

ESTTA Tracking number: **ESTTA345392**

Filing date: **05/03/2010**

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

Proceeding	91194259
Party	Defendant APRA INTERNATIONAL LLC
Correspondence Address	ADRIENNE DAWN MORAN, ESQ. ALSTON & BIRD LLP 90 PARK AVE NEW YORK, NY 10016-1301 ipnyc@alston.com
Submission	Answer and Counterclaim
Filer's Name	Lara A. Holzman, Esq.
Filer's e-mail	ipnyc@alston.com
Signature	/lah/
Date	05/03/2010
Attachments	Tattoo.PDF (7 pages)(215070 bytes)

Registration Subject to the filing

Registration No	2948656	Registration date	05/10/2005
Registrant	Michel Germain Parfums Ltd. 115 Industrial Avenue Carleton Place, Ontario K7C 3V7, CANADA		

Goods/Services Subject to the filing

Class 003. First Use: 2004/02/00 First Use In Commerce: 2004/06/21
All goods and services in the class are requested, namely: Perfumes

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of U.S. Application Serial No. 77/834,965
Mark: TATTOOED BY INKY & Design
Filing Date: September 25, 2009

Michel Germain Parfums, Ltd.

Opposer,

v.

Apra International, LLC,

Applicant.

Opposition No.: 91194259

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

APPLICANT'S ANSWER TO OPPOSER'S NOTICE OF OPPOSITION

Pursuant to Rule 2.106 of the Trademark Rules of Practice and Rule 8(b) of the federal Rules of Civil Procedure, applicant Apra International LLC ("Applicant" or "Apra"), by and through its undersigned counsel, files its answer to the Notice of Opposition to Applicant's U.S. Trademark application serial No. 77/834,965, filed by Michel Germain Parfums, Ltd. ("Opposer" or "Germain").

Applicant is a New York State limited liability company with its principal place of business at 53 Lormier Street, Apt 5B, Brooklyn, NY 11206, and the owner of U.S. Trademark application serial No. 77/834,965 (the "Application") for the mark TATTOOED BY INKY, filed

in International Class 3. The Application was published for opposition in the February 23, 2010 issue of the *Official Gazette*.

Applicant answers the specifically enumerated paragraphs in the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Notice of Opposition, and therefore denies the same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the notice of opposition, and therefore denies same, except admits that Opposer is listed as the Owner of registration number 2,948,656 for the Mark TATTOO.

3. Denied.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Notice of Opposition, and therefore denies same.

5. Denied.

AFFIRMATIVE DEFENSES

In further response to the Notice of Opposition, Applicant asserts that:

Absence of Likely Confusion

1. Likely confusion is avoided by, *inter alia*, the differences in appearance, sound, and meaning of Applicant and Opposer's respective marks.

2. Applicant's mark is a design mark, as depicted below:



Applicant's mark consists of three words "Tattooed by Inky" in a highly stylized font with a design of stars surrounding the words. Applicant's mark is both visually and audibly distinct from Opposer's word mark TATTOO.

3. Applicant's mark also differs in grammatical tense. Applicant's mark contains the word "tattooed." Opposer's mark is in the present tense. Thus, the marks differ in meaning. Further, Applicant's mark contains the distinctive words "by Inky" indicating the source. Opposer's mark is merely the word "tattoo." Thus, the marks differ in sound, sight and meaning and likelihood of confusion is avoided.

3. Based on the visual and audible differences between the marks, and the differences in the meanings of the marks, there is no likelihood of confusion.

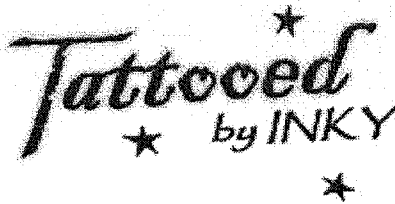
4. Further, there are several other registrations that include the term "tattoo" that exist on the register that cover goods in class 3. These marks are much closer to TATTOO than TATTOOED BY INKY & Design. These other co-existing marks include U.S. Reg. No.

3,562,440 for TATTOO BLUE owned by SZABO Dermatologica Incorporated; U.S. Reg. No. 3,686,019 for TATTOO DERMACARE owned by Hattie Johnson; U.S. Reg. No. 3,047,916 for TAMANU TATTOO owned by Auer Formulations Incorporated. If these other registrations can co-exist with TATTOO, then Applicant's mark should also be able to co-exist without confusion.

COUNTERCLAIM FOR CANCELLATION OF REG. NO. 2,948,656

Apra hereby petitions to cancel U.S. Reg. No. 2,948,656, issued May 10, 2005, for cancellation of the mark TATTOO owned by Germain. As grounds for this petition, it is alleged that:

1. U.S. Trademark application Serial No. 77/834,965 for the mark TATTOOED BY INKY & Design (as depicted below) was filed September 25, 2009 in the name of Preferred Fragrance Inc.



2. Apra became the owner by assignment of the U.S. Trademark application Serial No. 77/834,965 for the mark TATTOOED BY INKY & Design on October 29, 2009.

3. U.S. Trademark Application Serial No. 77/834,965 for the mark TATTOOED BY INKY & Design was filed covering the following goods: "fragrances and perfumery, colognes, perfumes, eau de colognes, eau de perfumes, oils for perfumes and scents, toilet waters, scented body sprays and mists, cosmetics, non-medicated skin care preparations and hair care preparations, and body lotions and powders."

4. Germain filed an application for the mark TATTOO covering “perfumes” on October 30, 2001. The application was granted U.S. Serial No. 76/331,441. On June 21, 2004, Germain filed a statement of use for the TATTOO mark claiming first use in interstate commerce of at least as early as June 2004.

5. Germain was granted U.S. Registration No. 2,948,656 on May 10, 2005 for the mark TATTOO covering perfumes.

6. Upon information and belief, at some point after the filing of its statement of use in 2004 and the filing of Applicant’s application for TATTOOED BY INKY & Design, Germain abandoned its mark for TATTOO because it failed to use this mark in commerce for a period of over three consecutive years.

7. Germain’s failure to use the TATTOO mark for a period of over three consecutive years constitutes abandonment, and U.S. Reg. No. 2,948,656 for the TATTOO mark should therefore be cancelled.

8. Further, Germain has failed to police its alleged mark TATTOO. There are several other marks registered that include the word TATTOO in class 3, including U.S. Reg. No. 3,562,440 for TATTOO BLUE owned by SZABO Dermatologica Incorporated; U.S. Reg. No. 3,686,019 for TATTOO DERMACARE owned by Hattie Johnson; U.S. Reg. No. 3,047,916 for TAMANU TATTOO owned by Auer Formulations Incorporated. Germain’s failure to police its mark s further evidence of its abandonment of the mark TATTOO.

WHEREFORE, Apra requests that the Board dismiss the *Notice of Opposition* filed in this proceeding and that Application Serial No. 77/834,965 for the mark TATTOOED BY INKY & Design be approved for registration, and that Apra's counterclaim for cancellation of Germain's U.S. Reg. No. 2,948,656 be granted.

Respectfully submitted,

/s/ Lara A. Holzman /s/

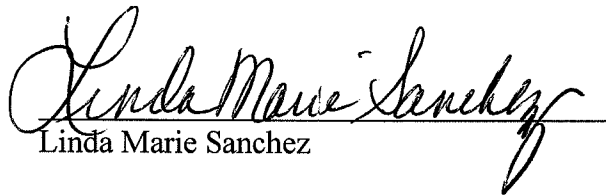
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Attorneys for Applicant,
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CERTIFICATE OF SERVICE

I certify that the foregoing "Applicant's Answer To Notice Of Opposition" was served on Opposer by mailing a copy of same by U.S. first class mail, postage prepaid, on the 3rd day of May, 2010, to Opposer's counsel, addressed as follows:

Thomas W. Brooke
Holland & Knight LLP
Suite 100
2099 Pennsylvania Avenue, NW
Washington, DC 20006


Linda Marie Sanchez