

ESTTA Tracking number: **ESTTA661353**

Filing date: **03/16/2015**

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

Proceeding	91220460
Party	Defendant Brookshire Grocery Company
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Date	03/16/2015
Attachments	BROOKSHIRE'S FOOD AND PHARM Answer and Defenses.pdf(130233 bytes)

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

BROOKSHIRE BROTHERS, INC.,

Opposer,

vs.

BROOKSHIRE GROCERY COMPANY,

Applicant.

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Opposition No. 91220460

Mark: **BROOKSHIRE'S FOOD & PHARMACY & Design**
(Serial No: 86199663)



Publication Date: January 13, 2015

**APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES
TO OPPOSER'S NOTICE OF OPPOSITION**

Applicant, Brookshire Grocery Company ("**Applicant**"), answers the Notice of Opposition ("**Opposition**") filed by Brookshire Brothers, Inc. ("**Opposer**"), with the United States Patent and Trademark Office ("**USPTO**"), before the Trademark Trial and Appeal Board ("**TTAB**") as follows, with the paragraphs hereof being numbered to correspond with the like-numbered paragraphs of the Opposition:

As to the introductory paragraph of the Opposition, Applicant admits only that Opposer filed and served the Opposition against the goods/services in U.S. Application Serial No. 86199663 for the mark BROOKSHIRE'S FOOD & PHARMACY & Design, but generally denies the claims and allegations set forth in the Opposition and as more fully stated herein.

With respect to the second introductory paragraph preceding Paragraph 1 of the Opposition, Applicant admits only that U.S. Application Serial No. 86199666 for the mark BROOKSHIRE'S FOOD & PHARMACY & Design was published in the Official Gazette on January 13, 2015. Applicant denies that Opposer will be damaged by the registration of the mark

BROOKSHIRE'S FOOD & PHARMACY & Design, and is without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in the second introductory paragraph.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 1 of the Opposition.

2. Applicant, on information and belief, denies the allegations set forth in Paragraph 2 of the Opposition.

3. Applicant admits only on information and belief that Wood T. Brookshire was a partner with the claimed "Brookshire Brothers partnership" and that he was a brother to Austin and Tom Brookshire. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in Paragraph 3 of the Opposition.

4. Applicant admits only that on information and belief, the alleged Brookshire Brothers partnership dissolved when Wood T. Brookshire left the partnership and continued to operate retail grocery stores in Tyler, Texas which he identified with the designation "BROOKSHIRE'S" or variants, all without objection by and with full knowledge of Opposer's purported predecessors. Since that time, Applicant, itself and through its predecessors, has continued to make substantial use of BROOKSHIRE'S and variants for decades. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in Paragraph 4 of the Opposition.

5. Applicant admits the allegations set forth in Paragraph 5 of the Opposition.

6. Applicant admits only that on or about January 1997, approximately five years after U.S. Registration No. 1,672,896 for the mark BROOKSHIRE'S issued, Opposer raised some

concerns with Applicant about the registration. Applicant denies that Opposer has preexisting rights to the mark BROOKSHIRE'S or BROOKSHIRE, and further denies that Applicant submitted a fraudulent declaration to the USPTO. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in Paragraph 6 of the Opposition.

7. Applicant admits only that on January 21, 1997, it voluntarily surrendered U.S. Registration No. 1,672,896 and that the USPTO's records indicate that the Registration was cancelled on February 2, 1998. Applicant denies that any agreement exists between the parties concerning the registration of any marks. Applicant also denies that it surrendered the registration as a result of any agreement between the parties. Applicant further denies all the remaining allegations set forth in Paragraph 7 of the Opposition.

8. Applicant denies all the allegations set forth in Paragraph 8 of the Opposition.

9. Applicant, on information and belief, admits only that Opposer has not filed any trademark or service mark applications for BROOKSHIRE or BROOKSHIRE'S. Applicant denies that any agreement exists between the parties concerning the registration of any marks. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all the remaining allegations set forth in Paragraph 9 of the Opposition.

10. Applicant admits only that it filed the following eight (8) United States Trademark or Service Mark Applications with the USPTO on November 24, 2004:

- App. No. 76622066, for BROOKSHIRE'S EXPRESS LANE & Design, depicted as



, covering “*cigars, cigarettes, smokeless tobacco products*” in Class 34;

- App. No. 76622067, for BROOKSHIRE'S EXPRESS LANE & Design, depicted as



, covering “*wine*” in Class 33;

- App. No. 76622068, for BROOKSHIRE'S EXPRESS LANE & Design, depicted as



, covering “*soft drinks, fountain drinks, flavored drinks, energy drinks and beer*” in Class 32;

- App. No. 76622069, for BROOKSHIRE'S EXPRESS LANE & Design, depicted as



, covering “*ice, drinking water, spring water, distilled water, ice cream, bread, bakery goods, coffee, gum, candy, and snack chips*” in Class 30;

- App. No. 76622070, for BROOKSHIRE'S EXPRESS LANE & Design, depicted as



, covering “*milk and other dairy products, eggs, and beef jerky*” in Class 29;

- App. No. 76622071, for BROOKSHIRE'S EXPRESS LANE & Design, depicted as



, covering “*automotive products*” in Class 12;

- App. No. 76622072, for BROOKSHIRE'S EXPRESS LANE & Design, depicted as



, covering “*energy pills and analgesics*” in Class 5; and

- App. No. 76622073, for BROOKSHIRE'S EXPRESS LANE & Design, depicted as



, covering “*retail grocery store services*” in Class 43.

Applicant otherwise denies the allegations in Paragraph 10 of the Opposition, including, but not limited to, Opposer's characterization of the aforesaid applications.

11. Applicant admits only that in 2005 Opposer contacted counsel for Applicant and objected to the filing of the eight (8) applications for the mark BROOKSHIRE'S EXPRESS LANE &



Design, depicted as , covering goods/services in Classes 34, 33, 32, 30, 29, 12, 5, and 43 respectively. Applicant denies that any agreement exists between the parties concerning the registration of any marks. Applicant also denies that Opposer has any prior existing rights to the mark BROOKSHIRE'S. Applicant further denies that it made fraudulent claims to the USPTO. Applicant denies any and all remaining allegations set forth in Paragraph 11 of the Opposition.

12. Applicant admits only that on January 4, 2006 it filed a Request for Express Abandonment of U.S. Application Serial Nos. 76622066, 76622067, 76622068, 76622069, 76622070, 76622071, 76622072, and 76622073, and that each such Request affirmatively stated: "Except as provided in 37 C.F.R. Section 2.135 (concerning the commencement of an opposition, concurrent use or interference proceeding), the fact that an application has been expressly abandoned shall not in any proceeding in the United States Patent and Trademark Office, affect any right that the applicant may have in the mark which is the subject of the abandoned application." Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all remaining allegations set forth in Paragraph 12 of the Opposition.

13. Paragraph 13 of the Opposition merely purports to state characterizations concerning U.S. Application Serial No. 86199663 for which no response is necessary as the document speaks for itself. Paragraph 13 of the Opposition purports to state conclusions of law and legal argument regarding ownership to which no response is required. To the extent a response is

deemed necessary, Applicant admits that it is the owner of the applied for mark BROOKSHIRE'S FOOD & PHARMACY & Design for the goods/services described in U.S. Application Serial No. 86199663, and that it claims ownership of the mark in U.S. Application Serial No. 86199663, the further details of such claims are set forth in that Application. Applicant is otherwise without knowledge or information sufficient to form a belief as to the truth or falsity of all remaining allegations set forth in Paragraph 13 of the Opposition.

14. Applicant denies that Opposer has made use of the mark BROOKSHIRE, per se, denies that Applicant has made any false representations, and further denies all remaining allegations set forth in paragraph 14 of the Opposition.

15. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 15 of the Opposition, particularly in view of the vagueness and ambiguity of what Opposer calls "previous disputes".

16. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in Paragraph 16 of the Opposition.

17. Paragraph 17 of the Opposition merely purports to state characterizations concerning U.S. Application Serial No. 86199663 for which no response is necessary as the file history for such application speaks for itself. To the extent a response is required, Applicant admits only that the following additional statement is of record in the file history for U.S. Application Serial No. 86199663: "Section 2(f) Claim of Acquired Distinctiveness, based on Use - The mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement." Applicant is without knowledge or

information sufficient to form a belief as to the truth or falsity of all remaining allegations set forth in Paragraph 17 of the Opposition.

18. Paragraph 18 of the Opposition purports to state conclusions of law and legal argument, including with respect to ownership of marks, to which no response is required. To the extent a response is deemed necessary, Applicant denies all the allegations set forth in Paragraph 18 of the Opposition.

19. Applicant denies that Opposer has made use of the mark BROOKSHIRE, per se. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of all remaining allegations set forth in Paragraph 19 of the Opposition.

20. Applicant denies all the allegations in Paragraph 20 of the Opposition.

21. Applicant admits only that it uses the mark BROOKSHIRE'S for, among other goods/services, retail grocery store services and products marketed through such outlets. Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of all the allegations set forth in Paragraph 21 of the Opposition concerning "instances of actual confusion". Applicant denies all remaining allegations set forth in Paragraph 21 of the Opposition.

22. Paragraph 22 of the Opposition purports to state conclusions of law and legal argument regarding fraud to which no response is required. To the extent a response is deemed necessary, Applicant denies all the allegations set forth in Paragraph 22 of the Opposition.

23. Applicant denies all the allegations set forth in Paragraph 23 of the Opposition.

In response to Opposer's prayer for relief, Applicant denies the entirety of the allegations set forth in the first conclusory paragraph following Paragraph 23 of the Opposition, and submits that the Opposition should be dismissed with prejudice in its entirety.

Applicant is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations set forth in the final paragraph preceding the signature of the Opposer and its counsel.

AFFIRMATIVE DEFENSES

Pursuant to Federal Rule of Civil Procedure 8(b) and (c), Applicant asserts the following defenses to the Opposition. By setting forth these affirmative defenses, Applicant does not assume the burden of proving any fact, issue, or element of a cause of action where such burden properly belongs to Opposer. Nothing herein is intended or shall be construed as an admission that any particular issue or subject matter is relevant to Opposer's allegations. Applicant has not knowingly and intentionally waived any applicable defenses, and it hereby reserves all rights to assert and rely upon other defenses and affirmative defenses that become available as discovery proceeds.

As separate and distinct affirmative defenses, Applicant states as follows:

First Affirmative Defense *(Failure to State a Claim)*

1. Opposer fails to state a claim for relief on the basis that it lacks standing and priority over Applicant, as Opposer has not established trademark rights or secondary meaning in the mark BROOKSHIRE'S FOOD & PHARMACY & Design, or even BROOKSHIRE, prior to Applicant's adoption and extensive use of BROOKSHIRE'S FOOD & PHARMACY & Design and variants.

Second Affirmative Defense *(Laches, Estoppel by Acquiescence, Equitable Estoppel)*

2. Opposer's claims in the Opposition are barred under the doctrines of estoppel by laches, estoppel by acquiescence and/or equitable estoppel

3. Applicant and Opposer have concurrently used their respective marks BROOKSHIRE'S and BROOKSHIRE BROTHERS since at least as early as 1928. These two marks have co-existed for decades without any known instances of actual confusion.

4. Since 1928, and during the 85 years of concurrent use, Opposer has not objected to Applicant's use in connection with any goods or services identified by BROOKSHIRE'S or variants, including, but not limited to the following: BROOKSHIRE'S; BROOKSHIRE'S &

Design, depicted as ; and BROOKSHIRE'S FOOD &

PHARMACY & Design, depicted as . Indeed, Opposer purchases

dairy products from Applicant on a regular basis and has done so for many years, and has not objected to Applicant's use of and expansion of its use of BROOKSHIRE'S and variants for decades.

5. Should Opposer proceed with its claims in the Opposition, Applicant will have relied to its detriment on Opposer's acquiescence, inaction and delay to enforce its alleged rights, particularly where Applicant contends that Opposer has never used the mark BROOKSHIRE'S FOOD & PHARMACY & Design, and insofar as Applicant will have invested substantial time, effort and resources in selecting, adopting, using and expanding its use of BROOKSHIRE'S FOOD & PHARMACY & Design and variants thereof for many years. On information and belief, Opposer knew or should have known of Applicant's BROOKSHIRE'S marks long before the filing date of the Opposition. As a result, Applicant has detrimentally relied on Opposer's delay, inaction, and acquiescence and will be damaged if the Opposition is sustained because it will be denied the benefits associated with and granted by a federal trademark registration for the

goods and services identified in the application at issue. Therefore, Opposer should be barred from proceeding with this Opposition.

Third Affirmative Defense
(Concurrent Use)

6. On information and belief, as a result of the parties' long coexistence in the marketplace, it is reasonable to conclude that relevant consumers have been conditioned to distinguish between the parties respective marks based, in part, on differences between the marks in overall appearance, pronunciation and/or commercial impression and distinct contexts and manners of use.

Fourth Affirmative Defense
(No Likelihood of Confusion)

7. Applicant's mark BROOKSHIRE'S FOOD & PHARMACY & Design is not likely to cause confusion, mistake or deception with any of Opposer's purported marks based, in part, on the overall differences between the parties respective marks in appearance, pronunciation and commercial impression and the distinct contexts and manners of use.

8. Applicant's use and registration of the BROOKSHIRE'S FOOD & PHARMACY & Design mark on the Principal Register of the USPTO is not likely to cause consumers to believe that Applicant, or its products and services identified by such mark, are in any way associated with, or sponsored or approved by Opposer.

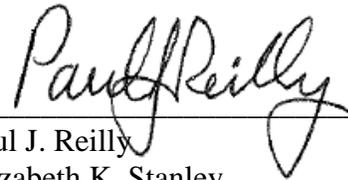
Fifth Affirmative Defense
(Lack of Damages or Injury)

9. On information and belief, Opposer has not and is not likely to suffer any injury or damage as a result of Applicant's use and registration of the mark BROOKSHIRE'S FOOD & PHARMACY & Design which is the subject of U.S. Application Serial No. 86199663.

Applicant reserves the right to rely on any and all further affirmative defenses that become available or appear during discovery in this matter, and reserves the right to amend this Answer for the purpose of asserting any such affirmative defenses.

WHEREFORE, Applicant requests that Opposition No. 91220460 be dismissed in its entirety, with prejudice, and that registration be granted on its U.S. Application Serial No. 86199663.

Respectfully submitted this the 16th day of March, 2015.



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**ATTORNEYS FOR APPLICANT
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CERTIFICATE OF SERVICE

I hereby certify that on this the 16th day of March, 2015, I served, via email and Federal Express overnight courier, a true and correct copy of the foregoing APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES TO OPPOSER'S NOTICE OF OPPOSITION to:

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Tyler M. Beas