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

Proceeding	92063134
Party	Defendant IP Services International Inc.
Correspondence Address	IP SERVICES INTERNATIONAL INC C/O DOUGLAS A FRYMER IRWINDALE, CA 91706 UNITED STATES
Submission	Answer
Filer's Name	Marc E. Hankin
Filer's e-mail	marc@hankinpatentlaw.com, kevin@hankinpatentlaw.com, anooj@hankinpatentlaw.com, courtfiling@hankinpatentlaw.com
Signature	/Marc E. Hankin/
Date	03/22/2016
Attachments	Answer to Petition for Cancellation - IP Services International Inc v Philip Morris USA.pdf(26928 bytes )

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

PHILIP MORRIS USA INC.,  
Petitioner,  
v.  
IP SERVICES INTERNATIONAL, INC.  
Registrant.

Cancellation No. 92063134

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**REGISTRANT’S ANSWER TO PETITIONER’S PETITION FOR  
CANCELLATION OF REGISTRATION NOS. 3,172,861, 3,140,971, 4,218,677,  
AND 4,261,884**

Registrant IP Services International, Inc. hereby responds to the grounds for Cancellation set forth in the Petition for Cancellation filed by Petitioner, Philip Morris USA Inc. for U.S. Trademark Registration Nos. 3,172,861, 3,140,971, 4,218,677, and 4,261,884 (collectively referred to hereinafter as the “Registrations”) as follows:

Answering the allegations in the unnumbered paragraph of pages 1-3 of the Petition for Cancellation, Registrant admits that Registrant owns the Registrations. Regarding Petitioner’s allegation that Petitioner “will be damaged by continued presence on the Principal Register” of the Registrations, Registrant denies this allegation.

1. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegation in ¶ 1 and therefore denies the allegation of ¶ 1, page 3, of the Petition for Cancellation.

2. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 2 and therefore denies the allegations of ¶ 2, page 3, of the Petition for Cancellation.

3. Registrant denies that Petitioner’s “Roof Design Trademarks” are famous or distinctive. Registrant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in ¶ 3 and therefore denies the remaining

allegations of ¶ 3, page 4, of the Petition for Cancellation.

4. Registrant is without knowledge or information sufficient to form a belief as to the truth of the allegations in ¶ 4 and therefore denies the allegations of ¶ 4, page 4, of the Petition for Cancellation.

5. Registrant denies that Petitioner's "future applications it will file for the Roof Design Trademarks may be subject to refusal" based on the Registrations. Registrant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in ¶ 5 and therefore denies the remaining allegations of ¶ 5, page 4, of the Petition for Cancellation.

6. Registrant admits the allegations of ¶ 6, page 5, of the Petition for Cancellation.

7. Registrant admits the allegations of ¶ 7, page 5, of the Petition for Cancellation.

8. Registrant admits the allegations of ¶ 8, page 5, of the Petition for Cancellation.

9. Registrant admits the allegations of ¶ 9, page 5, of the Petition for Cancellation.

10. The allegations of ¶ 10 contain legal conclusions to which a responsive pleading is not required. To the extent a response is required, Registrant denies all of the remaining allegations of ¶ 10, pages

11. Registrant admits the allegations of ¶ 11, page 6, of the Petition for Cancellation.

12. Registrant admits the allegation of ¶ 12, page 6, of "on or around August 1, 2012, Registrant filed a Statement of Use and specimen for the Second CARPE DIEM & Design Mark" and that "on August 21, 2012, the Examiner rejected the specimen as 'not acceptable because it consists of advertising material for goods.'" Registrant also admits that "on or around October 17, 2012, Registrant filed a substitute specimen for the Second CARPE DIEM & Design Mark" and admits that this substitute specimen was accepted by the USPTO. Registrant denies the allegations of ¶ 12 that this specimen was "not acceptable." Registrant denies the remaining allegations of ¶ 12.

13. Registrant denies the allegations of ¶ 13, page 7, of the Petition for

Cancellation.

14. Registrant denies the allegation of ¶ 14 that “Petitioner will be damaged by the continued presence of the Registrations”. Registrant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in ¶ 14 and therefore denies the remaining allegations of ¶ 14, page 7, of the Petition for Cancellation.

### **ABANDONMENT**

#### **SECTIONS 14 & 45 OF THE LANHAM ACT, 15 U.S.C. §§ 1064 & 1127**

15. Registrant incorporates each and every response set forth above in paragraphs 1 through 14, inclusive, as though set forth fully herein.

16. Registrant denies the allegations of ¶ 16, pages 7, of the Petition for Cancellation.

17. Registrant denies the allegations of ¶ 17, pages 7, of the Petition for Cancellation.

18. Registrant denies the allegations of ¶ 18, pages 7, of the Petition for Cancellation.

19. Paragraph 19 of the Petition for Cancellation fails to set forth any factual allegations and instead, states law and inappropriately asserts what “may be inferred from circumstances”, whatever that means. Accordingly, no responsive pleading is required to ¶ 19, page 8, of the Petition for Cancellation. To the extent that a response is required, Applicant denies the allegations of ¶ 19, page 8, of the Petition for Cancellation.

20. Paragraph 20 of the Petition for Cancellation fails to set forth any factual allegations and instead, states what Petitioner hopes to be able to prove as a conclusion of law. Accordingly, no responsive pleading is required to ¶ 20, page 8, of the Petition for Cancellation. To the extent that a response is required, Applicant denies the allegations of ¶ 20, page 8, of the Petition for Cancellation.

21. Paragraph 21 of the Petition for Cancellation fails to set forth any factual allegations and instead, states an unproven and erroneous conclusion. The allegations of ¶ 21 contain legal conclusions to which a responsive pleading is not required. Accordingly, no responsive pleading is required to ¶ 21, page 8, of the Petition for Cancellation. To the extent that a response is required, Applicant denies the allegations

of ¶ 21, page 8, of the Petition for Cancellation.

Answering the allegations in the unnumbered paragraph after ¶ 21, page 8 of the Petition for Cancellation, Registrant denies the allegation that the Registrations will damage Petitioner or that the Registrations are “to the detriment and harm of Petitioner.” Registrant denies the remaining allegations in the unnumbered paragraph after ¶ 21.

WHEREFORE, Registrant respectfully requests: (1) dismissal of the Petition for Cancellation with prejudice in its entirety, (2) a finding that U.S. Trademark Registration Nos. 3,172,861, 3,140,971, 4,218,677, and 4,261,884 be maintained, and (3) that the Petition for Cancellation be determined in favor of Registrant.

Applicant appoints Marc E. Hankin, Esq. and Hankin Patent Law, APC, 12400 Wilshire Blvd., Suite 1265, Los Angeles, California 90025, to transact all business on its behalf in connection with this Opposition.

Dated: March 22, 2016

Respectfully submitted,

/Marc E. Hankin/

Marc E. Hankin  
USPTO Reg. No. 38,908  
Hankin Patent Law, APC  
12400 Wilshire Blvd., Suite 1265  
Los Angeles, CA 90049-2435  
Marc@HankinPatentLaw.com  
Office Tel.: (310) 979-3600  
Cell Phone: (310) 892-1613

Attorneys for Registrant

**CERTIFICATE OF SERVICE**

I am employed in the County of Los Angeles, State of California. I am over the age of eighteen years and not a party to the within action; my business address is 12400 Wilshire Blvd., Suite 1265, Los Angeles, CA 90025.

I certify that on March 22, 2016, I caused to be served a copy of the foregoing **REGISTRANT'S ANSWER TO PETITIONER'S PETITION FOR CANCELLATION OF REGISTRATION NOS. 3,172,861, 3,140,971, 4,218,677, AND 4,261,884** on Counsel for PETITIONER by mail and e-mail, addressed as follows:

Ann K. Kord, Esq.  
DLA Piper LLP  
500 8<sup>th</sup> Street, NW  
Washington, DC 20004  
dctrademarks@dlapiper.com

XX (BY MAIL) The envelope was mailed with postage thereon fully prepaid U.S. Mail. I am "readily" familiar with the firm's practice of collection and processing correspondence for mailing. It is deposited with the U.S. Postal Service on that same day in the ordinary course of business.

\_\_\_ (BY PERSONAL SERVICE) I delivered such envelope by hand to the office of the addressee listed above.

XX Via E-Mail to the e-mail address of the addressee listed above.

\_\_\_ Via Facsimile to the fax number of the addressee listed above.

Date: March 22, 2016

/Anooj Patel/

Anooj Patel