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

Proceeding	91219312
Party	Defendant Karen Millen
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Date	09/14/2015
Attachments	Answer to Notice of Opposition - KARENX.pdf(15023 bytes)

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

In the Matter of Application Serial No. 86/246052
Filed: April 8, 2014
Published in the *Official Gazette* on October 14, 2014
For the mark: KARENX

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KAREN MILLEN FASHIONS LTD.,	:	
<i>Opposer,</i>	:	OPPOSITION NO.: 91219312
v.	:	
KAREN MILLEN,	:	
<i>Applicant.</i>	:	
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ANSWER TO NOTICE OF OPPOSITION

Applicant Karen Millen (“Applicant”), by and through her undersigned counsel, hereby answers the Notice of Opposition filed by Karen Millen Fashions Ltd. (“Opposer”) against Applicant’s application to register the word mark KARENX, identified in Application Serial No. 86/246052 in International Classes 3, 4, 8, 9, 14, 18, 20, 24, 25, and 35 as follows:

1. Applicant admits the allegations in Paragraph 1.
2. Applicant admits the allegations in Paragraph 2.
3. In response to the allegations in Paragraph 3, Applicant states that she is a fashion designer who, in 1981, founded a fashion business in the U.K. that traded under the brand name KAREN MILLEN. Various companies were incorporated as part of that business, including Karen Millen Limited in 1990, Karen Millen Holdings Limited in 1994, and Karen Millen US

Limited in 2001, and the business achieved significant success under her ownership and direction through the year 2004. Applicant further states that Opposer was incorporated in 2009.

Applicant is otherwise 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. Applicant 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. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 5, and accordingly denies such allegations.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 6, and accordingly denies such allegations, and further states that, notwithstanding any such allegations, the applied-for trademark KARENX is not likely to be confused with the trademark KAREN MILLEN.

7. Applicant denies the allegations in Paragraph 7.

8. Applicant denies the allegations in Paragraph 8, and further states that, notwithstanding any of such allegations, the applied-for trademark KARENX is not likely to be confused with the trademark KAREN MILLEN. Applicant further states, upon information and belief, in response to the specific allegations in Paragraph 8, that to the extent the Opposition is dependent upon Opposer's ownership of the KAREN MILLEN Registrations, Applicant has sought to cancel such registrations in a series of cancellation actions presently pending before the Trademark Trial and Appeal Board (Cancellation Nos. 92058954, 92058960, 92058979, 92058992, and 92058994), on the grounds that Opposer failed to provide USPTO with

Applicant's written consent to registration as required under Section 2(c) of the Lanham Act, 15 U.S.C. § 1052(c).

9. Applicant denies the allegations in Paragraph 9 to the extent it is alleged that Opposer is recognized as the source of products bearing the KAREN MILLEN Marks. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 9, and accordingly denies such allegations.

10. Applicant denies the allegations in Paragraph 10 to the extent it is alleged that any actions of Opposer have resulted in the KAREN MILLEN Marks achieving fame. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 10, and accordingly denies such allegations.

11. Applicant denies the allegations in Paragraph 11, and further states that, notwithstanding any such allegations, the applied-for trademark KARENX is not likely to be confused with the trademark KAREN MILLEN.

12. Applicant denies the allegations in Paragraph 12.

13. Applicant denies the allegations in Paragraph 13.

14. Applicant denies the allegations in Paragraph 14, and further states that, notwithstanding any such allegations, the applied-for trademark KARENX is not likely to be confused with the trademark KAREN MILLEN. Applicant further states, in response to the specific allegations in Paragraph 14, that (a) she originally submitted the Application without the written consent of a living individual, or any statement that consent was of record, (b) on August 16, 2014, the examining attorney assigned to the Application initiated an Office Action noting that the applied-for mark appeared to comprise a living individual's signature, and requested that

Applicant clarify whether the applied-for mark, KARENX, comprised the signature of a living individual and, if so, that Applicant submit a written consent from that individual authorizing Applicant to register the name of that individual as part of the mark, (c) in her Response to the Office Action, on September 2, 2014, Applicant confirmed that the mark comprised the signature of a living individual, namely, Applicant herself, and submitted her written consent to registration under Section 2(c) of the Lanham Act, 15 U.S.C. § 1052(c), and (d) under no circumstances did Applicant do so in order to carry out any “intention to invoke applicant’s name, KAREN MILLEN”

15. Applicant denies the allegations in Paragraph 15.

16. Applicant denies the allegations in Paragraph 16 to the extent it is alleged that Karen Millen Limited was “Opposer’s predecessor”, and further states that, notwithstanding any such allegations, the applied-for trademark KARENX is not likely to be confused with the trademark KAREN MILLEN.

17. Applicant denies the allegations in Paragraph 17.

18. Applicant denies the allegations in Paragraph 18.

19. Applicant admits the allegations in Paragraph 19.

20. Applicant denies the allegations in Paragraph 20.

21. Applicant admits the allegations in Paragraph 21, and further states that notwithstanding any of such allegations, the applied-for trademark KARENX is not likely to be confused with the trademark KAREN MILLEN.

22. Applicant denies the allegations in Paragraph 22.

23. Applicant denies the allegations in Paragraph 23.

24. Applicant denies the allegations in Paragraph 24.

25. Applicant denies the allegations in Paragraph 25.

AFFIRMATIVE DEFENSES

26. Applicant repeats and realleges each of the foregoing allegations contained in Paragraphs 1 to 25 above.

27. The Notice of Opposition fails to state a claim upon which relief can be granted.

28. As the Trademark Office Examiner found by approving the applied-for mark for publication, the applied-for mark KARENX is not likely to be confused with the trademark KAREN MILLEN.

29. In addition to the Affirmative Defense set forth in Paragraph 28, Opposer is barred from any relief under the doctrine of unclean hands.

PRAYER FOR RELIEF

WHEREFORE, Applicant respectfully prays that the Board dismiss the Opposition and grant registration of Applicant's KARENX Mark on the Principal Register in Classes 3, 4, 8, 9, 14, 18, 20, 24, 25, and 35.

Dated: September 14, 2015

Respectfully submitted,

ARNOLD & PORTER LLP

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on September 14, 2015 a copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served by First Class Mail upon the following counsel of record for Karen Millen Fashions Ltd.:

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