

ESTTA Tracking number: **ESTTA625559**

Filing date: **09/05/2014**

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

Proceeding	91217625
Party	Defendant COHEN, ELLIOT H
Correspondence Address	COHEN, ELLIOT H 189 BELLAFONTE CT CAMARILLO, CA 93012-7744 elco4321@gmail.com;elco4321@yahoo.com
Submission	Answer
Filer's Name	Daniel S. Latter
Filer's e-mail	dan@marqueelaw.com
Signature	/Daniel S. Latter/
Date	09/05/2014
Attachments	Elliot Cohen Answer.pdf(1075229 bytes)

1 Daniel S. Latter, Esq. (SBN 99848)
2 MARQUEE LAW GROUP, A Professional Corporation
3 9100 Wilshire Boulevard, Suite 445 East Tower
4 Beverly Hills, California 90212
5 dan@marqueelaw.com
6 (310) 275-1844 telephone
7 (310) 275-1801 fax

8 Attorneys for Applicant, Elliot Cohen

9
10 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
11 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

12 BIG FRONT DOOR, LLC,) Opposition No.: 86224809
13)
14)
15)
16)
17)
18)
19)
20)
21)
22)
23)
24)
25)
26)
27)
28)
vs.)
ELLIOT H. COHEN,)
Applicant.)

Elliot Cohen ("Applicant"), the owner of and applicant named in intent-to-use application (i) Serial No. 86224809 for the mark "BFD", filed on March 18, 2014 and published for opposition on July 29, 2014, for restaurants in International Class 043, by and through his undersigned counsel, files this Answer to the Notice of Opposition ("Opposition") filed by opposer, Big Front Door, LLC ("Opposer") on July 30, 2014, and pleads as follows:

ANSWER TO NOTICE OF OPPOSITION

In response to the introductory unnumbered paragraph of the Opposition, Applicant admits that the mark "BFD" is the subject of application Serial No. 86224809; denies that Opposer will be damaged by registration of Applicant's mark as set forth in his application; and states that he is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of the first, unnumbered paragraph. Applicant responds to the separately numbered paragraphs of the Opposition as follows:

1 1. In response to the allegations in paragraph 1 of the Opposition, Applicant admits
2 the allegations set forth therein, adding that to the best of Applicant's knowledge, Applicant's
3 application with Serial No. 86224809 was filed earlier on March 18, 2014 than the Opposer's
4 application with Serial No. 86224960, noting further that Applicant's application has a lower
5 number than Opposer's application as referred in this paragraph 1.
6

7 2. Applicant admits the allegations in paragraph 2 of the Opposition.

8 3. Applicant denies that the submission by Opposer comports with the requirements
9 of 37 CFR Section 2.122(d) as the submitted material by Opposer was not for registrations of
10 Opposer's marks, but rather for pending applications.
11

12 4. Applicant admits the allegations in paragraph 4 of the Opposition.

13 5. Applicant admits the allegations in paragraph 5 of the Opposition.

14 6. Applicant admits the allegations in paragraph 6 of the Opposition.

15 7. Applicant admits the allegations in paragraph 7 of the Opposition.

16 8. Applicant admits the allegations in paragraph 8 of the Opposition.
17

18 9. In response to the allegations in paragraph 9 of the Opposition, Applicant is
19 without knowledge or information sufficient to form a belief as to the truth of each and every
20 statement or allegation contained therein.
21

22 10. In response to the allegations in paragraph 10 of the Opposition, Applicant is
23 without knowledge or information sufficient to form a belief as to the truth of each and every
24 statement or allegation contained therein.
25

26 11. In response to the allegations in paragraph 11 of the Opposition, Applicant is
27 without knowledge or information sufficient to form a belief as to the truth of each and every
28 statement or allegation contained therein; provided however, that Applicant denies that Opposer

1 has made use of either or both of the marks set forth in application Serial Nos. 86224960 and
2 86225653 prior to Applicant's constructive use of the mark set forth in his application, Serial No.
3 86224809.

4 12. Applicant admits the allegations in paragraph 12 of the Opposition.

5 13. Applicant admits the allegations in paragraph 13 of the Opposition.

6 14. Applicant admits the allegations in paragraph 14 of the Opposition.

7 15. In response to the allegations in paragraph 15 of the Opposition, Applicant denies
8 each and every allegation contained therein.

9 16. In response to the allegations in paragraph 16 of the Opposition, Applicant is
10 without knowledge or information sufficient to form a belief as to the truth of each and every
11 statement or allegation contained therein.

12 17. In response to the allegations in paragraph 17 of the Opposition, Applicant denies
13 each and every allegation contained therein.

14 18. In response to the allegations in paragraph 18 of the Opposition, Applicant denies
15 each and every allegation contained therein. Applicant denies that Opposer will be damaged by
16 registration of Applicant's mark, denies that Opposer's marks have priority over Applicant's
17 mark, and denies that Applicant's application for registration of Applicant's mark should be
18 denied.

19
20
21
22 FIRST DEFENSE

23 19. As to Applicant's First Defense, Opposer has not pleaded any law or facts that
24 justify a refusal to register Applicant's application, and consequently, Opposer has failed to state
25 a claim upon which relief can be granted.
26
27
28

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

SECOND DEFENSE

20. As to Applicant's Second Defense, Opposer has improperly filed a Notice of Opposition and instead, should have filed a Notice of Concurrent Use Proceeding as, at most, Opposer has made prior use at common law of the mark or marks in a limited area in Southern California, although Applicant does not admit such use by Opposer pursuant hereto. Notwithstanding the preceding sentence, Applicant denies that Opposer has prior use of either of its marks and maintains that Applicant's application evidencing constructive use has priority over Opposer's alleged use of the marks set forth in its referenced applications.

THIRD DEFENSE

21. As to Applicant's Third Defense, Opposer has failed to establish that Applicant's mark "consists of or comprises a mark that so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive." (*quoting* 15 U.S.C.A. § 1052).

22. Opposer has failed to establish that Opposer used a mark or trade name in the United States that is likely to cause confusion, mistake, or to deceive the public as to an association with Applicant's mark because Opposer's alleged uses of the names and/or marks "BFD Big Front Door" and "BFD" do not qualify as uses granting common law or federal law rights and protections in said names.

23. Alternatively, Opposer has failed to establish that Opposer used a mark or trade name in the United States that is likely to cause confusion, mistake, or to deceive the public as to an association with Applicant's mark because the services used in connection with the parties' respective marks are distinctively different to preclude any finding that consumers would believe

1 that the services associated with Applicant's mark would fall within the normal fields of
2 expansion for Opposer's alleged goods and/or services.

3 24. The Trademark Examining Attorney assigned to Applicant's application,
4 concluded, on July 29, 2014, that there were no similar registered or pending marks, including
5 Opposer's marks, that would bar registration of Applicant's mark. Accordingly, Opposer has
6 failed to establish that Applicant's mark is likely to cause confusion, mistake, or to deceive the
7 public as to an association with Opposer's marks.
8

9 FOURTH DEFENSE

10 25. Opposer has failed to establish that Applicant's mark would falsely suggest a
11 connection between Opposer and Applicant as Applicant's mark is distinctively different than
12 the alleged uses claimed by Opposer.
13

14 FIFTH DEFENSE

15 26. Applicant respectfully requests that Opposer's Opposition be denied in that the
16 appropriate proceeding, if any, would be a Concurrent Use Proceeding based on the allegations
17 set forth in the Opposition.
18

19 SIXTH DEFENSE

20 27. Applicant reserves the right to rely on such other and further defenses as may be
21 supported by facts to be determined through full and complete discovery and to amend its
22 Answer to assert such defenses.
23

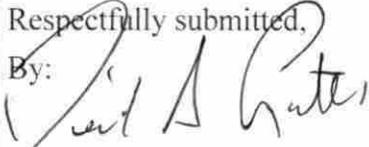
24 **WHEREFORE**, Applicant respectfully requests that this Opposition be denied and/or
25 dismissed with prejudice, that the registration of Applicant's mark, as applied for in application
26 Serial No. 86224809 be issued, and that Applicant be granted such other and further relief as the
27
28

1 Board deems just and proper.

2 Dated: September 5, 2014

3 Respectfully submitted,

4 By:

5 

6 Daniel S. Latter

7 Marquee Law Group, APC

8 9100 Wilshire Boulevard

9 Suite 445 East Tower

10 Beverly Hills, CA 90212

11 Telephone: 310.275.1844

12 Attorneys for Applicant and Defendant, Elliot Cohen

13

14

15

16

17

18

19

20

21

22

23

24

25

26

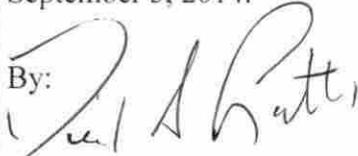
27

28

CERTIFICATE OF ELECTRONIC MAILING

I hereby certify that the foregoing Answer to the Notice of Opposition is being submitted electronically through the Trademark Trial and Appeal Board's ESTTA System on this September 5, 2014.

By:



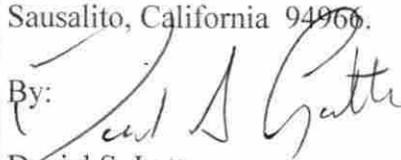
Daniel S. Latter

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on September 5, 2014, I caused a true and correct copy of the foregoing Answer to be sent via First-Class Mail, postage prepaid, to Opposer's Attorneys of Record, Drew M. Smith and Gabrielle A. Holley, Holley & Menker, PA, P.O. Box 1219, Sausalito, California 94966.

By:


Daniel S. Latter