

TTAB

5344-5L

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

BUSH INDUSTRIES, INC.,)
)
 Opposer,)
 vs.)
)
 SHARUT FURNITURE, INC.,)
)
 Applicant.)
)
)
)

Opposition No. 91160204
Serial No. 78249420



06-01-2004

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

Assistant Commissioner for Trademarks
BOX TTAB
2900 Crystal Drive
Arlington, Virginia 22202-3513

**APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND
COUNTERCLAIM FOR CANCELLATION OF
U.S. TRADEMARK REGISTRATION NO. 2,817,819**

Sir or Madam:

In response to the Opposer's Notice of Opposition to Application Serial No. 78/249,420 filed in the above-captioned action on April 12, 2004, applicant, Sharut Furniture, Inc., ("Applicant"), through its attorneys, Cohen, Pontani, Lieberman & Pavane, answers the Notice of Opposition and interposes a counterclaim as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1 of the Notice of Opposition, and therefore denies the same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2 of the Notice of Opposition, and therefore denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3 of the Notice of Opposition, and therefore denies the same.

4. Applicant admits that U.S. Trademark Registration No. 2,817,819 registered on February 24, 2004 for the trademark FURNITURE ON THE MOVE in International Classes 20 and 35, but is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 4 of the Notice of Opposition, and therefore denies the same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 5 of the Notice of Opposition, and therefore denies the same.

6. Applicant admits the allegations in paragraph 6 of the Notice of Opposition.

7. Applicant admits the allegations in paragraph 7 of the Notice of Opposition.

8. Applicant admits the allegations in paragraph 8 of the Notice of Opposition.

9. Applicant denies each and every allegation in paragraph 9 of the Notice of Opposition.

10. The allegations in paragraph 10 of the Notice of Opposition are legal conclusions and do not require a response from Applicant.

11. Applicant denies the allegations in paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations in paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations in paragraph 13 of the Notice of Opposition.

**COUNTERCLAIM FOR CANCELLATION
OF U.S. TRADEMARK REGISTRATION NO. 2,817,819**

Count I - Non-Use

14. On information and belief, Opposer has not made a bona fide use in commerce of the trademark FURNITURE ON THE MOVE for furniture.

15. On information and belief, Opposer has not made a bona fide use in commerce of the service mark FURNITURE ON THE MOVE for retail store services in the field of furniture.

16. Opposer's U.S. Trademark Registration No. 2,817,819 ("819 Registration") for FURNITURE ON THE MOVE is based on Opposer's purported use in commerce of that mark for "furniture, in Class 20" and for "retail store services in the field of furniture, in Class 35."

17. Because, on information and belief, Opposer has not used the FURNITURE ON THE MOVE mark in commerce for "furniture, in Class 20" and for "retail store services in the field of furniture, in Class 35," the '819 Registration should be cancelled.

Count II - Fraud on the PTO

18. Applicant incorporates by reference the allegations set forth in paragraphs 14-17 of Count I of this Counterclaim, as fully set forth herein.

19. On October 22, 2003, counsel for Opposer submitted to the United States Patent and Trademark Office ("USPTO") a Statement of Use Under §2.28 in support of the application that became the '819 Registration. In that Statement of Use Under §2.28, Opposer submitted to the USPTO sworn statements that Opposer had used the FURNITURE ON THE MOVE trademark for furniture. Opposer knew or should have known that these sworn statements of use of the FURNITURE ON THE MOVE trademark for furniture were false. These false statements were made with the intent to induce authorized agents of the USPTO to grant the application for the '819 Registration and, reasonably relying upon Opposer's false statements, the USPTO did in fact grant the '819 Registration to Opposer.

20. On October 22, 2003, counsel for Opposer submitted to the USPTO the aforementioned Statement of Use Under §2.28, wherein Opposer submitted sworn statements that Opposer had used the FURNITURE ON THE MOVE trademark for retail store services in the field of furniture. Opposer knew or should have known that these sworn statements of use of the FURNITURE ON THE MOVE trademark for retail store services in the field of furniture were false. These false statements were made with the intent to induce authorized agents of the USPTO to grant the application for the '819 Registration and, reasonably relying upon Opposer's false statements, the USPTO did in fact grant the '819 Registration to Opposer.

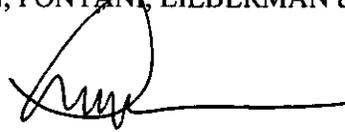
21. Opposer is not entitled to continued registration of the FURNITURE ON THE MOVE mark in the '819 Registration because as described above, Opposer willfully committed fraud in its procurement of the '819 Registration.

WHEREFORE, Applicant respectfully requests that the Trademark Trial and Appeal Board:

- (A) deny Opposer's Opposition to U.S. Trademark Application Serial No. 78249420 with prejudice;
- (B) cancel U.S. Trademark Registration No. 2,817,819; and
- (C) award Applicant its costs and reasonable attorneys' fees.

Respectfully submitted,

COHEN, PONTANI, LIEBERMAN & PAVANE,

A handwritten signature in black ink, appearing to be 'LJL', written over a horizontal line.

Lance J. Lieberman
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(212) 687-2770
Attorneys for Applicant

Dated: May 28, 2004

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM FOR CANCELLATION OF U.S. TRADEMARK REGISTRATION NO. 2,817,819 was served upon the following via first class mail on this 28th day of May, 2004:

William H. Logsdon, Esq.
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Attorneys for Opposer

By: 