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

Proceeding	91197089
Party	Defendant A. Stein Meat Products, Inc.
Correspondence Address	ROBERT T MALDONADO COOPER & DUNHAM LLP 30 ROCKEFELLER PLAZA NEW YORK, NY 10112-0015 UNITED STATES Rmaldonado@cooperdunham.com
Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	01/24/2011
Attachments	Cross Motion to Amend Answer and Counterclaims.pdf ( 20 pages )(148832 bytes )

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

In re Application Serial No. 77/750,645  
Filed: June 3, 2009  
For Mark: BROOKLYN BURGER (Stylized)  
Published in the Official Gazette: April 27, 2010

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LOS ANGELES DODGERS, LLC,	:	
	:	
Opposer,	:	Opposition No. 91197089
	:	Serial No. 77750645
v.	:	
	:	
A. STEIN MEAT PRODUCTS, INC.,	:	
	:	
Applicant.	:	
-----X		

**APPLICANT’S CROSS-MOTION FOR LEAVE TO FILE FIRST AMENDED ANSWER  
AND COUNTERCLAIMS AND OPPOSITION TO OPPOSER’S MOTIONS TO  
DISMISS**

Applicant submits this memorandum of law in support of its cross-motion for leave to file a first amended answer and counterclaims, pursuant to Fed.R.Civ.P. 15(a), and in opposition to Opposer’s motion to dismiss. The proposed amended complaint (annexed hereto as Exhibit A) seeks to amplify the factual allegations which support the counterclaims originally filed by Applicant, and, as such, cannot be considered prejudicial. *United States Olympic Committee v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221, 1223 (TTAB 1993). By this amendment, Applicant seeks to delete certain affirmative defenses which are duplicative of previously asserted counterclaims for cancellation of Opposer’s asserted trademark registrations, to add an additional affirmative

defense of unclean hands,<sup>1</sup> and to add factual allegations to support Applicant's previously-asserted counterclaims for cancellation of Opposer's asserted trademark registrations on the grounds of geographical deceptiveness. Considering the early stage of this proceeding (the discovery period has not opened), and the lack of delay or prejudice to Opposer, and in light of the requirement that leave to amend be given freely, Applicant's motion should be granted.

The present motion to amend Applicant's first amended answer and counterclaims moots Opposer's motion to dismiss. As such, Opposer's motion to dismiss should be denied as moot, and the suspension of proceedings should be lifted.

### **PROCEDURAL HISTORY**

This is an opposition proceeding commenced by Opposer Los Angeles Dodgers, LLC, concerning Applicant's application to register the mark BROOKLYN BURGER and Design for hamburger patties. By its opposition, Opposer the Los Angeles Dodgers, LLC claims exclusive rights to the geographic designation BROOKLYN, even though the Los Angeles Dodgers left Brooklyn in 1957, and retain no presence in Brooklyn.

On October 25, 2010, after six months of extensions of time, Opposer the Los Angeles Dodgers, LLC filed a Notice of Opposition, asserting five trademark registrations, which each include the word BROOKLYN. None of Opposer's asserted registrations includes the word BURGER, or includes any food products or products related to food in its respective identification of goods. Upon the filing of the Notice of Opposition, Opposer sought Applicant's

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<sup>1</sup> Unclean hands is a proper defense where Opposer has sold goods bearing a deceptive geographic mark, and seeks to prevent others from using that geographic mark, i.e. BROOKLYN. *Havana Club Holding, S.A. v. Galleon*, 49 U.S.P.Q.2d 1296 (S.D.N.Y. 1998).

consent to suspend the proceedings so that Opposer could decide its strategy, but Applicant was not agreeable to further delays.

On December 2, 2010, Applicant filed its answer to the Notice of Opposition, and also filed several counterclaims seeking cancellation of Opposer's asserted registrations on various grounds, including, *inter alia*, abandonment and geographic deceptiveness under Section 2(a). On December 8, 2010, the Board issued an Order resetting the discovery schedule for this proceeding, according to which the discovery period was scheduled to open on February 4, 2011.

On January 5, 2011, Opposer filed a motion to dismiss Applicant's first, second, third, fifth, sixth, seventh and eighth counterclaims, to strike Applicant's affirmative defenses stated in paragraphs 13 through 17, and to suspend proceedings. Opposer's motion to dismiss the counterclaims is based entirely upon Opposer's assertion that Applicant failed to allege the factual basis for the counterclaims, even though the factual bases are well-known to Opposer. Opposer's motion to strike the affirmative defenses set forth in paragraphs 13, 14 and 15 of the Answer (geographical deceptiveness and abandonment) is based upon the ground that the affirmative defenses are redundant of the counterclaims. Opposer's motion to strike the affirmative defense set forth in paragraph 16 of the Answer (that Opposer's mark is entitled to a narrow scope of protection) is based on the fact that the affirmative defense cites a prior decision of the United States District Court for the Southern District of New York which was vacated by settlement of the parties. Finally, Opposer's motion to strike the affirmative defense set forth in paragraph 17 of the Answer (laches, acquiescence and estoppel) is based upon the period of time for measuring laches and acquiescence.

Although Opposer claims that Applicant's Answer and Counterclaims do not provide fair notice of the claims asserted against it, Opposer cannot reasonably assert that it does not know

the nature and basis for the counterclaims. In its motion, Opposer does not allege that its products originate from Brooklyn, thereby admitting that its marks are geographically deceptive. Rather, Opposer seeks to connect its goods to a nostalgic reference to a currently non-existent Brooklyn baseball club, even though use of BROOKLYN DODGERS, BROOKLYN ROBINS or any of Opposer's other marks to refer to goods or services located in or originating from Brooklyn, was abandoned decades ago.

On January 10, 2011, the Board issued an Order suspending these proceedings pending the disposition of Opposer's motion to dismiss pursuant to 37 CFR § 2.127(d).<sup>2</sup>

## ARGUMENT

### A. THE COURT SHOULD PERMIT THE FILING OF AN AMENDED ANSWER AND COUNTERCLAIMS

Rule 15(a) of the Federal Rules of Civil Procedure provides that leave to amend "shall be freely given when justice so requires." *Foman v. Davis*, 371 U.S. 178, 182 (1962) ("this mandate is to be heeded"). This rule applies to opposition and cancellation proceedings. 37 CFR §§ 2.107 and 2.115. "[A]s a general matter, amendments are favored 'to facilitate a proper decision on the merits.'" *EK Success, Ltd. v. Uchida of America, Corp.*, 2004 WL 1837357 (S.D.N.Y. 2004) (citation omitted). Indeed, "the Board ... has recognized that 'amendments to pleadings should be allowed with great liberality at any stage of the proceeding where necessary to bring about a furtherance of justice unless it is shown that entry of the amendment would violate settled law or be prejudicial to the rights of any opposing parties.'" *Commodore Electronics Ltd.*

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<sup>2</sup> The motion to dismiss was filed by Opposer as a procedural tactic to further delay these proceedings, and to obtain the suspension which Opposer previously had sought, but to which Applicant would not consent.

*v. CBM Kabushiki Kaisha*, 26 U.S.P.Q.2d 1503, 1505 (TTAB 1993). Applicant submits that there are no reasons to deny Applicant leave to amend in this case.

These proceedings are suspended, and the Board has stated that it will give no consideration to any paper filed during the pendency of the motion to dismiss which is not relevant to the motion to dismiss. Since the present motion to amend directly responds to the alleged pleading deficiencies raised in Opposer's motion to dismiss, the present motion is germane to the motion to dismiss, and should be considered. *See United States Olympic Committee v. O-M Bread Inc.*, 26 U.S.P.Q.2d 1221, 1223 (TTAB 1993).

Opposer cannot argue that the proposed amendment would violate settled law. Indeed, in its motion to dismiss, Opposer argued that the counterclaims should be dismissed because they did not contain certain factual allegations. Applicant's proposed amendment adds factual allegations which Opposer asserts were not previously pled by Applicant. Thus, as implicitly admitted by Opposer, Applicant's counterclaims, as amended, state claims for relief under the law. *See, e.g., In re Bacardi & Co. Ltd.*, 48 U.S.P.Q.2d 1031, 1035 (TTAB 1997) (registration of HAVANA marks refused on grounds of geographic deceptiveness where Applicant used geographic term to refer to its historic, nostalgic roots in Havana, Cuba, but Applicant left Havana in 1960). Further, Applicant has not amended to assert any new counterclaims. There is no violation of law.

Opposer also cannot argue that it will suffer prejudice if the amendment is allowed. Courts typically find prejudice when the amendment: (i) requires the opponent to expend significant additional resources to conduct discovery and prepare for trial; (ii) significantly delays the resolution of the dispute; or (iii) prevents the plaintiff from bringing a timely action in another jurisdiction. *Banco Central Del Paraguay v. Paraguay Humanitarian Foundation, Inc.*,

2003 WL 21543543 (S.D.N.Y. 2003) quoting *Block v. First Blood Assocs.*, 988 F.2d 344, 350 (2d Cir. 1993). None of these factors are present here. Indeed, no discovery has been taken yet. Since the amendments seek to amplify the factual allegations of the counterclaims as originally filed, and since the discovery period has not opened, Opposer cannot argue that it will suffer any prejudice if the amendment is allowed. *Avedis Zildjian Co. v. D. H. Baldwin Co.*, 180 U.S.P.Q. 539, 541 (TTAB 1973); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 U.S.P.Q.2d 1316, 1318 (TTAB 1992); *Flatley v. Trump*, 11 U.S.P.Q.2d 1284, 1286 (TTAB 1989) (leave to amend should not be denied because respondent does not believe that petitioner can prove the allegations sought to be added); *Buffett v. Chi Chi's, Inc.*, 226 U.S.P.Q. 428, 431 (TTAB 1985); *Mack Trucks, Inc. v. Monroe Auto Equipment Co.*, 182 U.S.P.Q. 511 (TTAB 1974).

Based on the foregoing, Applicant's motion to amend should be granted.

**B. OPPOSER'S MOTION TO DISMISS THE COUNTERCLAIMS AND TO STRIKE THE AFFIRMATIVE DEFENSES SET FORTH IN PARAGRAPHS 13 THROUGH 15 AND 17 SHOULD BE DENIED AS MOOT**

Opposer has moved to dismiss Applicant's First, Second, Third, Fifth, Sixth, Seventh and Eighth Counterclaims on the basis that Applicant has not alleged a factual basis for the counterclaims. By its proposed amendment, Applicant has added the factual allegations which Opposer claimed were missing. Therefore, Opposer's motion to dismiss the counterclaims is mooted by the amendment, and should be denied.

In addition, Opposer has moved to strike Applicant's affirmative defenses as set forth in paragraphs 13 through 15 as redundant, and in paragraph 17 as insufficient. By its proposed

amendment, Applicant has deleted those affirmative defenses. Therefore, Opposer's motion to strike those affirmative defenses should be denied as moot.

**C. OPPOSER'S MOTION TO STRIKE THE AFFIRMATIVE DEFENSE SET FORTH IN PARAGRAPH 16 SHOULD BE DENIED BECAUSE THE DEFENSE IS ADEQUATELY STATED**

Opposer has moved to strike Applicant's affirmative defense as set forth in paragraph 16 of Applicant's Answer and Counterclaims, which reads as follows:

16. Opposer's marks which are the subject of U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 are entitled only to a narrow scope of protection. *See Major League Baseball v. Sed Non Olet Denarius*, 817 F. Supp. 1103, 1133 (S.D.N.Y. 1993), *vacated pursuant to settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994).

The basis for Opposer's motion is that the cited decision, *Sed Non Olet*, 817 F. Supp. 1103, was vacated pursuant to settlement, and, thus, allegedly has no precedential effect. However, *Sed Non Olet* was vacated by stipulation of the parties, not upon review by a higher court. Thus, other courts (cited below) have cited *Sed Non Olet* as persuasive for the very issues raised by Applicant's affirmative defense here. Applicant has cited a decision of the United States District Court for the Southern District of New York as setting forth the rationale for Applicant's affirmative defense that Opposer's marks are entitled to a narrow scope of protection. In that prior decision, the federal court determined that Opposer abandoned its rights to certain marks through a long and substantial period of nonuse, and that its rights in the marks, based upon a resumption of use, are entitled to a narrow scope of protection. Contrary to Opposer's position, there is ample authority that the cited decision not only has persuasive weight, but also may have collateral estoppel effect. *See L. & J.G. Stickley, Inc. v. Canal Dover Furniture Co, Inc.*, 79 F.3d 258, 264 (2d Cir. 1996) (Second Circuit cites *Sed Non Olet*, 817 F. Supp. 1103, as support for its

conclusion that the trade dress rights at issue there had been abandoned and are entitled to a limited scope of protection); *see also McKay v. Mad Murphy's, Inc.*, 899 F. Supp. 872, 881 (D. Conn. 1995) (citing *Sed Non Olet*, 817 F. Supp. 1103, for the proposition that trademark rights are lost when the trademarks are “warehoused”); *NASD Dispute Resolution, Inc. v. Judicial Council of the State of California*, 488 F.3d 1065, 1069 (9th Cir. 2007) (district court decision continues to be available and citable as persuasive authority even if it is vacated); *Russell-Newman, Inc. v. The Robeworks, Inc.*, 2003 WL 21047736 (S.D.N.Y. May 8, 2003) (although decision was vacated pursuant to settlement, the Order vacating the decision did not address the soundness of the underlying decision or the legal principles decided, and did not in any way change the reasoning of the original decision, which was entitled to collateral estoppel effect). The affirmative defense as pled gives Opposer notice of the basis for the defense. There is no basis to strike Applicant’s affirmative defense that the subject marks are entitled to a narrow scope of protection, so Opposer’s motion to strike this defense should be denied.

**CONCLUSION**

Applicant respectfully requests that the Board grant its motion to amend, deny Opposer's motion to dismiss and to strike on all grounds, and that the suspension of these proceedings be lifted so that discovery may be commenced.

Respectfully submitted,  
COOPER & DUNHAM LLP

/Robert T. Maldonado/

Dated: January 24, 2011

By: \_\_\_\_\_  
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Attorneys for Applicant  
A. STEIN MEAT PRODUCTS, INC.

# Exhibit A

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

In re Application Serial No. 77/750,645  
Filed: June 3, 2009  
For Mark: BROOKLY BURGER (Stylized)  
Published in the Official Gazette: April 27, 2010

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LOS ANGELES DODGERS, LLC,	:	
	:	
Opposer,	:	Opposition No. 91197089
	:	Serial No. 77750645
v.	:	
	:	
A. STEIN MEAT PRODUCTS, INC.,	:	<b>FIRST AMENDED</b>
	:	<b>ANSWER TO NOTICE OF</b>
	:	<b>OPPOSITION AND</b>
Applicant.	:	<b>COUNTERCLAIMS</b>
	:	<b>FOR CANCELLATION</b>
-----X		

Commissioner for Trademarks  
Attn: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Applicant, A. STEIN MEAT PRODUCTS, INC., through its attorneys, hereby answers the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief concerning the truth of the allegations of paragraph 1, and therefore denies same.
2. Applicant is without knowledge or information sufficient to form a belief concerning the truth of the allegations of paragraph 2, and therefore denies same, except to state that the baseball team once known as the BROOKLYN DODGERS ceased to exist in 1957.
3. Applicant is without knowledge or information sufficient to form a belief concerning the truth of the allegations of paragraph 3, and therefore denies same, except to state that the baseball team once known as the BROOKLYN DODGERS ceased to exist in 1957.

4. Applicant is without knowledge or information sufficient to form a belief concerning the truth of the allegations of paragraph 4, and therefore denies same. Further, to the extent that Opposer has not defined with specificity “Opposer’s BROOKLYN Marks,” Applicant is unable to respond.

5. Applicant is without knowledge or information sufficient to form a belief concerning the truth of the allegations of paragraph 5, and therefore denies same.

6. Applicant denies the allegations of paragraph 6.

7. Applicant admits the allegations of paragraph 7, except denies that Applicant filed the Application for “hamburger patties.”

8. Applicant admits the allegations of paragraph 8.

9. Applicant denies the allegations of paragraph 9.

10. Applicant denies the allegations of paragraph 10.

11. Applicant denies the allegations of paragraph 11.

#### **AFFIRMATIVE DEFENSES**

12. There is no likelihood of confusion between Applicant’s use of its mark BROOKLYN BURGER (Stylized) for hamburger patties, and Opposer’s use, if any, of the marks which are the subject of U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654.

13. Opposer’s marks which are the subject of U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 are entitled only to a narrow scope of protection. *See Major League Baseball v. Sed Non Olet Denarius*, 817 F. Supp. 1103, 1133 (S.D.N.Y. 1993), *vacated pursuant to settlement*, 859 F. Supp. 80 (S.D.N.Y. 1994).

14. Opposer's claim is barred by the doctrine of unclean hands by virtue of Opposer's deceptive use of the word BROOKLYN in connection with the goods cited in the asserted trademark registrations, which goods do not originate in Brooklyn, New York.

### COUNTERCLAIMS

15. Applicant A. Stein Meat Products, Inc. is a New York corporation having a place of business at 5600 First Avenue, Brooklyn, New York 11220.

16. Applicant has used the mark BROOKLYN BURGER (Stylized),



in interstate commerce continuously since at least as early of June 1, 2006.

17. Opposer is a Delaware limited liability company with offices at Dodger Stadium, 1000 Elysian Park Avenue, Los Angeles, California 90012.

18. Opposer claims to own U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 for various trademarks including the word BROOKLYN ("Opposer's Trademark Registrations").

19. The primary significance of the marks which are the subject of Opposer's Trademark Registrations is a generally known geographic location, i.e. Brooklyn, New York.

20. On information and belief, the goods which are the recited in Opposer's Trademark Registrations, namely, mugs, t-shirts, uniform jerseys, caps, hats, shirts, baseball uniforms, jerseys, sweatshirts, jackets, socks, and hosiery, do not originate in Brooklyn, New York.

21. On information and belief, purchasers would be likely to believe that the goods originate in Brooklyn, New York.

22. On information and belief, the misrepresentation is likely to affect a consumer's decision to buy the goods.

23. On information and belief, Opposer has no present connection with Brooklyn, New York, and has not had any such connection since its predecessor, the "Brooklyn Dodgers," left Brooklyn, New York in 1957, and relocated to Los Angeles, California, after which time Opposer's predecessor stopped using "Brooklyn Dodgers" as the name of its club.

24. Applicant believes that it will be damaged by the Opposer's Trademark Registrations and hereby seeks cancellation of same.

**FIRST COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 1,562,301  
UNDER 15 U.S.C § 1052(a)**

25. Opposer repeats and realleges the allegations set forth in paragraphs 18-24, as if fully set forth herein.

26. Opposer is the owner of record of U.S. Trademark Registration No. 1,562,301 for the mark BROOKLYN DODGERS (Stylized) for clothing, namely, t-shirts, in International Class 25, which issued October 24, 1989.

27. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 1,562,301 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. § 1052(a).

28. The continued presence of Registration No. 1,562,301 on the Principal Register has caused and is causing damage to Applicant.

**SECOND COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 1,571,978  
UNDER 15 U.S.C § 1052(a)**

29. Opposer repeats and realleges the allegations set forth in paragraphs 18-28, as if fully set forth herein.

30. Opposer is the owner of record of U.S. Trademark Registration No. 1,571,978 for the mark BROOKLYN DODGERS (Stylized) for beverage containers, namely, mugs, in International Class 21, which issued December 19, 1989.

31. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 1,571,978 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. § 1052(a).

32. The continued presence of Registration No. 1,571,978 on the Principal Register has caused and is causing damage to Applicant.

**THIRD COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 1,859,757  
UNDER 15 U.S.C § 1052(a)**

33. Opposer repeats and realleges the allegations set forth in paragraphs 18-32, as if fully set forth herein.

34. Opposer is the owner of record of U.S. Trademark Registration No. 1,859,757 for the mark BROOKLYN (Stylized) for clothing, namely, t-shirts and uniform jerseys, in International Class 25, which issued October 25, 1994.

35. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 1,859,757 was geographically deceptive as of the date that the

36. The continued presence of Registration No. 1,859,757 on the Principal Register has caused and is causing damage to Applicant.

**FOURTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 1,859,757  
UNDER 15 U.S.C § 1064(3)**

37. Opposer repeats and realleges the allegations set forth in paragraphs 18-36, as if fully set forth herein.

38. Opposer is the owner of record of U.S. Trademark Registration No. 1,859,757 for the mark BROOKLYN (Stylized) for clothing, namely, t-shirts and uniform jerseys, in International Class 25, which issued October 25, 1994.

39. Upon information and belief, the mark which is the subject of U.S. Trademark Registration No. 1,859,757 has been widely used by third parties without Opposer's authorization or consent.

40. Opposer has abandoned the mark which is the subject of U.S. Trademark Registration No. 1,859,757, due to a course of conduct that has caused the mark to lose significance as an indication of source, pursuant to 15 U.S.C. § 1064(3).

41. The continued presence of Registration No. 1,859,757 on the Principal Register has caused and is causing damage to Applicant.

**FIFTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 3,633,244  
UNDER 15 U.S.C § 1052(a)**

42. Opposer repeats and realleges the allegations set forth in paragraphs 18-41, as if

fully set forth herein.

43. Opposer is the owner of record of U.S. Trademark Registration No. 3,633,244 for the mark BROOKLYN DODGERS for clothing, namely, caps, hats, shirts, t-shirts, baseball uniforms, jerseys, sweatshirts, jackets, socks, hosiery, in International Class 25, which issued June 2, 2009.

44. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 3,633,244 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. § 1052(a).

45. The continued presence of Registration No. 3,633,244 on the Principal Register has caused and is causing damage to Applicant.

**SIXTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 3,633,244  
UNDER 15 U.S.C § 1052(e)**

46. Opposer repeats and realleges the allegations set forth in paragraphs 18-45, as if fully set forth herein.

47. Opposer is the owner of record of U.S. Trademark Registration No. 3,633,244 for the mark BROOKLYN DODGERS for clothing, namely, caps, hats, shirts, t-shirts, baseball uniforms, jerseys, sweatshirts, jackets, socks, hosiery, in International Class 25, which issued June 2, 2009.

48. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 3,633,244 is primarily geographically deceptively misdescriptive, pursuant to 15 U.S.C. § 1052(e).

49. The continued presence of Registration No. 3,633,244 on the Principal Register

has caused and is causing damage to Applicant.

**SEVENTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 3,797,654  
UNDER 15 U.S.C § 1052(a)**

50. Opposer repeats and realleges the allegations set forth in paragraphs 18-49, as if fully set forth herein.

51. Opposer is the owner of record of U.S. Trademark Registration No. 3,797,654 for the mark BROOKLYN ROBINS for clothing, namely, t-shirts, in International Class 25, which issued June 1, 2010.

52. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 3,797,654 was geographically deceptive as of the date that the registration issued, and continues to be geographically deceptive pursuant to 15 U.S.C. § 1052(a).

53. The continued presence of Registration No. 3,797,654 on the Principal Register has caused and is causing damage to Applicant.

**EIGHTH COUNTERCLAIM FOR CANCELLATION OF  
U.S. TRADEMARK REGISTRATION NO. 3,797,654  
UNDER 15 U.S.C § 1052(e)**

54. Opposer repeats and realleges the allegations set forth in paragraphs 18-53, as if fully set forth herein.

55. Opposer is the owner of record of U.S. Trademark Registration No. 3,797,654 for the mark BROOKLYN ROBINS for clothing, namely, t-shirts, in International Class 25, which issued June 1, 2010.

56. Upon information and belief, Opposer's mark which is the subject of U.S. Trademark Registration No. 3,797,654 is primarily geographically deceptively misdescriptive, pursuant to 15 U.S.C. § 1052(e).

57. The continued presence of Registration No. 3,797,654 on the Principal Register has caused and is causing damage to Applicant.

WHEREFORE, Applicant respectfully requests that Opposer's Notice of Opposition be dismissed, and that U.S. Trademark Registration Nos. 1,562,301; 1,571,978; 1,859,757; 3,633,244; and 3,797,654 be cancelled.

If any fee is deemed necessary for the filing of this amended Answer and Counterclaims, please charge any amount due to deposit Account No. 03-3125.

COOPER & DUNHAM LLP

/Robert T. Maldonado/

Dated: January 24, 2011

By: \_\_\_\_\_  
William E. Pelton  
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Tel: (212) 278-0400

Attorneys for Applicant  
A. STEIN MEAT PRODUCTS, INC.

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing **APPLICANT'S CROSS-MOTION FOR LEAVE TO FILE FIRST AMENDED ANSWER AND COUNTERCLAIMS AND OPPOSITION TO OPPOSER'S MOTIONS TO DISMISS** was served on this 24th day of January, 2011 by First Class mail on the following attorney for Opposer:

Mary L. Kevlin, Esq.  
Richard S. Mandel, Esq.  
Robert Riether, Esq.  
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/Robert T. Maldonado/

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