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

Proceeding	91180485
Party	Defendant GOREN, MELVINA
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Applicant, SOUL STAR UNDERGROUND, Serial No. 76652351 filed with the United States Patent & Trademark Office (hereinafter referred to as the “PTO”) December 22, 2005 submits this response to the Notice of Opposition filed on behalf of Application Serial No. 78680003 for the trademark UNDERGROUND SOUL filed on July 27, 2005.

Swat Fame, Inc.,

Opposer

vs.

Melvina Goren,

Applicant

Opposition No. 91180485

ANSWER

Melvina Goren (hereinafter referred to as “Applicant”), an individual, located in Brooklyn, New York, hereby refutes Swat Fame, Inc.’s (hereinafter referred to as “Opposer”) argument, mailed October 31, 2007, which contends that Applicant’s mark, SOUL STAR UNDERGROUND will likely cause confusion with Opposer’s mark, UNDERGROUND SOUL.

GENERAL OBJECTIONS

1. Applicant objects to Paragraph 1 of the Opposition to the extent that Opposer purports to have been engaged in the manufacture and sale of “a wide range of apparel in commerce in the United States” for several years. Applicant has conducted research to investigate this statement and to date has not found any evidence to support Opposer’s claim of its presence in commerce. Unless Opposer can prove otherwise, the Opposer’s claim is without merit.

2. Applicant neither accepts nor denies Paragraph 2 of the Opposition.

3. Applicant objects to Paragraph 3 of the Opposition to the extent that Applicant has no knowledge of Opposer’s actual use and has not been presented with or discovered any evidence to support Opposer’s claim of its use of the mark UNDERGROUND SOUL in the “distinctive format” that is displayed in Opposer’s Exhibit A. The “distinctive format” that Opposer alleges is displayed in Opposer’s Exhibit A, but yet there is no proof of such “distinctive format” prior to the date in which Applicant filed its application with the PTO. Applicant requests proof of Opposer’s use of the “distinctive format” prior to the registration date of Applicant’s application with the PTO. As stated in Paragraph 2 of the Opposition, Opposer filed an application with the PTO on July 27, 2005 for the mark UNDERGROUND SOUL in standard characters. Without contrary evidence of the Opposer’s use of its “distinctive format,” it must be assumed that the standard characters illustrated in Opposer’s application were only used in commerce. Additionally, Opposer contends without justification that its mark, which was registered only as UNDERGROUND SOUL, is somehow entitled to be referred to as SOUL UNDERGROUND, which is a completely different mark. Opposer attempts to

make this claim without merit; SOUL UNDERGROUND was never registered, and therefore such a claim is without merit because trademark law does not permit one to assume protection of the inverse of a mark which depicts an entirely different impression, unless a new application is filed to reflect such a change.

4. Applicant neither accepts nor denies Paragraph 4 of the Opposition.

5. Applicant neither accepts nor denies Paragraph 5 of the Opposition.

6. Applicant neither accepts nor denies Paragraph 6 of the Opposition.

7. Applicant objects to Paragraph 7 of the Opposition to the extent that Opposer fails to provide evidence of “extensive marketing and sales” as alleged in its Opposition. There is no notable knowledge and existence of the Opposer’s mark in commerce. Furthermore, as a result of thorough investigation, there is no evidence or sufficient knowledge which supports Opposer’s contention that the mark has “acquired a reputation among the trade and consumer” in connection with “quality apparel.” Unless Opposer can provide evidence of its extensive marketing and sales reports for the past two (2) years, the claim is without support.

8. Applicant neither accepts nor denies Paragraph 8 of the Opposition.

9. Applicant objects to Paragraph 9 of the Opposition to the extent that Opposer argues that Applicant’s trademark is intended to be applied to goods which are identical to the goods in connection with Opposer’s trademark. However, Opposer’s initial application has identified virtually every known variation of wearing apparel, forty two (42) types to be exact. Therefore, it would be impossible for any applicant, not only the Applicant at issue here, to identify completely different configurations of common goods when the class of clothing apparel consists of nearly everything Opposer has

included in its application. Trademark protection does not extend to a common class of goods, but rather allows marks to indicate the source of its goods with its exclusive registered trademark. The scope of Opposer's goods are so common to the apparel industry that it would severely undermine the legislative intent of the Trademark Act and would unduly prejudice the Applicant from utilizing the very arbitrary words SOUL or UNDERGROUND in connection with its goods.

10. Applicant strongly objects to Paragraph 10 of the Opposition because a likelihood of confusion fails to exist where Applicant's trademark SOUL STAR UNDERGROUND, has a very unique, stylized design feature entailing flowers, wrapping vines, coils, swirls and spirals as referenced in the mark as attached to the application; the first two words, SOUL STAR are placed in big letters over the word UNDERGORUND, thus making SOUL STAR the dominant feature of the mark. Although unlikely, in the event the Opposer can provide evidence to show its use of the mark in the "distinctive format" as displayed in Opposer's Exhibit A, Applicant's mark is nonetheless very dissimilar from that of Opposer's mark because the dominant feature of Opposer's mark is SOUL with the word UNDERGROUND going through the word SOUL which is drastically different than Applicant's mark. Therefore, both marks are very distinct from each other and such distinguishable characteristics will allow them to co-exist without the threat of confusion.

11. Applicant strongly objects to Paragraph 11 of the Opposition to the extent that Opposer argues that registration of Applicant's mark is barred by the provisions of Section 2(d) of the Trademark Act of 1946 which provides that a mark will be denied registration if another mark so resembles a mark registered in the Patent and Trademark

Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive. That is not the case here because the Applicant's mark and the Opposer's mark are completely distinctive as specified herein in Paragraph 10, and therefore will not cause confusion, mistake or deception amongst consumers in the marketplace. Additionally, Applicant's mark was submitted and the PTO could not support a finding of existing marks that were either similar to Applicant's mark or that could possibly cause confusion with Applicant's mark. Thus, without such evidence, registration cannot be withheld in this instance.

12. Again, there is no evidence that Opposer has actually used its mark in the "distinctive format" as alleged in the Opposition. In fact, there is no trace of the so-called "distinctive format" as used in commerce. To that point, although Opposer was very diligent in submitting an application on behalf of its existing mark, UNDERGROUND SOUL, in which the characteristics of that mark was deliberately divided to coincide with its specific use, Opposer in filing UNDERGROUND SOUL neglected to use proper due diligence in registering the SOUL UNDERGROUND mark as claimed, which by the way, is argued to be more consistent with Opposer's current use of the mark in commerce. Further, one could argue that Opposer's random submission for SOUL UNDERGROUND (Serial Nos. 77251393 and 77253166 respectively) dated nearly two (2) months after Applicant's mark, SOUL STAR UNDERGROUND was published for opposition was an act done in bad faith. Opposer's claim that UNDERGROUND SOUL is also referred to as SOUL UNDERGROUND is without merit and further shows

Opposer's unfair attempts to secure UNDERGROUND SOUL as against the registered SOUL STAR UNDERGROUND mark.

WHEREFORE, Applicant believes that the evidence fails to support a likelihood of confusion or a claim for damage suffered by Opposer if registration is granted, and therefore prays that this Response be sustained and the Opposition sought by Opposer be denied.

Applicant hereby appoints Patricia Lawrence Kolaras, member of the Bar of the State of New Jersey, and PLK Law Group, P.C., 390 Amwell Road, Building 3, Suite 313, Hillsborough, New Jersey 08844 as its attorneys to defend this Response, with full power of substitution and revocation, and to transact all business in the United States Patent & Trademark Office in connection therewith. All correspondence is to be forwarded to the PLK Law Group, P.C. at the address indicated herein.

BY: _____

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Dated: December 11, 2007

This response was sent to William A. Finkelstein of Dreier Stein & Kahan, LLP, located at 1620 26th Street, 6th Floor – North Tower, Santa Monica, CA 90404 via Express Mail on behalf of the Opposer in accordance with 37 C.F.R. §2.119.

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