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TTAB

October 25, 2012

VIA EXPRESS MAIL POST
OFFICE TO ADDRESSE

Attn: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313

85211681

Re: Academy of Motion Picture Arts and Sciences v. Alliance of Professionals and
Consultants, Inc. (Cancellation No. 92055081)/Respondent's Answer to
Petitioner's Cancellation Petition

Dear Sir or Madame:

Please find enclosed (1) original and one (1) copy of Respondent's Answer to Petitioner's
Cancellation Petition, including a self-addressed, stamped, envelope. Please return a file-
stamped copy of the Answer to my attention in the self-addressed, stamped envelope.

Do not hesitate to contact me should you have any questions.

Sincerely,

Maricia M. Roseboro
Corporate Counsel

Cc: Claudia T. Bogdanos (Counsel for Petitioner)
Ulana Holubec (Counsel for Petitioner)
David W. Quinto (Counsel for Petitioner)
Roy Roberts, Alliance of Professionals & Consultants, Inc.

Encls. (2 as stated in text)



U.S. Patent and Trademark Office #72

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

In the Matter of Registration No. 3,974,726
Registered June 7, 2011
Mark: OSCAR

ACADEMY OF MOTION PICTURE)
ARTS AND SCIENCES,)
)
Petitioner,)
)
v.)
)
ALLIANCE OF PROFESSIONALS &)
CONSULTANTS, INC.)
)
Respondent.)

Cancellation No. 92055081

ANSWER TO PETITION FOR CANCELLATION

TO THE COMMISSIONER FOR TRADEMARKS:

NOW COMES Respondent, Alliance of Professionals & Consultants, Inc. ("APC") pursuant to Rule 8(b) of the Federal Rules of Civil Procedure and Trademark Board Manual of Procedure §311.02, and Answers the Petition for Cancellation of the Academy of Motion Picture Arts and Sciences (the "Academy") as follows.

1. Admitted.
2. Admitted.
3. Answering Paragraph 3, APC avers that it first used the trademark OSCAR in commerce on March 13, 2009 that is listed in the subject trademark registration, and further that the filing date of APC's trademark application was January 6, 2011. APC is without knowledge or sufficient information to form a belief as to the truth of the remaining allegations in Paragraph

3, and on that basis denies the remaining allegations in Paragraph 3 except as specifically averred herein.

4. APC is without knowledge or sufficient information to form a belief as to the truth of the allegations in Paragraph 4, and on that basis denies the allegations in Paragraph 4.

5. APC is without knowledge or sufficient information to form a belief as to the truth of the allegations in Paragraph 5, and on that basis denies the allegations in Paragraph 5.

6. APC is without knowledge or sufficient information to form a belief as to the truth of the allegations in Paragraph 6, and on that basis denies the allegations in Paragraph 6.

7. APC is without knowledge or sufficient information to form a belief as to the truth of the allegations in Paragraph 7, and on that basis denies the allegations in Paragraph 7.

8. Answering Paragraph 8, the Academy is the current listed owner of Registrations Number 1096990, 1118751, 1528890, 1996585, 2021582, 2029445, and 2341104. The remaining allegations of Paragraph 8 are conclusions of law to which no responsive pleading is Required. To the extent that a response is required, APC denies the remaining allegations of Paragraph 8.

9. The phrase "above-referenced" in Paragraph 9 is vague. To the extent that a response is required, the allegations in Paragraph 9 are conclusions of law to which no responsive pleading is required, and, therefore, the allegations of Paragraph 9 are denied.

10. APC is without knowledge or sufficient information to form a belief as to the truth of the allegations in Paragraph 10, and on that basis denies the allegations in Paragraph 10.

11. APC is without knowledge or sufficient information to form a belief as to the truth of the allegations in Paragraph 11, and on that basis denies the allegations in Paragraph 11.

12. APC is without knowledge or sufficient information to form a belief as to the truth of the allegations in Paragraph 12, and on that basis denies the allegations in Paragraph 12.

13. Answering Paragraph 13, APC avers that it first used the OSCAR Mark in commerce as of March 13, 2009, and further that the filing date of APC's OSCAR Mark is January 6, 2011. APC is without knowledge or sufficient information to form a belief as to the truth of the remaining allegations in Paragraph 13, and on that basis denies the allegations in Paragraph 13 as except as specifically averred herein.

14. Answering Paragraph 14, APC avers that it first used the OSCAR Mark in commerce as of March 13, 2009, and further that the filing date of APC's OSCAR Mark is January 6, 2011. APC is without knowledge or sufficient information to form a belief as to the truth of the remaining allegations in Paragraph 14, and on that basis denies the allegations in Paragraph 14.

15. APC is without knowledge or sufficient information to form a belief as to the truth of the allegations in Paragraph 15 and on that basis denies the allegations in Paragraph 15.

16. Admitted.

17. Answering Paragraph 17, it is admitted that APC's Mark is OSCAR. Except as averred herein, the remaining allegations in Paragraph 17 are denied.

18. Answering Paragraph 18, APC avers that it first filed its application for the OSCAR Mark on January 6, 2011. APC is without knowledge or sufficient information to form a belief as to the truth of the remaining allegations in Paragraph 18, and on that basis denies the remaining allegations in Paragraph 18.

19. Answering Paragraph 19, APC avers that it applied to register for the OSCAR Mark in connection with "providing recognition and incentives by the way of awards and contests to

demonstrate excellence in the field of business consultation and information technology”; that APC uses the subject Mark; and obtained registration of the OSCAR Mark for “providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of business consultation and information technology”. As to the remaining allegations of Paragraph 19, APC denies that it was required to obtain the Academy’s consent, authorization, or license in connection with APC’s OSCAR Mark, and to the extent that a response is required, the remaining allegations of Paragraph 19 are denied.

20. Answering Paragraph 20, it is admitted that APC uses the OSCAR Mark to mean **Outstanding Service to Client – Award & Recognition** for APC’s outstanding business and information technology professionals. Attached hereto is APC’s Exhibit A representing a true and accurate printout from APC’s webpage referencing the winners of APC’s OSCAR – **Outstanding Service to Client- Award & Recognition**. Furthermore, the purported Exhibit B speaks for itself. The remaining allegations of Paragraph 20 are conclusions of law to which no responsive pleading is required, and, therefore, the allegations of Paragraph 20 are denied.

21. Denied.

22. The Trademark Trial and Appeal Board mailed an opinion to the parties on September 27, 2012, striking Paragraph 22 from the Academy’s Petition to Cancel in response to APC’s motion to dismiss for failure to state a claim, and, therefore, Paragraph 22 is denied.

23. The allegations of Paragraph 23 are conclusions of law to which no responsive pleading is required. To the extent that a response is required, APC denies the allegations of Paragraph 23.

24. The allegations of Paragraph 24 are conclusions of law to which no responsive pleading is

required. To the extent that a response is required, APC denies the allegations of Paragraph 24.

AFFIRMATIVE DEFENSES

First Affirmative Defense
(Failure to State a Claim)

1. The Academy's Petition for Cancellation fails to state a claim upon which relief may be Granted, and is incorporated by reference prior to Paragraph 1 above.

Second Affirmative Defense
(Laches)

2. The Academy's claims are barred by the doctrine of laches.

Third Affirmative Defense
(Waiver)

3. The Academy's claims are barred by the doctrine of waiver.

Fourth Affirmative Defense
(Unclean Hands)

4. The Academy's claims are barred or abated substantially by the doctrine of unclean hands.

Fifth Affirmative Defense
(Failure to Mitigate)

5. Without any admission by APC that the Academy suffered injury in any way, to the extent that the Academy did suffer such injury, their claims are barred in whole or in part because they failed to use reasonable means to prevent the alleged damage and failed to use reasonable means to mitigate their damages.

Sixth Affirmative Defense

(Acquiescence)

6. The Academy's claim is barred by the defense of acquiescence in that the Academy has acquiesced in APC's adoption, registration and use of the OSCARA Mark, and cannot now contest those rights in this proceeding.

Seventh Affirmative Defense

(No damages)

7. The Academy's claims fail in whole or in part to the extent they have suffered no damages.

Eighth Affirmative Defense

(Reservation of Rights to Add Defenses)

8. APC reserves the right to assert additional defenses upon discovery of further information concerning the Academy's claims.

WHEREFORE, APC prays:

1. That the Cancellation Petition be dismissed with Prejudice.
2. That the Academy take nothing by their Petition for Cancellation and further that any judgment be found in favor of APC.

3. That the Trademark Trial and Appeal Board order such other and further relief in APC's favor that is just and proper.

This the 25th day of October 2012.

By: Maricia Moye Roseboro
Maricia Moye Roseboro
8200 Brownleigh Drive
Raleigh, North Carolina 27617
Telephone: 919-510-9696
Fax: 919-510-9668
Attorney for Respondent Alliance of Professionals
& Consultants, Inc.

CERTIFICATE OF SERVICE

I certify that on the 25th day of October, 2012, I caused a true copy of the attached Answer to Petition for Cancellation be served on the attorneys for the Academy of Motion Picture Arts and Sciences via Transmission by Overnight Courier at the following address:

Quinn Emanuel Urquhart & Sullivan, LLP
Claudia T. Bogdanos
Ulana Holubec
51 Madison Avenue, 22nd Floor
New York, NY 10010

Quinn Emanuel Urquhart & Sullivan, LLC
David W. Quinto
865 South Figueroa Street, 10th Floor
Los Angeles, CA 90017-2543

This the 25th day of October 2012.

By: Maricia Moye Roseboro
Maricia Moye Roseboro
8200 Brownleigh Drive
Raleigh, North Carolina 27617
Telephone: 919-510-9696
Fax: 919-510-9668
Attorney for Respondent Alliance of Professionals
& Consultants, Inc.

CERTIFICATE OF MAILING

I hereby certify that on this 25th day of October 2012 this correspondence is being deposited with the United States Postal Service with sufficient postage as **Express Mail Post Office to Addressee** by Service of the United States Postal Service (USPS) in an envelope addressed to:

**ATTN: Trademark Trial and Appeal Board
Commissioner for Trademarks**

**P.O. Box 1451
Alexandria, VA 22313-1451**

This 25th day of October 2012.

By:

Maricia Moye Roseboro

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Attorney for Respondent Alliance of Professionals &
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