

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

In the matter of the Trademark Application Serial No. 76/657,886 for "911 RESTORATION" published in the Official Gazette on June 12, 2007

Sal Vitalie,)	Opposition No.: 91181177
)	
Opposer,)	
)	ANSWER TO NOTICE OF OPPOSITION
)	
vs.)	
)	
911 Restoration Enterprise, Inc.)	
)	
)	
Applicant.)	
_____)	

Commissioner for Trademarks
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

ANSWER TO NOTICE OF OPPOSITION

COMES NOW the Applicant, 911 Restoration Enterprise, Inc. a California corporation, (hereafter "Applicant"), by and through its attorney and pursuant to Rule 2.114 of the Trademark Rules of Practice and Rule 8(b) of the Fed. R. Civ. P., and for its Answer to the Notice for Opposition (hereafter the "Opposition"), filed by Sal Vitalie (hereafter "Opposer") seeking to oppose the issuance of United States Trademark Application Serial No. 76/657,886 for "911 RESTORATION", and answers the Opposition as follows:



01-14-2008

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ATTORNEYS AT LAW
18757 BURBANK BOULEVARD, SUITE 220
TARZANA, CALIFORNIA 91356-3346
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3 1. Answering Paragraph 1 of the Opposition, Applicant admits the
4 allegations of said Paragraph 1 of the Opposition.

5 2. Answering Paragraph 2 of the Opposition, Applicant admits the
6 allegations of said Paragraph 2 of the Opposition.

7 3. Answering Paragraph 3 of the Opposition, Applicant denies each and
8 every, all and singular, the allegations of said Paragraph 3 of the Opposition.

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10 4. Answering Paragraph 4 of the Opposition, Applicant admits that Opposer
11 is engaged in the same or related services as Applicant. Except as expressly admitted
12 herein, Applicant denies each and every, all and singular, the remaining allegations of
13 said Paragraph 4 of the Opposition.

14 5. Answering Paragraph 5 of the Opposition, Applicant denies each and
15 every, all and singular, the allegations of said Paragraph 5 of the Opposition.

16 6. Answering Paragraph 6 of the Opposition, Applicant denies each and
17 every, all and singular, the allegations of said Paragraph 6 of the Opposition.

18 7. Answering Paragraph 7 of the Opposition, Applicant denies each and
19 every, all and singular, the allegations of said Paragraph 7 of the Opposition.

20 8. Answering Paragraph 8 of the Opposition, Applicant denies each and
21 every, all and singular, the allegations of said Paragraph 8 of the Opposition.

22 9. Answering Paragraph 9 of the Opposition, Applicant denies each and
23 every, all and singular, the allegations of said Paragraph 9 of the Opposition.

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26 **AFFIRMATIVE DEFENSES**

27 **FIRST AFFIRMATIVE DEFENSE**

28 10. As a first, separate and distinct affirmative defense, Applicant alleges that its

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3 mark "911 RESTORATION" is not confusingly similar the application filed by Opposer.
4 The Applicant alleges that when considered in its entirety, "911 RESTORATION" is not
5 pronounced the same as and is not confusingly similar with Opposer's mark "24 HR.
6 EMERGENCY SERVICE FOR ALL YOUR CLEANING NEEDS FIRE/WATER
7 RESTORATION 9-1-1 650-8 RESTORE".
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10 SECOND AFFIRMATIVE DEFENSE

11 11. As a second, separate and distinct affirmative defense, Applicant alleges that
12 under the overall impression analysis, there is no rule that an applicant cannot register a
13 trademark which contains in part the whole of a prior registered mark. In re
14 Merchandising Motivation, Inc., 184 U.S.P.Q. 364 (T.T.A.B. 1974). In Merchandising
15 Motivation the Examiner stated that "no one has the right to incorporate the mark of
16 another" and refused registration of mark "MMI MENSWEAR" over prior registration of
17 mark "MEN'S WEAR". The Board reversed the Examiner's refusal because "the legal
18 proposition put forth by the [E]xaminer [wa]s not absolute." Id., at 365.
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20 In fact, the prior decision clearly indicates that there is no rule that confusion is
21 automatically likely when an applicant's trademark contains in part the whole of a prior
22 registered trademark. *See, e.g.*, S.C. Johnson & Sons, Inc. v. Johnson, 266 F.2d 129, 121
23 U.S.P.Q. 63 (6th Cir. 1959), *cert. denied*, 361 U.S. 820, 80 S. Ct. 65, 4 L. Ed.2d 65, 123
24 U.S.P.Q. 590 (1959); Clayton Mark & Co. v. Westinghouse Elec. Corp., 356 F.2d 943, 53
25 C.C.P.A. 951, 148 U.S.P.Q. 672 (C.C.P.A. 1964); Colgate-Palmolive Co. v. Carter-
26 Wallace, Inc., 432 F.2d 1400, 58 C.C.P.A. 735, 167 U.S.P.Q. 529 (C.C.P.A. 1970); Lever
27 Bros. Co. v. Barcolene Co., 463 F.2d 1167, 59 C.C.P.A. 1162, 174 U.S.P.Q. 392
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3 (C.C.P.A. 1972); Application of Ferrero, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A.
4 1973); Conde Nast Publications, Inc. v. Miss Quality, Inc., 5076 F.2d 1404, 184 U.S.P.Q.
5 422 (C.C.P.A. 1975); Plus Prod. v. General Mills, Inc., 188 U.S.P.Q. 520 (T.T.A.B.
6 1975); Lever Bros. Co. v. American Bakeries Co., 693 F.2d 251, 216 U.S.P.Q. 177 (2nd
7 Cir. 1982). In the above cited cases, the following registration of applicant's trademarks
8 are granted over prior registered trademarks which were respectively incorporated entirely
9 into the applicant's trademarks:
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<u>Applicant's Trademark</u>	<u>Prior Registered Trademark</u>
MARK 75	MARK
JOHNSON MOP	JOHNSON
PEAK PERIOD	PEAK
ALL CLEAR	ALL
TIC TAC TOE	TIC TAC
COUNTRY VOGUES	VOGUE
PROTEIN PLUS	PLUS
AUTUMN GRAIN	AUTUMN

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21 It is noted that in the above cited cases, no likelihood of confusion was found,
22 when the prior marks incorporated were found to be suggestive, or alternatively,
23 conveyed a different meaning as used alone.
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25 **THIRD AFFIRMATIVE DEFENSE**

26 12. As a third, separate and distinct affirmative defense, Applicant alleges that
27 the Opposer's mark "24 HR. EMERGENCY SERVICE FOR ALL YOUR CLEANING
28 NEEDS FIRE/WATER RESTORATION 9-1-1 650-8 RESTORE" has a totally different

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3 meaning from the Applicant's mark "911 RESTORATION" and the marks have a totally
4 different visual impression and no one would confuse the marks as emanating from the
5 same source since they are totally different marks having totally different commercial
6 impressions and totally different meanings in the marketplace.

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8 **FOURTH AFFIRMATIVE DEFENSE**

9 13. As a fourth, separate and distinct affirmative defense, Applicant alleges that
10 when the Opposer's mark and Applicant's mark are compared in their entireties, the
11 Applicant's mark for "911 RESTORATION" and the Opposer's mark for "24 HR.
12 EMERGENCY SERVICE FOR ALL YOUR CLEANING NEEDS FIRE/WATER
13 RESTORATION 9-1-1 650-8 RESTORE" are not confusingly similar in overall sight,
14 sound and meaning. The overall impression created by Applicant's mark is totally
15 different from the overall impression created by Opposer's mark.

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17 **FIFTH AFFIRMATIVE DEFENSE**

18 14. As a fifth, separate and distinct affirmative defense, Applicant alleges that
19 the Opposition and each and every paragraph stated therein fails to state a cause of action
20 against the Applicant.

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22 **SIXTH AFFIRMATIVE DEFENSE**

23 15. As a sixth, separate and distinct affirmative defense, Applicant alleges that
24 the Opposer has sustained no damage, injury or prejudice as a result of the Applicant's
25 trademark application for "911 RESTORATION".

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27 WHEREFORE, Applicant respectfully request that the Notice of Opposition be
28 dismissed with prejudice and Opposer take nothing by way of its Opposition, and that the

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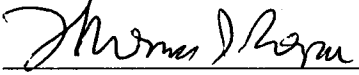
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honorable Trademark Trial and Appeal Board grants us further relief to Applicant as it may be deem just and proper under the circumstances.

If there is any charge required for the filing of this Answer to Notice of Opposition, the Commissioner of Patents and Trademarks is hereby authorized to charge my Deposit Account No. 18-2222 for the appropriate fee.

Please send all correspondence concerning this Opposition to Thomas I. Rozsa, at the address listed below.

Date: January 14, 2008

Respectfully submitted,


Thomas I. Rozsa
Registration No. 29,210
Attorney for Applicant
PowerBass USA Inc.
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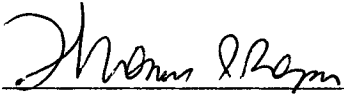
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CERTIFICATE OF MAILING

I hereby certify that the ANSWER TO NOTICE OF OPPOSITION,
CERTIFICATE OF SERVICE, and CERTIFICATE OF MAILING are being deposited
with the United States Postal Service with sufficient postage as Express Mail, Mail Label
No. EM 139378520 US an envelope addressed to:

Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Dated: January 14, 2008


Thomas I. Rozsa
Registration No. 29,210
Attorney For Applicant

In Re Opposition No. 91181177

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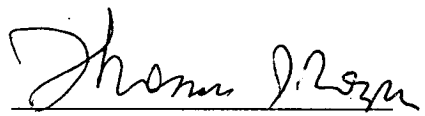
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the document entitled ANSWER TO NOTICE OF OPPOSITION was sent on January 14, 2008 via first class mail, postage prepaid, to the attorneys for the Opposer at the following address:

James A. Gale
Stephanie C. Alvarerz
Susan Marsillo
FELDMAN GALE, P.A.
One Biscayne Tower, 30th Floor
2 South Biscayne Boulevard
Miami, Florida 33131-4332

Dated: January 14, 2008


Thomas I. Rozsa
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In Re Opposition No. 91181177

911.ans.opp