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Filing date: **09/14/2016**

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

Proceeding	91226206
Party	Defendant Universal City Studios LLC
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Submission	Answer and Counterclaim
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Signature	/Nicole Rossi Townes/
Date	09/14/2016
Attachments	2016-09-14 Answer and Counterclaim - NBCU2.004M.pdf(408138 bytes)

Registrations Subject to the filing

Registration No	4690745	Registration date	02/24/2015
Registrant	Conan Doyle Estate Limited 9 London Road Southampton, SO152AE UNITED KINGDOM		

Goods/Services Subject to the filing

Class 041. First Use: 2013/10/09 First Use In Commerce: 2013/10/09 All goods and services in the class are requested, namely: Organisation of exhibitions for cultural, educational, and entertainment purposes			
Registration No	4313984	Registration date	04/02/2013
Registrant	Conan Doyle Estate Limited 9 London Road Southampton, SO152AE UNITED KINGDOM		

Goods/Services Subject to the filing

Class 028. First Use: 2012/12/03 First Use In Commerce: 2012/12/03 All goods and services in the class are requested, namely: Electronic gaming machines, namely, devices that accept a wager			
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Conan Doyle Estate Ltd.,)	Opposition No.: 91226206
)	
Opposer,)	Serial No.: 86/603772
v.)	Mark: SHERLOCK HOMEBOY
)	
Universal City Studios-LLC,)	
)	
Applicant.)	
)	

ANSWER AND COUNTERCLAIM

Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

Dear Sir or Madam:

Applicant, Universal City Studios LLC (“Applicant”), a Delaware limited liability company, located and doing business at 100 Universal City Plaza, Universal City, California 91608, hereby answers the Notice of Opposition (“Opposition”) filed by Opposer, Conan Doyle Estate Ltd. (“Opposer”), against Applicant’s U.S. Trademark Application Serial No. 86/603,772 for the SHERLOCK HOMEBOY mark (“Applicant’s Application”). Answering the unnumbered first paragraph in the Opposition, Applicant denies that Opposer will be damaged by registration of Applicant’s Application. The numbered paragraphs of this Answer correspond to the numbered paragraphs of the Opposition.

1. Answering Paragraph 1 of the Opposition, Applicant admits that Opposer has filed with the United States Patent and Trademark Office (“USPTO”) Application Serial No. 77/937,845 to register the SHERLOCK HOLMES mark for “[m]otion picture and television films featuring musical, dramatic, comedic and theatrical performance; prerecorded goods, namely, prerecorded audio and video cassettes, compact discs, and digital versatile discs all featuring audio books and stories in the field of detective fiction, motion picture and television films, animated cartoons, radio programs, music, and games; downloadable electronic publications in the nature of e-zines and electronic books in the field of detective fiction” in International Class 9. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the other allegations contained in Paragraph 1 of the Opposition, and on that basis denies each and every such allegation.

2. Answering Paragraph 2 of the Opposition, Applicant admits that U.S. Trademark Registration Nos. 4,690,745 and 4,313,984 were issued to Opposer for the SHERLOCK HOLMES mark. Applicant admits that Opposer has filed with the USPTO Application Serial Nos. 77/937,813, 77/937,852, and 77/937,863 to register the SHERLOCK HOLMES mark and Application Serial No. 85/229,790 to register the SHERLOCK HOLMES CONAN DOYLE ESTATE LTD and design mark. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the other allegations contained in Paragraph 2 of the Opposition, and on that basis denies each and every such allegation.

3. Answering Paragraph 3 of the Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained therein, and on that basis denies these allegations.

4. Answering Paragraph 4 of the Opposition, Applicant admits that it is a Delaware limited liability company having a place of business at 100 Universal City Plaza, Universal City, California 91608. Applicant also admits that it has filed Applicant's Application as well as six (6) other applications with the USPTO, namely, U.S. Trademark Application Serial Nos. 86/603,787, 86/603,779, 86/603,780, 86/603,782, 86/603,776 and 86/603,784 for the SHERLOCK HOMEBOY mark.

5. Answering Paragraph 5 of the Opposition, Applicant admits that Applicant's Application was filed on an intent-to-use basis and that the description of goods for Applicant's Application reads "[p]re-recorded media, namely, digital, audio, and video tapes and discs, CDs, DVDs, and MP3-players featuring books, music, television programs, movies or other entertainment audio-visual programming in the field of animation, cartoons, drama, action, adventure, science-fiction, romance and suspense; musical sound recordings; downloadable motion pictures, television programs and audio-visual entertainment programs in the field of animation, cartoons, drama, action, adventure, science-fiction, romance and suspense; downloadable ring tones, computer screen saver software, music files, images and videos featuring animation, cartoons, drama, action, adventure, science-fiction, romance, suspense, movie clips, television show clips and music video clips via a global computer network and wireless communication devices; downloadable computer game, video game and electronic game programs and software via a global computer network and wireless communication devices; downloadable interactive computer game, video game and electronic game programs and software via a global computer network and wireless communication devices; downloadable computer game software for use on mobile phones, cellular phones and tablets; video game software provided on CD or DVD, cartridges, and memory cards; interactive computer game

video game and electronic game programs and software provided on CD or DVD, cartridges, and memory cards; video game cartridges, and video game memory cards; computer screen saver software; downloadable electronic publications, namely, series of fiction books, comic books and animated story books; mouse pads; protective carrying cases adapted for portable music players; protective covers and cases for mobile phones, tablets, and PDAs; speakers, audio headphones and earbuds; computer storage devices, namely, blank flash drives; calculating machines; decorative magnets; kitchen magnets; sunglasses; 3-D glasses; swim masks; mobile phone accessories namely, batteries, chargers, cables, phone cases, covers and gel-skins, phone charms, cell phone mounts for cars, phone clips and screen protectors; photographic cameras; radios” in International Class 9.

6. Answering Paragraph 6 of the Opposition, Applicant admits that Applicant’s Application was published for opposition in the Official Gazette on August 11, 2015. Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the other allegations contained in Paragraph 6 of the Opposition, and on that basis denies each and every such allegation.

7. Answering Paragraph 7 of the Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 7 of the Opposition, and on that basis denies these allegations.

8. Answering Paragraph 8 of the Opposition, Applicant denies the allegations contained therein.

9. Answering Paragraph 9 of the Opposition, Applicant denies the allegations contained therein.

10. Answering Paragraph 10 of the Opposition, Applicant lacks knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 10 of the Opposition, and on that basis denies these allegations.

11. Answering Paragraph 11 of the Opposition, Applicant denies the allegations contained therein.

12. Answering Paragraph 12 of the Opposition, Applicant denies the allegations contained therein.

13. Answering Paragraph 13 of the Opposition, Applicant denies the allegations contained therein.

14. Answering Paragraph 14 of the Opposition, Applicant denies the allegations contained therein.

AFFIRMATIVE DEFENSES

Applicant alleges the following affirmative defenses. There may be additional affirmative defenses to the Opposition that are currently unknown to Applicant. Therefore, Applicant reserves the right to amend its Answer and Counterclaim to allege additional affirmative defenses in the event that discovery of additional information indicates they are appropriate.

FIRST AFFIRMATIVE DEFENSE

1. The Opposition fails to state a claim for which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

2. The Opposition is barred by the doctrine of laches, estoppel, acquiescence and/or waiver.

THIRD AFFIRMATIVE DEFENSE

3. The Opposition is barred by the doctrine of unclean hands.

FOURTH AFFIRMATIVE DEFENSE

4. The Opposition is barred by the abandonment and loss of Opposer's alleged rights due to Opposer's failure to police its alleged marks.

FIFTH AFFIRMATIVE DEFENSE

5. Opposer lacks standing for the Opposition because Opposer is not the rightful owner of its alleged marks.

COUNTERCLAIM FOR CANCELLATION

Universal City Studios, LLC ("Petitioner"), a Delaware limited liability company with a principal place of business of 100 Universal City Plaza, Universal City, California 91608 believes that it has been and will be damaged by the continued registration of U.S. Registration Nos. 4,690,745 and 4,313,984 for the SHERLOCK HOLMES trademark ("Registrations") purportedly owned by Conan Doyle Estate Ltd. ("Registrant"), and thus hereby petitions to cancel these Registrations.

1. Registrant claims to own U.S. Trademark Registration Nos. 4,690,745 and 4,313,984 for the SHERLOCK HOLMES mark.

2. Registrant relies upon these Registrations as grounds for this Opposition against Petitioner's U.S. Trademark Application Serial No. 86/603,772 for the SHERLOCK HOMEBOY mark.

3. On November 22, 2013, Registrant filed U.S. Trademark Application Serial No. 86/126,503, which resulted in U.S. Trademark Registration No. 4,690,745. Registrant stated under oath in Application Serial No. 86/126,503 that as of the filing date of this application it believes "[Registrant] to be the owner of the trademark/service mark sought to be registered, or if the application is being filed under 15 U.S.C. Section 1051(b), [it] believes [Registrant] to be

entitled to use such mark in commerce; to the best of [its] knowledge and belief no other person, firm, corporation or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”

4. On October 14, 2011, Registrant filed U.S. Trademark Application Serial No. 85/447,511, which resulted in U.S. Trademark Registration No. 4,313,984. Registrant stated under oath in Application Serial No. 85/447,511 that as of the filing date of this application it believes “[Registrant] to be the owner of the trademark/service mark sought to be registered, or if the application is being filed under 15 U.S.C. Section 1051(b), [it] believes [Registrant] to be entitled to use such mark in commerce; to the best of [its] knowledge and belief no other person, firm, corporation or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.”

5. Upon information and belief, Registrant was not the rightful owner of the SHERLOCK HOLMES mark in the U.S. at the time of filing its U.S. Trademark Application Serial Nos. 86/126,503 and 85/447,511, which resulted in U.S. Trademark Registration Nos. 4,690,745 and 4,313,984. Upon information and belief, a third party previously used and continues to use the SHERLOCK HOLMES mark in the U.S. prior to Registrant’s alleged use of the SHERLOCK HOLMES mark in the U.S. and filing of U.S. Trademark Application Serial Nos. 86/126,503 and 85/447,511 for the SHERLOCK HOLMES mark.

6. Upon information and belief, Registrant knew at the time it filed U.S. Trademark Application Serial Nos. 86/126,503 and 85/447,511 that it was not the rightful owner of the SHERLOCK HOLMES mark in the U.S.

7. As a result of Registrant's false statements in its U.S. Trademark Application Serial Nos. 86/126,503 and 85/447,511, the USPTO issued the Registrations.

8. Upon information and belief, Registrant made each of these false statements with knowledge that they are false, with the intent to deceive the USPTO and induce the USPTO to issue the Registrations. Further, these statements were material. But for the false statements, Registrant would not have received the benefit of the Registrations.

9. The Registrations should be cancelled as the applications that matured into these Registrations were *void ab initio* because Registrant was not the rightful owner of the SHERLOCK HOLMES mark at the time of filing the applications. Additionally, by knowingly submitting false statements to the USPTO in connection with U.S. Trademark Application Serial Nos. 86/126,503 and 85/447,511, Registrant has committed fraud on the USPTO, and Registrant's U.S. Trademark Registration Nos. 4,690,745 and 4,313,984 resulting from U.S. Trademark Application Serial Nos. 86/126,503 and 85/447,511 should be cancelled.

10. Alternatively, upon information and belief, numerous third parties have been and still are using the SHERLOCK HOLMES mark in the U.S.

11. Registrant has abandoned any trademark rights it may have had in the SHERLOCK HOLMES mark shown in the Registrations by failing to police the SHERLOCK HOLMES mark against third parties using identical or confusingly similar marks in connection with identical or similar goods or services.

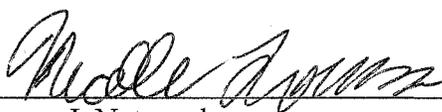
12. Petitioner has been, and continues to be damaged by Registrant's U.S. Trademark Registration Nos. 4,690,745 and 4,313,984 in that Registrant filed this Opposition against Petitioner's U.S. Trademark Application Serial No. 86/603,772 for the SHERLOCK HOMEBOY mark on the basis of Registrant's U.S. Trademark Registration Nos. 4,690,745 and 4,313,984.

13. In view of the fact that Registrant is not the rightful owner of the SHERLOCK HOLMES mark in the U.S. or in the alternative, has abandoned any rights it may have had in the SHERLOCK HOLMES mark in the U.S., Registrant's U.S. Trademark Registration Nos. 4,690,745 and 4,313,984 should be cancelled.

WHEREFORE, Petitioner prays that Registrant's U.S. Trademark Registration Nos. 4,690,745 and 4,313,984 be cancelled.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: September 14, 2016

By: 
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Nicole Rossi Townes
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Irvine, CA 92614
(949) 760-0404
Attorneys for Applicant,
Universal City Studios LLC

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **ANSWER AND COUNTERCLAIM** upon counsel for Conan Doyle Estate Ltd. by depositing one copy thereof in the United States Mail, first-class postage prepaid, on September 14, 2016, addressed as follows:

Benjamin Allison
BARDACKE ALLISON LLP
515 DON GASPAR, 2nd Floor
Santa Fe, NM 87505



Takeko Yoshioka-Moua

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