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10-02-2006

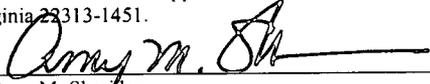
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #

28079-161

September 29, 2006

VIA EXPRESS MAIL

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Date of Deposit:	<u>September 29, 2006</u>
I hereby certify that this paper is being deposited postage prepaid with the United States Postal Service as "Express Mail Post Office to Addressee" service under 37 C.F.R. §2.198 on the date indicated above addressed to United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451.	
By:	 Amy M. Sheridan

Applicant:	San Diego County Credit Union
Mark:	FLY MILES PLUS
Serial No.:	78/477,138
Opposer:	United Air Lines, Inc./UAL Loyalty Services LLC
Opposition No.:	91169279
Subject:	San Diego County Credit Union's Answer to Notice of <u>Opposition and Counterclaims</u>

Dear Sir:

We enclose San Diego County Credit Union's Answer to Notice of Opposition and Counterclaims, and Proof of Service to the Opposing party, with regard to the above-referenced matter. So that we may have a timely record of this filing, please date-stamp the enclosed stamped, self-addressed postcard and deposit it in the U.S. mail. Please bill any charges related to this filing to our Deposit Account No. 50-2298.

Please direct any questions regarding the enclosed to my attention.

Mitchell P. Brook
of
LUCE, FORWARD, HAMILTON & SCRIPPS LLP

MPB/ams
Enclosure
3749492.1

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

In the Matter of Application Serial No. 78/477,138
FLY MILES PLUS
International Class: 35 and 36
Published in the *Official Gazette* of September 13, 2005

UNITED AIRLINES, INC. and)
UAL LOYALTY SERVICES LLC)
f/k/a UAL LOYALTY)
SERVICES, INC)
)
Opposers)
)
vs.)
)
SAN DIEGO COUNTY CREDIT UNION)
)
)
Applicant)
_____)

Opposition No. 91169279

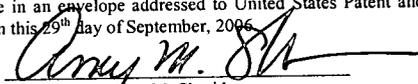
SAN DIEGO COUNTY CREDIT UNION'S
ANSWER TO NOTICE OF OPPOSITION
AND COUNTERCLAIMS

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Applicant San Diego County Credit Union ("SDCCU") hereby answers the Notice of Opposition filed by Opposers United Air Lines, Inc. and UAL Loyalty Services LLC f/k/a UAL Loyalty Services, Inc. (collectively "United") as follows, wherein numbered paragraphs correspond to the like numbered paragraphs in the Notice of Opposition.

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this paper is being deposited with the United States Postal Service via "Express Mail Post Office to Addressee", Label No. EV 749052373 US, in accordance with 37 C.F.R. §2.198, with sufficient postage in an envelope addressed to United States Patent and Trademark Office, Trademark Trial and Appeal Board, P.O. Box 1451, Alexandria, Virginia 22313-1451, on this 29th day of September, 2006.


Amy M. Sheridan

As to an initial unnumbered paragraph, SDCCU acknowledges United's representation as to its location and incorporation but has insufficient information upon which to form a belief as to the truth of the representations and therefore SDCCU denies that United will be damaged by the registration of SDCCU's mark FLY MILES PLUS, Serial No. 78/477,138.

1. SDCCU is aware of an airline known as United Air Lines. As to the other allegations in paragraph 1, SDCCU is without knowledge or information sufficient to form a belief as to the truth of those allegations and therefore denies the same.

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

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

4. SDCCU admits the issuance of the pleaded registrations and is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 4 and therefore denies the same.

5. Upon information and belief, SDCCU denies the allegations of paragraph 5 insofar as they relate to Reg. No. 1,322,575 and is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 5 and therefore denies the same. SDCCU acknowledges that two pages were attached as Exhibit A of the Notice of Opposition and will leave Opposers to their proofs as to their content.

6. Upon information and belief, SDCCU denies the allegations of paragraph 6 insofar as they relate to Reg. No. 1,322,575 and is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 5 and therefore denies the same.

7. SDCCU is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 7 and therefore denies the same.

8. SDCCU is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 8 and therefore denies the same.

9. SDCCU is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 9 and therefore denies the same.

10. SDCCU admits the allegations of paragraph number 10.

11. SDCCU is without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 11 and therefore denies the same.

12. SDCCU is without information sufficient to form an understanding as to the phrase "FLY MILES PLUS credit card" and accordingly denies each and every allegation of paragraph 12.

13. SDCCU denies each and every allegation of paragraph 13.

14. SDCCU denies each and every allegation of paragraph 14.

15. SDCCU admits that United has requested that registration be denied. SDCCU denies that United is being damaged by the Application, Serial No. 78/477,138. SDCCU is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 15 and therefore denies the same.

AFFIRMATIVE DEFENSES

16. Opposer's mark has been diluted and is entitled to only a narrow scope of protection, if any.

21. United's requested relief should be denied as claims are barred due to unclean hands on the part of United.

22. United's requested relief should be denied as claims are barred due to laches on the part of United.

23. United's requested relief should be denied as claims are barred due to acquiescence on the part of United.

24. United's requested relief should be denied as claims are barred due to estoppel.

25. United's requested relief should be denied as claims are barred due to abandonment as to Reg. No. 1,322,575.

COUNTERCLAIMS

COUNTERCLAIM I **(ABANDONMENT, AS AGAINST REGISTRATION NO. 1,322,575 FOR MILEAGE PLUS)**

SDCCU, for its counterclaims against United, alleges:

1. SDCCU was founded at least as early as 1938. It is incorporated in the State of California and has a place of business in San Diego, California.

2. SDCCU brings these counterclaims against United Air Lines, Inc. ("Registrant"), who is named as registrant of Registration No. 1,322,575 for MILEAGE PLUS, which recites as services in International Class 39 "transportation of persons, mail and property by air", and was renewed in 2004 for all the recited services.

3. Upon information and belief, MILEAGE PLUS is not functioning as a trademark for "transportation of persons, mail and property by air".

4. In the event that MILEAGE PLUS as registered in Reg. No. 1,322,375 was ever capable of functioning as a trademark, Registrant's course of conduct has caused this mark to lose significance constituting abandonment pursuant to 15 U.S.C. §1127.

5. SDCCU believes that it is and will be damaged by the continued registration of Reg. No. 1,322,375 to Registrant.

COUNTERCLAIM II

(FRAUD IN THE USPTO, AS AGAINST REGISTRATION NO. 1,322,575 FOR MILEAGE PLUS)

6. SDCCU re-avers and incorporates by reference paragraphs 1-5 of its Counterclaims herein.

7. On or about June 14, 2004, Registrant filed a false and fraudulent combined application for renewal of Reg. No. 1,322,175 under Section 9 and declaration under Section 8 wherein it incorrectly and falsely claimed that Registrant was using "MILEAGE PLUS" on or in connection with all of the services identified in Reg. No. 1,322,575.

8. The services identified in Reg. No. 1,322,175 are as follows: "transportation of persons, mail and property by air".

9. Registrant's declaration contained the following statement: "The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of this document, declares that he is properly authorized to execute this document on behalf of the owner; the mark is in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed true."

10. The combined Section 9 renewal application and Section 8 declaration stated that Registrant was using the mark in commerce on or in connection with all goods listed in Reg. No. 1,322,575 was false and fraudulent because the mark had not been used in commerce on or in connection with all of the goods listed in the registration.

11. Upon information and belief, the Section 9 renewal application and Section 8 declaration referred to in paragraph 8 above, was made on the signatory's own knowledge.

12. The Section 9 renewal application and Section 8 declaration referred to in paragraph 8 above was made with the intention that the USPTO rely upon the same.

13. The USPTO did rely on the Section 9 renewal application and Section 8 declaration referred to in paragraph 8 above when it renewed the registration for an additional term of ten years.

14. Had the USPTO been aware that the statements were false, it would not have granted renewal of Reg. No. 1,322,575.

15. As a result, the renewal was fraudulently obtained from the USPTO, and as a result the registration sought to be cancelled continues to exist to the detriment of petitioner SDCCU.

WHEREFORE, having fully answered, SDCCU requests that the present Opposition be dismissed with prejudice; that SDCCU be granted a registration for the mark applied for; and that the Petition for Cancellation against Opposer/Counterclaim Registrant United Air Lines be sustained and Trademark Reg. No. 1,322,575 for MILEAGE PLUS be cancelled.

Please address all correspondence to Mitchell P. Brook, Esq., c/o Luce, Forward,
Hamilton & Scripps, 11988 El Camino Real, Suite 200, San Diego, California 92130.

Dated: 9/28/06

Respectfully submitted,

By:



Mitchell P. Brook
Attorney for Applicant San Diego County
Credit Union

Luce, Forward, Hamilton & Scripps LLP
11988 El Camino Real, Suite 200
San Diego, California 92130
Telephone: (858) 720-6335

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PROOF OF SERVICE

I am employed in San Diego County. My business address is 11988 El Camino Real, Suite 200, San Diego, CA 92130, where this mailing occurred. I am over the age of 18 years and am not a party to this cause. I am "readily familiar" with the practices of LUCE, FORWARD, HAMILTON & SCRIPPS LLP for collection and processing of correspondence for mailing with the United States Postal Service. Such correspondence is deposited with the United States Postal Service the same day in the ordinary course of business.

On September 29, 2006, I served the foregoing document(s) described as:

**SAN DIEGO COUNTY CREDIT UNION'S ANSWER TO
NOTICE OF OPPOSITION AND COUNTERCLAIMS**

By placing the original a true copy thereof enclosed in sealed envelope(s) addressed as follows:

Philip A. Jones
Brinks, Hofer, Gilson & Lione
P.O. Box 10395
Chicago, Illinois 60610

BY MAIL: As follows: I am "readily familiar" with the business' practice of collection and processing of correspondence for mailing. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at San Diego, California, in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing an affidavit.

BY PERSONAL SERVICE. I delivered such envelope by hand to the offices of the party(ies) listed above [by delivering a copy to CalExpress Messenger Service] on this date for personal service on each party listed above.

(State) I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

(Federal) I declare under penalty of perjury under the laws of the United States of America that I am employed in the office of a member of the bar of this court at whose direction the service was made.

Executed on September 29, 2006, at San Diego, California


Amy M. Sheridan