

ESTTA Tracking number: **ESTTA352708**

Filing date: **06/14/2010**

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

Proceeding	91194909
Party	Defendant Supreme Corporation
Correspondence Address	MATTHEW KOLMES LAW OFFICE OF MATTHEW KOLMES 60 E 8TH ST APT 32P NEW YORK, NY 10003-6530 mkolmes@supremecorporation.com
Submission	Answer and Counterclaim
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Signature	/Kathleen Cooney-Porter/
Date	06/14/2010
Attachments	Ans Aff Defenses & Ctrcls_06-14-10.PDF (7 pages)(23287 bytes)

Registrations Subject to the filing

Registration No	1733234	Registration date	11/17/1992
Registrant	BOLLMAN HAT COMPANY P.O. BOX 517, 110 EAST MAIN STREET ADAMSTOWN, PA 19501 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 025. First Use: 1987/01/06 First Use In Commerce: 1987/01/06 All goods and services in the class are requested, namely: headwear

Registration No	1923736	Registration date	10/03/1995
Registrant	BOLLMAN HAT COMPANY P.O. BOX 517, 110 EAST MAIN STREET ADAMSTOWN, PA 19501 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 025. First Use: 1993/03/01 First Use In Commerce: 1993/03/01 All goods and services in the class are requested, namely: hats

Registration No	3464401	Registration date	07/08/2008
Registrant	BOLLMAN HAT COMPANY P.O. BOX 517, 110 EAST MAIN STREET ADAMSTOWN, PA 19501 UNITED STATES		

Goods/Services Subject to the filing

Class 025. First Use: 2007/04/01 First Use In Commerce: 2007/04/01 All goods and services in the class are requested, namely: HEADWEAR

Registration No	2462210	Registration date	06/19/2001
Registrant	BOLLMAN HAT COMPANY P.O. BOX 517, 110 EAST MAIN STREET ADAMSTOWN, PA 19501 UNITED STATES		
Grounds for filing	The registered mark has become the generic name for the goods.		

Goods/Services Subject to the filing

Class 025. First Use: 1998/09/07 First Use In Commerce: 1998/09/07 All goods and services in the class are requested, namely: HEADWEAR

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

BOLLMAN HAT COMPANY,)	
)	
Opposer,)	
)	
v.)	Opposition No.: 91/194,909
)	Appln. Serial No. 77/810,744
SUPREME CORPORATION a/k/a)	
TUFF-N-LITE,)	
)	
Applicant.)	
)	

The Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS

Applicant, SUPREME CORPORATION a/k/a TUFF-N-LITE (“Applicant” or “Supreme”), as and for its Answer, Affirmative Defenses and Counterclaims to the Notice of Opposition of Opposer, Bollman Hat Company (“Opposer” or “Bollman”), alleges as follows:

*. Supreme denies Bollman’s claim and belief of damage set forth in the Preamble of the Notice of Opposition.

1. Supreme lacks knowledge and information sufficient to form a belief regarding the allegations contained in paragraph 1 of the Notice of Opposition, and therefore denies same leaving Bollman to strict proof thereof.

2. Supreme lacks knowledge and information sufficient to form a belief regarding the allegations contained in paragraph 2 of the Notice of Opposition, and therefore denies same leaving Bollman to strict proof thereof.

3. Supreme lacks knowledge and information sufficient to form a belief regarding the allegations contained in paragraph 3 of the Notice of Opposition, and therefore denies same leaving Bollman to strict proof thereof.

4. Supreme lacks knowledge and information sufficient to form a belief regarding the allegations contained in paragraph 4 of the Notice of Opposition, and therefore denies same leaving Bollman to strict proof thereof.

5. Supreme lacks knowledge and information sufficient to form a belief regarding the allegations contained in paragraph 5 of the Notice of Opposition, and therefore denies same leaving Bollman to strict proof thereof.

6. Supreme lacks knowledge and information sufficient to form a belief regarding the allegations contained in paragraph 6 of the Notice of Opposition, and therefore denies same leaving Bollman to strict proof thereof.

7. Supreme lacks knowledge and information sufficient to form a belief regarding the allegations contained in paragraph 7 of the Notice of Opposition, and therefore denies same leaving Bollman to strict proof thereof.

8. Responding to paragraph 8 of the Notice of Opposition, Supreme admits that on August 23, 2009 it filed intent-to-use based Application Serial No. 77/810,744 with the U.S. Patent Office to register the mark TUFF-N-LITE COOL. As published for opposition, Application Serial No. 77/810,744 recites the following goods:

Insulating polymeric shells, namely, macro and micro capsules containing phase change material used for thermal regulation in the manufacture of clothing, footwear and headgear – in International Class 17; and

Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Moisture-wicking sports shirts; Short-sleeved or long-sleeved t-shirts; T-shirts; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon

singlets, triathlon shirts, triathlon suits; Wearable garments and clothing, namely, shirts – in International Class 25.

Supreme otherwise denies the allegations contained in paragraph 8 of the Notice of Opposition.

9. Supreme denies the allegations contained in paragraph 9 of the Notice of Opposition.

10. Responding to paragraph 10 of the Notice of Opposition, Supreme admits that, if the U.S. Patent and Trademark Office issues a registration to Applicant for the TUFF-N-LITE COOL mark of Application Serial No. 77/810,744, Supreme will be afforded the benefits of Trademark Act Section 7, 15 U.S.C. § 1057 as to said mark and the goods recited in said Application. Supreme otherwise denies the allegations contained in paragraph 10 of the Notice of Opposition.

FIRST AFFIRMATIVE DEFENSE

11. Bollman has not opposed registration of the TUFF-N-LITE COOL mark with respect to the goods recited in Class 17 of Application Serial No. 77/810,744.

12. Supreme, therefore, is entitled to registration of the TUFF-N-LITE COOL mark with respect to the goods recited in Class 17 of Application Serial No. 77/810,744.

SECOND AFFIRMATIVE DEFENSE

13. The LITE FELT, LITE STRAW, LITE CLOTH and ULTRA LITE marks of U.S. Reg. Nos. 1,733,234, 1,923,736, 3,464,401 and 2,462,210, respectively, are generic as applied to the relevant goods recited therein, and therefore the marks are not entitled to trademark protection.

THIRD AFFIRMATIVE DEFENSE

14. The LITE CLOTH mark of U.S. Reg. No. 3,464,401 is merely descriptive and/or not inherently distinctive as applied to, and has not acquired distinctiveness with respect to, the relevant goods recited therein, and therefore the mark is not entitled to trademark protection.

COUNTERCLAIMS

Counterclaimant, SUPREME CORPORATION a/k/a TUFF-N-LITE (“Counterclaimant” or “Supreme”), as and for its Counterclaims against Counterclaim-Respondent, Bollman Hat Company (“Counterclaim-Respondent ” or “Bollman”), alleges as follows:

15. Supreme is a North Carolina Corporation having a place of business at 325 Spencer Road, Conover, North Carolina, 28613.

16. Upon information and belief, Bollman is a Pennsylvania corporation having a place of business at 110 East Main Street, Adamstown, Pennsylvania 19501.

17. Bollman has opposed registration of the TUFF-N-LITE COOL mark with respect to the goods recited in Class 25 of Application Serial No. 77/810,744.

18. The grounds for Bollman’s Opposition against the TUFF-N-LITE COOL mark with respect to the goods recited in Class 25 of Application Serial No. 77/810,744 is Bollman’s alleged prior rights in the marks LITE FELT, LITE STRAW, LITE CLOTH and ULTRA LITE of U.S. Reg. Nos. 1,733,234, 1,923,736, 3,464,401 and 2,462,210, respectively, and likelihood of confusion.

19. In view of Bollman’s Opposition against the TUFF-N-LITE COOL mark with respect to the goods recited in Class 25 of Application Serial No. 77/810,744 based on the grounds described above, Supreme has standing to seek cancellation of Bollman’s LITE FELT,

LITE STRAW, LITE CLOTH and ULTRA LITE marks of U.S. Reg. Nos. 1,733,234, 1,923,736, 3,464,401 and 2,462,210, respectively.

FIRST COUNTERCLAIM

20. Supreme repeats and reallages the allegations made in paragraphs 15-19 above.

21. The LITE FELT, LITE STRAW, LITE CLOTH and ULTRA LITE marks of U.S. Reg. Nos. 1,733,234, 1,923,736, 3,464,401 and 2,462,210, respectively, are generic as applied to the relevant goods recited therein, and therefore the marks are not entitled to trademark protection.

SECOND COUNTERCLAIM

22. Supreme repeats and reallages the allegations made in paragraphs 15-19 above.

23. The LITE CLOTH mark of U.S. Reg. No. 3,464,401 is merely descriptive and/or not inherently distinctive as applied to, and has not acquired distinctiveness with respect to, the relevant goods recited therein, and therefore the mark is not entitled to trademark protection.

WHEREFORE, Applicant, SUPREME CORPORATION a/k/a TUFF-N-LITE, requests that the Opposition of Bollman Hat Company be denied, and that its Notice of Opposition be dismissed with prejudice.

WHEREFORE, Counterclaimant, SUPREME CORPORATION a/k/a TUFF-N-LITE, believes and avers that it is being and will continue to be damaged by registration of the LITE FELT, LITE STRAW, LITE CLOTH and ULTRA LITE marks of U.S. Reg. Nos. 1,733,234, 1,923,736, 3,464,401 and 2,462,210, respectively, as aforesaid, and requests that said registrations be cancelled, and that the Cancellation Counterclaims be sustained in favor of Counterclaimant.

Opposer has appointed KATHLEEN COONEY-PORTER and JONATHAN HUDIS, partners of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, L.L.P., and members of the Bar of the District of Columbia, to defend the opposition, to prosecute the cancellation proceedings and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

Kathleen Cooney-Porter, Esquire
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, L.L.P.
1940 Duke Street
Alexandria, Virginia 22314

We enclose our credit card payment form or check for the required filing fee for the Cancellation Counterclaims. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-2014.

Respectfully submitted,

SUPREME CORPORATION a/k/a
TUFF-N-LITE

By: /s/ Kathleen Cooney-Porter
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Date: June 14, 2010

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS** was served on counsel for Opposer/Counterclaim Respondent, this 14th day of June, 2010, by sending same via First Class mail, postage prepaid, to:

James E. Shlesinger, Esquire
Daniel T. Earle, Esquire
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/s/ Kathleen Cooney-Porter
Kathleen Cooney-Porter