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

Proceeding	91218523
Party	Defendant 13th Ave Fish Market Inc.
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Date	11/05/2014
Attachments	Answer to Notice of Opposition.pdf(933305 bytes)

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

OAKHURST INDUSTRIES, INC. DBA)
FREUND BAKING CO.,)
)
Opposer,)
)
v.)
)
13TH AVE FISH MARKETING INC.,)
DBA FREUND'S FISH,)
)
Applicant.)

Opposition No.: 91218523

ANSWER TO NOTICE OF OPPOSITION

Applicant, 13TH AVE FISH MARKETING INC. DBA FREUND'S FISH (hereinafter referred to as "Applicant"), through its counsel below, responds to the allegations in the Notice of Opposition as follows:

1. Lacks sufficient knowledge or information to respond to the allegations of paragraph 1 of the Notice of Opposition and, therefore, denies same.

2. Admits that "SINCE 1856" AND "BAKING CO." have been disclaimed from Registration No. 4,500,792 but otherwise lacks sufficient knowledge or information to respond to the remaining allegation in paragraph 2 of the Notice of Opposition and, therefore, denies same.

3. Lacks sufficient knowledge or information to respond to the allegations of paragraph 3 of the Notice of Opposition and, therefore, denies same.

Applicant also avers that the appearance of Opposer's alleged common law mark is so small in the Notice of Opposition that it is incapable of being scrutinized.

4. Lacks sufficient knowledge or information to respond to the

allegations of paragraph 4 of the Notice of Opposition and, therefore, denies same.

5. Lacks sufficient knowledge or information to respond to the allegations in paragraph 5 of the Notice of Opposition and, therefore, denies same.

6. Lacks sufficient knowledge or information to respond to the allegations in paragraph 6 of the Notice of Opposition and, therefore, denies same.

7. Lacks sufficient knowledge or information to respond to the allegations in paragraph 7 of the Notice of Opposition and, therefore, denies same.

8. Lacks sufficient knowledge or information about the allegations in paragraph 8 of the Notice of Opposition and, therefore, denies same.

9. Avers that the allegation in paragraph 9 of the Notice of Opposition calls for a legal conclusion to which no response is required but, in any event, denies same.

10. Denies that Opposer's alleged marks have become famous to qualify for protection under Section 43() of the Lanham Act as alleged in paragraph 10 of the Notice of Opposition and lacks sufficient knowledge or information about the remaining allegations in said paragraph and, therefore, denies same.

11. Admits that Opposer filed its trademark applications on December 10, 2013 but denies the remaining allegations in paragraph 11 of the Notice of Opposition.

12. In response to Paragraph 12 of the Notice of Opposition, Applicant relies upon its responses to Paragraphs 1 through 11 above.

13. Lacks sufficient knowledge to respond to the allegations in the first sentence of paragraph 13 of the Notice of Opposition and, therefore, denies same.

Applicant also admits that Opposer's claimed filing dates in paragraph 8 of the Notice of Opposition precedes Applicant's filing dates of its applications.

14. Lacks sufficient knowledge or information to respond to the allegations in paragraph 14 of the Notice of Opposition and, therefore, denies same.

15. Admits the allegations in paragraph 15 of the Notice of Opposition and avers that endorsement or sponsorship by Opposer is unnecessary.

16. Denies the allegations in Paragraph 16 of the Notice of Opposition and avers that "FAMOUS" has been disclaimed in the applications that are the subject of this opposition proceeding.

17. Denies the allegations in paragraph 17 of the Notice of Opposition; Applicant's marks have the word "FREUND'S", not FREUND.

18. Avers that the allegation in paragraph 18 of the Notice of Opposition calls for a legal conclusion to which no response is required but, in any event, denies same.

19. Denies the allegations in Paragraph 19 of the Notice of Opposition.

20. Denies the allegations in Paragraph 20 of the Notice of Opposition and avers that the common law mark shown therein is so small as to be incapable of being scrutinized.

21. Lacks sufficient knowledge or information to respond to the allegations in paragraph 21 of the Notice of Opposition and avers that the common law mark shown in the Notice of Opposition is so small as to be incapable of being scrutinized.

22. Denies the allegations in Paragraph 22 of the Notice of Opposition.

23. Denies the allegations in Paragraph 23 of the Notice of Opposition.

24. Avers that the allegations in paragraph 24 of the Notice of Opposition call for a legal conclusion to which no response is required but, in any event, denies same.

25. Avers that the allegations in paragraph 25 of the Notice of Opposition call for a legal conclusion to which no response is required but, in any event, denies same.

26. Objects to the first sentence of Paragraph 26 of the Notice of Opposition as vague and unintelligible and lacks sufficient knowledge or information to respond to the allegations therein and allegations made in the remaining sentences about what goods Opposer has made and what services Opposer has rendered and, therefore, denies same.

27. Denies the allegations in Paragraph 27 of the Notice of Opposition.

28. Lacks sufficient knowledge or information about Opposer's alleged goods and services to respond to the allegations in paragraph 28 of the Notice of Opposition and, therefore, denies same.

29. Lacks sufficient knowledge or information about Opposer's alleged goods to respond to the allegations in paragraph 29 of the Notice of Opposition and, therefore, denies same.

30. Lacks sufficient knowledge or information about Opposer's alleged goods to respond to the allegations in paragraph 30 of the Notice of Opposition and, therefore, denies same.

31. Denies the allegations in Paragraph 31 of the Notice of Opposition.
32. In response to Paragraph 32 of the Notice of Opposition, Applicant relies upon its responses to Paragraphs 1 through 31 above.
33. Denies the allegations in paragraph 33 of the Notice of Opposition.
34. Lacks sufficient knowledge to respond to the allegations in paragraph 34 of the Notice of Opposition and, therefore, denies same.
35. Denies the allegations as to fame sufficient for a claim under Section 43(c) in paragraph 35 of the Notice of Opposition.
36. Lacks sufficient knowledge to respond to the allegations in paragraph 36 of the Notice of Opposition and, therefore, denies same.
37. Denies the allegations in Paragraph 37 of the Notice of Opposition.
38. Denies the allegations in Paragraph 38 of the Notice of Opposition.
39. In response to Paragraph 39 of the Notice of Opposition, Applicant relies upon its responses to Paragraphs 1 through 38 above.
40. Admits the allegations in paragraph 40 of the Notice of Opposition.
41. Avers that the allegation in paragraph 41 of the Notice of Opposition call for a legal conclusion to which no response is required but, in any event, denies same.
42. Denies the allegations in paragraph 42 of the Notice of Opposition and avers that the goods in its applications are "gefilte fish, fresh fish, not live, frozen fish, canned tuna fish, and breaded fish fillets".
43. Avers that the allegation in paragraph 43 of the Notice of Opposition call for a legal conclusion to which no response is required. Further Applicant

admits that its mark incorporates the design of a fish but otherwise denies the allegations in said paragraph.

44. Denies the allegations set forth in paragraph 44 of the Notice of Opposition.

45. In response to Paragraph 45 of the Notice of Opposition, Applicant relies upon its responses to Paragraphs 1 through 44 above.

46. Admits the allegation in paragraph 46 of the Notice of Opposition that at the time of filing application Serial No. 86/139,577, the drawing of the mark contained the "®", and avers that the symbol is unregistrable matter.

47. Admits the allegation in paragraph 47 of the Notice of Opposition that it relied upon the same specimen of use for each application that showed gefilte fish with the mark appearing as in the drawing of the application as originally filed but otherwise denies the allegations in this paragraph.

48. Admits the allegations in paragraph 48 of the Notice of Opposition that it received an Office Action on March 27, 2014, in which the USPTO Examiner requested Applicant to submit a new drawing with the ® symbol deleted from the mark because the symbol "is not part of the mark and is not registrable" and denies the remaining allegations in this paragraph to the extent they suggest the USPTO Examiner advised the ® symbol may not be used in connection with a mark until it is registered with the USPTO.

49. Admits the allegation in paragraph 49 of the Notice of Opposition.

50. Objects to paragraph 50 in the Notice of Opposition as being vague and unintelligible but, in any event, denies same.

51. Objects to paragraph 51 in the Notice of Opposition as being vague and unintelligible but, in any event, denies same.

52. Denies the allegations in Paragraph 52 of the Notice of Opposition.

53. Applicant responds to the allegations in Paragraph 53 of the Notice of Opposition that the specimens of use Applicant submitted for its applications speak for themselves and that Applicant complied with USPTO requirements. Applicant otherwise denies the allegations in this paragraph.

54. Objects to paragraph 54 in the Notice of Opposition as being vague and unintelligible but to the extent the paragraph is understood, admits it has used the mark for its goods with the “®”.

55. Objects to paragraph 55 in the Notice of Opposition as being vague and unintelligible but admits that it has used for its goods the mark with the “®” symbol and avers such use was inadvertent and without any intent to deceive or mislead, and that Applicant is discontinuing such use.

56. Denies the allegations in paragraph 56 of the Notice of Opposition.

57. Denies the allegations in paragraph 57 of the Notice of Opposition and avers that its dates of first use are correct.

58. Denies the allegations in paragraph 58 of the Notice of Opposition and avers no willful misrepresentations of any kind occurred.

AFFIRMATIVE DEFENSES

First affirmative defense.

59. Opposer fails to state a claim upon which relief may be granted.

Second affirmative defense.

60. Applicant's use and registration of its marks as applied to its goods is

not likely to cause confusion of any kind with Opposer's alleged use and registration of its mark in connection with its alleged goods and services.

Third affirmative defense.

61. Applicant has used the FREUND'S FAMOUS word mark for at least 40 years for its fish products without any instances of actual confusion with any marks Opposer may apply to its goods.

Fourth affirmative defense.

62. Applicant has used the FREUND'S FAMOUS design mark for at least five years for its fish products without any instances of actual confusion with any marks Opposer may apply to its goods.

Fifth affirmative defense.

63. Applicant's use of the federal registration symbol has been inadvertent and without intent to mislead or deceive, and Applicant is discontinuing such use.

Sixth affirmative defense.

64. Whatever fame Opposer's marks might possess is insufficient for dilution protection under Section 43(c) of the Lanham Act.

Seventh affirmative defense.

65. Opposer's claims are barred due to laches and acquiescence.

Eight affirmative defense.

66. On information and belief, Opposer has not used its mark in connection with "private label baking services" as the specimens of use it submitted to cause the USPTO to issue Registration No. 4500792 do not refer to such services and thus do not meet the requirements of Section 1304.04 Trademark Manual of Examining Procedure et seq.

WHEREFORE, Opposer prays that the Notice of Opposition be dismissed.

Date: New York, N.Y.
November 5, 2014

Respectfully submitted,
BAKER & HOSTETLER LLP

Counsel for Applicant

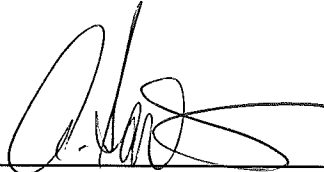
By: 

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing ANSWER TO NOTICE OF OPPOSITION and Exhibits was served by first class mail, postage prepaid, on Opposer's counsel, this 5th day of November, 2014 by first class mail, postage prepaid, in an envelope addressed as follows:

Steven A. Freund, Esq.
Law Offices of Steven A. Freund
P.O. Box 911457
Los Angeles, CA 90091

A handwritten signature in black ink, appearing to read 'Ana Dos Santos', written over a horizontal line.

Ana Dos Santos