

ESTTA Tracking number: **ESTTA600105**

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

Proceeding	92058861
Party	Defendant GlucksteinHome Inc.
Correspondence Address	GLUCKSTEINHOME INC 234 DAVENPORT ROAD TORONTO, ONTARIOM5 CANADA
Submission	Answer
Filer's Name	Susan B. Flohr
Filer's e-mail	trademarks@blankrome.com
Signature	/sbf/
Date	04/23/2014
Attachments	Glucksteinhome.pdf(60561 bytes )



7. Respondent admits that paragraph 4 of the license agreement provides for a term of ten years from April 7, 2000, and that the parties hereto continued to operate as though the license was still in effect, creating at a minimum, an implied license but denies the remaining allegations of paragraph 7, leaving Petitioner to its proofs.

8. Respondent admits the allegations of paragraph 8.

9. Respondent denies the allegations of paragraph 9 and leaves Petitioner to its proofs.

10. Respondent admits the allegations of paragraph 10.

11. Respondent denies the allegations of paragraph 11 and leaves Petitioner to its proofs.

12. Respondent denies the allegations of paragraph 12 and leaves Petitioner to its proofs.

13. Respondent denies the allegations of paragraph 13 and leaves Petitioner to its proofs.

14. Respondent denies that Gluckstein has offered any goods under the Gluckstein Marks or that the goods Gluckstein alleges to offer under the Gluckstein Marks are identical and/or commercially related to the goods covered by Respondent's registration and is without sufficient knowledge to admit or deny the remaining allegations contained in paragraph 14 of the Petition, and thus denies the same, and leaves Petitioner to its proofs.

15. Respondent admits that the Registered Mark GLUCKSTEINHOME is either identical to or nearly identical to one or more of the GLUCKSTEIN Marks as defined by Petitioner, and that consumers are likely to believe that GLUCKSTEINHOME is connected to or otherwise associated with Petitioner, or that Petitioner has, to some degree, sponsored or endorsed Respondent's products, since that is the case, and denies the remaining allegations of paragraph 15 and leaves Petitioner to its proofs.

16. Respondent denies the allegations of paragraph 16 and leaves Petitioner to its proofs.

17. Respondent denies the allegations of paragraph 17 and leaves Petitioner to its proofs.

18. Respondent denies the allegations of paragraph 18 and leaves Petitioner to its proofs.

19. Respondent denies the allegations of paragraph 19 and leaves Petitioner to its proofs.

20. Respondent denies the allegations of paragraph 20 and leaves Petitioner to its proofs.

21. Respondent denies the allegations of paragraph 21 and leaves Petitioner to its proofs.

### AFFIRMATIVE DEFENSES

1. The Petition fails to state a claim upon which relief can be granted.
2. Petitioner's claims are barred by the applicable statute of limitations.
3. Petitioner's claims are barred, in whole or in part, by the doctrine of unclean hands.
4. Petitioner's claims are barred, in whole or in part, by the doctrine of waiver.
5. Petitioner's claims are barred, in whole or in part, by the doctrine of estoppel, laches and acquiescence and Respondent's reliance to its detriment on same.
6. The Petition for Cancellation should be dismissed because the license between the parties was renewed by the course of dealings between the parties.
7. The Petition for Cancellation should be dismissed because an implied license between the parties arose as a result of the course of dealings between the parties, who acted in continuity with the past.
8. The Petition for Cancellation should be dismissed because Petitioner was precluded from terminating the license under the terms of the renewed or implied license except under the conditions set forth in such agreement, none of which were followed by Petitioner.
9. The Petition for Cancellation should be dismissed because Petitioner was precluded from challenging the Respondent's registration under the terms of the renewed or implied license.
10. The Petition for Cancellation should be dismissed because Respondent was and continues to be authorized to secure and maintain registrations in its name for the mark GLUCKSTEINHOME pursuant to the renewed or implied license, and/or by virtue of the fact that Petitioner is a 40% shareholder in Respondent, as well as an officer and director of Respondent.
11. The Petition for Cancellation should be dismissed because Petitioner conducted himself as if the license continued to be in effect for almost three years following the end date of the written license agreement, leading Respondent to rely to its detriment on Petitioner's acquiescence to business as usual, including but not limited to entering into contracts with third parties with the consent of Petitioner

which are predicated on the continuation of the license, as well as Respondent's other acts in continuing to conduct the business of Respondent in reliance on the continuation of the renewed or implied license.

12. The Petition for Cancellation should be dismissed because Respondent is the owner of the mark GLUCKSTEINHOME and the instant registration therefore.

13. The Petition for Cancellation should be dismissed because Respondent's use of the GLUCKSTEINHOME mark will not dilute the value and distinctive quality of Petitioner's marks.

14. The Petition for Cancellation should be dismissed because Respondent's use and registration of the GLUCKSTEINHOME mark will not disparage or falsely suggest a connection with Petitioner thereby causing loss, damage and injury to Petitioner, since Respondent's activities under the GLUCKSTEINHOME mark are authorized by Petitioner under the renewed or implied license for which Petitioner receives value, and by virtue of the fact that the Petitioner is a 40% shareholder, director and officer of Respondent.

15. The Petition for Cancellation should be dismissed because Respondent's use of the GLUCKSTEINHOME mark will not irreparably damage any rights Petitioner may have in the GLUCKSTEIN name or marks, if any.

16. The Petition for Cancellation should be dismissed because Petitioner failed to exercise any of its alleged rights in or to the Gluckstein name and/or marks for three years after the alleged expiration of the Letter Agreement, thus ceding ownership of the name and marks to Respondent.

WHEREFORE, Respondent prays that the instant Petition for Cancellation be dismissed with prejudice.

Respectfully submitted,



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SUSAN B. FLOHR, ESQ.  
Blank Rome LLP  
600 New Hampshire Avenue, NW  
Washington, D.C. 20037  
Tel: (202) 772-5872  
Fax: (202) 572-1403  
Email: [Flohr@BlankRome.com](mailto:Flohr@BlankRome.com)

*Attorneys for Respondent GlucksteinHome Inc.*

April 23, 2014

CERTIFICATE OF SERVICE

I hereby certify that on April 23, 2014 a true and correct copy of the foregoing Answer and Affirmative Defenses To Petition for Cancellation was served on the Petitioner Brian Gluckstein through his counsel of record Susan L. Heller, Candice E. Kim and Greenberg Traurig, LLP, 1840 Century Park East, Suite 1900, Los Angeles, California 90067, by first-class U.S. Mail, postage prepaid.



SUSAN B. FLOHR, ESQ.  
Blank Rome LLP  
600 New Hampshire Avenue, NW  
Washington, D.C. 20037  
Tel: (202) 772-5872  
Fax: (202) 572-1403  
Email: Flohr@BlankRome.com

*Attorneys for Respondent GlucksteinHome Inc.*