

ESTTA Tracking number: **ESTTA141485**

Filing date: **05/19/2007**

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

Proceeding	91176716
Party	Defendant Stengel, Peter J. Stengel, Peter J. 10717 Faulkner Ridge Circle Columbia, MD 21044
Correspondence Address	SCOTT A. CONWELL CONWELL, LLC 2138 PRIEST BRIDGE CT STE NO4 CROFTON, MD 21114-2462  scott@conwellusa.com
Submission	Answer
Filer's Name	Scott A. Conwell
Filer's e-mail	scott@conwellusa.com
Signature	/Scott A. Conwell/
Date	05/19/2007
Attachments	Answer to TM Opposition 1976 - final - May 19, 2007.pdf ( 10 pages )(103740 bytes )

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

In re Application Serial No. : 78/7751976  
For the Mark : SMARTdesks  
Filed : November 11, 2005  
Published in the Trademark  
Official Gazette on : February 13, 2007

-----X  
:  
CBT SUPPLY, INC. AND :  
JEFFREY KORBER :  
Opposers, : Opposition No. 91176716  
:  
v. :  
:  
PETER J. STENGEL :  
Applicant. :  
:  
-----X

Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**APPLICANT’S ANSWER TO OPPOSERS’ NOTICE OF OPPOSITION**

In response to the Notice of Opposition issued by the Board on April 11, 2007, Peter J. Stengel, deceased Applicant, hereby responds by and through his designated representative, Conwell, LLC, to CBT Supply, Inc. and Jeffery Korber, Opposers, as follows:

1. Applicant admits Paragraph 1 of the Notice of Opposition.
2. Applicant admits that Jeffrey Korber is an individual domiciled and residing in Rockaway, New Jersey, is without knowledge and information as to his

positions with CBT Supply, Inc. Applicant denies that Design Form, Inc. and Smartdesks, Ltd. are legal predecessors of CBT Supply, Inc. Therefore Applicant denies the remainder of this paragraph.

3. Applicant denies the matters asserted in Paragraph 3 of the opposition for the reasons stated above and avers that the date of formation of CBT by the Maryland State Department of Assessments and Taxation was February 6, 2001. Applicant further avers that neither Jeffrey Korber nor any entity with which he claims he controlled had anything more than a limited license to use the trademark SMARTdesks for limited periods of time for limited purposes.

4. Applicant denies all the matters asserted in Paragraph 4 of the Opposition.

5. Applicant denies the allegations of Paragraph 5 of the Notice of Opposition except that Applicant admits that at least since December 7, 2005 when Applicant and Jeffery Korber formally terminated the existing contract and associated license, Opposers have, illegally and without justification or license, been infringing Applicant's common law trademark SMARTdesks along with numerous other trademarks, copyrights and patents owned by Applicant.

6. Applicant admits that CBT currently operates a website at [www.smartdesks.com](http://www.smartdesks.com) but denies the remaining allegations of Paragraph 7 of the Notice of Opposition. Applicant avers that, while operating under color of a license, CBT fraudulently obtained control of the website that was solely authored, created and owned by Applicant. The Opposers are not the legal owners of this website domain address and Applicant avers that the Opposers have been operating this website address since the expiration of their license on or before December 7, 2005 in violation of Federal laws

against “cybersquatting”. Applicant further avers for the reasons stated above that CBT did not exist before 2001 and it has no legal predecessors.

7. Applicant denies the allegations of Paragraph 7 of the Notice of Opposition.

8. Applicant denies the allegations of Paragraph 8 of the Notice of Opposition except that they admit that Peter Stengel had business dealings with Korber going back at least to 1997 when Korber was a subcontractor furniture manufacturer to the Applicant. Applicant’s business dealings with CBT go back to February 6, 2001, the date it was first formed. As stated above, all business dealings including licenses ended by December 7, 2005. Applicant further avers that, prior to any alleged claim by the Opposers, for the period between 1995 and November 19, 1997, as stated in the affidavits in support of Applicant’s application before the U.S.P.T.O., Applicant had developed and sold a substantial volume of computer desks of substantial value under the substantially similar trademark “Smartdesk” on a website undisputedly owned and controlled solely by Applicant.

9. Applicant admits the allegations of Paragraph 9 of the Notice of Opposition.

10. The Applicant’s applications for the subject Marks speak for themselves. Applicant denies the remaining allegations of Paragraph 10 of the Notice of Opposition and denies specifically that neither Jeffrey Korber nor any entity with which he claims he controlled ever had any ownership rights in the SMARTdesks Marks. As stated above, Applicant further avers that the SMARTdesks trademark was created and used in commerce by 1995, prior to any alleged claim by the Opposers. Also as stated above,

Applicant avers that neither Jeffrey Korber nor any entity with which he claims he controlled ever had anything more than a limited license to use the SMARTdesks Mark pursuant to a contract and associated joint business venture and that the Applicant's rights in the SMARTdesks trademark were never assigned, sold or otherwise transferred to Jeffrey Korber or to any entity which he claims he controlled. Applicant avers Korber and CBT illegally and without license or color of law are producing products that infringe the Applicant's copyrights, trademarks and patents that they are selling under the SMARTdesks Mark owned by Applicant.

11. The Applicant's applications for the subject Marks and associated specimens and exhibits speak for themselves. Applicant denies the remaining allegations of Paragraph 11 of the Opposition and, as stated above, further avers that neither Jeffrey Korber nor any entity with which he claims he controlled ever had anything more than a limited license to use the trademark SMARTdesks for limited periods of time for limited purposes that had terminated on or before December 7, 2005.

12. The Applicant's applications for the subject Marks and associated declarations and statements speak for themselves. Applicant denies the remaining allegations of Paragraph 12 of the Opposition.

13. The U.S.P.T.O. examining attorney's actions speak for themselves. Applicant notes that the examining attorney properly withdrew all refusals.

14. The Applicant's applications for the subject Marks and associated declarations and statements speak for themselves. Applicant denies the remaining allegations of Paragraph 14 of the opposition, but admits that some of the sales alleged in Applicant's response to the initial Office Action were sales that were made when

Applicant had a business association and contract with Opposers, and as stated above, the associated limited license the Applicant granted to the Opposer to use the trademark SMARTdesks for limited periods of time for limited purposes terminated on or before December 7, 2005. Applicant further denies that the sales volume recited had anything to do with the withdrawal by the Examiner of her initial rejection.

15. Applicant denies the allegations of paragraph 15 of the opposition.

16. Applicant denies the allegations of Paragraph 16 of the opposition.

17. The Applicant's applications for the subject Marks and associated declarations and statements speak for itself. Applicant denies any remaining allegations of Paragraph 17 of the Opposition.

18. The Applicant's applications for the subject Marks and associated declarations and statements speak for themselves. Applicant denies the remainder of the allegations of Paragraph 18 of the Opposition.

19. The Applicant's applications for the subject Marks and associated declarations and statements speak for themselves. Applicant denies any remaining allegations of Paragraph 19 of the Opposition.

20. The Applicant's applications for the subject Marks and associated declarations and statements speak for themselves. Applicant denies any remaining allegations of Paragraph 20 of the Opposition. Applicant avers that web pages submitted to the U.S.P.T.O. were the web pages "as the website existed on or before 1999" as stated to the U.S.P.T.O., and that the web pages used to market the SMARTdesks line of computer furniture constantly changed over the years, from Applicant's initial website marketing on or before April 1996 through his business association, contract and license

granted to Opposers, to the termination of the Opposers' license thereof on or before December 7, 2005, to the present lawful website incarnation at [www.smartdesksinc.com](http://www.smartdesksinc.com) as of May 2007. Applicant further avers that these facts have no relevance to any matters raised by the Opposition.

21. Applicant denies the allegations contained in Paragraph 21 of the Opposition.

22. Applicant denies the allegations contained in Paragraph 22 of the Opposition.

23. Applicant admits the allegations contained in Paragraph 23, but avers that such consent or authorization is not necessary and would be without force and effect even if given because neither CBT nor Korber is legally in possession of any proprietary rights in any of the SMARTdesks trademarks.

24. Applicant admits the allegations contained in Paragraph 24, but avers that such consent or authorization is not necessary and would be without force and effect even if given because neither CBT nor Korber is legally in possession of any proprietary rights in any of the SMARTdesks trademarks.

25. Applicant denies the allegations contained in Paragraph 25 of the Opposition except and to the extent that the Opposers are illegally and without license or color of law producing products which infringe the Applicant's copyrights, trademarks and patents that they are selling under the SMARTdesks Mark owned by Applicant and to the extent that, under color of license, Opposers fraudulently obtained control of a website and domain name that was solely authored, created and owned by Applicant.

26. Applicant denies the allegations of Paragraph 26 of the Opposition.

27. Applicant denies the allegations of Paragraph 27 of the Opposition.

**AFFIRMATIVE DEFENSES**

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

FIRST AFFIRMATIVE DEFENSE

Opposers' Notice of Opposition fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition.

SECOND AFFIRMATIVE DEFENSE

Jeffrey Korber, CBT and related entities are estopped to assert any priority date for the "SMARTdesks" Mark prior to March 16, 2000, the date on which Smartdesks Ltd, an entity that Korber claims is a CBT predecessor, filed an Application with the U.S.P.T.O. for registration of the "SMARTDESKS.COM" mark, Ser. No. 76002027, asserting under penalty of perjury that the Application was for "intent to use" the proposed mark, a representation that the proposed mark was not then used in commerce by the Opposers or any claimed predecessor.

THIRD AFFIRMATIVE DEFENSE

Jeffrey Korber, CBT and related entities are estopped to oppose the Registration of Applicant's trademark because on January 21, 1999 and March 16, 2000 while still in a business relationship with Applicant and without informing Applicant, Smartdesks Ltd, an entity that Korber claims is a CBT predecessor, filed SMARTdesks applications with the U.S.P.T.O. for registration of SMARTdesks Marks, the first was for the Mark SMARTDESKS, including "Words, Letters, and/or Numbers in Stylized Form", Ser. No. 75624578, and the second was for the Mark "SMARTDESKS.COM", Ser. No.

76002027, both of which Opposers then abandoned. Opposers' failure to pursue these Applications at that time estops them from now raising any issues that would have been raised by the prosecution and publication of these Applications.

#### FOURTH AFFIRMATIVE DEFENSE

Opposers are estopped to oppose or claim priority for the Mark by their conduct.

#### FIFTH AFFIRMATIVE DEFENSE

Opposers are estopped to make any claims with regard to the trademark SMARTdesks because of their inequitable conduct before the U.S.P.T.O., including but not limited to, false and fraudulent statements made to the U.S.P.T.O. and elsewhere.

#### SIXTH AFFIRMATIVE DEFENSE

Opposers are estopped to oppose this Application because of their long years of Acquiescence as licensees of the mark and acceptance of benefits arising from the contractual use of this Mark in commerce.

#### SEVENTH AFFIRMATIVE DEFENSE

Opposers admit that Applicants have priority for the mark and do not allege that the mark was ever abandoned or that ownership of the mark was ever sold, assigned or otherwise transferred to any other party. Therefore, Applicant remains the sole owner of the mark with the lawful and unique right to register the mark.

#### NOTICE OF PENDING LITIGATION

Opposers mislead and misinform the U.S.P.T.O. With regard to the Preliminary Injunction mentioned, the Court in MJG-05-3456 specifically stated that it would *not then* make any determination as to the rights to the domain name or website pending any ultimate resolution of certain copyright and common law trademark issues. In fact,

currently, it is only the Opposers who are currently subject to a pending Preliminary Injunction that, among other Court ordered requirements, enjoins Opposers from the use of the www.smartdesks.com domain name, requires use of a domain name such as www.cbtsupplyinc.com, that does not confuse the public into believing that the goods or services offered on that website are produced or provided by Smartdesks, Inc., requires the Opposers to stop using the name Smartdesks as a corporate identifier of the products and services of CBT Supply, and requires the Opposers to present a reasonably prominent corporate indicator on the top part of the webpage indicating that each page of the website is owned and operated by CBT Supply, Inc. and not any name such as Smartdesks.

RELIEF REQUESTED

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

Respectfully submitted,

CONWELL, LLC

/s/ \_\_\_\_\_  
Scott A. Conwell  
**scott@conwellusa.com**

H. Robert Field  
**rfield@conwellusa.com**  
2138 Priest Bridge Court, Suite No. 4  
Crofton, MD 21114  
TELE: (410) 451-2707  
FAX: (410) 451-2706

Counsel for Applicant

Dated: May 18, 2007