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Filing date: **11/14/2011**

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

Proceeding	92054481
Party	Defendant India Macatee
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Submission	Answer
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Date	11/14/2011
Attachments	SUPPLEMENTAL ANSWER TO PETITION FOR CANCELLATION.pdf ( 4 pages )(87520 bytes ) Proof of Electronic Service02.pdf ( 1 page )(15937 bytes )

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7

8 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEALS BOARD  
9

10  
11 SONY PICTURES TELEVISION, INC.

12 Petitioner

13 v.

14 INDIA MACATEE

15 Respondent  
16

Cancellation No. 92054481

SUPPLEMENTAL ANSWER TO  
PETITION FOR CANCELLATION

17 In re: Trademark Registration Number 3,869,009  
18 Registered November 2, 2010  
19 reMODEL-Design Mark  
20 India Macatee  
21

22 Respondent INDIA ALLEN f/k/a INDIA MACATEE, a United States  
23 citizen, hereby files this supplemental answer to the Petition  
24 for Cancellation of Registration as follows:

25 SUPPLEMENTAL AFFIRMATIVE DEFENSE

26 Petitioner alleges, in Paragraph 3 of its Petition for  
27 Cancellation of Registration, that it is "the owner of U.S.  
28 Trademark Application Serial No. 85/360,227 for the mark RE-

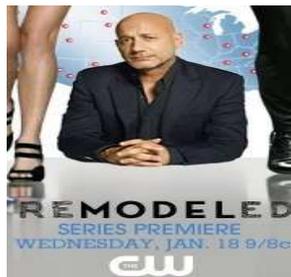
SUPPLEMENTAL ANSWER TO  
PETITION FOR CANCELLATION

1 MODELED", and that it "intends to use [that mark] on or in  
2 connection with entertainment services in the nature of a reality  
3 television series". The Standard-Character Word Mark appears as  
4 follows:

5 RE-MODELED  
6

7 In an email message to Respondent's counsel sent on July 28,  
8 2011, Petitioner's counsel assured Respondent that "it is  
9 [Petitioner's] intention to use the spelling of Re-modeled with  
10 the hyphen".

11 While Petitioner may indeed be the owner of the Registration  
12 for the mark "Re-modeled", that is not the mark which Petitioner  
13 intends to use in interstate commerce "in connection with  
14 entertainment services in the nature of a reality television  
15 series", or the mark which Petitioner will actually use in  
16 interstate commerce on January 18, 2012 when the first episode of  
17 its television series airs on the CW Network and when Petitioner  
18 will likely convert its registration to an "Actual Use"  
19 registration). Instead of using the mark "RE-MODELED" (with the  
20 hyphen), Respondent has just learned that Petitioner actually  
21 intends to use the mark "Remodeled" (without the hyphen) as  
22 follows:



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1 Petitioner's counsel's assurances to Respondent's counsel that it  
2 would be using the trademark "Re-modeled with the hyphen" have  
3 turned out to be false<sup>1</sup>.

4 The omission of the hyphen in the mark, while seemingly  
5 innocuous, is actually extremely important. Searching for the  
6 mark "Remodeled" (without the hyphen) on the Trademark Electronic  
7 Search System ("TESS") fails to reveal Petitioner's Registration;  
8 it is only when the mark "Re-modeled" with the hyphen is used as  
9 the TESS "search term" that TESS lists Petitioner's Registration.  
10 Thus, when Respondent's counsel repeatedly tried to search on  
11 TESS for the trademark "Remodeled" from the time of his first  
12 June 15, 2011 claim letter to Petitioner, that search  
13 consistently failed to reveal Petitioner's Registration.  
14 Respondent relied upon that "failure" to list Petitioner's  
15 registration in its dealings with Petitioner's counsel, and did  
16 not file its own Intent to Use registration [in an abundance of  
17 caution, in the unlikely, but possible, event that the  
18 Registered Trademark at issue herein (filed on July 15, 2008 with  
19 Registration issued on November 2, 2010) would be found to be  
20 invalid) until "matters came to a head" with Petitioner's counsel  
21 on July 28, 2011<sup>2</sup>.

22 Thus, the assertion in Paragraph 7 of Petitioner's Petition  
23 for Cancellation of Registration that Respondent's registration  
24

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25 <sup>1</sup>In an email message to Respondent's counsel dated July 29, 2011,  
26 Petitioner's counsel also said that Petitioner "has capitalized the 'm' [in  
27 'Re-modeled]". That, too, has turned out to be false.

28 <sup>2</sup>That Intent-to-Use Registration, filed on July 28, 2011, was converted  
to an Actual Use Registration on October 15, 2011, when the first episode of  
Respondent's television series aired on TLC.

1 of the trademark "Remodel" "interferes with Petitioner's right to  
2 use and register Petitioner's Mark [i.e. the trademark "Re-  
3 modeled" (with the hyphen)] for use in connection with  
4 Petitioner's Services" is absolutely false. While Petitioner may  
5 indeed have "priority" (because of its June 30, 2011 filing of  
6 its Intent-to-Use registration) with respect to the trademark  
7 "Re-modeled" (with the hyphen), it most certainly does not have  
8 "priority" with respect to the trademark "Remodeled" without the  
9 hyphen). If Petitioner attempts to convert its Intent-to-Use  
10 registration to an Actual Use registration on or after January  
11 18, 2012, when the first episode of its television series airs,  
12 such "conversion" should be rejected by the Trademark Examiner,  
13 as the Intent-to-Use registration does not reflect the trademark  
14 as actually used by Petitioner. If the Registration is never-the-  
15 less later Published for Opposition, Respondent will vigorously  
16 oppose that Registration, as Respondent, and not Petitioner, has  
17 "priority" with respect to the trademark "Remodeled" (without the  
18 hyphen) both by virtue of the Registration of the trademark  
19 "Remodel" at issue herein and by virtue of her Intent-to-  
20 Use/Actual Use registration of that mark on July 28, 2011 and her  
21 first use of that mark in interstate commerce on October 15,  
22 2011.

23 Respectfully submitted,

24 LAW OFFICE OF PAUL S. LEVINE

DATED: November 14, 2011

25  
26  
27 By: \_\_\_\_\_  
28 Paul S. Levine  
Attorney for Respondent

ATTORNEY OR PARTY WITHOUT ATTORNEY (Name, State Bar number, and address): Paul S. Levine (Bar # 102787) Law Office of Paul S. Levine 1054 Superba Avenue Venice, CA 90291-3940 TELEPHONE NO.: (310) 450-6711 FAX NO. (Optional): (310) 450-0181 E-MAIL ADDRESS (Optional): pslevine@ix.netcom.com ATTORNEY FOR (Name):	FOR COURT USE ONLY
SUPERIOR COURT OF CALIFORNIA, COUNTY OF STREET ADDRESS: MAILING ADDRESS: CITY AND ZIP CODE: BRANCH NAME:	
PLAINTIFF/PETITIONER: INDIA ALLEN DEFENDANT/RESPONDENT: SONY PICTURES TELEVISION, INC.	CASE NUMBER: 92054481 JUDICIAL OFFICER:
PROOF OF ELECTRONIC SERVICE	DEPT.:

1. I am at least 18 years old and **not a party to this action.**

a. My residence or business address is (specify):  
 \*\*\*Person serving state MC\*\*\*

b. My electronic service address is (specify):  
 pslevine@ix.netcom.com

2. I electronically served the following documents (exact titles):  
 Supplemental Answer to Petition for Cancellation

The documents served are listed in an attachment (Form POS-050 (D)/EFS-050(D) may be used for this purpose.)

3. I electronically served the documents listed in 2 as follows:

a. Name of person served: Peter K. Hahn, Esq.  
 On behalf of (name or names of parties represented, if person served is an attorney):  
 Petitioner

b. Electronic service address of person served: phahn@luce.com

c. On (date): November 14, 2011

d. At (time): 1:00 PM

The documents listed in item 2 were served electronically on the persons and in the manner described in an attachment.  
 (Form POS-050(P)/EFS-050(P) may be used for this purpose.)

Date: November 14, 2011

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

\_\_\_\_\_ Paul S. Levine \_\_\_\_\_  
 (TYPE OR PRINT NAME OF DECLARANT) (SIGNATURE OF DECLARANT)