



Applicant admits that it has filed an application having the particulars set out in the first unnumbered paragraph in the Notice of Opposition and, without admitting that the Notice of Opposition states any valid basis for opposition, admits that the Notice of Opposition purports to oppose the subject application. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in the second unnumbered paragraph of the Notice of Opposition and therefore denies same.

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 1 of the Notice of Opposition and therefore denies same.

2. Applicant denies the allegations set forth in paragraph 2 of the Notice of Opposition.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 3 of the Notice of Opposition and therefore denies same.

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 4 of the Notice of Opposition and therefore denies same.

5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 5 of the Notice of Opposition and therefore denies same.

6. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 6 of the Notice of Opposition and therefore denies same.

7. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 7 of the Notice of Opposition and therefore denies same.

8. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 8 of the Notice of Opposition and therefore denies same.

9. Applicant admits the allegations set forth in paragraph 9 of the Notice of Opposition.

10. Applicant admits the allegations set forth in paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations set forth in paragraph 11 of the Notice of Opposition.

12. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 12 of the Notice of Opposition and therefore denies same.

13. Applicant denies the allegations set forth in paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations set forth in paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations set forth in paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations set forth in paragraph 16 of the Notice of Opposition.

17. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 17 of the Notice of Opposition and therefore denies same.

18. Applicant denies the allegations set forth in paragraph 18 of the Notice of Opposition.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense**

19. The Notice of Opposition fails to state a claim upon which relief can be granted.

#### **Second Affirmative Defense**

20. The allegations set forth in Opposer's Notice of Opposition are barred by the equitable doctrines of laches, acquiescence and estoppel.

#### **Third Affirmative Defense**

21. There is no likelihood of confusion, mistake or deception between Applicant's mark and Opposer's marks at issue in the Notice of Opposition.

## COUNTERCLAIM PETITION FOR CANCELLATION

### First Counterclaim

1. Applicant/Petitioner Franklin Loufrani (hereinafter "Applicant"), a French citizen residing at 114 Eaton Square, London SW1, United Kingdom believes that he is being damaged by the registrations alleged to be owned by Opposer/Respondent Joe Boxer Company, LLC (hereinafter "Opposer") as pleaded in the Notice of Opposition, namely, Registrations Nos. 2,041,783; 2,028,591; and 2,038,467 as well as other U.S. registrations owned by Opposer for similar marks, namely, Reg. Nos. 2,065,095; 2,666,784; and 2,616,306 and hereby petitions to cancel same.

2. Applicant restates and reaffirms the denials and affirmative averments of paragraphs 1- 21 inclusive of its amended answer and incorporates said paragraphs by reference as if set forth in full.

3. Applicant is the owner of the following U.S. Trademark Applications: SN 75/977,376 for SMILEY & Design in Classes 3, 5, 8, 9, 14, 18, 21, 24, 31, 32, 33, 34, 35, 36, 38 and 39; SN 75/720,333 for OFFICIAL LICENSED MERCHANDISE SMILEY & Design in Classes 20 and 26; SN 75/647,117 for Miscellaneous Design in Classes 14, 18, 21 and 24; SN 75/647,116 for Miscellaneous Design in Classes 14, 18, 21 and 24; SN 75/630,514 for SMILEY BABIES & Design in Classes 16, 25 and 28; SN 75/630,513 for SMILEY FOR KIDS & Design in Classes 16, 25 and 28; SN 75/618,546 for Miscellaneous Design in Class 29; and SN 75/302,439 for SMILEY & Design in Classes 16, 25, 28, 29, 30, 41 and 42. All of these applications are for marks which contain a happy face design.

4. Applicant does not claim exclusive rights to the happy face design *per se* and in fact has agreed to disclaim this design element in its applications when requested.

5. The Opposer has filed several oppositions (including the subject opposition) against Applicant's trademark applications for marks which include a happy face design despite Applicant's disclaimer of exclusive rights to the design. The subject opposition is based on the following registrations owned by Opposer which include a happy face design: Reg. Nos. 2,041,783; 2,028,591; and 2,038,467. In each of these registrations, Opposer is claiming exclusive rights to the happy face design, rights to which Opposer is not entitled. The happy face design *per se*, in the United States is generic, is and has been for many years, widely used by others, is not in and of itself capable of exclusive appropriation and is not capable of trademark protection on its own. Despite this, Opposer has failed to disclaim exclusive rights to this design in all of its registrations.

6. In addition, Opposer also owns the following registrations which issued after the subject notice of opposition was filed and include a happy face design: Reg. Nos. 2,065,095; 2,666,784; and 2,616,306. In each of these registrations, Opposer is claiming exclusive rights to a happy face design, rights to which Opposer is not entitled. The happy face design *per se*, in the United State is generic, is and has been for many years, widely used by others, is not in and of itself capable of exclusive appropriation and is not capable of trademark protection on its own. Despite this, Opposer has failed to disclaim exclusive rights to this design in all of its registrations.

7. Opposer has no basis to oppose Applicant's SMILEY & Design application since Opposer has relied on alleged exclusive rights to the happy face design as the basis for its opposition, rights which Opposer may not claim for the reasons set forth in paragraphs 5 and 6 above. Therefore, U.S. Registration Nos. 2,041,783; 2,028,591; 2,038,467; 2,065,095; 2,666,784; and 2,616,306 should be declared invalid, amended to include disclaimers for the happy face design or cancelled in their entireties.

**Second Counterclaim**

8. Applicant restates and reaffirms paragraph numbers 1- 7 inclusive of its Counterclaims and incorporates said paragraphs by reference as if set forth in full.

9. Upon information and belief, Opposer and/or its predecessor(s)-in-interest filed trademark applications for trademark Registration Nos. 2,041,783 and 2,028,591 on November 17, 1995; Reg. No. 2,038,467 on November 22, 1995; Reg. No. 2,605,095 on June 18, 1998; Reg. No. 2,666,784 on April 15, 1999; and Reg. No. 2,616,306 on December 8, 1999, respectively.

10. Upon information and belief, Opposer and/or its predecessor(s)-in-interest asserted, under oath, in each of its applications for the above referenced registrations that Opposer was entitled to use the mark in commerce and that no other person has the right to use the mark in commerce, either in identical form or in such near resemblance as to be likely when used on or in connection with the goods/services of such other person to cause confusion.

11. Upon information and belief, each of the declarations filed in connection with the applications for Registrations Nos. 2,041,783; 2,028,591; 2,038,467; 2,065,095; 2,666,784; and

2,616,306 contained false, fraudulent and material misrepresentations by Opposer and/or its predecessor(s)-in-interest made with the intent that the United States Patent and Trademark Office would rely on such statements in accepting the applications and granting the subsequent registrations.

12. Upon information and belief, Opposer knew when it signed each of the declarations in its applications that the happy face design was and had been for many years used by others, that the design was not capable of exclusive appropriation in the United States, and that it did not have exclusive rights to the happy face design, since the mark is generic in the United States, but made the representations anyway.

13. Upon information and belief, Opposer's applications matured into Registration Nos. 2,041,783; 2,028,591; 2,038,467; 2,065,095; 2,666,784; and 2,616,306 as a result of the Opposer's false, fraudulent and material misrepresentations made in the declarations of the applications submitted to the United States Patent and Trademark Office.

14. Opposer's trademark Registration Nos. 2,041,783; 2,028,591; 2,038,467; 2,065,095; 2,666,784; and 2,616,306 should each be cancelled in their entireties pursuant to Section 14(3) of the Lanham Act on the ground that the registrations were obtained through Opposer's assertions of fraudulent, false and material misrepresentations.

Enclosed please find a check in the amount of \$2,400 as payment for all fees associated with the counterclaim-petition to cancel. In the event that the fee submitted is not sufficient, please charge any additional fees to the undersigned Attorney's Deposit Account No. 13-4500.

This pleading is filed in triplicate.

WHEREFORE, Applicant respectfully requests that Opposer's Notice of Opposition against SN 75/647,117 be denied and that the registrations of Opposer pleaded herein be cancelled.

Dated: New York, New York  
February 4, 2003

Respectfully submitted,

**MORGAN & FINNEGAN, L.L.P.**

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CERTIFICATE OF SERVICE


The undersigned hereby certifies that a true copy of the attached AMENDED ANSWER TO NOTICE OF OPPOSITION was served by express mail, postage prepaid, upon the attorney of record for the Opposer at the following address:

Andrew R. Tarshis  
Joe Boxer Company, LLC  
General Counsel  
1599 Post Road East  
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Roberta Bren, Esq.  
Oblon, Spivak McClelland  
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Dated: New York, New York  
February 4, 2003

By:

  
Maren Coburn