

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

GCP

Mailed: December 19, 2015

Opposition No. 91224783

*Naked Brand Group, Inc.*

v.

*Badih Khamis*

**By the Trademark Trial and Appeal Board:**

On December 18, 2015, Applicant timely filed his answer to the notice of opposition. Applicant's answer also makes reference to a counterclaim seeking to cancel Opposer's pleaded Registration No. 3669650 for the mark NAKED on the ground that the term "NAKED" is generic. The Board notes that Applicant did not submit the required \$300.00 filing fee for his asserted counterclaim, *see* Trademark Rule 2.6(16), nor did Applicant set forth a proper claim for genericness as a ground for its counterclaim.

In order to plead properly a claim of genericness, a plaintiff must affirmatively allege that the registered term is generic as applied to the specific goods and services for which it is registered and that the relevant consuming public understands that the registered term primarily describes the genus of the goods and/or services being sold. *See, e.g., In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001). Here, however, Applicant has not

specifically alleged that the term NAKED is generic for any of the goods identified in Opposer's pleaded Registration No. 3669650 or that the relevant consuming public primarily understands that the term NAKED describes the genus of the goods identified in Opposer's registration. Instead, Applicant merely alleges that (1) "[n]aked is an adjective in the English language and is a word by definition, meaning nude, bear, 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 U.S. Registration No. 3,669,650 should be withdrawn from the United States Patent and Trademark Office," and (2) "Applicant denies that the generic English word NAKED can be owned and/or monopolized by one company or person." See ¶¶ 5 and 21, respectively, of Applicant's answer.

In view of the foregoing, Applicant is allowed until **January 6, 2016** in which to (1) file the \$300.00 filing fee for his intended counterclaim, and (2) file and serve an amended answer and counterclaim which properly sets forth a claim of genericness as a ground for his counterclaim, pursuant to the guidelines set forth above,<sup>1</sup> failing which Applicant's counterclaim will be given no further consideration.

Proceedings are otherwise suspended pending Applicant's response to this order.

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<sup>1</sup> Applicant should assert his counterclaim under a separate caption/heading from his answer to the notice of opposition. Applicant should also restate his answer to the allegations set forth in the notice of opposition in his amended pleading. Further, Applicant should not argue the merits of Opposer's asserted allegations in his answer. In accordance with Fed. R. Civ. P. 8(b), it is incumbent on Applicant to answer the notice of opposition by only specifically admitting or denying the allegations contained in each paragraph. If Applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, he should so state and this will have the effect of a denial.

**Pro Se Information**

The Board notes that Applicant is representing himself in this proceeding. Although Patent and Trademark Rule 11.14 permits an entity to represent itself, it is strongly advisable for a party who is not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with such matters. The United States Patent and Trademark Office (USPTO) cannot aid in the selection of an attorney. As the impartial decision maker, the Board may not provide legal advice; it may provide information solely as to procedure.

Any party who does not retain counsel should be familiar with the authorities governing this proceeding, including the Trademark Trial and Appeal Board Manual of Procedure (TBMP), and the Trademark Rules of Practice (37 C.F.R. Part 2), both accessible directly from the Board's web page: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Also on the Board's web page are links to ESTTA, the Board's electronic filing system<sup>2</sup> at <http://estta.uspto.gov>, and TTABVUE, for case status and prosecution history at <http://ttabvue.uspto.gov/ttabvue>.

Trademark Rules 2.119(a) and (b) require that every paper filed in the USPTO in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney. Proof of service must be made before the paper will be considered by the Board. Accordingly, copies of all papers filed in

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<sup>2</sup> The Board strongly encourages parties to file all papers through ESTTA, which operates in real time and provides a tracking number that the filing has been received. For assistance in using ESTTA, call 571-272-8500.

this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. *See* TBMP § 113.03. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a certificate of service as follows:

**I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (name and address of opposing counsel or party).**

**Signature** \_\_\_\_\_  
**Date** \_\_\_\_\_

Strict compliance with the Trademark Rules of Practice, and the Federal Rules of Civil Procedure (where applicable), is required of all parties before the Board, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

This *inter partes* proceeding is similar to a civil action in a federal district court. The parties file pleadings and a range of possible motions. This proceeding includes designated times for disclosures, discovery (discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, to ascertain the facts underlying an adversary's case), a trial period, and the filing of briefs. The Board does not preside at the taking of testimony; all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed

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with the Board. No paper, document, or exhibit will be considered as evidence unless it has been introduced in evidence in accordance with the applicable rules.