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Filing date: **12/03/2014**

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

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| Proceeding | 92060016 |
| Party | Defendant<br>Dealmaker, LLC |
| Correspondence Address | DEALMAKER LLC<br>137 MAIN AVENUE<br>WATERTOWN, NY 13601<br>UNITED STATES<br>mh@hoffmanwarnick.com, mkinnier@hoffmanwarnick.com, ptocommunications@hoffmanwarnick.com |
| Submission | Answer |
| Filer's Name | Michael F. Hoffman |
| Filer's e-mail | ptocommunications@hoffmanwarnick.com, mh@hoffmanwarnick.com, mjkinnier@hoffmanwarnick.com |
| Signature | /Michael F. Hoffman/ |
| Date | 12/03/2014 |
| Attachments | Answer.12.3.14.pdf(66881 bytes ) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| MECUM AUCTION, INC.<br>(a Delaware corporation)<br><br>Petitioner,<br><br>v.<br><br>DEALMAKER, LLC<br>(a New York limited liability company)<br><br>Registrant. | )<br>)<br>)<br>)<br>)<br>)<br>)<br>)<br>)<br>)<br>)<br>) | Cancellation No. 92060016<br><br>Trademark Reg. No. 26000589<br><br>For the mark: DEALMAKER<br><br>Registered on July 30, 2002 |

REGISTRANT'S ANSWER TO PETITION TO CANCEL

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DEALMAKER, LLC ("Registrant"), a domestic Limited Liability Company organized under the laws of the State of New York with a mailing address of 137 Main Avenue, Watertown, New York 13601, believes that it has not abandoned the mark DEALMAKER in interstate commerce and is therefore entitled to maintain its registration in International Classes 35 and 39 for the mark DEALMAKER with Registration No. 2600589.

Further, Petitioner's request amounts to nothing more than an attempt to bury Registrant with legal costs to deflect the clear infringement of Registrant's registered and incontestable rights in the mark DEALMAKER with Registration No. 2600589. Registrant therefore reserves

all rights to pursue legal action against Petitioner in other proceedings before the Trademark Trial and Appeal Board or before judicial and administrative authorities of competent jurisdiction.

In response to the Petition to Cancel dated September 23, 2014, Registrant answers the Petition to Cancel filed by Mecum Auction, Inc. ("Petitioner") as follows:

1. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1 of the Petition to Cancel, and therefore, on that basis denies each and every allegation made therein.

2. Registrant denies the allegation in paragraph 2 that Registrant is a "New York Corporation" on grounds that Registrant is in fact a limited liability company duly organized and existing under the law of the State of New York, with its principal place of business at: 137 Main Avenue, Watertown, New York 13601.

3. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 3 of the Petition to Cancel, and therefore, on that basis denies each and every allegation made therein.

4. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 4 of the Petition to Cancel, and therefore, on that basis denies each and every allegation made therein.

5. Based on records in the United States Patent and Trademark Office, Registrant admits that Petitioner has filed U.S. Trademark Application Serial Numbers 86338580 for "DEALMAKER," 86338593 for "THE DEALMAKERS," and 86338560 for "MECUM

DEALMAKERS." Except as expressly admitted herein, Registrant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 5 of the Petition to Cancel, and therefore, on that basis denies each and every allegation made therein.

6. Registrant admits the allegations contained in paragraph 6 of the Petition to Cancel. Furthermore, Registrant notes that on September 26, 2007, the U.S. Patent and Trademark Office accepted and acknowledged a Combined Declaration of Use and Incontestability under Sections 8 & 15. The Office also accepted a renewal of Registrant's mark on July 24, 2012.

7. Registrant denies each and every allegation contained in paragraphs 7, 8, and 9 of the Petition to Cancel.

If any allegations should remain unanswered, Registrant denies each and every unanswered allegation contained in the Petition to Cancel.

## AFFIRMATIVE DEFENSES

In addition to the foregoing, and as separate and distinct affirmative defenses to the allegations set forth in the Petition to Cancel, Registrant asserts the following:

### FIRST AFFIRMATIVE DEFENSE

8. Petitioner's claims fail to state a claim upon which relief can be granted. More specifically, Petitioner does not allege nonuse of Registrant's mark for three consecutive years and therefore is not entitled to a presumption under 15 U.S.C. § 1127 of abandonment by

Registrant. Furthermore, Petitioner's allegations generally fail to allege facts supporting a claim that Registrants have discontinued use of its mark with intent not to resume such use.

SECOND AFFIRMATIVE DEFENSE

9. Petitioner's claims are barred by the doctrine of laches, estoppel, acquiescence, unclean hands, and/or waiver in relation to Registrant's ongoing use of the mark DEALMAKER since at least March 13, 2000 and Registrant's continued, timely renewal of U.S. Trademark Registration No. 2600589, most recently on July 24, 2012.

THIRD AFFIRMATIVE DEFENSE

10. Petitioner's claims are additionally or alternatively barred by the doctrine of laches, estoppel, acquiescence and/or waiver in relation to numerous third party uses on or in connection with a wide variety of goods and services.

FOURTH AFFIRMATIVE DEFENSE

11. Petitioner is not likely to be damaged by Registrant's mark, and therefore, Petitioner lacks standing to cancel registration of the same.

FIFTH AFFIRMATIVE DEFENSE

12. Petitioner additionally or alternatively lacks standing to cancel Registrant's mark because Petitioner's allegation that its owner and founder is personally referred to as "THE DEALMAKER" is not a use of the term as a trademark and is therefore ineligible for protection under common law and/or 15 U.S.C. § 1051 et seq. ("Lanham Act").

## SIXTH AFFIRMATIVE DEFENSE

13. Petitioner additionally or alternatively lacks standing to cancel Registrant's mark because Petitioner's alleged use of the term "THE DEALMAKERS" in connection with automobile auctions or television programming featuring automobiles and automobile auctions is a descriptive or generic use and therefore ineligible for protection under common law and/or the Lanham Act.

## RELIEF REQUESTED

In view of the foregoing:

Registrant respectfully requests that the relief requested by Petitioner in the Petition to Cancel dated September 23, 2014 be denied, that the Petition to Cancel be dismissed with prejudice, and that registration of Registrant's mark, DEALMAKER in U.S. Trademark Registration No. 2600589 be maintained as valid.

Registrant respectfully requests any and all additional relief that this Board deems appropriate.

Respectfully submitted,
Hoffman Warnick LLC

Dated: December 3, 2014

By: _____
Michael F. Hoffman

Attorneys for Registrant
DEALMAKER, LLC

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S ANSWER TO PETITION TO CANCEL has been served on Petitioner by mailing said copy on December 3, 2014, via First Class Mail, postage prepaid to:

Daniel E. Kattman
Reinhart Boerner Van Deuren, s.c.
1000 North Water Street, Suite 1900
Milwaukee, WI 53202-3186
414-298-1000

By: _____
Michael F. Hoffman

Date: December 3, 2014