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

Proceeding	91194292
Party	Defendant Schaffner, Katherine, Horton, Gladys
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Submission	Answer
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Date	05/05/2010
Attachments	THE MARVELETTES Answer.pdf (4 pages)(27406 bytes)

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

In the Matter of Application Serial No. 77/550,496

Published in the Official Gazette on February 9, 2010

Mark: THE MARVELETTES

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LARRY MARSHAK : Opposition No. 91194292

Opposer :

-against- :

KATHERINE SCHAFFNER :

GLADYS HORTON :

Applicants :

-----X

Box TTAB- NO FEE

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicants, Katherine Schaffner and Gladys Horton, for their answer to the Notice of Opposition filed by Larry Marshak, against application for registration of Applicants' trademark THE MARVELETTES, Serial No. 77/550,496, published in the Official Gazette on February 9, 2010, pleads and answers as follows:

1. Answering Paragraph 1 of the Notice of Opposition, Applicants do not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly deny the allegations thereof.
2. Answering Paragraph 2 of the Notice of Opposition, Applicants deny the allegations contained therein.
3. Answering Paragraph 3 of the Notice of Opposition, Applicants admit to the allegations thereof.
4. Answering Paragraph 4 of the Notice of Opposition, Applicants do not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly deny the allegations thereof.
5. Answering Paragraph 5 of the Notice of Opposition, Applicants do not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly deny the allegations thereof.

6. Answering Paragraph 6 of the Notice of Opposition, Applicants do not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly deny the allegations thereof.

7. Answering Paragraph 7 of the Notice of Opposition, Applicants do not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly deny the allegations thereof.

8. Answering Paragraph 8 of the Notice of Opposition, Applicants deny the allegations contained therein.

9. Answering Paragraph 9 of the Notice of Opposition, Applicants do not have sufficient knowledge or information to form a belief as to the allegations contained therein and accordingly deny the allegations thereof.

10. Answering Paragraph 10 of the Notice of Opposition, Applicants admit to the allegations thereof.

AFFIRMATIVE DEFENSES

11. Applicants' first use of the subject mark predates Opposer's claim of first use and Applicants' continued goodwill in the subject mark renders Applicants' rights superior to those claimed by Opposer. See *Kingsmen v. K-Tel Int'l, Ltd.*, 557 F. Supp. 178 (S.D.N.Y. 1983); *Turner v. HMH Publishing Co., Inc.*, 380 F.2d 224, 228-29 (5th Cir. 1967); *Pepsico, Inc. v. Grapette Co.*, 416 F.2d 285, 289 (8th Cir. 1969); see also 1 J. McCarthy, *Trademark and Unfair Competition*, § 18.1, p. 794 (2d ed. 1984); ***Marshak v. Green*, 746 F.2d 927, 929-930 (2nd Cir. 1984)**.

12. Opposer's claim of rights via assignment from Motown Records and the Motown Management companies as stated in its Paragraph 2 of the Notice of Opposition is baseless, as no goodwill associated with the subject mark was ever validly transferred to those parties or Opposer, and is thus without force and effect. See *Hy-Cross Hatchery, Inc. v. Osborne*, 303 F.2d 947 (C.C.P.A. 1962); *Defiance Button Machine Co. v. C.&C. Metal Products Corp.*, 759 F.2d 1053 (2nd Cir. 1985); ***Marshak v. Green*, 746 F.2d 927 (2nd Cir. 1984)**; *J. Atkins Holdings Ltd. v. English Discounts, Inc.*, 14 U.S.P.Q.2d 1301 (S.D.N.Y. 1990).

13. Opposer's claim of rights via assignment from Applicant Gladys Horton as stated in its Paragraph 4 of the Notice of Opposition is baseless, as such assignment was obtained through fraudulent means, did not validly transfer the goodwill associated with the subject mark, and the purported assignor did not have sufficient ownership rights in and of herself to grant such rights to Opposer, and is thus without force and effect.

14. Opposer's use and attempted use of the subject mark is in violation of the Truth in Music Act, enacted in over 30 U.S. states, and is thus unlawful and fails to rise to the level of bona fide trademark use for purposes of claiming rights therein. Accordingly, Opposer has no, nor ever had, substantive and enforceable common law rights in the subject mark.

In view of the foregoing, Applicants contend that this Opposition is groundless and baseless in that Opposer has not shown wherein it will be, or is likely to be, damaged by the registration of or has a rightful claim to Applicants' trademark.

Dated: New York, New York
May 5, 2010

Respectfully submitted,

REED SMITH LLP

By 

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Certificate of Service

I hereby certify that a copy of the foregoing Applicant's Answer to Notice of Opposition was mailed first-class mail postage prepaid to Larry Marshak, 69-41 261st Street, Floral Park, New York 11004 this 5th day of May 2010.



Ibis M. Vega
Assistant to Attorney for Applicants