

ESTTA Tracking number: **ESTTA45675**

Filing date: **09/20/2005**

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

Proceeding	91166203
Party	Defendant Citicorp Citicorp 399 Park Avenue New York, NY 10043
Correspondence Address	Citicorp 2nd floor/Zone 1 425 Park Avenue New York, NY 10043
Submission	Answer
Filer's Name	Stephanie J. Kamerow
Filer's e-mail	skamerow@skadden.com, smarquez@skadden.com
Signature	/Stephanie J. Kamerow/
Date	09/20/2005
Attachments	Driver's Edge Answer.pdf (6 pages)

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

----- x

DRIVE FINANCIAL SERVICES, LP,	:	
	:	
Opposer,	:	Opposition No. 91166203
-against-	:	Serial No. 78/324,239
	:	
CITICORP,	:	
	:	
Applicant.	:	
	:	
-----	x	

ANSWER TO NOTICE OF OPPOSITION

Citigroup Inc., a Delaware corporation with its principal office at 399 Park Avenue, New York, New York, successor by merger to Applicant Citicorp (“Applicant”), by its undersigned counsel, hereby responds to the Notice of Opposition filed by Opposer Drive Financial Services, LP (“Opposer”) concerning Serial Application No. 78/324,239 for the mark “DRIVER’S EDGE” as follows:

1. Applicant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 1 of the Opposition, and therefore denies same.

2. Applicant admits that Opposer owns the trademark registrations identified in paragraph 2 of the Opposition (the “DRIVE Marks”), and refers Opposer to

those registrations for the true and correct information concerning the registration dates and description of services thereof.

3. Applicant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 3 of the Opposition, and therefore denies same.

Applicant further states that it is the owner of the following three registrations which include DRIVER'S EDGE: (i) DRIVER'S EDGE, Reg. No. 1,791,884, Reg. Date 9/7/93; (ii) DRIVER'S EDGE, Reg. No. 2,545,574, Reg. Date 3/12/02; and (iii) CITIBANK DRIVER'S EDGE, Reg. No. 2,216,112, Reg. Date 1/5/99 (collectively, the "DRIVER'S EDGE Marks").

4. Applicant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 4 of the Opposition, and therefore denies same.

5. Applicant denies knowledge or information sufficient to form a belief as to the truth or falsity of the allegations contained in paragraph 5 of the Opposition, and therefore denies same, except that Applicant specifically denies Opposer's allegation that Applicant's registration of the DRIVER'S EDGE mark reflected in Serial No. 78/324,239 will cause any irreparable harm to, or destruction of, any alleged goodwill acquired by Opposer relating to its DRIVE Marks.

6. Applicant admits the allegation contained in paragraph 6 of the Opposition concerning the date of Applicant's filing of its Application for the DRIVER'S

EDGE mark reflected in Serial No. 78/324,239, and the date of publication of such mark in the Official Gazette. Applicant refers to this Application for the true and correct information concerning the Application date and description of services of the DRIVER'S EDGE Mark reflected therein. Applicant denies knowledge or information sufficient to form a belief as to the truth or falsity of the remaining allegations contained in paragraph 6 including specifically, Opposer's alleged first use date of its DRIVE Marks, and therefore denies same.

7. Applicant denies the allegations contained in paragraph 7 of the Opposition. Applicant further states that, as stated in Applicant's response to the allegations contained in paragraph 3 of the Opposition, Applicant is the owner of three DRIVER'S EDGE registrations. Applicant filed the Applications for registration of each such DRIVER'S EDGE mark prior to Opposer's filing of its applications for Opposer's DRIVE Marks. Further, Applicant has been using its DRIVER'S EDGE Marks since no later than October 31, 1992, which is prior to Opposer's filing date, and claimed first use date, for its DRIVE Marks.

8. Applicant denies the allegations contained in paragraph 8 of the Opposition.

9. Applicant denies the allegations contained in paragraph 9 of the Opposition.

10. Applicant states that the allegations contained in the first sentence of paragraph 10 of the Opposition contain conclusions of law as to which no response is

required by Applicant. Applicant denies the allegations contained in the second sentence of paragraph 10 of the Opposition.

AFFIRMATIVE DEFENSES

First Affirmative Defense

The Opposition fails to state a claim upon which relief may be granted.

Second Affirmative Defense

Applicant's mark DRIVER'S EDGE is not confusingly similar to Opposer's DRIVE Marks, and will not result in any likelihood of confusion between each party's respective goods and/or services

Third Affirmative Defense

Opposer's claims are barred in whole or in part because Applicant has prior and superior rights to Opposer based on Applicant's registrations for its DRIVER'S EDGE Marks. Specifically, as noted in Applicant's response to the allegations set forth in paragraph 3 of Opposer's Notice of Opposition, Applicant is the owner of three registrations for DRIVER'S EDGE Marks and each of Applicant's registrations for its DRIVER'S EDGE Marks was filed prior to Opposer's filing of its applications for its DRIVE Marks. Further, Applicant has been using its DRIVER'S EDGE Marks since no later than October 31, 1992, which is prior to Opposer's filing date, and claimed first use date, for its DRIVE Marks.

Accordingly, if Opposer were correct that Applicant's current DRIVER'S EDGE mark, reflected in Serial No. 78/324,239, cannot coexist with Opposer's DRIVE

Marks, the only appropriate remedy would be cancellation of Opposer's registrations for its DRIVE Marks.

Fourth Affirmative Defense

The claims of plaintiff are barred in whole or in part by the doctrine of unclean hands.

Fifth Affirmative Defense

The claims of Opposer are barred in whole or in part by the doctrines of laches, waiver and estoppel.

Sixth Affirmative Defense

The claims of plaintiff are barred in whole or in part by the doctrine of acquiescence.

Seventh Affirmative Defense

Applicant reserves the right to rely on such other and further affirmative defenses as may be supported by facts to be determined through full and complete discovery and to amend its Answer to assert such affirmative defenses.

WHEREFORE, Applicant respectfully requests that this Opposition be dismissed with prejudice, and that Applicant's Application for registration of the DRIVER'S EDGE mark reflected in Serial No. 78/234,239 be granted.

Dated: New York, New York
September 20, 2005

Bruce J. Goldner
Stephanie J. Kamerow
SKADDEN, ARPS, SLATE,
MEAGHER & FLOM LLP
Four Times Square
New York, NY 10036
(212) 735-3000 (telephone)
(212) 735-2000 (facsimile)

Attorneys for Citigroup Inc.,
Successor by Merger to Applicant Citicorp

By: 