

ESTTA Tracking number: **ESTTA586545**

Filing date: **02/10/2014**

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

Proceeding	92048732
Party	Defendant Ronald Beckenfeld
Correspondence Address	MICHAEL L LOVITZ BOWEN HAYES & KREISBERG 10350 SANTA MONICA BLVD, STE 350 LOS ANGELES, CA 90025 UNITED STATES trademarks@bowenhayes.com, trademarks@lovitziplaw.com
Submission	Answer
Filer's Name	Michael L. Lovitz
Filer's e-mail	trademarks@bowenhayes.com
Signature	/michael l lovitz/
Date	02/10/2014
Attachments	Answer to 2d Amended Petition.pdf(103369 bytes)

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

ALTVATER GESSLER – J.A. BACZEWSKI	:	Cancellation 92048732
INTERNATIONAL (USA) INC. and ALTVATER	:	
GESSLER – J.A. BACZEWSKI GMBH,	:	
	:	
Petitioners,	:	Registration No.: 2,731,948
	:	
v.	:	
	:	
RONALD BECKENFELD,	:	Attorney Docket No. B1001-9001
	:	
Respondent	:	

ANSWER TO SECOND AMENDED PETITION FOR CANCELLATION

Respondent Ronald Beckenfeld (“Respondent”), through his undersigned counsel, hereby responds to the Second Amended Petition for Cancellation (“2d Amended Petition”) filed with respect to Registration No. 2,713,948:

1. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.
2. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.
3. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.
4. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.
5. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.
6. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

7. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

8. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

9. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

10. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

11. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

12. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

13. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

14. Admitted in part, denied in part. Respondent admits that Mutual Wholesale Liquor Inc. d/b/a International Import Export (“Mutual”) has distributed the MONOPOLOWA brand vodka in the United States for more than thirty (30) years, and has imported and distributed such products exclusively in the United States since at least as early as August 1992. Respondent further admits that up until his death on May 4, 2012, Mickey Beckenfeld was owner and president of Mutual. Respondent is without knowledge concerning the remaining allegations contained in this Paragraph 14, and therefore denies the same.

15. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

16. Admitted in part, denied in part. Respondent admits that Mickey Beckenfeld suggested that Elek Gessler transfer the brand name MONOPOLOWA to Mutual in exchange for Mutual's commitment to advertise and promote the product in the United States. Respondent further admits that Mutual purchased and imported the MONOPOLOWA products directly from the products' manufacturer in Austria. Respondent denies the transfer of the brand to Mutual was related to or contingent upon any other event or action, such as a bankruptcy. Respondent is without knowledge concerning the remaining allegations contained in this Paragraph 16, and therefore denies the same.

17. Admitted in part, denied in part. Respondent admits that Mickey Beckenfeld had a discussion with Elek Gessler on August 27, 1992, wherein Elek Gessler agreed to transfer the brand name MONOPOLOWA to Mutual in exchange for Mutual's commitment to advertise and promote the product in the United States. Respondent further admits that Mutual confirmed the transfer and assignment of the MONOPOLOWA brand name to Mutual by providing Elek Gessler with three separate documents, each of which were immediately signed and returned by Mr. Gessler to Mutual: (i) a letter confirming the substance of the discussion and the agreement reached between Mickey Beckenfeld and Elek Gessler declaring the transfer of the brand ownership in the United States to Mutual; (ii) an assignment confirmation document signed by Elek Gessler; and (iii) a Power of Attorney document which, *inter alia*, confirmed that by separate agreement the ownership of the MONOPOLOW brand name for vodka had already been transferred to Mutual. Respondent is without knowledge concerning the remaining allegations contained in this Paragraph 17, and therefore denies the same.

18. Denied.

19. Admitted in part, denied in part. Respondent admits that the August 27, 1992 assignment and Power of Attorney documents were on letterhead bearing the crests and names of

Altvater Gessler and J.A. Baczewski. Respondent is without knowledge concerning the remaining allegations contained in this Paragraph 19, and therefore denies the same.

20. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

21. Denied.

22. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

23. Admitted in part, denied in part. Respondent admits that the label shown in Exhibit A to the 2d Amended Petition states MONOPOLOWA is “imported by International Import Export, Los Angeles, California.” Respondent further admits that International Import Export is a d/b/a of Mutual. Respondent further admits that the label shown in Exhibit A to the 2d Amended Petition states the product is “produced and bottled by J.A. Baczewski”. Respondent is without knowledge concerning the remaining allegations contained in this Paragraph 23, and therefore denies the same.

24. Denied. Respondent denies that Petitioners have any U.S. rights in the MONOPOLOWA trademark, which mark is the subject of the registration sought to be cancelled in the instant proceeding. Respondent further denies that any goodwill or consumer recognition of the MONOPOLOWA mark in the U.S. lies with Petitioners; rather, the ownership of the mark, together with the associated goodwill and consumer recognition, lies with the Respondent by and through its exclusive licensee, Mutual as a result of Mutual’s extensive advertising and promotion of the MONOPOLOWA brand products in the U.S. Respondent is without knowledge or information sufficient to form a belief as to the remaining allegations contained in this Paragraph 24, and therefore denies the same.

25. Denied.

26. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

27. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

28. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

29. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

30. Denied.

31. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

32. Denied.

33. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

34. Denied.

35. Admitted in part, denied in part. Respondent admits that Mutual filed an application with the U.S. Patent and Trademark Office on or about September 16, 2002 to register the mark MONOPOLOWA for vodka. Respondent denies that any authority or authorization from Petitioners was required in order to undertake such filing.

36. Admitted.

37. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

38. Admitted.

39. Admitted.

40. Denied.

41. Admitted in part, denied in part. Respondent admits that Mutual has been distributing MONOPOLOWA brand vodka in the United States since prior to August 27, 1992, more than ten years before Mutual filed the Application. Respondent denies that Petitioners had any rights in or ownership of the brand MONOPOLOWA for vodka subsequent to August 27, 1992, and therefore denies the remaining allegations contained in this Paragraph 41.

42. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

43. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

44. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

45. Denied.

46. Admitted in part, denied in part. Respondent admits that Mutual assigned the Registration to Respondent on or about October 4, 2007. Respondent denies that such assignment required any authorization from Petitioners.

47. Admitted.

48. Denied.

49. Admitted.

50. Admitted in part, denied in part. Respondent admits that he does not currently and has not in the past owned a liquor distribution business. The remaining allegations contained in this Paragraph 50 are denied.

51. Respondent admits that he is currently engaged, *inter alia*, in the business of manufacturing and selling vitamins and nutritional supplements.

52. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

53. Denied.

54. Denied.

55. Denied.

56. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

57. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

58. Respondent is without knowledge or information sufficient to form a belief as to the allegations of this paragraph, and therefore denies the same.

59. Denied.

60. Admitted in part, denied in part. Respondent admits that he and Mutual signed a license on October 4, 2007 that granted Mutual the exclusive license to use the MONOPOLOWA trademark on vodka within the United States. The remaining allegations of this Paragraph 60 are denied.

61. Admitted in part, denied in part. Respondent admits that the License Agreement provides, *inter alia*, that “[f]or the purpose of maintaining quality, LICENSOR or its duly authorized representative shall have the right at all reasonable times and on reasonable notice to enter the premises of LICENSEE and inspect the LICENSED PRODUCTS.” The remaining allegations of this Paragraph 61 are denied.

62. Denied.

63. Denied.

64. Denied.

65. Denied.

66. Denied

67. Denied.

68. Admitted in part, denied in part. Respondent admits that he filed a Combined Application for Renewal and Declaration of Use under Sections 8 and 9 of the U.S. Trademark Act for the Registration on January 24, 2013. Respondent states that he subsequently discovered that several specimens were inadvertently omitted from the January 24, 2013 filing, and so those missing specimens were subsequently submitted on January 20, 2013, prior to the renewal deadline. Respondent therefore denies that the January 24, 2013 filing represented the entire contents of the Renewal Application.

69. Admitted.

70. Admitted

71. Admitted.

72. Admitted.

73. Admitted in part, denied in part. Respondent admits that the photograph submitted with the January 24, 2013 portion of the Renewal Application shows the “blue” label for MONOPOLOWA brand vodka products. Respondent further states that the “blue” label remains in use in commerce by a number of retailers in the United States for advertising and promoting MONOPOLOWA brand vodka products offered for sale by such retailers, and on information and belief, such retailers continue to sell their existing inventory bearing such “blue” label. Respondent further states that specimens submitted on January 24, 2013 were incomplete, and that the labels inadvertently omitted from such filing were submitted to the USPTO shortly after the omission was discovered by way of an amendment dated June 20, 2013. The remaining allegations of this Paragraph 73 are denied.

74. Denied.

75. Denied.

76. Denied.

AFFIRMATIVE DEFENSES

A. Petitioners lack standing to bring the instant cancellation proceeding.

B. Petitioners have failed to allege any actual injury or damage resulting from the continued registration of the MONOPOLOWA mark.

C. The rights relied upon by Petitioners are invalid as all such rights were previously transferred by Petitioners to Registrant's predecessor in interest and title in 1992, long prior to the filing of the 2d Amended Petition.

D. Petitioners have demonstrated no current or future interest in the U.S. in the mark MONOPOLOWA for vodka.

E. Petitioners cannot demonstrate injury to any rights Petitioners may establish during the cancellation proceeding.

F. Petitioners are barred under laches from obtaining relief in the instant proceeding.

G. Petitioners are barred from obtaining relief in the instant proceeding by acquiescence.

H. Petitioners are barred from obtaining relief due to equitable estoppel.

I. Petitioners are barred from obtaining relief due to contractual estoppel.

J. Petitioners are barred from obtaining relief due to unclean hands, in light of Petitioners' admission that Elek Gessler intended to defraud creditors and the government and intended to hide assets, namely the U.S. rights in the MONOPOLOWA brand name, in the event of a bankruptcy filing.

K. Petitioners have failed to adequately plead grounds necessary to establish fraud on the USPTO, either in the initial filing for the Registration or in the renewal of the Registration.

L. Petitioners have failed to adequately assert a claim of abandonment as a result of naked licensing.

M. Petitioner is estopped from obtaining relief in the instant proceeding, having transferred all U.S. rights in the subject mark in 1992 to Registrant's predecessor in interest and title.

WHEREFORE, Respondent prays that this Cancellation proceeding be dismissed.

Respectfully submitted,

Dated: February 10, 2014

By: /michael l lovitz/
Michael L. Lovitz
BOWEN HAYES & KREISBERG
10350 Santa Monica Blvd., Ste. 350
Los Angeles, CA 90025
(310) 893-0422
trademarks@bowenhayes.com

Attorneys for Respondent