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

Proceeding	91184529
Party	Defendant Global Tissue Group, Inc.
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Submission	Answer and Counterclaim
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Date	04/23/2010
Attachments	First Amended Answer and Counterclaims.pdf (27 pages)(1375063 bytes)

Registrations Subject to the filing

Registration No	2872813	Registration date	08/10/2004
Registrant	Fort James Operating Company 133 Peachtree Street, NE, GA030-41N Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2003/12/01 First Use In Commerce: 2003/12/01 All goods and services in the class are requested, namely: Bath tissue
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Registration No	2957128	Registration date	05/31/2005
Registrant	Fort James Operating Company GA030-41N 133 Peachtree Street, N.E. Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 1993/01/07 First Use In Commerce: 1993/01/07 All goods and services in the class are requested, namely: bath tissue
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Registration No	3170713	Registration date	11/14/2006
Registrant	Fort James Operating Company 133 Peachtree St., N.E. Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2005/03/01 First Use In Commerce: 2005/03/01
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All goods and services in the class are requested, namely: Bath tissue

Registration No	2933048	Registration date	03/15/2005
Registrant	Fort James Operating Company GA030-41N 133 Peachtree Street, N.E. Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 1993/01/07 First Use In Commerce: 1993/01/07
All goods and services in the class are requested, namely: bath tissue

Registration No	3069376	Registration date	03/14/2006
Registrant	Fort James Operating Company GA030-41N 133 Peachtree Street, N.E. Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2005/05/02 First Use In Commerce: 2005/05/02
All goods and services in the class are requested, namely: Bath tissue

Registration No	2968615	Registration date	07/12/2005
Registrant	Fort James Operating Company GA030-41N 133 Peachtree Street, N.E. Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2004/08/01 First Use In Commerce: 2004/08/01
All goods and services in the class are requested, namely: Facial tissue

Registration No	3463900	Registration date	07/08/2008
Registrant	Georgia-Pacific Consumer Products LP 133 Peachtree St., NE Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2008/02/00 First Use In Commerce: 2008/02/00
All goods and services in the class are requested, namely: Bathroom tissue

Registration No	3463899	Registration date	07/08/2008
Registrant	Georgia-Pacific Consumer Products LP 133 Peachtree St., N.E. Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2008/02/00 First Use In Commerce: 2008/02/00
All goods and services in the class are requested, namely: Bathroom tissue

Registration No	3018501	Registration date	11/22/2005
Registrant	Fort James Operating Company GA030-41N 133 Peachtree Street, NE Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2004/08/01 First Use In Commerce: 2004/08/01 All goods and services in the class are requested, namely: Bath tissue
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Registration No	3293547	Registration date	09/18/2007
Registrant	Fort James Operating Company 133 Peachtree Street, NE Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2004/08/01 First Use In Commerce: 2004/08/01 All goods and services in the class are requested, namely: FACIAL TISSUES

Registration No	3463460	Registration date	07/08/2008
Registrant	Georgia-Pacific Consumer Products LP 133 Peachtree Street NE Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2008/02/00 First Use In Commerce: 2008/02/00 All goods and services in the class are requested, namely: Bathroom tissue
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Registration No	2980757	Registration date	08/02/2005
Registrant	Fort James Operating Company GA030-41N 133 Peachtree Street, NE Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2002/03/31 First Use In Commerce: 2002/03/31 All goods and services in the class are requested, namely: BATH TISSUE
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Registration No	3642378	Registration date	06/23/2009
Registrant	Georgia-Pacific Consumer Products LP 133 Peachtree St, NE Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2008/02/00 First Use In Commerce: 2008/02/00 All goods and services in the class are requested, namely: Bathroom tissue
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Registration No	3517622	Registration date	10/14/2008
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Registrant	Georgia-Pacific Consumer Products LP 133 Peachtree Street NE Atlanta, GA 30303 UNITED STATES
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Goods/Services Subject to the filing

Class 016. First Use: 2008/08/03 First Use In Commerce: 2008/08/03 All goods and services in the class are requested, namely: Bathroom tissue
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Registration No	3642213	Registration date	06/23/2009
Registrant	Georgia-Pacific Consumer Products LP 133 Peachtree St, NE Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2008/02/00 First Use In Commerce: 2008/02/00 All goods and services in the class are requested, namely: Bathroom tissue
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Registration No	3532136	Registration date	11/11/2008
Registrant	Georgia-Pacific Consumer Products LP 133 Peachtree St., NE Atlanta, GA 30303 UNITED STATES		

Goods/Services Subject to the filing

Class 016. First Use: 2008/02/04 First Use In Commerce: 2008/02/04 All goods and services in the class are requested, namely: Bathroom tissue
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GEORGIA-PACIFIC CONSUMER PRODUCTS LP,)	
)	
Opposer,)	Opposition No.: 91184529
)	
v.)	
)	
GLOBAL TISSUE GROUP, INC.)	
)	
Applicant.)	
)	

FIRST AMENDED ANSWER AND COUNTERCLAIMS

Applicant, Global Tissue Group, Inc., through its undersigned counsel, hereby files its First Amended Answer and Counterclaims in accordance with the Board’s Order of March 25, 2010. Applicant answers the specific allegations contained in the Opposer’s Amended Notice of Opposition as follows:

1. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 1 and therefore denies those allegations.
2. Applicant lacks sufficient information to either admit or deny the allegations concerning the scope of the Opposer’s business as alleged in Paragraph 2 and therefore denies those allegations. All other allegations in Paragraph 2 are denied.
3. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 3 and therefore denies those allegations.
4. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 4 and therefore denies those allegations.

5. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 5 and therefore denies those allegations.

6. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 6 and therefore denies those allegations.

7. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 7 and therefore denies those allegations.

8. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 8 and therefore denies those allegations.

9. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 9 and therefore denies those allegations.

10. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 10 and therefore denies those allegations.

11. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 11 and therefore denies those allegations.

12. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 12 and therefore denies those allegations.

13. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 13 and therefore denies those allegations.

14. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 14 and therefore denies those allegations.

15. Denied.

16. Denied.

17. Denied.

18. Admitted.

19. Denied.

20. Applicant lacks sufficient information to either admit or deny the allegations in Paragraph 20 and therefore denies those allegations.

21. Applicant denies the allegations contained in the first sentence of Paragraph 21. Applicant lacks sufficient information to either admit or deny the allegations in the second sentence of Paragraph 21 and therefore denies those allegations. Applicant admits the remainder of the allegations contained in Paragraph 21.

22. Denied.

23. Denied.

24. Denied.

25. Denied.

26. Denied.

AFFIRMATIVE DEFENSES

As its affirmative defenses to the Amended Notice of Opposition, Applicant alleges as follows:

27. Opposer fails to state a claim upon which relief can be granted.

28. Opposer is not likely to be damaged by registration of the Applicant's mark and therefore, Opposer lacks standing to oppose registration of same.

29. Opposer's opposition is barred by the doctrine of unclean hands.

30. The terms "Quilt" and "Quilted" for the relevant goods are generic or highly descriptive and to which no party may claim exclusive rights.

31. Opposer has disclaimed rights to the terms “Quilt” and “Quilted” in its trademark applications and registration, and cannot assert exclusivity with respect to those terms with respect to the relative goods.

32. Numerous third parties, which on information and belief are unrelated to Opposer and unlicensed by Opposer, are using the terms “Quilt,” “Quilted,” and other quilt-formative marks in connection with the same goods as the relevant goods in this opposition. In addition, there are several other Quilted-formative marks coexisting with Opposer’s marks both on the PTO register and in the marketplace, including Procter & Gamble’s registrations for THE STRONG QUILTED PICKER UPPER Reg. No. 3178381 and BOUNTY DOUBLE QUILTED Reg. No. 2533080, and Kruger Products’ registration for QUILTED POCKETS Reg. No. 3315444, all for paper towels. The co-existence of these Quilt-formative marks for the relevant goods in International Class 16 limit the distinctiveness of Opposer’s referenced marks and demonstrated the public’s ability to distinguish among the marks.

33. There is widespread third party use of the terms “Quilt” and “Quilted” in the relevant industry, rendering all of such terms incapable of serving as source identifiers by themselves.

34. Opposer’s purported rights to the term “Quilted” and “Quilt” are inferior to third parties who use those terms in the relevant industry.

35. The terms “Quilt” or “Quilted” as used by Opposer in all of its marks are inferior parts of each mark, as evidenced by Opposer’s own disclaimers, and Applicant does not use any of the dominant portions of such marks, making the likelihood of confusion between Applicant’s mark and any of Opposer’s marks highly unlikely.

36. Applicant's use of the independently coined term QUILTY has not and will not cause the public to mistakenly believe that Applicant's goods originate from the same source as Opposer's goods, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization and consent.

37. Applicant's mark QUILTY in its entirety is sufficiently distinctive and different from all of Opposer's marks to avoid confusion, deception or mistake as to the source, sponsorship or association of the Applicant's goods with Opposer.

38. Opposer's claims are barred by the doctrine of laches, estoppel, acquiescence and/or waiver in relation to the numerous third party uses of the terms "Quilt" and "Quilted" used on or in connection with a wide variety of goods and services.

WHEREFOR, Applicant requests that this Opposition proceeding be dismissed and that its application for registration of its design be allowed to register.

COUNTERCLAIMS

As for its counterclaims, Applicant/Petitioner Global Tissue Group, Inc. (Global Tissue) alleges as follows:

39. Global Tissue is the owner of U.S. Application Serial Number 77/364,616 for QUILTY covering "consumer and industrial paper products, namely, facial tissues, napkins, towels and bathroom tissues" in International Class 16.

40. Global Tissue has been and is now extensively engaged in the business of manufacturing, marketing and selling various goods in interstate commerce, including facial tissues, napkins, towels and bathroom tissues, and related goods.

41. Opposer/Registrant Georgia-Pacific Consumer Products LP (Georgia-Pacific) has been and is now engaged in the business of manufacturing, marketing and selling various goods in interstate commerce, including facial tissue, napkins, towels, bath tissue, and related goods.

42. Global Tissue and Georgia-Pacific are competitors and compete in the sale of facial tissue, napkins, towels, bathroom tissue, and related goods.

43. Georgia-Pacific has filed the present opposition proceeding against Global Tissue's intent-to-use application for QUILTY, citing the following twelve registrations: 3,170,713; 2,867,895; 3,069,376; 2,957,128; 2,933,048; 2,968,615; 2,209,027; 2,663,438, 3,018,501; 3,293,547; 2,059,102; and 2,872,813.

44. Global Tissue believes that it is being damaged and will continue to be damaged by registration of the marks that are the subject of the following United States Trademark Registrations owned by Georgia-Pacific: 2,872,813; 2,957,128; 3,170,713; 2,933,048; 3,069,376; 2,968,615; 3,463,900; 3,463,899; 3,018,501; 3,293,547; 3,463,460; 2,980,757; 3,642,378; 3,517,622; 3,642,213; and 3,532,136. As described more fully hereinbelow, Global Tissue hereby petitions for cancellation of such registrations and/or that such registrations be modified to include an appropriate disclaimer.

COUNT 1: US Reg. No. 2,872,813

45. Global-Tissue repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

46. Georgia-Pacific is the owner of United States Trademark Registration No. 2,872,813 for QUILTING covering "bath tissue" in International Class 16. The

registration was granted on August 10, 2004. As of the filing of this Answer, the registration is more than five years old.

47. Georgia-Pacific has cited Registration No. 2,872,813 against Global Tissue's intent-to-use application for QUILTY in the present opposition proceeding.

48. Global Tissue requests that Reg. No. 2,872,813 be cancelled on the grounds that it has been abandoned due to non-use. The applied-for mark, as shown in the drawing of the mentioned registration, has never been used and/or functioned in commerce as a trademark. The specimen associated with this registration does not show the applied-for mark functioning as a trademark. In particular, the specimen shows the phrase "It's all in the Quilting™" appearing on a package of bath tissue. The appearance of the term "Quilting" within the recited phrase, despite such term appearing in stylized lettering, does not constitute usage of the applied-for mark as a trademark because the purchasing public would not recognize the term "Quilting" in and of itself to be an indicator of source or origin for this particular product.

COUNT 2: US Reg. No. 2,957,128

49. Global Tissue repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

50. Georgia-Pacific is the owner of United States Trademark Registration No. 2,957,128 for QUILTED covering "bath tissue" in International Class 16. The registration was granted on May 31, 2005. As of the filing date of this petition, the registration is less than five years old.

51. Georgia-Pacific has cited Registration No. 2,957,128 against Global Tissue's intent-to-use application for QUILTY in the present opposition proceeding.

52. The term "Quilted" is merely descriptive and without secondary meaning as applied to the goods identified in Reg. No. 2,957,128. The term "Quilted" lacks secondary meaning and immediately describes a quality, characteristic, or feature of the goods.

53. The term "Quilted" was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued, and on this basis Reg. No. 2,957,128 should be cancelled. Alternatively, Global Tissue alleges that the term "Quilted" is merely descriptive and without secondary meaning as applied to the goods at the time the issue is considered in the instant proceeding, and on this basis requests that Reg. No. 2,957,128 be cancelled.

54. In the alternative, Global Tissue requests that Reg. No. 2,957,128 be cancelled on the grounds that it has been abandoned due to non-use. The applied-for mark, as shown in the drawing of the mentioned registration, has never been used and/or functioned in commerce as a trademark. The specimen associated with this registration does not show the applied-for mark functioning as a trademark. In particular, the specimen shows the composite mark "Quilted Northern and design" appearing on a package of bath tissue. The word "Quilted" is positioned above the word "Northern", and both words are surrounded by a continuous border design. A single trademark designation symbol ® appears at the lower right corner of the composite mark. The appearance of the term "Quilted" within the composite mark shown in the specimen does not constitute usage of the applied-for mark as a trademark because the purchasing public

would not recognize the term “Quilted” in and of itself to be an indicator of source or origin for this particular product. The applied-for mark does not create a commercial impression separate and apart from the other material appearing in the composite mark shown in the specimen.

COUNT 3: US Reg. No. 3,170,713

55. Global Tissue repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

56. Georgia-Pacific is the owner of United States Trademark Registration No. 3,170,713 for ACOLCHINADO covering “bath tissue” in International Class 16. The term “Acolchinado” translates into English as “Quilted.” The registration was granted on November 14, 2006. As of the filing date of this Answer, the registration is less than five years old.

57. Georgia-Pacific has cited Registration No. 3,170,713 against Global Tissue’s intent-to-use application for QUILTY in the present opposition proceeding.

58. The term “Acolchinado” translates into English as “quilted” and as such is merely descriptive and without secondary meaning as applied to the goods identified in Reg. No. 3,170,713. The term “Acolchinado” lacks secondary meaning and immediately describes a quality, characteristic, or feature of the goods.

59. The term “Acolchinado” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued, and on this basis Reg. No. 3,170,713 should be cancelled. Alternatively, Global Tissue alleges that “Acolchinado” is merely descriptive and without secondary meaning as applied to the

goods as of the time the issue is considered in the instant proceeding, and on this basis requests that Reg. No. 3,170,713 be cancelled.

60. In the alternative, Global Tissue requests that Reg. No. 3,170,713 be cancelled on the grounds that it has been abandoned due to non-use. The applied-for mark, as shown in the drawing of the mentioned registration, has never been used and/or functioned in commerce as a trademark. The specimen associated with this registration does not show the applied-for mark functioning as a trademark. In particular, the specimen shows the phrase “El único papel higiénico Acolchonado™ – suave y absorbente.” appearing on a package of bath tissue. The appearance of the term “Acolchonado” within the recited phrase, despite such term appearing in stylized lettering and including the “TM” notation, does not constitute usage of the applied-for mark as a trademark because the purchasing public would not recognize the term “Acolchonado” in and of itself to be an indicator of source or origin for this particular product.

COUNT 4: US Reg. No. 2,933,048

61. Applicant repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

62. Georgia-Pacific is the owner of United States Trademark Registration No. 2,933,048 for QUILTED and design covering “bath tissue” in International Class 16. The registration was granted on March 15, 2005. As of the filing date of this Answer, the registration is less than five years old.

63. Georgia-Pacific has cited Registration No. 2,933,048 against Global Tissue’s intent-to-use application for QUILTY in the present opposition proceeding.

64. The term “Quilted” is merely descriptive and without secondary meaning as applied to the goods identified in Reg. No. 2,933,048. The term “Quilted” lacks secondary meaning and immediately describes a quality, characteristic, or feature of the goods.

65. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date of the registration issued, and on this basis Reg. No. 2,933,048 should be cancelled. Alternatively, Global Tissue alleges that the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding, and on this basis requests that Reg. No. 2,933,048 be cancelled.

66. In the alternative, Global Tissue requests that “Quilted” be required to be disclaimed in Reg. No. 2,933,048, and that the registration should be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Global Tissue requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

67. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

68. In the alternative, Global Tissue requests that Reg. No. 2,933,048 be cancelled on the grounds that it has been abandoned due to non-use. The applied-for mark, as shown in the drawing of the mentioned registration, has never been used and/or functioned in commerce as a trademark. The specimen associated with this registration does not show the applied-for mark functioning as a trademark. In particular, the specimen shows the composite mark “Quilted Northern and design” appearing on a package of bath tissue. The word “Quilted” is positioned above the word “Northern”, and both words are surrounded by a continuous border design. A single trademark designation symbol ® appears at the lower right corner of the composite mark. The appearance of the term “Quilted” within the composite mark shown in the specimen does not constitute usage of the applied-for mark as a trademark because the purchasing public would not recognize the term “Quilted” in and of itself to be an indicator of source or origin for this particular product. The applied-for mark does not create a commercial impression separate and apart from the other material appearing in the composite mark shown in the specimen. The applied-for mark includes a continuous border design which surrounds the word “Quilted”. The composite mark shown in the specimen does not include a continuous border around the word “Quilted”. Accordingly, the specimen does not show usage of the applied-for mark.

COUNT 5: US Reg. No. 3,069,376

69. Global Tissue repeats and alleges the allegations in Paragraphs 39 through 44 as if here set forth at length.

70. Georgia-Pacific is the owner of United States Trademark Registration No. 3,069,376 for PLUSH-QUILTS covering “bath tissue” in International Class 16. The registration was granted on March 14, 2006. As of the filing date of this Answer, the registration is less than five years old.

71. Georgia-Pacific has cited Registration No. 3,069,376 against Global Tissue’s intent-to-use application for QUILTY in the present opposition proceeding.

72. The term “Plush-Quilts” is merely descriptive and without secondary meaning as applied to the goods identified in Reg. No. 3,069,376. The terms “Plush-Quilts” lacks secondary meaning and immediately describes a quality, characteristic, or feature of the goods.

73. The term “Plush-Quilts” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued, and on this basis Reg. No. 3,069,376 should be cancelled. Alternatively, Global Tissue alleges that the term “Plush-Quilts” is merely descriptive and without secondary meaning as applied to the goods at the time the issue is considered in the instant proceeding, and on this basis requests that Reg. No. 3,069,376 be cancelled.

74. In the alternative, Global Tissue requests that “Quilts” be required to be disclaimed in Reg. No. 3,069,376, and that the registration should be cancelled unless such a disclaimer is entered. The term “Quilts” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration was issued or, alternatively, the term “Quilts” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilts” should be disclaimed in the registration. However, in the subject

registration, the term “Quilts” is not disclaimed. On this basis, Global Tissue requests that “Quilts” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

75. Opposer has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

76. In the alternative, Global Tissue requests that Reg. No. 3,069,376 be cancelled on the grounds that it has been abandoned due to non-use. The applied-for mark, as shown in the drawing of the mentioned registration, has never been used and/or functioned in commerce as a trademark. The specimen associated with this registration does not show the applied-for mark functioning as a trademark. In particular, the specimen shows the phrase “Made with unique Plush-Quilts™ so it’s ultra soft and ultra thick.” appearing on a package of bath tissue. The appearance of the term “Plush-Quilts” within the recited phrase, despite such term being capitalized and including the “TM” notation, does not constitute usage of the applied-for mark as a trademark because the purchasing public would not recognize the term “Plush-Quilts” in and of itself to be an indicator of source or origin for this particular product.

COUNT 6: U.S. REGISTRATION NO. 2,968,615

77. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

78. Georgia-Pacific is the owner of United States Trademark Registration No. 2,968,615 for QUILTED NORTHERN for “facial tissue” in International Class 16. The registration was granted on July 12, 2005. The registration does not include

a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

79. Georgia-Pacific has cited Registration No. 2,968,615 against Global Tissue’s intent-to-use application for QUILTY in the present opposition proceeding.

80. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 2,968,615, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

81. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 7: U.S. REGISTRATION NO. 3,463,900

82. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

83. Georgia-Pacific is the owner of United States Trademark Registration No. 3,463,900 for Q ULTRA QUILTED NORTHERN covering “bathroom tissue” in International Class 16. The registration was granted on July 8, 2008. The registration

does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

84. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 3,463,900, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

85. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 8: U.S. REGISTRATION NO. 3,463,899

86. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

87. Georgia-Pacific is the owner of United States Trademark Registration No. 3,463,899 for Q QUILTED NORTHERN covering “bathroom tissue” in International Class 16. The registration was granted on July 8, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

88. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,463,899, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

89. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 9: U.S. REGISTRATION NO. 3,018,501

90. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

91. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,018,501 for QUILTED NORTHERN PS covering “bath tissue” in International Class 16. The registration was granted on November 22, 2005. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

92. Georgia-Pacific has cited Registration No. 3,018,501 against Global Tissue’s intent-to-use application for QUILTY in the present opposition proceeding.

93. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 3,018,501, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

94. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 10: U.S. REGISTRATION NO. 3,293,547

95. Global Tissue repeats and realleges the allegations in Paragraphs 1 through 3 above as if here set forth at length.

96. Georgia-Pacific is the owner of United States Trademark Registration No. 3,293,547 for QUILTED NORTHERN PS covering “facial tissue” in International Class 16. The registration was granted on September 18, 2007. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

97. Georgia-Pacific has cited Registration No. 3,293,547 against Global Tissue’s intent-to-use application for QUILTY in the present opposition proceeding.

98. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 3,293,547, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

99. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 11: U.S. REGISTRATION NO. 3,463,460

100. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

101. Georgia-Pacific is the owner of United States Trademark Registration No. 3,463,460 for Q QUILTED NORTHERN covering “bathroom tissue” in International Class 16. The registration was granted on July 8, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

102. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,463,460, and that the registration be cancelled unless such a disclaimer

is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

103. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 12: U.S. REGISTRATION NO. 2,980,757

104. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

105. Georgia-Pacific is the owner of record of United States Trademark Registration No. 2,980,757 for THE ULTIMATE QUILTED CLEAN covering “bath tissue” in International Class 16. The registration was granted on August 2, 2005. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

106. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 2,980,757, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or,

alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

107. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 13: U.S. REGISTRATION NO. 3,642,378

108. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

109. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,642,378 for QUILTED NORTHERN SOFT & STRONG covering “bathroom tissue” in International Class 16. The registration was granted on June 23, 2009. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

110. Petitioner requests that “Quilted” be required to be disclaimed in Registration No. 3,642,378, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present

proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

111. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 14: U.S. REGISTRATION NO. 3,517,622

112. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

113. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,517,622 for QUILTED NORTHERN ULTRA PLUSH covering “bathroom tissue” in International Class 16. The registration was granted on October 14, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

114. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,517,622, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this

basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

115. Georgia-Pacific has disclaimed the word “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 15: U.S. REGISTRATION NO. 3,642,213

116. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

117. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,642,213 for Q QUILTED NORTHERN SOFT & STRONG covering “bathroom tissue” in International Class 16. The registration was granted on June 23, 2009. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

118. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,642,213, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

119. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

COUNT 16: U.S. REGISTRATION NO. 3,532,136

120. Global Tissue repeats and realleges the allegations in Paragraphs 39 through 44 above as if here set forth at length.

121. Georgia-Pacific is the owner of record of United States Trademark Registration No. 3,532,136 for Q ULTRA QUILTED NORTHERN OUR SOFTEST EVER covering “bathroom tissue” in International Class 16. The registration was granted on November 11, 2008. The registration does not include a disclaimer of the term “Quilted.” As of the filing date of this petition, the registration is less than five years old.

122. Global Tissue requests that “Quilted” be required to be disclaimed in Registration No. 3,532,136, and that the registration be cancelled unless such a disclaimer is entered. The term “Quilted” was merely descriptive and without secondary meaning as applied to the goods as of the date the registration issued or, alternatively, the term “Quilted” is merely descriptive and without secondary meaning as applied to the goods as of the time the issue is considered in the present proceeding. As such, the term “Quilted” should be disclaimed in the registration. However, in the subject registration, the term “Quilted” is not disclaimed. On this basis, Petitioner requests that “Quilted” be required to be disclaimed in the registration, and that the registration be cancelled unless such a disclaimer is entered.

123. Georgia-Pacific has disclaimed the term “Quilted” in its following registrations: 2,059,102; 2,209,027; 1,877,561; and 2,407,296.

WHEREFOR, Global Tissue believes that it is being damaged by the challenged registrations.

Global Tissue does not claim trademark rights in the term “Quilted,” “Quilting,” or “Quilts,” but rather seeks to protect its right, and the right of others, to use the term in a generic or descriptive manner in connection with the goods at issue. The above-listed registrations are inconsistent with Global Tissue’s free use of such terms and therefore damage Global Tissue.

Global Tissue requests that United States Trademark Registration Nos. 2,872,813; 2,957,128; 3,170,713; 2,933,048; and 3,069,376 be cancelled as set forth above under Section 14(3) of the Lanham Act, 15 U.S.C. §1064(3). Global Tissue further requests that United States Trademark Registration Nos. 2,957,128; 3,170,713; 2,933,048; and 3,069,376 be cancelled as set forth above under Section 2(e)(1) of the Lanham Act, 15 U.S.C. § 1052(e)(1). Finally, Petitioner requests that United States Trademark Registration Nos. 2,933,048; 3,069,376; 2,968,615; 3,463,900; 3,463,899; 3,018,501; 3,293,547; 3,463,460; 2,980,757; 3,642,378; 3,517,622; 3,642,213; and 3,532,136 be modified to include a disclaimer of “Quilted” or “Quilts” as set forth above, and that such registrations be cancelled unless such a disclaimer is entered. Lanham Act Sections 2(e)(1) and 6(a), 15 U.S.C. §§ 1052(e)(1) and 1056(a).

The filing fee for this cancellation, in the amount of \$4,800.00, is enclosed.

The Commissioner is hereby authorized to charge any additional fees to Deposit Account No. 08-2461.

Dated: April 23, 2010

Respectfully submitted,



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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this date, April 23, 2010, a copy of the foregoing FIRST AMENDED ANSWER AND COUNTERCLAIMS was served upon the Opposer, by email and first-class U.S. mail, to Opposer's current identified counsel, as set forth below:

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R. Glenn Schroeder