ESTTA Tracking number: **ESTTA573090**
Filing date: **11/25/2013**

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

Proceeding	92058047
Party	Defendant GI Group, Inc.
Correspondence Address	GI GROUP INC 8301 RIO SAN DIEGO DR #5 SAN DIEGO, CA 92108 UNITED STATES
Submission	Answer
Filer's Name	John A. James, Esq.
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Date	11/25/2013
Attachments	img052.pdf(207211 bytes)

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

2156775 Ontario Inc., a Canadian Corporation	)	
	)	In the Matter of Reg. #: 3624412
vs.	)	
	)	For the Mark: STARZ
GI Group, Inc., a California Corporation	)	
	)	Date Registered: May 19, 2009
	)	

Answer to Petition to Cancel

Now comes GI Group, Inc. A California Corporation with it's principal place of business at 1100 N. Magnolia Ave. #B, El Cajon, CA 92020 by and through it's attorneys to answer and object to the PETITION TO CANCEL by Petitioner 2156775 Ontario, Inc., a Canadian Corporation filed on October 18, 2013.

The Respondent sets forth the following grounds for standing and affirmative defenses:

1) Respondent has no knowledge of Petitioner, their proposed products, their alleged "Petitioner's Investigation", or any other facts regarding Petitioner's allegations of filing of application(s) and/or appeals, and makes no representations as to the adequacy or timing of any act by the Petitioner whatsoever.

2) Respondent is the owner of registration # 3624412 for the mark: STARZ for class # 032.

3) Respondent reported first use in commerce of their mark on 03/02/2009 the day the consumer ready product was received from the common carrier after shipment from New York and was placed on multiple retailers shelves at multiple small businesses in California. Such placement had been prearranged with the respective retailers. This was due to an abundance of

caution as the entrance into commerce which is 'controllable by the US Congress' actually commenced some months earlier when the mark was/had: a) packaging materials (labels, six-pack carriers, and cases), indicating the mark, produced on September 23, 2008 (in New York), b) art work and label approval through the Bureau of Alcohol, Tobacco, and Firearms (ATF) proceeded all commissioning and approval of labeling and packaging. c) Respondent had the production of the product produced under contract by High Falls Brewing Co., LLC, of Rochester, NY on June 9, 2008, c) the finished consumer goods (consisting of some 42,999 pounds of product, a commercially significant amount and not a token) was shipped by common carrier between the dates of Feb. 18, 2009 and received on March 2, 2009 from the bottler in NY to this Respondent wholesaler in CA. Placement of product on multiple retail shelves commenced immediately upon receipt of product from supplier. d) Multiple restocking orders have been made to suppliers and a strong and consistent flow of products, using the registered mark, has been shipped to retailers and sold into the retail consumer.

4) Respondent alleges that the use of the mark in commerce has been continuous and expanding from before the first date of use on a retail shelf through today. As of June 26, 2009 the product was enrolled in and shown (as well as being physically available) at the "72nd National Beer Wholesalers Convention & Trade Show" in Las Vegas, NV (thus indicating interstate commerce and sales in addition to the interstate production and shipping). The first international sales were on June 10, 2010 into Mexico.

5) The Respondent continues to expand their sales area and sales efforts into not only interstate sales but also international sales and at all times since the issuance of their registration has continuously used their mark in an expanding wholesale and (through appropriately licensed retailers) retail environments, as well as providing numerous types of advertising support of the

mark in local, national and international advertising.

The Respondent would be materially damaged should their registration be cancelled due to the multiple, continuous, various, expensive and ongoing methods which have been employed with their mark to garner customer attention and sales. Sales successes and product recognition in the marketplace has already occurred since the retail launch in excess of four years ago. Respondent further alleges that should the mark be given to Petitioner that there exists an extremely high likelihood of confusion as to the origination of the goods from Respondent and those of Petitioner in likely violation of the Lanham Act due to the already established recognition of Respondent's mark in commerce today.

Respondent also avers that any investigation, no mater how negligently performed, could not have failed to disclose enough of the above facts to disprove the instant allegation of fraud. Upon information and belief, Respondent avers that Petitioner never had any good faith basis nor any evidence of fraud by Respondent or any of it's officers or agents and that this instant Petition is made in bad faith and not supported by any evidence whatsoever.

IN CONCLUSION, Respondent yet again verifies that the mark was in fact in commerce on and even before the first use date reported to the USPTO. Numerous third party verifiable sources have been cited and documentary evidence is available for review at the appropriate juncture. Respondent's initial use was significant and subsequently ongoing & expanding and was not just a 'token' use to obtain/maintain the mark. (Admittedly the 3/2/2008 allegation was based on the first day's sales, however, such sales have been followed up with a significant marketing effort and significant additional sales and greater market penetration through today.) Absolute verifiable truth is a complete defense to the Petitioner's allegation of Fraud. It is a truth, verifiable through multiple third party sources, that the mark was in fact in use on the date

so reported and has been in continuous use in the market ever since the date first reported.

WHEREFORE, Respondent prays that their mark be confirmed and that Petitioner be sanctioned for their baseless claims. Respondent further moves for costs of this suit and any further relief the court deems just and necessary.

Respectfully submitted,

Dated: November 26, 2013

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

2156775 ONTARIO INC. a Canadian Corporation Petitioner, vs. GI GROUP, INC., a California Corporation Respondent.	Registration No.: 3624412 Mark: STARZ Date Registered: May 19, 2009 PROOF OF SERVICE BY E-MAIL AND US MAIL

I, the undersigned, certify and declare that I am a citizen of the United States, over the age of 18 years, practicing as a licensed attorney in the State of California, admitted to practice in the United States District Court for the Southern District of California. I am not a party to the above entitled cause. I am readily familiar with the practice of processing and collection of mail in our office. Under that practice, mail would be deposited with the U.S. Postal Service on the same day with postage fully prepaid. I am aware that on motion of the party served, service is presumed invalid if the postal cancellation date of postage meter dates is more than one day after the date of deposit for mailing stated in this declaration. I served via U.S. Mail Service originals or copies of the following document(s): ANSWER TO PETITION TO CANCEL to the following address:

Ronald E. Shapiro
Shapiro and Silverstein PLLC
11350 Random Hills Road, Suite 740
Fairfax, VA 22030

I also served a copy to Petitioner's Attorneys, Ronald E. Shapiro (at rshapiro@sasiplaw.com), with the Respondent's Answer to petitioner's Petition for Cancellation by e-mail (by mutual agreement) on November 26, 2013.

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct.

DATED: November 26, 2013

John A. James, Esq.