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

Proceeding	92051579
Party	Defendant Commercial Furniture Group, Inc. (by merger with Howe Furniture Corporation)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

HUMANSCALE CORPORATION,)	
)	
Petitioner,)	Cancellation No. 92051579
)	
vs.)	
)	For the Mark: DIFFRIENT
COMMERCIAL FURNITURE GROUP,)	
INC.)	
)	
Respondent.)	

ANSWER AND AFFIRMATIVE DEFENSES TO PETITION FOR CANCELLATION

COMES NOW Respondent Commercial Furniture Group, Inc. (“CF Group”), by and through the undersigned counsel, and hereby responds to Petitioner Humanscale Corporation’s (“Humanscale’s”) petition to cancel Registration No. 1,632,391 as follows:

The Petition

1. Petitioner has applied for registration of the mark DIFFRIENT WORLD™ on an intent-to-use basis to identify its goods, which include furniture, namely seating, chairs, and stools in International Class 20. The application was filed on March 9, 2009. The mark consists of the surname of Niels Diffrient – a well-known ergonomic furniture designer. In accordance with 15 U.S.C. 1052, a written consent to register the DIFFRIENT WORLD™ mark was executed by Niels Diffrient. The written consent has been made of record.

ANSWER: CF Group admits that Petitioner has applied for registration of the mark DIFFRIENT WORLD on an intent-to-use basis for furniture, namely seating, chairs, and stools in International Class 20. CF Group further admits that the application was filed on March 9, 2009 and that the mark consists of the surname of Niels Diffrient – a well-known ergonomic furniture designer. CF Group denies the remaining allegations of Paragraph 1.

2. Petitioner's Trademark Application No. 77/686364 has been refused registration in an office action based upon Respondent's Registration No. 1,632,391. Therefore, Petitioner will be damaged by the continuance of Registration No. 1,632,391.

ANSWER: CF Group admits that Petitioner's Trademark Application No. 77/686364 has been refused registration in an office action based in part upon Respondent's Registration No. 1,632,391. CF Group denies the remaining allegations of Paragraph 2.

3. Upon information and belief, Howe Furniture Corporation—the predecessor in title of Registration No. 1,632,391— contracted with Niels Diffrient in July 1986 to design a line of tables. Howe Furniture subsequently filed its application for registration of the "DIFFRIENT" mark on April 9, 1990. The mark was registered on the Principal Register on January 22, 1991 in International Class 20 for "furniture, namely tables."

ANSWER: CF Group admits the allegations of Paragraph 3. CF Group further states that the contractual relationship between CF Group and Mr. Diffrient continues to this day. CF Group also states that, pursuant to the contract, Mr. Diffrient expressly authorized and licensed CF Group's predecessor to use the mark DIFFRIENT in connection with manufacturing and sale of furniture.

4. Upon information and belief, Registration No. 1,632,391 was obtained without Niels Diffrient's written consent to registration as required by 15 U.S.C. 1052(c).

ANSWER: CF Group denies the allegations of Paragraph 4.

5. Accordingly, Petitioner submits that Registration No. 1,632,391 is subject to cancellation pursuant to 15 USC 1064(3).

ANSWER: CF Group denies the allegations of Paragraph 5.

WHEREFORE, CF Group respectfully requests that the Petition for Cancellation be dismissed in its entirety at Petitioner's cost.

ANSWER: CF Group denies that Petitioner is entitled to relief it seeks, and demands strict proof thereof..

AFFIRMATIVE DEFENSES

Further answering the Petition, and by way of affirmative defense, and to the extent Registrant CF Group bears the burden of proof, CF Group respectfully states to the Board as follows:

1. Further answering, upon information and belief, Mr. Niels Diffrient does not want the registration at issue cancelled, and has not authorized Humanscale to seek cancellation of such registration on his behalf. Instead, Humanscale misrepresents Mr. Diffrient's intentions, as

well as the scope of its authority under its agreement(s) with Mr. Diffrient, and impermissibly attempts, through its trademark applications claiming its own exclusive rights in the mark DIFFRIENT, to expand its rights beyond those granted by Mr. Diffrient, as evidenced by its recent misrepresentation that CF Group needs a license from Humanscale (not Mr. Diffrient) to continue CF Group's longstanding and senior use of the DIFFRIENT mark.

2. Further answering, CF Group states that Humanscale fails to state a claim upon which relief may be granted, including without limitation on the basis that Humanscale is not in privity with Mr. Diffrient, and otherwise has no right to assert Mr. Diffrient's personal right under 15 U.S.C. § 1064(3).

3. Further answering, CF Group states that Humanscale fails to plead the necessary and operative facts in sufficient detail to provide CF Group with adequate notice of the grounds for supporting the Petition.

4. Further answering, CF Group states that, upon information and belief, Humanscale has not been and will be damaged by the subject registration, including without limitation on the basis that Humanscale is not in privity with Mr. Diffrient, is but a non-exclusive and junior licensee of Mr. Diffrient's, and has no right to assert Mr. Diffrient's personal right under 15 U.S.C. § 1064(3).

5. Further answering, CF Group states that Humanscale lacks standing to seek cancellation of the subject registration, including without limitation on the basis that Humanscale is not in privity with Mr. Diffrient, and otherwise has no right to assert Mr. Diffrient's personal right under 15 U.S.C. § 1064(3).

6. Further answering, CF Group states that any of Humanscale's alleged use of the "DIFFRIENT" mark constitutes a fraudulent trading on the reputation of CF Group, and, therefore, Humanscale cannot be damaged by the subject registration.

7. Further answering, CF Group states that, upon information and belief, Humanscale's claims for relief in its Petition are barred by the doctrines of laches, waiver and/or equitable estoppel.

8. Further answering, CF Group states that, upon information and belief, Humanscale's claims for relief in its Petition are barred by the doctrine of unclean hands.

9. Further answering, CF Group states that, upon information and belief, Humanscale has failed and neglected to use reasonable means to protect itself from its alleged damage and to minimize the alleged damage complained of in its Petition, and as a result, Humanscale's claims for relief are barred.

10. Further answering, CF Group states that Humanscale is entitled to no relief on the grounds that Humanscale has no enforceable trademarks asserted in the Petition and any such claims are invalid.

11. Further answering, CF Group states that, for nearly twenty (20) years, Niels Diffrient has had constructive notice and/or actual knowledge of, and consented, orally, in writing, and/or through his conduct to, CF Group's registration of the trademark DIFFRIENT.

12. Further answering, CF Group states that, after nearly twenty (20) years of his knowledge and consent, Niels Diffrient has acquiesced to the subject registration, is estopped from now asserting that the subject registration was obtained in violation of 15 USC § 1064(3), and any such claim has been affirmatively waived.

13. Further answering, CF Group states that Humanscale is merely a non-exclusive licensee of Mr. Diffrient's and, as such, Humanscale's current or anticipated use of the DIFFRIENT mark is junior to and subject to CF Group's proprietary rights.

14. Further answering, CF Group states that Humanscale lacks sufficient privity with Niels Diffrient to assert his personal rights pursuant to 15 U.S.C. 1052(c) in this proceeding.

15. Further answering, CF Group states that Humanscale is not authorized by Niels Diffrient to assert his personal rights pursuant to 15 U.S.C. 1052(c) in this proceeding.

16. Further answering, CF Group states that, upon information and belief, Humanscale's authorization to register the trademark DIFFRIENT is expressly qualified and limited to DIFFRIENT in connection with specific designs of furniture, and the subject registration falls outside such designs.

17. Further answering, CF Group states Humanscale's qualified authorization to register DIFFRIENT does not constitute a "written consent" to register under 15 U.S.C. 1052(c). Therefore, Humanscale is not authorized to register DIFFRIENT and so cannot be damaged by the subject registration.

18. Further answering, CF Group states that Niels Diffrient is a necessary and indispensable party to this proceeding since his personal right is being asserted and this right is the only basis for the proceeding. Humanscale's action is barred because it has failed to join such necessary and indispensable party.

CF Group reserves all additional affirmative defenses available to it and which become known as this case proceeds.

CONCLUSION

WHEREFORE, Respondent prays that the Board (i) enter an order dismissing this proceeding with prejudice and (ii) grant such other and further relief as it deems just and proper.

Dated: March 4, 2010

Respectfully submitted,

/s/ Jason L. Ross

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing was submitted to the Trademark Trial and Appeal Board electronically via the Internet on March 4, 2010, and was mailed via the United States Postal Service, with postage prepaid, on March 4, 2010, to the following:

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