

ESTTA Tracking number: **ESTTA669788**

Filing date: **04/30/2015**

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

Proceeding	91220956
Party	Defendant Sanjay Agarwal
Correspondence Address	SANJAY AGARWAL AEGIS VISION LIMITED BOSTON RD, BOUNDARY HOUSE LONDON W7 2QE, UNITED KINGDOM zlatinzlatev@yahoo.com
Submission	Answer
Filer's Name	Sanjay Agarwal
Filer's e-mail	zlatinzlatev@yahoo.com
Signature	/Sanjay Agarwal/
Date	04/30/2015
Attachments	answer pdf.pdf(118794 bytes)

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

UNIQUE PHOTO, INC., : Serial No. 79/153014
:
Opposer, : Filed: 5/13/2014
:
v. : For: UUNIQUE
:
SANJAY AGARWAL, : Published: 2/3/2015
:
Applicant. : Opposition No. _____
_____X

Commissioner for Trademarks

P.O. Box 1451

Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION

Sanjay Agarwal (“Applicant”) answers Unique Photo, Inc.’s (“Opposer”) Notice of Opposition as follows:

1. The allegations of paragraph 1 related to ownership of the enlisted trademarks are admitted and no opinion because of lack of information might be formed on the allegations related to the usage of these marks.

2. The applicant has no information related to usage of the opposer's trademarks and these allegations are therefore denied. The allegations related to usage of the applicant's trademarks are denied. The applicant's trademark is not unknown to the consumers in the United States. The trademark UUnique was represented at CES 2015 organised by the applicant's US distributor Brightstar in Las Vegas – one of the biggest consumer electronic shows in the world. The applicant's trademark was also advertised in few leading American newspapers, including New York Times.
3. The allegations of paragraph 3 related to ownership of the enlisted trademarks are admitted and no opinion because of lack of information might be formed on the allegations related to the usage of these marks.
4. The Applicant has no information regarding the usage of the Opposer's trademarks and therefore the allegations of paragraph 4 are denied.
5. The allegations of paragraph 5 are denied. Apart from the usage as stated in paragraph 2 above, the Applicant's trademark has been registered in various jurisdictions, including European Union and the United Kingdom, where the trademark is well-known on the market with products sold under the Applicant's trade mark. These products are also sold in Japan, Middle East, South Africa and Australia, where UUnique trademark is used too.
6. The allegations of paragraph 6 are denied.
7. The allegations related to the list of products that the Applicant's trademark is intended to be sued for is admitted, the remaining allegations are denied.
8. The allegations of paragraph 8 are denied.
9. The allegations of paragraph 9 are denied.
10. The allegations of paragraph 10 are denied.

AFFIRMATIVE DEFENCE



11. The trademark Uunique (reproduced as ) was registered on 8 December 2009 in the United Kingdom and soon after that in the European Union. Since its registration it has been used actively in the commercial activities in Aegis Vision Limited, incorporated and registered in England and Wales with company number 05134589 whose registered office is at Gladstone House, 77-79 High Street, Egham, Surrey TW20 9HY, including advertising campaigns, public presentations, direct sales via a special website (www.uunique.uk.com) and other internet retailers.
12. For this period of time there were no disputes with any other legal entities with regard to any possible conflicts related to usage of the Applicant's trademark. The Applicant's trademark Uunique is part of the applicant's corporate identity and the applicant believes that its registration in the USA will be in best interest in the Applicant's potential customers therein.
13. The only common element of the Applicant's marks and the opposer's marks is the word 'unique'. This hypothetically can only lead to association of these marks, but the other elements that distinguish them prevent any similarity.
14. The mere association of two marks does not necessarily lead to similarity of the marks and therefore cannot in any cases cause 'confusion'. The mere 'association' of two marks by virtue of their 'analogous semantic content' is insufficient ground for concluding that there is 'similarity' or even 'confusion' between them.
15. 'Likelihood of association' is not an alternative to 'likelihood of confusion' but a subcategory of it. 'Association' of marks is not therefore an infringement or a bar to registration in the absence of confusion.

16. The fact that some of the marks that are enlisted in the opposition contain the word 'unique' does not in itself lead to confusion. Even though the marks contain the word 'unique', the opposer does not prove that this leads at least to association of the marks.
17. The availability of common word in two marks is not considered to be hindering condition for their registration as it is not leading to association of the marks or to further consequences like similarity. This can be best demonstrated by the fact that so many marks having the word 'unique' have already been registered in the United States and no grounds for specific treatment of the mark Uunique can be substantiated on this ground.
18. The Opposer's allegations of likelihood of confusion are not proved in any of its elements. The connotation of the Applicant's mark is opposite to the one that can be implied from the other marks: the presence of the first letter 'U' for the pronoun "you" in the mark specifies the uniqueness of the consumers rather than the uniqueness of the products. Therefore there is even no semantic similarity between the Applicant's mark and the marks in the opposition. Without any similarity of the marks no conclusion about likelihood of confusion can be drawn.
19. Furthermore, comparison of marks should be made from the standpoint of the average relevant consumer. Global appreciation of marks must be based on the overall impression given by them, bearing in mind their distinctive and dominant components. We think that the perception of marks in the mind of the average consumer of the relevant goods or services plays a decisive role in the global appreciation of the likelihood of confusion, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various elements.
20. The Applicant's mark in that respect has no similar elements in its global appreciation with the other marks enlisted in the opposition. Its graphical and semantic perception is

generally different than those of the other marks where even without knowledge of their additional elements like the relatedness of goods, imply different visual perception.

21. By the doctrine of the impression conveyed, where it is necessary to determine the similarity of an earlier mark and a later mark that comprises the earlier mark together with another integer such as the company name or house mark of the proprietor of the later sign, one should consider the overall impression conveyed by each of the latter two signs in order to ascertain whether the component shared by the two marks characterizes the latter composite mark to the extent that the other components are largely secondary to its overall impression.
22. Once this comparison is made, no likelihood of confusion will be said to exist where that common component merely contributes to the overall impression of the later sign, regardless of whether the common component still has an independent distinctive role in the composite sign. In this case the earlier mark (and thus the common component of both parties' marks) was the word UNIQUE. The doctrine dictates that, when UNIQUE is not the dominant element of the latter sign (UNIQUE PHOTO, UNIQUE TOTS etc.) the composite sign could not be said to be confusingly similar to the earlier mark.
23. The trademark 'UNIQUE' contains one single adjective which meaning can only be related to the products that are sold. Being an adjective, its function is just to provide additional meaning to the noun to which it is used. As in the trademark there is no noun, the nearest possible object to which this word can be associated are the products sold under the trademark.
24. In all other marks the word 'unique' appears just as an adjective whose function is to provide additional meaning to the noun which is bearing the main semantic burden and therefore defines the general connotation of the mark.

25. In both cases the distinctive and dominant component will be the noun and the adjective should be merely supplementing the main meaning. The Applicant's trademark contains the words "UUunique" which stands for "You are unique" and in that respect the adjective is related to the qualities of the recipient of the mark rather than the products that are offered.
26. Therefore we consider that the Applicant's trademark is not similar to any of the previously registered marks as there is no similarity in its appearance, sound, connotation, and commercial impression. With regard to such conclusion we are asking that the opposition should be dismissed.
27. The applicant's goods neither move in similar trade channels, nor they are legally identical or closely related to registrants' goods and therefore there is no likelihood of confusion as to the source of goods.
28. The fact that all products are in international class 9 does not in any case mean that the products are identical.
29. There is no registrant that offers similar aggregation of goods that we offer under the applied-for trade mark. Moreover, there is not even a single product overlap with some of the Opposer's marks. Therefore it cannot be concluded that the products are either moving in similar trade channels or there is any single element of identity between the Applicant's mark and the Opposer's marks.
30. The Opposer does not substantiate its claim about similarity of the products but merely mentions that its products are in international class 9 too. If it is assumed that in all cases where the products are merely within one international class there is similarity of the marks, this would lead to significant restriction of the principles of the free trade and market economy and would allow for registration of only one trademark per class. On the contrary, the requirement for identical or closely related to goods is applied only in

cases where (i) there is similarity in the marks and (ii) the aggregation of goods is identical. For none of the enlisted previously registered marks these conditions, even if taken separately, are met.

31. Commercial Impression is one of the four factors (along with appearance, sound and meaning that were discussed above) considered when comparing trademarks for similarities. Once a consumer has had an opportunity to encounter the trademark with its goods or services in the market place and it has observed the appearance of the mark, perhaps heard the sound of the mark, and considered the meaning of the mark, it now has developed a “commercial impression” of the mark along with the goods or services. This main image or idea that has developed is considered to be the commercial impression or consumer impression and it should weigh as part of the likelihood of confusion analysis. In that respect UUnique trademark is significantly distinctive compared to the trademarks that the opposer represents.
32. We think that the distinctiveness of the mark should be construed in its regular meaning. When considering the distinctive character of the earlier mark for the purposes of assessing the degree of protection against a similar mark to which it is entitled, we believe that the standard of distinctiveness is that employed in determining whether a trade mark has the capacity to identify the goods or services for which it is registered as coming from a single origin.
33. For the purpose of registration, the criterion is one of whether an applied-for sign has the necessary degree of distinctiveness to enable it to identify goods or services as coming from a single origin, not that of how much surplus distinctiveness there exists over the minimal level at which a sign becomes sufficiently distinctive to be registered. Every trade mark that is the basis upon which opposition or infringement proceedings

are brought is a mark which has already satisfied, at the point of registration, these criteria of distinctiveness.

34. From the overall visual and semantic appearance of the Applicant's registration mark there is no similarity to any of the Opposer's marks. Moreover, none of the Opposer's goods are identical to those that are to be offered under the Applicant's mark. Therefore we consider that the opposition should be quashed as there is no likelihood of confusion with the Applicant's trademark. The trademark Unique was registered about 5 years ago in the United Kingdom and European Union and since then it has become part of the corporate identity of Aegis Vision Limited as it is invariably and actively used in its all commercial activities and it is widely associated with the products that it sells.

WHEREFORE, Applicant respectfully prays that the mark sought to be registered and that the opposition be dismissed.

Respectfully submitted on this the 30th day of April, 2015.

By: /Sanjay Agarwal/

Sanjay Agarwal

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 30th day of April, 2015, a true copy of the foregoing ANSWER and AFFIRMATIVE DEFENSES was served in the following manner, per the prior written agreement of counsel: **VIA FIRST CLASS MAIL (Royal Mail First Class International Service, Tracked and Signed upon delivery) at the following addresses:**

DANIEL P LAINE

LERNER DAVID LITTENBERG KRUMHOLZ & MENTLIK

600 SOUTH AVENUE WEST

WESTFIELD, NJ 07090

UNITED STATES OF AMERICA

Unique Photo Inc.

123 US Highway 46

Fairfield, NJ 07004

UNITED STATES OF AMERICA

VIA EMAIL at the following addresses:

dlaine@ldlkm.com, bsales@ldlkm.com, litigation@ldlkm.com

CERTIFICATE OF ELECTRONIC FILING

The undersigned certifies that this submission (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 30th day of April, 2015.

By: /Sanjay Agarwal/

SANJAY AGARWAL