

ESTTA Tracking number: **ESTTA276030**

Filing date: **04/03/2009**

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

Proceeding	92050557
Party	Defendant Direct From Vegas Productions, Inc.
Correspondence Address	Direct From Vegas Productions, Inc. 7871 Colgate Ave Westminster, CA 92683 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Jacob Hafter
Filer's e-mail	jhafter@hafterlaw.com
Signature	/jh/
Date	04/03/2009
Attachments	Answer.040209.final.pdf (6 pages)(48182 bytes)

Registration Subject to the filing

Registration No	2640066	Registration date	10/22/2002
Registrant	TRP ENTERTAINMENT, LLC 7910 BERMUDA ROAD LAS VEGAS, NV 89123 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		
	The registered mark is functional.		

Goods/Services Subject to the filing

Class 041. First Use: 2001/10/25 First Use In Commerce: 2001/10/25

All goods and services in the class are requested, namely: entertainment services, namely, live stage musical productions

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9 Attorneys for Plaintiff

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

TRP ENTERTAINMENT, LLC, a Nevada

Limited Liability Company,

Petitioner,

vs.

DIRECT FROM VEGAS PRODUCTIONS,
INC., a California Corporation,

Respondent.

Registration No: 3220387
Mark: DIRECT FROM VEGAS THE RAT
PACK
Cancellation No.: 92050557

**ANSWER AND COUNTERCLAIM FOR
CANCELLATION**

COMES NOW, Respondent DIRECT FROM VEGAS PRODUCTIONS, INC.
("DFVP," "Respondent" or "Counterpetitioner"), by and through its attorneys of record, the
law firm of Law Offices of Jacob Hafter & Associates, and hereby responds to the FIRST
AMENDED PETITION FOR CANCELLATION ("Petition") of TRP ENTERTAINMENT,
LLC ("TRP," "Petitioner" or "Counterrespondent") as follows:

1. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1 and on that basis denies the allegations therein.
2. Respondent admits the allegations contained in Paragraph 2.
3. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3 and on that basis denies the allegations therein.

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- 4. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4 and on that basis denies the allegations therein.
- 5. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 5 and on that basis denies the allegations therein.
- 6. Respondent denies the allegations contained in Paragraph 6.
- 7. Respondent admits the allegations contained in Paragraph 7.
- 8. Respondent admits the allegation contained in Paragraph 8.
- 9. Respondent denies the allegations contained in Paragraph 9.
- 10. Respondent denies the allegations contained in the first, fourth and fifth sentences of Paragraph 10. Respondent is without knowledge or information sufficient to form a belief as to the truth of the allegations in sentences two and three of Paragraph 10 and on that basis denies the allegations therein. Respondent admits it is a corporation headquartered in Westminster, California.
- 11. Respondent denies the allegations contained in Paragraph 11.
- 12. Respondent denies the allegations contained in Paragraph 12.
- 13. Respondent denies the allegations contained in Paragraph 13.
- 14. Respondent denies the allegations contained in Paragraph 14.
- 15. Respondent denies the allegations contained in Paragraph 15.
- 16. Respondent hereby denies all allegations not specifically admitted or denied.

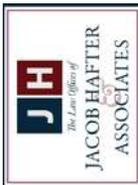
AFFIRMATIVE DEFENSES

First Affirmative Defense

17. Petitioner fails to state a claim upon which relief may be granted.

Second Affirmative Defense

18. The claims made by the Petitioner are barred by the doctrines of estoppel, waiver, acquiescence and/or laches.



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Third Affirmative Defense

19. Petitioner’s claims are barred by the doctrine of unclean hands.

Fourth Affirmative Defense

20. At all relevant times, Respondent acted in good faith, without actual or constructive knowledge of any infringement or dilution of any valid mark of Petitioner, with good and sufficient legal cause and therefore cannot be subject to liability.

Fifth Affirmative Defense

21. Petitioner’s claim is barred by applicable statutes of limitation.

Sixth Affirmative Defense

22. Upon information and belief, Petitioner lacks standing to petition for cancellation of Registration No. 3220387.

Seventh Affirmative Defense

23. Petitioner failed to mitigate damages, if any.

Eighth Affirmative Defense

24. Petitioner may not be the true legal owner of any rights in the mark “The Rat Pack is Back” and actions by Petitioner to enforce such rights are invalid.

Ninth Affirmative Defense

25. Petitioner cannot satisfy its burden to demonstrate that it suffered any injury-in-fact, nor did the Petitioner suffer any such injury.

Tenth Affirmative Defense

26. Respondent has not directly or indirectly infringed any alleged trademark of the Petitioner.

Eleventh Affirmative Defense

27. Petitioner is precluded from raising claims and/or issues already litigated between Respondent and Petitioner and/or its predecessor in interest.

Twelfth Affirmative Defense

28. Petitioner’s use of the term “Rat Pack” and “The Rat Pack is Back” is merely descriptive and not distinctive of its goods or services or is generic or does not function

1 to identify Petitioner's goods and services and distinguish them from the like goods and
2 services of others.

3 Thirteenth Affirmative Defense

4 29. The Petitioner's alleged trademark is functional as prohibited by 15 U.S.C. §
5 1052(e)(5).

6 Fourteenth Affirmative Defense

7 30. Respondent reserves the right to raise additional defenses as appropriate upon
8 completion of investigation and discovery.

9
10 **COUNTERCLAIM FOR CANCELLATION**

11 31. Counterpetitioner believes that it will be damaged by the continued registration of
12 Registration No. 2640066 for the designation "The Rat Pack is Back" owned by
13 Counterrespondent.

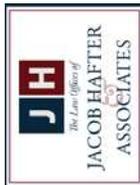
14 32. Upon information and belief, Counterrespondent is a Nevada corporation with its
15 principal place of business located at 7910 Bermuda Road, Las Vegas, Nevada 89123.

16 33. The designation "The Rat Pack is Back" is generic and the public has ceased to identify
17 any trademark utilizing the term "The Rat Pack" with a particular source of a product or
18 service, but rather identifies the mark with a class of products or services regardless of
19 source.

20 34. Continued registration of Registration No. 2640066 and Counterrespondent's
21 enforcement of said registration against any trademark holder utilizing the term "The
22 Rat Pack" is effectively creating monopoly status for Counterrespondent over the term
23 "The Rat Pack."

24 35. Continued registration of Registration No. 2640066 removes from the competitive
25 marketplace terms that other businesses have a right to use and improperly restricts and
26 trammels common and competitive speech.

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36. Counterpetitioner has sustained, and will continue to sustain, damages due to lost bookings as a direct result of Counterrespondent’s aggressive actions towards Counterpetitioner for utilizing the term “The Rat Pack.”

PRAYER FOR RELIEF

37. For the foregoing reasons Registration No. 2640066 should therefore be cancelled pursuant to 15 U.S.C. § 1064, et seq..

Dated this 3rd day of April, 2009.

LAW OFFICE OF JACOB HAFTER & ASSOCIATES.

By: 
JACOB L. HAFTER, ESQ.

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