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

Proceeding	91220893
Party	Defendant Sirius XM Radio Inc.
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Date	06/12/2015
Attachments	Answer.PDF(782241 bytes)

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

In re Application Serial Nos. : 85/915,417 and 85/915,418
Mark : MYSXM and MYSXM & Design
International Class : 38
Applicant : Sirius XM Radio Inc.
Filed : April 26, 2013
Published : November 4, 2014

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THOMAS BANNISTER :
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 Opposer, :
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 v. : Opposition No. 91220893
 :
 SIRIUS XM RADIO INC. :
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 Applicant. :
 :
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APPLICANT’S ANSWER TO NOTICE OF OPPOSITION

Sirius XM Radio Inc. (“Applicant”), by and through its undersigned counsel, hereby answers and responds to the Notice of Opposition¹ (the “Notice”) filed by Thomas Bannister (“Opposer”) against Application Nos. 85/915,417 and 85/915,418 for the marks MYSXM and MYSXM & Design, respectively (the “Applications”) as follows:

¹ Opposer filed two Notices of Opposition, contained in one document, to institute Opposition No. 91220893 – one against Application No. 85/915,417 for MYSXM, and the other against Application No. 85/915,418 for MYSXM & Design. Because both Notices of Opposition contain allegations that are identical both paragraph-by-paragraph and word-for-word, Applicant submits this one Answer in response to both Notices of Opposition, and refers to both Notices of Opposition collectively as the “Notice”.

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Notice, and on that basis denies the same.

2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Notice, and on that basis denies the same.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Notice, and on that basis denies the same.

4. Applicant states that the information reflected in U.S. Registration No. 3,961,047 speaks for itself.

5. Applicant admits that the Applications were filed on April 26, 2013; claim first use of the mark in commerce as April 2013; and currently cover “subscription-based radio broadcasting services.”

6. The allegations in Paragraph 6 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Notice, and on that basis denies the same.

7. The allegations in Paragraph 7 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant lacks knowledge or information sufficient to form a belief as to

the truth of the allegations contained in Paragraph 7 of the Notice, and on that basis denies the same.

8. The allegations in Paragraph 8 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant denies the allegations in Paragraph 8 of the Notice.

9. The allegations in Paragraph 9 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant denies the allegations in Paragraph 9 of the Notice.

10. The allegations in Paragraph 10 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant denies the allegations in Paragraph 10 of the Notice.

11. Applicant admits that it did not secure Opposer's express consent or permission to file the Applications. Applicant denies any other allegations concerning Opposer's consent or permission suggested in Paragraph 11.

12. The allegations in Paragraph 12 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant denies the allegations in Paragraph 12 of the Notice.

13. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 13 of the Notice, and on that basis denies the same.

14. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 14 of the Notice, and on that basis denies the same.

15. The allegations in Paragraph 15 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant denies the allegations in Paragraph 15 of the Notice.

16. The allegations in Paragraph 16 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant denies the allegations in Paragraph 16 of the Notice.

17. The allegations in Paragraph 17 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant denies the allegations in Paragraph 17 of the Notice.

18. The allegations in Paragraph 18 of the Notice constitute conclusions of law or legal argument to which no responsive pleading is necessary. To the extent a responsive pleading is necessary, Applicant denies the allegations in Paragraph 18 of the Notice.

19. Applicant denies the allegations in Paragraph 19 of the Notice.

AFFIRMATIVE DEFENSES

Applicant asserts the following affirmative defenses in response to the allegations in the Notice:

1. Opposer's claims are barred for failure to state a claim upon which relief can be granted.
2. Opposer's claims are barred under the doctrines of unclean hands, laches, acquiescence, waiver and/or estoppel because Opposer has for years been aware of use of Applicant's marks comprising SXM, and registrations/applications to register any or all of such marks, and by Opposer's actions or omissions has induced Applicant to rely prejudicially thereon.

3. Opposer's claims are barred by its failure to mitigate damages (if such damages exist).

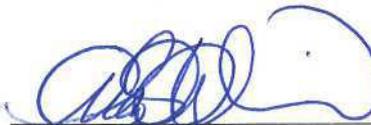
4. Opposer's claims are barred due to the existence of prior registrations owned by Applicant for substantially similar registered marks used in connection with substantially similar goods and services vis-à-vis the marks depicted and services identified in the Applications, since the registrations sought via the Applications would cause no added injury to Opposer.

WHEREFORE, Applicant respectfully requests that the Notice be dismissed with prejudice in all respects.

Respectfully submitted,

Dated: New York, NY
June 12, 2015

By:



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Attorneys for Applicant Sirius XM Radio Inc.

CERTIFICATE OF SERVICE

I hereby certify that on June 12, 2015, I caused one true and complete copy of the foregoing Answer to Notice of Opposition to be served by first class mail upon Opposer Thomas Bannister by causing a true and complete copy thereof to be deposited in the United States mail, postage prepaid, addressed to its attorney of record as follows:

Benjamin Orifici
222 Sackett Street, Suite 4R
Brooklyn, NY 11231


Erica D. Klein