

ESTTA Tracking number: **ESTTA772855**

Filing date: **09/26/2016**

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

Proceeding	91218001
Party	Defendant Mycoskie, LLC
Correspondence Address	LOUIS S EDERER ARNOLD & PORTER LLP 399 PARK AVE NEW YORK, NY 10022 UNITED STATES trademarkdocketing@aporter.com, louis.ederer@aporter.com, laura.tejeda@aporter.com, elisabeth.richards@aporter.com, mat- thew.salzmann@aporter.com
Submission	Answer
Filer's Name	Louis S. Ederer
Filer's e-mail	trademarkdocketing@aporter.com, louis.ederer@aporter.com, laura.tejeda@aporter.com, elisabeth.richards@aporter.com, Ben- jamin.Wolverton@aporter.com
Signature	/Louis S. Ederer/
Date	09/26/2016
Attachments	TOMS TODS - Answer - Amended.pdf(26324 bytes)

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

In the Matter of Application Serial No. 86/004,044
Published in the *Official Gazette* on April 29, 2014
For the Mark: TOMS

In the Matter of Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344
Registered: February 14, 2012; August 21, 2012; April 2, 2013; October 1, 2013
For the mark: TOMS

-----	x	
TOD’S S.P.A.,	:	
	:	
<i>Opposer/Petitioner,</i>	:	Opposition No.: 91218001 (parent)
	:	Cancellation No.: 92061234 (child)
v.	:	
	:	
MYCOSKIE, LLC,	:	
	:	
<i>Applicant/Respondent.</i>	:	
-----	x	

ANSWER TO AMENDED COMBINED NOTICE OF OPPOSITION AND
CONSOLIDATED CANCELLATION PETITION

Applicant/Respondent Mycoskie, LLC (“Mycoskie”), by and through its undersigned counsel, hereby answers the Amended Combined Notice of Opposition and Consolidated Cancellation Petition (the “Amended Combined Notice”) filed by Tod’s S.p.A. (“Tod’s”) against (1) Mycoskie’s application to register the word mark TOMS, identified in Application Serial No. 86/004044 (the “Mycoskie Application”) in International Class 18; and (2) Mycoskie’s registrations of the word mark TOMS, bearing U.S. Registration Nos. 4,097,948; 4,192,925; 4,313,981; 4,410,344 (collectively, the “Mycoskie Registrations”) (together with the Mycoskie Application, the “Mycoskie TOMS Marks”) in International Classes 9, 25 and 35, respectively, as follows:

1. Mycoskie is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1, and accordingly denies such allegations.

2. Mycoskie is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2, and accordingly denies such allegations.

3. Mycoskie is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3, and accordingly denies such allegations.

4. Mycoskie is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4, and accordingly denies such allegations.

5. Mycoskie admits the allegations in Paragraph 5.

6. Mycoskie admits the allegations in Paragraph 6.

7. Mycoskie admits the allegations in Paragraph 7.

8. Mycoskie admits the allegations in Paragraph 8.

9. Mycoskie admits the allegations in Paragraph 9.

10. Mycoskie denies the allegations in Paragraph 10.

11. Mycoskie denies the allegations in Paragraph 11.

12. Mycoskie denies the allegations in Paragraph 12.

13. Mycoskie denies the allegations in Paragraph 13. In addition, Mycoskie states that at the time it filed the Mycoskie Application, it had a bona fide intent to use the TOMS word mark on all products set forth in Paragraph 10 of the Amended Combined Notice. Mycoskie further states that the phrase “has no concrete plans of any kind to use the products set forth in Paragraph 10” is not comprehensible, and therefore not capable of being responded to.

14. Mycoskie denies the allegations in Paragraph 14.

15. Mycoskie denies the allegations in Paragraph 15.

16. Mycoskie denies the allegations in Paragraph 16. Mycoskie further states, on information and belief, that Tod's intended to refer to itself, rather than "Applicant/Respondent", as the party allegedly "being injured".

FACTS COMMON TO ALL AFFIRMATIVE DEFENSES

1. Mycoskie is the proprietor of the well-known TOMS brand for footwear, eyewear, apparel, and other related products and services. The TOMS word mark has been continuously in use in the United States since May 2006.

2. Mycoskie owns the following federal trademark registrations and/or pending applications for the TOMS word mark for various goods and services (collectively, the "TOMS Word Marks"):

International Class and Goods/Services	Reg. No./ Serial No.
25 (Canvas shoes, Shoes)	Reg. No. 3,353,902 Reg. Date: 12/11/07 Status: Incontestable as of 11/30/13
25 (Clothing, namely, canvas shoes, shoes, caps, shirts, t-shirts and hats)	Reg. No. 3,566,093 Reg. Date: 1/20/2009 Status: Incontestable as of 4/1/14
25 (Clothing, namely, hoods, jerseys, tops and jackets)	Reg. No. 3,662,112 Reg. Date: 7/28/09 Status: Incontestable as of 9/30/2014
25 (Clothing, namely, one piece garments for infants and babies)	Reg. No. 4,097,948 Reg. Date: 2/14/2012
9 (Sunglasses and cases for sunglasses)	Reg. No. 4,192,925 Reg. Date: 8/21/2012

International Class and Goods/Services	Reg. No./ Serial No.
9 (Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefore)	Reg. No. 4,313,981 Reg. Date: 4/2/2013
35 (On-line retail store services featuring footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters; Retail store services featuring footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters)	Reg. No. 4,410,344 Reg. Date: 10/1/2013
30 (Coffee and coffee-based beverages; and artificial coffee)	Reg. No. 4,602,798 Reg. Date: 9/9/14
30 (Tea; cocoa)	Ser. No. 85/965,239 App. Date: 1/20/13 Status: Notice of Allowance issued on 7/24/2014
18 (Goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key bags, key cases, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; valises; suitcases; tote bags; travelling bags; garment bags for travel; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; wheeled shopping bags and purses; jewelry pouches; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags; collars for pets; and leashes for animals)	Ser. No. 86/004,044 App. Date: 7/8/2013

3. Mycoskie also owns the following applications and registrations for the mark

TOMS and Design () (collectively, the “TOMS and Design Marks”), including applications and registrations in Classes 9, 18, 25 and 35 for the same or similar goods as the Mycoskie Application and the Mycoskie Registrations:

Mark	International Class and Goods/Services	Reg. No./ Serial No.
	25 (Baseball caps; Caps; Hat; Canvas shoes; Footwear for men and women; Shoes; and shirts)	Reg. No. 3,765,503 Reg. Date: 3/23/2010 Status: Incontestable as of 5/16/2015
	35 (Retail store services and on-line retail store services in the field of footwear, apparel, eyewear, jewelry, books, journals, and gift packs consisting of DVDs and posters)	Reg. No. 4,274,178 Reg. Date: 1/15/2013
	9 (Eyewear, namely, sunglasses, eyeglasses and ophthalmic frames and cases therefore)	Reg. No. 4,517,359 Reg. Date: 4/22/2014
	43 (Charitable services, namely, providing safe drinking water to those in developing countries)	Reg. No. 4,403,205 Reg. Date: 9/17/2013
	30 (Coffee and coffee-based beverages; and artificial coffee)	Reg. No. 4,602,814 Reg. Date: 9/9/14
	18 (Goods made of leather or imitations of leather, namely, card wallets, clutch bags, clutch purses, cosmetic bags sold empty, cosmetic cases sold empty, key wallets, and luggage; bags, namely, all-purpose carrying bags, all-purpose athletic bags, and backpacks; trunks; tote bags; travelling bags; rucksacks; satchels; holdalls; handbags; shoulder bags; canvas shopping bags; purses; wallets; credit card holders of leather and imitations of leather; pochettes; luggage label holders and tags)	Reg. No. 4,805,580 Reg. Date: 9/1/2015
	18 (Goods made of leather or imitations of leather, namely, key bags and key cases; valises; suitcases; garment bags for travel; wheeled shopping bags; jewelry pouches; collars for pets; and leashes for animals)	Reg. No. 5,032,218 Reg. Date: 8/30/2016
	21 (Cups, mugs, insulated coffee and beverage cups, and beverage glassware; thermal insulated bottles; portable bottles)	Reg. No. 4,827,152 Reg. Date: 10/6/2015

Mark	International Class and Goods/Services	Reg. No./ Serial No.
	sold empty; insulating sleeves for beverage cups; paper and plastic cups”	
	25 (Clothing, namely, hats, caps, sweatshirts, sweatpants, and shirts; and footwear)	Ser. No. 86/764,429 App. Date: 12/10/2014 Status: Pending
	30 (Tea; cocoa)	Ser. No. 85/965,247 App. Date: 6/20/2013 Status: Notice of Allowance issued on 1/28/2014

4. Tod’s has never filed any opposition or cancellation proceeding against any of the TOMS Word Marks or the TOMS and Design Marks referenced in Paragraphs 2 and 3 above, other than the Mycoskie Application and the Mycoskie Registrations, and all such marks have either registered, or are awaiting registration. Further, Tod’s did not file its Notice of Opposition to the Mycoskie Application until August 25, 2014, and did not file its Petition for Cancellation of the Mycoskie Registrations until April 8, 2015.

5. Since at least as early as May 2006, identical and/or related goods and services bearing the TOMS Word Marks and the TOD’S mark have coexisted in the United States marketplace — frequently being sold in the same retail locations, including, without limitation, the Nordstrom and Neiman Marcus department store chains — without any known instances of actual confusion, or any indication whatsoever that confusion is likely.

6. On August 25, 2014, Tod’s filed a Notice of Opposition against the Mycoskie Application. At that time, all of the Mycoskie Registrations that became the subject of Tod’s Petition for Cancellation were subsisting. Yet, without explanation, Tod’s did not file its Petition for Cancellation until nearly eight months later, on April 8, 2015. Further, between the time

Tod's filed its Notice of Opposition and its Petition for Cancellation, the TOMS word mark bearing U.S. Reg. No. 3,662,112 obtained incontestability status.

AFFIRMATIVE DEFENSES

7. The Amended Combined Notice fails to state a claim upon which relief can be granted.

8. Tod's is barred from any relief because there is no likelihood of confusion between the Mycoskie TOMS Marks and the TOD'S marks on which the Amended Combined Notice is based. Further, Tod's does not own any U.S. registrations for the TOD'S word mark itself, and, upon information and belief, does not use TOD's as a word mark on many, if not the majority of the products it offers for sale in commerce.

9. Tod's is barred from any relief because Mycoskie owns prior incontestable and other registrations for the same mark in connection with essentially the same goods and/or services as the Mycoskie TOMS Marks.

10. Tod's is barred from any relief under the doctrine of estoppel.

11. Tod's is barred from any relief under the doctrine of waiver.

12. Tod's is barred from any relief under the doctrine of laches. In fact, Tod's only filed its Petition for Cancellation in response to Mycoskie's allegation, in its Answer to Tod's Notice of Opposition (filed on September 14, 2014), that "[Tod's] has never filed any opposition or cancellation proceedings against any of the TOMS Marks."

13. Tod's is barred from any relief under the doctrine of acquiescence.

14. Tod's is barred from any relief under the doctrine of unclean hands.

PRAYER FOR RELIEF

WHEREFORE, Mycoskie respectfully prays that the Board dismiss the Amended Combined Notice of Opposition and Consolidated Cancellation Petition in its entirety.

Dated: September 26, 2016

Respectfully submitted,

ARNOLD & PORTER LLP

By: /Louis S. Ederer/

Louis S. Ederer
399 Park Avenue
New York, New York 10022
Telephone: (212) 715-1000
Facsimile: (212) 715-1399
louis.ederer@aporter.com
trademarkdocketing@aporter.com

*Attorneys for Applicant/Respondent Mycoskie,
LLC*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 26, 2016, a copy of the foregoing ANSWER TO AMENDED COMBINED NOTICE OF OPPOSITION AND CONSOLIDATED CANCELLATION PROCEEDING was served by First Class Mail upon the following counsel of record for Opposer/Petitioner Tod's S.p.A.:

Richard S. Mandel, Esq.
Lindsay M. Rodman, Esq.
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799

Attorneys for Opposer/Petitioner Tod's S.p.A.

/Louis S. Ederer/
Louis S. Ederer