

ESTTA Tracking number: **ESTTA102221**

Filing date: **10/03/2006**

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

Proceeding	91172550
Party	Defendant Smart Brain America, Inc. Smart Brain America, Inc. 40 Hillside Avenue Williston Park, NY 11596
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Date	10/03/2006
Attachments	Answer to Notice of Opposition.pdf ( 5 pages )(268098 bytes )

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

Akademi Sempoa & Mental Aritmetik  
U C MAS Sdn. Bhd.,

Opposer,

v.

Opposition No: 91172550

Application No.: 78/633,382

Mark: SMART BRAIN AMERICA  
(+ Design)

Smart Brain America, Inc.

Applicant.

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, VA 22313-1451

**ANSWER TO NOTICE OF OPPOSITION  
AND AFFIRMATIVE DEFENSES**

In response to the Notice of Opposition issued by the Board on August 25, 2006, Smart Brain America Inc. (“Applicant”) hereby responds to Akademi Sempoa & Mental Aritmetik U C MAS Sdn. Bhd. (“Opposer”) as follows:

1. Opposer is a Malaysian company that offers through its franchisees educational services in nearly 30 countries throughout the world, including U.S. Opposer’s educational services focus on mental development.

**Answer:** Applicant believes Opposer is a Malaysian company. Applicant is without knowledge or information sufficient to form a belief as to the truth of the other matters asserted in paragraph 1 of the Notice of opposition, and therefore denies the same.

2. On March 23, 2004, Opposer filed intent to use Application No. 78/389,287 for its highly distinctive house mark, which consists of a profile of a woman’s head that contains lines differentiating the learning centers of the brain (“Opposer’s Mark”). Opposer’s mark is depicted below (drawing not included in this response).

**Answer:** Applicant admits the allegations of Paragraph 2 of the Notice of Opposition. Applicant Notes that Opposer's Mark, as currently pending with the U.S. Trademark office, is: UCMAS COMPREHENSION LOGIC ANALYSIS VISION ENDURANCE MEMORY IMAGINATION APPLICATION DILIGENCE DISCOVERY SELF RELIANCE LISTENING (+ Design). The design element of Opposer's mark not only includes the bust of the head, but is also includes an image of the abacus/sorobon, while all by the "UCMAS" of the listed literal elements are contained within each of the differentiated parts of the brain.

3. Over one year later, on May 19, 2005, Applicant filed an application to register Applicant's Mark, which is depicted below (drawing not included in this response) and also consists of the profile of a woman's head that contains lines differentiating the learning centers of the brain.

**Answer:** Applicant admits that they filed an application to register their mark.

4. Because the design portions of Applicant's Mark and Opposer's mark are virtually identical, the designs are the predominant feature of each mark, and each application covers educational services, there is a likelihood of confusion between Opposer's Mark and Applicant's mark.

**Answer:** Applicant denies that the designs are virtually identical in that Opposer's mark includes other distinguishable design elements. Applicant admits that each application covers educational services, albeit completely different educational services, but they do both recite "educational services" in the broad sense. Applicant denies the remaining allegations of Paragraph 4 of the Notice of Opposition.

5. Given that Opposer's Mark and Applicant's mark are virtually the same, each application covers educational services, and the application to register Opposer's Mark was filed over one year before the application to register Applicant's Mark, the US Patent and Trademark Office ("USPTO") should have refused registration of Applicant's Mark based on a likelihood of confusion.

**Answer:** Applicant denies the allegations of Paragraph 5 of the Notice of Opposition.

6. Upon information and belief, at least one principal of Applicant used to work for or was otherwise affiliated with a former franchisee of Opposer in Thailand.

Neither the former franchisee nor Opposer granted Applicant any rights to use or to apply to register Applicant's mark in the United States.

**Answer:** Applicant denies the allegations of Paragraph 6 of the Notice of Opposition.

7. Because Applicant is not the owner of Applicant's mark under 15 U.S.C. §1051(a)(1), Applicant's application is void *ab initio*.

**Answer:** Applicant denies the allegations of Paragraph 7 of the Notice of Opposition.

8. Applicant, through its attorney, also stated in the Declaration to its application that Applicant:

believes the applicant to be the owner of the trademark/service mark sought to be registered;

to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form therefo 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;

and that all statements made of his/her knowledge are true; and that all statements made on information and belief are believed to be true.

**Answer:** Applicant admits the allegations of Paragraph 8 of the Notice of Opposition.

9. Upon information and belief, none of these statements was true at the time Applicant instructed its attorney to sign the Declaration to Applicant's application to register Applicant's mark. By making such material false statements upon which the USPTO relied, Applicant has committed fraud on the USPTO and therefore is not entitled to registration.

**Answer:** Applicant denies the allegations of Paragraph 9 of the Notice of Opposition.

10. Because Applicant is not the owner of the mark and has committed fraud on the USPTO, Applicant's mark is not entitled to registration.

**Answer:** Applicant denies the allegations of Paragraph 10 of the Notice of Opposition.

**AFFIRMATIVE DEFENSES**

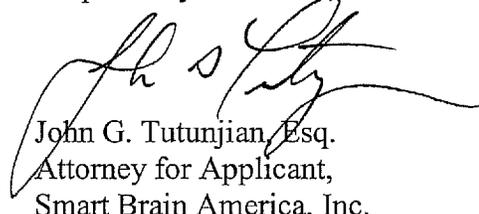
In further answer to the Notice of Opposition, Applicant asserts that:

1. Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.
2. Applicant's use of its mark will not mistakenly be thought by the public to derive from the same source as Opposer's Services, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization or approval.
3. The literal element of Applicant's mark, in its entirety, is sufficiently distinctively different from the literal element and additional design aspects of Opposer's mark to avoid confusion, deception or mistake as to the source or sponsorship or association of Applicant's services.
4. Applicant's mark, when used in connection with Applicant's services, is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's services by Opposer.
5. Opposer's actions and assertions of services provided that are not listed in their application constitute deceptiveness under section 2(a) of the Trademark act. Opposer's Notice of Opposition is therefore barred by the doctrine of unclean hands.

**RELIEF REQUESTED**

**WHEREFORE**, Applicant respectfully requests that this opposition proceeding be dismissed, with prejudice.

Respectfully submitted,

  
John G. Tutunjian, Esq.  
Attorney for Applicant,  
Smart Brain America, Inc.

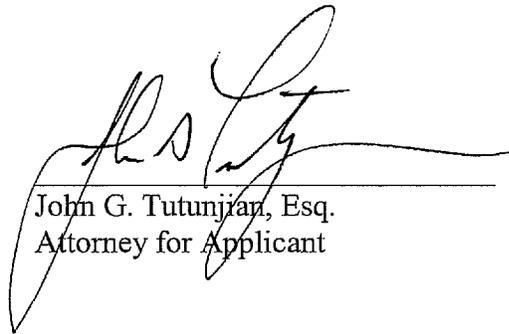
Dated: OCTOBER 3, 2006

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**CERTIFICATE OF FILING SERVICE**

I hereby declare that the foregoing instrument was filed via ESTTA and was also served upon the following this 3<sup>rd</sup> day of October, 2006, via 1<sup>st</sup> Class Mail.

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