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

Proceeding	91213445
Party	Defendant LUMINARA WORLDWIDE, LLC
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Attachments	Luminara Response.pdf(172738 bytes )

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*Luminara Worldwide LLC*

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

In re the matter of:

Trademark Application Serial No.: 85/123625  
For the Mark: LUMINARA

Malgor & Co, Inc.,

Opposer

v.

Luminara Worldwide LLC,

Applicant

Proceeding No.: 91213445

**ANSWER**

**ANSWER TO NOTICE OF OPPOSITION**

Applicant, Luminara Worldwide, LLC (“Applicant”), hereby submits its Answer to the Notice of Opposition (“Opposition”) filed by Opposer Malgor & Co, Inc. (“Opposer”) on November 12, 2013 as follows:

1. Applicant is without sufficient knowledge or information to admit or deny the allegations contained in Paragraph 1 of the Opposition and on that basis denies the allegations therein.

2. Applicant is without sufficient knowledge or information to admit or deny the allegations contained in Paragraph 2 of the Opposition and on that basis denies the allegations therein.

3. Applicant is without sufficient knowledge or information to admit or deny the allegations contained in Paragraph 3 of the Opposition and on that basis denies the allegations therein.

4. Applicant is without sufficient knowledge or information to admit or deny the allegations contained in Paragraph 4 of the Opposition and on that basis denies the allegations therein.

5. Applicant admits that Opposer is listed as the owner of record for USPTO Application No. 76/705841 as alleged in Paragraph 5 of the Opposition; however, Applicant is without sufficient or information to admit or deny the remaining allegations contained in Paragraph 6 of the Opposition and on that basis denies the remaining allegations therein.

6. Applicant denies the allegations contained in Paragraph 6 of the Opposition.

7. Applicant denies the allegations contained in Paragraph 7 of the Opposition.

8. Applicant denies the allegations contained in Paragraph 8 of the Opposition.

9. Applicant denies the allegations contained in Paragraph 9 of the Opposition.

10. Applicant denies the allegations contained in Paragraph 10 of the Opposition.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense**

##### ***Genericness***

1. Opposer is not entitled to the relief sought because Opposer's mark "Luminaria" ("Opposer's Mark") and/or a component of Opposer's Mark upon which the Opposition is based, is a generic term for Opposer's goods. Therefore, Opposer has no valid trademark rights on which to base its Opposition to Applicant's mark.

#### **Second Affirmative Defense**

##### ***Descriptiveness***

2. Opposer is not entitled to the relief sought because Opposer's Mark and/or a component of Opposer's Mark upon which the Opposition is based, is a descriptive term for

Opposer's goods. Therefore, Opposer has no valid trademark rights on which to base its Opposition to Applicant's mark.

**Third Affirmative Defense**

*Fair Use*

3. Opposer is not entitled to the relief sought because Opposer's Mark and/or a component of Opposer's Mark upon which the Opposition is based, is a descriptive term for at least some of Applicant's goods. Therefore, Applicant asserts that the Opposition and its claim(s) for relief therein are barred by the doctrine of fair use.

**Fourth Affirmative Defense**

*Priority*

4. Upon information and belief, Applicant asserts that it has priority of use in its mark in the United States, and therefore the Opposition and its claim(s) for relief therein are barred.

**Fifth Affirmative Defense**

*Waiver*

5. Applicant asserts that Opposer has waived any claims against Applicant arising out of the matters alleged in the Opposition.

**Sixth Affirmative Defense**

*Estoppel*

6. Applicant asserts that Opposer is estopped from asserting any claims against Applicant arising out of the matters alleged in the Opposition.

**Seventh Affirmative Defense**

*Acquiescence*

7. Applicant asserts that the Opposition and its claim(s) for relief therein are barred by the doctrine of acquiescence.

**Eighth Affirmative Defense**

*Laches*

8. Applicant asserts that the Opposition and its claim(s) for relief therein are barred by the doctrine of laches.

**Ninth Affirmative Defense**

*Other Affirmative Defenses*

9. Applicant intends to rely on any additional affirmative defenses that become available or apparent during discovery and thus reserves the right to amend its answer to assert such additional affirmative defense.

**WHEREFORE**, Applicant believes that Opposer will not be damaged by registration of Applicant's mark, and prays that the Trademark Trial and Appeal Board dismiss with prejudice the Opposition and that the Trademark Office issue a Notice of Allowance for Applicant's application for LUMINARA.

Respectfully submitted,

Date: December 20, 2013

/s/ Ryan S. Dean

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