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

Proceeding	91186986
Party	Defendant SHAUN ROBERTS ALLEN
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Submission	Other Motions/Papers
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Date	03/10/2010
Attachments	Silver Fern Answers to Request for Admissions.pdf (7 pages)(92943 bytes)

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

In the Matter of Application Serial No. 77247611
Published in the Official Gazette of March 4, 2008

LOEST & McNAMEE, INC.	*	
Opposer	*	
v.	*	ANSWER TO OPPOSER'S REQUEST FOR ADMISSIONS
Shaun Roberts Allen	*	
Applicant	*	

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APPLICANT SHAUN ROBERTS ALLEN'S RESPONSES TO OPPOSER LOEST & McNAMEE, INC.'S REQUEST FOR ADMISSION OF FACTS

GENERAL OBJECTIONS AND RESERVATION OF RIGHTS

The following General Objections respond to all Requests for Admissions, regardless of whether specifically repeated in the individual Responses and Objections:

A. Mr. Allen generally objects to Loest & McNamee's *Requests* to the extent they purport to impose obligations and duties upon Mr. Allen beyond those set forth in the Federal Rules.

B. Mr. Allen generally objects to Loest & McNamee's *Requests* to the extent they purport to impose upon Mr. Allen a duty to admit or deny facts or allegations unknown to Mr. Allen or about which Mr. Allen has insufficient information and/or knowledge with which to form a belief as to their truth or falsity, and which information or knowledge is not likely to become known or available through reasonable investigation.

C. Mr. Allen reserves the right to supplement its Responses as additional information becomes available.

D. Mr. Allen reserves all rights and privileges to make and defend against any argument in law or equity, and these admissions and denials shall not impair or erode, or otherwise act to waive, such rights and privileges.

INDIVIDUAL RESPONSES AND OBJECTIONS

REQUEST NO. 1: Applicant filed application serial no. 77247611 to register the mark SILVER FERN for use on wines, spirits, liqueurs and alcoholic beverages other than beer.

RESPONSE: Admit.

REQUEST NO. 2: The word SILVER is often used on consumer goods such as alcoholic beverages to indicate quality.

OBJECTION: Plaintiff objects to this request on the basis that, standing alone, it does not request admission of a matter of fact relevant to this case. Regardless of whether the word SILVER is often used on consumer goods to indicate quality, the word SILVER in the relevant mark is not used to indicate quality of the alcoholic beverages. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 3: The term SILVER is laudatory.

OBJECTION/RESPONSE: Plaintiff objects to this request on the basis that, standing alone, it does not request admission of a matter of fact relevant to this case. Plaintiff further objects to this request to the extent that the term "laudatory" implies that Mr. Allen's mark uses SILVER in a laudatory fashion, as Mr. Allen denies and does not admit that the term SILVER is used in this way and believes it is used arbitrarily. Plaintiff further objects on the basis that the term SILVER is undefined, vague and therefore confuses the issue of its use in the mark. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 4: The word FERN is the dominant portion of applicant's mark.

RESPONSE: Deny. The word FERN is not the dominant portion of Mr. Allen's mark. The words SILVER and FERN in the mark are given equal weight and are to be used in conjunction with each other, not separated into individual terms. A silver fern is a species of tree fern endemic to New Zealand that has become one of the most widely recognized symbols of the country. It is often used as a logo for many organizations in New Zealand and permeates all aspects of the culture, from politics to sports. The terms in the mark should be read together as SILVER FERN to connote the symbol of New Zealand, and thus neither term in the mark dominates the other.

REQUEST NO. 5: The word FERN in the applied for mark is identical to Opposer's mark in registration no. 2906981.

RESPONSE: Admit, as to only the word FERN. The connotations of the marks are not identical – nor is the commercial impression, sound or meaning that is created when the words SILVER and FERN are joined as a mark comprised of the words. Thus, although Mr. Allen admits the matter of fact asserted in Request No. 5, material facts not included or referred to in Request No. 5 result in a materially misleading statement of fact. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 6: The goods wines listed in application no. 77247611 are identical to the goods in registration no. 2906981.

RESPONSE: Admit, except to state that the *category of goods* are identical, not the individual wines. Thus, although Mr. Allen admits the matter of fact asserted in Request No. 6, material facts not included or referred to in Request No. 6 result in a materially misleading

statement of fact. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 7: The goods sold under the applied for mark are sold through the same retail outlets as goods sold under Opposer's mark.

RESPONSE: Generally, this may be true, but it remains to be seen whether the goods will be sold through the same distributors in various states to the same retail outlets.

REQUEST NO. 8: Consumers who purchase wine also purchase spirits, liqueurs and other alcoholic beverages in class 33.

RESPONSE: Mr. Allen objects to this request on the basis that, standing alone, it does not request admission of a matter of fact relevant to this case. Further, there is no quantifiable evidence presented that indicates that consumers who purchase wine also purchase spirits, liqueurs and other alcoholic beverages in class 33. Mr. Allen denies any portion of this Request not expressly address and admitted herein.

REQUEST NO. 9: Consumers familiar with registrant's mark FERN are likely to believe that the mark SILVER FERN is a line extension of Opposer's brand and that Opposer is the source or origin of applicant's goods.

RESPONSE: Deny.

REQUEST NO. 10: Registration no. 2906981 issued on November 30, 2004.

RESPONSE: Admit.

REQUEST NO. 11: Registration no. 2906981 is valid and subsisting.

RESPONSE: Admit.

REQUEST NO. 12: Opposer's priority in its mark predates any priority which may be claimed by applicant in the mark SILVER FERN and in application no. 77247611.

RESPONSE: Admit that Opposer used FERN first, in the United States; the mark sought to be registered by Mr. Allen is SILVER FERN and this mark was used in New Zealand, Europe and Australia before Opposer's registration of FERN in the United States. Material facts not included or referred to in Request No. 12 result in a materially misleading statement of fact. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

REQUEST NO. 13: Registration no. 2906981 is *primae facae* evidence of Opposer's exclusive right to use the mark FERN on goods in international class 33.

RESPONSE: Admit, but that presumption is clearly rebuttable.

REQUEST NO. 14: New Zealand registration no. 707364 is the subject of a revocation action in the Intellectual Property Office of New Zealand.

RESPONSE: Admit, except to state that the registration no. 707364 is the subject of a revocation action for non-use in New Zealand. Mr. Allen nevertheless asserts that the mark is in use and is valid and subsisting in New Zealand, and he has filed a counterstatement and evidence in support of use. Material facts not included or referred to in Request No. 14 result in a materially misleading statement of fact. Mr. Allen denies any portion of this Request not expressly addressed and admitted herein.

Date: March 10, 2010

Respectfully submitted,

/James B. Astrachan/

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CERTIFICATE OF SERVICE

I hereby further certify that, on this 10th day of March, 2010, a copy of the Answer to Opposer's Request for Admissions and this Certificate of Service were served upon Opposer's counsel, by first-class, United States mail, postage pre-paid and electronic delivery upon:

Paulette R. Carey
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Date: March 10, 2010

Respectfully submitted,

/James B. Astrachan/

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