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Filing date: **12/13/2013**

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

|                        |  |
|------------------------|--|
| Proceeding             | 92058144   |
| Party                  | Defendant<br>Skimpy Cocktails LLC dba Skimpy Mixers  |
| Correspondence Address | SKIMPY COCKTAILS LLC<br>1000 E BELT LINE, #230<br>CARROLLTON, TX 75006-6201<br>UNITED STATES<br>Megan@skimpymixers.com |
| Submission             | Answer   |
| Filer's Name           | David W. Carstens  |
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| Signature              | /David W. Carstens/  |
| Date                   | 12/13/2013   |
| Attachments            | ASKIM.0703-Answer.pdf(1679249 bytes )  |



knowledge sufficient to form a belief as to the truth of the remaining allegations, and therefore, denies same.

2. With respect to paragraph 2 of the Petition to Cancel, Registrant denies allegations that the listed registrations are incontestable and constitute conclusive evidence of validity, registrations, ownership or exclusive rights to the marks and registrations. Registrant denies all other allegations therein.

3. With respect to paragraph 3 of the Petition to Cancel, Registrant denies any of the registrations noted in or attached to the Petition are valid and subsisting. Registrant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations, and therefore, denies same.

4. With respect to paragraph 4 of the Petition to Cancel, Registrant denies the allegation of Petitioner's use or its predecessors-in-interest or their licensees' use of one or more of the SICLE Family of Marks as stated. Registrant is without information or knowledge sufficient to form a belief as to the truth of the remaining allegations, and therefore, denies same.

5. With respect to paragraph 5 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations and therefore denies the allegations therein.

6. With respect to paragraph 6 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations and therefore denies the allegations of paragraph 6.

7. With respect to paragraph 7 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations and therefore denies the allegations of paragraph 7.

8. With respect to paragraph 8 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations and therefore denies the allegations of paragraph 8.

9. With respect to paragraph 9 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations and therefore denies the allegations of paragraph 9.

10. With respect to paragraph 10 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations and therefore denies the allegations of paragraph 10.

11. With respect to paragraph 11 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

12. With respect to paragraph 12 of the Petition to Cancel, Registrant denies the allegations therein.

13. With respect to paragraph 13 of the Petition to Cancel, Registrant denies the allegations therein.

14. With respect to paragraph 14 of the Petition to Cancel, Registrant admits the allegations therein.

15. With respect to paragraph 15 of the Petition to Cancel, Registrant denies the allegations therein.

16. With respect to paragraph 16 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

17. With respect to paragraph 17 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore, denies same.

18. With respect to paragraph 18 of the Petition to Cancel, Registrant specifically denies that Petitioner has acquired exclusive rights in the subject mark or alleged family of marks. Registrant is without information or knowledge sufficient to form a belief as to the truth of the further allegations, and therefore, denies same.

19. With respect to paragraph 19 of the Petition to Cancel, Registrant denies the allegations therein and further avers that Petitioner's rights to the mark SICLE or alleged family of marks are not superior to those of Registrant.

20. With respect to paragraph 20 of the Petition to Cancel, Registrant denies the allegations therein.

21. With respect to paragraph 21 of the Petition to Cancel, Registrant admits that both marks use the letters SICLE. Otherwise, Registrant denies the allegation.

22. With respect to paragraph 22 of the Petition to Cancel, Registrant denies the allegations therein.

23. With respect to paragraph 23 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore denies those allegations.

24. With respect to paragraph 24 of the Petition to Cancel, Registrant is without information or knowledge sufficient to form a belief as to the truth of the allegations, and therefore denies those allegations.

25. Any allegations within the Petition to Cancel not already specifically admitted or denied herein, are hereby denied.

### **AFFIRMATIVE DEFENSES**

Pursuant to 37 C.F.R. § 2.106(b)(1) and Federal Rule of Civil Procedure 8(c), and without conceding that Registrant must necessarily plead any of the following as an affirmative defense or that Registrant necessarily bears the burden of persuasion for any of the following, Registrant asserts the following affirmative defenses to the claims set forth in the Petition to Cancel. For clarity, Registrant fully denies Petitioner's assertions that Petitioner's "mark" is famous, that a likelihood of confusion exists as between its "mark" and Registrant's mark, and that Registrant's mark will dilute Petitioner's "mark" by either blurring, tarnishment, or otherwise. Registrant further denies that Petitioner's SICLE Family of Marks are famous, distinctive, or that exclusive rights exist in such Family of Marks. Registrant reserves the right to amend its Answer further to plead additional affirmative defenses, consistent with the facts discovered in this case.

### **FIRST AFFIRMATIVE DEFENSE**

26. Petitioner does not have the exclusive right to use the term "sicle" because the term was descriptive at the time of Petitioner's adoption of the "mark" and remains descriptive, namely because it was and is understood by the relevant primary public to describe the genus of goods or food items placed on a stick where "sicle" refers to the stick and/or implies the item is frozen on a stick.

### **SECOND AFFIRMATIVE DEFENSE**

27. The Petition to Cancel should be denied because the mark is weak. A number of unrelated companies use the phrase "sicle" in their trademarks. This list of unrelated companies

includes a maker of Christmas tree ornaments (scentsicles, scented ornaments), a sports drink (sportsicle), a liquid container (beersicle, sodasicle) and a maker of hats, scarves and carrying bags (whim sicle).

### **THIRD AFFIRMATIVE DEFENSE**

28. Petitioner does not have the exclusive right to use the term “sicle” due to the affirmative defense of laches because Petitioner’s delay in bringing this action was unreasonable and Petitioner has been prejudiced by the delay. Moreover, Petitioner has failed to assert cancellation claims against numerous other trademark registrations including scentsicle, sportsicle, beersicle, sodasicle, whim sicle, vitaminsicle, coolsicle, and pigcicle gourmet sauce.

### **FOURTH AFFIRMATIVE DEFENSE**

29. There is no danger of Petitioner’s and Registrant’s marks being confusingly similar because of the following factors:

(a) The commercial connotation of the products are different since the target demographic for sales of Registrant’s frozen non-alcoholic cocktail mixers is those persons aged 21 years or older, whereas Petitioner’s target demographic is children aged 12 years and younger.

(b) The dissimilar nature of the goods and actual sales are different. Registrant’s frozen, non-alcoholic cocktail mixers are typically purchased through a careful, sophisticated buying decision by persons following directions for preparing alcoholic cocktail beverages. Petitioner’s frozen confection products are typically impulse purchases. Further these products are sold in different parts of a store. Petitioner’s frozen confections are sold alongside ice cream and frozen novelties whereas Registrant’s products are sold alongside alcoholic beverages. The dissimilar nature of the goods is

further demonstrated by the cost differential between a frozen non-alcoholic cocktail mixer for adults and a frozen confection intended for children.

(c) Registrant's products are not sold out of mobile ice cream trucks or carts that regularly visit residential neighborhoods, whereas Petitioner's products can probably be found in certain ice cream trucks or carts regularly visiting residential neighborhoods.

(d) There is no concurrent use of products. Petitioner's products are consumed by children and Registrant's products are consumed by adults.

(e) The number and nature of similar marks makes confusion unlikely. There are at least nine live trademarks using "SICLE" as part of their mark. These include scentsicle, sportscicle, beersicle, sodasicle, whim sicle, vitaminsicle, coolsicle, and pigcicle gourmet sauce.

When considered as a whole these factors suggest any actual confusion will likely be de minimus, minor or unimportant, thus no harm to the consumer and no loss of goodwill for the Petitioner.

### **HISTORY OF TERM "POPSICLE"**

30. The term Popsicle® as a name resulted from the accidental invention in 1905 of a frozen liquid with a stick in it by 11-year-old Frank Epperson. Epperson left a mixture of powdered soda and water and a stirring stick in a cup on his porch. That night San Francisco experienced record low temperatures, and Epperson awoke the next morning to find a frozen pop. Epperson originally named his creation the "Epsicle." It wasn't until 1923, that Epperson changed the name to "Popsicle" while running a lemonade stand at an amusement park in Oakland, California. The patent for frozen ice on a stick was issued August 19, 1924. Since that time the term "sicle" has come to be used to describe numerous food, drink, confection, edible and non-

edible items, frozen and un-frozen, situated on a stick. This widespread use of “sicle” as a descriptive term is evidenced by the wide variety of products and industries mentioned in the Second Affirmative Defense, above.

31. WHEREFORE, Registrant denies that Petitioner is entitled to the relief it seeks and Registrant asserts it is entitled to retain its registration for the PINEAPPLESICLE mark in the Principal Register of the United States Patent and Trademark Office. Therefore, Registrant requests: (1) dismissal of Petitioner’s Petition for Cancellation No. 92058144, and (2) that Registrant be awarded such other and further relief as the Trademark Trial and Appeal Board deems to be proper and just.

Date: December 13, 2013

Respectfully submitted,

By:



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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing document has been served on the following individuals via facsimile on this the 13th day of December, 2013:

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