

ESTTA Tracking number: **ESTTA657688**

Filing date: **02/24/2015**

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

Proceeding	91220284
Party	Defendant GIVN Goods Inc, John Houseal
Correspondence Address	GIVN GOODS INC GIVN GOODS INC 400 PERIMETER CENTER TER NE STE 900 ATLANTA, GA 30346-1236 john.houseal@givnbrands.com;john.housea
Submission	Answer and Counterclaim
Filer's Name	John Houseal
Filer's e-mail	john.houseal@givnbrands.com
Signature	/John Houseal/
Date	02/24/2015
Attachments	91220284 GIVN Answer.pdf(315295 bytes)

Registration Subject to the filing

Registration No	4063528	Registration date	11/29/2011
Registrant	KARMA CULTURE, LLC P.O. BOX 698 MENDON, NY 14506 UNITED STATES		

Goods/Services Subject to the filing

Class 005. First Use: 2011/09/02 First Use In Commerce: 2011/09/02

All goods and services in the class are requested, namely: Dietary supplements in the nature of stimulants in liquid form made from botanicals, algae, spices, and herbs for use in restoring mental alertness, all for non-medicinal purposes

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

In the matter of Application Serial No.: 86247771
Published in the Official Gazette on September 23, 2014

Karma Culture, LLC

Opposer,

Opposition No.: 91220284

v.

MARK: INFUSED WITH GOOD KARMA
Serial No.: 86247771

GIVN Goods Inc.

Applicant.

Attn.: Trademark Trial and Appeal Board
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

ANSWER TO OPPOSITION AND COUNTERCLAIM

Applicant GIVN Goods Inc. ("Applicant"), owner of U.S. Trademark Application for "INFUSED WITH GOOD KARMA," Serial No. 86247771, hereby answers the Notice of Opposition opposing the registration of said mark filed by Opposer Karma Culture, LLC ("Opposer") as follows:

- 1) Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in paragraph 1 of the Notice, and therefore denies the allegations.
- 2) Applicant denies the allegations in paragraph 2 of the Notice.
- 3) Applicant admits the allegations in paragraph 3 of the Notice.
- 4) Applicant admits the allegations in paragraph 4 of the Notice.

- 5) Applicant denies the allegations in paragraph 5 of the Notice. As indicated in the Examiner's Amendment dated August 19, 2014, the Application was amended to file under §1(a) of the Lanham Act, 15 U.S.C. §1051(a) based on use in commerce for goods in International Class 032 for: "Bottled drinking water", and also §1(b) based on Intent-to-Use in International Class 032 for: "Distilled drinking water; Drinking water; Drinking water with vitamins; Drinking waters; Purified bottled drinking water."
- 6) Applicant admits use of the mark KARMA in connection with conventional food items – specifically beverages – but lacks sufficient information to form a belief as to the truth or falsity of the long use of trademarks similar to the Opposer's alleged Mark as set forth in paragraph 6 of the Notice, and therefore denies those allegations. Upon information and belief, the Opposer's alleged Mark does not include beverages and is narrowly defined. As stated by the USPTO Examiner in the October 12, 2011 Outgoing Office Action (Document 10) for Application Serial No. 77024533 for the mark KARMA, the *"Applicant seeks registration of the proposed mark in connection with narrowly defined goods, namely, "Dietary supplements in the nature of stimulants in liquid form made from botanicals, algae, spices, and herbs for use in restoring mental alertness, all for non-medicinal purposes," in Class 5."...As indicated, applicant's goods are defined by their primary nature (i.e., as a dietary supplement rather than beverage), by their sole specific use (a liquid stimulant for restoring mental alertness) and finally by their ingredients (botanicals, algae, spices and herbs)... In this case, the specimen appears to depict use of the mark for drinking water with vitamins...there is nothing on the specimen to confirm the primary nature of the goods as a liquid stimulant...Applicant also should be aware that use other than for the goods as identified would not be encompassed by the subject application or any resulting registration."*
- 7) Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in paragraph 7 of the Notice, and therefore denies the allegations.

- 8) Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in paragraph 8 of the Notice, and therefore denies the allegations.
- 9) Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in paragraph 9 of the Notice, and therefore denies the allegations.
- 10) Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in paragraph 10 of the Notice, and therefore denies the allegations.

CLAIM FOR RELIEF UNDER 15 U.S.C §1052(d) – LIKELIHOOD OF CONFUSION

- 11) Applicant hereby repeats and incorporates its responses to paragraphs 1 through 10 as though set forth fully herein.
- 12) Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in paragraph 10 of the Notice, and therefore denies the allegations. Upon information and belief, the Opposer has previously asserted to the USPTO that consumers can and do differentiate between marks containing KARMA. As stated on July 16, 2009 in a Response to Office Action (Document 20) as part of Application Serial No. 77024533 for the Opposer's alleged mark KARMA, "*many uses of KARMA, CARMA, or similar marks exist in this and related industries. The following registrations show that KARMA, CARMA, and like marks are only entitled to a narrow scope of protection due to the many uses and registrations of similar marks...(citing: Registration No. 3438203 KARMA CREATIVES, Registration No. 3037478 GOOD KARMA BEVERAGE, INC., Registration No. 3107703 KARMA TEA AND TONICS, No. 3190885 KARMA COFFEEHOUSE HANDCRAFTED AND FRESH ROASTED ORGANIC FAIR TRADE COFFEE GOOD COFFEE. GOOD FRIENDS. GOOD KARMA. WWW.KARMA COFFEEHOUSE.COM, Registration No. 3034106 KARMA COFFEE ROASTERS, Registration No. 3507951 KARMA QUENCH HYDRATING THE WORLD.ONE DROP AT A TIME, Registration No. 3401348 BANANA KIWI KARMA,*

and Registration No. 3351541 KARMAQUENCH)... consumers are accustomed to encountering marks that contain KARMA, CARMA, or a similar mark on goods in the relevant and similar industries. Therefore, consumers can and do differentiate between marks containing KARMA, CARMA, and similar marks.”

- 13) Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in paragraph 13 of the Notice, and therefore denies the allegations.
- 14) Applicant hereby repeats and incorporates its responses to paragraphs 1 through 13 as though set forth fully herein, and denies the allegations in paragraph 14 of the Notice.
- 15) Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in paragraph 15 of the Notice, and therefore denies the allegations. Upon information and belief, the Opposer has not made prior and continuous use of Opposer’s alleged Mark in commerce in connection with the goods listed for the mark KARMA in Application Serial No. 77024533 / Registration No. 4063528.

Additionally, by reason of the foregoing, Applicant denies that Opposer will be damaged by the registration of Applicant’s U.S. Trademark Application for “INFUSED WITH GOOD KARMA,” Serial No. 86247771.

WHEREFORE, Applicant respectfully requests that the Board deny the Notice of Opposition, Opposition No. 91220284, and permit registration of U.S. Trademark Application for “INFUSED WITH GOOD KARMA,” Serial No.86247771.

COUNTERCLAIM I - CANCELLATION FOR FRAUD

Applicant believes that it is and will continue to be damaged by Opposer Karma Culture, LLC’s alleged Registration No. 4063528 for the mark KARMA and counterclaims for cancellation of said registration for fraud. As grounds for the Counterclaim, it is alleged that:

- 1) Registrant has alleged that it is the owner of Registration No. 4063528, issued on November 29, 2011, which issued from Application Serial No. 77024533, for the mark KARMA, based on use in commerce for goods in International Class 005, for: “dietary supplements in the nature of stimulants in liquid form made from botanicals, algae, spices, and herbs for use in restoring mental alertness, all for non-medicinal purposes,” and is based upon the allegation of use of the mark in commerce.
- 2) Applicant has standing to bring this counterclaim as a result of the Opposition filed by Opposer’s Opposition No. 91220284, in which Opposer pleaded ownership of the registration at issue, Registration No. 4063528, and alleged a likelihood of confusion with the mark INFUSED WITH GOOD KARMA in Application Serial No. 8624777.
- 3) Upon information and belief, the mark KARMA of Registration No. 4063528 was not, and is not, used in commerce by the Opposer in connection with the goods identified in Application Serial No. 77024533.
- 4) Upon information and belief, Registration No. 4063528 was improperly issued for the goods identified in Application Serial No. 77024533.
- 5) Upon information and belief, Applicant alleges that Application Serial No. 77024533, filed by the Opposer on October 19, 2006, which issued into Registration No. 4063528 on November 29, 2011, which application claims first use of mark on 09-02-2011 and first use of the mark in commerce on 09-02-2011, identified goods on which neither the Opposer or any company related to the Opposer was using the KARMA mark.
- 6) Upon information and belief, Applicant alleges that the application that resulted in Registration No. 4063528 had a declaration (statement of use) that was signed on September 6, 2011 by Katherine H. McGuire, attorney of record for Opposer.
- 7) Upon information and belief, Applicant alleges that Opposer signed the declaration of the application reciting the identification of goods that included articles on which the mark KARMA had not and was not being used with the knowledge of falsity of the

material representation that the mark was being used on all of the goods identified in the application, for the purpose of obtaining rights to which the Opposer was not entitled.

- 8) Specifically, Opposer was not using the mark KARMA on “dietary supplements in the nature of stimulants in liquid form made from botanicals, algae, spices, and herbs for use in restoring mental alertness, all for non-medicinal purposes,” on the date that the declaration (statement of use) was signed or at any prior date sufficiently close to the signing of the declaration to be a reasonable basis for a claim of use of the mark.
- 9) Opposer would not have received Registration No. 4063528 for the goods identified therein, but for the willful material misrepresentation in Application Serial No. 77024533.
- 10) Applicant accordingly alleges that the application that resulted in Registration No. 4063528 constituted a fraud on the U.S. Patent and Trademark Office.
- 11) GIVN Goods Inc. avers that it is damaged by the continued ownership by Karma Culture, LLC of Registration No. 4063528 because Karma Culture, LLC has opposed registration of GIVN Goods Inc.’s trademark INFUSED WITH GOOD KARMA based on asserted likelihood of confusion with the trademark of Registration No. 4063528 for goods identified therein.

WHEREFORE, Applicant respectfully requests that this Counterclaim/Petition to Cancel Opposer’s alleged Registration No. 4063528 for fraud be granted and that said registration relied upon by Opposer in this opposition proceeding be canceled.

This Counterclaim petitioning for cancellation on the grounds of fraud is submitted together with the statutory filing fee. Should any additional fee be required, please notify us accordingly.

COUNTERCLAIM II - CANCELLATION FOR ABANDONMENT

Applicant believes that it is and will continue to be damaged by Opposer Karma Culture, LLC's alleged Registration No. 4063528 for the mark KARMA and counterclaims for cancellation of said registration for abandonment. As grounds for the Counterclaim, it is alleged that:

- 1) Registrant has alleged that it is the owner of Registration No. 4063528, issued on November 29, 2011, which issued from Application Serial No. 77024533, for the mark KARMA, based on use in commerce for goods in International Class 005, for: "dietary supplements in the nature of stimulants in liquid form made from botanicals, algae, spices, and herbs for use in restoring mental alertness, all for non-medicinal purposes," and is based upon the allegation of use of the mark in commerce.
- 2) Applicant has standing to bring this counterclaim as a result of the Opposition filed by Opposer's Opposition No. 91220284, in which Opposer pleaded ownership of the registration at issue, Registration No. 4063528, and alleged a likelihood of confusion with the mark INFUSED WITH GOOD KARMA in Application Serial No. 8624777.
- 3) Upon information and belief, Applicant alleges that Application Serial No. 77024533, filed by the Opposer on October 19, 2006, which issued into Registration No. 4063528 on November 29, 2011, claims first use of mark on 09-02-2011 and first use of the mark in commerce on 09-02-2011.
- 4) Upon information and belief, Opposer is not using the mark KARMA in connection with "dietary supplements in the nature of stimulants in liquid form made from botanicals, algae, spices, and herbs for use in restoring mental alertness, all for non-medicinal purposes," nor has it used the mark on said goods for at least three consecutive years.
- 5) Upon information and belief, Opposer has no intention to use the mark KARMA in connection with "dietary supplements in the nature of stimulants in liquid form made

from botanicals, algae, spices, and herbs for use in restoring mental alertness, all for non-medicinal purposes.”

- 6) Upon information and belief, Opposer has abandoned the mark KARMA pleaded in Registration No. 4063528 in connection with “dietary supplements in the nature of stimulants in liquid form made from botanicals, algae, spices, and herbs for use in restoring mental alertness, all for non-medicinal purposes.”
- 7) GIVN Goods Inc. avers that it is damaged by the continued ownership by Karma Culture, LLC of Registration No. 4063528 because Karma Culture, LLC has opposed registration of GIVN Goods Inc.’s trademark INFUSED WITH GOOD KARMA based on asserted likelihood of confusion with the trademark of Registration No. 4063528 for goods identified therein.

WHEREFORE, Applicant respectfully request that this Counterclaim/Petition to Cancel Opposer’s alleged Registration No. 4063528 for abandonment be granted and that said registration relied upon by Opposer in this opposition proceeding be canceled.

This Counterclaim petitioning for cancellation on the grounds of abandonment is submitted together with the statutory filing fee. Should any additional fee be required, please notify us accordingly.

Dated: Atlanta, Georgia

February 27, 2015

Respectfully submitted,

/s/John Houseal

John Houseal, President
GIVN GOODS INC.
400 Perimeter Center Terrace. N.
Suite 900
Atlanta, Georgia 30319
Phone: 404-955-8095
john.houseal@givnbrands.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer to Opposition and Counterclaim has been served on the Opposer Karma Culture, LLC by mailing a copy of the same on February 24, 2015 via First Class Mail, postage prepaid to the owner of record of U.S. Trademark Registration No. 4063528 at the address for the party identified as "Current Owner" in the USPTO TSDR database:

Karma Culture, LLC.
P.O. Box 698
Mendon, New York 14506
United States

With a copy by first class mail, postage prepaid, to the opposing counsel and attorney for U.S. Trademark Registration No. 4063528:

Katherine H. McGuire, Esq.
Woods Oviatt Gilman LLP
2 State Street
700 Crossroads Building
Rochester, NY 14614

Executed in Atlanta, Georgia on February 24, 2015.

By_ /s/ John Houseal