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

Proceeding	91169547
Party	Defendant A Smart Move L.L.C. A Smart Move L.L.C. 5350 S. Roslyn Street Suite 380 Greenwood Village, CO 80111
Correspondence Address	JEFFREY J. SAPYTA 15415 TRIPLE CRK. SAN ANTONIO, TX 78247-2929
Submission	Answer and Counterclaim
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Signature	/Camille M. Miller/
Date	04/17/2006
Attachments	SMART BOX.pdf (10 pages)

3. Denied. The averments in this paragraph are legal conclusions to which no response is required, however to the extent that an answer may be necessary, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

4. Denied. The averments in this paragraph are legal conclusions to which no response is required, however to the extent that an answer may be necessary, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

5. Denied. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

6. Denied. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

7. Denied. The averments in this paragraph are legal conclusions to which no response is required, however to the extent that an answer may be necessary, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

The Applicant and Its SMARTVAULT Mark

8. Admitted in part. Denied in part. Applicant admits only that it is a Colorado corporation in the business of providing non-metal containers for the storage and transportation

of goods to and ancillary transportation and shipping related services to residential and commercial customers, including arranging for the pickup, delivery, storage, and transportation of containers involved with personal and business belongings. Applicant denies by implication that the aforementioned services (referred by Opposer as “Applicant’s Services”), encompass all of the services that Applicant provides. In addition, Applicant uses its SMARTVAULT container as a vehicle to secure peoples’ goods to transport these goods within the UPS Freight network.

9. Denied. Applicant demands strict proof of Opposer’s allegations at the time of trial.

10. Admitted in part. Denied in part. Applicant admits only that Applicant has not filed an application to register the mark SMARTVAULT in connection with any services. Applicant denies the remaining allegations in this paragraph.

11. Admitted only that on February 3, 2005, Applicant filed an application for federal registration of the mark SMARTVAULT, used in connection with Applicant’s Claimed Goods under Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a). Applicant denies the remaining allegations in this paragraph.

12. Admitted in part and denied in part. Applicant admits only that the declaration filed with the SMARTVAULT application claims that the SMARTVAULT mark was in use in connection with Applicant’s Claimed Goods at the time that the application was filed, and the declaration further claimed that use of the SMARTVAULT Mark began on August 1, 2004 and that use of such mark in commerce began on January 1, 2005. Applicant denies the remaining allegations in this paragraph.

13. Denied. Applicant demands strict proof of Opposer’s allegations at the time of trial.

14. Denied. Applicant demands strict proof of Opposer's allegations at the time of trial.

15. Denied. Applicant demands strict proof of Opposer's allegations at the time of trial.

16. Admitted in part and denied in part. Applicant admits only that its SMARTVAULT application was published for opposition in the *Official Gazette* of November 15, 2005. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same.

Count I

17. Applicant restates and realleges the allegations of Paragraphs 1-16 above as if fully set forth herein.

18. Denied. The averments in this paragraph are legal conclusions to which no response is required, however to the extent that an answer may be necessary, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

19. Denied. The averments in this paragraph are legal conclusions to which no response is required, however to the extent that an answer may be necessary, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

20. Denied. The averments in this paragraph are legal conclusions to which no response is required, however to the extent that an answer may be necessary, Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in

this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

21. Denied. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

Count II

22. Applicant restates and realleges the allegations of Paragraphs 1-21 above as if fully set forth herein.

23. Denied. Applicant demands strict proof of Opposer's allegations at the time of trial.

24. Denied. Applicant demands strict proof of Opposer's allegations at the time of trial.

25. Denied. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments in this paragraph, and therefore denies same. Applicant demands strict proof of Opposer's allegations at the time of trial.

AFFIRMATIVE DEFENSES

First Affirmative Defense: Opposer's claims, in whole or in part, fail to state a claim upon which relief may be granted.

Second Affirmative Defense: Opposer's claims based upon allegations of fraud and/or misrepresentation fail to state claims with specificity and particularity.

Third Affirmative Defense: There is no likelihood of confusion between Opposer's claimed SMARTBOX and/or SMARTBOX & Design marks and Applicant's SMARTVAULT mark.

Fourth Affirmative Defense: Applicant's SMARTVAULT mark is inherently distinctive.

Fifth Affirmative Defense: Opposer's claimed SMARTBOX mark is unenforceable and/or invalid.

Sixth Affirmative Defense: Opposer's claimed SMARTBOX and SMARTBOX & Design marks are weak if at all enforceable, and therefore, Opposer is permitted a narrow, if any, scope of limited protection with respect to its claimed SMARTBOX and SMARTBOX & Design marks in light of third party uses and/or trademark registrations of marks containing the term "SMART" for related goods and/or services.

Seventh Affirmative Defense: Opposer's claimed SMARTBOX mark is merely descriptive, and not capable of protection without proof of secondary meaning.

Eighth Affirmative Defense: Opposer's Registration for its SMARTBOX A B & Design mark was obtained by fraud (and should be canceled) in that Opposer misled the UPSTO that, at the time the application was made, Opposer was entitled to use the term SMARTBOX in commerce and that no other person, firm, corporation, or association has the right to use SMARTBOX (or SMART BOX) in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive, when in fact, others have used the term (or incorporated use of the term) "SMART" including "SMARTBOX" and/or "SMART BOX" in connection with related goods or services.

Ninth Affirmative Defense: Opposer's claims are barred by unclean hands, waiver, estoppel and/or acquiescence.

PRAYER FOR RELIEF

WHEREFORE, Applicant prays this opposition be overruled and that Application Serial No. 78/560,422 issue to registration.

COUNTERCLAIM FOR CANCELLATION OF REG. NO. 2,864,385

26. On July 20, 2004, Opposer registered SMARTBOX A B & Design mark, Registration Number 2,864,385, for “arranging for the pickup, delivery, storage, and transportation of containers involved with personal and business belongings” alleging that it first used the mark in January 2003 when it filed as application Serial Number 76/495,584 on February 19, 2003.

27. Upon information and belief, at the time that Opposer filed its application to federally register the SMARTBOX A B & Design mark subject to Registration Number 2,864,385, Opposer knew or should have known that the mark was crowded by numerous third party uses and registrations of similar terms including many of which incorporate the term “SMARTBOX” and/or “SMART BOX” and/or predate Opposer’s use of SMARTBOX A B & Design mark subject to Registration Number 2,864,385.

28. Opposer’s Registration for SMARTBOX A B & Design mark subject to Registration Number 2,864,385 should be cancelled on the grounds that Opposer’s Registration for its SMARTBOX A B & Design mark was obtained by fraud in that Opposer misled the USPTO by claiming that no other person, firm, corporation, or association has the right to use the term SMARTBOX in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive, when in fact, others have used the term (or incorporated use of the term) “SMART” including “SMARTBOX” and/or “SMART BOX” in connection with related goods or services.

29. Applicant has been, and will continue to be, damaged by Opposer's Registration for SMARTBOX A B & Design mark, Registration Number 2,864,385 including but not limited to Opposer's enforcement of its claimed marks against Applicant, interference with Applicant's Initial Public Offering of securities; its merger and/or acquisition opportunities, among other grounds.

COUNTERCLAIM FOR PARTIAL CANCELLATION OF REG. NO. 2,864,385

30. Applicant incorporates the preceding paragraphs herein as though the same were fully set forth at length.

31. On July 20, 2004, Opposer registered SMARTBOX A B & Design mark, Registration Number 2,864,385, for "arranging for the pickup, delivery, storage, and transportation of containers involved with personal and business belongings" alleging that it first used the mark in January 2003 when it filed as application Serial Number 76/495,584 on February 19, 2003.

32. Opposer's Registration for SMARTBOX A B & Design mark subject to Registration Number 2,864,385 should be partially cancelled on the grounds that the term "SMARTBOX" is merely descriptive, lacks secondary meaning, and is crowded by numerous third party uses and registrations of similar terms including many of which incorporate the term "SMARTBOX" and/or "SMART BOX" and/or predate Opposer's use of SMARTBOX A B & Design mark subject to Registration Number 2,864,385.

33. The Opposer's SMARTBOX A B & Design mark subject to Registration Number 2,864,385 should be amended to disclaim the term "SMARTBOX" separate and apart from the mark as a whole.

34. Applicant has been, and will continue to be, damaged by Opposer's Registration for SMARTBOX A B & Design mark, Registration Number 2,864,385 including but not limited to Opposer's enforcement of its claimed marks against Applicant, interference with Applicant's Initial Public Offering of securities; its merger and/or acquisition opportunities, among other grounds.

PRAYER FOR RELIEF

WHEREFORE, Applicant prays this cancellation be granted and that Registration Number 2,864,385 be cancelled. In the alternative, Applicant prays that Registration Number 2,864,385 be partially cancelled to disclaim the term "SMARTBOX" as part of the mark.

Applicant, as counterclaimant, requests that the required fee and any additional fees be charged to the deposit account of Cozen O'Connor, Account No. 503111.

Respectfully submitted,

FOR APPLICANT:

/s/ Camille M. Miller

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Attorneys for Applicant,

A Smart Move LLC

Date: April 17, 2006

CERTIFICATE OF SERVICE

I, the undersigned, hereby certify that the foregoing was served on counsel of record for
Opposer by U.S. First Class Mail, postage prepaid, on the date below.

S. Brian Farmer, Esquire
Hirschler Fleischer
Federal Reserve Bank Building
701 East Byrd Street
Richmond, Virginia 23219

Date: April 17, 2006

Calvin Miller