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Filing date: **08/29/2011**

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

Proceeding	91200794
Party	Defendant Joseph, Jake
Correspondence Address	JOSEPH, JAKE 2902 STONEWALL CT MISSOURI CITY, TX 77459-4942  jakecjoseph@gmail.com
Submission	Answer and Counterclaim
Filer's Name	Erica D. Klein
Filer's e-mail	KLTrademark@kramerlevin.com
Signature	/Erica D. Klein/
Date	08/29/2011
Attachments	Answer.PDF ( 6 pages )(123531 bytes )

**Registration Subject to the filing**

Registration No	3534666	Registration date	11/18/2008
Registrant	Pico Manufacturing Sales Corp. 463 Seventh Avenue, Suite 1500 New York, NY 10018 UNITED STATES		

**Goods/Services Subject to the filing**

Class 025. First Use: 2008/07/24 First Use In Commerce: 2008/07/24  
Requested goods and services in the class: Thermal Underwear, Undershirts

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

-----X  
Pico Manufacturing Sales Corporation, :  
 :  
 Opposer, : Opposition No.: 91200794  
 :  
 v. : Application No: 85/144,266  
 :  
 Jake Joseph, :  
 :  
 Applicant. :  
-----X

CERTIFICATE OF MAILING

I hereby certify that this Answer is being  
filed electronically, by means of the ESTTA system,  
on August 29, 2011.

ERICA D. KLEIN

Name

Signature

August 29, 2011

Date of Signature

**ANSWER TO NOTICE OF OPPOSITION**

Jake Joseph ("Applicant"), by and through his attorneys Kramer Levin Naftalis & Frankel LLP, hereby answers the Notice of Opposition (the "Notice") filed by Pico Manufacturing Sales Corporation ("Opposer") against Application No. 85/144,266 for the mark JAKE JOSEPH (the "Application") as follows:

1. Denied.
2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 2 of the Notice, and on that basis denies the same.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 3 of the Notice, and on that basis denies the same, except admits that the online records of the United States Patent and Trademark Office (“PTO”) identify Opposer as the registrant of Trademark Registration Nos. 1,687,935 and 3,534,666, which records reflect the Mark, Reg. No., Filing Date and Goods referenced in Paragraph 3 of the Notice.

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Notice, and on that basis denies the same.

5. Applicant admits that: (a) Application Serial No. 85/144,266 was filed by Jake Joseph on October 4, 2010 to register the mark JAKE JOSEPH; (b) the Application covers boxer briefs; boxer shorts; briefs; briefs; knitted underwear; ladies’ underwear; loungewear; sleepwear; trunks; underwear; women’s underwear; woven or knitted underwear, in International Class 25; (c) the Application shows a date of first use of January 10, 2008 and a date of first use in commerce of June 15, 2008; (d) the Application was published for opposition in the *Official Gazette* on March 22, 2011; and (e) Opposer obtained an extension of time up to and including September 18, 2011 to oppose the Application.

6. Applicant admits that: (a) the dates of first use and first use in commerce shown in the Application are January 10, 2008 and June 15, 2008, respectively; (b) the online records of the PTO indicate that Registration No. 1,687,935 shows a filing date of December 6, 1990 and a date of first use and first use in commerce of November 8, 1990; (c) the online records of the PTO indicate that Reg. No. 3,524,666 shows a filing date of February 8, 2007 and a date of first use and first use in commerce of July 24, 2008; (d) January 10, 2008 and June 15,

2008 are subsequent to December 6, 1990 and February 8, 2007. Applicant denies all other allegations of Paragraph 6 of the Notice.

7. Denied.

8. Denied.

**AFFIRMATIVE DEFENSES**

9. The Notice fails to state a cognizable basis upon which relief can be granted.

10. Opposer's claims are barred under the doctrine of unclean hands.

11. Opposer's claims are barred with respect to any reliance on Reg. No. 3,534,666, because such registration was secured on the basis of fraud.

**COUNTERCLAIM FOR  
CANCELLATION OF U.S. REG. NO. 3,534,666**

Counterclaimant Jake Joseph ("Applicant") hereby petitions for cancellation of U.S. Registration No. 3,534,666 on the following grounds:

12. Upon information and belief, Pico Manufacturing Corporation ("Opposer") is guilty of fraud on the U.S. Patent & Trademark Office ("PTO") with respect to its pleaded U.S. Registration No. 3,534,666 for the mark JAKE (the "Pico Registration"), which, on information and belief, is invalid because at the time that a Statement of Use was executed and filed on behalf of Opposer, the mark covered by the Pico Registration was not then in use in commerce (as that term is defined by 15 U.S.C. §1127) on or in connection with all of the goods recited therein.

13. The Pico Registration incorporates the following identification of goods: undergarments, knit and thermal underwear, woven and knitted boxer shorts, undershirts, briefs.

14. Upon information and belief, Opposer manufacturers private label goods.

15. Diligent research on behalf of Applicant found no use of the mark covered by the Pico Registration on certain goods covered thereby, namely thermal underwear and undershirts.

16. Upon information and belief, the mark covered by the Pico Registration was not in use in interstate commerce on all goods covered by the Pico Registration at the time that a sworn declaration was executed stating that such mark was in use on all identified goods.

17. Applicant is damaged by Opposer's assertion of the Pico Registration against Applicant in Opposition No. 91200794.

18. Accordingly, the Pico Registration should be cancelled.

**GROUND II:  
ABANDONMENT**

19. Applicant repeats and realleges the allegations of the Paragraphs 12-18, and incorporates the same by reference as though fully restated herein.

20. Upon information and belief, Opposer has never used or has discontinued use of the mark JAKE, which is the subject of U.S. Reg. No. 3,534,666, in commerce on certain goods covered by U.S. Reg. No. 3,534,666, namely thermal underwear and undershirts.

21. Upon information and belief, Opposer's omission to use, or discontinuance of use of, the mark JAKE, which is the subject of U.S. Reg. No. 3,534,666 has been with intent not to resume such use (as can be inferred from the surrounding circumstances) and constitutes an abandonment of such mark and the registration directed thereto.

22. Applicant is damaged by Opposer's assertion of the Pico Registration against Applicant in Opposition No. 91200794.

23. Accordingly, the Pico Registration should be cancelled.

WHEREFORE, Applicant respectfully requests that: (a) Opposition No. 91200794 against Application Serial No. 85/144,266 be dismissed and that such Application proceed to registration; (b) U.S. Reg. No. 3,524,666 be cancelled; and (c) such other relief as is just be granted.

Respectfully submitted,

Dated: New York, NY  
August 29, 2011

By:



Erica D. Klein

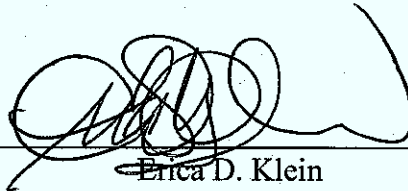
KRAMER LEVIN NAFTALIS & FRANKEL LLP  
1177 Avenue of the Americas  
New York, NY 10036  
(212) 715-9205 (Telephone)  
(212) 715-8000 (Facsimile)  
Email: [KLTrademark@kramerlevin.com](mailto:KLTrademark@kramerlevin.com)

Attorneys for Applicant Jake Joseph

CERTIFICATE OF SERVICE

I hereby certify that on August 29, 2011, I caused one true and complete copy of the foregoing Answer to Notice of Opposition to be served by first class mail upon Opposer Pico Manufacturing Sales Corporation by causing a true and complete copy thereof to be deposited in the United States mail, postage prepaid, addressed to its attorney of record as follows:

Robert Weisbein  
Foley & Lardner LLP  
90 Park Avenue  
New York, New York 10016



Erica D. Klein