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

Proceeding	92053336
Party	Defendant J.B. Custom, Inc.
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Attachments	Answer to Braztech Petition to Cancel.pdf (20 pages)(105041 bytes)

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

IN THE MATTER OF TRADEMARK REG. NO. 3,645,700

Filed: April 17, 2008

Registration Date: June 30, 2009

Braztech International, L.C.)

Petitioner,)

v.)

J.B. Custom, Inc.)

Registrant.)

Cancellation No. 92053336

ANSWER TO PETITION TO CANCEL AND AFFIRMATIVE DEFENSES

Commissioner for Trademarks

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Alexandria, VA 22313-1451

COMES NOW Registrant J.B. Custom Inc., (“JB”), by counsel, and for its
Opposition to the Petition to Cancel filed by Petitioner Braztech, L.C., states as follows:

1. Petitioner imports and sells firearms in the United States, including a type
of firearm commonly called a “mare’s leg.”

ANSWER

Registrant is without knowledge as to whether Petitioner imports and sells
firearms in the United States. Registrant denies that Petitioner sells “Mare’s Leg”
firearms or that any “type” of firearm is “commonly called” a Mare’s Leg other than
firearms custom manufactured by Registrant.

2. Petitioner has been accused of trademark infringement under the Registration by Registrant for allegedly referring to one of its mare's leg-type firearms as a mare's leg, in the case of J.B. Custom, Inc. v. Amadeo Rossi, S.A., Forjas Taurus, S.A., Taurus International Manufacturing, Inc. and Braztech International, L.C., Case No. 1:10CV326, filed on September 20, 2010 and currently pending in the Northern District of Indiana (the "Lawsuit").

ANSWER

Registrant admits it has accused Petitioner of violations of law including infringement of Registrant's "Mare's Leg" mark in the Lawsuit specified in Petitioner's paragraph 2. Registrant denies the remaining allegations of Paragraph 2.

3. Petitioner desires to refer to its mare's leg-type firearms by the term "mare's leg" so that the consuming public will clearly know what type of firearm Petitioner offers for sale.

ANSWER

Registrant is without knowledge as to the allegations of Petitioner's Paragraph 3, and therefore denies the same.

4. Petitioner has the right to use the designation "mare's leg" to describe or identify this type of firearm that it imports and sells.

ANSWER

Registrant denies the allegations of Petitioner's Paragraph 4.

5. Petitioner has standing to bring this cancellation proceeding because it is already damaged by the Registration by virtue of the Lawsuit filed against it by Registrant. Further, the Registration continues to damage Petitioner because the evidentiary effect of the Registration tends to impair Petitioner's right to legally use the term "mare's leg" to refer to its products by their common or descriptive name, in that Petitioner for some time has been and will continue to be involved in the importation and sale of mare's leg-type firearms which are of related nature to the services of the Registration.

ANSWER

Registrant denies that Petitioner has standing to bring this cancellation proceeding, denies that Petitioner has a right to legally use the term "mare's leg," and denies that the "Mare's Leg" mark is a common or descriptive name. Registrant is without knowledge as to the remaining allegations of Petitioner's Paragraph 5, and therefore denies the same.

COUNT I

6. Petitioner repeats and re-alleges the allegations set forth in paragraphs 1 through 5 above.

ANSWER

Registrant repeats and re-alleges its Answers to Petitioner's paragraphs 1 through 5 above.

7. Numerous companies worldwide have made and continue to make working and non-working firearms replicas resembling a Winchester Model 1892 rifle

with a shortened barrel and stock (a “mare’s leg-type firearm”), and such firearms are commonly referred to generically by such companies and the consuming public as “a mare’s leg.” The phrase “mare’s leg” (sometimes spelled “mare’s laig”) was coined and popularized in the 50’s by a television show featuring this kind of gun, which was new and unique at the time.

ANSWER

Registrant denies the allegations of Petitioner’s Paragraph 7.

8. JB has registered the “MARE’S LEG” Mark for the services of custom manufacturing of firearms and accessories for firearms (“Registrant’s Services”). JB uses the term “mare’s leg” in conjunction with its sale of goods: mare’s leg-type firearms.

ANSWER

Registrant states that its Mare’s Leg registration speaks for itself, and Petitioner’s Paragraph 8 is denied to the extent inconsistent therewith. Registrant admits that it uses the term “Mare’s Leg” in conjunction with sales of firearms, particularly firearms subject to Registrant’s custom manufacture and gunsmithing services. Registrant denies the remaining allegations of Petitioner’s Paragraph 8.

9. At the time JB obtained the Registration, “mare’s leg” had already become the generic name for any firearm resembling a Winchester 1892 rifle with a shortened barrel and stock. Because “mare’s leg” is a generic term for the type of gun sold by JB under the MARE’S LEG Mark, the term “mare’s leg” is also generic for Registrant’s services involving the “custom manufacturing” of such firearms. Because the registration

of a generic term does not function to identify Registrant's Services and distinguish them from goods and services offered by others, it should be cancelled.

ANSWER

Registrant denies the allegations of Petitioner's Paragraph 9.

COUNT II

10. Petitioner repeats and re-alleges the allegations set forth in paragraphs 1 through 9 above.

ANSWER

Registrant repeats and re-alleges its Answers to Petitioner's paragraphs 1 through 9 above.

11. Registrant's MARE'S LEG Mark was registered pursuant to Section 1(a) of the Lanham Act based upon the trademark examining attorney's acceptance of a Substitute Specimen submitted by JB during the prosecution of the Registration showing use of the MARE'S LEG Mark in connection with Registrant's Services in commerce (the "Substitute Specimen").

ANSWER

Registrant states that the file of its application for the Mare's Leg registration speaks for itself, and Petitioner's Paragraph 11 is denied to the extent inconsistent therewith.

12. Registrant in fact had not used Registrant's Mark in connection with Registrant's Service anywhere and/or in interstate commerce as of at least February 10, 2006. (Exhibit A, Complaint and Contract attached as an exhibit to the Complaint as "Exhibit A"). On February 10, 2006, JB agreed that all of its mare's leg-type firearms would be manufactured for JB by a company in Brazil. Effective on this date, JB's mare's leg-type firearms were not "custom manufactured" by JB for the consuming public.

ANSWER

Registrant denies the allegations of Petitioner's Paragraph 12.

13. JB's Registration was obtained fraudulently in that the formal application papers and responses filed by JB, under oath, states that its Substitute Specimen was a copy of pages from its web site actually in use in commerce as of the filing date of the application, and supported the Registrant's Services advertised under the MARE'S LEG Mark. Said statements were false, however, because the Substitute Specimen was altered and/or fabricated knowingly for the sole purpose of deceiving the Trademark Office and obtaining the registration.

ANSWER

Registrant denies the allegations of Petitioner's Paragraph 13.

14. As shown in the record, JB's application was initially rejected in an Office Action issued on August 4, 2008 because the original Specimen of use did not show the applied-for mark used in connection with Registrant's Services, but rather, was merely an

advertisement for its goods: the mare's leg-type firearms imported and re-sold in the United States by JB (Exhibit B, First Specimen of Use).

ANSWER

Registrant states that the file of its application for the Mare's Leg registration speaks for itself, and Petitioner's Paragraph 14 is denied to the extent inconsistent therewith.

15. On January 29, 2009, JB filed a response to the Office Action by submitting a Substitute Specimen consisting of four pages supported by a Declaration, which described the Substitute Specimen as "specimens of adds distributed and on our website jbcustom.com used in commerce for custom manufacturing of firearms and accessories for firearms." [Sic] (Exhibit C, Substitute Specimen of Use). The Declaration indicates that the Substitute Specimen was actually in use in commerce as of the filing date of the application, April 17, 2008. JB knew that this statement was false.

ANSWER

Registrant states that the file of its application for the Mare's Leg registration speaks for itself, and Petitioner's Paragraph 15 is denied to the extent inconsistent therewith. The remaining allegations of Petitioner's Paragraph 15 are denied.

16. Archival images of JB's website, www.jbcustom.com, show that the Substitute Specimen, as presented to the Trademark Office, was actually not in use as of

April 17, 2008, the filing date of the application. (See Declaration of Kerri A. Hochgesang, Exhibit D).

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner's claimed "archival" images," and therefore denies the same. Registrant denies the remaining allegations of Petitioner's Paragraph 16.

17. According to the sworn statement of JB, if the Substitute Specimen was indeed in use on JB's website at the time of the filing of the application, the correspondence pages of Archival Comparison Page 1 and Archival Comparison Pages 3-4 should match the Substitute Specimen. (Exhibit 2 to the Declaration of Kerri A. Hochgesang). They do not match.

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner's claimed "archival" images," and therefore denies the same. Registrant denies the remaining allegations of Petitioner's Paragraph 17.

18. Page 3 (which continues onto Page 4) of the Substitute Specimen is entitled "1892 Mare's Leg Pistol," and is a printout from a single page at the URL www.jbcustom.com/new-mares.htm. Directly under this title is the critical phrase "Custom Manufactured." Comparing the substitute specimens with the archival images of this page from April of 2008 (immediately before the application was filed); and from

January of 2009) (captured the *very day* that JB filed its response containing the Substitute Specimen), it is apparent that the pages don't match.

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner's claimed "archival" images," and therefore denies the same. Registrant denies the remaining allegations of Petitioner's Paragraph 18.

19. The April 2008 archive of the URL www.jbcustom.com/new-mares.htm looks completely different from the Substitute Specimen. The title of the page from the archive, "1892 Mares Leg Lever Action Pistol." [Sic] including an incorrect spelling of the mark ("Mares Leg" in the archive, as opposed to "Mare's Leg," as seen on the Substitute Specimen). The archive contains no mention of a "custom" mare's leg-type firearm, nor any custom manufacturing services, as seen on Pages 3-4 of the Substitute Specimen.

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner's claimed "archival" images," and therefore denies the same. Registrant denies the remaining allegations of Petitioner's Paragraph 19.

20. The archives of the same URL from September and December of 2008 and January of 2009 are radically different from the April 2008 URL, but identical to each other. The September, December, and January archives of Pages 3-4 resemble those submitted in the Substitute Specimen, but have a critical difference: the phrase "Custom

Manufactured” does not appear on any version of this URL either before or after the application, or before or after the response was filed by JB. The critical phrase for showing use of the mark with Registrant’s Services, “Custom Manufactured,” was not and is not contained on JB’s web site. This phrase was either temporarily added for the sole purpose of printing, or was simply typed into the Substitute Specimen to create a false specimen of use to deliberately mislead the Trademark Office. The fabricated text was the only instance in which the words “custom manufactured” were printed on the same page where the applied-for MARE’S LEG mark was correctly spelled.

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner’s claimed “archival” images,” and therefore denies the same. Registrant denies the remaining allegations of Petitioner’s Paragraph 20

21. Page 2 of the Substitute Specimen has not been located on any year or version of the JB web site, nor are there any links to this page contained therein. Further, a careful examination of Page 2 of the Substitute Specimen contains several inconsecutively numbered and incomplete printouts allegedly from the website www.jbcustom.com as it appeared prior to the filing of the application. Page 2 of the Substitute Specimen has no page number, and the “URL” from the alleged web page, www.jbcustom.com, was clearly altered by hand in blue ink by JB prior to it’s [sic] submission to the Trademark Office.

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner's claimed "archival" images," and therefore denies the same. Registrant denies the remaining allegations of Petitioner's Paragraph 21.

22. Visible borders around the text at the top of Page 2 and the color photographs in the lower half of Page 2 also clearly indicate that the text and photographs were printed, cut out, and pasted together to create an altered and/or fabricated specimen of use. The unusual spacing, capitalization, and formatting on this page are consistent with such a hand-alteration, and tend to further show that Page 2 was not a print-out of a page or link on JB's web site (although presented as if it were).

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner's claimed "archival" images," and therefore denies the same. Registrant denies the remaining allegations of Petitioner's Paragraph 22.

23. Page 1 of the Substitute Specimen does not contain any use of the mark "MARE'S LEG," and does not support the Registration. It is notable, however, that the statement "Custom Manufacturing of Firearms and Accessories for Firearms" appears on this page. This phrase happens to be a verbatim recitation of the description of Registrant's Services taken directly from the Registration. This phrase did not appear on the archival copy of the URL www.jbcustom.com/gunsmith.htm from December 8, 2007, just before the filing of the subject application. (Exhibit 1 to the Declaration of Kerri A. Hochgesang). Instead, the phrase is visible in the URL archive of February 27, 2009,

after the response was filed by JB. Like the other pages of the Substitute Specimen, this specific language appears to have been added to the text of the web site for the sole purpose of responding to the requirements of the Trademark Office.

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner's claimed "archival" images," and therefore denies the same. Registrant denies the remaining allegations of Petitioner's Paragraph 23.

24. Just over a week from the date the Substitute Specimen was submitted to the Trademark Office, JB Custom evidenced its belief that it was successful in deceiving the Trademark Office by including a new registered trademark symbol ® after the phrase MARE'S LEG even though JB had not yet obtained the Registration. (See Exhibit 3 to the Declaration of Kerri A. Hochesgang).

ANSWER

Registrant is without knowledge as to the content, accuracy, or manner of generation of Petitioner's claimed "archival" images," and therefore denies the same. Registrant denies the remaining allegations of Petitioner's Paragraph 24.

25. Said false statements and the deliberate creation and/or alteration of the Substitute Specimen was a misrepresentation of material fact knowingly made by an authorized agent of JB with the knowledge and belief that said statement was false with an intent to deceive the Trademark Office and procure the Registration.

ANSWER

Registrant denies the allegations of Petitioner's Paragraph 25.

26. Said false statement was made with the intent to induce authorized agents of the United States Patent and Trademark Office to grant said Registration, and, reasonably relying upon the truth of said false statements, the United States Patent and Trademark Office did, in fact, grant said registration.

ANSWER

Registrant denies the allegations of Petitioner's Paragraph 26.

27. Petitioner was damaged by said false statements and the Registration issued in reliance thereon in that Petition has been sued in federal court for infringement of the Registration.

ANSWER

Registrant admits that Petition has been sued in federal court for infringement of the Registration. Registrant denies the remaining allegations of Petitioner's Paragraph 27.

28. Petitioner's continued and legal use of the generic term "mare's leg" will be impaired by the continued registration of said mark of Registrant.

ANSWER

Registrant denies the allegations of Petitioner's Paragraph 28.

COUNT III

29. Petitioner repeats and re-alleges the allegations set forth in paragraphs 1 through 28 above.

ANSWER

Registrant repeats and re-alleges its Answers to Petitioner's paragraphs 1 through 28 above.

30. As shown in the record, JB applied to register the MARE'S LEG Mark on the Principal Register of the U.S. Patent and Trademark Office on April 17, 2008. The application states that the mark is used to identify Registrant's Services and claims a date of first use of the mark anywhere as June 4, 200, and a date of first use of the mark in commerce of August 10, 2000.

ANSWER

Registrant states that the file of its application for the Mare's Leg registration speaks for itself, and Petitioner's Paragraph 30 is denied to the extent inconsistent therewith.

31. These dates are merely a recitation of the dates of use claimed in United States trademark Registration No. 2,451,391 for MARE'S LEG, also in connection with Registrant's Services, the "Prior Registration") which was assigned to Registrant on October 18, 2006. Registrant was not itself engaging in the Registrant's Services in commerce on October 18, 2006 according to the details contained in Exhibit A.

ANSWER

Registrant states that the file of its application for the Mare's Leg registration speaks for itself, and Petitioner's Paragraph 31 is denied to the extent inconsistent therewith. The remaining allegations of Petitioner's Paragraph 31 are denied.

32. The specimen supporting the Prior Registration and the date of use in commerce are clearly invalid and false because, at best, the specimen for the Prior Registration only shows use of the MARE'S LEG Mark in conjunction with goods (mare's leg-type firearms), not the Registrant's services. (Exhibit E, Prior Registration Specimen.

ANSWER

Registrant states that the file of its application for the Mare's Leg registration speaks for itself, and Petitioner's Paragraph 32 is denied to the extent inconsistent therewith. The remaining allegations of Petitioner's Paragraph 32 are denied.

33. JB allowed its Prior Registration to expire by February 23, 2008.

ANSWER

Registrant states that the file of its application for the Mare's Leg registration speaks for itself, and Petitioner's Paragraph 33 is denied to the extent inconsistent therewith.

34. Because the Prior Registration was invalid, Registrant's dates of first use listed in the Registration are incorrect, making the Registration invalid. As such, the Registration should be cancelled.

ANSWER

The allegations of Petitioner's Paragraph 34 are denied.

COUNT IV

35. Petitioner repeats and re-alleges the allegations set forth in paragraphs 1 through 34 above.

ANSWER

Registrant repeats and re-alleges its Answers to Petitioner's paragraphs 1 through 34 above.

36. Even if the Substitute Specimen submitted by JB were genuine, the Registration should be cancelled because the Substitute Specimen, at best, only shows JB's use of the MARE'S LEG Mark to describe its goods (mare's leg-type firearms), not to advertise or sell custom manufacturing services.

ANSWER

The allegations of Petitioner's Paragraph 36 are denied.

37. At the time the Substitute Specimen was submitted by JB to the USPTO, JB did not use the term "mare's leg" to custom manufacture firearms for the consuming public. Further, JB's mare's-leg type firearms are not "custom," but rather, they are previously manufactured by machines.

ANSWER

The allegations of Petitioner's Paragraph 37 are denied.

38. The mare's leg-type firearms were, in fact, mass-manufactured by third parties for J.B. Custom since at least February 10, 2006. JB is merely an importer of mare's leg-type firearms who then sells such firearms under the "mark" MARE'S LEG to the consuming public "off the shelf."

ANSWER

The allegations of Petitioner's Paragraph 38 are denied.

39. The Substitute Specimen itself states that JB was not using the MARE'S LEG Mark in conjunction with any custom manufacturing services at least as early as the filing date of the application, April 17, 2008. In fact, the Substitute Specimen states on Page 3 that the mare's leg-type firearms imported and sold by JB are manufactured for JB in Italy by ARMI SPORT-CHIAPPA, not custom manufactured by JB for the benefit of the consuming public.

ANSWER

The allegations of Petitioner's Paragraph 39 are denied.

40. Because JB has failed to show use of the MARE'S LEG Mark in conjunction with Registrant's services, and because JB is not now, and has not, since at least February 10, 2006, custom manufactured firearms and firearm accessories under the MARE'S LEG Mark, its Registration should be cancelled.

ANSWER

The allegations of Petitioner's Paragraph 40 are denied.

COUNT V

41. Petitioner repeats and re-alleges the allegations set forth in paragraphs 1 through 40 above.

ANSWER

Registrant repeats and re-alleges its Answers to Petitioner's paragraphs 1 through 40 above.

42. Upon information and belief, alternatively, Registrant has abandoned said Registration by discontinuing use of the MARE'S LEG Mark in conjunction with Registrant's Services with no intent to resume said use. As such, Registrant has lost all capacity as a source indicator for Registrant's Services.

ANSWER

The allegations of Petitioner's Paragraph 42 are denied.

43 [erroneously enumerated "29"]. Petitioner will be damaged by continuance of said Registration in that Petitioner has a right to use the term "mare's leg" to describe its mare's leg-type firearms, but is prevented from doing so by the Registration, as evidenced by the Lawsuit. Petitioner's continued and legal use of the term "mare's leg" will be impaired by the continued registration of said abandoned registration.

ANSWER

The allegations of Petitioner's Paragraph 43 are denied.

WHEREFORE, Registrant prays that Petitioner's request for Cancellation be denied.

AFFIRMATIVE DEFENSES

1. Petitioner lacks standing to pursue its Petition for Cancellation.
2. Petitioner's request is barred by unclean hands.
3. Petitioner is estopped from seeking Cancellation of the Registration.
4. Petitioner's request is barred by laches.
5. Petitioner has acquiesced in Registrant's use of the Mare's Leg Mark.
6. Petitioner's allegations fail to state cognizable grounds for cancellation.
7. Petitioner's allegations fail to satisfy the pleadings standards of F.R.C.P. 8 and 9(b).

Registrant hereby appoints Jeremy N. Gayed, a member of the State Bar of Indiana, of the law firm Barrett & McNagny, LLP to act its attorney herein, with full power to oppose said Petition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts and to receive all official communications in connection with this Petition for Cancellation.

BARRETT & McNAGNY, LLP

/Jeremy N. Gayed/

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CERTIFICATE OF SERVICE

I hereby certify that I have this 10th day of January, 2011, served a copy of the foregoing via U.S. or Courthouse Mail, postage prepaid, properly addressed to:

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