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

Proceeding	91218800
Party	Defendant Matosantos Commercial Corp.
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Date	05/26/2016
Attachments	Answer to Amended Opposition.pdf(130498 bytes)

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

KIMBERLY-CLARK WORLDWIDE,
INC.

Opposer

v.

MATOSANTOS COMMERCIAL
CORP.

Applicant

Opposition No. 91218800

Serial No. 85/901,644

Mark: TENDER PUFF BATHROOM TISSUE
and Design

Filing Date: April 11, 2013

Publication Date: April 15, 2014

ANSWER TO AMENDED NOTICE OF OPPOSITION

Applicant, Matosantos Commercial Corp., (“Matosantos” or “Applicant”), respectfully submits its Answer to Amended Notice of Opposition (“Amended Opposition”) filed by Kimberly-Clark Worldwide, Inc. (“Kimberly-Clark” or “Opposer”) in the above referenced matter. Applicant denies any averments not expressly admitted and responds to the Opposition as follows:

In response to the opening un-numbered paragraph of the Opposition, Applicant admits upon information supplied by Opposer and belief, that Kimberly-Clark is a Delaware corporation, with its principal place of business at 2300 Winchester Road, Neenah, Wisconsin, 54956. Applicant denies that Kimberly-Clark is or will be damaged by the registration of the mark shown in Application Serial No. 85/901,644 filed on April 11, 2013 in International Class 16, for toilet paper.

In response to the numbered paragraphs of the Opposition, Applicant states as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 1 of the Amended Opposition, and therefore denies the same.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 2 of the Amended Opposition, and therefore denies the same.
3. Applicant denies the allegations in Paragraph 3 of the Amended Opposition as drafted. Applicant admits that Kimberly-Clark appears in the U.S. Patent and Trademark Office database as the owner of record of the trademark Design, U.S. Registration No.: 4,656,343 (hereinafter "Opposer's mark").
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 4 of the Amended Opposition, and therefore denies the same.
5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 5 of the Amended Opposition, and therefore denies the same.
6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 6 of the Amended Opposition, and therefore denies the same.
7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 7 of the Amended Opposition, and therefore denies the same.

8. Applicant denies the allegations set forth in paragraph 8 of the Amended Opposition, as drafted. Furthermore, Applicant avers that the design element of Applicant's mark is:



9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 9 of the Amended Opposition, and therefore denies the same.

10. Applicant denies the allegations set forth in paragraph 10 of the Amended Opposition, as drafted, since Applicant began using Applicant's mark before Opposer began using trademark U.S. Registration No. 4,656,343, which is the only trademark that is part of this Amended Opposition. However, Applicant admits that it began using Applicant's mark in February 7, 2013.

11. The allegations made in paragraph 11 of the Opposition are legal conclusions and therefore, do not require a response from Applicant. To the extent a response is needed, Applicant denies the allegations made in paragraph 11.

12. Applicant admits the allegations made in the first sentence of paragraph 12 of the Amended Opposition. Applicant denies the rest of the allegations set forth in paragraph 12 of the Amended Opposition.

13. Applicant denies the allegations set forth in paragraph 13 of the Amended Opposition. Furthermore, Applicant avers that Applicant's mark does not

resemble Opposer's registered trademark, U.S. Registration No. 4,656,343, as to cause confusion, mistake, or deceive with respect to the source of Applicant's goods.

14. Applicant admits that the registration of Applicant's mark would constitute prima facie evidence of Applicant's exclusive right to use Applicant's Mark in connection with Applicant's goods. However, Applicant denies the rest of the allegations set forth in paragraph 14 of the Amended Opposition.

15. Applicant denies the allegations set forth in paragraph 15 of the Amended Opposition.

16. Applicant denies the allegations set forth in paragraph 16 of the Amended Opposition.

In response to the Prayer for Relief, Applicant denies that Opposer is entitled to any form of relief.

AFFIRMATIVE DEFENSES

In further answer to the Notice of Opposition, Applicant asserts that:

1. The Opposition fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the Opposition.
2. Applicant's mark in U.S. Application Serial No. 85/901,644 for **TENDER PUFF BATHROOM TISSUE and design** is inherently distinctive and thus, registrable and protectable under Trademark Law.
3. Applicant has prior use over Opposer's trademark U.S. Registration No. 4,656,343, and therefore, Applicant has superior and prior rights over the puppy design part of Applicant's trademark, Serial No. 85/901,644.

4. Applicant's mark **TENDER PUFF BATHROOM TISSUE and design**, when applied to the goods identified in the Application Serial No. 85/901,644, is not likely to cause confusion, mistake or deception with Opposer's trademarks.
5. Applicant's mark in U.S. Application Serial No. 85/901,644 for **TENDER PUFF BATHROOM TISSUE and design** will not cause any harm or damage to Opposer.
6. As alleged by Opposer in its Amended Opposition, Opposer has used a "puppy design" in various poses and positions, and therefore the alleged "puppy design" is highly diluted as a trademark formative, and hence, weak, and has caused Opposer to lose any exclusive rights over the purported puppy design.
7. Applicant's mark, when analyzed as a whole, is sufficiently distinctively different from Opposer's marks as to avoid confusion, deception or mistake of the source of sponsorship or association of Opposer's goods.
8. Applicant's use of its mark will not mistakenly be thought by the public to derive from the same source as Opposer's goods, nor will such use be thought by the public to be a use by Opposer or with Opposer's authorization or approval.
9. Applicant's mark, when used on Applicant's goods, is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Applicant with Opposer, or as to the origin, sponsorship, or approval of Applicant's goods by Opposer.
10. The trademarks at issue contain different literal elements.
11. The trademarks at issue contain different designs.
12. Opposer is not entitled to maintain its Opposition by reason of estoppel.

13. Opposer is not entitled to maintain its Opposition by reason of laches.
14. The Opposition is barred by the equitable doctrine of waiver.
15. Opposer has brought this Opposition for improper purposes and with unclean hands.
16. There is no evidence of actual confusion between Opposer's marks and Applicant's mark.
17. Opposer is illegally expanding the scope of its alleged trademark protection.
18. Opposer maliciously filed the instant action in an attempt to monopolize or restrain trade and in order to harass a legitimate competitor.

Applicant reserves the right to amend or include additional affirmative defenses as the proceedings in this case, particularly as the discovery of evidence, progress.

WHEREFORE, in light of the foregoing, Applicant contends that this Amended Opposition is groundless and baseless in fact; that Opposer has not shown wherein it will be, or is likely to be, damaged by the registration of Applicant's trademark; that Applicant's trademark is manifestly distinct from any alleged mark of the Opposer or any designation of the Opposer; and Applicant prays that this Opposition be dismissed with prejudice and that Applicant be granted registration of its trademark **TENDER PUFF BATHROOM TISSUE and design**, U.S. Application Serial No. 85/901,644.

RESPECTFULLY SUBMITTED

On this 27th of May, 2016.



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CERTIFICATE OF SERVICE

It is hereby certified that the foregoing "Answer to Amended Notice of Opposition" was served by first class mail, postage prepaid, upon the Opposer's representative: Jennifer E. Hoekel, Armstrong Teasdale LLP, 7700 Forsyth Boulevard, Suite 1800, Saint Louis, MO 63105

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