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

Proceeding	92060426
Party	Defendant Unitabac, LLC
Correspondence Address	UNITABAC LLC 114 RICHARDS AVENUE DOVER, NJ 07801 UNITED STATES
Submission	Answer
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Signature	/Ryan S. Osterweil/
Date	12/30/2014
Attachments	Answer to Petition to Cancel.PDF(42900 bytes)

4. Registrant admits that it is a company organized and existing under the laws of the State of New Jersey.

5. Registrant denies the allegations in Paragraph 5 of the Petition for Cancellation.

6. Registrant admits that it was awarded U.S. Trademark Registration No. 4,068,062 for the mark CLOUD9 (“Registrant’s Mark”) for the goods “Cigarillos; Cigars” in International Class 34 (“Registrant’s Goods”). Registrant admits that Registrant’s Mark was applied for based on an intent to use the mark in commerce.

7. Registrant admits that it declared during prosecution that Registrant’s Mark was first used by Registrant on July 28, 2010, and that Registrant’s Mark was subsequently registered.

8. Registrant denies the allegations in Paragraph 8 of the Petition for Cancellation.

9. Registrant lacks knowledge or information sufficient to form a belief regarding the allegations in Paragraph 9 of the Petition for Cancellation.

10. Registrant lacks knowledge or information sufficient to form a belief regarding the allegations in Paragraph 10 of the Petition for Cancellation, except that it admits that the CLOUD9 mark is an arbitrary or fanciful term for Registrant’s Goods.

11. Registrant denies the allegations in Paragraph 11, except that it admits that the mark CLOUD9, when used by Petitioner in conjunction with Petitioner’s Goods, so resembles Registrant’s Mark as to be likely to cause confusion, to cause mistake, and to deceive with respect to Registrant’s use of CLOUD9 with Registrant’s Goods, within the meaning of 15 U.S.C. §1052(d).

12. Registrant admits that the type of goods offered in conjunction with Petitioner’s Mark are similar or related to the type of goods offered under the Registrant’s Mark.

13. Registrant lacks knowledge or information sufficient to form a belief regarding the allegations in Paragraph 13 of the Petition for Cancellation, except that it admits that Petitioner's Goods have been and continue to be marketed to identical or similar groups of consumers as Registrant's Goods.

14. Registrant lacks knowledge or information sufficient to form a belief regarding the allegations in Paragraph 14 of the Petition for Cancellation, except that it admits that Petitioner's Goods have been and continue to be advertised, promoted, and/or sold through the same or similar channels of trade as Registrant's Goods.

15. Registrant lacks knowledge or information sufficient to form a belief regarding the allegations in Paragraph 15 of the Petition for Cancellation, except that it admits that Petitioner's Goods have been and continue to be targeted to the same general class of purchasers as Registrant's Goods.

16. Registrant denies the allegations in Paragraph 16 of the Petition for Cancellation, except that it admits that Petitioner has no control over the nature and quality of Registrant's Goods sold under Registrant's Mark.

17. Registrant denies the allegations in Paragraph 17 of the Petition for Cancellation, except that it admits that the mark CLOUD9, when used by Petitioner in conjunction with Petitioner's Goods, so resembles Registrant's Mark as to be likely to cause confusion, cause mistake, and deceive purchasers into the erroneous belief that Petitioner's Goods originate from the same source as, or are authorized or sponsored by, Registrant's use of CLOUD9 with Registrant's Goods.

18. Registrant denies the allegations in Paragraph 18 of the Petition for Cancellation, except that it admits that the mark CLOUD9, when used by Petitioner in conjunction with

Petitioner's Goods, so resembles Registrant's Mark as to be likely to cause confusion, cause mistake, and deceive Registrant's purchasers, as well as the general public, into the erroneous belief that Petitioner's Goods originate from the same source as, or are authorized or sponsored by, Registrant's use of CLOUD9 with Registrant's Goods.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

19. The Petition for Cancellation fails to state a claim upon which relief may be granted and on which the Petition for Cancellation may be sustained in whole or in part by the Board.

SECOND AFFIRMATIVE DEFENSE

20. Registrant's first use of its Mark precedes Petitioner's date of first use of the Mark in connection with Petitioner's Goods sold, and because there is a likelihood of confusion between Petitioner's Mark and Registrant's Mark, Registrant has priority and superior rights in use of the Mark with respect to such goods.

THIRD AFFIRMATIVE DEFENSE

21. On information and belief, to the extent that Petitioner has used Petitioner's Mark prior to the filing date or date of first use of Registrant's Mark, Petitioner's non-use of the Mark is such that it has abandoned its rights in the Mark.

FOURTH AFFIRMATIVE DEFENSE

22. Petitioner's claims are barred by the doctrines of fraud and unclean hands. On information and belief, Petitioner Cloud 9 Distributors, LLC was not in existence until August 29, 2012, when it was registered with the State of California Secretary of State, and thus

Petitioner falsely or, at a minimum, negligently, represented that it used CLOUD9 in commerce “at least as early as November 2003.”

Further, on or about June 18, 2003, Mike Nouredine, an individual believed to be affiliated with Petitioner, filed a trademark application for CLOUD 9 CHARCOAL (Serial No. 85/963,252) alleging a date of first use of that mark of December 1, 2012. That application, which identifies the same address for applicant Mike Nouredine as alleged for Petitioner in Petitioner’s Mark, was rejected based on a likelihood of confusion with Registrant’s Mark, as well as issues with the drawing and specimen as filed. No response was filed to that Office Action, and subsequently, Petitioner filed the application for Petitioner’s Mark, now claiming a first use date of “at least as early as November 2003.”

FIFTH AFFIRMATIVE DEFENSE

23. Petitioner’s claims are barred by doctrine of unclean hands. On information and belief, Petitioner has not provided a genuine specimen for Petitioner’s Mark showing evidence of use of Petitioner’s Mark as of the filing date of the Application for Petitioner’s Mark. On further information and belief, Petitioner has provided a specimen for Petitioner’s Mark which consists of a computer-generated mockup that does not evidence actual use of Petitioner’s Goods in commerce as sold under Petitioner’s Mark. On further information and belief, Petitioner has provided a specimen for Petitioner’s Mark which constitutes advertising and promotional material and is thus not acceptable to support a claim of actual use of Petitioner’s Mark in commerce.

Registrant hereby gives notice that it intends to rely upon such other and further defenses as may become available through discovery or otherwise and reserves its right to assert and rely upon such further defenses as of right or by appropriate motion.

WHEREFORE, Registrant, Unitabac, LLC requests that this Petition for Cancellation be dismissed.

Respectfully submitted,

/Ryan S. Osterweil/

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Dated: December 30, 2014

Certificate of Service

I hereby certify that on the date set forth below a true and correct copy of the foregoing **Registrant's Answer To Petition for Cancellation** was served upon the attorneys of record for the Petitioner by first-class certified mail, postage prepaid, in an envelope addressed as follows:

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Signature: /Ryan S. Osterweil/

By: Ryan S. Osterweil

Date: December 30, 2014