

ESTTA Tracking number: **ESTTA519855**

Filing date: **02/05/2013**

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

Proceeding	91208630
Party	Defendant Shutterup.com Florida, Inc.
Correspondence Address	BRYAN L LOEFFLER THE LIVINGSTON FIRM 963 TRAIL TERRACE DRIVE NAPLES, FL 34103-2329 UNITED STATES
Submission	Answer and Counterclaim
Filer's Name	Erica L. Loeffler
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Signature	/Erica L. Loeffler/
Date	02/05/2013
Attachments	Answer Affirmative Defenses and CC.pdf (5 pages)(114241 bytes)

Registration Subject to the filing

Registration No	3855551	Registration date	10/05/2010
Registrant	International General Management of Orlando L.L.C. 1631 Rock Springs Rd. #240 Apopka, FL 32712 UNITED STATES		

Goods/Services Subject to the filing

Class 019. First Use: 2009/07/14 First Use In Commerce: 2009/07/14
All goods and services in the class are requested, namely: Interior window Poly shutter with aluminum core

Answer

1. Denied that the relevant consuming public will likely be confused or mistaken about the source of the product or service sold using the mark Alumacore, denied that any likelihood of confusion exists; and denied that the mark Alu Core Poly Shutters has been infringed.

2. Admitted that the goods offered by Applicant and Opposer are similar. Denied that Applicant and Opposer are in competition with one another. Denied that there is any likelihood of confusion.

3. Admitted that the goods offered by Applicant and Opposer are related. Opposer's allegation regarding the channels of distribution is unclear and therefore denied.

4. Denied that there has been any actual confusion. Denied that Applicant is located in Naples, Florida. Applicant is without knowledge of the remaining allegations in this paragraph and therefore denies same.

5. Denied that the marks are similar in appearance, phonetic sound, or meaning.

6. Denied that Applicant and Opposer are accessing overlapping customer bases. Applicant is without knowledge of Opposer's business and market and therefore denies all allegations regarding same. Denied that there is or is likely to be consumer confusion.

7. Applicant is without knowledge of Opposer's mark or any public recognition of same and therefore denies all allegations regarding same. Denied that there is any likelihood of confusion between Applicant's ALUMACORE mark and Opposer's Alu Core Poly Shutters and design mark.

Affirmative Defenses

As affirmative defenses, Applicant, SHUTTERUP asserts as follows:

First Affirmative Defense

As a first affirmative defense, Opposer has committed fraud upon the United States Patent and Trademark Office by providing false dates of first use in its application for registration of its ALU CORE POLY SHUTTERS mark and thus is entitled to no relief due to unclean hands.

Second Affirmative Defense

As a second affirmative defense, Opposer's ALU CORE POLY SHUTTERS mark and Applicant's ALUMACORE mark are not confusingly similar as they are not virtually identical in sight, sound, and meaning.

Third Affirmative Defense

As a third affirmative defense, Opposer's registration is voidable and should be cancelled due to lack of use in interstate commerce on the first use date stated in the application for registration.

COUNTERCLAIM FOR CANCELLATION

Applicant/Petitioner SHUTTERUP.COM FLORIDA, INC., a Florida corporation, believes that it is being damaged as a result of the Registration No. 3,855,551, for ALU CORE POLY SHUTTERS, issued to Opposer/Respondent, INTERNATIONAL GENERAL MANAGEMENT OF ORLANDO, LLC on October 5, 2010 and hereby respectfully requests the cancellation of same.

As grounds for cancellation, Applicant/Petitioner alleges:

1. On July 14, 2009, Opposer/Respondent filed a trademark application based on Section 1(a) to register the mark ALU CORE POLY SHUTTERS in International Class 19 for "Interior non-metal window shutters; Non-metal window shutters." Opposer/Respondent's registration for said application issued on October 5, 2010.

2. The application filed by Opposer/Respondent on July 14, 2009 was based on Opposer/Respondent's alleged first use of the mark in commerce in conjunction with its goods on July 14, 2009.

3. With its application, Opposer/Respondent submitted a "specimen" which appears to be a screen shot from a website showing the mark thereon. This specimen was refused by the USPTO by Office Action dated October 19, 2009.

4. On October 19, 2009, Opposer/Respondent responded to said Office Action and submitted a substitute specimen in the form of an information sheet showing the mark thereon. This specimen was also refused by the USPTO by Office Action dated

November 15, 2009.

5. Finally, on January 5, 2010, Opposer/Respondent submitted an acceptable specimen of use in the form of a photograph of the product having a label with the applied for mark affixed thereto.

6. The Opposer/Respondent committed fraud on the USPTO by making knowingly false and material misrepresentations in the filing of the Application in that Opposer/Respondent alleged false dates of first use.

7. At the time Opposer/Respondent filed its trademark application for ALU CORE POLY SHUTTERS on July 14, 2009, and executed the declaration thereon, it knew that it did not have bona fide use of its mark in the ordinary course of trade.

8. At the time Opposer/Respondent filed its trademark application for ALU CORE POLY SHUTTERS on July 14, 2009, the same date which it alleges as its date of first use, Opposer/Respondent had not placed the mark on the goods or containers nor had it sold or transported said goods in commerce, nor could it provide the USPTO with acceptable evidence of same.

9. Opposer/Respondent in failing to disclose its inadequate bona fide use of its mark in commerce on the date alleged in the application, intended to deceive the USPTO to procure a registration to which it was not entitled.

10. For the foregoing reasons, Registration No. 3,855,551 should be cancelled as the registration was obtained by fraud and Petitioner has been damaged as a result.

WHEREFORE, Applicant/Petitioner respectfully requests that Registration No. 3,855,551 be cancelled and that this Cancellation be sustained in favor of Petitioner.

Dated: February 5, 2013

Respectfully submitted,

By: /s/ Edward M. Livingston

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the Answer, Affirmative Defenses and Petition for Cancellation was served via first class mail on International General Management of Orlando, LLC, 1175 Academy Dr., Altamonte Springs, FL 32714 on the 5th day of February, 2013.

/s/Erica L. Loeffler
Erica L. Loeffler