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

Proceeding	91200327
Party	Defendant Victor Suarez
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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. 77/886,135
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: Elizabeth J. Winter APPLICANT’S ANSWER TO AMENDED NOTICE OF OPPOSITION WITH AFFIRMATIVE DEFENSES
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**APPLICANT’S ANSWER TO AMENDED 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 Amended Notice of Opposition filed by James Murta (“Opposer”) on November 23, 2011. Unless indicated differently, each paragraph below corresponds with the paragraph of the Amended 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 Amended 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 Amended 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, filed December 4, 2009. Applicant further admits that U.S. Trademark Application Serial No. 77/886,135 in all ways speaks for itself. 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 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 2 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. 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 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 3 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. 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 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 4 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. 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 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 5 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. 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 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 6 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 6.

7. Applicant submits that the allegations in Paragraph 7 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 7 are now the subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 7.

8. Applicant submits that the allegations in Paragraph 8 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 8 are now the subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 8.

9. Applicant submits that the allegations in Paragraph 9 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 9 are now the subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 9.

10. Applicant submits that the allegations in Paragraph 10 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 10 are now the subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 10.

11. Applicant submits that the allegations in Paragraph 11 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 11 are now the subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 11.

12. Applicant submits that the allegations in Paragraph 12 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 12 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 12.

13. Applicant submits that the allegations in Paragraph 13 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 13 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 13.

14. Applicant submits that the allegations in Paragraph 14 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 14 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 14.

15. Applicant submits that the allegations in Paragraph 15 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 15 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 15.

16. Applicant submits that the allegations in Paragraph 16 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 16 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. 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 regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 17 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 17.

18. Applicant submits that the allegations in Paragraph 18 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 18 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 18.

19. Applicant submits that the allegations in Paragraph 19 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As

such, the allegations in Paragraph 19 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. 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 regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 20 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 20.

21. Applicant submits that the allegations in Paragraph 21 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 21 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 21.

22. Applicant submits that the allegations in Paragraph 22 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 22 are now the subject of Applicant's currently-pending

Motion to Strike and Motion for a More Definite Statement. 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 regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 23 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 23.

24. Applicant submits that the allegations in Paragraph 24 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 24 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 24.

25. Applicant submits that the allegations in Paragraph 25 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. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 25 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. 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 regarding Applicant's commercial activities are related to issues of proof and not pleading and are not proper allegations for a Notice of Opposition. Moreover, it is not clear to Applicant how these allegations relate to any claim made by Opposer in this proceeding. As such, the allegations in Paragraph 26 are now the subject of Applicant's currently-pending Motion to Strike and Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 26.

27. 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 27 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 27 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 27.

28. 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 28 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 28 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 28.

29. 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 29 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 29 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds,

and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 29.

30. 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 30 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 30 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 30.

31. Applicant denies the allegations contained in the first sentence of Paragraph 31. The second sentence in Paragraph 31 is merely informative and does not require a response. The third sentence in Paragraph 31 is the subject of Applicant's currently-pending Motion for a More Definitive Statement. The fourth and last sentence of Paragraph 31 is the subject of Applicant's currently pending Motion for Partial Dismissal. On all of the aforementioned grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 31.

32. Applicant admits that the file history for Application Serial No. 77/886,135 in all ways speaks for itself. Applicant further submits that the allegations in Paragraph 32 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 32 are now the subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, and except as expressly admitted herein, Applicant denies each and every allegation contained in Paragraph 32.

33. Applicant submits that the allegations in Paragraph 33 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 33 are now the

subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 33.

34. Applicant submits that the allegations in Paragraph 34 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 34 are now the subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 34.

35. Applicant submits that the allegations in Paragraph 35 are not sufficiently pled with the required level of specificity. As such, the allegations in Paragraph 35 are now the subject of Applicant's currently-pending Motion for a More Definite Statement. On these grounds, Applicant denies each and every allegation contained in Paragraph 35.

36. Applicant submits that the allegations in Paragraph 36 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 36 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, Applicant denies each and every allegation contained in Paragraph 36.

37. Applicant submits that the allegations in Paragraph 37 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 37 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, Applicant denies each and every allegation contained in Paragraph 37.

38. Applicant submits that the allegations in Paragraph 38 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 38 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, Applicant denies each and every allegation contained in Paragraph 38.

39. Applicant submits that the allegations in Paragraph 39 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 39 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, Applicant denies each and every allegation contained in Paragraph 39.

40. Applicant submits that the allegations in Paragraph 40 fail to state a claim upon which relief may be granted. As such, the allegations in Paragraph 40 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. 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 the file history for Application Serial No. 77/886,135 do not state a claim upon which relief can be granted to Opposer. As such, the allegations in Paragraph 41 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. 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 the file history for Application Serial No. 77/886,135 do not state a claim upon which relief can be granted to Opposer. As such, the allegations in Paragraph 42 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. 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 the file history for Application Serial No. 77/886,135 do not state a claim upon which relief can be granted to Opposer. As such, the allegations in Paragraph 43 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. 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 the file history for Application Serial No. 77/886,135 do not state a claim upon which relief can be granted to Opposer. As such, the allegations in Paragraph 44 are now the subject of Applicant's currently-pending Motion for Partial Dismissal. On these grounds, Applicant denies each and every allegation contained in Paragraph 44.

AFFIRMATIVE DEFENSES

First Affirmative Defense (*Standing*)

1. Opposer lacks standing to bring this opposition. Opposer claims in his Notice of Opposition that he will be harmed if Applicant's mark is allowed to register because Opposer's own application to register stylized logo with the words DERBY OF SAN FRANCISCO has been suspended pending the disposition of Applicant's application. However, Opposer was aware of Applicant's use of the mark at issue in this proceeding when he filed his application. Therefore, the declaration executed by Opposer that he was entitled to use the mark in commerce was fraudulent and the ensuing application is invalid. Because Opposer never had a legitimate right to apply to register the mark in the first place and because he would not be damaged by Applicant's registration of superior rights, Opposer cannot sustain support a finding that he has standing to bring this opposition.

Second Affirmative Defense (*Unclean Hands*)

2. By virtue of Opposer's conduct, Opposer's claims are barred by the doctrine of unclean hands. Opposer first became acquainted with Applicant in December 2009 when he

contacted Applicant to offer to sell used jackets to be used as prototype designs for Applicant's inventory. It was then that Opposer learned of Applicant's business and prior use of Applicant's DOSF mark. Notwithstanding his prior knowledge of Applicant's earlier rights, Opposer proceeded to file an application to register a competing variation of the DOSF Mark, and then contacted Applicant to announce his own trademark filing and his intention to extort money from Applicant by "licensing" Applicant's own mark back to him. As such, Opposer never had any bona fide intent to use his own trademark; rather, he merely filed an application to reserve rights in a mark and to use the filing to extort money from Applicant.

Respectfully submitted,

Date: December 23, 2011

By: /Marina A. Lewis/
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CERTIFICATE OF SERVICE

I certify that on December 23, 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/