

ESTTA Tracking number: **ESTTA212700**

Filing date: **05/20/2008**

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

Proceeding	91183496
Party	Defendant David H. Brown, dba Alliance Skateboards
Correspondence Address	David H. Brown Alliance Skateboards 1410 Vantage Court Vista, CA 92083 syndromedist@verizon.net
Submission	Answer and Counterclaim
Filer's Name	Kit M. Stetina
Filer's e-mail	opposition@stetinalaw.com
Signature	/Kit M. Stetina/
Date	05/20/2008
Attachments	AnswerandCounterclaim.pdf (7 pages)(145792 bytes)

Registration Subject to Counterclaim

Registration No	3026496	Registration date	12/13/2005
Registrant	ALPHA 6 DISTRIBUTIONS, LLC 8 HAVEN AVENUE SUITE 226 PORT WASHINGTON, NY 11050 UNITED STATES		

Goods/Services Subject to Counterclaim

<p>Class 025. First Use: 2004/01/00 First Use In Commerce: 2004/01/00 All goods and services in the class are requested, namely: MEN'S, WOMEN'S AND CHILDREN'S CLOTHING AND APPAREL, NAMELY, SKI JACKETS, ONE-PIECE SKI SUITS, SKI PANTS; SWEATERS, HATS, SHORTS, PANTS, T-SHIRTS, KNIT SHIRTS, INSULATED BOMBER JACKETS, PARKAS, UNFILLED SHELL JACKETS, DOWN-FILLED JACKETS, INSULATED PANTS AND SHELL PANTS; NAMELY, DOWN-FILLED JACKETS AND POLYESTER-FILLED JACKETS; SKIWEAR, NAMELY, BOOTS, GLOVES AND HEADWEAR; INCLEMENT WEATHER AND SKI APPAREL, NAMELY, JACKETS, PANTS, BIB OVERALLS AND SHIRTS; SHORTS; SWIMWEAR</p>
<p>Class 028. First Use: 2004/01/00 First Use In Commerce: 2004/01/00 All goods and services in the class are requested, namely: SURFBOARD BAGS, SNOWBOARD BAGS</p>

4. Applicant admits the allegations of this paragraph.
5. Applicant denies the allegations of this paragraph.
6. Applicant denies the allegations of this paragraph.
7. Applicant denies the allegations of this paragraph.
8. Applicant denies the allegations of this paragraph.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

Opposer has failed to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Opposer has no standing to assert the claims set forth in the Notice of Opposition.

THIRD AFFIRMATIVE DEFENSE

Opposer's claims are precluded by the Doctrine of Estoppel.

FOURTH AFFIRMATIVE DEFENSE

Opposer's claims are precluded by the Doctrine of Acquiescence.

FIFTH AFFIRMATIVE DEFENSE

Opposer will not be damaged by registration of Applicant's Mark.

SIXTH AFFIRMATIVE DEFENSE

Opposer is barred, in whole or in part, from relief by the Doctrine of Waiver.

SEVENTH AFFIRMATIVE DEFENSE

Opposer is barred, in whole or in part, from relief by the Doctrine of Laches.

EIGHTH AFFIRMATIVE DEFENSE

Opposer is barred, in whole or in part, from relief by the Doctrine of Unclean Hands.

NINTH AFFIRMATIVE DEFENSE

Applicant alleges that its conduct was at all times lawful, privileged, justified, reasonable, and in good faith, based upon the relevant facts known at the time it acted.

TENTH AFFIRMATIVE DEFENSE

Opposer's claims are barred insofar as Opposer has abandoned its trademark(s).

ELEVENTH AFFIRMATIVE DEFENSE

Opposer has failed to adequately maintain, police or enforce any trademark or proprietary rights it may once have had in its alleged pleaded mark(s).

TWELFTH AFFIRMATIVE DEFENSE

Applicant hereby gives notice that it may rely on any other defenses that may become available or appear proper during discovery, and hereby reserves its right to amend this Answer to assert any such defenses.

WHEREFORE, Applicant prays that this opposition be dismissed, and that the subject application proceed to registration and for such other and further relief as may be appropriate.

PETITION TO CANCEL

In the matter of U.S. Trademark Registration No. 3,026,496 for the mark ALLYANCE, registered December 13, 2005, to Alpha 6 Distributions LLC, of New York, NY ("Opposer"), for men's, women's and children's clothing and apparel, namely, ski jackets, one-piece ski suits, ski pants; sweaters, hats, shorts, pants, t-shirts, knit shirts, insulated bomber jackets, parkas, unfilled shell jackets, down-filled jackets, insulated pants and shell pants; namely, down-filled jackets and polyester-filled jackets; skiwear, namely, boots, gloves and headwear; inclement weather and ski apparel, namely, jackets,

pants, bib overalls and shirts; shorts; swimwear in International Class 025, and surfboard bags, snowboard bags in International Class 028, Applicant believes that it will be damaged by the continued registration of this trademark and hereby petitions to cancel the same. As grounds for cancellation, it is alleged as follows:

1. Applicant is and has been for many years engaged in the extensive development, advertising and marketing of a variety of clothing, shoes and the like. In connection therewith, Applicant has used, or filed federal applications with an intent to use, in interstate commerce, the mark ALLIANCE (ALLIANCE TRADEMARK) for the aforementioned goods since long prior to Opposer's date of first use set forth in U.S. Registration No. 3,026,496 for the mark ALLYANCE.

2. Since at least as early as January 25, 1999, Applicant has made use of its ALLIANCE TRADEMARK throughout the United States in interstate commerce. Since adoption of its ALLIANCE TRADEMARK, Applicant has continuously used those marks throughout the United States in interstate commerce.

3. Applicant has expended considerable sums in exerting every effort to maintain the highest standard of quality for its products, and has created valuable goodwill among the purchasing public under its ALLIANCE TRADEMARK.

4. As a result of the continuous and extensive use of the ALLIANCE TRADEMARK by Applicant, those marks have become and continue to function as a valuable business and marketing asset of Applicant, and serve to indicate to the trade and consuming public the products originating from Applicant and its authorized representative.

5. Opposer has obtained United States Trademark Registration No. 3,365,649, registered January 8, 2008, for the mark ALLIANCE for the goods set forth in that registration. A copy of that registration is attached hereto as **Exhibit 1**.

6. Opposer's above-identified registration recites a date of first use, as well as first use in commerce, on January 2004. Since Applicant has been using its ALLIANCE TRADEMARK in commerce for many years prior to Opposer's stated date of first use and first use in commerce, Applicant has priority over Opposer concerning its mark, or any mark confusingly similar thereto.

7. Based upon Opposer's assertions made in the Notice of Opposition, Opposer's use of the designation ALLYANCE constitutes misrepresentation of source of the products offered in connection therewith and falsely suggests an association between the products of Opposer and Applicant. Further, based upon Opposer's assertions made in the Notice of Opposition, Opposer's ALLYANCE mark is confusingly similar to Applicant's ALLIANCE TRADEMARKS and its registration and continued use by Opposer on the goods claimed in the subject registration is likely to cause confusion, deception and mistake.

8. Therefore, Opposer's use of the mark ALLYANCE interferes with Applicant's use of its ALLIANCE TRADEMARKS and continued registration of the mark ALLYANCE by Opposer will seriously damage Applicant.

9. Accordingly, if Opposer's Registration is not canceled, Applicant will continue to suffer irreparable harm and damage.

10. On the foregoing basis, Applicant believes it has been damaged by, and will continue to be damaged by, the continued existence of United States Registration No. 3,026,496.

WHEREFORE, Applicant prays for cancellation of United States Registration No. 3,026,496.

Applicant authorizes the filing fee for this Petition for Cancellation in the amount of \$600 (2 international classes) to be charged to Applicant's Deposit Account.

Respectfully submitted,

Dated: May 20, 2008

By:



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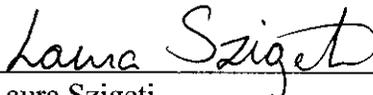
PROOF OF SERVICE

State of California)
) ss.
County of Orange)

I am over the age of 18 and not a party to the within action; my business address is 75 Enterprise, Suite 250, Aliso Viejo, California 92656. On **May 20, 2008**, the attached **ANSWER AND COUNTERCLAIM FOR CANCELLATION** was served on all interested parties in this action by U.S. Mail, postage prepaid, at the address as follows:

Mario Aieta
Satterlee Stephens Burke & Burke LLP
230 Park Avenue
New York, NY 10169

Executed on **May 20, 2008** at Aliso Viejo, California. I declare under penalty of perjury that the above is true and correct. I declare that I am employed in the office of STETINA BRUNDA GARRED & BRUCKER at whose direction service was made.



Laura Szigeti