

ESTTA Tracking number: **ESTTA664871**

Filing date: **04/03/2015**

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

Proceeding	91220765
Party	Defendant Bangle Jangle, LLC.
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Submission	Answer and Counterclaim
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Signature	/Caroline H. Mankey/
Date	04/03/2015
Attachments	ANSWER AND COUNTERCLAIM.pdf(24325 bytes )

**Registrations Subject to the filing**

Registration No	4680090	Registration date	01/27/2015
Registrant	FD9 GROUP, INC. 5150 Wilshire Boulevard, Suite 225 Los Angeles,, CA 90036 UNITED STATES		

**Goods/Services Subject to the filing**

Class 014. First Use: 2012/08/01 First Use In Commerce: 2013/01/21 All goods and services in the class are requested, namely: Bracelets; Jewelry; Necklaces; Rings
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Registration No	4541700	Registration date	06/03/2014
Registrant	FD9 GROUP, INC. 5150 Wilshire Boulevard, Suite 225 Los Angeles,, CA 90036 UNITED STATES		

**Goods/Services Subject to the filing**

Class 014. First Use: 2012/11/15 First Use In Commerce: 2012/12/01 All goods and services in the class are requested, namely: Bracelets; Jewelry; Necklaces; Rings
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Registration No	4482636	Registration date	02/11/2014
Registrant	FD9 GROUP, INC. 5150 Wilshire Boulevard, Suite 225 Los Angeles, CA 90036 UNITED STATES		

**Goods/Services Subject to the filing**

Class 014. First Use: 2012/09/01 First Use In Commerce: 2013/02/01 All goods and services in the class are requested, namely: Bracelets; earrings; jewelry; necklaces;
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rings
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Registration No	4668121	Registration date	01/06/2015
Registrant	FD9 GROUP, INC. 5150 Wilshire Boulevard, Suite 225 Los Angeles, CA 90036 UNITED STATES		

### Goods/Services Subject to the filing

Class 014. First Use: 2013/02/01 First Use In Commerce: 2013/11/01 All goods and services in the class are requested, namely: Bracelets; Jewelry; Necklaces; Rings
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Registration No	4668122	Registration date	01/06/2015
Registrant	FD9 GROUP, INC. 5150 Wilshire Boulevard, Suite 225 Los Angeles, CA 90036 UNITED STATES		

### Goods/Services Subject to the filing

Class 014. First Use: 2013/02/01 First Use In Commerce: 2013/11/01 All goods and services in the class are requested, namely: Jewelry; Necklaces
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Registration No	4668123	Registration date	01/06/2015
Registrant	FD9 GROUP, INC. 5150 Wilshire Boulevard, Suite 225 Los Angeles., CA 90036 UNITED STATES		

### Goods/Services Subject to the filing

Class 014. First Use: 2013/02/01 First Use In Commerce: 2013/11/01 All goods and services in the class are requested, namely: Bracelets; Jewelry
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Registration No	4675909	Registration date	01/20/2015
Registrant	FD9 GROUP, INC. 5150 Wilshire Boulevard, Suite 225 Los Angeles, CA 90036 UNITED STATES		

### Goods/Services Subject to the filing

Class 014. First Use: 2012/11/01 First Use In Commerce: 2013/02/01 All goods and services in the class are requested, namely: Bracelets; jewelry; necklaces; rings
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

FD9 GROUP, INC.,

Opposer,

vs.

BANGLE JANGLE, LLC, an  
individual,

Applicant.

Opposition No. 91220765

Serial No. 86352420

**ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM**

Applicant Bangle Jangle, LLC (“Applicant” or “Bangle”) hereby answers the allegations contained in the Opposition filed by Opposer FD9 Group, Inc. (“Opposer” or “FD9”) as follows:

1. Applicant denies all of the allegations in paragraph 1 of the Opposition.
2. Applicant lacks the requisite knowledge to admit or deny the allegations contained in paragraph 2 of the Opposition.
3. Applicant lacks the requisite knowledge to admit or deny the allegations contained in paragraph 3 of the Opposition.
4. Applicant lacks the requisite knowledge to admit or deny the allegations contained in paragraph 4 of the Opposition.

5. Applicant lacks the requisite knowledge to admit or deny the allegations contained in paragraph 5 of the Opposition.
6. Applicant lacks the requisite knowledge to admit or deny the allegations contained in paragraph 6 of the Opposition.
7. Applicant denies all of the allegations contained in paragraph 7 of the Opposition.
8. Applicant admits the allegations contained in paragraph 8 of the Opposition, except that it denies that it currently occupies #173.
9. Applicant admits the allegations contained in paragraph 9 of the Opposition.
10. Applicant denies all of the allegations contained in paragraph 10 of the Opposition.
11. Applicant denies all of the allegations contained in paragraph 11 of the Opposition.
12. Applicant denies all of the allegations contained in paragraph 12 of the Opposition.
13. Applicant lacks the requisite knowledge to admit or deny the allegations contained in paragraph 13 of the Opposition.
14. Applicant admits that registration of its LAT & LO mark would afford it certain rights, but denies all other allegations contained in paragraph 14 of the Opposition.
15. Applicant admits that registration of its LAT & LO mark would afford it certain rights, but denies all other allegations contained in paragraph 15 of the Opposition.
16. Applicant denies that Opposer would be damaged by registration of Application Serial No. 86/352420.

## **AFFIRMATIVE DEFENSES**

The following affirmative defenses are asserted by Applicant.

### **FIRST AFFIRMATIVE DEFENSE**

(Unclean Hands)

17. Opposer's Opposition is barred by the doctrine of unclean hands.

### **SECOND AFFIRMATIVE DEFENSE**

(Waiver)

18. Opposer's Opposition is barred by the doctrine of waiver.

### **THIRD AFFIRMATIVE DEFENSE**

(Estoppel)

19. Opposer's Opposition is barred by the doctrine of estoppel.

### **FOURTH AFFIRMATIVE DEFENSE**

(Unjust Enrichment)

20. Refusal to register Applicant's mark would unjustly enrich Opposer at the expense of Applicant.

### **FIFTH AFFIRMATIVE DEFENSE**

(No Valid, Enforceable or Registered Trademark)

21. Opposer is not entitled to any relief because Opposer's alleged trademark, trade dress, and/or slogan is invalid, unenforceable and/or unregistered.

### **SIXTH AFFIRMATIVE DEFENSE**

(Abandonment of Trademarks)

22. Opposer's Opposition is barred, in whole or in part, by Opposer's abandonment of the alleged trademarks on which it relies as the basis for the Opposition.

**SEVENTH AFFIRMATIVE DEFENSE**

(Invalid Trademarks)

23. Opposer's Opposition is barred because its purported trademarks are invalid and should be cancelled and Opposer cannot claim common law trademark rights because Opposer is the infringing junior user of the marks.

**EIGHTH AFFIRMATIVE DEFENSE**

(Priority of Use)

24. Applicant's use of "The Coordinate Line" predated Opposer's purported use of its alleged COORDINATES marks, establishing priority of use.

**NINTH AFFIRMATIVE DEFENSE**

(Trademark Misuse)

25. Opposer is not entitled to oppose Applicant's registration because Opposer has engaged in trademark misuse to stifle competition.

**TENTH AFFIRMATIVE DEFENSE**

(No Likelihood of Confusion)

26. Opposer is not entitled to any relief because there is no likelihood of confusion among consumers over the source of any of Applicant's goods.

**ELEVENTH AFFIRMATIVE DEFENSE**

(Consent or Acquiescence)

27. Opposer's Opposition is barred, in whole or in part, by Opposer's consent or acquiescence.

**TWELFTH AFFIRMATIVE DEFENSE**

(Right to Assert Additional Affirmative Defenses)

28. Applicant reserves the rights to assert additional affirmative defenses in the event that discovery and/or further investigation of Opposer's Opposition indicates that additional affirmative defenses are available to Applicant.

## COUNTERCLAIM FOR CANCELLATION

1. Bangle Jangle, LLC (“Bangle”) hereby counterclaims against FD9 Group Inc. (“FD9”) for cancellation of its registered marks as follows:

2. Bangle is a limited liability company organized and existing under the laws of the State of Florida, with its principal place of business at 97 Levy Road, #182, Atlantic Beach, Florida 32233.

3. In approximately January or February 2013, Bangle began developing, designing and manufacturing a new line of jewelry that it called “The Coordinate Line by Bangle Jangle.” The pieces of jewelry in THE COORDINATE LINE BY BANGLE JANGLE are hand-crafted and bear the latitude and longitude coordinates of a location selected by the customer on the front, as well as optional customized engravings on the back.

4. On April 3, 2013, Bangle launched the line by posting a photograph of its cuff-style bracelet bearing latitude and longitude coordinates (the “Bangle Cuff”) on Facebook. At that time, Bangle began marketing and selling the line in interstate commerce by posting and selling it publicly on social media and selling it directly to stores using the trade name THE COORDINATE LINE BY BANGLE JANGLE.

5. When Bangle launched THE COORDINATE LINE BY BANGLE JANGLE and started selling the Bangle Cuff in April 2013, FD9 was not marketing or selling online any products under the trade name COORDINATES.

6. In May 2013, Bangle began marketing and selling online its “Anchor Me” necklace, which had an anchor shaped charm, as well as a round disc bearing latitude and longitude coordinates. Bangle also released necklaces with discs (the “Disc Necklace”) and mini dog tags (the “Mini Dog Tag Necklace”) bearing latitude and longitude coordinates in mid 2013 and bar style necklaces bearing coordinates (the “Bar Necklace”) in February 2014.

7. Bangle is informed and believes, and based thereon alleges, that in or after June 2013, several months after the public debut and sales launch of THE COORDINATE LINE BY BANGLE JANGLE, FD9 launched a line of metal jewelry called “Coordinates Collection” that also bears latitude and longitude coordinates, and began selling it on its website [www.coordinatescollection.com](http://www.coordinatescollection.com). Among the goods FD9 began selling in or after June 2013 was a cuff bracelet that is a copy of the Bangle Cuff that Bangle had been selling since April 3, 2013. In April 2014, FD9 began selling necklaces that were copies of the Disc Necklaces and Mini Dog Tag Necklaces that Bangle had been selling since mid 2013, and the Bar Necklaces that Bangle had been selling since February 2014.

8. Despite Bangle’s priority of use of THE COORDINATE LINE BY BANGLE JANGLE for jewelry bearing latitude and longitude coordinates, on or about September 29, 2013, Bangle received a cease and desist letter from counsel for FD9, claiming that THE COORDINATE LINE BY BANGLE JANGLE infringed on FD9’s alleged trademark rights in the name “Coordinates Collection.”

9. After receipt of the cease and desist letter, Bangle contacted the USPTO to investigate FD9’s claims. A USPTO staff attorney informed Bangle that FD9 did not have a registered trademark and that the term that FD9 claimed as its mark, “Coordinates Collection,” was considered descriptive and was commonly used in the marketplace and could not be trademarked.

10. Despite Bangle’s priority of use, in order to avoid any possibility of consumer confusion, on November 20, 2013, Bangle announced publicly on social media that it was transitioning from the name THE COORDINATE LINE BY BANGLE JANGLE to LAT & LO. LAT & LO is not a commonly known or used term for latitude and longitude. After doing extensive research, Bangle determined that no one had previously used the term LAT & LO on any goods or services and that Bangle was the first and original user of the mark for any purpose. The fact

that LAT & LO was *not* a common reference for latitude and longitude is the reason why Bangle selected this mark to differentiate its goods.

11. Since November 20, 2013, Bangle has sold its jewelry line bearing latitude and longitude coordinates under the mark LAT & LO. LAT & LO is not confusingly similar to COORDINATES or WHAT ARE YOURS? In addition to the marked differences between the marks LAT & LO, COORDINATES and WHAT ARE YOURS?, Bangle further distinguished its LAT & LO line by using an image of an anchor in its logo and the tag line “Where are you anchored?,” which FD9 does not. Bangle is informed and believes, and based thereon alleges, that FD9 does not use WHAT ARE YOURS? in any way in its marketing, social media, or branding campaigns.

12. FD9’s COORDINATES marks and WHAT ARE YOURS? mark were registered less than five years ago. Bangle is informed and believes, and based thereon alleges, that FD9’s COORDINATES marks were not registered by the PTO until February 11, 2014 (Reg. No. 4,482,636), June 3, 2014 (Reg. No. 4,541,700), January 6, 2015 (Reg. Nos. 4,668,121, 4,668,122 and 4,668,123), and January 27, 2015 (Reg. No. 4,680,090).

13. On or about July 30, 2014, Bangle filed an application with the United States Patent & Trademark Office for registration of its mark LAT & LO, Serial No. 86/352420.

14. On January 22, 2015, FD9 filed a complaint against Bangle in the United States District Court for the Central District of California, entitled FD9 Group, Inc. v. Bangle Jangle, LLC, Case No. 2:15-cv-00512 BRO (ASx), asserting claims for statutory and common law trademark infringement, trade dress infringement, unfair competition, false designation of origin, and copyright infringement arising out of Bangle’s manufacture and sale of its LAT & LO line of jewelry.

15. On or about February 23, 2015, FD9 filed its Opposition to Bangle's application to the United States Patent & Trademark Office for registration of its trademark LAT & LO. Contemporaneously with the filing of this Answer and Counterclaim, Bangle is also filing a Motion to Stay the Opposition Proceeding pending the outcome of the United States District Court litigation.

16. In light of the District Court Case and the Opposition to Bangle's application for registration, Bangle believes that it is being damaged by FD9's COORDINATES trademark registrations (Reg. Nos. 4,680,090, 4,541,700, 4,482,636, 4,668,121, 4,668,122, and 4,668,123) and its mark WHAT ARE YOURS? (Reg. No. 4,675,909) in that FD9 is attempting to use the marks to obtain a monopoly on the use of latitude and longitude coordinates on jewelry and to inhibit lawful competition.

17. Bangle is informed and believes, and based thereon alleges, that it is the prior and senior user of the trade name or mark THE COORDINATE LINE BY BANGLE JANGLE in connection with the manufacture and sale of jewelry bearing latitude and longitude coordinates in intrastate and interstate commerce, and that FD9's use of the COORDINATES marks on jewelry bearing latitude and longitude coordinates creates a likelihood of consumer confusion as to the source of the jewelry.

18. Bangle is informed and believes, and based thereon alleges, that FD9 made no bona fide use of the COORDINATES marks prior to its filing of use-based applications for registration under Trademark Act § 1(a), 15 U.S.C. § 1051(a).

19. Bangle is further informed and believes, and based thereon alleges, that COORDINATES, when used in connection with goods bearing latitude and longitude coordinates, is and was at the time of registration merely descriptive,

generic, lacks secondary meaning, and is not distinctive. Bangle has an interest in using the term “coordinates” descriptively to identify attributes of its jewelry.

20. Cancellation of Registration Nos. 4,680,090, 4,541,700, 4,482,636, 4,668,121, 4,668,122, 4668,123 and 4,675,909 is the proper remedy because the foregoing facts negate FD9’s right to registration of its COORDINATES marks and WHAT ARE YOURS? mark pursuant to 15 U.S.C. §§ 1051(a), 1052(d), and 1052(e).

21. Cancellation of Registration Nos. 4,680,090, 4,541,700, 4,482,636, 4,668,121, 4,668,122, 4668,123 and 4,675,909 is also proper because of the inaccurate and/or untruthful nature of the representations by FD9 in its applications that resulted in the subject registrations and/or in other papers filed with the USPTO during the prosecution of said applications. 15 U.S.C. § 1120.

WHEREFORE, Bangle prays for cancellation of U.S. Trademark Registration Nos. 4,680,090, 4,541,700, 4,482,636, 4,668,121, 4,668,122, 4668,123 and 4,675,909.

Dated: April 3, 2015

Respectfully submitted,  
BANGLE JANGLE, LLC

By its Attorneys,  
SEDGWICK LLP

/Caroline H. Mankey/

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition and Counterclaim has been served on counsel for Opposer FD9 Group, Inc. by mailing said copy on April 3, 2015, via First Class Mail, postage prepaid to:

Michael N. Cohen  
Cohen IP Law Group PC  
9025 Wilshire Blvd. Suite 301  
Beverly Hills, CA 90211

Dated: April 3, 2015

/Caroline H. Mankey/

Caroline H. Mankey