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

Proceeding	91215038
Party	Defendant Kiaico, Inc.
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Submission	Answer
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Date	03/25/2014
Attachments	Answer and Affirmative Defenses 91215038.pdf(36611 bytes)

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

Opposition Proceeding 91215038

In the matter of Trademark Application No. 85904663

For the mark: MARSHAL A.R.T.

Publication Date: Aug. 27, 2013

Marshall Amplification PLC

v.

KIAICO, Inc.

ANSWER

The Applicant, KIAICO, Inc., a Delaware corporation with offices located at, 445 Park Avenue, New York, N.Y., United States, hereby submits its answer with affirmative defenses to the Notice of Opposition filed by the Opposer, Marshall Amplification, a United Kingdom corporation with a mailing address of, Denbigh Road, Bletchley, Milton Keynes Buckinghamshire, United Kingdom, responds as follows to the numbered paragraphs of the Notice of Opposition herein.

1. Applicant admits the allegations of paragraph 1, notably that Applicant's mark has been used by Applicant in commerce in the US for 23 years.

2. Applicant admits that the application was published for opposition on August 27, 2013 but denies that the Extension of Time was granted until February 23, 2013.
<http://ttabvue.uspto.gov/ttabvue/v?pno=85904324> identifies that the extension was granted until February 26, 2013.
3. Applicant denies that the application and registrations listed by Opposer have any priority or relevance to this proceeding. Applicant denies that the registrations are valid.
4. Applicant denies that Opposer is famous for clothing, the goods involved in this proceeding. Applicant denies that Opposer is famous in any regard outside of the channels of trade for guitar amplifiers. Applicant denies that 'M' or 'Marshall' points uniquely and directly to Opposer for clothing. Applicant denies that Opposer has priority for using 'Marshall' clothing in the US and notes that no first use dates are alleged in the Notice of Opposition nor are any first use dates alleged in the applications which are based on 44(e) filings.
5. Denied. On affirmative and belief, Marshallamps.com, the official web site, only sells products in the UK and all prices are in £. (See <http://shop.marshallamps.com/p/beanie-hat> and <http://shop.marshallamps.com/p/movember-t-shirt-in-black-grey> for examples.)
6. Denied. Applicant denies that 'M' or 'Marshall' points uniquely and directly to Opposer for clothing. Opposer has been repeatedly denied registration for 'Marshall' for clothing because of other registrants with priority.

7. Denied. Opposer's registrations and application are only evidence of Opposer's foreign trademarks not evidence of any actual use in the US nor evidence of any bona fide intent to use in the US.
8. Applicant lacks sufficient knowledge and information to form a belief as to the truth of the allegations of this paragraph, and therefore denies same.
9. Denied. Opposer's registrations and application are only evidence of Opposer's foreign trademarks not evidence of any actual use in the US.
10. Denied.
11. Denied.
12. Denied.
13. Denied.
14. Denied.
15. Denied.
16. Denied.
17. Denied.
18. Denied.

AMPLIFICATIONS AND AFFIRMATIVE DEFENSES

1. MARSHALL as used by Opposer consists of matter that is primarily merely a surname under §2(e)(4) of the Trademark Act and is not an inherently distinctive mark and is not entitled to a broad or even ordinary scope of protection under the law. See *Chase Federal Savings and Loan Assoc. v. Chase Manhattan Financial Services, Inc.*, 681 F.Supp. 771, 788 (S.D.Fla. 1987). [W]here a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958).
 - a. Marshall is listed in the top 150 (#147) most common surnames in the US Census for 2000 making it a prima facie weak mark.
 - b. Applicant's Marshal is not a surname and would not be viewed as a surname. Marshall without the double 'L' is not even in the top 1000 names making it not primarily a surname and deserving more protection under trademark law.
 - c. Any acquired distinctiveness or fame if it exists belongs to MARSHALL AMPLIFICATION for Marshall amplifiers and not for collateral clothing.
 - d. Marshall as a standalone mark for clothing does not point to Opposer, it points to Marshall's (the clothing stores) whose registrations 1066952, 1978509, 2094505, 2161385, 2495278, 2697650, 2720765, 2872828, 2996344, 3062008, 3065910

and 3084265 were used to refute Opposer's claims in their attempt to register 'Marshall' without the 'Amplification.'

2. There is no likelihood of confusion because Marshall is commonly used by others for clothing and because Applicant and Opposer's mark have a different overall impression. "The consumer's overall impression of the mark determines whether two differing marks are similar. . . . But as McCarthy explains: "If the common element of conflicting marks is a word that is 'weak' then this reduces the likelihood of confusion. A portion of a mark may be 'weak' in the sense that such portion is descriptive, highly suggestive, or is in common use by many other sellers in the market." *Ziebart International Corp. v. Z Tech Rustproofing, Car Care, & Accessories, LLC* (TTAB 2009).
3. Opposer's ornamental use is weak. Opposer's use of 'M' and "MARSHALL AMPLIFICATION" are ornamental and do not function as a trademark for Opposer for clothing making it a weak mark and not deserving of ordinary or broad protection under trademark law.
4. Opposer's marks, especially those for clothing ('M' (SN 86093877) and MARSHALL AMPLIFICATION (RN 3940239)) and are not substantially similar to Applicant's MARSHAL A.R.T. for purposes of fame for Section 2(a) False Suggestion of a Connection or dilution under Section 43(a). Applicant maintains an objection to these claims.
5. Applicant is at least entitled to a registration with a restriction in the description for goods limiting the clothing to **Character Brand** Clothing , namely, shirts, T-shirts, sweatshirts, sweat pants, sweat suits, pants, skirts, shorts, sarongs, vests, boxer shorts, underwear, jackets, coats, rain wear, pullovers, sweaters, jumpers, overalls, rompers,

infant wear, socks, shoes, slippers, halloween and masquerade costumes, promotional mascot character costumes, sleep wear, robes, hats, caps, bandanas, headbands, gloves, mufflers, scarves, swim wear, beach cover ups.

6. Applicant has been selling clothing under its mark in the US for 23 years and is entitled to registration. The absence of any known incident of actual confusion in an extensive period of contemporaneous use of the marks is strong evidence that confusion is not likely to occur in the future. See *In re American Management Associations*, 218 USPQ 477, 478 (TTAB 1983).
7. Opposer has never used or has abandoned its marks for many types of clothing depriving it of common law rights.

Submitted By: /MRKIAI/

Date: March 25, 2014

Dan Healy, CEO KIAICO Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer has been served on John A. Clifford by mailing said copy on March 25, 2014, via First Class Mail, postage prepaid to:

John A. Clifford, Esq.
Merchant & Gould, P.C.
P.O. Box 2910
Minneapolis, MN 55402-0910

By: /MRKIAL/

Date: March 25, 2014

Dan Healy, CEO KIAICO Inc.