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Filing date: **10/04/2013**

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

Proceeding	91211668
Party	Plaintiff Square, Inc.
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Submission	Answer to Counterclaim
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Date	10/04/2013
Attachments	Answer to Counterclaim.pdf(210458 bytes)

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

In the matter of
Trademark Application No.: 79/111,017
Mark: FAIR SQUARE COM (and design)
Filed: February 16, 2012
Published: February 26, 2013

Square, Inc.,)	
)	
Opposer,)	
)	
v.)	
)	Opposition No. 91211668
Soft Integrated Sp. zo.o,)	
Applicant.)	
)	
)	

Answer to Counterclaim for Cancellation

Opposer, by and through its attorneys, hereby admits, denies, and pleads to the Applicant's Counterclaim as follows:

16. Opposer avers that Paragraph 16 of the counterclaim calls for a legal conclusion to which no response is required. To the extent any response is required, Opposer prays that the Trademark Trial and Appeal Board deny Applicant's counterclaim for Cancellation, sustain the Opposition, and enter judgment in favor of Opposer.

17. Opposer lacks sufficient information to admit or deny the allegations of Paragraph 17 and, on that basis, denies those allegations.

18. Opposer admits the allegations of Paragraph 18.

19. Opposer admits the allegations of Paragraph 19.

20. Opposer admits the first sentence of Paragraph 20. Opposer avers that the remaining allegations of Paragraph 20 of the counterclaim call for a legal conclusion to which no response is required.

21. Opposer denies each and every allegation of Paragraph 21.

22. Opposer denies each and every allegation of Paragraph 22.

23. Opposer denies each and every allegation of Paragraph 23, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at www.merriam-websiter.com.

24. Opposer denies each and every allegation of Paragraph 24.

25. Opposer denies each and every allegation of Paragraph 25, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at www.thelaw.com.

26. Opposer denies each and every allegation of Paragraph 26.

27. Opposer lacks sufficient information to admit or deny the allegations of Paragraph 27 and, on that basis, denies those allegations.

28. Opposer lacks sufficient information to admit or deny the allegations of Paragraph 28 and, on that basis, denies those allegations.

29. Opposer lacks sufficient information to admit or deny the allegations of Paragraph 29 and, on that basis, denies those allegations.

30. Opposer denies each and every allegation of Paragraph 30.

31. Opposer denies each and every allegation of Paragraph 31, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at www.ivetriedthat.com.

32. Opposer lacks sufficient information to admit or deny the allegations of Paragraph 32 and, on that basis, denies those allegations.

33. Opposer denies each and every allegation of Paragraph 33, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at www.austinchronicle.com.

34. Opposer denies each and every allegation of Paragraph 34.

35. Opposer lacks sufficient information to admit or deny the allegations of Paragraph 35 and, on that basis, denies those allegations.

36. Opposer denies each and every allegation of Paragraph 36, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at www.ideasinactiontv.com.

37. Opposer denies each and every allegation of Paragraph 37, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at www.angelfire.com.

38. Opposer lacks sufficient information to admit or deny the allegations of Paragraph 38 and, on that basis, denies those allegations.

39. Opposer denies each and every allegation of Paragraph 39, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at paper.standartnews.com.

40. Opposer denies each and every allegation of Paragraph 40, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at frankfordgazette.com.

41. Opposer denies each and every allegation of Paragraph 41, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at lawyerslitigation.itags.org.

42. Opposer denies each and every allegation of Paragraph 42, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at loncaoc.soup.io.

43. Opposer denies each and every allegation of Paragraph 43, except admits that the counterclaim purports to refer to and quotes selectively from and out of context the website at www.clubgti.com.

44. Opposer denies each and every allegation of Paragraph 44.

45. Opposer denies each and every allegation of Paragraph 45. Opposer further specifically denies that the term SQUARE is highly descriptive or generic for the goods and services in Opposer's U.S. Reg. Nos. 3,917,735 and 3,962,489.

46. Opposer denies each and every allegation of Paragraph 46.

47. Opposer admits that the first use in commerce date for Registration No. 3,917,735 is at least as early as July 2009, but denies each and every other allegation of Paragraph 47. Opposer further avers that since its mark is non-descriptive, it does not have to demonstrate secondary meaning or acquired distinctiveness.

48. Opposer admits that the first use in commerce date for Registration No. 3,962,489 is at least as early as July 2009, but denies each and every other allegation of Paragraph 48. Opposer further avers that since its mark is non-descriptive, it does not have to demonstrate secondary meaning or acquired distinctiveness.

49. Opposer denies each and every allegation of Paragraph 49.

50. Opposer denies each and every allegation of Paragraph 50. Opposer further avers that since its mark is non-descriptive, it does not have to demonstrate secondary meaning or acquired distinctiveness.

51. Opposer avers that Paragraph 51 of the counterclaim either does not assert any allegations against Opposer or it calls for a legal conclusion to which no response is required. To the extent any response is required, Opposer prays that the Trademark Trial and Appeal Board deny Applicant's affirmative defenses and counterclaim for Cancellation, sustain the Opposition, and enter judgment in favor of Opposer.

All allegations in the counterclaim, whether explicit or implicit and including averments, which require an answer are denied to the extent that those allegations are not expressly and specifically admitted herein. Moreover, pursuant to Rule 8(b)(6) of the Federal Rules of Civil Procedure, allegations in the counterclaim, to which no responsive pleading is required shall be deemed as denied.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

(Estoppel)

Applicant's claims are barred, in whole or in part, by the doctrine of equitable estoppel. Applicant's attempt to register a confusingly similar SQUARE-based mark for "Brokerage in assets, settlements and payments via the Internet, namely, brokerage of mutual funds, debt settlement services, and credit card and payment card services; handling of Internet payment instruments, maintenance of payment cards via the internet, namely, Electronic commerce payment services, namely, establishing funded accounts used to purchase goods and services on

the Internet; electronic funds transfer" estops Applicant from alleging that Opposer's SQUARE marks are descriptive or generic for the same and similar services.

SECOND AFFIRMATIVE DEFENSE

(Laches)

Applicant's claims are barred, in whole or in part, by the doctrine of laches. Specifically, on information and belief, Applicant has unreasonably delayed in asserting any claimed rights against Opposer causing material prejudice due to that delay. On information and belief, this unreasonable delay and prejudice includes Applicant's failure to oppose or move to cancel Opposer's pre-existing and famous SQUARE-based names and marks.

THIRD AFFIRMATIVE DEFENSE

(Acquiescence)

Applicant's claims are barred, in whole or in part, by the doctrine of acquiescence. Specifically, on information and belief, Applicant's actions establish its assent to Opposer's registration of U.S. Trademark Registration Nos. 3,917,735 and 3,962,489. On information and belief said actions include Applicant's consent to Opposer's registration of its pre-existing and famous SQUARE-based names and marks, which furthered Opposer's activities in connection with U.S. Trademark Registration Nos. 3,917,735 and 3,962,489 and the SQUARE mark.

FOURTH AFFIRMATIVE DEFENSE

(Secondary Meaning)

Opposer affirmatively avers that it has used its SQUARE marks since at least as early as July 2009. Opposer further avers that since this time it has developed significant consumer

recognition and goodwill in its SQUARE marks, including consumer recognition and goodwill sufficient to establish secondary meaning.

FIFTH AFFIRMATIVE DEFENSE

(Distinctive Trademarks)

Opposer affirmatively alleges that its SQUARE marks are distinctive, non-descriptive and not generic.

These answers and affirmative defenses are based on the knowledge and information currently available to Opposer, and Opposer reserves the right to seek amendment of these answers or affirmative defenses pursuant to Federal Rule of Civil Procedure 15 and any other applicable rule, statute or case law, based on facts later discovered, pled, or offered.

WHEREFORE, Opposer prays that the Trademark Trial and Appeal Board deny Applicant's Counterclaim for Cancellation, sustain the Notice of Opposition, and enter judgment in favor of Opposer.

Respectfully submitted,

Dated: October 4, 2013

/Stephen Garcia/
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PROOF OF SERVICE BY MAIL

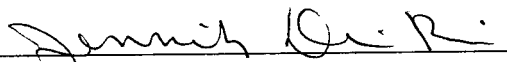
I declare that:

I am employed in the County of Mountain View, California.

I am over the age of eighteen years and not a party to the within cause; my business address is 801 California Street, Mountain View, California 94041. On the date indicated below, I served the within **Answer to Counterclaim**, on the interested parties in said cause, by placing a true copy thereof enclosed in a sealed envelope with postage thereon fully prepaid, in the United States mail at Mountain View, California, addressed as follows:

Alexander S. Lazousi
Lazouski & Associates LLC
Suite 2C 157 Third Avenue
Westwood, NJ 07675

I declare under penalty of perjury that the foregoing is true and correct, and that this declaration was executed at Mountain View, California, this 4th day of October, 2013.



Jennifer Davis Rink