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Filing date: **02/05/2015**

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

Proceeding	91209687
Party	Defendant ABC-Clio, LLC
Correspondence Address	KURT KOENIG KOENIG & ASSOCIATES 920 GARDEN STREET SUITE A SANTA BARBARA, CA 93101 UNITED STATES Kurt@incip.com
Submission	Answer and Counterclaim
Filer's Name	Kurt Koenig
Filer's e-mail	Kurt@incip.com
Signature	/Kurt Koenig/
Date	02/05/2015
Attachments	Amended_Answer_CLIO.pdf(106115 bytes )

**Registrations Subject to the filing**

Registration No	2837926	Registration date	05/04/2004
Registrant	PROMETHEUS GLOBAL MEDIA, LLC 770 BROADWAY NEW YORK, NY 10003 UNITED STATES		
Grounds for filing	The registered mark has been abandoned. The registration was obtained fraudulently.		

**Goods/Services Subject to the filing**

Class 016. First Use: 2001/09/00 First Use In Commerce: 2001/09/00  
All goods and services in the class are requested, namely: PRINTED PUBLICATIONS IN THE NATURE OF BOOKS DIRECTED TO THE ADVERTISING INDUSTRY

Registration No	1134824	Registration date	05/06/1980
Registrant	PROMETHEUS GLOBAL MEDIA, LLC 770 BROADWAY NEW YORK, NY 10003 UNITED STATES		
Grounds for filing	The registered mark has been abandoned. The registration was obtained fraudulently.		

**Goods/Services Subject to the filing**

Class 041. First Use: 1963/06/01 First Use In Commerce: 1963/06/01  
All goods and services in the class are requested, namely: EDUCATIONAL AND ENTERTAINMENT SERVICES IN THE FIELDS OF ADVERTISING AND MARKETING COMMUNICATIONS-NAMELY, LIBRARY SERVICES, FILM PRODUCTION SERVICES AND CONDUCTING AWARDS CEREMONIES REWARDING EXCELLENCE IN THE PRODUCTION OF COMMERCIALS IN VARIOUS MEDIA



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

PROMETHEUS GLOBAL MEDIA, LLC,	)	
	)	
Opposer,	)	Opposition No. 91209687
	)	
v.	)	Mark: ABC-CLIO & DESIGN
	)	
ABC-CLIO, LLC,	)	Published: September 11, 2012
	)	
Applicant.	)	
	)	

**AMENDED ANSWER TO NOTICE OF OPPOSITION**  
**AND**  
**COUNTERCLAIM**

ABC-CLIO, LLC (“Applicant”), by its attorneys, hereby answers the allegations set forth in the Notice of Opposition filed by Prometheus Global Media, LLC (“Opposer”) on March 11, 2013 as follows:

1. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations of Paragraph 1 and, therefore, Applicant denies any and all allegations therein.
2. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations of Paragraph 2 and, therefore, Applicant denies any and all allegations therein.
3. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations of Paragraph 3 and, therefore, Applicant denies any and all allegations therein, except that Applicant admits that Exhibit A appears to be printouts from the USPTO online database.

4. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations of Paragraph 4 and, therefore, Applicant denies any and all allegations therein.

5. Admitted, except that the address listed is not a business address.

6. Admitted.

7. Admitted, that the date of first use of the ABC-CLIO mark together with the design element noted in the application is October 25, 2010.

8. Denied.

9. Denied.

10. Applicant repeats and incorporates by reference all prior responses and answers.

11. Denied.

12. Denied.

13. Denied.

14. Applicant repeats and incorporates by reference all prior responses and answers.

15. Denied.

16. Denied.

17. Denied.

18. Applicant is unable to understand the statement set forth in Paragraph 18 sufficient enough to form a belief or sufficient to truthfully admit or deny the allegations of Paragraph 18 and, therefore, Applicant denies any and all allegations therein.

19. Denied.

20. Denied.

21. Applicant repeats and incorporates by reference all prior responses and answers.

22. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations of Paragraph 22 and, therefore, Applicant denies any and all allegations therein.

23. Applicant is without knowledge or information sufficient to form a belief or sufficient to truthfully admit or deny the allegations of Paragraph 23 and, therefore, Applicant denies any and all allegations therein.

24. Denied.

25. Denied.

26. Denied.

#### **AFFIRMATIVE DEFENSES**

As and for separate affirmative defenses to Opposer's Notice of Opposition, Applicant states the following:

27. AS A FIRST AFFIRMATIVE DEFENSE, Opposer lacks standing because Opposer does not own U.S. Reg. No. 1134824.

28. AS A SECOND AFFIRMATIVE DEFENSE, Opposer lacks standing because Opposer does not own U.S. Reg. No. 2837926.

#### **COUNTERCLAIM FOR ABANDONMENT AND FRAUD**

1. Applicant-Counterclaimant, ABC-CLIO, LLC is a California LLC located at 130 Cremona Dr., Santa Barbara, CA 93117 ("ABC-CLIO").

2. Opposer-Counterdefendant, Prometheus Global Media, LLC, has alleged it is an LLC under the laws of Delaware, having an address at 770 Broadway, New York, NY 10003 ("Prometheus").

3. ABC-CLIO is the owner of Application Ser. No. 85582882 for ABC-CLIO & DESIGN in International Classes 9, 16, 35, and 42 for the goods and services noted therein ("882

Application”) and ABC-CLIO has extensive common law rights to the mark ABC-CLIO going back to at least as early as 1958.

4. On information and belief, Prometheus claims to be the owner of two federal trademark registrations for the mark CLIO (“Prometheus Mark”).

5. On information and belief, the mark CLIO is currently registered for goods listed as “Printed Publications in the Nature of Books directed to the Advertising Industry” and was issued U.S. Reg. No. 2837926 by the USPTO (“926 Registration”).

6. On information and belief, the mark CLIO is currently registered for goods listed as “Educational and Entertainment Services in the Fields of Advertising and Marketing Communications-Namely, Library Services, Film Production Services and Conducting Awards Ceremonies Rewarding Excellence in the Production of Commercials in Various Media” and was issued U.S. Reg. No. 1134824 by the USPTO (“824 Registration”).

7. On information and belief, Prometheus, or any predecessor-in-interest, was not using the Prometheus Mark for any of the goods identified in the application, that eventually matured into the 824 Registration, at the time of filing and has never used or has discontinued, without an intent to resume, any and all use of the Prometheus Mark for the goods listed in said application at the time of filing.

8. On information and belief, Prometheus, or any predecessor-in-interest, was not using the Prometheus Mark for any of the goods identified in the application, that eventually matured into the 926 Registration, at the time of filing and has never used or has discontinued, without an intent to resume, any and all use of the Prometheus Mark for the goods listed in said application at the time of filing.

9. On information and belief, Prometheus was not using the Prometheus Mark for all of the goods identified in each of the Section 8 Declarations filed for the 824 Registration and had never used or had discontinued, without an intent to resume, any and all use of the Prometheus Mark for some or all of the goods listed in the Section 8 Declaration at the time of filing the same.

10. On information and belief, Prometheus was not using the Prometheus Mark for all of the goods identified in each of the Section 8 Declarations that were filed for the 926 Registration and had never used or had discontinued, without an intent to resume, any and all use

of the Prometheus Mark for some or all of the goods listed in each Section 8 Declaration at the time of filing the same.

11. On information and belief, certain Section 8 Declarations that were filed for the 824 Registration were filed by the wrong party and the 824 Registration is therefore void.

12. On information and belief, certain Section 8 Declarations that were filed for the 926 Registration were filed by the wrong party and the 926 Registration is therefore void.

13. On information and belief, Prometheus has never used the Prometheus Mark for any of the goods listed in Application No. 73191144 that eventually matured into the 824 Registration.

14. On information and belief, Prometheus has never used the Prometheus Mark for any of the goods listed in Application No. 76470470 that eventually matured into the 926 Registration.

15. On information and belief, Prometheus has abandoned use of the Prometheus Mark, and therefore is no longer entitled to maintain its registration.

16. Prometheus non-use of the Prometheus Mark for more than three (3) consecutive years as a trademark is prima facie evidence of abandonment pursuant to Lanham Act 15 U.S.C. § 1127.

17. On information and belief, Prometheus does not use the Prometheus Mark for any goods or services.

18. On information and belief, Prometheus does not use any mark containing the word CLIO for any goods or services.

19. On information and belief, Prometheus is not the owner of the Prometheus Mark. ABC-CLIO reserves the right to add additional counterclaims in the event discovery reveals other information that provides an additional basis for cancellation. ABC-CLIO will be damaged if Prometheus is able to assert its registration for the '926 Registration and/or the 824 Registration against the 882 Application and ABC-CLIO requests that Prometheus '926 and 824 Registration be immediately cancelled and the Opposition filed by Prometheus be dismissed in

its entirety. ABC-CLIO has submitted the requisite filing fee in the amount of \$600 for the Counterclaim.

WHEREFORE, in view of the foregoing, Applicant contends this Opposition is groundless and baseless in fact; that Opposer has not shown it has any right to oppose the Mark owned by Applicant and Applicant prays that the Notice of Opposition be dismissed in its entirety.

Respectfully submitted,

Dated: February 5, 2015

By:

  
Kurt Koenig

KOENIG & ASSOCIATES  
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Santa Barbara, CA 93101  
Tel: 805-965-4400  
Email: Kurt@incip.com  
Attorneys for Applicant

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the foregoing “AMENDED ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM” was served on **February 5, 2015** by first-class mail, postage prepaid, to Opposer’s counsel addressed as follows:

Gene S. Winter  
Andy I. Corea  
Tatyana Voloshchuk  
St. Onge Steward Johnston & Reens LLC  
986 Bedford Street  
Stamford, CT 06905-5619

  
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Kurt Koenig

Dated: February 5, 2015

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**CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that this correspondence is being transmitted by electronic mail to the United States Patent and Trademark Office via ESTTA on the date identified below.

Dated: February 5, 2015

  
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Kurt Koenig

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