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

Proceeding	91211760
Party	Defendant 101 West 57th Street Investors, LLC
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Signature	/Michele Schwartz/
Date	04/02/2014
Attachments	4.2.14 Answer and Counterclaim.pdf(23078 bytes)

Registration Subject to the filing

Registration No	3546992	Registration date	12/16/2008
Registrant	QUINTESSENTIALLY (UK) LIMITED 29 Portland Place GBX GBX		

Goods/Services Subject to the filing

<p>Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: Writing implements; bookbinding materials, namely, cardboard backing, laminated paper; photographs; stationery; books in the fields of travel, luxury lifestyle, events, wine, art, cars, fine food, jewelry, and yachting; printed matter, namely, coffee-table travel books, periodicals, events calendars, wine guides, art guides, leaflets about luxury lifestyle; Magazines featuring travel, art, wine, fine food, jewelry, yachting; printed publications, namely, brochures and booklets in the field of hospitality, wine, art, travel, printed plastic cards, namely, gift cards, credit cards, cards not magnetically encoded for use in business transactions, namely, membership cards; bank checks; check books; travel guides and gazetteers</p>
<p>Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: Goods made of leather or of imitations of leather, namely, luggage tags, wallets; boxes of leather or of leather board for storing business cards; envelopes in the nature of bags of leather for merchandise packaging; trunks, valises, traveling bags, traveling sets comprising garment bags, duffel bags and valises garment bags for travel; vanity-cases sold empty; handbags; beach bags; shopping bags of leather, canvas, cloth, denim; shoulder bags; attaché cases; briefcases; pouches of leather, canvas, cloth, denim, fine leather goods, namely, pocket wallets, purses, key-cases, credit-card cases, umbrellas, parasols, canes</p>
<p>Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: Administration of a discount program for enabling participants to obtain discounts on goods and services through use of a discount membership card; Business management consultancy services and advisory relating to administration of a discount program for enabling participants to obtain discounts on goods and services through use of a discount membership card; Business management consultancy and advisory services in the field of customer service relations, hospitality, marketing, sales, and luxury lifestyle administration;</p>

credit card registration; advertising services, namely, promoting the goods and services of others by means of offering discounts on hotels, resort accommodations, restaurants, car rentals, cruises, air fares, leisure facilities, exercise and recreational facilities, restaurants and clubs, tour packages, credit cards and brand name merchandise; Wholesale and retail ordering of goods and services for others in the fields of fine food and beverages, clothing, accessories, jewelry, real estate, cars, jets, and yachts; database management, customer relationship management, residential building employment staffing, hotel management

Class 036. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Financial services, namely, credit cardservices; real estate brokerage services; insurance services, namely, travel insurance underwriting; insurance services, namely, brokerage of travel insurance relating to assistance for persons who get into difficulties while traveling, while away from home and while away from their permanent residence; medical insurance underwriting, namely, guaranteeing payment of medical expenses for travelers; guarantee insurance services, namely, medical insurance underwriting and emergency loans for payment of emergency medical services; insurance services, namely, underwriting warranty programs in the field of travel, art, shipping, luxury goods and services; real estate affairs, namely, real estate acquisition services

Class 039. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Transport of persons and goods by ferry, boat, rail, and air; Travel agency services, namely, arranging, booking and arrangement of travel, excursions and cruises, organizing transport services, organizing, booking and arrangement of tours, excursions and sightseeing, travel consultancy and tour guide services for travelers on guided tours; organization, booking and arrangement of excursions, daytrips and sightseeing tours by airplane; organization, booking and arrangement of excursions, day trips and sightseeingtours by boat, namely, rowing boats andmotor boats, yachts and canoes; organization, booking and arrangement of excursions, day trips and sightseeing tours bymotor vehicles, bicycles, and horses; organization of sightseeing tours; travelagency services, namely, consultancy and booking of travel, provision of travelinformation, arranging of transport andtravel; transport reservation services for sporting, scientific, political and cultural events; travel agency services,namely, providing information on travel, and making reservations and providing booking services in the field of tourismand business travel via the Internet, excluding reservations for temporary lodging and restaurants; traffic informationservices

Class 041. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Education services, namely, providing classes in the fields of hospitality, wine and art appreciation, hotel operations, and luxury goods and services; providing of training in the fields of hospitality services and basic hospitality functions; entertainment, namely, ballet and other dance performances, opera, live theater, and circus performances; sportingevents, namely, entertainment in the nature of baseball, football, basketball, hockey and soccer games; cultural activities in the nature of art appreciation events; Entertainment services, namely, providing a television program in the field of real estate sales via a global computer network; providing information andadvisory services relating to entertainment, namely, art and music appreciation; information relating to entertainment provided online from a computer databaseor the Internet, namely, music, movie, art; providing online publications in the nature of magazines and blogs in the fields of food, wine, art, jewelry, cars,boats, airplane; online publication of electronic books and journals in the fields of food, wine, art, jewelry, cars, boats, airplane; publication of printed media and recordings, namely, music, audio and video, and spoken word; arranging for ticket reservations for shows and other entertainment events, social events,club entertainment events and live entertainment at dancing facilities, nightclubs, discotheques, music halls, concerts, dance halls, ballrooms, cabarets, circuses, visual and musical entertainment events, entertainment shows featuring dancers and singers, events, exhibitions and shows for entertainment purposes, music competitions, balls, theme parks, amusement parks, amusement arcades, cinema and theatres, sports facilities, recreation facilities and amenities, tenpin bowling alley and bowling greens, leisure centers, boating lakes, swimming facilities, golf facilities, tennis court facilities, health and fitness clubs, casino and gaming facilities, quizzes, games and competition events, beauty competitions;arranging sporting competitions, namely, baseball, football, basketball, hockeyand soccer, organizing conferences, seminars and exhibitions; entertainment, namely, production of gala dinners and events, namely, cigar nights, auctions and gala balls the proceeds of which are donated to charity; rental of sporting apparatus; arranging for ticket reservationsfor the cinema

Class 043. First Use: 0 First Use In Commerce: 0

All goods and services in the class are requested, namely: Travel agency services, namely, making reservations and booking for [temporarylodging, namely, holiday homes, touristhomes and apartments,] hotels, hotel rooms, motels, temporary accommodation; Travel agency services, namely, making reservations and bookings for restaurants and meals; restaurant, bar and catering services; tourism services, namely, providing information about [temporary accommodations and] places to eat and drink

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

-----X

Quintessentially (UK) Limited,

Opposer,

v.

Opposition No. 91211760
(Serial Nos. 85/708,961 and 85/708,972)

101 West 57th Street Investors, LLC,

Applicant.

-----X

ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM

Applicant 101 West 57th Street Investors, LLC (“Applicant” or “West Street”) files its Answer to Opposer Quintessentially (UK) Limited’s (“Opposer” or “Quintessentially”) Notice of Opposition and its Counterclaim against Opposer, and would respectfully show as follows:

**I.
ANSWER**

1. Applicant denies that allowing Application Serial Nos. 85/708,961 and 85/708,972 to proceed to registration will cause Opposer damage. As the additional allegations set forth in paragraph 1 of the Notice of Opposition are not directed to Applicant, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and, therefore, denies same.

2. As the allegations set forth in paragraph 2 of the Notice of Opposition are not directed to Applicant, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and, therefore, denies same.

3. Applicant admits the allegations contained in paragraph 3 of the Notice of Opposition.

4. Applicant admits the allegations contained in paragraph 4 of the Notice of Opposition.

5. As the allegations set forth in paragraph 5 of the Notice of Opposition are not directed to Applicant, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and, therefore, denies same.

6. As the allegations set forth in paragraph 6 of the Notice of Opposition are not directed to Applicant, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and, therefore, denies same.

7. As the allegations set forth in paragraph 7 of the Notice of Opposition are not directed to Applicant, Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained therein and, therefore, denies same.

8. Applicant denies the allegations contained in paragraph 8 of the Notice of Opposition.

9. Applicant denies the allegations contained in paragraph 9 of the Notice of Opposition as they relate to the use of Opposer's Mark in U.S. Commerce in connection with any goods and services other than lifestyle management and concierge services. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in the remaining allegations and, therefore, denies same.

10. Applicant denies the allegations contained in paragraph 10 of the Notice of Opposition as they relate to the sale any goods or services under Opposer's Mark in U.S. Commerce, other than the sale of lifestyle management and concierge services. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in the remaining allegations and, therefore, denies same.

11. Applicant denies the allegations contained in paragraph 11 of the Notice of Opposition as they relate to the sale any goods or services under Opposer's Mark in U.S. Commerce, other than the sale of lifestyle management and concierge services. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in the remaining allegations and, therefore, denies same.

12. Applicant denies that Opposer has priority over Applicant with respect to the use of Opposer's Mark in connection with the sale of any goods or services, other than the sale of lifestyle management and concierge services. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations contained in the remaining allegations in paragraph 12, including whether Opposer has priority over Applicant with respect to the use of Opposer's Mark in connection with the sale of lifestyle management and concierge services, and, therefore, denies same.

13. Applicant denies the allegations contained in paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations contained in paragraph 14 of the Notice of Opposition.

15. Applicant admits the allegations contained in paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations contained in paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations contained in paragraph 17 of the Notice of Opposition.

18. Applicant admits it does not have Opposer's consent or permission to use Applicant's Mark. Otherwise, Applicant denies the remaining allegations contained in paragraph 18 of the Notice of Opposition.

19. Applicant denies the allegations contained in paragraph 19 of the Notice of Opposition.

20. Applicant denies the allegations contained in paragraph 20 of the Notice of Opposition.

21. Applicant denies the allegations contained in paragraph 21 of the Notice of Opposition.

Applicant denies that Opposer is entitled to the relief sought in the Notice of Opposition, or that Opposer is otherwise entitled to any relief.

II. **AFFIRMATIVE DEFENSES**

For further answer, should same be necessary, Applicant asserts the following affirmative defenses:

22. Opposer's claims are barred, in whole or in part, by the doctrine of waiver and/or estoppel.

23. Opposer's claims are barred, in whole or in part, by the doctrine of unclean hands.

24. Opposer's claims are barred, in whole or in part, by the acquiescence and/or doctrine of laches.

25. Opposer's claims fail because no likelihood of confusion exists between Opposer's services and Applicant's hotel services.

26. Opposer's claims are barred, in whole or in part, by its use of fraud in procuring the registrations at issue.

III.
COUNTERCLAIM FOR CANCELLATION

West Street, a limited liability company organized and existing under the laws of the state of New York with its principal place of business at 101 West 57th Street, New York, New York 10019, believes that it is and will continue to be damaged by the maintenance of Registration Nos. 3,546,992; 3,888,453; 3,906,140 and 3,912,687 on the Principal Register and hereby petitions to cancel same.

As grounds for this Counterclaim, it is alleged as follows:

1. On August 21, 2012, West Street filed Application Serial Nos. 85/708,961 and 85/708,972 for the marks THE QUIN and THE QUIN (stylized) for “hotel services” in International Class 43 (“THE QUIN Marks”). True and correct copies of the U.S. Patent & Trademark Office (“USPTO”) records relating to applications for THE QUIN Marks are attached hereto as Exhibit “A.”

2. On July 25, 2013, Quintessentially filed this Notice of Opposition, arguing the applications for THE QUIN Marks should be rejected based on Registration Nos. 3,546,992; 3,888,453; 3,906,140 and 3,912,687 for the mark QUINTESSENTIALLY (collectively, “QUINTESSENTIALLY Marks”), on the basis that the QUINTESSENTIALLY Marks and THE QUIN Marks are likely to be confused. True and correct copies of the USPTO records relating to the QUINTESSENTIALLY Marks are attached hereto as Exhibit “B.”

3. Quintessentially’s registrations for the QUINTESSENTIALLY Marks are based on Section 44(e) and 66(a) of the Trademark Act. *See* Ex. B. Quintessentially did not file an allegation of use in U.S. Commerce in connection with the applications. *Id.*

4. Although the subject applications filed by Quintessentially under oath assert that Quintessentially had a *bona fide* intention to use the QUINTESSENTIALLY Marks in U.S. Commerce, upon information and belief, at the time of filing, Quintessentially did not have a *bona*

fide intention to use the QUINTESSENTIALLY Marks in U.S. Commerce in connection with all of the goods and services listed in the applications and set forth in the resulting registrations.

5. Upon information and belief, Quintessentially has not ever used the QUINTESSENTIALLY Marks in U.S. Commerce in conjunction with any of the goods and services set forth in the registrations, other than in connection with lifestyle management and concierge services.

6. An applicant who has applied for registration under Sections 44(e) and 66(a) of the Lanham Act must, in its U.S. application, verify, in writing, that it has a bona fide intent to use the mark in U.S. Commerce for the specified goods or services.

7. By virtue of the false, material claims regarding a *bona fide* intention to use the QUINTESSENTIALLY Marks in U.S. Commerce in connection with all of the goods and services listed in the applications and resulting registrations (including hotel services), the registrations for the QUINTESSENTIALLY Marks were invalidly obtained and should be cancelled, except to the extent they relate to lifestyle management and concierge services.

8. In the alternative, upon information and belief, Quintessentially has ceased use of the QUINTESSENTIALLY Marks in connection with certain goods and services set forth in the registrations, including hotel services, and thus has abandoned said marks with no intention to resume use of the marks.

9. Based on the foregoing, Quintessentially's registrations are causing and will continue to cause injury and damage to West Street unless and until such registrations are cancelled.

PRAYER FOR RELIEF

WHEREFORE, 101 West 57th Street Investors, LLC respectfully requests that the claims asserted against it by Quintessentially (UK) Limited be dismissed with prejudice, that the USPTO

register the marks that are subject to Application Serial Nos. 85/708,961 and 85/708,972, that Registration Nos. 3,546,992; 3,888,453; 3,906,140 and 3,912,687 be cancelled, and for such other and further relief as the Board deems just and proper.

Dated: April 2, 2014

Respectfully submitted,

/s Crystal L. Jamison _____

Michele P. Schwartz

Crystal L. Jamison

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ATTORNEYS FOR APPLICANT

101 WEST 57TH STREET INVESTORS, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Applicant's Answer to Notice of Opposition and Counterclaim was served by first-class mail, postage pre-paid:

Stephen L. Baker
Neil B. Friedman
BAKER and RANNELLS, PA
575 Route 28
Raritan, New Jersey 08869

/s Crystal L. Jamison
Crystal L. Jamison