

ESTTA Tracking number: **ESTTA450991**

Filing date: **01/12/2012**

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

Proceeding	91201125
Party	Defendant Fortrend Group LLC
Correspondence Address	JASON A KOTZKER THE KOTZKER LAW GROUP 10268 ROYAL EAGLE ST HIGHLANDS RANCH, CO 80129-6969 UNITED STATES kotzkeriplaw@gmail.com
Submission	Answer
Filer's Name	Jason A. Kotzker
Filer's e-mail	kotzkeriplaw@gmail.com, melias@trademarkportfolios.com
Signature	/jak/
Date	01/12/2012
Attachments	Answer to Amended Notice of Opposition.pdf ( 9 pages )(98489 bytes ) Exhibit A and B to Answer.pdf ( 13 pages )(5692138 bytes )

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

**In the Matter of Application Serial No. 85/160,126: PRIVÉ**

9228-4330 Quebec, Inc.	)	
	)	
Opposer,	)	
	)	Opposition No. 91201125
vs.	)	
	)	
	)	
Fortrend Group LLC,	)	
	)	
Applicant.	)	

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**ANSWER TO AMENDED NOTICE OF OPPOSITION**

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Respondent/Applicant, Fortrend Group LLC, by its attorney, hereby answers the allegations set forth in the Amended Notice of Opposition as follows:

1. Applicant has insufficient knowledge or information as to the truth of the allegations set forth in the first sentence of Paragraph 1 of the Amended Notice of Opposition and, therefore, denies said allegations. Applicant further denies the allegations set forth on the second sentence of Paragraph 1.

2. Applicant admits that it filed a trademark application under Section 1(a) of the Lanham Act on October 25, 2010 to register PRIVÉ (the “Mark”) in International Class 35 for “Retail consignment store services; consignment services, namely, promoting and marketing the goods of others; Online retail consignment services featuring a variety of consumer goods” (the “Services”). Applicant further admits the application was assigned Serial No. 85/160,126 (the “Application”).

3. Applicant admits it had originally claimed first use of the Mark in connection

with the Services anywhere at least as early as June 2007. Applicant further admits it originally claimed first use of the Mark in connection with the Services in interstate commerce as early as June 2007. Applicant further states that on July 28, 2011, it submitted a post publication amendment pursuant to TMEP 1505.01(a) and (b), which amended the first use and first use in interstate commerce dates in the Application to September 30, 2008 (the “Amendment.”) The Examining Attorney accepted the Amendment, and the Application was republished for opposition on October 4, 2011.

4. Applicant admits that an Examiner’s Amendment was issued on February 4, 2011 amending the identification of Services to: “Retail consignment stores featuring clothing, shoes, handbags, jewelry, home goods, bedding and linens, glassware, silverware, and action sports apparel; consignment services, namely, promoting and marketing the goods of others; online retail consignment stores featuring a variety of consumer goods.”

5. Applicant admits the Application was published for Opposition on April 12, 2011.

6. Applicant admits Opposer filed a request for a 30-day extension of time to oppose the Application on May 10, 2011 and that such request was granted on May 10, 2011.

7. Applicant admits Opposer requested a further 60-day extension of time to oppose the Application on June 2, 2011 and such request was granted on June 6, 2011.

8. Applicant admits the allegations set forth in Paragraph 8 of the Amended Notice of Opposition.

9. Applicant admits that the post publication amendment filed on July 28, 2011 was not properly supported by the required declaration under TMEP 1505.1 (a) and (b). Applicant also asserts that such amendment was cured by submitting the missing Declaration on January 10, 2012. A copy of the filing containing the motion and amendment with declaration is attached

herewith as Exhibit A.

10. Applicant admits the allegations set forth in Paragraph 10 of the Amended Notice of Opposition as to the acceptance of Applicant's post publication amendment but denies the claims regarding the erroneousess of such acceptance.

11. Applicant admits the allegations set forth in Paragraph 11 of the Amended Notice of Opposition.

12. Applicant admits the allegations set forth in Paragraph 12 of the Amended Notice of Opposition.

13. Applicant admits the allegations set forth in Paragraph 13 of the Amended Notice of Opposition.

14. Applicant denies the allegations set forth in Paragraph 14 of the Amended Notice of Opposition as Opposer is aware that Applicant amended its date of first use and first use in commerce to March 25, 2010 in connection with "online retail consignment stores featuring a variety of consumer goods."

15. Applicant denies the allegations set forth in Paragraph 15 of the Amended Notice of Opposition.

16. Applicant denies the allegations set forth in Paragraph 16 of the Amended Notice of Opposition.

17. The admissions and denials in paragraph 1-16 are incorporated by reference.

18. Applicant denies the allegations set forth in Paragraph 18 of the Amended Notice of Opposition.

19. Applicant denies the allegations set forth in Paragraph 19 of the Amended Notice of Opposition.

20. The admissions and denials in paragraph 1-19 are incorporated by reference.
21. Applicant admits the allegations set forth in Paragraph 21 of the Amended Notice of Opposition.
22. Applicant denies the allegations set forth in Paragraph 22 of the Amended Notice of Opposition. Opposer mistakenly asserts an incorrect filing date for the application and confuses the amended date of use and use in commerce of March 25, 2010 for “online retail consignment stores featuring a variety of consumer goods” with the filing date of the application of October 25, 2010.
23. Applicant admits that the post publication amendment filed on July 28, 2011 was not properly supported by the required declaration under TMEP 15050.1 (a) and (b). Applicant also asserts that such amendment was cured by submitting the missing Declaration on January 10, 2012. A copy of the filing containing the motion and amendment with declaration is attached herewith as Exhibit A.
24. Applicant denies the allegations set forth in Paragraph 24 of the Amended Notice of Opposition.
25. Applicant denies the allegations set forth in Paragraph 25 of the Amended Notice of Opposition.
26. The admissions and denials in paragraph 1-25 are incorporated by reference.
27. Applicant denies the allegations set forth in Paragraph 27 of the Amended Notice of Opposition.
28. Applicant denies the allegations set forth in Paragraph 28 of the Amended Notice of Opposition.
29. The admissions and denials in paragraph 1-28 are incorporated by reference.

30. Applicant denies the allegations set forth in Paragraph 30 of the Amended Notice of Opposition. Opposer is aware that Applicant amended its date of first use and first use in commerce to March 25, 2010 in connection with “online retail consignment stores featuring a variety of consumer goods” and even though Applicant inadvertently did not attach a proper declaration with its amendment, it cured such deficiency by filing same on January 10, 2012 as evidenced by the attached Exhibit A.

31. Applicant denies the allegations set forth in Paragraph 31 of the Amended Notice of Opposition.

32. Applicant admits the allegations set forth in Paragraph 32 of the Amended Notice of Opposition.

33. Applicant denies the allegations set forth in Paragraph 33 of the Amended Notice of Opposition.

34. Applicant denies the allegations set forth in Paragraph 34 of the Amended Notice of Opposition. Opposer is confused as to Applicant’s filing date of October 25, 2010 and amended dates of use and first use in commerce of March 25, 2010 for “online retail consignment stores featuring a variety of consumer goods.”

35. Applicant denies the allegations set forth in Paragraph 35 of the Amended Notice of Opposition.

36. Applicant denies the allegations set forth in Paragraph 36 of the Amended Notice of Opposition.

37. Applicant denies the allegations set forth in Paragraph 37 of the Amended Notice of Opposition.

38. Applicant denies the allegations set forth in Paragraph 38 of the Amended Notice

of Opposition.

39. Applicant denies the allegations set forth in Paragraph 39 of the Amended Notice of Opposition.

Applicant denies all other allegations of the Amended Notice of Opposition that have not been affirmatively admitted herein.

### **AFFIRMATIVE DEFENSES**

Applicant, on information and belief, submits as its Affirmative Defenses to the Amended Notice of Opposition the following:

#### First Affirmative Defense

The Notice of Opposition, in whole or in part, fails to state a claim upon which relief may be granted.

#### Second Affirmative Defense

Applicant is currently using and has used the mark **PRIVÉ** in interstate commerce and anywhere in the world at least as early as September 30, 2008 for “Retail consignment stores featuring clothing, shoes, handbags, jewelry, home goods, bedding and linens, glassware, silverware, and action sports apparel; consignment services, namely, promoting and marketing the goods of others;” and March 25, 2010 for “Online retail consignment stores featuring a variety of consumer goods.”

#### Third Affirmative Defense

Upon information and belief Applicant has prior rights to the use of the mark **PRIVÉ** in the United States, Canada and other countries. Applicant’s use anywhere and use in commerce of the mark **PRIVÉ** dates back to September 30, 2008 for “Retail consignment stores featuring clothing, shoes, handbags, jewelry, home goods, bedding and linens, glassware, silverware, and

action sports apparel; consignment services, namely, promoting and marketing the goods of others;” and March 25, 2010 for “Online retail consignment stores featuring a variety of consumer goods“ while Opposer’s dates of use date back to January 07, 2011 as shown in the attached copy of the Canadian Intellectual Property Office’s (CIPO) trademark data dated January 12, 2012, attached herewith as Exhibit B.

#### Fourth Affirmative Defense

Upon information and belief Opposer has not used the mark **PRIVÉ** in commerce or anywhere prior to September 30, 2008 in connection with retail stores services featuring a variety of consumer goods.

#### Fifth Affirmative Defense

Pursuant to 37 C.F.R. §2.71(c) (1), Applicant is entitled to amend its prior alleged date of first use and first use in commerce of June 2007 to a later date as long as this date is not prior to the filing date of the application. Applicant submitted its Application on **October 25, 2010** and amended its date of use anywhere and use in commerce to **September 30, 2008** for “Retail consignment stores featuring clothing, shoes, handbags, jewelry, home goods, bedding and linens, glassware, silverware, and action sports apparel; consignment services, namely, promoting and marketing the goods of others;” and **March 25, 2010** for “Online retail consignment stores featuring a variety of consumer goods.”

#### Sixth Affirmative Defense

Applicant’s amendment of July 28, 2011 of Applicant’s dates of use and use in commerce has been verified by a Declaration pursuant to TMEP 15050.1 (a) and (b) as evidenced by the filing submitted to the Board on January 10, 2012, a copy of which is enclosed as Exhibit A.

Seventh Affirmative Defense

Opposer's claims are barred by the doctrine of laches.

Eighth Affirmative Defense

Opposer is estopped from bringing this Notice of Opposition as Applicant has been using its mark since September 2008 and Opposer has never objected to Applicant's use.

Applicant reserves the right to amend its Affirmative Defenses, as facts and information are obtained through discovery and other means of investigation.

Wherefore, Applicant respectfully prays that this Amended Notice of Opposition be denied and dismissed and that Applicant's application matures into registration.

Respectfully submitted,

Date: January 12, 2012

By:     /s/ Jason A. Kotzker      
Jason A. Kotzker  
KOTZKER LAW GROUP  
Attorney for Respondent  
PO Box 632134  
Highlands Ranch, CO 80163-2134  
Jason@KLGIP.com

**CERTIFICATE OF SERVICE**

I hereby certify that on this 12h day of January 2012, a true and correct copy of the foregoing ANSWER TO AMENDED NOTICE OF OPPOSITION was placed in the U.S. Mail, first class postage prepaid, addressed to:

Jennifer D. Silverman, Esq.  
Ellenoff Grossman & Schole LLP  
150 E. 42<sup>nd</sup> Street, 11<sup>th</sup> Floor  
New York, NY 10017

By:     /s/ Jason A. Kotzker      
Jason A. Kotzker  
KOTZKER LAW GROUP  
Attorney for Respondent  
PO Box 632134  
Highlands Ranch, CO 80163-2134  
[Jason@KLGIP.com](mailto:Jason@KLGIP.com)

# **EXHIBIT A**

ESTTA Tracking number: **ESTTA450444**

Filing date: **01/10/2012**

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

Proceeding	91201125
Party	Defendant Fortrend Group LLC
Correspondence Address	JASON A KOTZKER THE KOTZKER LAW GROUP 10268 ROYAL EAGLE ST HIGHLANDS RANCH, CO 80129-6969 UNITED STATES kotzkeriplaw@gmail.com
Submission	Other Motions/Papers
Filer's Name	Jason A. Kotzker
Filer's e-mail	kotzkeriplaw@gmail.com, melias@trademarkportfolios.com
Signature	/jak/
Date	01/10/2012
Attachments	Motion for Leave to Supplement Post Publication Amendment Revised.pdf ( 3 pages )(275125 bytes ) Exhibits A and B to Motion for Leave to file Amendment w Dec.pdf ( 5 pages )(2597348 bytes )

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

**In the Matter of Application Serial No. 85/160,126: PRIVÉ**

9228-4330 Quebec, Inc.	)	
	)	
Opposer,	)	
	)	Opposition No. 91201125
vs.	)	
	)	
Fortrend Group LLC,	)	
	)	
Applicant.	)	

**Applicant’s Motion for Leave to Supplement Post Publication  
Amendment to Applicant’s Dates of Use**

Respondent/Applicant, Fortrend Group LLC. through and by its attorney files this Motion for Leave to Supplement an earlier filed amendment as follows:

1. Applicant filed Trademark Application Serial No. 85/160,126, hereinafter “the application” for the mark PRIVÉ on October 25, 2010.
2. On April 12, 2011, the application was published for opposition.
3. On July 28, 2011, Applicant filed a Post Publication Amendment to the application.

Since the Amendment was filed between publication and the commencement of opposition proceedings, such amendments are reviewed by the paralegal specialists in the Office of the Deputy Commissioner for Trademark Examination Policy and as such the instant proceedings were suspending pending the disposition of this filing.

4. On August 24, 2011, the Board issued an Order advising of the acceptance of the amendment and the resumption of proceedings.

5. The amendment filed by Applicant on July 28, 2011, in accordance with TMEP 15050.1(a) and (b), requested an amendment of Applicant's dates of first use and dates of first use in commerce. Such amendment is attached hereto as Exhibit "A".

6. Although this amendment was accepted by the Office of the Deputy Commissioner for Trademark Examination, Applicant inadvertently did not include a proper declaration as required by 37 C.F.R. §2.76(e) and TMEP §1104.08. As such, Applicant wishes to correct such deficiency by submitting a properly executed declaration pursuant to 37 C.F.R. §2.76(g). Please refer to Exhibit "B" which includes the amendment and the declaration for review and approval.

Wherefore, in view of the attached supplemental filing, Applicant respectfully requests that instant amendment be reviewed again and accepted accordingly.

Respectfully submitted,

Date: January 10, 2012

By: /s/ Jason A. Kotzker  
Jason A. Kotzker  
KOTZKER LAW GROUP  
Attorney for Respondent  
PO Box 632134  
Highlands Ranch, CO 80163-2134  
Jason@KLGIP.com

**Certificate of Service**

I hereby certify that on this 10<sup>th</sup> day of January, 2012, a true and correct copy of the foregoing Motion was placed in the U.S. Mail, first class postage prepaid, addressed to:

Jennifer D. Silverman, Esq.  
Ellenoff Grossman & Schole LLP  
150 E. 42<sup>nd</sup> Street, 11<sup>th</sup> Floor  
New York, NY 10017

By: /s/ Jason A. Kotzker  
Jason A. Kotzker  
KOTZKER LAW GROUP  
Attorney for Respondent  
PO Box 632134  
Highlands Ranch, CO 80163-2134  
Jason@KLGIP.com

# **EXHIBIT A**

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THE KOTZKER LAW GROUP

TRADEMARK · COPYRIGHT · INTERNET LAW

DIRECT E-MAIL:  
[jason@klgip.com](mailto:jason@klgip.com)

WEBSITE:  
[www.klgip.com](http://www.klgip.com)

Paralegal Specialist  
U.S. Patent and Trademark Office  
Office of the Deputy Commissioner for Trademark Examination Policy

Re.: U.S. Trademark Application Serial No. 85,160,126 for the mark "PRIVÉ"

Dear Paralegal Specialist:

Pursuant to TMEP 1505.01(a) and (b), please accept this proper request for a post publication amendment to the mark PRIVÉ found in U.S. Application Serial No. 85,160,126. The Applicant, Fortrend Group, LLC, seeks to amend the first use dates associated with the services described in this application. Namely, the Applicant wishes to amend the application to include the following first use and first use in commerce dates:

**IC 035. Retail consignment stores featuring clothing, shoes, handbags, jewelry, home goods, bedding and linens, glassware, silverware, and action sports apparel; consignment services, namely, promoting and marketing the goods of others;**

**FIRST USE: September 30, 2008, FIRST USE IN COMMERCE: September 30, 2008**

**IC 035. Online retail consignment stores featuring a variety of consumer goods**

**FIRST USE: March 25, 2010. FIRST USE IN COMMERCE: March 25, 2010**

It is understood that this amendment will require republication of the mark, and such action is respectfully requested. Thank you for your attention to this matter. If you have any questions, please contact the undersigned.

Regards,

Jason Kotzker  
THE KOTZKER LAW GROUP

# **EXHIBIT B**

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THE KOTZKER LAW GROUP

TRADEMARK · COPYRIGHT · INTERNET LAW

DIRECT E-MAIL:  
[jason@klgip.com](mailto:jason@klgip.com)

WEBSITE:  
[www.klgip.com](http://www.klgip.com)

Paralegal Specialist  
U.S. Patent and Trademark Office  
Office of the Deputy Commissioner for Trademark Examination Policy

Re.: U.S. Trademark Application Serial No. 85,160,126 for the mark "PRIVÉ"

Dear Paralegal Specialist:

Pursuant to TMEP 1505.01(a) and (b), please accept this proper request for a post publication amendment to the mark PRIVÉ found in U.S. Application Serial No. 85,160,126. The Applicant, Fortrend Group, LLC, seeks to amend the first use dates associated with the services described in this application. Namely, the Applicant wishes to amend the application to include the following first use and first use in commerce dates:

**IC 035. Retail consignment stores featuring clothing, shoes, handbags, jewelry, home goods, bedding and linens, glassware, silverware, and action sports apparel; consignment services, namely, promoting and marketing the goods of others;**

**FIRST USE: September 30, 2008, FIRST USE IN COMMERCE: September 30, 2008**

**IC 035. Online retail consignment stores featuring a variety of consumer goods**

**FIRST USE: March 25, 2010, FIRST USE IN COMMERCE: March 25, 2010**

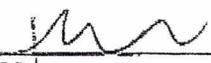
It is understood that this amendment will require republication of the mark, and such action is respectfully requested. Thank you for your attention to this matter. If you have any questions, please contact the undersigned.

Regards,

Jason Kotzker  
THE KOTZKER LAW GROUP

### Declaration Signature

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34(a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the 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/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature:  Date: 01/06/2012

Signatory's Name: JAY M. SABA

Signatory's Position: Executive

Signatory's Phone Number: (212) 380-3000

# **EXHIBIT B**



Canadian Intellectual  
Property Office  
An Agency of  
Industry Canada

Office de la propriété  
intellectuelle du Canada  
Un organisme  
d'Industrie Canada

Canada

## Canadian Intellectual Property Office

### Canadian Trade-marks Database

#### CANADIAN TRADE-MARK DATA

[↪ Search Page](#)

\*\*\* Note **Data on trade-marks is shown in the official language in which it was submitted.**

The database was last updated on: 2012-01-10

**APPLICATION NUMBER:**

1524559

**REGISTRATION NUMBER:**

not registered

**STATUS:**

SEARCHED

**FILED:**

2011-04-20

**FORMALIZED:**

2011-04-28

**APPLICANT:**

9228-4330 Québec Inc.  
9600 Meilleur  
bureau 1050  
Montreal  
H2N 2E3  
QUEBEC

**AGENT:**

BLAKE, CASSELS & GRAYDON LLP  
INTELLECTUAL PROPERTY GROUP  
SUITE 4000, COMMERCE COURT WEST  
199 BAY STREET  
TORONTO  
ONTARIO M5L 1A9

**REPRESENTATIVE FOR SERVICE:**

BLAKE, CASSELS & GRAYDON LLP  
INTELLECTUAL PROPERTY GROUP  
SUITE 4000, COMMERCE COURT WEST  
199 BAY STREET  
TORONTO  
ONTARIO M5L 1A9

**TRADE-MARK:**

**PRIVÉ**

**INDEX HEADINGS:**

PRIVÉ

**SERVICES:**

(1) Online retail services, providing the public with the ability to view and purchase a variety of brand-named goods at discount prices, namely women's and men's fashion clothing, apparel, footwear, headwear, accessories, jewellery, houseware and electronics.

**CLAIMS:**

Used in CANADA since at least as early as January 07, 2011.

**Action Information**

<b><u>ACTION</u></b>	<b>DATE</b>	<b>BF</b>	<b>COMMENTS</b>
Filed	2011-04-20		
Created	2011-04-21		
Formalized	2011-04-28		
Search Recorded	2011-10-11		
Examiner's First Report	2011-10-17	2012-04-17	
Approval Notice Sent	2011-11-28	2011-12-26	

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Last updated: 2011-12-12