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

Proceeding	91166342
Party	Defendant JAX Ltd., Inc.
Correspondence Address	Cynthia A. Moyer, Sarah C.S. McLaren Fredrikson & Byron, P.A. 200 South Sixth Street, Suite 4000 Minneapolis, MN 55402-1425 UNITED STATES cmoyer@fredlaw.com, smclaren@fredlaw.com, kmcwilliams@fredlaw.com
Submission	Answer and Counterclaim
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Signature	/Sarah C.S. McLaren/
Date	12/08/2008
Attachments	91_166_342_Cover Ltr re Jax Amended Answer and Counterclaim.pdf (1 page) (58994 bytes) 91_166_342_Jax Amended Answer and Counterclaim.pdf (6 pages) (89562 bytes)

Registration Subject to the filing

Registration No	2267543	Registration date	08/03/1999
Registrant	Jakks Pacific, Inc. 22619 Pacific Coast Highway Malibu, CA 90265 UNITED STATES		
Grounds for filing	The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 028. First Use: 1997/02/02 First Use In Commerce: 1997/02/02
All goods and services in the class are requested, namely: toys, namely, male action figures, radio controlled vehicles, fashion dolls and mini dolls

December 8, 2008

Fredrikson
& BYRON, P.A.

VIA ESTTA FILING
Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1451
Alexandria, VA 22313-1451

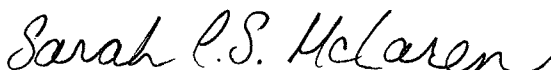
Re: **Jakks Pacific, Inc. v. Jax, Ltd.; TTAB Opposition No. 91,166,342**

Dear Sir or Madam:

I write on behalf of Applicant Jax, Ltd. regarding the above-referenced Opposition. On April 21, 2008, Applicant moved for leave to amend its answer to assert a counterclaim. As part of Applicant's motion papers, Applicant included its proposed amended answer to the notice of opposition and counterclaim. Applicant's motion papers, including the proposed amended answer and counterclaim, were served on Opposer at the same time they were filed with the Board. The Board granted Applicant's motion on October 29, 2008, and permitted Opposer 30 days to file an answer to the counterclaim. In its answer to the counterclaim, Opposer now asserts that Applicant's counterclaim is jurisdictionally defective for failure to pay the filing fee.

While the Board has not ordered Applicant to formally file its counterclaim, Applicant does so at this time in order to pay the filing fee. Accordingly, enclosed please find Applicant's amended answer to notice of opposition and counterclaim. It is identical to the proposed amended answer and counterclaim filed April 21, 2008. By copy of this cover letter, Opposer's attorney is receiving an additional copy of Applicant's amended answer to notice of opposition and counterclaim, with which he was previously served on April 21, 2008.

Very truly yours,



Sarah C.S. McLaren

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Enclosure

cc: Cynthia A. Moyer, Esq. (w/o enc.)
Larry B. Miller (w/ enc.)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JAKKS Pacific, Inc.,)	
)	Opposition No. 91,166,342
)	Serial No. 78/337,577
Opposer,)	Mark: JAX
)	
v.)	
)	
Jax Ltd., Inc.)	For Cancellation:
)	Trademark Registration No. 2,267,543
)	For the Mark: JAKKS PACIFIC
Applicant.)	Date Registered: August 3, 1999

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**AMENDED ANSWER TO NOTICE OF
OPPOSITION AND COUNTERCLAIM**

Applicant, Jax Ltd., Inc. for its Amended Answer to the Notice of Opposition filed by Opposer, JAKKS Pacific, Inc., states and alleges as follows:

1. Applicant admits the allegations contained in Paragraph 1 of the Notice of Opposition.
2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Notice of Opposition and therefore denies same.
3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Notice of Opposition and therefore denies same.
4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Notice of Opposition and therefore denies same.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 5 of the Notice of Opposition and therefore denies same.

6. Applicant denies the allegations contained in Paragraph 6 of the Notice of Opposition.

SEPARATE DEFENSES

7. There is no likelihood of confusion between Opposer's mark and Applicant's mark because they differ in appearance, sound, connotation and communicate a different overall commercial impression.

8. The goods on which Opposer's mark is used are completely different from those goods under Applicant's mark.

9. Opposer's goods and Applicant's goods are not sold in the same channels of trade.

10. Opposer's opposition is barred by Opposer's unclean hands.

COUNTERCLAIM

Petitioner JAX Ltd., Inc. ("Petitioner" or "Jax"), a Minnesota corporation located at 141 Cheshire Lane, Suite 100, Plymouth, Minnesota 55441, believes it is or will be damaged by Registration No. 2,267,543, (the "Registration") and hereby petitions to cancel the Registration on the following grounds:

1. Upon information and belief, the name and current address of Registrant is JAKKS Pacific Inc. ("Registrant" or "JAKKS Pacific"), 22619 Pacific Coast Highway, Malibu, CA 90265.

2. Petitioner has for many years, and at least since 1981, been engaged in the manufacture, distribution, advertising, and sale of games, namely board and card games.

3. Upon information and belief, Petitioner used the JAX trademark in connection with the advertising and sale of board and card games for more than 15 years prior to the first use by JAKKS Pacific.

4. Petitioner has sold many thousands of dollars worth of goods under the JAX trademark, and has spent substantial sums in advertising and promoting the JAX trademark throughout the United States.

5. By virtue of Jax's aforesaid extensive sales and promotion, Jax has built up and owns valuable goodwill which is symbolized by its JAX trademark.

6. The use of the JAKKS PACIFIC trademark by Registrant for "toys, namely, male action figures, radio controlled vehicles, fashion dolls and many dolls" is likely to cause confusion, mistake or deception with Petitioner's JAX trademark and to cause the belief that Registrant's JAKKS PACIFIC goods are goods sponsored or approved by Petitioner.

7. Upon information and belief, neither Registrant nor any predecessor or related company of Registrant has made use of the JAKKS PACIFIC mark prior to February 2, 1997, the date of first use claimed in Registration No. 2,267,543.

8. Use by Registrant of the JAKKS PACIFIC mark is without Petitioner's consent or permission.

9. In approximately August 1995, Jax learned that an individual named Jack Freedman was contemplating forming a corporation to engage in the toy and game business under the name "JAXX." By letter dated August 31, 1995, counsel for Petitioner wrote Jack Freedman, CEO of Jakks Pacific, and informed him that Petitioner "has been in the toy and game business utilizing the JAX corporate name for many years." As such, Jax demanded that Mr.

Freedman “not engage in the sale of toys or games utilizing the JAXX or JAX name.” A copy of the August 31, 1995, letter is attached hereto as Exhibit A.

10. Approximately 14 months later, Jax learned that Mr. Jack Freedman was engaged in the toy and game business under the name “JAKKS TOYS.” By letter dated October 30, 1996, counsel for Petitioner wrote Jack Freedman and informed him that “the use of the name JAKKS by you, on, or in connection with, toys or games, is a violation of our client’s trademark rights. Your intentional use of a similar name appears to be designed to confuse the trade and customers and mislead them as to the source of the products.” As such, Jax demanded that Mr. Freedman “immediately cease and desist from utilizing the ‘JAKKS’ name in the sale of toys or games.” A copy of the October 30, 1996, letter is attached hereto as Exhibit B.

11. Approximately one month after receiving the October 30, 1996 letter, on November 25, 2006, Registrant filed its trademark application for “JAKKS PACIFIC.” As part of that application, Mr. Joel Bennett, the Chief Financial Officer for Registrant signed a Declaration dated November 21, 1996, that “to the best of his knowledge and belief, no other person, firm, corporation, or association has the right to use the above identified trademark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely . . . to cause confusion, or to cause mistake, or to deceive.” A copy of the November 21, 1996, Declaration is attached hereto as Exhibit C.

12. As a result of the foregoing, Registrant was aware of the JAX trademark at the time Registrant applied for the registration of JAKKS PACIFIC and the declaration of Mr. Joel Bennett was false.

13. Registrant fraudulently Registration No. 2,267,543 from the Patent and Trademark office by submitting the false declaration of Mr. Joel Bennett.

13. As a result, Registrant's Registration should be cancelled and the JAX trademark should be registered.

WHEREFORE, Applicant/Petitioner Jax Ltd., Inc. respectfully requests as follows:

1. The Opposer's Opposition be dismissed with prejudice and on the merits; and
2. The registration by Registrant of the aforesaid trademark for the aforesaid goods be cancelled.

Dated: April 21, 2008

/Cynthia A. Moyer/

Cynthia A. Moyer

Grant Fairbairn

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**Attorneys for Applicant/Petitioner
Jax Ltd., Inc.**

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the AMENDED ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM was served by United States mail on the attorney of record for Opposer in this action, Larry Miller, Feder, Kaszovitz, Isaacson, Weber, Skala, Bass & Rhine LLP, by mailing it to his address of record by first-class mail, postage prepaid, this 8th day of December, 2008.

/Sarah C.S. McLaren/
Sarah C.S. McLaren

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