

ESTTA Tracking number: **ESTTA280239**

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	Answer and Counterclaim
Filer's Name	Nicole Knox
Filer's e-mail	knox@saveyourworld.com
Signature	/Nicole Knox/
Date	04/24/2009
Attachments	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)

Registrations Subject to the filing

Registration No	2256706	Registration date	06/29/1999
Registrant	Rainforest Cafe, Inc. 1510 West Loop South Houston, TX 77027 UNITED STATES		
Grounds for filing	The registered mark has been abandoned. The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 035. First Use: 1994/09/02 First Use In Commerce: 1994/10/03 Requested goods and services in the class: RETAIL STORE SERVICES LOCATED ON THE PREMISES OF A RESTAURANT, AND ON-LINE ORDERING SERVICES, FEATURING SOUVENIRS AND OTHER GENERAL MERCHANDISE GIFTWARE

Registration No	2319752	Registration date	02/15/2000
Registrant	Rainforest Cafe, Inc. 1510 WEST LOOP SOUTH HOUSTON, TX 77027 UNITED STATES		
Grounds for filing	The registered mark has been abandoned. The registration was obtained fraudulently.		

Goods/Services Subject to the filing

Class 035. First Use: 1996/06/28 First Use In Commerce: 1996/07/25

Requested goods and services in the class: 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

**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

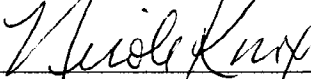
partially cancelled with regard to the service of “on-line ordering services, featuring souvenirs and other general merchandise giftware.”

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

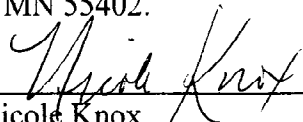


Nicole Knox, Esquire
P.O. Box 745
Short Hills, New Jersey 07078
(646)528-0044

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 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