

ESTTA Tracking number: **ESTTA619962**

Filing date: **08/06/2014**

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

Proceeding	92054683
Party	Defendant The Hispanic National Bar Foundation, Inc.
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Signature	/AKS/
Date	08/06/2014
Attachments	FINAL HNBF Amended Answer and Affirmative Defenses to Petitioner's Amended Petition for Cancellation.pdf(36571 bytes)

3. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations asserted in paragraph 3 and therefore denies those allegations.
4. Registrant denies the allegations contained in paragraph 4.
5. Registrant denies the allegations pertaining to its By-Laws as stated in paragraph 5 on the grounds that its current and past By-Laws speak for themselves. Registrant lacks sufficient knowledge or information sufficient to form a belief as to the truth of the remaining allegations asserted in paragraph 5 and therefore denies those allegations.
6. Registrant denies the allegations of paragraph 6.
7. Registrant admits that it is the owner of U.S. Trademark Registration No. 3,443,817 for



the following mark:

in connection with

“providing educational scholarships” in International Class 36 and that the filing date for the application from which the registration issued is April 2, 2007. Registrant further admits that the first use date listed on this registration is March 1, 1987. Registrant denies the remaining allegations of paragraph 7.

8. Registrant admits that it is the owner of U.S. Trademark Registration No. 3,447,638 for



the following mark:

in connection

with “providing educational scholarships” in International Class 36 and that the filing date for the application from which the registration issued is March 21, 2007. Registrant

further admits that the first use date listed on this registration is January 12, 2007.

Registrant denies the remaining allegations of paragraph 8.

9. Registrant admits that the Trademark Electronic Search System (TESS) lists Hispanic National Bar Association as the registrant for U.S. Registration No. 2,690,074 and lists The Hispanic National Bar Association, Inc. as the registrant for U.S. Registration Nos. 3,892,489 and 3,942,939. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations asserted in paragraph 9 and, therefore, denies those allegations.
10. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations asserted in paragraph 10 and, therefore, denies those allegations.
11. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the allegations asserted in paragraph 11 and, therefore, denies those allegations.
12. Registrant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations asserted in paragraph 12 and, therefore, denies those allegations.
13. Registrant admits that it has amended its By-Laws over time and that its By-Laws speak for themselves. Registrant denies the remaining allegations in paragraph 13.
14. Registrant denies the allegations of paragraph 14.
15. Registrant admits that the alleged first use date listed with respect to its registration for U.S. Registration No. 3,443,817 is March 1, 1987 and that the alleged first use date claimed with respect to U.S. Registration No. 3,447,638 is January 12, 2007. Registrant further admits that the alleged first use date claimed with respect to U.S. Registration No. 3,942,939 for HISPANIC NATIONAL BAR ASSOCIATION is May 1984. Registrant

lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations asserted in paragraph 15 and, therefore, denies those allegations.

16. Registrant denies the allegations in paragraph 16.
17. Registrant denies the allegations in paragraph 17.
18. Registrant denies the allegations in paragraph 18.
19. Registrant denies the allegations in paragraph 19.
20. Registrant denies the allegations in paragraph 20.
21. Registrant denies the allegations in paragraph 21.
22. Registrant denies the allegations in paragraph 22.
23. Registrant denies the allegations in paragraph 23.
24. Registrant denies the allegations in paragraph 24.
25. Registrant denies the allegations in paragraph 25.
26. Registrant denies the allegations in paragraph 26.
27. Registrant denies the allegations in paragraph 27.
28. Registrant denies the allegations in paragraph 28.
29. Registrant denies the allegations in paragraph 29.

AFFIRMATIVE DEFENSES

FIRST DEFENSE (Laches)

Petitioner's claims are barred by the doctrine of laches. Petitioner had knowledge of Registrant's marks and use of the same, but has unreasonably and unduly delayed in asserting its rights in its marks, which delay has caused Registrant prejudice.

SECOND DEFENSE (Acquiescence)

Petitioner actively represented that it would not assert its rights in its various marks against Registrant and, after such representation was made, delayed in asserting its rights under its marks, which delay was non-excusable. Registrant will be prejudiced as a result of this delay. Accordingly, Petitioner's claims are barred by the doctrine of acquiescence.

THIRD DEFENSE
(Waiver)

Petitioner had full knowledge of its alleged rights under its marks, yet Petitioner engaged in intentional conduct inconsistent with its alleged rights and/or intended to waive its rights as against Registrant. Therefore, Petitioner has waived its alleged rights as against Registrant.

CONCLUSION

Based on the foregoing, Registrant prays that the Petition for Cancellation be dismissed.

Respectfully submitted,

HOGAN LOVELLS US LLP

Dated: August 6, 2014

By: /AKS/

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