence:* Applicant's parent corporation has been known throughout the United States as UNITED STATES HISPANIC CHAMBER OF COMMERCE since at least 1979 and has peacefully co-existed with Opposer as a national chamber of commerce since that time. Such use and peaceful coexistence has inured to the benefit of Applicant. Further, Applicant has used the design mark at issue throughout the United States since June of 2001 and applied to federally register the design mark at issue in August of 2001. Nevertheless, Opposer made no objection until August of 2002. Given their close proximity, Opposer, through its inaction and failure to object to Applicant's use of UNITED STATES HISPANIC CHAMBER

OF COMMERCE and the design mark at issue, has actively misrepresented that it would not assert a right or claim against Applicant. This delay is not excusable and has caused Applicant undue prejudice since Applicant has built a considerable amount of goodwill in UNITED STATES HISPANIC CHAMBER OF COMMERCE and the design mark at issue and has spent a considerable amount of monetary resources to promote these marks. Given the Applicant and Opposer's long-time co-existence in close proximity of each other, Applicant notes this is an exceptional case and respectfully requests that the Board considers this defense as it relates to Applicant's use of its mark.

COUNTERCLAIMS

Applicant asserts the following counterclaim:

PETITION FOR CANCELLATION

In the matter of Registration No. 1,686,865; Registration No. 1,522,157; Registration No. 1,436,813 and Registration No. 1,430,627 issued to Opposer, Applicant deems itself injured by these registrations and hereby applies for cancellation thereof.

For its Petition for Cancellation against Opposer, Applicant states as follows:

1. Applicant is a Washington, D.C. not-for-profit corporation foundation with its principal place of business in Washington, D.C..

2. Opposer is a Washington, D.C. corporation with its principal place of business in Washington, D.C.

3. Both Applicant and Opposer engage in chamber of commerce activities of national scope and membership.

4. Over the years, numerous entities have used the terms “Chamber of Commerce,” “National Chamber” or “United States” or “U.S.” to denote chamber of commerce activities of national scope and membership (*See* Tab 2 for a sampling of such use pulled from a simple Internet search).

5. Over the years, numerous entities have registered or sought to register federal trademarks using the terms noted in Paragraph 4 above (*See* Tab 3 for a listing of such applications and registrations).

6. Opposer’s registration is invalid due to the fact that “U.S. Chamber,” “U.S. Chamber of Commerce,” “Chamber of Commerce of the United States,” and “National Chamber” are generic terms for chamber of commerce activities of national scope or membership. As noted in the Meriam-Webster On-Line Dictionary at Tab 4, a “chamber” is defined as “a legislative or judicial body” or “a voluntary board or council” and a “chamber of commerce” is defined as “an association of businessmen to promote commercial and industrial interests in the community.” The listings at Tab 2 and 3 prove that such terms are that are used, out of necessity, as the generic designations for such bodies, boards, councils and associations. Similarly, “U.S.,” “United States” and “National” are generic indicators that these bodies are housed within the United States and national in their scope and membership.

7. Opposer's registrations have and will continue to harm Applicant because the registration of these generic terms, with naught to distinguish them, makes it impossible for Applicant and others to use these generic terms for their chamber of commerce services.

8. Applicant authorizes the United States Patent and Trademark Office to charge Armstrong Teasdale LLP's Deposit Account No. 01-2384 with respect to the necessary statutory fee.

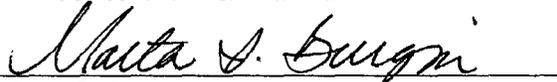
WHEREFORE, Applicant prays that Registration No. 1,686,865; Registration No. 1,522,157; Registration No. 1,436,813 and Registration No. 1,430,627 be cancelled.

CONCLUSION

WHEREFORE, Applicant respectfully prays that Opposer's Opposition be dismissed, that Opposer's registrations be cancelled, and that Applicant's application for registration be allowed to proceed.

RESPECTFULLY SUBMITTED,

ARMSTRONG TEASDALE LLP


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CERTIFICATE OF SERVICE

I certify that on June 24, 2003, a copy of the foregoing ANSWER was mailed, first class mail postage prepaid, to Mark C. Comtois and L. Lawton Rogers, III, D. of Duane Morris LLP, 1667 K Street, N.W., Suite 700, Washington, D.C. 20006 attorneys for Opposer.

