

ESTTA Tracking number: **ESTTA608417**

Filing date: **06/05/2014**

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
Correspondence Address	MICHELE P SCHWARTZ ANDREWS KURTH LLP 1717 MAIN ST STE 3700 DALLAS, TX 75201 4749 UNITED STATES Dallasipdocket@akllp.com, mps@akllp.com, Cjamison@akllp.com, lynneuniman@akllp.com
Submission	Opposition/Response to Motion
Filer's Name	Michele P. Schwartz
Filer's e-mail	micheleschwartz@akllp.com, crystaljamison@akllp.com, kristyneal@akllp.com, lynneuniman@akllp.com
Signature	/Michele Schwartz/
Date	06/05/2014
Attachments	6.5.14 Applicant's Response to Motion to Strike with Exhibit A.pdf(37823 bytes)

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

-----X

QUINTESSENTIALLY (UK) LIMITED,

Opposer/Counterclaim Defendant,

v.

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

101 WEST 57TH STREET INVESTORS,
LLC,

Applicant/Counterclaimant.

-----X

**RESPONSE TO OPPOSER’S MOTION TO STRIKE APPLICANT’S AFFIRMATIVE
DEFENSES, PARAGRAPHS 22, 23, 24, AND 26 FROM APPLICANT’S ANSWER TO THE
NOTICE OF OPPOSITION AND/OR ALTERNATIVELY OPPOSER’S MOTION FOR
MORE DEFINITIVE [SIC] STATEMENT**

Applicant 101 West 57th Street Investors, LLC (“Applicant”) responds to the “*Motion to Strike Applicant’s Affirmative Defenses, Paragraphs 22, 23, 24, and 26 From Applicant’s Answer to the Notice of Opposition and/or Alternatively Opposer’s Motion for More Definitive [sic] Statement*” (the “Motion”) filed by Quintessentially (UK) Limited (“Opposer”) as follows:

1. Through its Motion, Opposer requests the Board to either strike the affirmative defenses asserted in Paragraphs 22, 23, 24, and 26 of Opposer’s Answer to the Notice of Opposition (“Original Answer”), or to order Applicant to provide a more definite statement as to said defenses.

2. Contemporaneously with this Response, Opposer is filing a “*First Amended Answer to the Notice of Opposition and Counterclaim*” (“Amended Answer”), a true copy of which is attached hereto as **Exhibit A**.¹

¹ In suspending this proceeding pending the disposition of Opposer’s Motion, the Board permitted the parties to file papers that are germane to the Motion. See May 22, 2014 Corr. from Monique Tyson, Paralegal Specialist. For the DAL:894735.2

3. The Amended Answer omits the affirmative defenses previously asserted in Paragraphs 22, 24, and 26 of Opposer's Original Answer.

4. In addition, the Amended Answer includes a more definite statement as to the defense asserted in Paragraph 23 of Opposer's Original Answer, which sets forth a short and plain statement of the defense pursuant to Federal Rule of Civil Procedure 8(b)(1)(A). *See also Duffy-Mott Co. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 USPQ 422 (CCPA 1970) (permitting applicant to, by way of affirmative defense in its answer, assert that false statements made in the procurement or maintenance of a registration remaining in force preclude the party from relying upon such registration: "This is in accord with the principle of the equitable doctrine of 'unclean hands.'").

Based on the foregoing, Applicant respectfully requests that the Board deny Opposer's Motion in its entirety as being moot.

Dated: June 5, 2014

purpose of clarification, Opposer notes that the Counterclaim portion of the Amended Answer was also slightly amended in that the previous references to "Exhibit A" and "Exhibit B" are omitted.

Respectfully submitted,

/s Crystal L. Jamison _____
ANDREWS KURTH LLP

Michele P. Schwartz
Crystal L. Jamison
1717 Main Street, Suite 3700
Dallas, Texas 75201
Telephone: (214) 659-4400
Facsimile: (214) 659-4401

Lynne M. Fischman Uniman
450 Lexington Avenue
New York, New York 10017
Telephone: (212) 850-2800
Facsimile: (212) 850-2929

**ATTORNEYS FOR APPLICANT
101 WEST 57TH STREET INVESTORS, LLC**

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Response to Opposer's Motion to Strike Applicant's Affirmative Defenses, Paragraphs 22, 23, 24, and 26 From Applicant's Answer to the Notice of Opposition and/or Alternatively Opposer's Motion for More Definitive Statement 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

EXHIBIT A

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

-----X

QUINTESSENTIALLY (UK) LIMITED,

Opposer/Counterclaim Defendant,

v.

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

101 WEST 57TH STREET INVESTORS,
LLC,

Applicant/Counterclaimant.

-----X

FIRST AMENDED ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM

Applicant 101 West 57th Street Investors, LLC (“Applicant” or “West Street”) files its First Amended 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 unclean hands. As set forth in more detail in Applicant's Counterclaim for Cancellation, U.S. Trademark Registration Nos. 3,546,992; 3,888,453; 3,906,140 and 3,912,687 were procured by Opposer's false statements. Therefore, pursuant to the equitable doctrine of unclean hands, Opposer is precluded from relying on said registrations.

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

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”).

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.

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

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: June 5, 2014

Respectfully submitted,

/s Crystal L. Jamison
ANDREWS KURTH LLP

Michele P. Schwartz
Crystal L. Jamison
1717 Main Street, Suite 3700
Dallas, Texas 75201
Telephone: (214) 659-4400
Facsimile: (214) 659-4401

Lynne M. Fischman Uniman
450 Lexington Avenue
New York, New York 10017
Telephone: (212) 850-2800
Facsimile: (212) 850-2929

**ATTORNEYS FOR APPLICANT
101 WEST 57TH STREET INVESTORS, LLC**

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Applicant's First Amended 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