

ESTTA Tracking number: **ESTTA614123**

Filing date: **07/07/2014**

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

Proceeding	92059257
Party	Defendant Netmasons Incorporated
Correspondence Address	NETMASONS INCORPORATED 4367 SOUTH 100 WEST ANDERSON, IN 46013-3633 UNITED STATES
Submission	Answer
Filer's Name	Antonio G. Vann
Filer's e-mail	avann@dunlapweaver.com, jim@netmasons.com
Signature	/avann/
Date	07/07/2014
Attachments	BonusBoxAnswer-Final.pdf(268941 bytes)

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

In the Matter of Registration No.:)	
4,083,747 – Registered January 10, 2012)	
Mark: BONUSBOX)	
)	
Bonusbox GmbH)	Opposition No. 92059257
)	
Petitioner,)	
)	
v.)	
)	
Netmasons, Inc.)	
)	
Registrant.)	

REGISTRANT’S ANSWER AND AFFIRMATIVE DEFENSES

Registrant, Netmasons, Inc., by and through counsel, hereby answers Petitioner, Bonusbox GmbH’s May 06, 2014 Petition for Cancellation pleads and avers as follows:

ANSWER

As to the first unnumbered paragraph preceding Paragraph 1 of the Petition For Cancellation, Registrant admits that the mark BONUSBOX is federally registered trademark under Registration No. 4,083,747. Registrant lacks sufficient information to form a belief as to the truth of the alleged damaged Petition will suffer in the first unnumbered paragraph and therefore denies the same.

1. Registrant lacks sufficient information to form a belief as to the truth of the allegations of paragraph 1 of the Petition to Cancel and therefore denies the same.

2. Admitted.

3. Registrant lacks sufficient information to form a belief as to the truth of the allegations of paragraph 3 of the Petition to Cancel and therefore denies the same.

4. Registrant denies the allegations of paragraph 4. In response to the allegations in paragraph 4, to the best of Registrant's knowledge, the U.S. Patent and Trademark Office refused Petitioner's Trademark Application No. 79143344 for "BONUSBOX & design" for several grounds, including, the identification of the goods, the identification of services, and the description of the mark.

5. Admitted.

6. Denied.

7. Denied. (See Attached Exhibit A: An executed customer contract for software offered under the BonusBox trademark dated within the alleged three years of abandonment) (See Attached Exhibit B: Images of a 2012 transaction using the BonusBox portal within the alleged three years of abandonment)

8. Denied. (See Exhibit C: An executed customer contract displaying BonusBox software purchased in April 9, 2009)

9. Denied.

COUNT I – FALSE DECLARATION

10. Registrant realleges and incorporates herein by reference each and every allegation of paragraphs 1 through 10 of the Petition For Cancellation.

11. Admitted.

12. Denied.

13. Denied.

COUNT II – ABANDONMENT

14. Registrant realleges and incorporates herein by reference each and every allegation of paragraphs 1 through 13 of the Petition For Cancellation.

15. Denied

16. Denied.

AFFIRMATIVE DEFENSES

Registrant asserts the following affirmative defenses bar Petitioner's request for relief in its Petition To Cancel.

FIRST AFFIRMATIVE DEFENSE

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

SECOND AFFIRMATIVE DEFENSE

As a result of Registrant's continuous use of the Mark since the time of Registrant's adoption thereof, the Mark has developed significant goodwill among the consuming public and consumer acceptance of the services offered by Registrant in conjunction with the Mark. Such goodwill and widespread usage has caused the Mark to acquire distinctiveness with respect to Registrant, and caused the Mark to become a valuable asset of Registrant.

THIRD AFFIRMATIVE DEFENSE

Registrant has been using the Mark in commerce and developing consumer recognition and goodwill therein since at least July 13, 2010, such use being open,

notorious and known to the general consuming public and such knowledge, in turn, being known to Petitioner.

FOURTH AFFIRMATIVE DEFENSE

Registrant hereby gives notice that it may rely on any other defenses that may become available or appear proper during discovery, and hereby reserves its right to amend this Answer to assert any such defenses.

WHEREFORE, Registrant denies that Petitioner is entitled to the relief prayed for, and prays that the subject cancellation be dismissed and Registrant's mark remain registered.

Respectfully submitted,

By: 

Antonio G. Vann, Esq. (VSB 79765)
DUNLAPWEAVER, PLLC
211 Church Street, SE
Leesburg, VA 20175
Telephone: (703) 777-7319
Attorney for Registrant

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **REGISTRANT'S ANSWER** has been filed electronically through the Electronic System for Trademark Trials and Appeals ("ESTTSA") of the U.S. Patent & Trademark Office, and a true a correct copy has been served upon Petitioners by first class mail to Petitioners' counsel on the 7th day of July 2014 at the following address:

Paul Juettner
GREER, BURNS, & CRAIN, LTD.
300 South Wacker Drive, Ste 2500
Chicago, Illinois 60606
Attorney for Petitioner



Antonio G. Vann
DunlapWeaver, PLLC
211 Church Street, SE
Leesburg, VA 20175
Attorney for Registrant

EXHIBIT A
CONTRACT DATED SEPTEMBER 1, 2011 CLEARLY DISPLAYING THE
PURCHASE OF BONUSBOX SOFTWARE IN RESPONSE TO ALLEGATIONS
OF ABANDONMENT FOR THREE CONSECUTIVE YEARS

BONUS BOX

Engaging Offers that Grow Society

Software and Services Contract

Company Name: SAGEWELL DBA SAGEWELL Primary Contact: MARCO RESENDE
Address: 1927 POWERS FERRY RD Email address: MARCO@SAGEWELL.COM
City: ATLANTA State: GA Contact Phone: 770 850 1440
Zip code: 30339 Website: WWW.SAGEWELL.COM
Customer # _____ (office use) Sales Representative: _____

Bonusbox Standard Solution

- Use of Bonusbox web application to create up to 3 deals / month
- Bonusbox customer portal Interface for customers to accumulate rewards-incentives
- Fixed 15% all inclusive rate structure, includes rewards to customers, credit card fees, use of portal
- Bonusbox Facebook Application ID and Embeddable Website Code
- Access to Bonusbox Merchant Tips, Best Practices, and Marketing Webinars
- Bonusbox for Merchants Mobile Application for fast and easy operation validation

Bonusbox Solution Agreement

No monthly on-going fees, no yearly fees and no initial fees.

Fees / Pricing

No initial or on-going fees.

\$0

Contract Period: Month to Month

No on-going fees for use of services. Any accounts not using services for any 5 consecutive month period will be flagged as inactive.

Customer agrees to terms and conditions of Bonusbox.

[Signature] 09-01-11
Customer Date

Bonusbox Reseller

Date

EXHIBIT B
IMAGES OF A 2012 TRANSACTION USING THE BONUSBOX PORTAL
WITHIN THE ALLEGED THREE YEARS OF ABANDONMENT

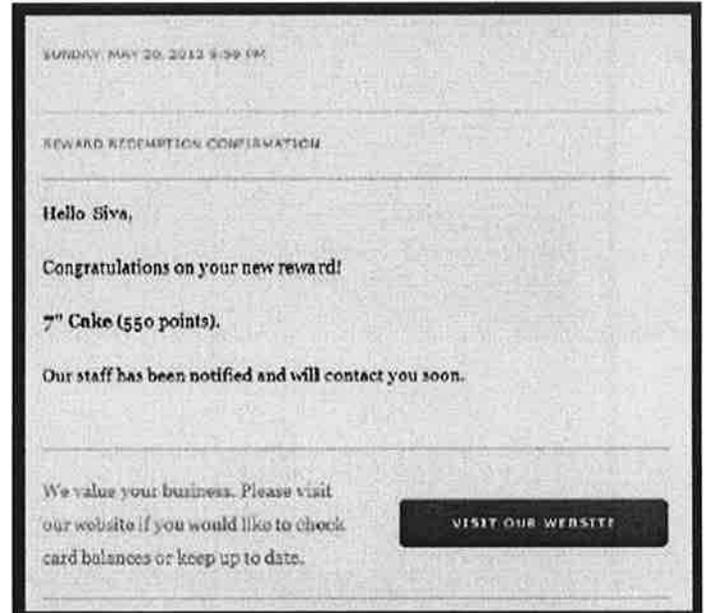
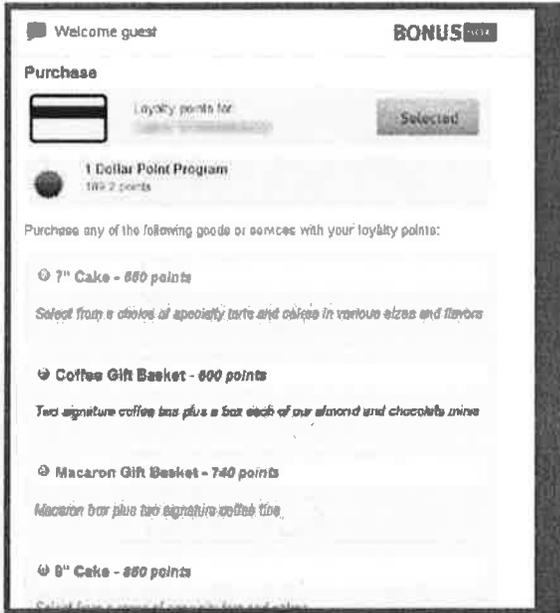


EXHIBIT C
CONTRACT DATED APRIL 9, 2009 CLEARLY DISPLAYING "BONUSBOX"
SOFTWARE OFFERED AND PURCHASED IN RESPONSE TO ALLEGATIONS
OF FRAUD.

NetMasons

Software and Services Contract

Company Name: IFP Sales Rep Code: 14
Customer # 348 (office use)

Event Software Hosting + Loyalty Portal

- Event and tournament software application hosting
- Embedded Bonusbox applet for online point assignment and commerce integration
- All inclusive rate structure
- Embeddable JavaScript IFrame code
- Custom embedding of applet into event software

Netmasons Solution Agreement

No monthly ongoing fees, one-time fee.

Fees / Pricing

Pricing schedule:
<http://www.netmasons.com/srv/bonusbox-pricing.aspx>

Payment: Net Terms

No on-going fees for use of services. 2 year term.

Customer agrees to NetMasons hosting terms and conditions at <http://www.netmasons.com/terms/hosting.aspx>

IFP 4/9/2009
Customer Date


Authorized Signature