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

Proceeding	91216445
Party	Defendant Black Card LLC
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Date	06/27/2014
Attachments	Answer to Consolidated Opposition.pdf(402887 bytes)

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

AMERICAN EXPRESS MARKETING &
DEVELOPMENT CORP.,

OPPOSER,

v.

BLACK CARD LLC,

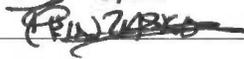
APPLICANT.

OPPOSITION NO.: 91216445

APPLICATION NO.: 86/025,189
MARK: MADE OF STAINLESS STEEL

APPLICATION NO.: 86/017,446
MARK: HEAVY METAL

I hereby certify that this Answer to Opposition is being electronically
filed with the Trademark Trial and Appeal Board through its ESTTA
filing system on 6/27, 2014.



ANSWER TO CONSOLIDATED NOTICE OF OPPOSITION

Black Card LLC (“Applicant”) hereby answers the Consolidated Notice of Opposition (“Notice”) filed by American Express Marketing & Development Corp. (“Opposer”) against Application Serial Nos. 86/025,189 and 86/017,446 filed by Applicant to register the marks MADE OF STAINLESS STEEL and HEAVY METAL (collectively, the “Marks”), respectively, by specifically responding to the numbered paragraphs thereof as follows:

1. Applicant admits that the services offered in connection with the Marks are associated with its VISA BLACK CARD, a card that is stiff and heavy and noticeably different from plastic credit cards. Applicant denies the remaining allegation asserted in Paragraph 1.
2. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 2 and accordingly denies the allegations therein.
3. Applicant admits that AMEX has licensed Applicant to use AMEX’s registered service mark BLACKCARD (Reg. No. 3,613,898). Applicant denies the remaining allegations asserted in Paragraph 3.

4. Applicant denies all allegations asserted in Paragraph 4.

5. Applicant denies the allegation that the mark MADE OF STAINLESS STEEL sought to be registered in Application Serial No. 85/025,189 is descriptive on its face. Applicant is without knowledge or information sufficient to form a belief as to the remaining allegations in Paragraph 5, and accordingly denies such allegations. In addition, such remaining allegations are irrelevant since Application Serial No. 85/025,189 does not identify any products/goods made of stainless steel.

6. Applicant states that the allegations in Paragraph 6 do not require a response, and otherwise notes that as often as it requires a disclaimer the U.S. Patent and Trademark Office does not require a disclaimer. Applicant affirmatively denies any suggestion, express or implied, in Paragraph 6 that the mark MADE OF STAINLESS STEEL describes an ingredient, quality, characteristic, function, feature, purpose or use of the financial services recited in Application Serial No. 85/025,189.

7. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 7, and accordingly denies such allegations. Applicant denies any allegation, express or implied, in Paragraph 7 that Application Serial No. 85/025,189 identifies any goods, including any physical payment or credit card; rather, it recites specific financial services in connection with the mark MADE OF STAINLESS STEEL.

8. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 8, and accordingly denies such allegations. The allegations in Paragraph 8 are irrelevant since Application Serial No. 85/025,189 does not identify a physical payment or credit card, but rather recites specific financial services.

9. Applicant admits that it has sought registration of the mark MADE OF STAINLESS STEEL under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b). Applicant states that the remainder of Paragraph 9 does not require a response.

10. Applicant denies all allegations asserted in Paragraph 10.

11. Applicant admits to various uses of the mark MADE OF STAINLESS STEEL on its website. The allegations in Paragraph 11 are irrelevant since Application Serial No. 85/025,189 does not identify a physical payment or credit card, but rather recites specific financial services. Applicant denies the remaining allegations asserted in Paragraph 11.

12. Applicant denies all allegations asserted in Paragraph 12.

13. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 13; however, Applicant admits that there are various items referenced in Paragraph 13 that are included as exhibits but are not evidence of any third-party use, or of use of the term “heavy metal” in connection with the services recited in Application Serial No. 86/017,446. Applicant denies any allegation, express or implied, in Paragraph 13 that Application Serial No. 86/017,446 identifies any goods, including any physical payment or credit card; rather, it recites specific financial services in connection with the mark HEAVY METAL.

14. Applicant admits that it has sought registration of the mark HEAVY METAL under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b). Applicant states that the remainder of Paragraph 14 does not require a response.

15. Applicant denies all allegations asserted in Paragraph 15.

16. Applicant states that registration of the Marks that are the subject of Application Serial Nos. 85/025,189 and 86/017,446 would not prohibit fair use permitted under Section 33(b)

(4) of the Lanham Act; therefore, such registrations would not prohibit Opposer from accurately describing its cards with terms used solely for descriptive purposes and not otherwise as trademarks. Application notes that Application Serial Nos. 85/025,189 and 86/017,446 do not identify a physical payment or credit card, but rather recite specific financial services. Applicant denies the remaining allegations asserted in Paragraph 16.

17. Applicant denies all allegations asserted in Paragraph 17.

18. Applicant denies all allegations asserted in Paragraph 18.

19. Applicant denies all allegations asserted in Paragraph 19.

20. Applicant denies all allegations asserted in Paragraph 20.

Except as set forth herein, all other paragraphs and all other allegations contained in the Notice are denied.

AFFIRMATIVE DEFENSES

In further answer to the Notice, Applicant alleges the following affirmative defenses. There may be additional affirmative defenses to the claims alleged by Opposer that are currently unknown to Applicant. Therefore, Applicant reserves the right to amend its Answer to allege additional affirmative defenses in the event discovery of additional information indicates that they are appropriate.

FIRST AFFIRMATIVE DEFENSE

21. Opposer has failed to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

22. Various paragraphs of the Consolidated Notice of Opposition do not comply with Rule 8(c) of the Federal Rules of Civil Procedure as adopted by the Trademark Rules of Practice,

which require a “short and plain statement” of the claims showing Opposer is entitled to relief, and 37 C.F.R. §2.104(a) and T.B.M.P §312.03, which require a “short and plain statement” of the reasons why Opposer believes it would be damaged by registration of the mark(s) at issue. As such, Applicant is not required to separately admit or deny each of the allegations contained therein.

WHEREFORE, Applicant respectfully prays that:

1. Opposer’s Consolidated Notice of Opposition be dismissed and that judgment be entered in Applicant’s favor on all claims; and
2. Such other and further relief as the Board deems just and proper.

This 21st day of June, 2014.

Respectfully submitted,

TROUTMAN SANDERS LLP

By: 
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MARK: HEAVY METAL

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing ANSWER TO CONSOLIDATED NOTICE OF OPPOSITION was sent by first class mail, postage prepaid to Attorney for Opposer American Express Marketing & Development Corp. as follows:

David H. Bernstein
Debevoise & Plimpton, LLP
919 Third Avenue
New York, New York 10022

This 27 day of June, 2014.



Maria I. Briskorn