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

Proceeding	91227888
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Cackalacky, Inc,

Opposer,

v.

Terrell Rhodes,

Applicant.

Opposition No. 9122788

ANSWER TO NOTICE OF OPPOSITION

Applicant, Terrell Rhodes (“Applicant”) hereby replies to the numbered grounds for opposition set forth in Opposer’s Notice of Opposition as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1 and therefore denies those allegations.

2. Applicant is the owner of the CACKALAK mark with prior registration Reg. No. 2906949 published for opposition July 29, 2003. During a thirteen year period, no parties opposed Reg. No. 2906949. Applicant filed an application for the CACKALAK mark on September 06, 2015. The Opposer filed its application for its mark on November 16, 2015. The Applicant’s filing date predates the filing date of the Opposer.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3 and therefore denies those allegations.

4. The allegations of paragraph 4 are denied. Applicant is the owner of a lifestyle apparel company based on the CACKALAK mark and brand. The CACKALAK mark and brand was created and

marketed at the University Of South Carolina by the Applicant. The Applicant has established a common law trademark based on years of marketing and sales commencing in 1991. This establishes common law rights that predate any use or federal registration as admitted by the Opposer in its application and in paragraph 5. The Applicant is also the owner of prior registration of the mark, CACKALAK, with Reg. No. 2906949. Before prior registration of the CACKALAK mark, the Applicant conducted an exhaustive search in the clothing and apparel industry. The Opposer's proposed mark is used commonly throughout North Carolina and South Carolina due to its geographical nature and origin. This significantly dilutes its ability to function as a mark and refutes the claim that the Opposer "has acquired substantial goodwill and value" in its mark. The CACKALACKY mark used by the Opposer is used by countless other entities.

Examples of parties offering CACKALACKY food and clothing are below:

- a. Cackalack's Hot Chicken Shack
<http://www.cackalacks.com>
- b. Palmetto Traditions
<http://www.palmettotraditions.com/palmetto-south-cackalacky-t-shirt/sct200491/product>
- c. The Tiger Sports Shop
<http://www.tigersports.com/browseproducts/Clemson-South-Cackalacky-T-Shirt.html>
- d. MTN Merch
<https://www.mtnmerch.com/product/north-cackalacky-tee>
- e. Palmettoville
<http://palmettoville.com/products/south-cackalacky>
- f. One 10 Threads
<http://www.one10threads.com/north-cackalacky-t-shirt>
- g. Imperial Sports
<https://www.imperialsports.com/product/the-south-cackalacky>

5. The allegations of paragraph 5 are denied. The CACKALAK mark of the Applicant has been established in the clothing retail sector as a lifestyle apparel brand and it clearly distinguishes and identifies clothing sold by the Applicant. The Applicant has been marketing and selling clothing under the CACKALAK brand since 1991. The Applicant has provided numerous entities and consumers with

clothing items under the CACKALAK brand. A substantial amount of time and effort of the Applicant has created a demand for clothing under the CACKALAK mark. The CACKALAK mark and brand was sold and promoted significantly by the Applicant. Proof of popularity and use can be found in sources that predate any use of the Opposer. The platinum music recording artist, A Tribe Called Quest, used the CACKALAK brand in the song “Scenario” in 1991. This is a direct result of the marketing and promotion efforts of the Applicant. Applicant has used the CACKALAK brand in commerce a full ten years before the Opposer’s first date of use in commerce stated in paragraph 5.

6. The allegations of paragraph 6 are denied. Applicant maintains a constant, progressive retail presence based on the CACKALAK mark and brand. Applicant has sold clothing based on agreements with Columbia Fashion Place Mall, the United States Military PX at Fort Jackson, retail locations in North Carolina and South Carolina, and the Women’s Expo at the Colonial Life Arena in Columbia, SC. The Applicant offers clothing for sale 24 hours a day on the Applicant’s website and this website was active when Opposer filed its application and Notice of Opposition.

7. The allegations of paragraph 7 are denied. Applicant has established the CACKALAK mark and brand in the clothing retail sector and is currently marketing and selling clothing under the CACKALAK brand.

8. The allegations of paragraph 8 are denied. Applicant does not need permission or authorization to market and sell clothing under the CACKALAK brand that is marketed and owned by the Applicant.

9. The allegations of paragraph 9 are denied. Applicant does not need authorization, sponsorship, or a licensing agreement to market and sell clothing under the CACKALAK brand that is marketed and owned by the Applicant.

10. The allegations of paragraph 10 are denied. Applicant is the owner of prior registration of Reg. No. 2906949 in trademark class 025 that was published without opposition. Applicant is simply seeking to reinstate a prior registration that has been continuously used in commerce. The CACKALAK

mark has been marketed and used in commerce by the Applicant for over two decades. The Applicant also denies that the Opposer has used its proposed mark in trademark classification 025 in 2001.

11. The Applicant denies that the Opposer will be damaged by the registration of Serial No. 86748917 for the mark CACKALAK or that the Opposer is entitled to any relief requested in the Notice Opposition. The Applicant is the owner of the prior registration of the CACKALAK mark with Reg. No 2906949. The Opposer was not previously damaged by the prior registration of the CACKALAK mark and will not be damaged by the registration of application Serial No. 86748917.

FIRST AFFIRMATIVE DEFENSE

One or more of the Opposer's claims fail to state a claim upon which relief may be granted.

SECOND AFFIRMATIVE DEFENSE

One or more of the Opposer's claims are barred in view of the Applicant's prior registration for the identical mark, CACKALAK, as more fully displayed in Reg. No. 2906949, for the same clothing and services of that of the contested mark, namely clothing, pants, shirts, t-shirts, sweatshirts, shorts, headwear, and footwear. The Applicant has been continuously using this mark in commerce.

THIRD AFFIRMATIVE DEFENSE

Applicant hereby gives notice that it may rely on other defenses that may become available or appear proper during discovery, and hereby reserves its right to amend this Answer to assert any such defenses.

WHEREFORE, Applicant requests that the Trademark Trial and Appeal Board dismiss the Notice of Opposition and grant all other appropriate relief to Applicant as it deems just.

June 24, 2016

Respectfully submitted,

/Terrell Rhodes/
Terrell Rhodes
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Columbia, SC 29229

CERTIFICATE OF SERVICE

I hereby certify that the foregoing ANSWER TO NOTICE OF OPPOSITION was served on Counsel
for Opposer by first class mail at the address below:

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Dated: June 24, 2016

/Terrell Rhodes/