

ESTTA Tracking number: **ESTTA475600**

Filing date: **05/31/2012**

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

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated
Correspondence Address	ALAN S COOPER WILEY REIN LLP 1776 K STREET NW WASHINGTON, DC 20006 UNITED STATES acooper@wileyrein.com
Submission	Other Motions/Papers
Filer's Name	Alan S. Cooper
Filer's e-mail	acooper@wileyrein.com, tmyers@wileyrein.com
Signature	/Alan S. Cooper/
Date	05/31/2012
Attachments	Opposer's Reply to Applicant's Counterclaims.pdf (6 pages)(387485 bytes)

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

BRINK'S NETWORK, INCORPORATED)
)
 Opposer)
)
 v.) Opposition No. 91164764
)
 BRINKMANN CORPORATION)
)
 Applicant)

OPPOSER'S REPLY TO
APPLICANT'S COUNTERCLAIMS

In accordance with Rule 8(b) Fed. R. Civ. P. and Rule 2.114(b)(1) of the Trademark Rules of Practice, Opposer states its Reply to the Counterclaims asserted in Applicant's Answer to Opposer's Third Amended Notice of Opposition filed on December 20, 2010, as set forth below.

This paper is being filed at this time because of the original due date of January 24, 2011, was extended by virtue of the Order entered by the Board on January 7, 2011 suspending proceedings pending the disposition of Opposer's motion filed on January 5, 2011 seeking partial summary judgment dismissing Applicant's *Morehouse* prior registration defense to Opposer's § 43(c) dilution claim. On May 21, 2012, the Board entered an Order denying Opposer's motion for partial summary judgment and directing that proceedings be resumed. Accordingly, the filing of the present Reply is now timely.

*

*

*

(1) Answering the allegations of ¶ 31 of the Counterclaims, Opposer admits only that Applicant has asserted counterclaims for cancellation of Opposer's pleaded Registration Nos. 529,622, 1,412,587 and 1,411,610 on the grounds asserted in ¶¶ 32 through 46, inclusive, but denies Applicant is lawfully entitled to the relief which it seeks.

(2) Answering the allegations of ¶ 32 of the Counterclaims, Opposer admits that ¶ 12 of Third Amended Notice of Opposition asserts ownership of Registration No. 529,622 of the mark BRINK'S (Stylized) for receiving checks, cashing the same, carrying same or other moneys or securities, and guarding and protecting same, which issued on August 12, 1950, and has been duly renewed.

(3) Answering ¶ 33 of the Counterclaims, Opposer admits that it is not presently using the mark BRINKS in the precise form shown in Registration No. 529,622 for the services described in that registration, but is using the mark BRINK'S in other forms in connection with such services. Except as thus stated, Opposer denies the allegations of ¶ 33 of the Counterclaims

(4) Opposer denies the allegations of ¶ 34 of the Counterclaims.

(5) Answering the allegations of ¶ 35 of the Counterclaims, Opposer admits that its opposition to Application Serial No. 76/483,115 is based in part on Registration No. 529,622.

(6) Opposer denies the allegations of ¶ 36 of the Counterclaims.

(7) Answering the allegations of ¶ 37 of the Counterclaims, Opposer admits that ¶ 14 of Third Amended Notice of Opposition asserts ownership of Registration No. 1,412,587 of the mark BRINK'S HOME SECURITY for security

alarm and monitoring system services which issued October 7, 1986, and has been duly renewed.

(8) Answering the allegations of ¶ 38 of the Counterclaims, Opposer admits that it has temporarily discontinued use of the mark BRINKS HOME SECURITY in the United States in connection with security alarm and monitoring system services. Except as thus stated, Opposer denies the allegations of ¶ 38 of the Counterclaims.

(9) Opposer denies the allegations of ¶ 39 of the Counterclaims.

(10) Answering the allegations of ¶ 40 of the Counterclaims, Opposer admits that its opposition to Application Serial No. 76/483,115 is based in part on Registration No. 1,412,587.

(11) Opposer denies the allegations of ¶ 41 of the Counterclaims.

(12) Answering the allegations of ¶ 42 of the Counterclaims, Opposer admits that ¶ 15 of Third Amended Notice of Opposition asserts ownership of Registration No. 1,411,610 of the mark BRINK'S & Design for security alarm and monitoring system services which issued on September 30, 1986, and has been duly renewed.

(13) Answering the allegations of ¶ 43 of the Counterclaims, Opposer admits that it has temporarily discontinued use of the mark BRINKS & Design in the United States in connection with security alarm and monitoring system services. Except as thus stated, Opposer denies the allegations of ¶ 43 of the Counterclaims.

(14) Opposer denies the allegations of ¶ 44 of the Counterclaims.

(15) Answering the allegations of ¶ 45 of the Counterclaims, Opposer admits that its opposition to Application Serial No. 76/483,115 is based in part on Registration No. 1,411,610.

(16) Opposer denies the allegations of ¶ 46 of the Counterclaims.

(17) All allegations in the Counterclaims not admitted in the preceding paragraphs are hereby expressly denied.

AFFIRMATIVE DEFENSES

(18) Applicant's use of the mark BRINKMANN in connection with the home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets as described in International Class 9 of the opposed application (hereinafter "home security systems and components therefor") is likely to cause confusion, mistake or deception with respect to the source, origin and/or sponsorship of such goods. As a consequence of such acts, Applicant is guilty of unclean hands and thereby estopped from recovering on its Counterclaims.

(19) Applicant's use of the mark BRINKMANN in connection with the home security systems and components therefor is likely to dilute the distinctiveness of the Opposer's famous marks BRINK'S, BRINK'S & Design, BRINK'S (Stylized), BRINK'S HOME SECURITY and BRINK'S HOME SECURITY & Design. As a consequence of such acts, Applicant is guilty of unclean hands and thereby estopped from recovering on its Counterclaims.

(20) Applicant has used packaging and/or labeling for home security systems and components therefor which displays the federal statutory

registration symbol ® in connection with the mark BRINKMANN. As Applicant does not own a subsisting federal registration of the mark BRINKMANN that covers home security systems and components therefor, its use of the federal statutory registration symbol ® in connection with such goods constitutes a violation of § 29 of the Federal Trademark Act which deceives the consuming public. As a consequence of such acts, Applicant is guilty of unclean hands and thereby estopped from recovering on its Counterclaims.

WHEREFORE, Opposer respectfully prays that Applicant's Counterclaims for cancellation of Registration Nos. 529,622, 1,412,587 and 1,411,610 be dismissed with prejudice.

BRINK'S NETWORK, INC.

Date: May 31, 2012

By: /Alan S. Cooper/
Alan S. Cooper
Kimberly Sikora Panza
Wiley Rein LLP
1776 K Street, N.W.
Washington, DC 20006
202.719.7250
202.719. (Facsimile)

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing Opposer's Reply to Applicant's Counterclaims was served on the following attorneys of record for Applicant by depositing the same in the United States mail, first class postage prepaid, on this 31st day of May, 2012:

Gary A. Clark, Esq.
Susan Hwang, Esq.
Sheppard, Mullin, Richter & Hampton LLP
333 South Hope Street, 48th Floor
Los Angeles, California 90071

/Alan S. Cooper/