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

Proceeding	91199922
Party	Plaintiff Christopher A McGrath
Correspondence Address	CHRISTOPHER MCGRATH McG PRODUCTIONS LTD 22 ST JOHN STREET NEWPORT PAGNELL MILTON KEYNES, MK16 8HJ UNITED KINGDOM legal@mcgproductionsltd.com
Submission	Opposition/Response to Motion
Filer's Name	Christopher A McGrath
Filer's e-mail	legal@mcgproductionsltd.com
Signature	/C A McGRATH/
Date	07/28/2011
Attachments	REPLY TO SECOND MOTION TO DISMISS.pdf (4 pages)(232267 bytes)

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

In the matter of trademark application Serial No. 85053714 and opposition Serial No. [91199922](#)

For the mark: 20XI

Published in the Official Gazette on 3 May 2011

BETWEEN

MR. CHRISTOPHER McGRATH

Opposer

- and -

NIKE, INC.

Defendant

OPPOSER'S REPLY TO DEFENDANT'S SECOND MOTION TO DISMISS.

1. Counsel for the Defendant states: "... as carefully documented by Opposer in the Amended Notice of Opposition (ANOP ¶¶ 43-50), the online store was set up four months *after* NIKE filed its application". This is correct; but what is not correct is as follows: "(and after Opposer had learned of NIKE's Mark, as described in paragraph 35 of the Amended Notice of Opposition)".

2. The online store agreement was finalised on 4 October 2010. The email copied below was sent 31 October 2011, the date the Opposer first knew of the Defendant's trademark application, at which time no merchandise had appeared online and only a press photo appeared as follows:



3. The email sent on 31 October 2010 read in part as follows:

[Print](#) | [Close Window](#)

Subject: 20XI - trademark infringementUS Serial No: 85053714

From: info@mcgproductionsltd.com

Date: Sun, Oct 31, 2010 4:35 pm

To: Trademark@nike.com

Attach: sigimg1

Re: http://tmportal.uspto.gov/external/portal!/ut/p/c5/04_SB8K8xLLM9MSSzPy8xBz9CP0os3iLEH9XEz_cPIwMDEw9jA0-jsKAQrxBfAwNvQ6B8JJK8u1OIK1A-yNXCz9nQ2MDAiCLdBgR0h4Nci992vPIGEHkDHMDRQN_Piz83Vb8gNzTCIDMgHQDjF_k7/dl3/d3/LOIDU0IKSWdrbUNTUS9JUFJBQUlpQ2dBek15cXpHWUEhIS80QkVqOG8wRmxHaXQtYlhwQUh0Qi83XzhUT0U0RkgyMDA0SDMwSTJWUIRKVE0wMDLxLzpqSEVOODI2ODAwMDUvc2EuZ292LnVzcHRvLnRvdy5hY3Rpb25zLkRldGFpbFZpZXdBZ3Rpb24!/#

And: <http://www.trademarks411.com/marks/85053714-20xi>

Dear Nike,

My name is Christopher A McGrath, Managing Director of McG Productions Ltd in the U.K. This email is in relation to the International Trade Mark application by Nike of the mark 20XI, as per the above links that I have only this evening become aware of by chance. If this is not the correct correspondnece email on this matter, please would you provide an appropriate email at Nike to correspond. You will note at the following websites that the trademark 20XI infringes on my own trademark,

20XII The Honor of Sport™

We are already trading internationally with the following trademark at:

<http://www.mcgproductionsltd.com/Sports.php>

<http://www.20xii.com/>

<http://www.20xii.co.uk/...>

Nike will of course be the subject of legal action should your trademark application proceed, as is only right in defence of our legal and commercial interests worldwide...

Yours sincerely,

Mr. Christopher A McGrath

McG Productions Ltd
22 St John Street
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info@mcgproductionsltd.com

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4. The Opposer respectfully draws attention for the second time to a breach by the Defendant pursuant to **35 U.S.C. § 25. Declaration in lieu of oath:**

U.S.C. § 1001 provides: "Whoever in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statements or entry, shall be fined not more than \$10,000 or imprisoned not more than five years, or both."

And:

37 C.F.R. PART 2-RULES OF PRACTICE IN TRADEMARK CASES

§ 2.20 Declarations in lieu of oaths.

...willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom...

And:

§ 1 (15 U.S.C. § 1051). Application for registration; verification:

(3) The statement shall be verified by the applicant and specify that—

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and (D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive

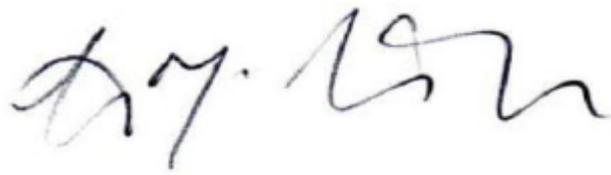
5. The willful false statement regarding a 'material fact' by counsel for the Defendant in suggesting the Opposer's online sports logo-store came *after* the Opposer knew about the Defendant's trademark application, when the Defendant received a later email notifying them on the very day the Opposer discovered the application online, should, in addition to the already cited emails of May and June 2010 between the Defendant and the Opposer in the Opposer's Amended Pleadings, "*jeopardize the validity of the application*".

6. Conclusion

On the above grounds, in addition to those in the Amended Pleadings, the Opposer respectfully requests that the Defendant's application be denied.

Respectfully submitted,

Mr. Christopher Anthony McGrath.



28 July 2011

CERTIFICATE OF SERVICE

I hereby certify that on this 28th day of July, 2011, a true and complete copy of the foregoing OPPOSER'S REPLY TO APPLICANT'S SECOND MOTION TO DISMISS has been served by email on the Defendant at: hminsker@bannerwitcoff.com and bwlitdocket@bannerwitcoff.com to be followed by first class registered prepaid post to:

Correspondence: [HELEN HILL MINSKER](#)
BANNER & WITCOFF LTD
TEN SOUTH WACKER DRIVE, SUITE 3000
CHICAGO, IL 60611
UNITED STATES

And that similar service of [P'S MOTION TO AMEND PLEADING/AMENDED PLEADING](#) was effected by email on 14 July 2011 with follow-up first class, registered prepaid post sent to both the above correspondence address for the Defendant and also to the United States Patent and Trademark Commissioner for Trademarks Office PO BOX 1451, Alexandria, VA 22313-1451.

By: /Christopher A McGrath/