

ESTTA Tracking number: **ESTTA616523**

Filing date: **07/18/2014**

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

Proceeding	91214376
Party	Defendant Isaac Daniel Group, Inc.
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Date	07/18/2014
Attachments	Answer_to_Opposition_7_18_2014.pdf(106853 bytes )

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

SOCIAL CODE, LLC,	)	Opposition No.: <b>91214376</b>
Opposer,	)	
	)	
v.	)	Mark: <b>SOCIAL CODE MOBILE</b>
	)	Serial No.: <b>85/761,507</b>
ISAAC DANIEL GROUP, INC.	)	Filed: <b>October 23, 2012</b>
Applicant.	)	
	)	
	)	
	)	
	)	

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**ANSWER TO NOTICE OF OPPOSITION**

Applicant Isaac Daniel Group, Inc., a Delaware corporation, by and through its undersigned attorney, hereby files its Answer to SOCIAL CODE, LLC’s (“Opposer”) Notice of Opposition, respectfully showing as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in Paragraph 1 of the Notice of Opposition. Since Applicant lacks knowledge to either admit or deny the allegations stated therein, Applicant therefore denies the same.
2. Denied, as Applicant is without knowledge or information sufficient to form a belief as to Opposer’s allegation of the prior first use for the claimed mark and trade name.
3. Denied, as Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in Paragraph 3 of the Notice of Opposition, specifically whether Opposer has acquired valuable rights and goodwill in and for the trade name and mark for the listed services.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in Paragraph 4 of the Notice of Opposition, specifically whether

Opposer is the current, correct and proper owner of the claimed trademark registration. Since Applicant lacks knowledge to either admit or deny the allegations stated therein, Applicant therefore denies the same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in Paragraph 5 of the Notice of Opposition, specifically whether the claimed registration is currently valid and subsisting. Since Applicant lacks knowledge to either admit or deny the allegations stated therein, Applicant therefore denies the same.

6. Admitted.

7. Admitted.

8. Applicant re-alleges and incorporates by reference its prior responses to paragraphs 1 through 7 as though fully stated herein.

9. Denied, as Applicant is without knowledge or information sufficient to form a belief as to Opposer's date of the prior first use for the claimed mark and trade name.

10. Denied.

11. Denied, as Applicant's mark speaks for itself, without incorporating Opposer's trade name and/or mark.

12. Denied.

13. Applicant admits in part that the term MOBILE has been disclaimed by Applicant, but further denies the remaining allegations of Paragraph 13 of the Notice of Opposition.

14. Denied.

15. Admitted.

16. Denied.

17. Denied.

18. Denied as Applicant's mark and Opposer's mark are not likely to cause confusion, mistake or deception to consumers as to the source of the services.

19. Denied.

20. Applicant hereby denies any and all allegations that have not been specifically denied.

**WHEREFORE**, Applicant prays that the Notice of Opposition and all claims and causes of action asserted against Applicant be dismissed with prejudice and that the Trademark Trial and Appeal Board ("TTAB") grant such other and further relief as the TTAB deems just and proper.

### **AFFIRMATIVE DEFENSES**

#### **FIRST AFFIRMATIVE DEFENSE (Estoppel)**

A. On October 12, 2010 Opposer filed a trademark application for the "SOCIAL CODE" mark for "advertising agency services, namely, creating advertisements and managing advertising campaigns for brand advertisers on social networking websites" in International Class 35 before the United States Patent and Trademark Office ("USPTO").

B. During prosecution of Opposer's "SOCIAL CODE" trademark application, the U.S. Registration No. 3,246,221 ("the '221 Registration") for the mark "CODE" was cited against Opposer's mark as a bar to its registerability. The '221 registration covers the mark "CODE" as registered for use with "educational services, namely, providing sales training in the field of improving advertising, promotional, and marketing processes," in International Class 41 and "advertising and promotion consulting services; marketing consulting services in the field of business development," in International Class 35.

C. In support of its argument for registration, Opposer argued that its application should be allowed to proceed over a likelihood of confusion rejection with the mark “CODE” in “educational services, namely, providing sales training in the field of improving advertising, promotional, and marketing processes,” in International Class 41 because “the services at issue are not so related or similar that consumers are likely to believe that . . . [Opposer’s] services emanate from Registrant.” *See* Opposer’s Response to Office Action dated February 28, 2011.

D. Opposer also represented to the USPTO that “the services at issue are not so related or similar that consumers are likely to believe that . . . [Opposer’s] services emanate from Registrant.” *Id.*

E. Opposer further opined that “[b]ecause . . . [its] advertising services directed to online networking applications are so different than the enterprise improvement and business development services associated with Registered mark, and the services at issue travel through dissimilar channels of trade to differing business consumers, . . . confusion as to source between its SOCIAL CODE mark and the [registered] CODE mark . . . is unlikely.” *Id.*

F. In support of its argument for registration [for the identical class of services in International Class 35), Opposer cited 15 third-party CODE-formative issued registrations in International Class 35 for marks containing the term “Code”, for use with advertising, marketing, and other business consulting services.

G. Opposer relied on those 15 prior registrations to argue that **“the relevant consumer is capable of distinguishing among numerous CODE-formative marks for business consulting and advertising services emanating from multiple unrelated sources,** and that the scope of protection afforded to any single CODE-formative mark, including the CODE mark of the cited registration, is not overly broad. Indeed, . . . **for the same reason that**

**the CODE-formative marks . . . are able to co-exist on the Register** with the CODE mark of the cited registration for the same or similar services **without a likelihood of confusion as to source, so too can . . . [Opposer’s] SOCIAL CODE mark.”** *Id.* (*emphasis added*).

H. Opposer’s trademark application was allowed to proceed to registration.

I. In direct contradiction to its previous position before the USPTO, Opposer now asserts that Applicant’s “SOCIAL CODE” mark for use with distinctly different services, i.e. “on-line social networking services,” in International Class 45, versus “advertising services” in International Class 35 allegedly offered by Opposer, where the services travel through dissimilar channels of trade to differing business consumers should be denied registration because of a likelihood of confusion with Opposer’s “SOCIAL CODE” registration.

J. Based on the equitable doctrine of estoppel, Opposer is therefore barred from taking this contradictory, inconsistent position.

#### **SECOND AFFIRMATIVE DEFENSE**

K. Opposer is engaged in trademark misuse in attempting to monopolize the market beyond the boundaries of any purported trademark rights they may have, if any.

#### **THIRD AFFIRMATIVE DEFENSE**

L. Opposer lacks standing to bring this Opposition as Opposer is not the registered owner of the marks upon which Opposer bases its claim of priority use, and demands strict proof thereof. Opposer further lacks standing as Opposer cannot and will not be damaged by the registration of the subject Mark.

#### **FOURTH AFFIRMATIVE DEFENSE**

M. The Notice of Opposition fails to state a claim upon which relief may be granted.

**FIFTH AFFIRMATIVE DEFENSE**

N. Opposer is denied a priority claim to the Cited Registration, i.e. Registration No. 85/036,881 and demands strict proof thereof.

**SIXTH AFFIRMATIVE DEFENSE**

O. Opposer's mark is invalid and contestable.

**SEVENTH AFFIRMATIVE DEFENSE**

P. Applicant reserves the right to assert additional defenses as may be appropriate upon completion of its investigation and discovery.

**WHEREFORE**, Applicant prays that the TTAB deny the Opposition and permit registration of Applicant's proposed mark in Application Serial Number 85/761,507.

Dated: July 18, 2014.

Respectfully submitted,

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/Carol Green/  
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**CERTIFICATE OF SERVICE**

I, Carol N. Green, hereby certify that on July 18, 2014, a true and correct copy of the foregoing document was filed through the electronic filing system of the U.S. Patent and Trademark Office, Trademark Trial and Appeal Board, and served by email to: [tm@skgf.com](mailto:tm@skgf.com), [tdurkin@skgf.com](mailto:tdurkin@skgf.com) and [jshirk@skgf.com](mailto:jshirk@skgf.com), and by first class mail to:

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