

ESTTA Tracking number: **ESTTA480391**

Filing date: **06/27/2012**

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

Proceeding	92055406
Party	Defendant Reginald C. Barrett
Correspondence Address	REGINALD C BARRETT 20 LAUREL HILL LANE, PO BOX 914 AMAGANSETT, NY 11930 UNITED STATES
Submission	Answer
Filer's Name	Todd Wengrovsky
Filer's e-mail	contact@twlegal.com
Signature	/Todd Wengrovsky/
Date	06/27/2012
Attachments	Barrett TTAB Answer 06272012 Filing.pdf (6 pages)(21589 bytes)

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

Proceeding Number: **92055406**

Registration No.: **3,883,715**

Mark: **(Logo in International Class 034)**

BOX TTAB
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**DEFENDANT'S ANSWER TO
PLAINTIFF'S PETITION TO CANCEL**

Defendant /Registrant Reginald Barrett, by his attorney Todd Wengrovsky, hereby responds to the petition letter filed by Plaintiff (the “Petition”), as follows:

1. Defendant denies the allegation identified as “(1)” in the Petition that “*the design descriptively suggests the applicant is a Native American, and that the products are Native American made products.*”

2. Defendant denies the allegation identified as “(2)” in the Petition that “*the design falsely suggests a connection with Native America.*”

3. Defendant denies the allegation identified as “(3)” in the Petition that “*the design application was a fraud upon the Patent and Trademark Office.*”

4. Furthermore, Defendant denies the unnumbered allegation on Page 2 of the Petition that “*Mr. Barrett went into competition against petitioner.*”

5. Defendant also denies the unnumbered allegation on Page 2 of the Petition that “*Petitioner has recently learned of Registration Number 3883715*” (emphasis added).

6. Finally, Defendant denies the unnumbered allegation on Page 2 of the Petition that the registration is petitioner’s earlier filed design “*with slight modification.*”

Defendant further states the following:

The parties to the present proceeding met in 2006 due to business unrelated to the present action. Petitioner happened to own a smoke shop at the time, and Defendant, originally from South Carolina, had contacts in the tobacco industry. Defendant therefore suggested a joint venture between the parties to develop a new cigarette brand. Defendant suggested several cigarette manufacturers and a graphic designer for the joint venture. Petitioner originally desired a foreign manufacturer for cost-cutting reasons, but Defendant selected a domestic manufacturer to insure the

highest quality product.

The parties then together developed a logo for a “SHINNECOCK BRAND” of cigarettes (hereinafter referred to as the “first logo”). Although Petitioner had *some* input in the contents of the first logo, Defendant later found out that Petitioner’s alleged contribution was taken directly from the Shinnecock Nation’s actual seal. In addition, the phrase “Made Under Sovereign Authority” was added by Petitioner, but was never wanted by Defendant. Petitioner represented that he had authority to use this language, but the usage of such language was later found to be inappropriate and indeed inaccurate.

Defendant’s contributions to the first logo were many, and included: (1) a unique large tan pipe with red and purple feathers in the foreground of the logo at issue; (2) a unique yellow and orange sunrise with a pink and white sky in the background of the image; and (3) a tobacco plant in the middle of the image.

Despite Defendant’s designing of the key components of the logo, Petitioner filed a trademark application including the first logo without Defendant’s knowledge and without Defendant being listed as a co-applicant. Consistent with such behavior, Petitioner also communicated directly with Defendant’s industry contacts without Defendant’s knowledge.

Following a falling out between the parties (largely due to the above-noted misrepresentations and behavior by Petitioner), Defendant left to develop his own product. At this time, Petitioner was not a manufacturer of cigarettes, and only owned the aforementioned retail location. Defendant then designed his own logo (hereinafter referred to as the “new logo”). The new logo used only the generic male native from the first logo and nothing else significant, but for the elements that had been designed by Defendant. With the new logo, and in his new business,

Defendant was acting privately and wholly independent from the Petitioner, the Shinnecock Nation, and any other entity.

As is well established in the record, Defendant then applied for and was granted Trademark Registration Number 3,883,715 for the new logo. It should be noted that Petitioner did not oppose the Registration, and did not protest Defendant's application publicly or privately in any way. In fact, Defendant's application was filed on May 27, 2009, nearly two years prior to the current Petition. Upon information and belief, Petitioner was well aware of Defendant's application long before the filing date of the present Petition and, without explanation, significantly delayed filing same.

Defendant also applied for and was granted a South Carolina state trademark for the new logo. In addition, Defendant applied for and was granted a New York state trademark for the new logo. Moreover, Defendant even applied for and was granted a Copyright Registration for the new logo, further solidifying his rights to the mark.

As for the commercialization of Defendant's product, Defendant uses a licensed and respected manufacturer for his SHINNEOCK BRAND. Furthermore, Defendant, in an abundance of caution, even uses a disclaimer on his packaging to the effect that his product is not in any way affiliated with or distributed by the Shinnecock Nation. Importantly, upon information and belief, the Shinnecock Nation was and is completely aware of Defendant's new logo and product. The Shinnecock Nation has filed nothing to challenge Defendant's Registration and has not objected to Defendant's logo or product in any way.

Due to all of the foregoing, it is disingenuous for Petitioner to assert that "*the design descriptively suggests the applicant is a Native American, and that the products are Native*

American made products.” Likewise, Petitioner’s argument that “*the design falsely suggests a connection with Native America*” is a mere conclusory statement that is completely without merit. In fact, dozens of businesses in Suffolk County, New York (the county of Defendant’s residence) utilize the term “Shinnecock” within their business names, in part because Shinnecock is an actual geographic region of Suffolk County, New York.

In sum, due to the circumstances outlined above, it can not be stated that “*the design application was a fraud upon the Patent and Trademark Office,*” as asserted by Petitioner. Far from fraudulent activity, Defendant designed his own logo and has repeatedly gone through all of the proper channels to confirm his absolute rights in and to the mark. Accordingly, Defendant’s Registration should not be cancelled and the Petition should be dismissed in its entirety.

WHEREFORE, Registrant / Defendant requests that the Petition to Cancel be dismissed in its entirety with prejudice.

Dated: Calverton, New York.
June 27, 2012

/s/ Todd Wengrovsky
Todd Wengrovsky
Law Offices of
Todd Wengrovsky, PLLC.
285 Southfield Road, Box 585
Calverton, NY 11933
Tel (631) 727-3400
Attorney for Defendant

CERTIFICATE OF SERVICE

I hereby certify that on June 27, 2012, a copy of the foregoing Defendant's Answer to Plaintiff's Petition to Cancel was electronically filed with the United States Patent and Trademark Office and that a copy was deposited with the United States Postal Service as First Class Mail, postage paid, in an envelope addressed to Plaintiff's attorney of record:

Scott Michael Moore, Esq.
Moore International Law PLLC
45 Rockefeller Plaza, Suite 2000
New York, NY 10111

/s/ Todd Wengrovsky
Todd Wengrovsky
Law Offices of
Todd Wengrovsky, PLLC.
285 Southfield Road, Box 585
Calverton, NY 11933
Tel (631) 727-3400
Attorney for Defendant