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

Proceeding	91184436
Party	Defendant Arthur H. Garceau
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Date	07/13/2008
Attachments	Answer.pdf (7 pages)(95042 bytes)

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

Mark: JORDAN MARSH

JORDAN MARSH THE BETTER SWEATER

Applicant: Arthur H. Garceau

Serial Nos.: 77/174,947, 77/239,684

Published: February 5, 2008

MACY'S, INC.

Opposer,

Opposition No.911844366

v.

Arthur H. Garceau

Applicant

APPLICANT'S ANSWER TO OPPOSER'S NOTICE OF OPPOSITION

In answer to the Notice of Opposition in the above entitled cause, Applicants states the following:

FIRST CLAIM: LIKELIHOOD OF CONFUSION

1. Applicant, upon information and belief, knows of no current JORDAN MARSH Mark owned by Opposer. Opposer has abandoned its previous U.S. registrations for the JORDAN MARSH Mark and admits to non-use of the

JORDAN MARSH Mark. Applicant therefore denies each and every allegation set forth in Paragraph 1. Opposer's abandonment/non use of the JORDAN MARSH Mark goes to the issue of each of its additional allegations which follow.

2. Applicant denies each and every allegation set forth in Paragraph 2.

3. Applicant denies each and every allegation set forth in Paragraph 3.

4. Applicant denies each and every allegation put forth in Paragraph 4.

5. Applicant admits Opposer is not currently offering goods or services under the JORDAN MARSH Mark. Applicant denies each and every other allegation set forth in Paragraph 5.

6. Applicant denies each and every allegation put forth in Paragraph 6.

7. Applicant admits no one associated with Applicant is named JORDAN MARSH nor has JORDAN or MARSH as a first or last name, as alleged in Paragraph 7.

8. Applicant, upon information and belief, knows of no current JORDAN MARSH Mark owned by Opposer. Opposer has abandoned its previous U.S. registrations for the JORDAN MARSH Mark and admits to non-use of the JORDAN MARSH Mark. Applicant therefore denies each and every allegation set forth in Paragraph 8.

9. Applicant denies each and every allegation put forth in Paragraph 9

10. Applicant denies each and every allegation put forth in Paragraph 10

11. Applicant denies each and every allegation put forth in Paragraph 11.

SECOND CLAIM: FALSELY SUGGESTING A CONNECTION

12. Applicant repeats and reasserts its answers to the allegations of the preceding Paragraphs as if fully set forth herein.

13. Applicant denies each and every allegation put forth in Paragraph 13.

14. Applicant denies each and every allegation put forth in Paragraph 14.

15. Applicant denies each and every allegation put forth in Paragraph 15.

16. Applicant denies each and every allegation put forth in Paragraph 16.

17. Applicant denies each and every allegation put forth in Paragraph 17.

18. Applicant denies each and every allegation put forth in Paragraph 18.

19. Applicant denies each and every allegation put forth in Paragraph 19.

20. Applicant denies each and every allegation put forth in Paragraph 20.

21. Applicant denies each and every allegation put forth in Paragraph 21.

22. Applicant denies each and every allegation put forth in Paragraph 22.

APPLICANT'S DEFENSES

Applicant asserts the following defenses in response to the allegations set forth in Opposer's Notice of Opposition, and expressly reserves its right to amend its Answer and Defenses as additional information becomes available and/or is otherwise discovered.

First Defense

1. Applicant denies any likelihood of confusion based on the Opposer's abandonment/non-use of the JORDAN MARSH Mark. Opposer states it owns no registered mark for JORDAN MARSH nor for JORDAN

MARSH THE BETTER SWEATER and further states it is not using such marks. Upon information and belief, Opposer has not used the JORDAN MARSH Mark for more than ten years.

Second Defense

2. Applicant has no intention of using the JORDAN MARSH Mark to suggest a continuation of any previous company nor to suggest a connection with any individual, nor with the Opposer, MACY'S, Inc.

Third Defense

3. JORDAN MARSH is not primarily a surname. Neither is the word JORDAN nor the word MARSH primarily a surname. Applicant has no intention of using the JORDAN MARSH Mark to imply a connection to any individual, living or dead, and in particular, not to Eben Jordan nor Benjamin Marsh, individuals who lived and died in the 19th century.

Fourth Defense

4. The JORDAN MARSH Mark was not advertised to the purchasing public nationwide but was confined to primarily two regions, to wit, the New England area and South Florida. Opposer changed the name of its South Florida stores to Burdines in 1991. Opposer changed the name of its New England stores in 1996. Therefore, advertising of the abandoned JORDAN MARSH Marks was discontinued in Florida over fifteen years ago, and in New England over ten years ago. Opposer apparently saw no goodwill or secondary meaning lost after changing its Florida stores name to Burdines, as borne out by the Opposer's action of discontinuing

the use of the JORDAN MARSH Mark on it's New England stores, five years later, in 1996. Opposer claims its JORDAN MARSH Mark was of inestimable value and yet chose to abandon it and not use it for over ten years now.

Fifth Defense

5. The JORDAN MARSH Mark is totally unknown today to the vast majority of people. It has no secondary meaning to the purchasing public, and is not associated by them with a single anonymous source, namely, the Opposer. Opposer's decision to entirely discontinue the use of the JORDAN MARSH Mark, more than ten years ago, contradicts its claims of its abandoned JORDAN MARSH Mark having residual goodwill, secondary meaning, and of being of inestimable value. Opposer has had over ten years now to resume use of its abandoned JORDAN MARSH Mark and has not done so.

Sixth Defense

6. In 1996, after other corporate entities, now dissolved, and which may or may not have been connected to Opposer, had their registered JORDAN MARSH Marks declared cancelled or abandoned, Opposer, known then as Federated Department Stores, Inc., registered the JORDAN MARSH Mark, Serial No. 75042699, registered December 10, 1996. Opposer changed the name of all of its JORDAN MARSH stores that same year and discontinued the use of the JORDAN MARSH Mark.

Seventh Defense

7. Opposer's Section 8, for its JORDAN MARSH Mark, Serial No. 75042699 was filed in 2003. Opposer admitted to non-use of the mark and asked for an exception, based on its intent to begin using the mark again in the immediate future. The request was denied by the Examiner. Opposer's appeal to the TTAB was upheld and reversed the Examiner's decision. Upon information and belief, Opposer did not resume use of the JORDAN MARSH Mark, Serial No. 75042699, and Opposer's JORDAN MARSH Mark was declared abandoned on September 15, 2007.

Eighth Defense

8. Opposer chose to abandon the JORDAN MARSH Mark via non-use,over ten years ago, and has abandoned its registered JORDAN MARSH Mark as well, but claims it is still the owner of the JORDAN MARSH Mark, in perpetuity, which runs counter to the rule of non-use of a mark equals abandonment.

WHEREFORE, Applicant respectfully requests that the opposition be dismissed with prejudice and that the Board allow Applicant's marks, shown in U.S. Trademark Application Serial Nos. 77/174,947 and 77/239,684 to proceed to registration.

Respectfully submitted,

Arthur H. Garceau_____

By: /@r+G/ Dated: 07/13/2008

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CERTIFICATE OF ELECTRONIC SUBMISSION

I hereby certify that this correspondence is being submitted to the Trademark Trial and Appeal Board via ESTTA on 07/13/2008.

/@r+G/
Arthur H. Garceau, Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition has been served by mailing said copy on 07/13/2008 via Priority U.S. Mail, postage prepaid, to Opposer's Attorney of Record, addressed as follows:

Holly Pekowsky
Amster Rothstein & Ebenstein LLP
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New York, NY 10016

/@r+G/
Arthur H. Garceau, Applicant
07/13/2008