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

Proceeding	91195018
Party	Defendant Arnold P. Nerenberg
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 77/538,225
Published in the *Official Gazette* on January 26, 2010

BANANA REPUBLIC (APPAREL), LLC,)	
)	
Opposer,)	
)	Opposition No. 91195018
-against-)	
)	
ARNOLD P. NERENBERG,)	
)	
Applicant.)	
)	

ANSWER TO NOTICE OF OPPOSITION

Applicant Arnold P. Nerenberg (hereinafter “Applicant”), through its undersigned counsel, responds to the grounds set out in the Notice of Opposition filed by Opposer Banana Republic (Apparel), LLC (hereinafter “Opposer”) on May 24, 2010 as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 1 of the Notice of Opposition and therefore denies the same.

2. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in paragraph 2 of the Notice of Opposition and therefore denies the same.

3. Applicant admits the allegations in paragraph 3 of the Notice of Opposition that “Opposer owns numerous U.S. trademark registrations for the BR mark in connection with such goods and services, including but not limited to U.S. Reg. No. 3,248,232 for” the BR mark “for ‘Clothing, namely t-shirts, shirts, blouses, sweaters, vests, pants, jeans, shorts, dresses, skirts, jackets, blazers, suits, coats, sleepwear, swimwear, loungewear, jogging suits, sweatshirts, socks, underwear, lingerie, athletic pants, tops, belts, scarves, ties, gloves; footwear; headwear’ in International Class 25, registered on May 29, 2007 based on first use on August 18, 2005; and “U.S. Reg. No. 3,776,293” for the BR mark “for ‘Jewelry, namely, rings, bracelets, necklaces, earrings and cuff-links’ in International Class 14, filed under section 1(b) of the Lanham Act, 15 U.S.C. § 1052(b) on November 18, 2004, and registered on April 13, 2010 based on first use on August 6, 2008.” Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations set forth in paragraph 3 of the Notice of Opposition and therefore denies the same.

4. Applicant admits the allegation in paragraph 4 of the Notice of Opposition that “Opposer is also the owner of a pending application, Application Serial No. 77/718,976” for the BR mark “for ‘Bottoms; Footwear; Headwear; Outer jackets; Tops’ in International Class 25 based on first use on August 18, 2005.” Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations set forth in paragraph 4 of the Notice of Opposition and therefore denies the same.

5. Applicant admits the allegations in paragraph 5 of the Notice of Opposition.

6. Applicant admits that on August 4, 2008, Applicant filed Application Serial No. 77/538,225 to register the Applicant’s mark based on a bona fide intent to use under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b). Applicant denies the remaining allegations in

paragraph 6 of the Notice of Opposition. Applicant denies that the description was specifically “Jewelry, namely, tie tacks, necklaces, tiepins, pins, bracelets” in International Class 14; and “Clothing, namely, t-shirts, hats, shorts, jackets, pants and shorts” in International Class 25. Applicant maintains that the description was “Clothing, namely, t-shirts, hats, shorts; jewelry, namely, tacks, tiepins, pins, bracelets; belt buckles; books; DVDs and CDs; restaurant services; and cruise services”.

7. Applicant admits the allegations in paragraph 7 of the Notice of Opposition.

8. Applicant denies the allegations in paragraph 8 of the Notice of Opposition.

9. Applicant admits the allegations in paragraph 9 of the Notice of Opposition that the filing date of Applicant’s application is August 4, 2008. Applicant denies the allegations in paragraph 9 of the Notice of Opposition that “[t]he registration of Applicant’s Mark is inconsistent with Opposer’s prior rights and statutory grant of exclusivity of use.” Applicant denies that “[t]he filing date of the Applicant’s application, August 4, 2008, which is the earliest date upon which Applicant can rely, is years after the use, registration and acquisition of rights in Opposer’s Marks by Opposer or its predecessors in interest.” Opposer defines Opposer’s Marks in paragraph 4 of the Notice of Opposition to include pending Application Serial No. 77/718,976 which is not registered. U.S. Registration No. 3,776,293 registered on April 13, 2010.

Therefore, the Opposer’s allegation that “[t]he filing date of Applicant’s application, August 4, 2008, which is the earliest date upon which Applicant can rely, is years after the use, registration and acquisition of rights in Opposer’s Marks by Opposer or its predecessors in interest” is clearly false. Applicant admits only that the filing date of Applicant’s application is after the date of registration for U.S. Registration No. 3,248,232. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations set forth in

paragraph 9 of the Notice of Opposition and therefore denies the same.

10. Applicant admits that Applicant seeks to use its Mark in connection with jewelry in International Class 14 and clothing in International Class 25. Applicant denies the remaining allegations in paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations in paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations in paragraph 12 of the Notice of Opposition.

13. As to any remaining allegations in paragraphs 1 through 12 of the Notice of Opposition that Applicant has not specifically denied, Applicant denies such remaining allegations.

AFFIRMATIVE DEFENSES

14. Applicant will rely on any and all defenses, which may be developed through discovery and/or the testimony periods in this opposition.

WHEREFOR, Applicant prays that the Trademark Trial and Appeal Board denies this opposition against the registration of U.S. Trademark Application Serial No. 77/538,225.

Dated: June 30, 2010

Respectfully submitted,

SCHMEISER, OLSEN & WATTS, LLP

/Arlen L. Olsen/

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