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

Proceeding	92054106
Party	Defendant AWeber Communications, Inc.
Correspondence Address	AWEBER COMMUNICATIONS INC 3103 PHILMONT AVE STE 200, ATTN: TOM KULZER HUNTINGDON VALLEY, PA 19006 UNITED STATES
Submission	Answer
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Date	07/19/2011
Attachments	Answer to Petition to Cancel.pdf (7 pages)(307746 bytes)

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

Emailability LLC,
Plaintiff

v.

AWeber Communications, Inc.
Registrant – Respondent



Cancellation No. 92054106

Reg. No. 3,728,211

Mark: Email Marketing Delivered

Answer to Petition to Cancel

Registrant-Respondent (“Registrant”), hereby answers and responds, solely for the purpose of this proceeding, to each of the grounds set forth in the Petition to Cancel, as follows:

1. Plaintiff has been continuously using the mark EMAIL DELIVERED ("Plaintiffs Mark") since August of 2008.

Answer: Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 1 and therefore denies same.

2. Plaintiff uses Plaintiffs Mark in connection with products and services designed to enhance and compliment user's experience with email services.

Answer: Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 2 and therefore denies same.

3. Registrant has listed its date of First Use in Commerce on its USPTO Registration for EMAIL MARKETING DELIVERED ("Registrant's Mark") as January 1st, 2009.

Answer: The USPTO records speak for themselves, are the best evidence of their contents and no responsive pleading is required. Registrant reserves the right to introduce such evidence as may be available or necessary to establish dates of first use or other evidentiary material.

4. On April 11th, 2011 AWeber sent a communication to l&l Internet, Inc., the company that hosts Plaintiffs website. In this letter AWeber stated that Plaintiffs Mark "constitutes trademark infringement" and Plaintiffs website should be taken down because its use will result in consumer confusion. On April 21st AWeber sent a communication to Plaintiff stating that AWeber is considering commencing a proceeding under the Uniform Domain Name Dispute Resolution Policy (UDRP) for the purpose of having Plaintiffs domain registration cancelled. The inability of Plaintiff to operate its website will result in substantial harm to Plaintiff.

Answer: Registrant admits that its counsel sent a letter to 1&1 Internet, Inc. All letters sent speak for themselves and is the best evidence of its contents. Otherwise, the allegations in Paragraph 4 are denied as stated.

5. Since commencing use of the Plaintiff's Mark, Plaintiff has created and continues to create goodwill in connection with its mark. Plaintiff has expended significant time, money, and resources in the establishment of goodwill through the advertisement and promotion of its mark.

Answer: Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 5 and therefore denies same.

6. Plaintiffs Mark has become recognized throughout the United States with the high quality products and services of Plaintiff. As such, the goodwill associated with Plaintiff's Mark has made Plaintiff's Mark a valuable asset to Plaintiff.

Answer: Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 6 and therefore denies same.

7. Plaintiff began its use of the mark EMAIL DELIVERED prior to Registrant's use of the mark EMAIL MARKETING DELIVERED.

Answer: Registrant lacks information sufficient to form a belief as to the truth or

falsity of the allegations contained in Paragraph 7 and therefore denies same.

8. Plaintiffs Mark and Registrant's Mark have a similar appearance and commercial impression.

Answer: Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 8, and in particular, the mark that Plaintiff has allegedly adopted or its appearance and impression and therefore denies same.

9. Plaintiffs Mark and Registrant's Mark operate in similar channels of trade and target similar consumers in the promotion of their goods and services.

Answer: Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 9, and in particular, the channels of trade or consumers that Plaintiff has allegedly used in the promotion of its services and therefore denies same.

10. Registrant's Mark is confusingly similar to Plaintiffs Mark as defined in 15 USC § 1052(d).

Answer: Registrant lacks information sufficient to form a belief as to the truth or falsity of the allegations contained in Paragraph 10, and in particular, the mark that Plaintiff has allegedly adopted or its appearance and impression and therefore denies same.

11. Upon information and belief, there was no bona fide use in commerce by the Registrant of Registrant's Mark prior to filing their use-based application under 15 USC § 1051(a) on May 28th, 2009.

Answer: Denied.

12. Upon information and belief, the Registrant committed fraud upon the USPTO in its procurement of a registration for Registrant's Mark.

Answer: Denied.

13. Registrant is primarily engaged in the business of email marketing services and computer software connected therewith. Registrant use of its mark has been solely in connection its email marketing and related services.

Answer: Registrant admits that it is engaged in providing email marketing services and computer software. Otherwise, the allegation is denied as stated.

14. Registrant's Mark is generic, or in the alternative, merely descriptive under 15 USC 1052(e), of the goods and services used in connection with Registrant's Mark.

Answer: Denied.

15. Registrant's Mark has not acquired distinctiveness.

Answer: Denied.

16. Upon information and belief, Registrant does not use Registrant's mark on its website or with any other promotional material it displays to the public.

Answer: Denied.

17. Upon information and belief, Registrant has ceased use of Registrant's Mark without intent to resume use of the mark.

Answer: Denied.

18. Upon information and belief, Registrant has not used Registrant's Mark in the preceding three years.

Answer: Denied.

19. Registrant has abandoned Registrant's Mark as defined in 15 USC § 1127 due to nonuse.

Answer: Denied.

Registrant's Statements

In addition, Registrant sets forth the following statements in support of its defenses:

20. Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001); *In re American Fertility Society*, 188 F.3d 1341, 1346, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999).

21. Where the mark is a phrase, it is generic only if the composite mark as a whole is found to be generic. *In re American Fertility Society*, 188 F. 3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999) (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine because where the mark is a phrase evidence that each separate term is generic is not sufficient). *See also In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1810 (Fed. Cir. 2001) (1-888-M-A-T-R-E-S-S not generic for telephone shop-at-home retail services in the field of mattresses because it "bears closer conceptual resemblance to a phrase than a compound word" and there is no evidence of record that the mark as a whole is generic); and *In re Active Ankle Systems Inc.*, 83 USPQ2d 1532 (TTAB 2007) (DORSAL NIGHT SPLINT found generic for orthopedic splints for the foot and ankle based on record that included third-party use of the entire phrase).

22. "[A] proper genericness inquiry focuses on the description of [goods or] services set forth in the [application or] certificate of registration." *Magic Wand Inc. v. RDB Inc.*, 940 F. d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991).

23. The test for genericness "is to be applied to a mark... as a whole, for the whole may be greater than the sum of its parts." *In re American Fertility*, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999).

24. If the relevant term is merely descriptive, but not generic, the mark may be registered on the Principal Register with a proper showing of acquired distinctiveness under §2(f). See *Express Mortgage Brokers Inc. v. Simpson Mortgage Inc.*, 31 USPQ2d 1371 (E.D. Mich. 1994).

25. The Email Marketing Delivered mark in Registrant's Registration No. 3,728,211 is not generic with regard to the relevant services, namely, "Advertising and commercial information services, via the internet."

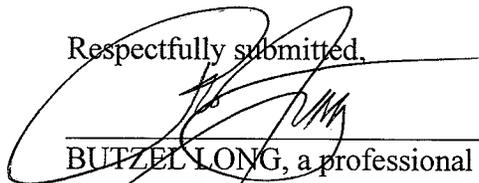
26. Applicant hereby appoints Paul R. Fransway, a member of the Bars of the State of Michigan, Florida and Texas at the firm of:

Butzel Long PC
350 S. Main Street
Suite 300
Ann Arbor, MI 48104

to act as attorneys in the matter of the petition for cancellation identified above, to respond to said petition, to transact all business in the Patent and Trademark Office or the Trademark Trial and Appeal Board connected with the petition for cancellation, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

WHEREFORE, Registrant ask that Plaintiff's petition to cancel be dismissed with prejudice, and for such other relief to which it shows itself entitled.

Respectfully submitted,

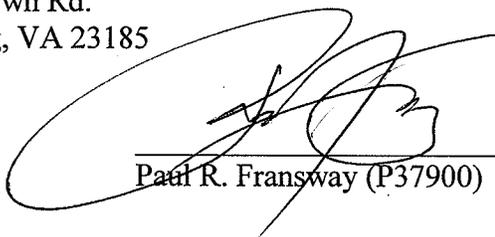


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Dated: July 19, 2011

I hereby certify that on July 19, 2011 a copy of the foregoing **Answer to Petition to Cancel** was served on the Plaintiff's counsel via first class mail to the following address:

Edward Nunes
Bambi Faivre Walters P.C.
1201 Jamestown Rd.
Williamsburg, VA 23185



Paul R. Fransway (P37900)