ESTTA Tracking number: **ESTTA647323**
Filing date: **12/29/2014**

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

Proceeding	91212231
Party	Defendant VENM, LLC
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Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	12/29/2014
Attachments	COS.pdf(378637 bytes) SAA.pdf(409796 bytes)

CERTIFICATE OF SERVICE

I, Konrad Sherinian, an attorney, hereby certify that on December 29, 2014, the listed documents were served on Opposer by delivering a true and correct copy thereof to the address of Opposer's Attorney by depositing the same with the United States Postal Service, postage pre-paid, via first class mail, addressed to:

Aaron Silverstein
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14 Cedar Street, Suite 224
Amesbury, MA 01913

SERVED DOCUMENTS

- Second Amended Answer
- Certificate of Service

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

DRAGON BLEU (SARL), Opposer, v. VENM, LLC, Applicant.	Opposition No. 91212231 Application Ser. No. 85848528

SECOND AMENDED ANSWER

Applicant, VENM, LLC ("VENM"), by and through its attorneys, hereby submits its Answer to the Notice of Opposition filed by Opposer Dragon Bleu (SARL) as follows, with the following numbered Paragraphs corresponding to the numbers of the Paragraphs of the Notice of Opposition under the headings used in the Notice of Opposition.

1. Admit.
2. Applicant does not possess sufficient information to determine the truth or falsity of this allegation, and accordingly, denies the same.
3. Applicant does not possess sufficient information to determine the truth or falsity of this allegation, and accordingly, denies the same.
4. Applicant does not possess sufficient information to determine the truth or falsity of this allegation, and accordingly, denies the same.
5. Deny.
6. Deny.
7. Deny.

8. Applicant admits that if the opposed registration is granted, Applicant would have the right to use the mark VENM. Applicant denies the remaining allegations of paragraph 8 of the Notice of Opposition.

Opposer's Claimed Damages

VENM, LLC is without knowledge as to Opposer's belief that it will be damaged by the registration of Applicant's mark upon the Principal Register. Applicant denies that Opposer shall suffer any damage whatsoever, and denies that Opposer is entitled to any relief.

AFFIRMATIVE DEFENSES

First Affirmative Defense – Failure to State a Claim

9. Opposer has failed to state a claim upon which the relief it seeks can be granted.

Second Affirmative Defense – Opposer's Weak Marks

10. Opposer's marks cannot be accorded the deference due a strong, inherently distinctive and/or arbitrary mark, because none of them are strong, inherently distinctive or arbitrary.

Third Affirmative Defense – Difference in Marks

11. With regards to Opposer's Registration No. 3896673, the claimed mark consists of the stylized wording "VENUM" under a design of a snake's head within a circle (hereinafter "VENUM AND DESIGN"). "VENUM" is written in a stylized font wherein the 'N' resembles a set of fangs. In addition, the mark VENUM AND DESIGN has a distinctive sound. Applicant's Mark is substantially different than Opposer's Mark, and is unlikely to be confused therewith. In particular, Applicant's mark is drawn in a non-stylized font and appears substantially different. In addition, Applicant's mark has its own distinctive sound.

12. With regards to Opposer's Registration No. 3927787, the claimed mark consists of the stylized wording "VENUM" under a design of a snake's head within a circle. "VENUM AND DESIGN" is written in a stylized font wherein the 'N' resembles a set of fangs. In addition, the mark VENUM AND DESIGN has a distinctive sound. Applicant's Mark is substantially different than Opposer's Mark, and is unlikely to be confused therewith. In particular, Applicant's mark is drawn in a non-stylized font and appears substantially different. In addition, Applicant's mark has its own distinctive sound.

13. With regards to Opposer's Registration No. 4017907, the claimed mark consists of the stylized wording "VENUM" under a design of a snake's head. "VENUM" is written in a stylized font wherein the 'N' resembles a set of fangs. In addition, the mark VENUM AND DESIGN has a distinctive sound. Applicant's Mark is substantially different than Opposer's Mark, and is unlikely to be confused therewith. In particular, Applicant's mark is drawn in a non-stylized font and appears substantially different. In addition, Applicant's mark has its own distinctive sound.

14. With regards to Opposer's Serial Number 79124129, the mark consists of the stylized wording "VENUM" under a design of a snake's head within a circle. "VENUM" is written in a stylized font wherein the 'N' resembles a set of fangs. In addition, the mark VENUM AND DESIGN has a distinctive sound. Applicant's Mark is substantially different than Opposer's Mark, and is unlikely to be confused therewith. In particular, Applicant's mark is drawn in a non-stylized font and appears substantially different. In addition, Applicant's mark has its own distinctive sound.

Fourth Affirmative Defense – Different Goods or Services

15. There is no likelihood of confusion, mistake or deception because, inter alia, Applicant's mark and the pleaded Opposer's marks are drawn to entirely different goods and/or services.

16. The challenged Application is directed to class 25, and specifically to dance costumes. Applicant VENM designs, manufactures, markets and sells high quality stylish dance wear.

17. VENM targets the dancing market, including the pole dancing market. Its products include Crop Tank Tops, Spring Training Dolman Tops, Polekini outfits, and Thigh High Stirrup Leg Warmers.

18. Opposer's Registration No. 3896673 is directed to classes 24 and 26.

19. With regards to class 24, Opposer claims to use the mark on "Fabrics, namely, fabrics made of cotton, microfiber, polyamide, acrylic; fabrics for textile use; velvet; bed linen; household linen; table linen not of paper; bath linen; except clothing."

20. With regards to class 26, Opposer claims to use the mark on "Lace and embroidery, ribbons and braid; buttons, hooks and eyes, ornamental novelty pins and needles; artificial flowers; false beards, hair or moustaches; lace trimmings; wigs; clothing fasteners, namely clothing hooks or clasps; hair ornaments."

21. Opposer's Registration No. 3927787 is directed to class 25. Opposer claims to use the mark on "Martial arts and boxing clothes, namely, martial arts uniforms, shorts, kimonos; Sport shoes, especially for the practice of martial arts."

22. Opposer's Registration No. 4017907 is directed to class 28. Opposer claims to use the mark on "Protective equipment for sports, namely, boxing gloves and gloves for randori,

shin guards, elbow guards, knee guards; protective padding for engaging in combat sports and martial arts."

23. Opposer's Serial Number 79124129 is directed to class 9. Opposer claims to use the mark on "Protective helmets for combat sports."

24. All of the goods and services to which Opposer's marks are directed are substantially different than the goods and services to which Applicant's mark is directed.

Fifth Affirmative Defense – Different Marketing Channels

25. On information and belief, Opposer's products are marketed through the website http://www.venumfight.com. This site appears to target the mixed martial arts market. There is no dancewear marketed on this website.

26. On information and belief, Opposer does not design, manufacture, market, or sell dance wear. Nor does Opposer market any of its products to consumers of dance wear.

27. Opposer has admitted that "[martial arts] goods are most commonly sold through specialized stores which cater exclusively to the fight sports and martial arts markets." Trademark Ser. No. 79063381, Request for Reconsideration after Final Action, Filed Oct. 22, 2010, at 5. Applicant does not sell its goods through specialized stores that cater to the fight sports and martial arts markets.

28. There is no likelihood of confusion, mistake or deception because Applicant's opposed mark and the pleaded Opposer's marks are used in entirely different marketing channels.

Sixth Affirmative Defense – Sophisticated Consumers

29. There is no likelihood of confusion, mistake or deception because Applicant's goods are marketed to sophisticated dancers that exercise a high degree of care in their purchasing decisions, and clearly understand the difference between Opposer's goods; i.e.; martial

art themed clothing and equipment, and Applicant's goods; i.e.; dance related costumes and equipment.

Seventh Affirmative Defense – Estoppel by Lack of Use and/or Abandonment

30. All of the marks asserted by Opposer were filed under Section 66(a) of the U.S. Trademark Act. As such, Opposer did not submit evidence of use of any of the asserted marks in the United States.

31. Opposer's Registration No. 3896673 is directed to classes 24 and 26.

32. With regards to class 24, Opposer claims to use the mark on "Fabrics, namely, fabrics made of cotton, microfiber, polyamide, acrylic; fabrics for textile use; velvet; bed linen; household linen; table linen not of paper; bath linen; except clothing."

33. With regards to class 26, Opposer claims to use the mark on "Lace and embroidery, ribbons and braid; buttons, hooks and eyes, ornamental novelty pins and needles; artificial flowers; false beards, hair or moustaches; lace trimmings; wigs; clothing fasteners, namely clothing hooks or clasps; hair ornaments."

34. On information and belief, Opposer does not use the mark VENUM AND DESIGN on each and every product and/or service for which it registered the asserted mark, and is accordingly estopped from asserting Registration No. 3896673. For example, and without limitation, Applicant's investigation did not uncover use of the mark VENUM AND DESIGN on bed linen, household linen, table linen, ribbons and braids, ornamental novelty pins and needles, artificial flowers, false beards, hairs or moustaches, lace trimmings, wigs, clothing hooks or clasps, and hair ornaments. Accordingly, this mark was either never used or is now abandoned, and Opposer is estopped from its assertion.

Eighth Affirmative Defense – Estoppel by Statements Made to Secure Registration

35. During prosecution of Reg. No. 3927787, Opposer sought registration of the mark VENUM AND DESIGN in International Class 25. This registration was initially rejected by an Office Action dated April 22, 2010 as likely causing confusion with Reg. No. 3,676,523, which is directed to the mark "VENOM" for use in connection with "Ski and snowboard wear, namely jackets, pants, insulated jackets, insulated pants, one piece insulated suits, fleece tops, fleece jackets, sweaters, fleece pants, shirts, t-shirts, gloves, hats, caps, hoods, mittens, sweatshirts, waterproof and water repellant jackets and pants" in International Class 25.

36. In Opposer's response, filed on October 22, 2010, Opposer argued that "both marks are specifically and narrowly directed to clothing used in connection with the entirely unrelated sports of skiing and martial arts respectively […]" Opposer then went on to admit that the "cited mark coexists with a number of registered VENOM-formative marks for other sporting goods […]," and that "the VENOM mark itself is widely used in the sporting goods industry, and is registered by different parties in connection with the sports of baseball, cycling, billiards, and sport shooting."

37. Opposer goes on to admit that martial arts goods are not likely to be confused with any other type of sporting goods by consumers in the marketplace. In particular, Opposer argues that "[s]port is a very broad category that encompasses many different types of activities that speak to widely varied interests […]," and that the traditional likelihood of confusion analysis simply does not apply to different types of specialty markets.

38. Opposer also admitted that martial arts goods are most commonly sold through specialty retailers. For example, Opposer argued that "[martial arts] goods are most commonly

sold through specialized stores which cater exclusively to the fight sports and martial arts markets." (emphasis added).

39. Given these admissions, Opposer is estopped from asserting that Applicant's mark "VENM," which seeks registration in International Class 25 for "dance costumes" could cause confusion with Opposer's mark "VENUM," which is restricted exclusively to martial arts related products.

COUNTERCLAIM

Abandonment

40. Applicant incorporates by reference all of its responses to Opposer's allegations in paragraphs 1-8, and its affirmative representations in paragraphs 9-39.

41. Applicant is the owner of pending Trademark App. Ser. No. 85848528, which is directed to the mark "VENM." It has been filed in international class 25 for dance costumes.

42. Opposer's Registration No. 3,896,673 was registered under Section 66(a). This registration is not incontestable as it has been registered for less than five years and accordingly can be challenged for any grounds recited in 15 U.S.C. § 1064.

43. Opposer's Registration No. 3,896,673 is for VENUM AND DESIGN for goods in International Classes 24 and 26.

44. Opposer's Registration No. 3,896,673 was filed in the United States Trademark Office on on November 24, 2008, claiming priority of International Registration No. 0988214. It was published for opposition October 12, 2010, and registered on December 28, 2010.

45. In its Class 24 application for registration via an extension under the Madrid Protocol, Opposer declared that it uses its VENUM AND DESIGN mark on "Fabrics, namely, fabrics made of cotton, microfiber, polyamide, acrylic; fabrics for textile use; velvet; bed

linen; household linen; table linen not of paper; bath linen; except clothing." (emphasis added).

46. In its Class 26 application for registration via an extension under the Madrid protocol, Opposer declared that it uses its VENUM AND DESIGN mark on "Lace and embroidery, ribbons and braid; buttons, hooks and eyes, ornamental novelty pins and needles; artificial flowers; false beards, hair or moustaches; lace trimmings; wigs; clothing fasteners, namely clothing hooks or clasps; hair ornaments."

47. During prosecution of Registration No. 3896673, Opposer did not submit any evidence of use of its VENUM AND DESIGN mark on any of the aforelisted goods in Classes 24 and 26 during prosecution of the asserted registration.

48. Opposer's current website, www.venumfight.com displays and lists for sale various clothing, bags and gear utilizing the VENUM ND DESIGN mark, but does not display any of the fabrics listed in its Class 24 application listing of goods. The "clothing" offered for sale on this website was specifically excepted from the Class 24 registration, so Opposer is unable to claim that such website constitutes either actual or technical use of its VENUM AND DESIGN mark on its listing of goods in Class 24..

49. The website www.venumfight.com also does not display or offer for sale any of the goods listed in its Class 26 application. Opposer cannot claim that its website constitutes technical use of its VENUM AND DESIGN mark on its listing of goods in Class 26.

50. Inasmuch as its own website does not offer for sale any of the listed goods in Classes 24 and 26, Opposer cannot claim that it has used its VENUM AND DESIGN mark on any of its goods listed in Classes 24 and 26.

51. On information and belief, Opposer has not used VENUM AND DESIGN on any of the goods that it listed with regards to Registration No. 3896673 in classes 24 and 26 for more than three years, which constitutes *prima facie* evidence of abandonment.

52. On information and belief, it has been more than four years since VENUM AND DESIGN was registered for the goods that are listed for Registration No. 3896673, and Opposer has not made any qualifying use of VENUM AND DESIGN with regards to the listed goods. Therefore, on information and belief, it is likely that Opposer never intends to use VENUM AND DESIGN on these goods.

53. On information and belief, Opposer has abandoned VENUM AND DESIGN with respect to Registration No. 3896673 in its entirety, and never intends to use (or resume use of) VENUM AND DESIGN on the goods listed for Registration No. 3896673.

54. Accordingly, Opposer's Registration No. 3896673 should be canceled in its entirety.

55. Opposer's Registration No. 3,927,787 was also registered under Section 66(a). This registration is not incontestable as it has been registered for less than five years and accordingly can be challenged for any grounds recited in Section 14 (15 U.S.C. 1064).

56. Opposer's Registration No. 3,927,787 is for VENUM AND DESIGN for goods in International Class 25.

57. Opposer's Registration No. 3,927,787 was filed in the United States Trademark Office on on November 24, 2008, claiming priority of International Registration No. 0988214. It was registered on March 8, 2011.

58. In its Class 25 application for registration via an extension under the Madrid Protocol, Opposer declared that it uses its VENUM AND DESIGN mark on "Martial arts and box-

ing clothes, namely martial arts uniforms, shorts, kimonos; Sport shoes, especially for the practice of martials arts."

59. During prosecution of Registration No. 3,927,787, Opposer did not submit any evidence of use of its VENUM AND DESIGN mark on "kimonos" or "sport shoes, especially for the practice of martial arts".

60. Opposer's current website, www.venumfight.com displays and lists for sale various clothing, bags and gear utilizing the VENUM AND DESIGN mark, but does not display any kimonos or sport shoes, especially for the practice of martial arts. Accordingly, Opposer is unable to claim that its website constitutes either actual or technical use, of its VENUM AND DESIGN mark on fabrics.

61. Opposer's website does display and offer for sale "sandals", but such sandals are traditional beach shoes in the nature of "flip-flops."

62. Inasmuch as its own website does not display and offer for sale any kimonos or sport shoes for use in martial arts in Class 25, Opposer cannot claim that it has used its VENUM AND DESIGN mark on these two specific goods.

63. On information and belief, Opposer has not used VENUM AND DESIGN on any of the goods that it listed with regards to Registration No. 3927787 in class 25 for more than three years since it was registered, which constitutes *prima facie* evidence of abandonment.

64. Given that it has been more than four years since VENUM AND DESIGN was registered for the goods that are listed for Registration No. 3927787, and Opposer has not made any qualifying use of VENUM AND DESIGN with regards to the listed goods, it is likely that Opposer never intends to use VENUM AND DESIGN on these goods.

65. On information and belief, Opposer has abandoned VENUM AND DESIGN with respect to Registration No. 3927787 with regards to kimonos and sport shoes for use in martial arts, and never intends to use (or resume use of) VENUM AND DESIGN on these goods.

66. On information and belief, Opposer has abandoned VENUM AND DESIGN with respect to Registration No. 3927787 with regards to kimonos and sport shoes for use in martial arts.

67. Accordingly, Opposer's Registartion No. 3927787 should be canceled with regards to kimonos and sport shoes for use in martial arts.

68. Accordingly, Opposer has abandoned its trademark rights for its VENUM AND DESIGN mark on these goods. Section 66 does not eliminate the use requirement for a registrant under it. Accordingly, U.S. Trademark Reg. No. 3,896,673 should be cancelled in its entirety and U.S. Trademark Reg. No. 3,927,787 should be cancelled for kimonos and sport shoes for use in martial arts.

FEE

69. Applicant previously filed the statutory fee for its counterclaim.

ADDITIONAL DEFENSES AND COUNTERCLAIMS

70. Applicant hereby reserves the right to assert additional defenses and/or counterclaims based on information learned or obtained during discovery.

WHEREFORE, Applicant prays for judgment as follows:

(a) this opposition be dismissed with prejudice;

(b) for the cancellation of U.S. Trademark Reg. Nos. 3896673 in its entirety and 3927787 with regards to kimonos and sports shoes for use in martial arts;

(c) that Registration for Applicant's trademark application Serial Number 85848528 is issued to Applicant.

Respectfully submitted,

VENM, LLC

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