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

Proceeding	91200327
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Attachments	Applicant's Answer to Notice of Opposition.pdf (15 pages)(27792 bytes)

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

In the Matter of Application Serial No. 77/886,135
For the mark: DERBY OF SAN FRANCISCO (and Design)
Published in the *Official Gazette* on: March 15, 2011

James Murta, Opposer, v. Victor Suarez. Applicant.	Opposition No. 91/200,327 Interlocutory Attorney: Jennifer Krisp APPLICANT’S ANSWER TO NOTICE OF OPPOSITION WITH AFFIRMATIVE DEFENSES
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**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION
WITH AFFIRMATIVE DEFENSES**

Victor Suarez (“Applicant”), the owner of the above-referenced application, Serial No. 77/886,135, by and through his attorneys, hereby submits his Answer to the Notice of Opposition filed by James Murta (“Opposer”). Unless indicated differently, each paragraph below corresponds with the paragraph of the Notice of Opposition bearing the same number.

Applicant lacks sufficient knowledge and information regarding the allegations contained in the two un-numbered introductory paragraphs of the Notice of Opposition to admit or deny and, on that basis, denies each and every allegation contained therein. To the extent any other un-numbered paragraphs, captions, or headings in the Notice of Opposition are treated as allegations, such allegations are hereby denied.

1. Applicant admits that it is the Applicant for U.S. Trademark Application Serial No. 77/886,135. Applicant further admits that U.S. Trademark Application Serial No.

77/886,135 and the *Official Gazette* in which that application was published in all ways speak for themselves. Except as expressly admitted herein, Applicant denies each and every remaining allegation contained therein.

2. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 2 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 2.

3. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 3 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 3.

4. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 4 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 4.

5. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 5

concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 5.

6. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 6 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 6.

7. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 7 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 7.

8. Applicant admits that U.S. Patent and Trademark Office (“PTO”) records indicate that the PTO issued U.S. Trademark Registration No. 1,348,076 and that the file history for that registration speaks for itself. Except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 8.

9. Applicant admits that the file history for Registration No. 1,348,076 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 9 concerning alleged evidentiary details of Registration No. 1,348,076 are related to issues of proof and not

pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 9.

10. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 10 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 10.

11. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 11 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 11.

12. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 12 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 12.

13. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 13

concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 13.

14. Applicant submits that the allegations in Paragraph 14 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 14.

15. Applicant denies each and every allegation contained in Paragraph 15 of the Notice of Opposition.

16. Applicant submits that the allegations in Paragraph 16 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 16.

17. Applicant submits that the allegations in Paragraph 17 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 17.

18. Applicant denies each and every allegation contained in Paragraph 18 of the Notice of Opposition.

19. Applicant submits that the allegations in Paragraph 19 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not

pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 19.

20. Applicant submits that the allegations in Paragraph 20 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 20.

21. Applicant denies each and every allegation contained in Paragraph 21 of the Notice of Opposition.

22. Applicant submits that the allegations in Paragraph 22 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 22.

23. Applicant submits that the allegations in Paragraph 23 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 23.

24. Applicant denies each and every allegation contained in Paragraph 24 of the Notice of Opposition.

25. Applicant submits that the allegations in Paragraph 25 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 25.

26. Applicant submits that the allegations in Paragraph 26 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 26.

27. Applicant denies each and every allegation contained in Paragraph 27 of the Notice of Opposition.

28. Applicant submits that the allegations in Paragraph 28 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 28.

29. Applicant submits that the allegations in Paragraph 29 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 29.

30. Applicant submits that the allegations in Paragraph 30 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 30.

31. Applicant submits that the allegations in Paragraph 31 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 31.

32. Applicant submits that the allegations in Paragraph 32 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 32.

33. Applicant submits that the allegations in Paragraph 33 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 33.

34. Applicant submits that the allegations in Paragraph 34 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 34.

35. Applicant submits that the allegations in Paragraph 35 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 35.

36. Applicant submits that the allegations in Paragraph 36 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 36.

37. Applicant submits that the allegations in Paragraph 37 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and

not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 37.

38. Applicant submits that the allegations in Paragraph 38 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 38.

39. Applicant submits that the allegations in Paragraph 39 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 39.

40. Applicant submits that the allegations in Paragraph 40 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 40.

41. Applicant submits that the allegations in Paragraph 41 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 41.

42. Applicant submits that the allegations in Paragraph 42 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 42.

43. Applicant submits that the allegations in Paragraph 43 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 43.

44. Applicant submits that the allegations in Paragraph 44 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 44.

45. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 45 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 45.

46. Applicant admits that PTO records reflect that Opposer filed a request for an Extension of Time to Oppose Application Serial No. 77/886,135 on April 1, 2011.

47. Applicant submits that the allegations in Paragraph 47 concerning alleged evidentiary details regarding the history of this opposition are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 47.

48. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 48 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues

of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 48.

49. Applicant submits that the allegations in Paragraph 49 concerning alleged evidentiary details regarding the history of this opposition are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 49.

50. Applicant submits that the allegations in Paragraph 50 concerning alleged evidentiary details of Application Serial No. 77/886,135, as well as the history of this opposition, are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 50.

51. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Moreover, Applicant submits that the allegations in Paragraph 51 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 51.

52. Applicant denies each and every allegation contained in Paragraph 52 of the Notice of Opposition.

53. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 53.

54. Applicant submits that the allegations in Paragraph 54 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 54.

55. Applicant submits that the allegations in Paragraph 55 concerning alleged evidentiary details regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 55.

56. Applicant submits that the allegations in Paragraph 56 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 56.

57. Applicant submits that the allegations in Paragraph 57 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 57.

58. Applicant submits that the allegations in Paragraph 58 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 58.

59. Applicant submits that the allegations in Paragraph 59 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not

pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 59.

60. Applicant submits that the allegations in Paragraph 60 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 60.

61. Applicant submits that the allegations in Paragraph 61 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 61.

62. Applicant submits that the allegations in Paragraph 62 concerning alleged evidentiary details of Application Serial No. 77/886,135 are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. On these grounds, Applicant denies each and every allegation contained in Paragraph 62.

AFFIRMATIVE DEFENSES

First Affirmative Defense ***(Failure to State a Claim)***

1. Opposer has failed to state facts sufficient to constitute any claim for relief.

Second Affirmative Defense ***(Standing)***

2. Opposer lacks standing to bring this opposition.

Third Affirmative Defense
(Unclean Hands)

3. By virtue of Opposer's conduct, Opposer's claims are barred by the doctrine of unclean hands.

Fourth Affirmative Defense
(Estoppel)

4. Opposer is estopped from asserting any claims against Applicant arising out of the matters alleged in the Notice of Opposition.

Fifth Affirmative Defense
(Failure to Mitigate)

5. To the extent Opposer suffered or is entitled to any relief at all, Opposer has failed to mitigate its damages.

Respectfully submitted,

Date: August 1, 2011

By: /Marina A. Lewis/
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CERTIFICATE OF SERVICE

I certify that on August 1, 2011, a true copy of the foregoing **APPLICANT'S ANSWER TO NOTICE OF OPPOSITION WITH AFFIRMATIVE DEFENSES** was sent via first class mail, postage prepaid, to:

Mr. Kurt Leyendecker
Leyendecker & Lemire LLC
9137 E. Mineral Cir., Ste. 280
Centennial, CO 80112

/Marina A. Lewis/