

ESTTA Tracking number: **ESTTA721208**

Filing date: **01/19/2016**

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

Proceeding	91224783
Party	Defendant Badih Khamis
Correspondence Address	BADIH KHAMIS 6395 COTE DE LIESSE MONTREAL, QC H4T 1E5 CANADA bkhamis@linendepotdirect.com, bobkhamis@gmail.com, opt@marimacgroup.com
Submission	Answer and Counterclaim
Filer's Name	Badih Khamis
Filer's e-mail	opt@marimacgroup.com, bobkhamis@gmail.com
Signature	/BADIH KHAMIS/
Date	01/19/2016
Attachments	NAKED Counterclaim.pdf(3192818 bytes)

Registration Subject to the filing

Registration No	3669650	Registration date	08/18/2009
Registrant	NAKED BRAND GROUP INC. 311 S. Division Street Carson City, NV 89703 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

<p>Class 025. First Use: 1998/06/01 First Use In Commerce: 2009/05/09 All goods and services in the class are requested, namely: [MEN'S CLOTHING, namely, CAPS;] T-SHIRTS, TOPS, [TANK TOPS, JACKETS, PANTS, TROUSERS, JEANS, SHORTS;] LOUNGEWEAR, [ROBES, BATHROBES,] PAJAMAS, BOXER SHORTS, UNDERGARMENTS, [SWIMWEAR, BATHING TRUNKS; WOMEN'S CLOTHING, NAMELY, CAPS; T-SHIRTS,] TANK TOPS, [CROP TOPS, BLOUSES, DRESSES, SKIRTS, PANTS, JEANS, COATS,] LINGERIE, BRAS, [UNDERGARMENTS, UNDERGARMENT THONGS, BUSTIERS, CORSETS,] CAMISOLES, CHEMISES, NIGHTGOWNS, PEIGNOIRSETS, TEDDIES, PAJAMAS, ROBES, BATHROBES, [SWIMWEAR, BATHING SUITS, BEACH THONGS]</p>

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

RE: U.S. Trademark Application Serial No. 75568492
Published in the Official Gazette on 7 March, 2006

BADIH KHAMIS)	
)	
Opposer)	
)	Counter Claim No.: _____
)	
-v-)	
)	
NAKED BRAND GROUP, INC.)	
)	
Applicant)	
_____)	

COUNTERCLAIM

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

In the matter of Trademark U.S. Registration No. 3,669,650 for the generic English Word NAKED, related to Naked Brand Group Inc. (Opposer) of Carson City, Nevada, Badih Khamis (Applicant) believes that not one person, nor one company can own a generic word found in the English Language; especially in the United States of America, where the English Language is the primary language for most of the commerce that occur in the U.S.A. Badih Khamis pleads a claim of genericness for the Trademark NAKED and affirmatively alleges that the registered term is generic and does not

apply to specific goods for which it is registered for and the relevant consuming public does not primarily describe the genus of the goods being sold. The grounds for this Counterclaim are as follows:

1. This Counterclaim is related to the Notice of Opposition filed by Naked Brand Group Inc. and Answer to Notice of Opposition filed by Badih Khamis under Opposition No. 91224783 and Application No. 86063139
2. Upon information and belief, Opposer, Naked Brand Group Inc., is a Nevada corporation and Black Ice by Design Inc., a Canadian Company in the province of Ontario, is the owner of the Trademark NAKED. Under U.S. Registration No. 3,669,650 for the mark NAKED, currently covering goods described as “t-shirts, tops, loungewear, pajamas, boxer shorts, undergarments, tank tops, lingerie, bras, camisoles, chemises, nightgowns, peignoir sets, teddies, robes, bathrobes”, in the International Class 025 (collectively “Opposers Goods”)
3. Applicant denies that the generic English word NAKED can be owned and/or monopolized by a company or person. Badih Khamis requests the Cancellation of the Trademark Serial No. 75568492, for the generic word NAKED.
4. Applicant denies that the Opposer can own the English word NAKED. NAKED is an adjective in the English language and is a word by definition, meaning nude, bare, unclothed, undressed, etc. The Opposer is attempting to monopolize the word NAKED, a situation that should not be permitted. U.S. Registration No. 3,669,650 should be withdrawn from the United States Patent and Trademark Office.

Exhibit A

5. The word NAKED is not a name similar to Nike, Adidas, Kleenex, Coke, Pepsi etc., where these names can be associated with another word, making it an Intellectual Property. For example:

When one hears or sees the word;

- Nike – one would think of running shoes and athletics
- Kleenex – one would think of tissues
- Coke – one would think of a soft drink

When a person hears or sees the word NAKED, consumers would think of an undressed person or a bare room or an undressed manikin or nude toy, doll etc., NAKED is not a brand that would make consumers think of t-shirts, tops, loungewear, pajamas, boxer shorts, undergarments etc.

6. Applicant respectfully denies the right of the Opposer to be granted the “NAKED” trademark since the word NAKED alone is a generic English word commonly used and without any reference to particular product or corporation. Yet Applicant admits and agrees that, Opposer is the owner of eleven Trademarks that all consist of two words, one of which, include the English word NAKED. Applicant does not contest the two word combination trademarks.

Exhibit B

7. Applicant acknowledges Opposers 11 trademarks, all of which are two word trademarks with the English word NAKED combined with a second word. United States Patents and Trademark offices website search function lists over 2000 trademarks that the English word NAKED is affiliated to. Some are similar to the following brands, that are not owned by Opposer, yet all are in the same International Class 025 and have the inclusion of the generic word NAKED in conjunction with another word.

- BUCK NAKED
- BUTT NAKED
- NAKED NOMAD
- NAKED WARDROBE
- NAKED ANTLERS
- VAPE NAKED
- NAKED&RICH
- SURF NAKED
- SLEEP NAKED
- NAKED TRUTH
- FIT TO BE NAKED

All trademarks with the word Naked as a part of their name and are under the International Class 025 status. All listed trademarks co-exist in the USA market with the Opposers Trademark and all infringe on the Opposers Trademark. How can one tell if each of these names is legally acceptable on the market with the NAKED Trademark? With the Opposers' Trademark of the word NAKED, Opposer proceeds to take legal action against other entities for the use of the English word NAKED.

8. Opposer has over 19 Trademarks owned and/or in process, all of which are two words each and contain the word NAKED. There are countless combinations of words that could be affiliated with the commonly used, word NAKED and the Applicant believes that limiting ownership of one word to one Trademark is not in the best interest of the USA market. Limiting creativity,

growth, ideas, advertising ideas, etc. would limit an economy of its abilities to grow and diversify. Registration No. 3,669,650, should be cancelled to avoid future conflicts and legal proceedings.

9. Applicant considers that the trademark on the word NAKED alone should not have been granted. Applicant will rely on the United States Patent and Trademark Office to render a fair judgment made in good faith, based on other situations and in the best interest of the U.S. market.
A Trademark is an Intellectual property. An intellectual property for this particular case, is a creative word, words, name, or phrase. The word NAKED is not a creative word like; Nike, Adidas, Kleenex, Coke, etc. NAKED is a common English word that is used by the general public and should not be monopolized by one person or entity.
10. NAKED is a commonly used word in the English language. It does not describe the genus of the goods identified in Opposers registration under International Class 025.
11. The word NAKED cannot be monopolized alone. If there is no confusion with the “Naked” used by other brands that already do not belong to Opposer. Furthermore, the Opposer has 19 variations of the generic word NAKED in conjunction with other words which leads the Applicant to believe that the word NAKED was not sufficient alone to create a distinctive brand in the minds of consumers. NAKED is a word, not a name and not a Trademark similar to Adidas, Nike and Coke, etc.
12. If one follows the Opposers’ logic, the alleged problem of confusion might arise with any product (clothing, tools, books, movies, etc.) in which the word NAKED is used since a consumer might think this product is related to the “NAKED” trademark.

13. Applicant's plea of claim of Genericness for the Trademark NAKED is due to the fact that it clearly does not apply to any specific goods of the Opposer and the general consumer is very unlikely to understand that NAKED primarily describes the genus of goods being sold by Naked Brand Group Inc.
14. Opposer knows the generic word NAKED is not sufficient alone for a Trademark. Opposer has expended funds to create 19 Two-Word Trademarks with the word NAKED in them. If NAKED was a name such as Adidas or Nike, there would be no need to create and register so many variations of the brand. Applicant believes that Nike for example, can use their Trademark and create variation brands such as; Nike Athletic, Nike Sport or even Nike Naked. Nike can use their Trademark in anyway, with other words found in the English language if it decides to NAKED. Confusion and conflict will continue to exist, as long as the NAKED Trademark exists.
15. In the applicants opinion and belief, the Trademark NAKED should be withdrawn by the United States Patent and Trademark Office.
16. Applicant believes that the generic word NAKED is not an Intellectual property that can be owned by anyone, nor any entity.
17. Confusion, mistake or purchase deception, does not exist with other brands with the word NAKED, that do not belong to the Opposer and, to the Applicant's knowledge, the Opposer did not ask or was not able to have those supposedly similar trademarks rejected. When one says Kleenex, most consumers know the product is a tissue. Coke is a soft drink, Nike is running

shoes. NAKED is not perceived as clothing, nor is any item related to Naked Brand Group Inc.
NAKED perceived as a state of undress, being nude, bare, unclothed, undressed etc.

WHEREFORE, Applicant prays that the Opposers Serial No.75568492 – Registration No. 3,669,650 for
the generic word NAKED be cancelled and abolished by the Trademark Trial and Appeal Board.

Respectfully submitted;

Date: 19 January 2016

By: Badih (Bob) Khamis

6395 Cote De Liesse

Montreal, Québec

H4T 1E5

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing "Counterclaim, has been served on January 19, 2016, to Michael J Leonard, Gerard P Norton, Christopher D Olszyk Jr. of Fox Rothschild LLP, by mailing said copy on January 19, 2015, via First Class Mail, postage prepaid, through Post Canada to: Michael J Leonard, Fox Rothschild LLP, 997 Lenox Drive, Building #3, Lawrenceville, NJ 08648-2311, United States.

Signature:



BADIH KHAMIS

Date:

January 19, 2016

EXHIBIT A



meaning of naked

bob



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na·ked

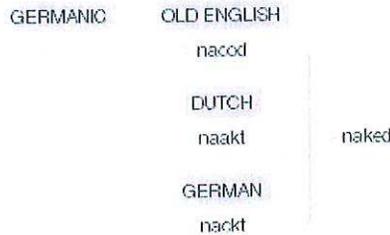
/ˈnākid/

adjective

adjective: **naked**

- (of a person or part of the body) without clothes.
 "he'd never seen a naked woman before"
synonyms: **nude, bare**, in the nude, stark naked, having nothing on, stripped, **unclothed, undressed**; [More](#)
antonyms: clothed, dressed
 - (of an object) without the usual covering or protection.
 "her room was lit by a single naked bulb"
synonyms: **unprotected, uncovered**, exposed, **unguarded**
 "a naked flame"
antonyms: covered
 - (of a tree, plant, or animal) without leaves, hairs, scales, shell, etc.
 "the twisted trunks and naked branches of the trees"
synonyms: **bare, barren**, denuded, stripped, **uncovered**
 "the naked branches of the trees"
 - exposed to harm; unprotected or vulnerable.
 "John looked naked and defenseless without his glasses"
synonyms: **vulnerable, helpless, weak, powerless, defenseless**, exposed, open to attack
 "I felt naked and exposed"
- (of something such as feelings or behavior) undisguised; blatant.
 "naked, unprovoked aggression"
synonyms: **undisguised, plain, unadorned, unvarnished, unqualified, stark, bald**.
[More](#)

Origin



Old English *nacod*, of Germanic origin; related to Dutch *naakt* and German *nackt*, from an Indo-European root shared by Latin *nudus* and Sanskrit *nagna*.

Translate naked to Choose language

Use over time for: naked



Show less

EXHIBIT B

Trademark	App. No./Reg. No.	Status/Status Date
BABY NAKED	SN: 77302916	Pending - Suspended March 25, 2014 Filed: October 12, 2007
NAKED BEACH	SN: 76005995	Allowed Filed: March 23, 2000
NAKED BEAUTY	SN: 76005990	Allowed Filed: March 23, 2000
NAKED BOYZ	SN: 76005988	Allowed Filed: March 23, 2000
NAKED DANCE	SN: 76011962	Allowed Filed: March 29, 2000
NAKED DESIRE	SN: 76005994	Allowed Filed: March 23, 2000
NAKED GIRL	SN: 76005989	Allowed Filed: March 23, 2000
NAKED SILHOUETTE	SN: 76005985	Allowed Filed: March 23, 2000

Trademark	App. No./Reg. No.	Status/Status Date
NAKED ATHLETICS	RN: 3974743 SN: 75568493	Registered June 7, 2011
NAKED ATTRACTION	RN: 4392517 SN: 77838986	Registered August 27, 2013
NAKED BOUND	RN: 4392513 SN: 77838931	Registered August 27, 2013
NAKED ECSTASY	RN: 4392518 SN: 77838995	Registered August 27, 2013
NAKED EROTICA	RN: 4392520 SN: 77839015	Registered August 27, 2013
NAKED FANTASY	RN: 4392519 SN: 77839007	Registered August 27, 2013
NAKED INNOCENCE	RN: 4392516 SN: 77838973	Registered August 27, 2013
NAKED KISS	RN: 4392514 SN: 77838950	Registered August 27, 2013
NAKED LOVE	RN: 4392521 SN: 77839041	Registered August 27, 2013
NAKED OBSESSION	RN: 4392515 SN: 77838962	Registered August 27, 2013
PLANET NAKED	RN: 4822252 SN: 76005983	Registered September 29, 2015