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Filing date: **09/27/2013**

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

Proceeding	91212081
Party	Defendant Lee, Nelle Harper
Correspondence Address	ROBERT W. CLARIDA REITLER KAILAS & ROSENBLATT, LLC 885 3RD AVE NEW YORK, NY 10022-4834 rclarida@reitlerlaw.com
Submission	Answer
Filer's Name	Robert Clarida
Filer's e-mail	rclarida@reitlerlaw.com
Signature	/robert clarida/
Date	09/27/2013
Attachments	TKAM_Answer.pdf(337035 bytes)

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

In re Serial No. 85726786 for a word mark "TO KILL A MOCKINGBIRD"
filed on September 12, 2012

MONROE COUNTY HERITAGE MUSEUM,

Opposer,

-against-

NELLE HARPER LEE,

Applicant.

OPPOSITION NO. 91212081

ANSWER

Nelle Harper Lee ("Applicant"), a natural person, for her answer to the Notice of Opposition of Monroe County Heritage Museum ("Opposer"), alleges that:

1. Denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 1.
2. Admits the allegations contained in paragraph 2, except that to the extent that Opposer's use of the words "TO KILL A MOCKINGBIRD", and various stylizations and variations thereof, are used in a trademark sense, that such use infringes upon and dilutes Applicant's senior use, which began in July 1960, when she published the world-famous novel entitled *To Kill A Mockingbird*.
3. Admits the allegations contained in paragraph 3.
4. Denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 4.
5. Admits the allegations contained in paragraph 5.

6. Denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 6, except (1) admits that Opposer sells infringing and diluting goods in a gift shop, advertises infringing and diluting goods, uses an infringing and diluting website in violation of the Anticybersquatting Consumer Protection Act and (2) admits that Opposer has produced the play entitled *To Kill A Mockingbird* under license from Applicant's authorized agent.

7. Admits the allegations contained in paragraph 7.

8. Denies the allegations contained in paragraph 8.

9. Denies the allegations contained in paragraph 9.

10. Denies the allegations contained in paragraph 10.

11. Denies the allegations contained in paragraph 11.

12. Denies the allegations contained in paragraph 12, except admits that Applicant is a resident of Monroeville, Alabama and that Applicant met with Patricia Neal as alleged but did not "visit" the gift shop at any time; and further states that upon seeing the Opposer's infringing and diluting uses on the referenced occasion, Applicant demanded strenuously that Opposer cease and desist from such uses, as Applicant has done consistently each time she has encountered Opposer's infringing and diluting uses.

13. Admits the allegations contained in paragraph 13.

14. Denies the allegations contained in paragraph 14.

15. Admits the allegations contained in paragraph 15.

DEFENSES

16. The opposition should be dismissed on grounds of fraud and unclean hands because Opposer has knowingly withheld material information from the Board with an intent to

influence the outcome of this opposition. Specifically, Opposer has not advised the Board that it has made material statements to Applicant and to third parties that are inconsistent with Opposer's claim of senior rights in the mark TO KILL A MOCKINGBIRD. Opposer has intimidated an unrelated third-party news organization with the prospect of legal action for having reported, *in an article concerning this very opposition proceeding*, that Opposer has refused to pay Applicant any royalty or other compensation for Opposer's sale of merchandise bearing the mark TO KILL A MOCKINGBIRD. See attached Exhibit A (Reuters news item as originally published on September 21, 2013, stating "the museum [Opposer] said it did not believe she [Applicant] was entitled to share in the profits from the sale of the merchandise"); Exhibit B (email correspondence to Reuters from Opposer's counsel dated September 21 2013, demanding correction of Exhibit A, stating "the museum [Opposer] has never said that, and in fact would be happy to talk to Ms. Lee [Applicant] about this matter"). Opposer's intimidation was effective, and Reuters quickly "corrected" its news item. See Exhibit C ("Corrected" Reuters news item, stating "corrects characterization of museum's trademark application [sic] in paragraph 5 to make clear that museum is not refusing to share profits with Lee"). In fact, the original Reuters news item (Exhibit A) was true with respect to the Museum's refusal to share profits with Applicant, and Opposer knew the item to be true at the time it contacted Reuters to complain of its alleged inaccuracy in this regard, because Opposer had explicitly and in writing refused to pay any royalty to Applicant for Opposer's TO KILL A MOCKINGBIRD merchandise sales, or to buy authorized TO KILL A MOCKINGBIRD merchandise from Applicant. See Exhibit C (email correspondence dated June 6, 2013 to counsel for Applicant from counsel for Opposer, demanding "royalty-free" license as condition of not opposing the instant trademark registration); Exhibit D (email correspondence dated August 1, 2013 to

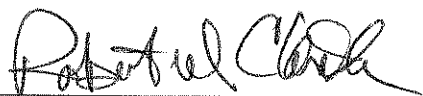
counsel for Applicant from counsel for Opposer, refusing Applicant's offer to sell authorized merchandise to Opposer: "the museum is not going to purchase its TKAM merchandise from Ms. Lee").

17. WHEREFORE, Petitioner requests that the Board deny the opposition and permit a Notice of Allowance to issue.

Dated: New York, New York
September 27, 2013

Respectfully submitted,

REITLER KAILAS & ROSENBLATT LLC

By: 

Robert W. Clarida
Office and P.O. Address:
885 Third Avenue, 20th Floor
New York, New York 10022
(212) 209-3050

Attorneys for Petitioner

TO: Matthew I. Goforth
Gordon, Dana, Knight & Gilmore, LLC
600 University Park Place
Suite 100
Birmingham, AL 35209
Attorney for Opposer

EXHIBIT A

International News September 21, 2013 posted by Al Davidian - 1 Comment

‘To Kill a Mockingbird’ author in dispute with US museum over book’s title

<http://i1.wp.com/cyprus-mail.com/wp-content/uploads/2013/09/mockingbirdWEB.jpg?fit=1024%2C1024><http://i1.wp.com/cyprus-mail.com/wp-content/uploads/2013/09/mockingbirdWEB.jpg?fit=1024%2C1024>

By Verna Gates and Melinda Dickinson

The Pulitzer Prize-winning author of “To Kill a Mockingbird,” Harper Lee, is locked in a dispute with a museum in her Alabama hometown over the use of the novel’s title.

The 87-year-old author has filed an application seeking a trademark for the book’s title when it is displayed on clothing and other merchandise.

The move is being challenged by the Monroe County Heritage Museum, which says it sells T-shirts and souvenirs with the words “To Kill a Mockingbird” to help fund its operations.

The museum, located in Monroeville, Alabama, is dedicated to the novel, widely considered a classic. The museum draws thousands of fans each year and includes an old courthouse that served as a model for the courtroom in the movie version of the novel that starred Gregory Peck.

Arguing against Lee’s trademark application, the museum said it did not believe she was entitled to share in the profits from the sale of the merchandise. Museum officials did not immediately return calls for comment.

Robert Clarida, an attorney for Lee, said he believed his client should receive a portion of the proceeds. “Who is going to buy those T-shirts if they don’t say ‘To Kill a Mockingbird?’” he asked.

The book, which won the Pulitzer Prize in 1961 and has sold more than 30 million copies, tells the story of two children of an attorney growing up in a small Southern town.

Their father, who is white, is selected to defend a black man accused of raping a white woman, and the man is convicted despite his innocence.

It is the only novel that Lee ever published.

Earlier this month, Lee agreed to terminate a lawsuit she filed against her former agent that claimed she had been tricked into giving away the copyright to her novel. No details of the agreement were made public.

EXHIBIT B

From: Matt Goforth <mgoforth@gattorney.com>

Date: Sat, 21 Sep 2013 10:36:52 -0500

To: vernagates@aol.com<vernagates@aol.com>

Subject: your Harper Lee story

Ms. Rawls,

I am the attorney for the museum and just read your story. I have spoken with the Museum and confirmed that neither you nor anyone else from Reuters contacted the Museum for comment about this article. No one contacted me either, though you apparently contacted Ms. Lee's attorney, Mr. Clarida. The statement in your article about museum officials not immediately returning calls for comment is not accurate, since no one called the museum. The statement that "the museum said it did not believe she was entitled to share in the profits from the sale of the merchandise" is also not accurate. The museum has never said that, and in fact would be happy to talk with Ms. Lee about this matter. To our knowledge Ms. Lee has never engaged in any use of "To Kill a Mockingbird" as a trademark in connection with the sale of any item, and the museum is doing what is necessary to protect its trademark rights in the merchandise it has been selling for many years.

Please correct your story immediately or we will take whatever legal action we deem necessary.

Thank you,

Matt Goforth

EXHIBIT C

CORRECTED-'To Kill a Mockingbird' author in dispute with U.S. museum over book's title

- [inShare0](#)
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- [Email](#)
- [Print](#)

•Related Topics

- [Cyclical Consumer Goods »](#)

•Sat Sep 21, 2013 10:09pm EDT

(Corrects characterization of museum's trademark application in paragraph 5 to make clear that museum is not refusing to share profits with Lee)

BIRMINGHAM, Ala., Sept 20 (Reuters) - The Pulitzer Prize-winning author of "To Kill a Mockingbird," Harper Lee, is locked in a dispute with a museum in her Alabama hometown over the use of the novel's title.

The 87-year-old author has filed an application seeking a trademark for the book's title when it is displayed on clothing and other merchandise.

The move is being challenged by the Monroe County Heritage Museum, which says it sells T-shirts and souvenirs with the words "To Kill a Mockingbird" to help fund its operations.

The museum, located in Monroeville, Alabama, is dedicated to the novel, widely considered a classic. The museum draws thousands of fans each year and includes an old courthouse that served as a model for the courtroom in the movie version of the novel that starred Gregory Peck.

The museum "would be happy to talk with Ms. Lee about this matter," according to Matthew Goforth, a lawyer for the museum. "To our knowledge, Ms. Lee has never engaged in any use of 'To Kill a Mockingbird' as a trademark in connection with the sale of any item, and the museum is doing what is necessary to protect its trademark rights in the merchandise it has been selling for many years," Goforth said.

Robert Clarida, an attorney for Lee, said he believed his client should receive a portion of the proceeds. "Who is going to buy those T-shirts if they don't say 'To Kill a Mockingbird?'" he asked.

The book, which won the Pulitzer Prize in 1961 and has sold more than 30 million copies, tells the story of two children of an attorney growing up in a small Southern town. Their father, who is white, is selected to defend a black man accused of raping a white woman, and the man is convicted despite his innocence.

It is the only novel that Lee ever published.

Earlier this month, Lee agreed to terminate a lawsuit she filed against her former agent that claimed she had been tricked into giving away the copyright to her novel. No details of the agreement were made public. (Reporting by Verna Gates and Melinda Dickinson; Editing by Kevin Gray and Eric Beech)

EXHIBIT D

From: Matt Goforth [<mailto:mgoforth@gattorney.com>]
Sent: Thursday, June 06, 2013 10:19 AM
To: Clarida, Robert W.
Subject: Harper Lee / Monroe County Heritage Museum

Robert,

My deadline to oppose Ms. Lee's trademark registration (Serial Number 85726786) is June 19. I have been instructed to oppose the registration if we cannot agree on a royalty-free license that allows the museum to continue to use the phrase "To Kill A Mockingbird" on products and materials in its museum and on its website. Please give me a call to discuss or let me know if your client is in agreement and you would like to propose a draft agreement for discussion.

Thanks,

Matthew I. Goforth
Gordon, Dana, Knight & Gilmore, LLC
600 University Park Place, Suite 100
Birmingham, Alabama 35209
(205) 874-7974 Direct
(205) 874-7950 Main
(205) 776-6541 Fax
www.gattorney.com

EXHIBIT E

From: Matt Goforth [mailto:mgoforth@gattorney.com]
Sent: Thursday, August 01, 2013 3:37 PM
To: Clarida, Robert W.
Subject: RE: Harper Lee / Monroe County Heritage Museum

Bob,

The Museum is not going to agree to purchase its TKAM merchandise from Ms. Lee. Since it appears we are not going to reach agreement, we are moving forward with opposing the trademark application.

Matthew I. Goforth
Gordon, Dana, Knight & Gilmore, LLC
(205) 874-7974

From: Clarida, Robert W. [mailto:rclarida@reitlerlaw.com]
Sent: Thursday, June 13, 2013 7:58 AM
To: Matt Goforth
Subject: Re: Harper Lee / Monroe County Heritage Museum

We would certainly agree to a further extension. Please give me some possible times for a call in the next day or two to discuss next steps.

Bob

From: Matt Goforth [mailto:mgoforth@gattorney.com]
Sent: Wednesday, June 12, 2013 07:30 PM
To: Clarida, Robert W.
Subject: RE: Harper Lee / Monroe County Heritage Museum

Robert,

This is certainly something I would need some additional time to discuss with my client, and we would need samples of merchandise your client has manufactured. Please let me know if your client agrees to this further extension. Thanks,

Matthew I. Goforth
Gordon, Dana, Knight & Gilmore, LLC
(205) 874-7974

From: Clarida, Robert W. [<mailto:rclarida@reitlerlaw.com>]
Sent: Wednesday, June 12, 2013 4:42 PM
To: Matt Goforth
Cc: Clarida, Robert W.
Subject: RE: Harper Lee / Monroe County Heritage Museum

Matt --

I am sorry we keep missing each other on the phone. Going forward, my client would propose to manufacture any TKAM merchandise herself, subject to her quality control standards, and to sell merchandise to the Museum for re-sale. The Museum would sell no other TKAM merchandise. I believe this would be the most beneficial arrangement for all concerned, and would avoid a lengthy and expensive dispute which will do nothing to improve the relationship between the parties. Please let me know if you would like to discuss. If you need some additional time to discuss with your client, I would recommend that my client agree to a further extension of the opposition period to allow the details to be worked out.

Regards,

Robert Clarida
Reitler Kailas & Rosenblatt LLC
885 Third Avenue, 20th Floor
New York, NY 10022
Tel: 212-209-3044
Fax: 212-371-5500
email: rclarida@reitlerlaw.com
web: www.reitlerlaw.com

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing Answer upon Registrant at its correspondence address of record in the United States Patent and Trademark Office by depositing one copy thereof in a depository of the United States Postal Service with first class postage affixed thereon on September 27, 2013, addressed as follows and in accordance with 37

C.F.R. § 2.119(b)(4):

Matthew I. Goforth
Gordon, Dana, Knight & Gilmore, LLC
600 University Park Place
Suite 100
Birmingham, AL 35209



Robert W. Clarida