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

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|------------------------|--|
| Proceeding | 91226583 |
| Party | Defendant P.M.I. Trading & Enterprise Ltd. |
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| Submission | Answer |
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| Signature | /Yuval H. Marcus/ |
| Date | 04/06/2016 |
| Attachments | Answer 4.6.16 (01473194).pdf(30583 bytes) |

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

MARCO HÜSGES,

Opposer,

Serial No. 86/501,625

v.

Opposition No. 91226583

P.M.I. TRADING AND ENTERPRISE, LTD.,

Applicant.

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, P.M.I. Trading and Enterprise, Ltd. (“Applicant”), by and through its attorneys, Leason Ellis, LLP, hereby answers the Notice of Opposition as follows:

1. Applicant admits that printouts from the U.S.P.T.O. Trademark Electronic Search System (“TESS”) related to U.S. Trademark Registration Nos. 4,595,110, 4,766,492, 4,868,832 and 4,893,876 are attached as **Exhibit A** to the Notice of Opposition. The documents speak for themselves. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in paragraph 1 and, accordingly, denies the same.

2. Applicant admits that TESS printouts related to U.S. Trademark Application Serial Nos. 79/136,472 and 79/975,145 are attached as **Exhibit B** to the Notice of Opposition. The documents speak for themselves. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph and, accordingly, denies the same.

3. Applicant admits that TESS printouts related to U.S. Trademark Application Serial Nos. 79/975,148, 79/975,149, 79/975,150, 79/975,087, 86/705,903, 86/768,309, 86/842,096 and 86/496,978 are attached as **Exhibit B** to the Notice of Opposition. The documents speak for

themselves. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph and, accordingly, denies the same.

4. Applicant admits that TESS printouts related to U.S. Trademark Applications for the marks EMOJI FASHION, THE EMOJIS, FOREVER EMOJI, EMOJIPLANET, EMOJIWORLD and EMOJITOWN are attached as **Exhibit C** to the Notice of Opposition. The documents speak for themselves. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in this paragraph and, accordingly, denies the same.

5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 5 and, accordingly, denies the same.

6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 6 and, accordingly, denies the same.

7. Applicant admits the allegations in paragraph 7.

8. Applicant admits the allegations in paragraph 8, however, the application cited in the paragraph speaks for itself.

9. Applicant admits the allegations in paragraph 9.

10. Applicant admits the allegations in paragraph 10.

11. Applicant admits the allegations in paragraph 11.

12. Paragraph 12 states a legal conclusion for which no responsive pleading is required. To the extent that any responsive pleading is deemed to be required, Applicant denies the averments of the paragraph.

13. Paragraph 13 is an incorporation clause for which no responsive pleading is required. To the extent that any responsive pleading is deemed to be required, Applicant denies the averments of the paragraph.

14. Applicant denies the allegations in paragraph 14.

15. Applicant denies the allegations in paragraph 15.

16. Applicant denies the allegations in paragraph 16, except admits that certain goods listed in Applicant's Application are related to and/or overlap certain goods listed in Opposer's EMOJI Registrations.

17. Applicant admits that it has not included a limitation as to the "particular trade channels" of its goods in its Application. All other allegations in paragraph 17 are denied.

18. Paragraph 18 states a legal conclusion for which no responsive pleading is required. To the extent that any responsive pleading is deemed to be required, Applicant denies the averments of the paragraph.

19. Applicant denies the allegations in paragraph 19.

20. Applicant denies the allegations in paragraph 20.

In response to the unnumbered paragraph that follows Paragraph 20 of the Notice, Applicant denies that the Opposition should be sustained, and denies that Applicant's Application should be refused registration.

AFFIRMATIVE DEFENSES

Responding further to the Notice of Opposition, Applicant asserts the following affirmative defenses:

FIRST AFFIRMATIVE DEFENSE

1. The Notice of Opposition fails to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

2. Opposer is engaged in trademark misuse in attempting to monopolize the market beyond the boundaries of any purported trademark rights it may have, if any.

THIRD AFFIRMATIVE DEFENSE

3. Opposer has no standing to bring this Opposition as Opposer cannot and will not be damaged by the registration of the subject mark because Opposer is legally incapable of asserting trademark rights in the term “emoji.”

FOURTH AFFIRMATIVE DEFENSE

4. Opposer’s mark is merely descriptive, and therefore prohibited from registration pursuant to Section 2(e)(1) of the Trademark Act.

FIFTH AFFIRMATIVE DEFENSE

5. Opposer’s use of “emoji” in an ornamental manner, and/or for an informational purpose, does not identify and distinguish Opposer’s goods and, thus, does not function as a trademark.

SIXTH AFFIRMATIVE DEFENSE

6. Applicant reserves the right to assert additional defenses as new information becomes known to Applicant.

COUNTERCLAIMS

Applicant asserts the following counterclaims:

1. The parties have agreed to consolidate Opposition Proceeding No. 91226583 and Cancellation Proceeding No. 92062897 into a single proceeding.
2. Wherefore, to simplify matters, Applicant hereby adopts by reference pursuant to Fed.R.Civ.P. 10(c) the claims currently asserted by Petitioner (P.M.I.) against Registrant (Hüsges) in Cancellation Proceeding No. 92062897 as Counterclaims in this action, as if fully set forth herein.

WHEREFORE, Applicant respectfully requests that this Opposition No. 91226583 be dismissed with prejudice, and The Trademark Trial and Appeal Board grant Applicant such other and further relief as the Board deems just and proper.

Dated: April 6, 2016
White Plains, New York

Respectfully submitted,



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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** was served by First-Class mail, postage prepaid, upon the attorney for Opposer, this 6th day of April, 2016, addressed as follows:

Michael E. Dukes
Cohen & Grigsby, P.C.
625 Liberty Avenue
Pittsburgh, PA 15222-3125



Yuval H. Marcus