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Filing date: **05/11/2016**

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

Proceeding	91224533
Party	Defendant Dazzle Up, LLC
Correspondence Address	DAVID W SAR BROOKS PIERCE MCLENDON HUMPHREY & LEONARD PO BOX 26000 GREENSBORO, NC 27420-6000 UNITED STATES dsar@brookspierce.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	David W. Sar
Filer's e-mail	dsar@brookspierce.com
Signature	/DavidWSar/
Date	05/11/2016
Attachments	Filing Motion for Leave 2016 05 11.pdf(180790 bytes)

Under Fed. R. Civ. P. 15, Applicant has 14 days after service to respond to the First Amended Notice of Opposition. Applicant's filing is therefore timely.

To the extent Applicant's current pleading is considered an amendment to its prior filing rather than a first response to the newly filed First Amended Notice of Opposition, it is noted that the Board "liberally grant[s] leave to amend at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would be prejudicial to the rights of the adverse party or would violate settled law." *Prosper Bus. Dev. Corp. v. International Business Machines, et al.*, 2014 TTAB LEXIS 354, *12-17, 113 USPQ2d 1148 (TTAB 2014) (granting motion to amend answer filed prior to due date for initial disclosures, as well as motion to amend notice of opposition).

Discovery recently commenced in this case and will not close for another five (5) months, on October 9, 2016. According to the Board's April 11, 2015 Order in this case and the parties' agreement as reflected in their April 11, 2016 motion for an extension, the parties have until May 11, 2016 to amend pleadings. Further, according to the same Order and agreement, initial disclosures are not due until May 11, 2016. The timing of Applicant's filing satisfies both the Order and the agreement concerning the timing of amendments.

Further, the changes in Applicant's pleading both respond to Opposer's amendment and are clarifying in nature. With respect to the clarifying changes, in both its original Answer and its Amended Answer, it was asserted by Applicant in the "Fourth Defense" that Opposer could not establish prior use and/or prior rights as compared to Applicant with respect to any allegedly confusingly similar mark. In the interests of clarity, Applicant's amendment adds an "Eighth Defense" with language giving notice that Applicant has priority for SIMPLY SOUTHERN as compared to Opposer's rights, in two ways. First, under the tacking doctrine, Applicant has

priority from its, or its predecessor-in-interest's, usage of SIMPLY SOUTHERN CHIC at least as early as March 2011 for costume jewelry and even earlier for t-shirts, as compared to Opposer's later use in 2011, as Opposer's store did not open until October 2011. Second, and as further stated in the Eighth Defense, in the alternative and if Applicant's priority date for SIMPLY SOUTHERN does not tack to its earlier date for SIMPLY SOUTHERN CHIC, Applicant's use of SIMPLY SOUTHERN still has priority over Opposer as Applicant, through its predecessor-in-interest and itself, began switching to SIMPLY SOUTHERN and thus using and selling costume jewelry and other products under that mark in September/October 2011 at a time, upon information and belief, prior to Opposer's priority date.

A related express denial concerning the priority issue is also added in paragraph 4 of the answer. The basis for the counterclaim is unchanged as compared to the prior filing.

Opposer has consented to this motion. And, Opposer will not be prejudiced. Opposer will have opportunity to explore and address the merits of the case. Discovery recently opened and will not close for about five (5) months, on October 9, 2016. Neither party has yet served initial disclosures, interrogatories, document request or other written discovery requests, nor have any depositions been scheduled. As in *Prosper Bus. Dev. Corp. v. International Business Machines, et al.*, 2014 TTAB LEXIS 354, *12-17, 113 USPQ2d 1148 (TTAB 2014), this motion is filed before the time for initial disclosures has elapsed.

Applicant's motion should therefore be granted.

WHEREFORE, Applicant requests that its motion be granted and that its Answer to the Amended Notice of Opposition and Counterclaim be filed and treated as the currently operative pleading from Applicant.

Respectfully submitted this the 11th day of May, 2016.

/David W. Sar/
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Attorneys for Dazzle Up, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Motion for Leave to Amend and File Answer to Opposer's First Amended Notice of Opposition and Counterclaim, and Brief, with exhibits, has been served on Opposer (via its counsel) by mailing said copy on May 11, 2016 via e-mail and First Class Mail, postage prepaid, and addressed as follows:

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Attorneys for Dazzle Up, LLC

EXHIBIT A

**Applicant's Answer to First Amended Notice of Opposition and
Counterclaim**

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

SIMPLY SOUTHERN FINE ARTS AND HOME DÉCOR, LLC, Opposer/Registrant,)	
)	Opposition No. 91224533
)	Application Serial No. 86/450,713
v.)	
)	Counterclaim Cancellation Petition
)	Registration No. 3,335,887
DAZZLE UP, LLC, Applicant/Counterclaim Petitioner.)	
)	

**APPLICANT’S ANSWER TO FIRST AMENDED NOTICE OF OPPOSITION AND
COUNTERCLAIM**

Dazzle Up, LLC (“Applicant”), by and through undersigned counsel, and pursuant to 37 C.F.R. § 2.107 and TBMP §§ 313 & 315, hereby provides its answer and response to the First Amended Notice of Opposition (the “Notice”) of Simply Southern Fine Art and Home Décor, LLC (“Opposer”) and its counterclaim/petition to cancel as follows:

Pursuant to the Board’s April 11, 2015 Order in this case and the parties’ agreement as reflected in their April 11, 2016 motion for an extension, the deadline to amend pleadings is May 11, 2016, and this is timely filed.

**FIRST DEFENSE
(Answer to Allegations of Notice)**

Responding to the numbered paragraphs of the Notice, Applicant states as follows:

1. Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 1 of the Notice, and therefore denies the same.
2. Responding to the allegations of paragraph 2 of the Notice, it is admitted that the records of the United States Patent and Trademark Office (“USPTO”) reflect some of the

information alleged in paragraph 2 of the Notice, such as the referenced trademark registration, the recited goods, and the last listed owner of such registration. Except as expressly admitted, Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 2 of the Notice, and therefore denies the same.

3. Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 3 of the Notice, and therefore denies the same.

4. Responding to the allegations of paragraph 4 of the Notice, it is admitted that on November 11, 2014, Applicant filed trademark application Serial No. 86/450,713 (the “Application”). To the extent that paragraph 4 of the Notice alleges that a copy of the Application is attached to the Notice as Exhibit A, such allegation is denied. It is expressly denied that Opposer has prior use of SIMPLY SOUTHERN as compared to Applicant’s first use. Except as expressly admitted or denied, Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 4 of the Notice, and therefore denies the same.

5. Applicant denies the allegations contained in paragraph 5 of the Notice.

6. Responding to the allegations of paragraph 6 of the Notice, Applicant admits that that Opposer has not informed Applicant that it has granted any trademark rights to Applicant; that Applicant is not affiliated with, connected with, endorsed by, or sponsored by Opposer; and that Opposer has not informed Applicant that it has approved any of the goods offered or sold, or intended to be sold by Applicant under the Opposed Mark. Except as expressly admitted, Applicant denies the allegations in paragraph 6 of the Notice.

7. Responding to the allegations of paragraph 7 of the Notice, Applicant admits that the mark for which registration is sought through its application Serial No. 86/450,713 is SIMPLY

SOUTHERN. Except as expressly admitted, Applicant denies the allegations contained in paragraph 7 of the Notice.

8. Applicant denies the allegations contained in paragraph 8 of the Notice.

9. Applicant denies the allegations contained in paragraph 9 of the Notice.

10. Applicant denies the allegations contained in paragraph 10 of the Notice.

11. Applicant denies the allegations contained in paragraph 11 of the Notice.

With respect to Opposer's prayer for relief, Applicant expressly denies Opposer is entitled to any relief.

ADDITIONAL DEFENSES/RESPONSES

Applicant asserts the following additional defenses or responses to the Notice. The fact of an assertion below and herein does not amount to an admission or a denial that the matter set forth is properly characterized as an affirmative defense as opposed to a specific denial of a matter for which the Opposer bears the burden of proof, as such a determination is a matter of law for the Board. Applicant reserves the right to, and may assert any and all other valid defenses and/counterclaims that may be learned of or developed through discovery and/or testimony in this proceeding.

SECOND DEFENSE (Failure to State a Claim—Fed. R. Civ. P. 12(b)(6))

The allegations asserted in the Notice fail to state a claim upon which relief can be granted against Applicant in this proceeding and should be dismissed.

THIRD DEFENSE (No Likelihood of Confusion)

The goods recited in the Application are different from the retail and computerized online ordering services identified in United States trademark registration No. 3,335,887 and other

goods/services with which Opposer alleges that it has used its alleged mark and on which it bases this Opposition, and there is no likelihood of confusion.

**FOURTH DEFENSE
(Different Marks; Lack of Prior Rights)**

Upon information and belief, one name and mark purportedly used by Opposer, if any, is Simply Southern Fine Art and Home Décor or Simply Southern Fine Arts and Home Décor, not Simply Southern. Upon information and belief, Opposer cannot establish prior use and/or prior rights as compared to Applicant with respect to any allegedly confusingly similar mark, or a likelihood of confusion with a mark it has purportedly used. To the extent Opposer has commenced using the two-word phrase Simply Southern, it has done so after Applicant established its rights and/or use of SIMPLY SOUTHERN.

**FIFTH DEFENSE
(Abandonment)**

Upon information and belief, United States trademark registration No. 3,335,887 was abandoned and thus is not a proper basis on which to oppose the application.

**SIXTH DEFENSE
(Opposer Owns No Rights in the Cited Registration)**

Upon information and belief, United States trademark registration No. 3,335,887 was abandoned prior to the purported assignment of which Opposer apparently claims the benefit. Consequently, the purported assignment of which Opposer apparently claims the benefit was invalid, Opposer owns no valid trademark rights to United States trademark registration No. 3,335,887, and United States trademark registration No. 3,335,887 is not a proper basis on which to oppose the application.

**SEVENTH DEFENSE
(Different Parties; No Rights)**

Opposer previously identified itself in its original Notice of Opposition and prior requests for extensions of time to oppose as Simply Southern Fine Arts and Home Décor, LLC (with an “s” at the end of “Art”), and this opposition was captioned with such name. That entity, to the extent it existed or exists, is not the assignee of United States trademark registration No. 3,335,887, nor is it the last listed owner of United States trademark registration No. 3,335,887, according to United States Patent and Trademark Office’s on-line records. The assignment available through the United States Patent and Trademark Office’s on-line records indicates that United States trademark registration No. 3,335,887 was assigned to Simply Southern Fine Art and Home Décor, LLC (without an “s” at the end of “Art”). To the extent the Opposer properly identified itself originally (with an “s” at the end of “Art”), it owns no rights in United States trademark registration No. 3,335,887, and, upon information and belief, also holds no other rights in the names in question, and its opposition should be dismissed.

EIGHTH DEFENSE
(Applicant Has Priority; Tacking)

Upon information and belief, Applicant has priority for SIMPLY SOUTHERN as compared to Opposer’s rights. Under the tacking doctrine, Applicant has priority from its, or its predecessor-in-interest’s, usage of SIMPLY SOUTHERN CHIC at least as early as March 2011 for costume jewelry and even earlier for t-shirts. Upon information and belief, the earliest date of priority by Opposer of any of SIMPLY SOUTHERN, SIMPLY SOUTHERN FINE ART AND HOME DÉCOR or SIMPLY SOUTHERN FINE ARTS AND HOME DÉCOR, and in particular in connection with the sale of jewelry, was after Applicant’s date of priority. Upon information and belief, Opposer was not selling product until its store opened in October 2011. By comparison, Applicant, through its predecessor-in-interest, actually displayed for sale costume jewelry under its mark at least as early as March 2011, with sales at least as early April 2011.

In the alternative and if Applicant's priority date for SIMPLY SOUTHERN does not tack to its earlier date for SIMPLY SOUTHERN CHIC, Applicant's use of SIMPLY SOUTHERN still has priority over Opposer as Applicant, through its predecessor-in-interest and itself, began switching to SIMPLY SOUTHERN and established trademark priority for costume jewelry and other products under that mark in September/October 2011 at a time, upon information and belief, prior to Opposer's priority date.

WHEREFORE, Applicant requests that the First Amended Notice of Opposition proceeding be dismissed with prejudice and that Applicant's application be allowed to mature to registration.

COUNTERCLAIM

Dazzle Up, LLC, a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct., Greensboro, North Carolina 27410 (hereinafter "Applicant", "Petitioner" or "Dazzle Up"), believes it has been or will be damaged by the existence of Registration No. 3,335,887 for SIMPLY SOUTHERN (the "Registration"), is also the applicant for application Serial No. 86/450,713 which has been opposed on the basis, in part, of the Registration, and hereby asserts a counterclaim petitioning for the cancellation of the Registration, by and through counsel, pursuant to 15 U.S.C. § 1064(3) and TBMP § 313.

The grounds for this cancellation counterclaim are as follows:

1. Dazzle Up is a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct., Greensboro, North Carolina 27410.

2. Dazzle Up is the applicant for application Serial No. 86/450,713 which has been opposed by Simply Southern Fine Arts and Home Décor, LLC which has now filed an amendment reciting that its name is Simply Southern Fine Art and Home Décor, LLC (“Opposer”) on the basis, in part, of the Registration.

3. Opposer has alleged in its First Amended Notice of Opposition that it is a limited liability company formed under the laws of the State of Louisiana. Upon information and belief, Opposer has mis-identified itself.

4. Opposer claims ownership of the Registration in its First Amended Notice of Opposition. Opposer cites the Registration as a basis, in part, for its opposition to Dazzle Up’s application Serial No. 86/450,713.

5. Upon information and belief, Simply Southern Fine Art and Home Décor, LLC (“SSFAHD”) is a limited liability company organized and existing under the laws of the State of Louisiana.

6. SSFAHD is the last listed owner of record for the Registration shown on the on-line TSDR records of the United States Patent and Trademark Office.

7. As shown on the on-line records of the United States Patent and Trademark Office, SSFAHD was purportedly assigned the Registration on May 19, 2015.

8. Opposer requested an extension of time to file its Notice of Opposition on May 26, 2015.

9. The Registration - No. 3,335,887 - is for the mark SIMPLY SOUTHERN for “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs,

upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” in international class 035.

10. As reflected by the on-line records of the United States Patent and Trademark Office, the most recent prior owner of the Registration was Lawrence Taylor (“Taylor”), an individual who provided an address in Melbourne, Florida.

11. Upon information and belief, Taylor, or another prior owner of the Registration, ceased using with no intention to resume use of, and otherwise abandoned, the use of SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

12. Upon information and belief, Taylor, or another prior owner of the Registration, failed to use SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” for at least three consecutive years.

13. The Registration was abandoned, in part or in whole, within the meaning of 15 U.S.C. § 1064(3) & 1127.

14. The Registration should therefore be cancelled, in part or in whole, due to abandonment.

15. Dazzle Up has been damaged and will continue to be damaged if the Registration is permitted to remain on the Principal Register, including because the Registration has been cited by Opposer as a basis for its opposition to Dazzle Up's application Serial No. 86/450,713.

WHEREFORE, Petitioner respectfully requests that this counterclaim/petition be sustained and that Registration No. 3,335,887 be cancelled, and also that Opposer's First Amended Notice of Opposition proceeding be dismissed with prejudice and that Applicant's application be allowed to mature to registration.

Please recognize as an attorney for Applicant/counterclaim petitioner in this proceeding, David W. Sar, and the law firm of Brooks, Pierce, McLendon, Humphrey & Leonard, LLP, P.O. Box 26000, Greensboro, North Carolina 27420, dsar@brookspierce.com.

Respectfully submitted this the 11th day of May, 2016.

/David W. Sar/
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Attorneys for Dazzle Up, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Answer to First Amended Notice of Opposition and Counterclaim has been served on Opposer (via its counsel) by mailing said copy on May 11, 2016 via e-mail and First Class Mail, postage prepaid, and addressed as follows:

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Attorneys for Dazzle Up, LLC

EXHIBIT B

Redline Comparison of

Applicant's Answer to First Amended Notice of Opposition and

Counterclaim

to

Applicant's Amended Answer to Notice of Opposition and

Counterclaim

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

_____)	
SIMPLY SOUTHERN FINE ARTS)	
AND HOME DÉCOR, LLC,)	Opposition No. 91224533
Opposer/Registrant,)	Application Serial No. 86/450,713
)	
v.)	Counterclaim Cancellation Petition
)	Registration No. 3,335,887
DAZZLE UP, LLC,)	
Applicant/Counterclaim)	
Petitioner.)	
_____)	

**APPLICANT'S ~~AMENDED~~ ANSWER TO FIRST AMENDED NOTICE OF
OPPOSITION AND COUNTERCLAIM**

Dazzle Up, LLC ("Applicant"), by and through undersigned counsel, and pursuant to 37 C.F.R. § 2.107 and TBMP §§ 313 & 315, hereby provides its ~~amended~~ answer and response to the First Amended Notice of Opposition (the "Notice") of Simply Southern Fine ~~Arts~~Art and Home Décor, LLC ("Opposer") and its counterclaim/petition to cancel as follows:

Pursuant to the Board's ~~November 25~~April 11, 2015 Order in this case, ~~37 C.F.R. § 2.196,~~ and ~~TBMP 112~~the parties' agreement as reflected in their April 11, 2016 motion for an extension, the deadline ~~for filing an Answer to amend pleadings is today, January 4, 2015, the next succeeding non-holiday weekday following the deadline which fell on a federal holiday~~May 11, 2016, and this is timely filed.

FIRST DEFENSE
(Answer to Allegations of Notice ~~of Opposition~~)

Responding to the numbered paragraphs of the Notice, Applicant states as follows:

1. Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 1 of the Notice, and therefore denies the same.

2. Responding to the allegations of paragraph 2 of the Notice, it is admitted that the records of the United States Patent and Trademark Office (“USPTO”) reflect some of the information alleged in paragraph 2 of the Notice, such as the referenced trademark registration, the recited goods, and the last listed owner of such registration. Except as expressly admitted, Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 2 of the Notice, and therefore denies the same.

3. Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 3 of the Notice, and therefore denies the same.

4. Responding to the allegations of paragraph 4 of the Notice, it is admitted that on November 11, 2014, Applicant filed trademark application Serial No. 86/450,713 (the “Application”). To the extent that paragraph 4 of the Notice alleges that a copy of the Application is attached to the Notice as Exhibit A, such allegation is denied. It is expressly denied that Opposer has prior use of SIMPLY SOUTHERN as compared to Applicant’s first use. Except as expressly admitted or denied, Applicant lacks information or knowledge sufficient to form a belief as to the allegations contained in paragraph 4 of the Notice, and therefore denies the same.

5. Applicant denies the allegations contained in paragraph 5 of the Notice.

6. Responding to the allegations of paragraph 6 of the Notice, Applicant admits that that Opposer has not informed Applicant that it has granted any trademark rights to Applicant; that Applicant is not affiliated with, connected with, endorsed by, or sponsored by Opposer; and that Opposer has not informed Applicant that it has approved any of the goods offered or sold, or intended to be sold by Applicant under the Opposed Mark. Except as expressly admitted, Applicant denies the allegations in paragraph 6 of the Notice.

7. Responding to the allegations of paragraph 7 of the Notice, Applicant admits that the mark for which registration is sought through its application Serial No. 86/450,713 is SIMPLY SOUTHERN. Except as expressly admitted, Applicant denies the allegations contained in paragraph 7 of the Notice.

8. Applicant denies the allegations contained in paragraph 8 of the Notice.

9. Applicant denies the allegations contained in paragraph 9 of the Notice.

10. Applicant denies the allegations contained in paragraph 10 of the Notice.

11. Applicant denies the allegations contained in paragraph 11 of the Notice.

With respect to Opposer's prayer for relief, Applicant expressly denies Opposer is entitled to any relief.

ADDITIONAL DEFENSES/RESPONSES

Applicant asserts the following additional defenses or responses to the Notice. The fact of an assertion below and herein does not amount to an admission or a denial that the matter set forth is properly characterized as an affirmative defense as opposed to a specific denial of a matter for which the Opposer bears the burden of proof, as such a determination is a matter of law for the Board. Applicant reserves the right to, and may assert any and all other valid defenses and/counterclaims that may be learned of or developed through discovery and/or testimony in this proceeding.

SECOND DEFENSE (Failure to State a Claim—Fed. R. Civ. P. 12(b)(6))

The allegations asserted in the Notice fail to state a claim upon which relief can be granted against Applicant in this proceeding and should be dismissed.

THIRD DEFENSE (No Likelihood of Confusion)

The goods recited in the Application are different from the retail and computerized online ordering services identified in United States trademark registration No. 3,335,887 and other goods/services with which Opposer alleges that it has used its alleged mark and on which it bases this Opposition, and there is no likelihood of confusion.

**FOURTH DEFENSE
(Different Marks; Lack of Prior Rights)**

Upon information and belief, ~~the~~one name and mark purportedly used by Opposer, if any, is Simply Southern Fine Art and Home Décor or Simply Southern Fine Arts and Home Décor, not Simply Southern. Upon information and belief, Opposer cannot establish prior use and/or prior rights as compared to Applicant with respect to any allegedly confusingly similar mark, or a likelihood of confusion with a mark it has purportedly used. To the extent Opposer has commenced using the two-word phrase Simply Southern, it has done so after Applicant established its rights and/or use of SIMPLY SOUTHERN.

**FIFTH DEFENSE
(Abandonment)**

Upon information and belief, United States trademark registration No. 3,335,887 was abandoned and thus is not a proper basis on which to oppose the application.

**SIXTH DEFENSE
(Opposer Owns No Rights in the Cited Registration)**

Upon information and belief, United States trademark registration No. 3,335,887 was abandoned prior to the purported assignment of which Opposer apparently claims the benefit. Consequently, the purported assignment of which Opposer apparently claims the benefit was invalid, Opposer owns no valid trademark rights to United States trademark registration No.

3,335,887, and United States trademark registration No. 3,335,887 is not a proper basis on which to oppose the application.

**SEVENTH DEFENSE
(Different Parties; No Rights)**

Opposer ~~identifies previously identified~~ itself in ~~the Notice~~its original Notice of Opposition and prior requests for extensions of time to oppose as Simply Southern Fine Arts and Home Décor, LLC (with an “s” at the end of “Art~~”~~), and this opposition was captioned with such name. That entity, to the extent it existed or exists, is not the assignee of United States trademark registration No. 3,335,887, nor is it the last listed owner of United States trademark registration No. 3,335,887, according to United States Patent and Trademark Office’s on-line records. The assignment available through the United States Patent and Trademark Office’s on-line records indicates that United States trademark registration No. 3,335,887 was assigned to Simply Southern Fine Art and Home Décor, LLC (without an “s” at the end of “Art”). To the extent the Opposer ~~has~~ properly identified itself originally (with an “s” at the end of “Art”), it owns no rights in United States trademark registration No. 3,335,887, and, upon information and belief, also holds no other rights in the names in question, and its opposition should be dismissed.

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(Applicant Has Priority; Tacking)

Upon information and belief, Applicant has priority for SIMPLY SOUTHERN as compared to Opposer’s rights. Under the tacking doctrine, Applicant has priority from its, or its predecessor-in-interest’s, usage of SIMPLY SOUTHERN CHIC at least as early as March 2011 for costume jewelry and even earlier for t-shirts. Upon information and belief, the earliest date of priority by Opposer of any of SIMPLY SOUTHERN, SIMPLY SOUTHERN FINE ART AND HOME DÉCOR or SIMPLY SOUTHERN FINE ARTS AND HOME DÉCOR, and in particular

in connection with the sale of jewelry, was after Applicant's date of priority. Upon information and belief, Opposer was not selling product until its store opened in October 2011. By comparison, Applicant, through its predecessor-in-interest, actually displayed for sale costume jewelry under its mark at least as early as March 2011, with sales at least as early April 2011.

In the alternative and if Applicant's priority date for SIMPLY SOUTHERN does not tack to its earlier date for SIMPLY SOUTHERN CHIC, Applicant's use of SIMPLY SOUTHERN still has priority over Opposer as Applicant, through its predecessor-in-interest and itself, began switching to SIMPLY SOUTHERN and established trademark priority for costume jewelry and other products under that mark in September/October 2011 at a time, upon information and belief, prior to Opposer's priority date.

WHEREFORE, Applicant requests that the First Amended Notice of Opposition proceeding be dismissed with prejudice and that Applicant's application be allowed to mature to registration.

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COUNTERCLAIM

Dazzle Up, LLC, a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct., Greensboro, North Carolina 27410 (hereinafter "Applicant", "Petitioner" or "Dazzle Up"), believes it has been or will be damaged by the existence of Registration No. 3,335,887 for SIMPLY SOUTHERN (the "Registration"), is also the applicant for application Serial No. 86/450,713 which has been opposed on the basis, in part, of the Registration, and hereby asserts a counterclaim petitioning for the cancellation of the Registration, by and through counsel, pursuant to 15 U.S.C. § 1064(3) and TBMP § 313.

The grounds for this cancellation counterclaim are as follows:

1. Dazzle Up is a limited liability company organized and existing under the laws of the State of North Carolina, with a principal place of business located at 4300 Waterleaf Ct., Greensboro, North Carolina 27410.
2. Dazzle Up is the applicant for application Serial No. 86/450,713 which has been opposed by Simply Southern Fine Arts and Home Décor, LLC which has now filed an amendment reciting that its name is Simply Southern Fine Art and Home Décor, LLC (“Opposer”) on the basis, in part, of the Registration.
3. Opposer has alleged in its First Amended Notice of Opposition that it is a limited liability company formed under the laws of the State of Louisiana. Upon information and belief, Opposer has mis-identified itself.
4. Opposer claims ownership of the Registration in its First Amended Notice of Opposition. Opposer cites the Registration as a basis, in part, for its opposition to Dazzle Up’s application Serial No. 86/450,713.
5. Upon information and belief, Simply Southern Fine Art and Home Décor, LLC (“SSFAHD”) is a limited liability company organized and existing under the laws of the State of Louisiana.
6. SSFAHD is the last listed owner of record for the Registration shown on the on-line TSDR records of the United States Patent and Trademark Office.
7. As shown on the on-line records of the United States Patent and Trademark Office, SSFAHD was purportedly assigned the Registration on May 19, 2015.
8. Opposer requested an extension of time to file its Notice of Opposition on May 26, 2015.

9. The Registration - No. 3,335,887 - is for the mark SIMPLY SOUTHERN for “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” in international class 035.

10. As reflected by the on-line records of the United States Patent and Trademark Office, the most recent prior owner of the Registration was Lawrence Taylor (“Taylor”), an individual who provided an address in Melbourne, Florida.

11. Upon information and belief, Taylor, or another prior owner of the Registration, ceased using with no intention to resume use of, and otherwise abandoned, the use of SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals.”

12. Upon information and belief, Taylor, or another prior owner of the Registration, failed to use SIMPLY SOUTHERN for all, or some, of “Retail and computerized online ordering services featuring home furnishings, wall accessories, candles, tableware, housewares, glasswares, floral wreaths, wall shelves, benches, chairs, upholstered furnishings, clocks, wall artwork, primitive notecards, stationery, primitive dolls, wood figurines, pottery, baskets, pillows, rugs, dried florals,” for at least three consecutive years.

13. The Registration was abandoned, in part or in whole, within the meaning of 15 U.S.C. § 1064(3) & 1127.

14. The Registration should therefore be cancelled, in part or in whole, due to abandonment.

15. Dazzle Up has been damaged and will continue to be damaged if the Registration is permitted to remain on the Principal Register, including because the Registration has been cited by Opposer as a basis for its opposition to Dazzle Up's application Serial No. 86/450,713.

WHEREFORE, Petitioner respectfully requests that this counterclaim/petition be sustained and that Registration No. 3,335,887 be cancelled, and also that Opposer's First Amended Notice of Opposition proceeding be dismissed with prejudice and that Applicant's application be allowed to mature to registration.

Please recognize as an attorney for Applicant/counterclaim petitioner in this proceeding, David W. Sar, and the law firm of Brooks, Pierce, McLendon, Humphrey & Leonard, LLP, P.O. Box 26000, Greensboro, North Carolina 27420, dsar@brookspierce.com.

Respectfully submitted this the ~~4th~~11th day of ~~January~~May, 2016.

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's ~~Amended~~ Answer to First Amended Notice of Opposition and Counterclaim has been served on Opposer (via its counsel) by mailing said copy on ~~January 4~~May 11, 2016 via e-mail and First Class Mail, postage prepaid, and addressed as follows:

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