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Filing date: **04/24/2009**

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

Proceeding	91185925
Party	Defendant Save Your World, L.L.C.
Correspondence Address	NICOLE KNOX Save Your World, LLC P.O. BOX 745 Short Hills, NJ 07078 UNITED STATES knox@saveyourworld.com
Submission	Motion to Amend/Amended Answer or Counterclaim
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Date	04/24/2009
Attachments	Motion to Amend Answer and Counterclaim 1.pdf (1 page)(1108947 bytes) Motion to Amend Answer and Counterclaim 2.pdf (1 page)(1108947 bytes) Motion to Amend Answer and Counterclaim 3.pdf (1 page)(1108947 bytes) Motion to Amend Answer and Counterclaim 4.pdf (1 page)(1108947 bytes) Amend Answer and Counterclaim 1.pdf (1 page)(1108937 bytes) Amend Answer and Counterclaim 2.pdf (1 page)(1108937 bytes) Amend Answer and Counterclaim 3.pdf (1 page)(1108937 bytes) Amend Answer and Counterclaim 4.pdf (1 page)(1108937 bytes) Amend Answer and Counterclaim 5.pdf (1 page)(1108937 bytes) Amend Answer and Counterclaim 6.pdf (1 page)(1108937 bytes)

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

RAINFOREST CAFE, INC.)	
)	Opposition No. 91185925
Opposer,)	
)	
v.)	Serial No.: 77/270,643
)	
SAVE YOUR WORLD, L.L.C.)	
)	
Applicant)	

**APPLICANT'S MOTION TO AMEND ANSWER TO ADD
COUNTERCLAIM FOR CANCELLATION OF PLEADED
REGISTRATIONS NOS. 2,256,706 AND 2,319,752**

Applicant hereby moves the Board pursuant to 37 CFR 2.106(b)(2)(i) and TBMP Section 507.02(b) for leave to amend its Answer to the Notice of Opposition to add a Counterclaim for cancellation of Opposer's pleaded Registrations Nos. 2,256,706 and 2,319,752.

During the course of Applicant's discovery in this opposition proceeding, it has come to Applicant's attention through a detailed website and internet search that certain of Opposer's pleaded registrations may have been either fraudulently issued or maintained, or in the alternative, abandoned.

Specifically, the following newly discovered facts have come to light by virtue of Applicant's research during the discovery period.

1. Registration No. 2,256,706

On April 20, 2005, Opposer filed a Combined Declaration under Sections 8 & 15 of the Trademark Act covering the following International Class 35 services listed in this registration, “retail store services located on the premises of a restaurant, and on-line ordering services, featuring souvenirs and other general merchandise giftware” and such Declaration is based on the allegation of use of the mark on those services.

Applicant has discovered that Opposer’s website on which the mark is displayed does not offer any souvenirs or other general merchandise giftware for sale. Further, Opposer’s website is not configured for e-commerce activities to allow a consumer to purchase souvenirs or other general merchandise giftware in any manner on Opposer’s website to constitute “on-line ordering services” as listed in the registration for this mark. The sole item of a “gift card” which is advertised for sale on Opposer’s website cannot be purchased directly on Opposer’s website. In order for a consumer to purchase a gift card from Opposer, the consumer is required to exit Opposer’s website and is directed to Opposer’s parent company’s website which is a completely separate website from Opposer’s website where the mark is used as alleged in the marks’ registration. Finally, Applicant conducted an internet search for the last ten years and was unable to find one instance whereby Opposer offered or even had the capability to offer souvenirs and other general merchandise giftware for sale in an on-line manner in conjunction with the use of the mark. Applicant believes Opposer is not using Opposer’s Registration No. 2,256,706 mark in connection with all of the International Class 35 services listed in the registration for the mark, and that the mark is being used solely in connection with restaurant services and on-site retail store services.

2. Registration No. 2,319,752

On May 11, 2005, the Opposer filed a Combined Declaration under Sections 8 & 15 of the Trademark Act covering the following International Class 35 services listed in this registration, “retail store services located on the premises of a restaurant, mail-order catalog services, and on-line ordering services, featuring souvenirs and other general merchandise giftware” and such Declaration is based on the allegation of use of the mark on those services.

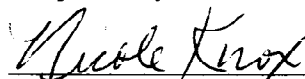
Applicant has discovered that Opposer’s website on which the mark is displayed does not offer any souvenirs or other general merchandise giftware for sale. Further, Opposer’s website is not configured for e-commerce activities to allow a consumer to purchase souvenirs or other general merchandise giftware in any manner on Opposer’s website to constitute “on-line ordering services” as listed in the registration for this mark. The sole item of a “gift card” which is advertised for sale on Opposer’s website cannot be purchased directly on Opposer’s website. In order for a consumer to purchase a gift card from Opposer, the consumer is required to exit Opposer’s website and is directed to Opposer’s parent company’s website which is a completely separate website from Opposer’s website where the mark is used as alleged in the marks’ registration. Finally, Applicant conducted an internet search for the last ten years and was unable to find one instance whereby Opposer offered or even had the capability to offer souvenirs and other general merchandise giftware for sale in an on-line manner in conjunction with the use of the mark. Applicant believes that Opposer is not using Opposer’s Registration No. 2,319,752 mark in connection with all of the International Class 35 services listed in the registration for the mark, and that the mark is being used solely in connection with restaurant services and on-site retail store services.

Applicant did not learn of the foregoing grounds for cancellation of Opposer's pleaded registrations until Applicant began the discovery process, and therefore, Applicant was not able to file a counterclaim with Applicant's original Answer.

In view of the foregoing, it is respectfully requested that this Motion to Amend the Applicant's Answer to include a Counterclaim for Cancellation of Opposer's Pledaded Registrations be granted, and that the Applicant's Amended Answer and Counterclaim be accepted and instituted.

Dated: April 24, 2009

Respectfully submitted



Nicole Knox, Esquire

P.O. Box 745

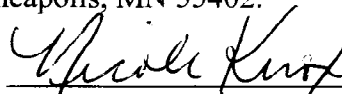
Short Hills, New Jersey 07078

(646)528-0044

Attorney for Applicant Save Your World, L.L.C.

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing **APPLICANT'S MOTION TO AMEND ANSWER TO ADD COUNTERCLAIM FOR CANCELLATION OF PLEADED REGISTRATIONS NOS. 2,256,706 AND 2,319,752** was served upon Opposer's counsel of record this 24th day of April, 2009 by sending the same via UPS courier, as follows: Sandra Epp Ryan, Faegre & Benson LLP, 2200 Wells Fargo Center, 90 South Seventh Street, Minneapolis, MN 55402.



Nicole Knox

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

RAINFOREST CAFE, INC.)	
)	Opposition No. 91185925
Opposer,)	
)	Serial No.: 77/270,643
v.)	
)	
SAVE YOUR WORLD, L.L.C.)	
)	
Applicant)	
)	

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

Applicant, Save Your World, L.L.C., through its attorney hereby responds to the allegations set forth in the Notice of Opposition in the above-captioned matter.

With respect to the preamble of the Notice of Opposition, Applicant denies that Opposer is being or will be damaged by the registration of application Ser. No. 77/270,643 for the mark RAINFOREST MALL which was published for opposition in the Official Gazette on April 22, 2008.

1. Applicant admits the allegations of Paragraph 1.
2. Applicant admits the allegations of Paragraph 2.
3. Applicant denies knowledge or information sufficient to form a belief as to the truth of each and every allegation of Paragraph 3 and, therefore, denies them.
4. Applicant denies knowledge or information sufficient to form a belief as to the truth of each and every allegation of Paragraph 4 and, therefore, denies them.
5. Applicant denies each and every allegation of Paragraph 5.

6. Applicant denies each and every allegation of Paragraph 6.

AFFIRMATIVE DEFENSES

7. As a first and separate affirmative defense, there is no likelihood of confusion, mistake or deception between Applicant's mark and the pleaded marks of Opposer because the marks are not confusingly similar.

8. As a second and separate affirmative defense, Applicant is informed and believes, and on this basis asserts that Opposer's marks should be entitled to a narrow scope of protection due to the fact that there are already numerous third party registrations for the mark RAINFOREST in connection with multiple goods and services in various classes, and owned by different parties.

Applicant reserves the right to raise additional defenses as may become known during discovery.

WHEREFORE, Applicant requests that the Notice of Opposition be dismissed in its entirety, and that a registration be issued to Applicant for its mark.

APPLICANT'S COUNTERCLAIM

Applicant believes that it is and will continue to be damaged by Opposer's pleaded Registrations Nos. 2,256,706 and 2,319,752 and hereby counterclaims for cancellation of said registrations.

As for this counterclaim, it is alleged that:

1. On April 20, 2005, the Opposer filed a Combined Declaration under Sections 8 & 15 of the Trademark Act in connection with Registration No. 2,256,706, stating that the mark shown in this registration was at that time currently in use in connection with the

following International Class 35 services “retail store services located on the premises of a restaurant, and on-line ordering services, featuring souvenirs and other general merchandise giftware” and had been in continuous use for the previous five consecutive years.

2. Applicant has discovered that Opposer’s website on which Opposer’s Registration No. 2,256,706 mark is displayed does not offer any souvenirs or other general merchandise giftware for sale. Further, Opposer’s website is not configured for e-commerce activities to allow consumers to purchase souvenirs or other general merchandise giftware on Opposer’s website to constitute “on-line ordering services, featuring souvenirs and other general merchandise giftware” as listed in Opposer’s registration for Opposer’s Registration No. 2, 256,706 mark. The sole item of a “gift card” which is advertised for sale on Opposer’s website cannot be purchased directly on Opposer’s website. In order for a consumer to purchase a gift card from Opposer, the consumer is required to exit Opposer’s website and is directed to Opposer’s parent company’s website which is completely separate website from Opposer’s website where Opposer’s Registration No. 2,256,706 mark is used as alleged in the registration. Finally, Applicant conducted an internet search for the last ten years and was unable to find one instance whereby Opposer offered or even had the capability to offer souvenirs and other general merchandise giftware for sale through “on-line ordering services” as described in Opposer’s Registration No. 2,256,706 mark.

3. Registration No. 2,256,706 in International Class 35 has been maintained by Opposer’s knowingly false or fraudulent statements, which statements were made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to approve the Declaration of Use and Incontestability Under Sections 8 & 15 of the Trademark Act, and, reasonably relying on the truth of said false statements, the U.S. Patent and Trademark Office

did, in fact, approve Opposer's Declaration of Use and Incontestability under Sections 8 & 15 of the Trademark Act.

4. Opposer is therefore not entitled to continue Registration No. 2,256,706 in its entirety since Opposer committed fraud in the continuance of the subject registration in International Class 35, and said registration is therefore void in its entirety.

5. In the alternative, Opposer has abandoned its use of the mark in Registration No. 2,256,706 with regard to the specific service of "on-line ordering services, featuring souvenirs and other general merchandise giftware" and therefore said registration should be partially cancelled with regard to the service of "on-line ordering services, featuring souvenirs and other general merchandise giftware."

6. On May 11, 2005, the Opposer filed a Combined Declaration under Sections 8 & 15 of the Trademark Act in connection with Registration No. 2,319,752, stating that the mark shown in this registration was at that time currently in use in connection with the following International Class 35 services "retail store services located on the premises of a restaurant, mail-order catalog services, and on-line ordering services, featuring souvenirs and other general merchandise giftware" and had been in continuous use for the previous five consecutive years.

7. Applicant has discovered that Opposer's website on which Opposer's Registration No. 2,319,752 mark is displayed does not offer any souvenirs or other general merchandise giftware for sale. Further, Opposer's website is not configured for e-commerce activities to allow consumers to purchase souvenirs or other general merchandise giftware on Opposer's website to constitute "on-line ordering services, featuring souvenirs and other general merchandise giftware" as listed in Opposer's registration for Opposer's Registration

No. 2,319,752 mark. The sole item of a “gift card” which is advertised for sale on Opposer’s website cannot be purchased directly on Opposer’s website. In order for a consumer to purchase a gift card from Opposer, the consumer is required to exit Opposer’s website and is directed to Opposer’s parent company’s website which is completely separate website from Opposer’s website where Opposer’s Registration No. 2,319,752 mark is used as alleged in the registration. Finally, Applicant conducted an internet search for the last ten years and was unable to find one instance whereby Opposer offered or even had the capability to offer souvenirs and other general merchandise giftware for sale through “on-line ordering services” as described in Opposer’s Registration No. 2,319,752 mark.

8. Registration No. 2,319,752 in International Class 35 has been maintained by Opposer’s knowingly false or fraudulent statements, which statements were made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to approve the Declaration of Use and Incontestability Under Sections 8 & 15 of the Trademark Act, and, reasonably relying on the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, approve Opposer’s Declaration of Use and Incontestability under Sections 8 & 15 of the Trademark Act.

9. Opposer is therefore not entitled to continue Registration No. 2,319,752 in its entirety since Opposer committed fraud in the continuance of the subject registration in International Class 35, and said registration is therefore void in its entirety.

10. In the alternative, Opposer has abandoned its use of the mark in Registration No. 2,319,752 with regard to the specific service of “on-line ordering services, featuring souvenirs and other general merchandise giftware” and therefore said registration should be

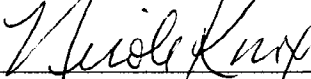
partially cancelled with regard to the service of “on-line ordering services, featuring souvenirs and other general merchandise giftware.”

WHEREFORE, Petitioner respectfully requests that this Counterclaim/Petition to Cancel Opposer’s pleaded Registrations Nos. 2,256,706 and 2,319,752 be granted and that said registrations relied upon by Petitioner in this opposition proceeding be canceled in part or in whole.

This Counterclaim for Cancellation is submitted together with the statutory filing fee of \$1,200.00. Should any additional fee be required, please notify us accordingly.

Dated: April 24, 2009

Respectfully submitted

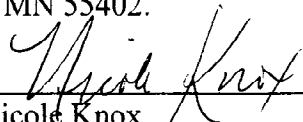


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Attorney for Applicant Save Your World, L.L.C.

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing APPLICANT’S AMENDED ANSWER AND COUNTERCLAIM TO NOTICE OF OPPOSITION was served upon Opposer’s counsel of record this 24th day of April, 2009 by sending the same via UPS courier, as follows: Sandra Epp Ryan, Faegre & Benson LLP, 2200 Wells Fargo Center, 90 South Seventh Street, Minneapolis, MN 55402.



Nicole Knox