

ESTTA Tracking number: **ESTTA263707**

Filing date: **01/30/2009**

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

| | |
|------------------------|---|
| Proceeding | 91188162 |
| Party | Defendant Yupoong, Inc. |
| Correspondence Address | David M. Pitcher and Alexander H. Butter Staas & Halsey LLP 1201 New York Avenue NW - Floor 7 Washington, DC 20005-3917 UNITED STATES |
| Submission | Answer |
| Filer's Name | Alexander H. Butterman |
| Filer's e-mail | pitcher@s-n-h.com,abuterman@s-n-h.com,rhussain@s-n-h.com,docketing@s-n-h.com |
| Signature | /Alex Butterman/ |
| Date | 01/30/2009 |
| Attachments | Applicant's Answer to Opposition.pdf (4 pages)(231047 bytes) |

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

In the matter of
Trademark Application Serial No.: 77/290884
Filed: September 27, 2007
Published on: September 2, 2008
For the Mark: PRO-FORMANCE (Standard Character)

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|-------------------------|---|--------------------------|
| FAIRWAY & GREENE, LTD., |) | |
| |) | |
| v. |) | Opposition No.: 91188162 |
| |) | |
| YUPOONG, INC., |) | |
| |) | |
| Applicant. |) | |

Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451
BOX TTAB NO FEE

APPLICANT'S ANSWER TO OPPOSITION

Applicant, Yupoong, Inc., by its attorneys, hereby answers the allegations set forth in the Notice of Opposition as follows, with each Answer applying equally and separately to both Applicant's Class 24 and Class 25 goods identified in the application:

As and for specific Answer to the specific allegations in the unnumbered, introductory paragraph of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations and information insofar as it relates to the Opposer's name, entity type and location and, therefore, denies said allegations. Applicant denies that Opposer has been or will be damaged by Application Serial No. 77/290884 for the PRO-FORMANCE (standard character) mark ("the Mark"). Applicant admits only the specific application data cited by Opposer that is of record in the U.S. Patent and Trademark Office for the application opposed herein, such as the application Serial Number, filing date, publication date and opposition deadline date.

As and for Applicant's specific Answer to the specific numbered paragraphs of the Notice of Opposition, Applicant respectfully answers as follows:

1. Applicant admits the allegations set forth in Paragraph 1 of the Notice of Opposition only to the extent that it accurately reflects the records of the U.S. Patent and Trademark Office, and otherwise denies said allegations.
2. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 2 and, therefore, denies said allegations.
3. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in Paragraph 3 and, therefore, denies said allegations.
4. Applicant denies the allegations set forth in Paragraph 4 of the Notice of Opposition.
5. Applicant denies the allegations set forth in Paragraph 5 of the Notice of Opposition.
6. Applicant denies the allegations set forth in Paragraph 6 of the Notice of Opposition, particularly with respect to Opposer's claim of prior rights, except insofar as the specific application data cited therein accurately reflects the records of the U.S. Patent and Trademark Office.
7. Applicant denies the allegations set forth in Paragraph 7 of the Notice of Opposition.

AFFIRMATIVE DEFENSES

Each of the following Affirmative Defenses apply equally and separately to both Applicant's Class 24 and Class 25 goods identified in the application.

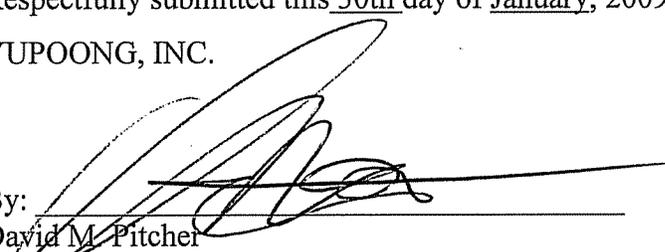
1. The Notice of Opposition and each count thereof fail to state a claim upon which relief can be granted.
2. Opposer lacks standing to oppose registration in that, upon information and belief, Opposer does not have rights, superior or otherwise, sufficient to support a claim of likelihood of confusion.
3. Opposer lacks standing to oppose registration in that it is not likely to be damaged or injured by Applicant's use and registration of the Mark.
4. Opposer is estopped to assert the claims made in the Notice of Opposition based upon deference to the examining attorney's determination of no likelihood of confusion between the Mark and Opposer's alleged marks by

failing to refuse registration of the Mark because of any registration of Opposer.

5. No likelihood of confusion, mistake or deception exists between the Mark and Opposer's alleged marks since the parties' respective actual and intended uses of their marks are decidedly different and distinguishable in sight, sound, meaning and commercial impression.
6. No likelihood of confusion, mistake or deception exists between the Mark and Opposer's alleged marks because the PERFORMANCE term or formative and terms or formatives with the "-FORMANCE" suffix are diluted, weak and not sufficiently distinctive on the relevant goods to distinguish Opposer's marks and permit Opposer to claim exclusive rights or fame in said marks.
7. If it is determined that the Opposer's marks and the Mark of the Applicant are confusingly similar for any Class of goods, Applicant contends that it has prior rights in the Mark.

WHEREFORE, having made full Answer to the Notice of Opposition, Applicant requests that the Notice of Opposition be denied, that this action be dismissed with prejudice, that Application Serial No. 77/290884 be allowed to register on the Principal Register in the records of the U.S. Patent and Trademark Office; and that Applicant be granted such other relief as the Board deems just and equitable under the circumstances.

Respectfully submitted this 30th day of January, 2009,
YUPOONG, INC.

By: 
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER to Notice of Opposition has been served on K. Bradford Adolphson, counsel for Opposer, by mailing said copy on this 30th day of January, 2009, via First Class Mail, postage prepaid to:

Ware, Fressola, Van der Sluys & Adolphson
755 Main Street, P.O. Box 224
Monroe, Connecticut 06468
Tel. (203) 261-1234

and/or e-mailing said copy to E-mail: kba@wfva.net



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