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

Proceeding	92057877
Party	Defendant Motel One GmbH
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD

In the matter of Registration No. 3,505,545
Date of Registration: September 23, 2008
Trademark: MOTEL ONE (and Design)

G6 HOSPITALITY IP LLC.,	:	
Petitioner,	:	
vs.	:	Cancellation No. 92,057,877
MOTEL ONE GMBH,	:	
Registrant.	:	

ANSWER TO PETITION TO CANCEL

Registrant Motel One GmbH ("Motel One") runs a chain of hotels[1] in Europe under the trademark MOTEL ONE offering premium services and lodgings at an affordable price. In 2007, as part of its plans to expand into the United States and to promote its European hotels to United States consumers, Motel One applied to register the mark MOTEL ONE (and Design) (Registration No. 3,505,545) through Section 66(a) of the Lanham Act. Since 2007, Motel One has continuously advertised its hotel services

[1] Although Motel One uses the trademark MOTEL ONE to emphasize the savings that its customers receive, it is actually a chain of hotels and caters to a very different market demographic than Motel 6. Its hotels are therefore not typical "motels" in that they are not roadside hotels having rooms adjacent to an outside parking area or urban hotels offering parking within the building. In contrast, MOTEL 6 is the paradigmatic "motel," as its hotels are usually roadside motels having rooms adjacent to an outside parking area in rural locations.

and offered reservation services to customers in the United States under the MOTEL ONE mark directly through the Internet and through online travel agencies such as Orbitz and Expedia. Further, Motel One has continuously engaged in efforts to open a hotel in the United States under the MOTEL ONE mark, including pursuing real estate contracts and other contracts and licenses necessary to run a hotel.

During these seven years, Motel One's registered trademark has coexisted with Petitioner G6 Hospitality IP LLC's MOTEL 6 registered trademarks without any indication that consumers were confused by the marks. That peaceful coexistence is hardly surprising given that MOTEL ONE and MOTEL 6 hotels are located in very different geographic areas and cater to very different consumers, and that they both coexist with numerous other hotels that have numbers in their marks including but not limited to:

- the following federally-registered marks for hotel-related services: 1 HOTEL & RESIDENCES, HOTEL FORMULE 1, HOTEL FIVE, SUPER 8 MOTEL, E-Z 8 MOTELS, HOTEL32, HOTEL 43, HOTEL FIFTY, HOTEL 400, HOTEL 1000, and TWENTY4SEVEN HOTELS;
- the following state-registered marks for hotel-related services: MOTEL 7, SUPER 7 MOTEL, 7-STAR MOTEL, ASHLEY'S MOTEL 7, LUCKY-7 MOTEL, MOTEL 8, MOTEL 9, NINE PINES MOTEL, SELECT 10 MOTEL, THE BIG 12 MOTEL, HOTEL 18; and FORTY WINKS MOTEL; and

- the following common law marks for hotel services: SEA ESTA MOTEL 2, MOTEL 3, MOTEL 4, MOTEL 7, MOTEL 8, E-Z 8 MOTEL, MOTEL 9, MOTEL 10, MOTEL 62, MOTEL 63, MOTEL 66, and MOTEL 68,.

Motel One, by and through its counsel, Debevoise & Plimpton LLP, therefore Answers the Petition to Cancel (the "Petition") filed on September 16, 2013 by Motel 6 as follows:

1. Motel One denies knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Petition. Motel One further notes that, according to the Motel 6 website (www.motel6.com/about/corpprofile.aspx), the first Motel 6 hotel charged $6 per night, which established the chain's brand name.

2-5. Motel One denies knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraphs 2-5 of the Petition.

6. Motel One denies knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Petition and refers the Board to the identified federal registrations for their true and complete contents.

7-8. Motel One denies knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraphs 7-8 of the Petition.

9. Motel One admits that it filed Application Serial No. 79/044,672 (the "Application") with the U.S. Patent and Trademark Office ("USPTO") for the mark MOTEL ONE (and Design) and refers to the application for its true and complete contents.

10. Motel One admits the allegations contained in Paragraph 10 of the Petition.

11. Motel One admits the allegations contained in Paragraph 11 of the Petition.

12. Paragraph 12 states a legal conclusion to which no response is required. To the extent a response is required, Motel One denies the allegations contained in Paragraph 12 of the Petition, except admits that, as of the date the Petition was filed, the MOTEL ONE mark had not yet been registered in the United States for five years.

13. Motel One repeats and re-alleges each of its responses to Paragraphs 1-12 as if fully set forth herein.

14. Motel One denies the allegations contained in Paragraph 14 of the Petition.

15. Motel One admits the allegations contained in Paragraph 15 of the Petition.

16. Motel One denies the allegations contained in Paragraph 16 of the Petition.

17. Motel One admits the allegations contained in Paragraph 17 of the Petition.

18. Motel One admits the allegations contained in Paragraph 18 of the Petition.

19-21. Motel One denies the allegations contained in Paragraphs 19-21 of the Petition.

22. Motel One repeats and re-alleges each of its responses to Paragraphs 1-21 as if fully set forth herein.

23. Motel One denies the allegations contained in Paragraph 23 of the Petition.

24. Motel One repeats and re-alleges each of its responses to Paragraphs 1-12 as if fully set forth herein.

25-26. Motel One denies knowledge and information sufficient to form a belief as to the truth of the allegations contained in Paragraphs 25-26 of the Petition.

27. Motel One admits that MOTEL ONE and MOTEL 6, when used as words, both begin with the word "MOTEL", but denies any implication that the marks are confusingly similar and avers that the word MOTEL is generic for MOTEL 6's services and that the word MOTEL is generally disclaimed from the parties' registrations.

28. Motel One denies the allegations contained in Paragraph 28 of the Petition, and avers that, although the mark MOTEL 6 contains a single digit number directly after the word "MOTEL", the mark MOTEL ONE contains a three-letter word forming the meaning of a different number after the word "MOTEL" as well as a stylized number "1" inside a circle superimposed under the mark.

29-35. Motel One denies the allegations contained in Paragraphs 29-35 of the Petition.

GENERAL DENIAL

Except as expressly stated above, Motel One denies each and every allegation in the Petition.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Motel 6's claims are barred by the equitable doctrine of laches.

Second Affirmative Defense

Motel 6's claims are barred by the doctrine of acquiescence.

Third Affirmative Defense

Motel 6's claims are barred by the doctrine of estoppel.

Fourth Affirmative Defense

Motel 6's claims are barred because Motel One has used, is using, and intends to use the MOTEL ONE mark in commerce in the United States under the doctrine of tacking.

PRAYER FOR RELIEF

Motel One respectfully requests that the Board reject the Petition and grant such other and further relief as it deems appropriate.

Dated: July 25, 2014

Respectfully submitted,

DEBEVOISE & PLIMPTON LLP

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CERTIFICATION OF SERVICE

This is to certify that on July 25, 2014, I caused a copy of the foregoing ANSWER TO PETITION TO CANCEL to be served by first class mail upon:

Tanya Marie Curcio
Vorys Sater Seymour & Pease LLP
1909 K Street NW, 9th Floor
Washington, DC 20006
United States

Executed this 25th day of July, 2014 in New York, New York.

Zheng Wang