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

Proceeding	91174787
Party	Defendant B.J. Alan Company B.J. Alan Company 555 Martin Luther King, Jr. Blvd. Youngstown, OH 445021102 Waweimer@fireworks.com
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Attachments	2007-03-12 Answer Counterclaims.pdf (9 pages)(131983 bytes)

Registrations Subject to Cancellation

Registration No	2547824	Registration date	03/12/2002
Registrant	NEW LINE PRODUCTIONS, INC. 888 Seventh Street New York, NY 10106 UNITED STATES		
Goods/Services Subject to Cancellation	Class 016. First Use: 1997/05/02 , First Use In Commerce: 1997/05/02 Goods/Services: Printed matter and paper goods-namely, books featuring characters from animated action adventure, comedy and/or drama features, comic books, children's books, magazines featuring characters from animated, action adventure, comedy and/or drama features, coloring books, children's activity books; stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets, chalk and chalkboards; decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper; paper party favors and paper party decorations-namely, paper napkins, paper doilies, paper place mats, crepe paper, paper hats, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliques; printed patterns for costumes, pajamas sweatshirts and t-shirts; paper photo frames		
Registration No	2677644	Registration date	01/21/2003
Registrant	New Line Productions, Inc. 888 Seventh Avenue New York, NY 10106 UNITED STATES		
Goods/Services	Class 025. First Use: 1997/05/02 , First Use In Commerce: 1997/05/02		

Subject to Cancellation	Goods/Services: Clothing for men, women and children - namely, shirts, t-shirts, sweatshirts, jogging suits, trousers, pants, shorts, tank tops, rainwear, cloth bibs, skirts, blouses, dresses, suspenders, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sunvisors, belts, scarves, sleepwear, pajamas, lingerie, underwear, boots, shoes, sneakers, sandals, booties, slipper socks, swimwear and masquerade and Halloween costumes and masks sold in connection therewith
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

NEW LINE PRODUCTIONS, INC.)	
)	Opposition No. 91174787
)	
v.)	
)	
B.J. ALAN COMPANY)	
)	
)	
)	
)	
)	

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIMS

Applicant, B.J. Alan Company ("BJAL"), by its undersigned attorneys, hereby answers the Notice of Opposition (hereinafter "the Notice") as follows:

1. BJAL admits that Opposer is the owner of record of Registration No. 2,547,824 for the mark SHAGADELIC, covering the listed goods. BJAL has insufficient knowledge or information to either deny or admit the remainder of the allegations contained in paragraph 1 of the Notice, and therefore denies the same.

2. BJAL admits that Opposer is the owner of record of Registration No. 2,677,644 for the mark SHAGADELIC, covering the listed goods. BJAL has insufficient knowledge or information to either deny or admit the remainder of the allegations contained in paragraph 2 of the Notice, and therefore denies the same.

3. BJAL has insufficient knowledge or information to either deny or admit the allegations contained in paragraph 3 of the Notice, and therefore denies the same.

4. Denied.

5. BJAL has insufficient knowledge or information to either deny or admit the allegations contained in paragraph 5 of the Notice, and therefore denies the same.

6. Denied.

7. Denied.

8. Admitted.

9. Admitted.

10. Denied.

11. Denied.

12. Denied.

12. Denied. [paragraph 12 is repeated in the original notice, and so it is repeated here.]

13. Denied.

14. Denied.

15. Denied.

FIRST AFFIRMATIVE DEFENSE

16. Applicant is the owner of U.S. Trademark Application No. 76/736,828 ("Applicant's '828 application"), for SHAGADELLIC MOJO, in connection with fireworks in International Class 13.

17. On July 25, 2000, Opposer filed a Statement of Use Registration No. 2,547,824. This combined declaration alleged use of the mark on all the goods and services listed in the registration as early as May 2, 1997.

18. In the application filed on March 22, 2002, which registered as Registration No. 2,677,644, Opposer alleged a date of first use of the mark on all the goods and services listed in the application as early as May 2, 1997.

19. Applicant has made long and continuous use of the mark SHAGADELLIC MOJO on or in connection with fireworks, at least since May 2, 1992.

20. Therefore, Opposer's claims are barred, in whole or in part, by prior use.

SECOND AFFIRMATIVE DEFENSE

21. There is no likelihood of confusion between use of Applicant's mark SHAGADELLIC MOJO on fireworks and Opposer's SHAGADELIC mark as applied to the goods listed in Reg. Nos. 2,547,824 and 2,677,644.

THIRD AFFIRMATIVE DEFENSE

22. There is no likelihood of dilution of Opposer's SHAGADELIC mark as a result of Applicant's use of its SHAGADELLIC MOJO mark on fireworks.

COUNTERCLAIMS

B.J. Alan Company ("BJAL") a corporation of Ohio, with its main office located at 555 Martin Luther King, Jr., Blvd., Youngstown, Ohio 44502, believes that it is and will be damaged by continued registration of the mark SHAGADELIC, Registration Nos. 2,547,824 and 2,677,644. Accordingly, BJAL petitions this Honorable Board, pursuant to 15 U.S.C. §1064 and

37 C.F.R. §2.112, to cancel the above-referenced registrations and in support of its petition alleges as follows:

1. On March 12, 2002, New Line Productions, Inc. ("Registrant"), a California corporation, received Registration No. 2,547,824 for the mark SHAGADELIC in Class 16. The mark as originally registered alleged use of the mark on or in connection with printed matter and paper goods -- namely, books featuring characters from animated action adventure, comedy and/or drama features, comic books, children's books, magazines featuring characters from animated, action adventure, comedy and/or drama features, coloring books, children's activity books; stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets, chalk and chalkboards; decals, heat transfers; posters; mounted and/or unmounted photographs; book covers, book marks, calendars, gift wrapping paper; paper party favors and paper party decorations namely, paper napkins, paper doilies, paper place mats, crepe paper, paper hats, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliques; printed patterns for costumes, pajamas sweatshirts and t-shirts; paper photo frames.

2. On January 21, 2003, NPLI received Registration No. 2,677,644 for the mark SHAGADELIC in Class 25. The mark as originally registered alleged use of the mark on or in connection with clothing for men, women and children - namely, shirts, t-shirts, sweatshirts, jogging suits, trousers, pants, shorts, tank tops, rainwear, cloth bibs, skirts, blouses, dresses, suspenders, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sunvisors, belts, scarves, sleepwear, pajamas, lingerie, underwear, boots, shoes, sneakers,

sandals, booties, slipper socks, swimwear and masquerade and Halloween costumes and masks sold in connection therewith.

3. To the best of BJAL's knowledge, the name and address of the current owner of Registration No. 2,547,824 are New Line Productions, Inc. ("NLPI") at 888 Seventh Street, New York, NY, 10106.

4. To the best of BJAL's knowledge, the name and address of the current owner of Registration No. 2,677,644 are New Line Productions, Inc. ("NLPI") at 888 Seventh Street, New York, NY, 10106.

5. On July 25, 2000, NLPI filed a Statement of Use Registration No. 2,547,824. This combined declaration alleged use of the mark on all the goods and services listed in the registration as early as May 2, 1997.

6. In the application filed on March 22, 2002, which registered as Registration No. 2,677,644, NLPI alleged a date of first use of the mark on all the goods and services listed in the application as early as May 2, 1997.

7. BJAL has made long and continuous use of the mark SHAGADELLIC MOJO on or in connection with fireworks, at least since May 2, 1992.

8. The SHAGADELLIC MOJO mark is an arbitrary and unique mark as applied to BJAL's goods, and therefore is entitled to a broad scope of protection.

9. BJAL has invested a great deal of time, effort, and money in advertising, promoting and marketing the goods under the SHAGADELLIC MOJO mark and sales thereunder have generated revenues in the millions of dollars.

10. As a result of BJAL's efforts, the public has come to know, recognize and rely on the SHAGADELLIC MOJO mark as identifying goods which originate with BJAL, and BJAL has created and acquired substantial good will in the SHAGADELLIC MOJO mark.

11. BJAL filed an application for registration of the mark SHAGADELLIC MOJO for fireworks, in International Class 13, on October 20, 2005, bearing Serial No. 78/737,828.

12. On information and belief, continued registration of the mark SHAGADELIC by NLPI on or in connection with NLPI's products, will provide NLPI with the prima facie right to suggest falsely that NLPI's products are associated with or authorized by BJAL.

13. NLPI's continued registration of the mark SHAGADELIC in classes 16 and 25, will tend to reduce the value of the goodwill associated with BJAL's mark SHAGADELLIC MOJO.

14. BJAL believes and alleges that NPLI's use of the alleged SHAGADELIC mark, when applied to the goods of NPLI, is likely to cause confusion or mistake or to deceive or will cause confusion or mistake, and will deceive and mislead the trade and the purchasing public into believing that NPLI's products are the products of BJAL or that NPLI is authorized, licensed or controlled by BJAL, or that NPLI is a subsidiary of, or in some way related to BJAL. In addition, BJAL asserts and alleges that continued registration of the mark SHAGADELIC on the products of NPLI will have an adverse impact on BJAL's ability to use its SHAGADELLIC MOJO mark on or in connection with fireworks and will hamper BJAL's ability to promote its own goods in the U.S.

15. In addition, any concurrent use by NLPI of the mark SHAGADELIC on products inferior to BJAL's goods will cause irreparable harm to BJAL's reputation and goodwill, because purchasers will be likely to consider BJAL as the source of these inferior goods.

16. BJAL's SHAGADELLIC MOJO mark is famous and distinctive and BJAL believes and alleges that NPLI's alleged mark SHAGADELIC, when applied to the goods in Registration No. 2,547,824, is likely to dilute BJAL's SHAGADELLIC MOJO mark.

17. BJAL has also been damaged by virtue of the filing of opposition no. 91174787 by NPLI to oppose BJAL's registration of its mark.

FIRST COUNTERCLAIM

18. NPLI is not entitled to Registration No. 2,547,824 for SHAGADELIC at least by virtue of BJAL's prior use of BJAL's SHAGADELLIC MOJO mark in connection with fireworks.

SECOND COUNTERCLAIM

19. NPLI is not entitled to Registration No. 2,677,644 for SHAGADELIC at least by virtue of BJAL's prior use of BJAL's SHAGADELLIC MOJO mark in connection with fireworks.

PRAYER FOR RELIEF

WHEREFORE:

A. BJAL believes that is it and will be irreparably damaged by continued registration of NPLI's confusingly similar mark SHAGADELIC on products in Class 16, Registration No. 2,547,824, and petitions for cancellation thereof.

B. BJAL believes that is it and will be irreparably damaged by continued registration of NPLI's confusingly similar mark SHAGADELIC on products in Class 25, Registration No. 2,677,644, and petitions for cancellation thereof.

Respectfully submitted,

Date: March 12, 2007

/Ronni S. Jillions/
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CERTIFICATE OF ONLINE FILING

I hereby certify that the foregoing was submitted to the Trademark Trial and Appeal Board, via the on-line filing system on the USPTO website, on this 12th day of March 2007.

/Ronni S. Jillions/
Ronni S. Jillions

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing Answer to Notice of Opposition and Counterclaim was delivered via First Class Mail, addressed to counsel for Opposer, Ms. Erin S. Hennessy, Time Warner, Inc., One Time Warner Center, 14th Floor, New York, New York, 10019, on this 12th day of March 2007.

/Ronni S. Jillions/
Ronni S. Jillions