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

Proceeding	91185884
Party	Defendant Imagini Holdings Ltd
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Submission	Answer and Counterclaim
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Date	10/08/2008
Attachments	VISUALDNA.PDF (8 pages)(245094 bytes)

Registration Subject to Counterclaim

Registration No	3245349	Registration date	05/22/2007
Registrant	DATING DNA, LLC 13804 TORREY DEL MAR DR SAN DIEGO, CA 92130 UNITED STATES		

Goods/Services Subject to Counterclaim

Class 045. First Use: 2006/09/26 First Use In Commerce: 2006/09/26
All goods and services in the class are requested, namely: Dating and Matchmaking services

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

In the Matter of Application No. 77/258529

Dating DNA, LLC. Opposer, v. Imagini Holdings Ltd., Applicant.	ANSWER TO AMENDED NOTICE OF OPPOSITION AND COUNTERCLAIMS FOR CANCELLATION Opposition No. 91185884
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ANSWER TO AMENDED NOTICE OF OPPOSITION

Applicant, Imagini Holdings Ltd. (“Applicant”), for its Answer to the Amended Notice of Opposition (“Answer”) in the above-captioned matter responds to the Notice of Opposition as follows:

Opposer Dating DNA, LLC (“Opposer”) has not stated its claims in numbered paragraphs as required by Federal Rule of Civil Procedure 10(b) and TBMP § 309.03(a)(2). In order to accurately respond to the Notice of Opposition, Applicant has assigned each of the paragraphs a number as shown in Exhibit A to this Answer

1. Applicant denies the allegations of Paragraph 1.
2. The averments in Paragraph 2 assert Applicant’s legal conclusions to which no response is required.
3. Applicant admits that Opposer is listed as the last owner of record for the registration for DATING BY DNA at Registration Number 3245349 and is listed as the last owner of record for the filing for DATING DNA at Application Serial Number

77/091424 on the TARR system at the United States Trademark Office. Except as expressly admitted, Applicant denies the allegations of Paragraph 3.

4. Applicant admits that the services listed in its Application Serial No. 77/258, 529 are “Personal and social services rendered by others to meet the needs of individuals, namely, social networking services, social introduction and dating services; Internet based social networking services; visually profiling consumers for networking, social, and personal purposes; analyzing personality and personal profile information data for networking, social and personal purposes” and the services listed in the DATING DNA registration at Registration No. 3496500 are “Computer dating services; Dating services; Internet based social networking, introduction, and dating services; Marriage partner introduction or dating services; On-line identity reliability investigation in the field of on-line dating and claims made about age, gender; Reminder services in the area of upcoming important dates and events; Video dating services; Web site services featuring on-line dating club” according to the TARR system at the United States Trademark Office. Applicant is without sufficient information to form a belief as to the allegations regarding whether “registrant’s services are dating and matching [sic] making services” and, therefore, denies same. Applicant denies all remaining allegations in Paragraph 4.

5. Applicant is without sufficient information to form a belief as to the allegations set forth in Paragraph 5 and, therefore, denies same.

6. Applicant denies the allegations in Paragraph 6.

AFFIRMATIVE DEFENSES

1. Opposer's request for relief is barred in so far as Opposer relies on Registration Number 3245349 for DATING BY DNA since, upon information and belief, the underlying intent-to-use application for the mark was improperly assigned and the resulting registration is void.

2. Opposer's request for relief is barred in so far as Opposer relies on Registration Number 3245349 for DATING BY DNA on the grounds that, upon information and belief, Opposer has abandoned use of the DATING BY DNA trademark.

3. Opposer's request for relief is barred in so far as Opposer relies on Registration Number 3245349 for DATING BY DNA on the grounds that Opposer does not have valid rights in and is not the proper owner of said registration.

4. Opposer's request for relief is barred in so far as Opposer relies on Registration Number 3496500 for DATING DNA because, upon information and belief, Opposer does not have priority over Applicant with respect to that trademark.

5. Opposer's request for relief is barred because Opposer fails to state a claim upon which relief can be granted.

COUNTERCLAIMS FOR CANCELLATION

1. Applicant hereby presents counterclaims for cancellation of Registration No. 3245349 for DATING BY DNA registered to Dating DNA, LLC.

2. Upon information and belief, Opposer Dating DNA, LLC is a limited liability company with an address at 13804 Torrey Del Mar Drive, San Diego, California 92130.

3. Opposer is the listed registrant for Registration Number 3245349 for DATING BY DNA for “dating and matchmaking services.”

FIRST COUNTERCLAIM

4. Upon information and belief, the underlying application (Serial No. 78432066) that resulted in the subject DATING BY DNA registration was improperly assigned on August 20, 2006 when it was an intent to use application. Upon information and belief, the purported assignee was neither a successor to the then listed applicant nor to the portion of the business to which the mark pertained. Therefore, the registration should be cancelled.

SECOND COUNTERCLAIM

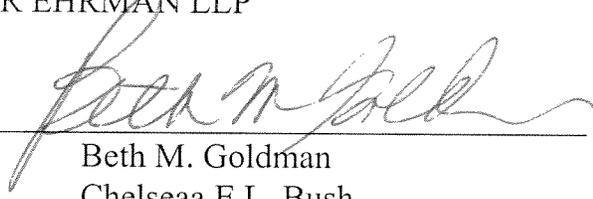
5. Upon information and belief, Opposer has replaced its DATING BY DNA mark with DATING DNA. Opposer has therefore abandoned DATING BY DNA with no intent to resume use. Therefore, the registration should be cancelled.

WHEREFORE, Applicant respectfully requests that (1) the subject opposition against its application for VISUALDNA be dismissed with prejudice, and (2) Opposer’s counterclaim for cancellation be sustained and Opposer’s DATING BY DNA registration be canceled.

Dated: October 8, 2008

HELLER EHRMAN LLP

By: _____

A handwritten signature in cursive script, appearing to read "Beth M. Goldman", written over a horizontal line.

Beth M. Goldman
Chelsea E.L. Bush

333 Bush Street
San Francisco, California 94104
(415) 772-6000
Attorneys for Applicant

EXHIBIT A

Likelihood of Confusion

- ① The applicant's mark, when used on or in connection with the identified services, so resembles the mark in U.S. Registration No. 3245349 and Application No. 77091424 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP section 1207. See the enclosed registration.
- ② The applicant's mark must be analyzed in two steps to determine whether there is a likelihood of confusion. First, you must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression (*VisualDNA v Dating By DNA/Dating DNA*). In re *E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, you must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. In re *August Storck KG*, 218 USPQ 823 (TTAB 1983); In re *International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).
- ③ The marks of the parties are highly similar. The applicant has applied to register the mark "VISUADNA." The registered mark is "DATING BY DNA" and the registrant's other pending mark is "DATING DNA." The dominant portion of each mark is the term DNA which is identical in sound, appearance, and meaning. As a result, the marks are confusingly similar.
- ④ The services of the applicant are highly related to the services of the registrant so as to cause a likelihood of confusion. The applicant's services are Personal and social services rendered by others to meet the needs of individuals, namely, social networking services, social introduction and dating services; Internet based social networking services; visually profiling consumers for networking, social, and personal purposes; analyzing personality and personal profile information data for networking, social and personal purposes. The registrant's services are dating and matching making services. Registrant's other pending "DATING DNA" mark's services are Computer dating services; Dating services; Internet based social networking, introduction, and dating services; Marriage partner introduction or dating services; On-line identity reliability investigation in the field of on-line dating and claims made about age, gender; Reminder services in the area of upcoming important dates and events; Video dating services; Web site services featuring on-line dating club.
- ⑤ The services are virtually identical since both include dating and matchmaking/Internet social networking services/social introduction services. These types of services are likely to be marketed in the same channels and encountered by the same consumers.
- ⑥ Since the marks of the parties are very similar and the services are essentially identical, registration must be refused on the Principal Register under section 2(d) of the Trademark Act.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing ANSWER TO AMENDED NOTICE OF OPPOSITION AND COUNTERCLAIMS FOR CANCELLATION upon Opposer by depositing one copy thereof in a sealed envelope in the United States mail, first-class, postage prepaid, on October 8, 2008, addressed as follows:

Chad Olson
Dating DNA, LLC
13804 Torrey Del Mar Dr
San Diego, CA 92130

Dated: October 8, 2008



Chelsea E.L. Bush