

ESTTA Tracking number: **ESTTA685555**

Filing date: **07/23/2015**

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

Proceeding	92061499
Party	Defendant Kaveh Harounian
Correspondence Address	KAVEH HAROUNIAN 1500 SOUTH LOS ANGELES STREET , #5 LOS ANGELES, CA 90015 UNITED STATES ssilbert@berliner-ip.com, rberliner@berliner-ip.com, lwerk@berliner-ip.com, armin.azod@usaiplaw.com, william.steffin@usaiplaw.com, jino26@aol.com
Submission	Answer and Counterclaim
Filer's Name	Sarah Silbert
Filer's e-mail	ssilbert@berliner-ip.com, rberliner@berliner-ip.com, lwerk@berliner-ip.com
Signature	/Sarah Silbert/
Date	07/23/2015
Attachments	FINAL VICE ANSWER AND COUNTERCLAIM 7.23.15.pdf(44689 bytes)

Registration Subject to the filing

Registration No	4625064	Registration date	10/21/2014
Registrant	Vice Media Canada Inc. 127 B KING STREET Montreal, Quebec, H3C2P2 CANADA		

Goods/Services Subject to the filing

Class 045. First Use: 1994/01/00 First Use In Commerce: 1994/10/31
All goods and services in the class are requested, namely: Providing information about fashion

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

Vice Media LLC, and
Vice Media Canada Inc.

Plaintiffs,

vs.

Kaveh Harounian,

Defendant.

Cancellation No.: 92/061,499

Registration No.: 3,053,079

By Kaveh Harounian for the mark:
VICE (standard character)

Cancellation Filed: May 1, 2015

**DEFENDANT'S ANSWER AND COUNTERCLAIM TO CANCEL PLAINTIFFS'
REGISTRATION NO. 4,625,064**

Defendant Kaveh Harounian, an individual residing in California (“Registrant” or “Counterclaimant”), by and through his undersigned attorney, hereby answers the Notice of Cancellation of Plaintiffs Vice Media LLC and Vice Media Canada Inc. Registrant denies that his U.S. Trademark Registration No. 3,053,079 has been abandoned or procured by fraud, and requests that the Cancellation proceeding be dismissed with prejudice.

Except as herein explained or admitted, Registrant denies each and every allegation contained in Plaintiff’s Notice. Registrant specially answers as follows:

Plaintiffs’ General Allegations

1. Registrant is without is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 1 of the Petition for Cancellation, and on that basis denies all such allegations.

2. Registrant admits that the marks enumerated in paragraph 2 of the Petition for Cancellation are registered with the United States Patent and Trademark Office. Registrant is

without is without knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations in paragraph 2 of the Petition for Cancellation, and on that basis denies all such allegations.

3. Registrant is without is without knowledge or information sufficient to form a belief as to the truth or falsity of the allegations in paragraph 3 of the Petition for Cancellation, and on that basis denies all such allegations.

4. Registrant admits and alleges that he is an individual and resident of California. Registrant denies that he resides at 1500 South Los Angeles Street, #5, Los Angeles, California, 90015. Registrant's business, Vice Clothing, Inc., owns and operates a retail/wholesale storefront at that address, from which Registrant sells VICE-branded merchandise. Registrant's business has operated at that address, which includes approximately 7,140 square feet of warehouse space, since on or about January 1, 2009.

5. Admit.

6. Admit.

Plaintiffs' First Basis of Cancellation: Abandonment

7. Admit.

8. Denied.

9. Denied.

10. Denied.

Plaintiffs' Second Basis of Cancellation: Fraud

11. Admit.

12. Registrant admits that he swore that he was, as of February 23, 2015, using the Vice trademark "in commerce on or in connection with all goods or services listed in the existing registration for this specific class" Registrant denies the remaining allegations in paragraph 12 of the Petition for Cancellation.

13. Registrant admits that, in support of his February 23, 2015, Combined Declaration of Use and Application for Renewal under Sections 8 and 9, Registrant attached a specimen of use consisting of a photograph of a T-shirt. Registrant denies the remaining allegations in paragraph 13 of the Petition for Cancellation.

14. Denied.

15. Denied.

16. Denied.

17. Denied.

18. Registrant admits that the U.S. Patent and Trademark Office relied on the statements made in connection with his February 23, 2015, Combined Declaration of Use and Application for Renewal under Sections 8 and 9. Registrant denies the remaining allegations in paragraph 18 of the Petition for Cancellation.

AFFIRMATIVE DEFENSES

As and for its affirmative defenses herein, Registrant alleges as follows:

First Affirmative Defense

19. The Petition for Cancellation, and each and every purported claim for relief therein, fails to state claims upon which relief may be granted.

Second Affirmative Defense

20. Plaintiffs come to this Court with unclean hands, and are precluded at law and in equity from asserting any of the claims purported to be set forth in the Petition for Cancellation.

COUNTERCLAIMS

For its Counterclaim in this action against Plaintiffs and Counterclaim-Defendants, Vice Media LLC and Vice Media Canada Inc., Registrant and Counterclaimant Kaveh Harounian alleges as follows:

COUNTERCLAIM TO CANCEL PLAINTIFF’S REGISTRATION NO. 4,625,064

1. By and through his undersigned attorney, Registrant and Counterclaimant, an individual with a principal place of business at 1500 South Los Angeles Street, #5, Los Angeles, California, 90015, hereby petitions to cancel Registration No. 4,625,064 (“the ‘064 Registration.”)

2. Registrant is the owner of Registration No. 3,053,079 for the word mark VICE for “[c]lothing for men, women, and children, namely, shirts, T-shirts, sport shirts, polo shirts, sweatshirts, sweaters, jerseys, sport coats, pants, jeans, jogging suits, hats, and caps” (the “VICE Registration”). The VICE Registration is valid and subsisting, in full force and effect, and is conclusive evidence of Registrant’s exclusive right to use the VICE mark for the goods and services referenced therein as well as for related goods and services.

3. Registrant has used the VICE mark continuously in interstate commerce since at least as early as September 1, 1994, and is and has been at all pertinent times the owner of all right, title, and interest in and to the VICE mark for the goods described in the VICE Registration.

4. Registrant is also the owner of the VICE Logo, depicted below:



5. Registrant has adopted and continuously used the VICE Logo since at least as early as September 1, 1994, in connection with clothing for men, women, and children, namely, shirts, T-shirts, sport shirts, polo shirts, sweatshirts, sweaters, jerseys, sport coats, pants, jeans, jogging suits, hats, and caps.

6. As the result of Registrant's use of the VICE Logo, Registrant has established common-law trademark rights for the goods upon which Registrant uses it, and for related goods, and valuable good will, in the mark.

7. Registrant and Counterclaimant believes that he is being damaged by registration of Plaintiffs' and Counterclaim-Defendants' VICE & Design mark, depicted below:



8. Plaintiffs and Counterclaim-Defendants filed an application to register the VICE & Design mark on April 29, 2014. On October 21, 2014, the U.S. Patent and Trademark Office issued the '064 Registration for the VICE & Design mark in International Class 045 for "[p]roviding information about fashion." Plaintiffs and Counterclaim-Defendants claim a date of first use in commerce of October 31, 1994.

First Basis for Cancellation – Ownership of Prior Registration

9. Registrant filed the application to register the VICE Mark on October 23, 2003, prior to the April 29, 2014, date of filing of Plaintiffs' and Counterclaim Defendants' '064 Registration.

10. Registrant's claimed date of first use in commerce of September 1, 1994, predates Plaintiffs' and Counterclaim-Defendants' claimed first use date of October 31, 1994.

11. Accordingly, Plaintiffs and Counterclaim-Defendants are unable to establish priority of use of the VICE mark.

CERTIFICATE OF SERVICE

I hereby certify that, on July 23, 2015, I have served the foregoing **ANSWER AND COUNTERCLAIM TO CANCEL PLAINTIFFS' REGISTRATION NO. 4,625,064** on Plaintiff in this matter by mailing a true and correct copy thereof by first class mail, postage prepaid, to the following attorney of record for Plaintiffs:

Kimberly Herman
Sullivan & Worcester LLP,
One Post Office Square,
Boston, MA 02109

July 23, 2015

/Sarah Silbert/
Robert Berliner
Sarah Silbert
Berliner & Associates
555 West Fifth Street, 31st Floor
Los Angeles, CA 90013
tel: 213-533-4171
fax: 213-533-4174
ssilbert@berliner-ip.com

Counsel for Registrant
KAVEH HAROUNIAN