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Filing date: **03/22/2016**

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

Proceeding	91226280
Party	Defendant PLATINUM LUXURY AUCTIONS LLC
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Date	03/22/2016
Attachments	91226280_Answer, Affirmative Defenses, and Counterclaims.pdf(404298 bytes )

### Registrations Subject to the filing

Registration No	3866943	Registration date	10/26/2010
Registrant	GEA, Inc. 9115-F OLD STATESVILLE RD CHARLOTTE, NC 28269 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

### Goods/Services Subject to the filing

Class 035. First Use: 2005/10/14 First Use In Commerce: 2005/10/14 All goods and services in the class are requested, namely: Real estate services, namely, real estate auction services and real estate auction marketing services, namely, print advertising of residential and commercial real estate auctions and on-line services featuring auctions of residential and commercial real estate and on-line toursof residential and commercial real estate
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Registration No	4011247	Registration date	08/16/2011
Registrant	GEA, Inc. 9115-F OLD STATESVILLE ROAD CHARLOTTE, NC 28269 UNITED STATES		

### Goods/Services Subject to the filing

Class 035. First Use: 2005/10/14 First Use In Commerce: 2005/10/14 All goods and services in the class are requested, namely: Real estate services, namely, real estate auction services and real estate auction marketing services, namely, print advertising of residential and commercial real estate auctions and on-line services featuring auctions of residential and commercial real estate and on-line toursof residential and commercial real estate
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GEA, Inc. a/k/a Grand Estates Auction  
Company,

Opposer,

v.

Platinum Luxury Auctions, LLC,

Applicant.

Opposition No. 91226250

Mark: LUXURY AUCTION

Serial No. 86/662,581

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Platinum Luxury Auctions, LLC,

Counterclaimant,

v.

GEA, Inc. a/k/a Grand Estates Auction  
Company,

Registrant.

Re:

Registration No. 3,866,943

For the Mark: GRAND ESTATES

Date of Registration: October 26, 2010

Registration No. 4,011,247

For the Mark: GRAND ESTATES AUCTION  
COMPANY

Date of Registration: August 16, 2011

**APPLICANT’S ANSWER, AFFIRMATIVE AND OTHER DEFENSES, AND  
COUNTERCLAIMS TO OPPOSER’S NOTICE OF OPPOSITION**

Platinum Luxury Auctions, LLC (“Applicant” or, as later identified as, “Counterclaimant”), by and through undersigned counsel, hereby submits this Answer and affirmative defenses in response to the Notice of Opposition filed in this matter by GEA, Inc. a/k/a Grand Estates Auction (“Opposer” or, as later identified as “Registrant”). Unless specifically admitted below, Applicant denies each and every allegation in the Notice of

Opposition. Applicant further answers the numbered paragraphs in the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 1 of the Notice of Opposition and therefore denies those allegations.

2. Admit.

3. Admit.

4. Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 4 of the Notice of Opposition and therefore denies those allegations.

5. Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 5 of the Notice of Opposition and therefore denies those allegations.

6. Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 6 of the Notice of Opposition based on Opposer's failure to specify a relevant period of time and/or define what "numerous" means, and therefore denies those allegations.

7. Admit.

8. Deny.

9. Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 9 of the Notice of Opposition and therefore denies those allegations.

**First Ground for "Cancellation"<sup>1</sup>**  
(Descriptiveness)

10. Applicant incorporates by reference the aforementioned responses to Opposer's averments in paragraphs 1-9.

11. Denied.

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<sup>1</sup> Applicant uses Opposer's headings for reference only, and objects to the use of the term "cancellation," as Opposer has asserted an opposition proceeding.

12. Denied.

13. Denied.

**Second Ground for “Cancellation”<sup>2</sup>**  
(Genericness)

14. Applicant incorporates by reference the aforementioned responses to Opposer’s averments in paragraphs 1-13.

15. Denied.

16. Denied.

17. Denied.

WHEREFORE, Applicant requests the Board deny Opposer’s grounds for opposition, and Applicant’s application should be proceed to registration.

**AFFIRMATIVE AND/OR OTHER DEFENSES**

1. Applicant asserts that Opposer’s claims for relief should be denied on the basis that Opposer lacks standing to assert the instant opposition proceeding against Applicant.

2. Applicant also asserts its use of the “Luxury Auction” mark has acquired distinctiveness and secondary meaning in the eyes of the interested public and consumers.

**COUNTERCLAIMS**

Applicant, hereinafter “Counterclaimant,” a Florida limited liability company having its principal place of business at 201 S. Biscayne Blvd., 28<sup>th</sup> Floor, Miami, Florida 33131, believes it is or will be damaged by Registration Nos. 3,866,943 and 4,011,247, all believed to be owned by GEA, Inc. a/k/a Grand Estates Auction Company (“Registrant”), and hereby submits these counterclaims and petitions to cancel the above registrations under the provisions of 15 U.S.C. §§ 1064(1), 1092. As grounds for cancellation, Counterclaimant asserts:

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<sup>2</sup> Applicant uses Opposer’s headings for reference only, and objects to the use of the term “cancellation,” as Opposer has asserted an opposition proceeding.

1. Counterclaimant has, since at least May of 2010, offered services related to arranging and conducting auctions in the field of real estate, yachts, and aircraft.

2. Counterclaimant is a juristic person, within the meaning of T.B.M.P. § 303.02.

3. Upon information and belief, as memorialized in paragraph 4 of Opposer's Notice of Opposition, Registrant is and has been engaged in the business of auctions of real estate.

4. Counterclaimant and Registrant are competitors in the auctioneering market place, particularly with respect to auctioneering of real estate.

5. On March 13, 2010, Registrant filed a trademark application under the basis of 15 U.S.C. § 1051(a), given a serial number of 77/958,387 (hereinafter "the '387 Application"), for the mark GRAND ESTATES in International Class 035 for "real estate services, namely, real estate auction services and real estate auction marketing services, namely, print advertising of residential and commercial real estate auctions and on-line services featuring auctions of residential and commercial real estate and on-line tours of residential and commercial real estates."

6. On June 17, 2010, the '387 Application received a rejection based on the descriptiveness of the mark GRAND ESTATES. On June 18, 2010, Registrant's representative amended the '387 Application to recite a section 2(f) claim asserting the GRAND ESTATES "mark has become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement." The '387 Application became registered on the Principal Register Registration on October 26, 2010, under registration number 3,866,943 ("the '943 Registration").

7. On June 28, 2010, Registrant filed a trademark application under the basis of 15 U.S.C. § 1051(a), given a serial number of 85/073,289 (hereinafter "the '289 Application"), for

the mark GRAND ESTATES AUCTION COMPANY in International Class 035 for “real estate services, namely, real estate auction services and real estate auction marketing services, namely, print advertising of residential and commercial real estate auctions and on-line services featuring auctions of residential and commercial real estate and on-line tours of residential and commercial real estate.”

8. On October 6, 2010, the '289 Application received a rejection based on the descriptiveness of the mark GRAND ESTATES AUCTION COMPANY. On March 31, 2011, Registrant's representative asserted a section 2(f) claim that the mark GRAND ESTATES AUCTION COMPANY has “become distinctive of the goods/services through the applicant's substantially exclusive and continuous use in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.” The '289 Application became registered on the Principal Register, based on the section 2(f) claim, on August 16, 2011, under registration number 4,011,247 (“the '247 Registration”).

9. The word “grand” is defined as “having more importance than others,” “having higher rank than others bearing the same general designation,” “large and striking in size, scope, extent, or conception,” or “very good.” See <http://www.merriam-webster.com/dictionary/grand>.

10. The word “estates” is defined as “the degree, quality, nature, and extent of one's interest in land or other property” or “a person's property in land and tenements,” or “a landed property usually with a large house on it.” See <http://www.merriam-webster.com/dictionary/estates>.

11. As such, GRAND ESTATES is generic, in that the genus is real estate services and the relevant public understands “grand estates” to primarily refer to real estate services.

12. Moreover, GRAND ESTATES is also laudatory and/or merely describes Registrant's real estate services featuring large houses or a person's property, i.e., real estate.

13. In both the '943 Registration and the '247 Registration (collectively referred to as "the Challenged Registrations"), Registrant submitted no evidence of its section 2(f) use claim, other than the aforementioned statements concerning five (5) years of substantially exclusive and continuous use.

14. Registrant knew, when it submitted the section 2(f) use claim in the Challenged Registrations, that there were third-party users of the term "grand estates."

15. Registrant knew, when it submitted the section 2(f) use claim in the Challenged Registrations, the term "grand estates" referred generally to real estate services, including auctioneering services related to real estate.

16. The Challenged Registrations are all owned by Registrant and have not sought incontestable status under 15 U.S.C. § 1141. Moreover, the '247 Registration has not been registered more than five years and the grounds brought by Counterclaimant to cancel the '943 Registration are authorized by section 14(3) of the Trademark Act; therefore, Counterclaimant is entitled to seek cancellation of the Challenged Registrations under the below grounds pursuant to 15 U.S.C. § 1064(1).

17. From 2005 through present, Counterclaimant and/or third parties have used the phrase "grand estates" to convey to actual and prospective consumers, both in printed brochures/manuals and other media, features and characteristics associated with auctioneering services or the real estate of which those auctioneering services concern, e.g., the size, scale, price, extent, and condition of said real estate.

18. Counterclaimant is likely to be damaged by the continued registration of the Challenged Registrations because Counterclaimant, a competitor of Registrant, has and/or intends to use the phrase “grand estates,” and permitting Registrant to monopolize the use of said generic and/or descriptive term would inhibit marketplace competition.

19. Registrant’s aforementioned section 2(f) claims are ineffective to establish distinctiveness for the term “grand estates” because Registrant’s use is believed not to be continuous or substantially exclusive.

**GROUND I – DESCRIPTIVENESS UNDER 15 U.S.C. § 1052(E)(1)**

20. Counterclaimant realleges and revers paragraphs one (1) through nineteen (19) as if fully set forth herein.

21. GRAND ESTATES AUCTION COMPANY is, at least, merely descriptive in that they immediately describe a feature, ingredient, quality, function, purpose, use, or characteristic of Registrant’s services, namely “real estate services, namely, real estate auction services and real estate auction marketing services, namely, print advertising of residential and commercial real estate auctions and on-line services featuring auctions of residential and commercial real estate and on-line tours of residential and commercial real estate.”

22. The mark GRAND ESTATES AUCTION COMPANY has not acquired distinctiveness.

WHEREFORE, Counterclaimant prays that Registration No. 4,011,247 be canceled and that this counterclaim for cancellation be sustained in favor of Counterclaimant.

**GROUND II – GENERICNESS UNDER 15 U.S.C. § 1052(E)(1)**

23. Counterclaimant realleges and revers paragraphs one (1) through nineteen (19) as if fully set forth herein.

24. GRAND ESTATES and GRAND ESTATES AUCTION COMPANY, whether considered together or apart, are generic in that the relevant public uses and understands that said terms refer to the common or class name for the services to which Registrant applied for in the Challenged Registrations.

WHEREFORE, Counterclaimant prays that Registration No. 3,866,943 and 4,011,247 be canceled and that this counterclaim for cancellation be sustained in favor of Counterclaimant.

Respectfully submitted,

THE CONCEPT LAW GROUP, P.A.

By:



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CERTIFICATE OF SERVICE

I certify that on March 22, 2016, the foregoing Answer, Affirmative Defenses, and Counterclaims was served via USPS Priority Mail to Opposer/Registrant's counsel at:

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