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

NAKED BRAND GROUP, INC.	)	**Opposition No.:** 91224783
Opposer	)	**Application No.:** 86063139
	)	**Mark:** NAKED UNDERNEATH
VS.	)	
	)	**Published in the Official Gazette on July 7, 2015**
BADIH KHAMIS	)	
	)	**Cancellation No.:** _____
Applicant	)	
	)	**Registration No.:** 3669650
	)	**Mark:** NAKED

ANSWER TO NOTICE OF OPPOSITION FOR SERIAL NO. 86/063139

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

Commissioner:

In the matter of application Serial No. 86/063139 filed September 12 2013 by Badih Khamis ("Applicant"), to register the mark NAKED UNDERNEATH for the goods described as "Clothing, namely, Underwear, Bath Robes, Shirts, T-Shirts, Sweaters, Pants" in International Class 025 ("Applicant's Goods"), which was published in the Official Gazette on July 7, 2015. Naked Brand Group Inc. ("Opposer") of Carson City, Nevada believes it will be damaged by the registration of NAKED UNDERNEATH mark and opposes same. The grounds for this defense and denial of the allegations are as follows:

02-01-2016
U.S. Patent & TM Ofc/TM Mail Rcpt Dt. #22

1. Answering paragraph 1 of the notice of opposition; Applicant admits allegations thereof.

2. Answering paragraph 2 of the notice of opposition; Applicant intends to use the mark NAKED UNDERNEATH in the USA and Canada, given that, Applicant owns the Canadian Trademark in Canada and owns a .ca domain named nakedunderneath.ca.

   Exhibit A.

3. Answering paragraph 3 of the notice of opposition; Applicant admits, upon information and belief that the Opposer is a Nevada Corporation but denies that the Opposer is the owner of the word NAKED. Opposer is the owner of the company called NAKED BRAND GROUP INC. and eleven trademarks that all contain the word NAKED, as per paragraph 7 of notice of opposition. Applicant had no knowledge of the existence of the Opposer, prior to the letter sent by Michael J. Leonard, dated October 9, 2015, and Applicant applied for the Trademark NAKED UNDERNEATH in good faith without any intent of direct competition nor conflict.

   Exhibit B

4. Answering paragraph 4 of the notice of opposition; Applicant lacks knowledge and information to admit or deny allegation. Applicant 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. But Applicant admits that, Opposer is the owner of eleven Trademarks that all consist of two words, one of which, include the English word NAKED.

5. Answering paragraph 5 of the notice of opposition; 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's opposition is based on monopolizing 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 C

6. Answering paragraph 6 of the notice of opposition; Applicant denies allegation on the bases of population and purchaser's class. Opposer advertises on their website, products related to International class 025 at values that are not affordable to the majority of consumers. Opposer's target market is the upper class, employees that pertain a feasible budget to purchase, for example; one pair of underwear at a cost of $32.00 in U.S funds. The upper class consumer is approximately 10% of the population of the U.S.A. In addition, Opposer targets the athletic and sportive markets, which reduces the percentage of individuals targeted, creating a small "niche" of people who could purchase the Opposer' s products with the use of professional sport celebrities. Applicants target market is extremely different than that of the Opposer. Applicant intends to target all categories of the middle class and the lower classes that can afford the NAKED UNDERNEATH brand. NAKED UNDERNEATH brand is more of a Joe Boxer underwear, found at Costco to a Tommy Hilfiger underwear found at a Hilfiger outlet. Opposer's brands are more of a Lacoste level of clothing to a Versace class that is more

intended for very high income individuals. Applicant strongly believes that both brands can co-exist in the diversified market, of the USA.

Exhibit D

Exhibit E

7. Answering paragraph 7 of the notice of opposition; Applicant admits allegation of Opposer's 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 2124 trademarks that the English word NAKED is affiliated to. Similar to the following brands, that are not owned by Opposer, yet all are in International Class 025 and have the inclusion of the generic word NAKED in conjunction with another word. In addition, the last 3 of the following Trademarks have the word NAKED in conjunction with more than one word.

- BUCK NAKED (Note: Website images in Exhibit F)
- BUTT NAKED
- NAKED NOMAD
- NAKED WARDROBE
- NAKED ANTLERS
- VAPE NAKED
- NAKED&RICH
- SURF NAKED
- SLEEP NAKED
- NAKED TRUTH

- FIT TO BE NAKED
- GO HARD TO LOOK GOOD NAKED
- FOR WHEN YOU ARE NAKED
- TOTALLY BUCK 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 Opposer's Trademark.

Applicant also denies date of first use. Applicant first started business in Canada, within the province of Quebec, when the Applicant first registered "surface style" company in 1990. In 1992-1993, Applicant began producing t-shirts with the mark NAKED UNDERNEATH. As mentioned in email;

Exhibit F

Exhibit G

8. Answering paragraph 8 of the notice of opposition; Applicant agrees with the allegations of paragraph 8 based on information provided by the Opposer, all of which can also co-exist with the Applicant's one Trademark, NAKED UNDERNEATH in the same class. Applicant, again denies the date of first use, as per reply in paragraph #7. 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. Answering paragraph 9 of the notice of opposition; Applicant considers that the trademark on the work NAKED alone should not have been granted in the first place. 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. NAKED UNDERNEATH is a new and creative expression that may provide fun, laughter and amusement to consumers of various types of clothing. Based on past experience; consumers found the expression generally cute, amusing and self-expressive on a t-shirt. It is conservative and proactive at the same time.

   Exhibit H

10. Answering paragraph 10 of the notice of opposition; Applicant does not have sufficient knowledge or information to form a belief as to the allegations contained therein. Applicant denies that the Opposer has commenced the use of the word NAKED prior to the Applicant since, Applicant started using the NAKED UNDERNEATH Brand in Canada in 1992-1993.

11. Answering paragraph 11 of the notice of opposition; Applicant has limited information on Opposers Advertising and promotional strategies. Countless corporations use common words in their own Trademarks, which is also used by other companies that co-exist in the market.

A famous Trademark co-existence example is "Pepsi Cola" and "Coca Cola". Both have creative names that incorporate the word "Cola" in the name of their individual brands. Both are carbonated soft drinks that compete in the international market, with continuous creativity in advertising, promotions and marketing. In addition; Presidents Choice also has a "Cola" called "PC Cola" that is sold at more affordable costs to lower income consumers. Opposer and Applicant can co-exist if the three mentioned giants, amongst many more brands that use the word "Cola". NAKED UNDERNEATH is very unlikely to reach the levels of sales as Coke and Pepsi and will not affect market share with Opposer. NAKED UNDERNEATH will not affect Opposers sales, advertising, marketing, etc., as mentioned in Paragraph #6, due to the fact that other International Class 025 Trademarks with the word NAKED are already in the marketplace and Applicants target market is very different than that of the Opposer. NAKED UNDERNEATH would be targeted to much lower income consumers, similar to "Fruit of the Loom" sold in Walmart, and "Joe Boxer" sold in Costco and "Tommy Hilfiger" in Hilfiger outlets. Furthermore, based on the website, the Opposer sells underwear and sleepwear online. A consumer is free to buy online a product originating from any place in the world and the Applicant has been granted the trademark for NAKED

UNDERNEATH in Canada, and is therefore free to use that trademark in its online dealings.

Exhibit I

12. Answering paragraph 12 of the notice of opposition; Applicant admits that it did not request permission from Opposer since it does not need such a permission, being the owner of the Canadian trademark NAKED UNDERNEATH.

GROUNDS OF OPPOSITION

(UNLIKELYHOOD OF CONFUSION AND POSSIBLE CO-EXISTANCE)

13. Answering paragraph 13 of the notice of opposition; Applicant re-alleges the counter allegations of Applicant in paragraphs 1-12 of this notice of Opposition.

14. Answering paragraph 14 of the notice of opposition; Applicant denies the allegation. Confusion, mistake or purchase deception, may presently 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. Applicants brand NAKED UNDERNEATH is not a threat to Opposer's market, since the targeted markets are not the same.

15. Answering paragraph 15 of the notice of opposition; Applicant reaffirms all of its previous allegations.

16. Answering paragraph 16 of the notice of opposition; Applicant denies allegations as stipulated in Paragraph #2 through 12. Applicant and Opposer's Channels of Trade are very unlikely to conflict, other than on the internet, which is used by all and on which the Applicant has the right to carry out business under its Canadian trademark. 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, a co-existence with NAKED UNDERNEATH is possible. 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.

17. Answering paragraph 17 of the notice of opposition; Applicant denies all stated allegations. Applicant believes Opposer's brands and NAKED UNDERNEATH do not address the same class of purchasers and, that this difference in the consumer's class will avoid the possibility of confusion between the respective party's goods. The Applicant also believes that Opposer's alleged reputation in terms of quality and prestige to their higher level, upper class market will be sufficient to avoid confusion with the lower end products commercialized under NAKED UNDERNEATH. The high quality of the Opposer's products and the use of the UNDERNEATH on the products of the Applicant will avoid customers being mislead into thinking that NAKED UNDERNEATH is the

same as the products of the Opposer's. Furthermore, if one follows the Opposer's 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.

18. Answering paragraph 18 of the notice of opposition; Applicant denies allegation, since 13 other similar brands not related to Opposer are already using a name that includes the English word NAKED and the presence of NAKED UNDERNEATH should not change the retail position of the Oppose. NAKED UNDERNEATH and these 13 brands are that do not belong to the Opposer are clearly distinct between each other and cause no threat to Opposer.

19. Answering paragraph 19 of the notice of opposition; Applicant denies allegation. Other existing brands are active in the USA, along with the Opposer's brand and the presence of a new player in a "niche" different than the one the Opposer occupies would not violate or diminish the rights of the Opposer.

20. Answering paragraph 20 of the notice of opposition; Applicant re-alleges all responses contained in Paragraph #1-19 of this answer to the Notice of Opposition.

21. Answering paragraph 21 of the notice of opposition; Applicant denies that the generic English word NAKED can be owned and/or monopolized by one company or person.

22. Answering paragraph 22 of the notice of opposition; Applicant denies allegations and reaffirms that other trademarks with the word NAKED in it are already present in the market, for the same kind of products and do not seem to create confusion. Opposer may regret not thinking of the term NAKED UNDERNEATH before and would like to adopt the new mark for his own. NAKED UNDERNEATH is the Applicant's Intellectual Property, created in 1992-1993 and the Applicant should be entitled to use his brand.

23. Answering paragraph 23 of the notice of opposition; Applicant denies allegation, as per Paragraphs 7 and 10.

24. Answering paragraph 24 of the notice of opposition; Applicant denies allegations. Goods may be related but of different quality, pricing and target market. The channels of trade will be very different, except for the internet in which the Applicant has the right to use his NAKED UNDERNEATH trademark by virtue of a valid Canadian trademark.

25. Answering paragraph 25 of the notice of opposition; Applicant denies allegation. Opposer is making an assumption of the competence of the general public. When the Applicant performed an internet Google search of NAKED UNDERNEATH, none of the products of the Opposer showed in the results. The Applicant submits that this leads to believe that the consumer will not be mislead in thinking that NAKED UNDERNEATH brand is related to the Opposer's Brand, since these brands do not even show up in the Google search, therefore confusion is very unlikely.

Exhibit J

26. Answering paragraph 26 of the notice of opposition; Applicant denies allegations for reasons already stated in this Answer To Notice Of Opposition.

27. Answering paragraph 27 of the notice of opposition; Applicant denies and contests the statement in paragraph #27. NAKED UNDERNEATH mark should be granted the chance to be exploited in the USA market, as to any other NAKED marks that are not owned by the Opposer and that already exist in the USA Market.

WHEREFORE, Applicant prays that the Opposer and its Opposition is overruled and the Application Serial No.86/063139 for NAKED UNDERNEATH is granted, in good standing by the Trademark Trial and Appeal Board.

Respectfully re-submitted; as per request of USPTO, letter dated December 19, 2015.

Date: 18 January 2016

By: Badih (Bob) Khamis

6395 Cote De Liesse

Montreal, Quebec

H4T 1E5

Owner & Creator of the NAKE UNDERNEATH Brand

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing "Revised" ANSWER TO NOTICE OF OPPOSITION TO for Serial No. 86/063139, has been served on January 18, 2016, to Michael J Leonard, Gerard P Norton, Christopher D Olszyk Jr. of Fox Rothschild LLP, by mailing said copy on January 18, 2015, via Fist 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 18, 2016