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

Proceeding	92055641
Party	Defendant Yitzhak Birnhack
Correspondence Address	YITZHAK BIRNHACK 1939 50TH STREET BROOKLYN, NY 11204 UNITED STATES
Submission	Answer
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Date	08/23/2012
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE

TRADEMARK TRIAL AND APPEAL BOARD

Respondent: Rabbi Mayer Birnhack
Registration No.: 3,244,713
Mark: E-ZPASSPORT
Registered: May 22, 2007

<p>The Port Authority of New York and New Jersey, Petitioner, v. Rabbi Mayer Birnhack, Registrant.</p>	<p>Cancellation No.: 92055641 ANSWER</p>
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Registrant Rabbi Mayer Birnhack (“Registrant” or “Birnhack”)¹, in response to the Petition to Cancel filed by Petitioner The Port Authority of New York and New Jersey (“Petitioner” or “Port Authority”), by and through his undersigned counsel, hereby answers the Petition for Cancellation (the “Petition”) as follows:

¹ The Petition for Cancellation was originally filed against Registrant Yitzhak Birnhack. However, the Registration has been assigned to Registrant Rabbi Mayer Birnhack. Said Assignment was filed with the USPTO prior to filing this Answer.

ANSWER

1. Registrant admits the allegations contained in paragraph 1 of the Petition.
2. Registrant denies the allegations contained in paragraph 2 of the Petition.
3. Registrant admits the allegations contained in paragraph 3 of the Petition.
4. Registrant admits the allegations contained in paragraph 4 of the Petition.
5. Registrant denies the allegations contained in paragraph 5 of the Petition.
6. Responding to paragraph 6 of the Petition, Registrant is without knowledge or information to form a belief as to the truth of the allegations contained therein, and on that basis denies them.
7. Responding to paragraph 7 of the Petition, Registrant is without knowledge or information to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

8. Responding to Paragraph 8 of the Petition, Registrant is without knowledge or information to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

9. Responding to Paragraph 9 of the Petition, Registrant admits Petitioner's use of the domain names e-zpassny.com, ezpassny.com and ezpassmd.com but is without knowledge or information to form a belief as to the truth of the allegation that there are other domain names used by petitioner to market Petitioner's services, and on that basis denies the remaining allegations.

10. Responding to Paragraph 10 of the Petition, Registrant is without knowledge or information to form a belief as to the truth of the allegations contained therein, and on that basis denies them.

11. Registrant denies the allegations contained in Paragraph 11 of the Petition.

12. Registrant denies the allegations contained in Paragraph 12 of the Petition.

13. Registrant denies the allegations contained in Paragraph 13 of the Petition.

14. Registrant admits the allegations contained in Paragraph 14 of the Petition.

15. Registrant admits the allegations contained in Paragraph 15 of the Petition.

16. Registrant admits the allegations contained in Paragraph 16 of the Petition.

17. Responding to paragraph 17 of the Petition, Birnhack restates and incorporates by reference his responses to the allegations contained in paragraphs 1 to 16 of the Petition.

18. Registrant denies the allegations contained in Paragraph 18 of the Petition.

19. Registrant denies the allegations contained in Paragraph 19 of the Petition.

20. Registrant denies the allegations contained in Paragraph 20 of the Petition.

21. Registrant denies the allegations contained in Paragraph 21 of the Petition.

22. Responding to Paragraph 22 of the Petition, Registrant admits that the date of first use for E-Z PASSPORT is claimed as July 1, 2005 but is without knowledge or information to form a belief as to the truth of the allegation regarding Petitioner's alleged date of first use, and on that basis denies it.

23. Registrant denies the allegations contained in Paragraph 23 of the Petition.

24. Registrant denies the allegations contained in Paragraph 24 of the Petition.

25. Registrant denies the allegations contained in Paragraph 25 of the Petition.

26. Registrant denies the allegations contained in Paragraph 26 of the Petition.

27. Responding to paragraph 27 of the Petition, Birnhack restates and incorporates by reference his responses to the allegations contained in paragraphs 1 to 26 of the Petition.

28. Registrant denies the allegations contained in Paragraph 28 of the Petition.

29. Registrant denies the allegations contained in Paragraph 29 of the Petition.

PETITIONER'S PRAYER FOR RELIEF

Registrant denies that Petitioner is entitled to any of the relief requested in its prayer for relief. Registrant prays that the Petition is denied and dismissed in favor of Registrant.

AFFIRMATIVE DEFENSES

Further answering the Petition, Registrant asserts the following defenses, without assuming the burden of proof when such burden would otherwise be on the Petitioner.

FIRST DEFENSE: Failure to State a Claim

1. Petitioner fails to state a claim upon which relief can be granted.

SECOND DEFENSE: No Likelihood of Confusion

2. Registrant alleges that there is no likelihood of confusion, mistake or deception between Registrant's E-ZPASSPORT Mark and Petitioner's Marks.

THIRD DEFENSE: Unclean Hands

3. Petitioner's claims are barred by the doctrine of unclean hands.

FOURTH DEFENSE: Acquiescence

4. Petitioner's claims are barred by the doctrine of acquiescence.

SIXTH DEFENSE: Laches, Waiver and/or Estoppel

6. Petitioner's claims are barred by the equitable doctrines and affirmative defenses of laches, waiver and/or estoppel, as applicable.

SEVENTH DEFENSE: Abandonment of Mark

7. Petitioner does not have trademark rights in the E-ZPASSPORT mark. Among other things, Petitioner abandoned two (2) previous applications for an "E-ZPASSPORT" mark (Serial Nos. 76381475 and 76381494).

EIGHTH DEFENSE: Coexistence

8. The marks at issue have coexisted for at least seven (7) years, without any consumer confusion.

NINTH DEFENSE: Reservation of Rights

9. Respondent currently has insufficient knowledge or information on which to form a belief as to whether it may have additional, as yet unstated, defenses available. Respondent reserves the right to assert additional defenses in the event that discovery indicates it would be appropriate.

WHEREFORE, Registrant requests that the claims alleged by Petitioner be dismissed and that Applicant's U.S. Trademark Registration No. 3,244,713 remain registered.

Date: August 23, 2012

Respectfully submitted,

Rabbi Mayer Birnhack, by his counsel,
Lipsitz Green Scime Cambria LLC

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CERTIFICATE OF SERVICE

I, Lori Vangelov, hereby certify that a true copy of the foregoing Answer of Registrant Rabbi Mayer Birnhack was mailed, first class, postage prepaid this 23rd day of August, 2012, upon counsel for Petitioner at the following address:

Carole E. Klinger
Kramer Levin Naftalis & Frankel LLP
1177 Avenue of the Americas
New York, New York 10036

Dated: August 23, 2012

/Lori Vangelov/
Lori Vangelov

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