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

Proceeding	91217562
Party	Defendant Jennifer Zvitco
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No.: 86/061,950  
Mark: UNCLE SAM'S MISGUIDED CHILDREN  
Published for Opposition in the Official Gazette: January 28, 2014

UNCLE SAM GmbH	)	
	)	
Opposer,	)	Opposition No. 91217562
	)	Serial No. 86061950
	)	
v.	)	
	)	
JENNIFER ZVITCO	)	
	)	
Applicant	)	

**APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO THE  
MOTION TO DISMISS FIRST AMENDED NOTICE OF OPPOSITION**

Applicant Jennifer Zvitco's (hereinafter "Uncle Sam's Misguided Children"), by and through counsel, hereby submits this Reply to Opposer Uncle Sam GmbH's (hereinafter "Uncle Sam Germany" or "USG") Opposition to Applicant's Motion to Dismiss the Amended Complaint. The Motion was filed October 17, 2014 and Opposition on November 4, 2014.

**ARGUMENT**

- I. The Board can dispose of this matter immediately because, as a matter of law, "Uncle Sam" is not capable of *exclusive* protection by USG under the *Durable Toy* case.**

Tellingly, USG has failed to mention or address the case of *Durable Toy & Novelty Co. v. J. Chein & Co.*, 133 F.2d 853 (2d. Cir. 1943), which forms the primary basis for the Motion to Dismiss. *See also Mother's Restaurants Inc. v. Mother's Bakery, Inc.*, 498 F. Supp. 847 (W.D.N.Y. 1980) (agreeing with *Durable Toy*, and expanding it from "Uncle Sam" to other

widely used terms such as “Mother’s”). By neglecting to address or oppose the *Durable Toy* arguments, USG has again conceded that this case applies and controls.

The Board is empowered – indeed, required – to dismiss USG’s Amended Notice of Opposition because USG **has no right to the relief requested**. The *Durable Toy* case makes clear that a company using the character, image, or phrase “Uncle Sam” as a mark “cannot deprive others of the same commercial advantage which led it originally to adopt a legend so commonly employed.” *Id.* at 855. USG cannot deprive Uncle Sam’s Misguided Children from exploiting Uncle Sam, and thus its Opposition is a nullity. The Board can decide upon the facts pled that USG has no *legal* right to oppose Uncle Sam’s Misguided Children’s application to use the same figure of national mythology (in a starkly different way, to be sure).

USG’s suggestion that Uncle Sam’s Misguided Children should assert these matters in a “counterclaim for cancellation” is an utter red herring, and would needlessly and exponentially increase the costs for this proceeding. The Board need not decide *any* matter related to the need to cancel USG’s registration, but instead is entitled to conclude that under *Durable Toy*, Uncle Sam’s Misguided Children may proceed with registration of its mark when the only alleged basis of opposition is a likelihood of confusion with a national character widely used. USG has no standing to oppose Uncle Sam’s Misguided Children from registering its own trademark, and has no right to exclude Uncle Sam’s Misguided Children from exploiting the national character of Uncle Sam.

**II. None of Opposer’s remaining points suggests any further entitlement to relief.**

- A. **Amendment** - While Uncle Sam’s Misguided Children does not contest that amendments to pleadings should be liberally granted, the Board need not grant the motion for leave as it is both (1) futile, and (2) was put forth only in order to cause delay by changing just a few words. Only on November 4, 2014 – almost two months after Uncle Sam’s Misguided Children filed its Motion to Dismiss – did USG finally respond to any of the

substance of the Motion to Dismiss. The Amendment was not made to correct material defects that addressed the *Durable Toy* case, but meant to give Opposer additional time to file a responsive brief to the original Motion to Dismiss.

- B. **Factual Development Unnecessary** – USG claims that “factual development” is necessary. Under the *Durable Toy* rationale, no factual development is necessary, as there is no circumstance under which USG could prevent Uncle Sam’s Misguided Children from using the name “Uncle Sam.” There are no facts to be developed which could result in the success of the Amended Notice of Opposition.
- C. **Irrelevant Arguments** – USG’s description of “Uncle Sam’s Misguided Children” as a “backronym” to USMC (Opp. at n. 3) is completely irrelevant to the Amended Notice of Opposition, as USG has no standing to oppose the mark on these grounds.
- D. **Concession of Lack of Claim** – USG concedes that it has no “false suggestion of connection” claim, despite pleading such claim in the text of its Notice of Opposition and Amended Notice of Opposition. This leaves only the “likelihood of confusion” claim, which fails under *Durable Toy*, as the adoption of the Uncle Sam character as a company mark is *per se* not capable of exclusive protection.

### **CONCLUSION**

WHEREFORE, Jennifer Zvitco, by and through undersigned counsel and for the reasons stated above, respectfully requests that this board dismiss Opposer’s First Amended Notice of Opposition with prejudice.

Dated: November 24, 2014

Respectfully submitted,

**POSEY LEBOWITZ PLLC**

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**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing document was served upon counsel for applicant this 24<sup>th</sup> day of November, 2014, by mailing a copy thereof via first-class mail, postage prepaid, to:

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