

ESTTA Tracking number: **ESTTA451511**

Filing date: **01/17/2012**

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

Proceeding	91201611
Party	Defendant Panamonte Licensing, LLC
Correspondence Address	MATTHEW H SWYERS THE TRADEMARK COMPANY PLLC 344 MAPLE AVENUE WEST, SUITE 151 VIENNA, VA 22180 UNITED STATES mswyers@TheTrademarkCompany.co,
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Matthew H. Swyers
Filer's e-mail	mswyers@thetrademarkcompany.com
Signature	/Matthew H. Swyers/
Date	01/17/2012
Attachments	Motion to Amend Counterclaim.pdf ( 4 pages )(29342 bytes ) Amended Counterclaim.pdf ( 4 pages )(43066 bytes ) Exhibit A.pdf ( 2 pages )(283532 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**The Trademark Trial and Appeal Board**

Serial No. 85/188,495,  
For the mark PURE PANAMANIAN OVER PROOF RUM 108 PANAMA RED PROOF RED  
SKY AT NIGHT, SAILOR'S DELIGHT EST. \* 1967 and design,

Panama Jack International, Inc.,	:	
	:	
Opposer,	:	
	:	
vs.	:	Opposition No. 91201611
	:	
Panamonte Licensing, LLC,	:	
	:	
Applicant.	:	

**MOTION TO AMEND COUNTERCLAIM**

COMES NOW the Applicant, Panamonte Licensing, LLC (hereinafter “Applicant”), by and through counsel, The Trademark Company, PLLC, and files its Motion to Amend Counterclaim and Amended Counterclaim to the Notice of Opposition and in support of the instant motion Applicant states as follows:

**Statement of Facts**

1. The instant opposition proceeding was issued by Opposer Panama Jack International, Inc. (hereinafter “Opposer”) on or about September 14, 2011.
2. Applicant filed an Answer and Counterclaim on October 24, 2011.
3. Opposer filed an Answer to Applicant’s Counterclaim on December 8, 2011.
4. On December 19, 2011 Applicant retained new Counsel through The Trademark Company.
5. Upon review of the pleadings submitted by Applicant’s predecessor counsel, Applicant’s new counsel seeks to clarify Applicant’s counterclaim filed on or about October 24, 2011.

## **Motion**

A party may amend its pleading by leave of the Board when justice so requires unless entry of the proposed amendment would prejudice the rights of the adverse party. *See* FRCP 15(a).

In the instant case, Applicant seeks to clarify the original counterclaim of abandonment by setting forth the necessary elements of such a claim missing in the original counterclaim. Clarifying the Counterclaim does not violate settled law in this matter and does not violate the rights of the Opposer. Moreover, as the Opposer has already denied the salient allegations thereof, Opposer will be neither surprised nor unduly prejudiced by this mere clarification.

Applicant is filing the instant motion in the interests of judicial economy and to potentially avoid further proceedings surrounding this matter later in this case. As Applicant would retain the separate right to file a Petition to Cancel Opposer's trademark on these grounds and to join the same in this matter should this motion be denied, it is respectfully submitted that it is simpler and more efficient for the Board to grant the motion at this stage and to allow the necessary clarification.

This motion is being filed with all due haste following the retention of Applicant's new counsel and their review of the previous pleadings in this matter. As such, it is respectfully submitted that good cause having been shown the instant motion should be granted.

Finally, this request is not being sought to delay the proceedings herein. To that end, Applicant respectfully requests that the Board keep the current discovery and trial dates unchanged, enter the instant counterclaim as the current counter claim in the instant matter, and

treat the same as the original counterclaim further not requiring a denial of the same by Opposer as Opposer's denial of the same is already of record.

**Conclusion**

WHEREFORE for good cause shown Applicant Panamonte Licensing, LLC, by counsel, prays that it be granted leave to amend the Counterclaim in this matter.

Respectfully submitted this 17<sup>th</sup> day of January, 2012.

The Trademark Company, PLLC

/Matthew H. Swyers/  
Matthew H. Swyers, Esquire  
344 Maple Avenue West, Suite 151  
Vienna, VA 22180  
Tel. (703) 585-2077  
Fax (270) 477-4574  
mswyers@TheTrademarkCompany.com  
Counsel for Applicant

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	:	
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	:	
Panamonte Licensing, LLC,	:	
	:	
Applicant.	:	

**Certificate of Service**

I HEREBY CERTIFY that a true and accurate copy of the foregoing *Motion to Amend Counterclaim* was served this 17<sup>th</sup> day of January, 2012 upon the Opposer's Attorney of Record via first class mail at the address listed on the TARR database as reported this day as follows:

Ava K. Doppelt, Esq.  
Allen, Dyer, Doppelt, Milbrath, & Gilchrist, P.A.  
255 South Orange Avenue, Suite 1401  
Orlando, FL 32801

/Matthew H. Swyers/  
Matthew H. Swyers

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**The Trademark Trial and Appeal Board**

Serial No. 85/188,495

For the mark and design PURE PANAMANIAN OVER PROOF RUM 108 PANAMA RED PROOF RED SKY AT NIGHT, SAILOR'S DELIGHT EST. \* 1967

Panama Jack International, Inc.,	:	
	:	
Opposer,	:	
	:	
vs.	:	Opposition No. 91201611
	:	
Panamonte Licensing, LLC,	:	
	:	
Applicant.	:	

**AMENDED COUNTERCLAIM**

Applicant, Panamonte Licensing, LLC (hereinafter "Applicant"), a Limited Liability Company located and doing business at 32510 Wolfbranch Lane, Sorrento, FL 32776, believes that it is and will continue to be damaged by the continued registration of U.S. Registration 2,972,884 for the mark and PANAMA JACK for rum, and, accordingly, hereby petitions this honorable tribunal to cancel the same pursuant to 15 U.S.C. § 1064 and 37 C.F.R. § 2.111(b).

**Grounds for Counterclaim**

As grounds for the instant Counterclaim, it is alleged that:

1. The mark PANAMA JACK when used for rum was abandoned and is no longer is use by the Opposer Panama Jack International, Inc., a related entity, assignee, or successor in interest.

**Statement of Facts**

In support for the instant Counterclaim, it is alleged that:

1. Opposer Panama Jack International, Inc. (hereinafter "Opposer") contends that it is the owner of the mark PANAMA JACK used in connection with the following goods:

International Class 33: rums, and excluding whiskey and prepared cocktails containing whiskey.


2. Opposer filed its application to register the mark PANAMA JACK on or about November 15, 2002 alleging a first date of use of April of 2003. The application received U.S. Serial No. 78/185,385.

3. Opposer's application for the mark PANAMA JACK registered on July 19, 2005 on the Principal Register and received U.S. Registration No. 2,972,884.

4. Based upon information and belief, Opposer ceased use of the mark PANAMA JACK in connection with the goods identified in U.S. Registration No. 2,972,884 in December of 2006. *See* Exhibit A.

5. Moreover, Opposer has not used nor does it retain an intent to resume use of the mark PANAMA JACK in connection with the goods identified in U.S. Registration No. 2,972,884 since December 2006.



6. Applicant filed its application to register the mark  with the U.S. Patent and Trademark Office in connection with rum in International Class 33 on December 1, 2010.

7. Applicant's application received U.S. Serial No. 85/188,495.

8. Applicant believes that it will be damaged by Opposer's continued Registration insofar as Applicant's mark will not be permitted to register while Opposer's registration remains in effect.

WHEREFORE in consideration that the mark PANAMA JACK is no longer in use in connection with the goods identified in U.S. Registration No. 2,972,884, and has

been abandoned, Applicant requests and prays the U.S. Registration No. 2,972,884 be cancelled on the grounds and reasons set forth above.

Respectfully submitted this 17<sup>th</sup> day of January 2012.

The Trademark Company, PLLC

/Matthew H. Swyers/

Matthew H. Swyers, Esquire

344 Maple Avenue West, Suite 151

Vienna, VA 22180

Tel. (800) 906-8626

Fax (270) 477-4574

mswyers@TheTrademarkCompany.com

Counsel for Applicant



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	:	
vs.	:	Opposition No. 91201611
	:	
Panamonte Licensing, LLC,	:	
	:	
Applicant.	:	

**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that I caused a copy of the foregoing this 17<sup>th</sup> day of January, 2012, to be served, via first class mail, postage prepaid, upon:

Ava K. Dopplet, Esq.  
Allen, Dyer, Dopplet, Milbrath, & Gilchrist, PA  
255 South Orange Avenue, Suite 1401  
Orlando, FL 32801

/Matthew H. Swyers/  
Matthew H. Swyers



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**The Original Panama Jack** Since 1974

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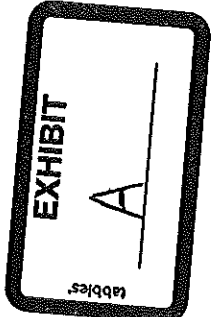
It's a sun-soaked celebration with  
 Panama Jack's **DIAMANTE**  
 It's a tropical escape to  
 a factory surrounded  
 It's a sun and a white dress,  
 It's a style so simply classic.

It's straw hats and dark sunglasses,  
 It's reflecting on what passes,  
 It's a lifestyle at half acento,  
 It's an island in a bottle,  
 It's a mango ripe for peeling,  
 It's a Panama Jack kind of feeling.

**Baby Sunblock**  
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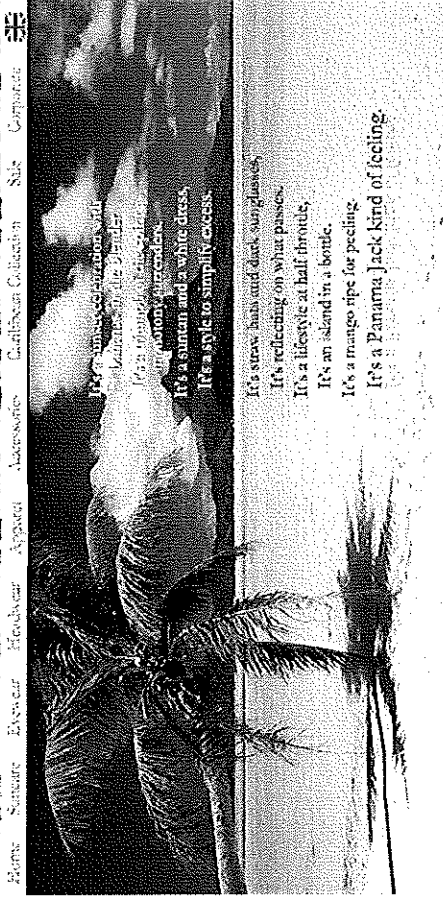
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# The Original Panama Jack

Since 1974



It's a simple celebration with  
 a little bit of the island.  
 It's a tropical breeze  
 in your hair.  
 It's a sun and a white dress.  
 It's a style to simply excess.

It's straw hats and dark sun glasses.  
 It's reflecting on what passes.  
 It's a lifestyle at half throttle.  
 It's an island in a bottle.  
 It's a mango ripe for peeling.  
 It's a Panama Jack kind of feeling.

**Surf 'N Sport Sunblock Lotion SPF-15**

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