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

Proceeding	91190161
Party	Defendant Frank Tavakoli
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of

Trademark Application Serial No.: 77/554,386
For the mark SHI
Published in the Official Gazette on April 14, 2009

Farouk Systems, Inc..		§	
		§	
	Opposer	§	Opposition No. 91190161
		§	
v.		§	
		§	
Frank Tavakoli		§	
		§	
	Applicant	§	

Trademark Trial and Appeal Board
US Patent and Trademark Office
PO Box 1451
Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION

In response to the Notice of Opposition against this application, Answer being due on June 21, 2009, the Applicant, Frank Tavakoli, pleads and avers as follows, wherein paragraph numbers herein correspond to paragraph numbers in the Notice of Opposition:

1. Applicant admits the first sentence of paragraph 1. Applicant lacks information or knowledge sufficient to form a belief as to the truth of the second sentence of paragraph 1.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 2, and based thereon denies each and every such averment.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 3, and based thereon denies each and every such averment.

4. Applicant admits that U.S. Registration Nos. 3,426,769, 2,660,257, 3,107,769, 3,527,483 and 3,054,490 for the mark CHI, 3,387,588 for the mark CHI NANO, and 3,341,114 and 3,331,008 for the mark ULTRA CHI appear to be owned by Opposer, according to the records of the United States Patent and Trademark Office. Application admits that these registrations list goods in International Classes 3, 8, 9, 11 and 16. Applicant further admits that U.S. Registration No. 3,107,769 lists "electric hand-held dryers" in international class 11 in the description of goods and services. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments of actual ownership set forth in paragraph 4, and accordingly denies such averments.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 5, and accordingly denies the same.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 6, and accordingly denies the same.

7. Denied.

8. Admitted.

9. Applicant admits that it filed the opposed application without prior discussions with any third parties, including Opposer, as the Applicant was not under a duty to obtain the Opposer's authorization or consent because Applicant's SHI mark is not confusingly similar to any of Opposer's marks referenced in paragraph 4 above.

10. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 10, and accordingly denies the same.

11. Denied. There is no likelihood of confusion, mistake, or deception between Applicant's SHI mark and any of Opposer's marks referenced in paragraph 4, because, *inter alia,* Applicant's SHI mark is not similar in sight, sound or meaning to any of Opposer's marks listed in paragraph 4.

A) The letter "S" in "SHI" clearly can not be confused with the letter "C" in "CHI". The last two letters in the CHI mark is merely an acronym for "Hair Iron" and are not distinctive, whereas applicant's SHI mark is a truncation of its affiliate's long used trademark SHIVA and benefits from goodwill built up in the SHIVA mark.

B) "CHI" has an accepted English pronunciation as KIE or KEE, although in Opposer's usage it is typically pronounced CHEE. SHI has no English accepted English dictionary meaning nor pronunciation and would appear to be pronounced SHY or SHE, or, as initials, "S" "H" "I". There is no possible pronunciation of these marks that would be so similar as to be likely to cause confusion, mistake, or deception in the minds of consumers.

C) The word CHI has an accepted English dictionary meaning (a letter in the Greek alphabet) whereas the mark SHI has no accepted English meaning, other than that which has been developed by applicant. There are no possible meanings of the marks CHI and SHI that would be likely to give rise to confusion, mistake, or deception in the minds of consumers.

D) Applicant's mark SHI has achieved secondary meaning with respect to applicant's goods.

12. Denied.

13. Denied.

AFFIRMATIVE DEFENSES

14. Opposer has failed to state a claim for which relief can be granted. (F.R.C.P. 12(b)(6). There is no likelihood of confusion, mistake or deception because, *inter alia,* Applicant's SHI mark is not similar in sight, sound, or meaning, to any of Opposer's marks referenced in paragraph 4, for reasons as stated in paragraph 11 above..

15. Opposer's opposition to the registration of SHI and other marks is an attempt to impermissibly expand the scope of its CHI mark. Opposer should not prevail under the doctrine of unclean hands.

16. Opposer is estopped from challenging Applicant due to failure of Opposer to previously challenge use of the mark SHIVA.

17. The term "CHI" is weak and diluted, and is entitled to a very narrow scope of protection.

18. The term "CHI" has become generic for a type of hair iron, and cancellation of the mark on grounds of genericness is requested.

19. Opposer has committed fraud on the US Patent and Trademark Office in listing goods in its applications/registrations that Opposer had not actually sold in commerce.

RELIEF REQUESTED

Applicant asks that this opposition proceeding be dismissed with prejudice and that its application issue forthwith.

Applicant asks the CHI registration be canceled to the extent that the mark has become generic for goods sold under the mark.

Respectfully submitted,

12 June 2009

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CERTIFICATE OF SERVICE

I hereby certify that on 12 June 2009 a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was forwarded by first class mail, postage prepaid, to

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