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

Proceeding	91224201
Party	Defendant Elaine Ton
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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ETONIC HOLDINGS, LLC	)	
	)	Opposition No. 91224201
Opposer,	)	
	)	Mark: Etoncie
	)	
ELAINE TON	)	Serial No. 86513369
	)	
Applicant	)	
	)	

ANSWER TO NOTICE OF OPPOSITION WITH AFFIRMATIVE DEFENSES

Applicant, Elaine Ton, by her attorneys, hereby submits her Answer to the Notice of Opposition filed by Opposer, Etonic Holdings, LLC (Etonic Holdings) as follows, with the following numbered Paragraphs corresponding to the numbers of the Paragraphs of the Notice of Opposition under the headings used in the Notice of Opposition:

THE PARTIES

1. Applicant admits that it seeks to register a mark as fully displayed in U.S. Serial No. 86513369 for sale of all-purpose sport bags; all-purpose athletic bags; all-purpose carrying bags; purses: Class 18: bags, purses, backpacks, wallets, luggage; and Class 25: caps, hats, blouses, tops, t- shirts, knitwear, outerwear, hoodie, coats, jackets, belts, undergarments, socks, skirts, shorts, school uniform, scarves, ponchos, pullover, sweaters, pants, jeans, shorts, leggings, bathing suits, sandals, shoes, slippers, boots.

2. With respect to the allegations of paragraph 1, Applicant lacks knowledge or information sufficient to form a belief as to the allegations in Paragraph 1 and therefore denies the same.

3. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 2 and therefore denies the same.

4. Applicant admits that Etonic Holdings is shown as the owner of Reg. Nos. 0872644, 0766756 and 3456272 in the records of the U.S. Patent and Trademark Office. Applicant is without knowledge or information sufficient to for a belief as to the remainder of Paragraph 3 and therefore denies the same.

5. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 4 and therefore denies the same.

6. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 5 and therefore denies the same.

7. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 6 and therefore denies the same.

8. Applicant is without knowledge or information sufficient to form a belief as to the allegations in Paragraph 7 and therefore denies the same.

9. Applicant further affirmatively alleges that as a result of its continuous substantial usage of its mark etoncie since adoption, this mark is a valuable asset of Applicant and carries considerable goodwill and consumer acceptance of its products sold under the mark. Such goodwill and widespread usage has made the mark distinctive to the Applicant.

10. Applicant further affirmatively alleges that there is no likelihood of confusion, mistake or deception because, *inter alia,* Applicant's mark and the pleaded marks of Opposer are not confusingly similar.

11. Applicant further affirmatively alleges that there is no likelihood of confusion, mistake or deception because, *inter alia,* Applicant's mark and the pleaded marks of Opposer are not confusingly similar. Any similarity, if at all, between Applicant's

mark and the pleaded marks of Opposer is in the portion "Eton" which, upon information and belief, has been used and registered by numerous third parties in the foods, restaurant and processed foods businesses. As a result, Opposer cannot base any similarity between its pleaded marks and the mark of Applicant of the "Eton." Any trademark or service mark rights that Opposer may have are narrowly circumscribed to the goods or services indicated and any other use would not lead to a likelihood of confusion.

12. Applicant further affirmatively alleges that there is no likelihood of dilution of Opposer's mark by tarnishment because Opposer's marks are associated with expensive, high quality athletic shoes whereas Applicant's mark is associated with all-purpose bags whose primary market is girls between the age of 2 and 16.

13. Applicant further affirmatively alleges that there is no likelihood of dilution by blurring because Opposer's and Applicant's marks are not sufficiently similar; there are, upon information and belief, numerous uses and registrations of third party marks with the "Eton" formative; Applicant does not intend any association with Opposer's marks or any of them; and upon information and belief, ordinary prospective purchasers of Applicant's products do not associate Applicant's and Opposer's marks.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE
(Fair Use)

14. As a First and Separate Affirmative Defense, Applicant alleges that the primary meaning of Applicant's use of its mark is employed in good faith and no consumer confusion is likely to result. Specifically, when read and spoken out loud, Applicant's mark "etoncie and design" do not bare any resemblance to the Opposer's mark.

15. Further, the word etoncie and design are not synonymous with any of the

products Opposer's market or sell. Here, Opposer markets and sells "Men's and Women's Street and Sport Shoes and Shorts, Clothing-Namely, Shirts, Sweaters, Slacks, Shorts, Skirts, Sport Coats, Dresses, Culottes, Hoisery and Rainwear", while Applicant exclusively markets and sells "all-purpose athletic bags; all-purpose carrying bags and pants." Given this fact, there is no likelihood of consumer confusion.

16. Applicant's use of its mark in connection with its advertising and promotion of its products permits consumers to compare and determine the clear difference between Opposer's mark and its respective goods and services.

SECOND AFFIRMATIVE DEFENSE
(Laches)

As a Second and Separate Affirmative Defense, Applicant alleges that Opposer's claims as set forth in its Notice are barred by the equitable doctrine of laches based on Opposer's delay by failing to, without limitation, claim exclusive ownership of its alleged marks, adequately police its trademarks from use by others, and exercise quality control over the products or services displaying the marks in commerce.

THIRD AFFIRMATIVE DEFENSE
(Acquired Distinctiveness)

17. As a Third and Separate Affirmative Defense, Applicant alleges that the goods and services associated with Applicant's mark have acquired a distinctiveness in the mind of the relevant public to whom it markets and sells its unique products. Given this truth, coupled with the fact that Opposer markets and sells its products to a completely different audience and consumer, there is no likelihood that Applicant's mark will confuse the consumer in determining a relationship with either mark.

FOURTH AFFIRMATIVE DEFENSE
(Strength of the Mark)

18. As a Fourth and Separate Affirmative Defense, Applicant alleges that there is little doubt that Opposer's Mark is a distinctive, widely recognized trademark. Opposer has sold millions of shoes worldwide under the ETONIC mark and invested millions of dollars in advertising. However, the clarity of etoncie's parodic intent, the widespread familiarity with etoncie's parodies, and the strength of ETONIC's mark, all weigh strongly against the likelihood of confusion as to source or sponsorship between ETONIC's mark and the name "etoncie." Moreover, this reasoning applies to both use of the etoncie's character likeness alone and use of the likeness and name together on ETONIC's merchandise.

FIFTH AFFIRMATIVE DEFENSE
(Degree of Similarity between the Marks)

19. As a Fifth and Separate Affirmative Defense, Applicant alleges that combined use of the name and likeness does not present a strong case of similarity. Viewed alone, of course, the names "ETONIC" and "etoncie bear more than a passing resemblance.

20. However, there are also some significant differences; "etoncie" is pronounced much more different than the word ETONIC. Further, Applicant's mark "etoncie" contains a distinctive heart shape above the letter "i" in its spelling. The setting in which a designation is used affects its appearance and colors the impression conveyed by it. In this connection, placement of the marks next to other identifying but dissimilar symbols is clearly relevant. Here, Applicant plans to always use the name etoncie name next to a likeness of all of its bags. In addition, the words "And Design" always will be prominently displayed wherever the name "etoncie" appears. Thus, the two marks appear

in strikingly different contexts and project wholly different visual displays. Moreover, the prominence of Opposer's Mark ETONIC, is widely recognized as a source of athletic shoe wear, will make it clear that the merchandise itself parodies ETONIC's product, a message which depends for its success on distinguishing etoncie and Design from ETONIC. Therefore, although the two marks are superficially similar, in all likelihood the parodic context in which the name "etoncie" appears will distinguish the marks in the consumer's mind.

SIXTH AFFIRMATIVE DEFENSE
(Proximity of Products)

21. As a Sixth and Separate Affirmative Defense, Applicant alleges that Applicant's Mark, as it appears on merchandise, will be defined almost entirely by its appearance on all-purpose bags. This connection will be strengthened by the presence of the etoncie and Design logo. Thus, it is unlikely that consumers will confuse merchandise featuring etoncie with similar items displaying the ETONIC trademark.

SEVENTH AFFIRMATIVE DEFENSE
(Bridging the Gap)

22. As a Seventh and Separate Affirmative Defense, Applicant alleges that there is no evidence that consumers, members of the media, or anyone else has mistaken Applicant's Mark "etoncie and Design" as a promotional figure for Opposer's Mark "ETONIC", or as a character sponsored by ETONIC. This is true because there is no actual confusion because the vastly different contexts in which the marks at issue herein will appear militate against any possible confusion as to source or sponsorship.

EIGHTH AFFIRMATIVE DEFENSE
(No Bad Faith)

23. As an Eighth and Separate Affirmative Defense, Applicant alleges

Applicant's parody depends on consumer recognition that it's Mark "etoncie and Design" caters to a specific consumer that is not likely to be confused with Opposer's brand and product. Further, Applicant would have absolutely nothing to gain from creating a confusion among [merchandise consumers] causing them to believe there was a business association between Applicant and Opposer. Indeed, the lack of subtlety in Applicant's parody is evidence in itself that Applicant does not intend to deceit the public or its consumers because there is nothing to indicate that Applicant is acting in bad faith.

NINTH AFFIRMATIVE DEFENSE
(Quality of the Products)

24. As a Ninth and Separate Affirmative Defense, Applicant alleges that Applicant's products are high quality all-purpose bags, similar in this respect to Opposer's high quality shoes. However, similarity of quality as between ETONIC and etoncie is unlikely to cause confusion, because its products are not otherwise related to Opposer as to makeup, usage, etc., and will not damage Opposer's image.

TENTH AFFIRMATIVE DEFENSE
(Consumer Sophistication)

25. As a Tenth and Separate Affirmative Defense, Applicant alleges that a child or adult who would be likely to buy merchandise featuring Applicant's mark would do so "because she likes the all-purpose bags, not because she mistakenly thinks that it is an ETONIC product.

ELEVENTH AFFIRMATIVE DEFENSE
(Unclean Hands)

26. As an Eleventh and Separate Affirmative Defense, Applicant alleges that Opposer's claims in its Notice are barred, in whole or in part, by the doctrine of unclean hands of Opposer.

TWELFTH AFFIRMATIVE DEFENSE
(Lack of Secondary Meaning)

27. As a Twelfth and Separate Affirmative Defense, Applicant alleges that Opposer's alleged marks containing the term "etoncie and Design" lacks secondary meaning and are not protectable trademarks because Opposer cannot show that the primary significance of the term "etoncie and Design" in the minds of the consuming public is not etoncie and Design's product, but rather the source itself; therefore, Applicant is free to use the alleged trademark in commerce.

THIRTEENTH AFFIRMATIVE DEFENSE
(Generic Trademark)

28. As an Thirteenth and Separate Affirmative Defense, Applicant alleges that Opposer's alleged marks are generic for use on apparel sold by Opposer and Applicant's use of the term "etoncie and Design" in commerce is permissible.

FOURTEENTH AFFIRMATIVE DEFENSE
(No Famous Marks)

29. As a Fourteenth and Separate Affirmative Defense, Applicant alleges that Opposer's alleged marks have not obtained the level of fame, renown and distinctiveness sufficient to obtain relief as a famous mark under the Lanham Act or other applicable state and federal laws.

FIFTEENTH AFFIRMATIVE DEFENSE
(No False Designation of Origin)

30. As a Fifteenth and Separate Affirmative Defense, Applicant alleges that Opposer cannot establish that Applicant has engaged in acts of false designation of origin prohibited under the Lanham Act on grounds including, without limitation, that Applicant legitimately used the trademarks, service marks, and/or trade names to identify products

and services to the public and are exercising its legitimate trademark rights in commerce.

SIXTEENTH AFFIRMATIVE DEFENSE
(No Trademark Infringement)

31. As a Sixteenth and Separate Affirmative Defense, Applicant alleges that Opposer cannot establish that Applicant has engaged in acts of trademark infringement prohibited under the Lanham Act on grounds including, without limitation, that Applicant legitimately uses the trademarks, service marks, and/or trade names to identify products and services to the public and are exercising its legitimate trademark rights in commerce. Applicant's mark is unique to Opposer's alleged marks in style, color, and content, and in no way refers to or implies any relation to the ETONIC brand of shoes.

SEVENTEENTH AFFIRMATIVE DEFENES
(Additional Defenses)

32. As a Seventeenth and Separate Affirmative Defense, as Applicant's discovery and investigation continues, Applicant reserves the right to assert additional defenses as they become known as to all claims asserted against them, whether or not submitted and/or tendered.

DATED: November 13, 2015

Respectfully submitted,
LAW OFFICES OF PAUL P. CHENG

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CERTIFICATE OF SERVICE

I hereby certify that on November a true and complete copy of the foregoing Answer to Notice of Opposition has been served on William H. Cox – Gordon, Herlands, Randolph & Cox, LLP, by mailing said copy on November 13, 2015, via First Class Mail, postage prepaid to William H. Cox – Gordon, Herlands, Randolph & Cox, LLP, 355 Lexington Avenue, New York, NY 10017, counsel to Opposer Etonic Holdings, LLC.

Date: November 13, 2015

Victor Estrada