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Filing date: **08/31/2015**

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

Proceeding	91222582
Party	Defendant Undies E-Commerce LLC
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Submission	Answer and Counterclaim
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Date	08/31/2015
Attachments	Answer to Notice of Opposition.pdf(341095 bytes)

Registration Subject to the filing

Registration No	4270721	Registration date	01/08/2013
International Re- gistration No.	NONE	International Re- gistration Date	NONE
Registrant	ETAM 57 - 59, rue Henri Barbusse 92110 Clichy, FRANCE		

Goods/Services Subject to the filing

<p>Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: (Based on 44(e)) Bags, namely, hand-bags, rucksacks, school bags, traveling bags, traveling trunks, shoe bags for travel and garment bags for travel; valises, traveling trunks, pocket wallets, purses, card cases, namely, calling card cases, credit card cases and name card cases; umbrellas, parasols and walking sticks</p>
<p>Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are requested, namely: (Based on 44(e)) Clothing, namely, frocks, coats, suits, pants, skirts, shirts, blouses, tee-shirts, waistcoats, pullovers, vests, shorts, gloves, stockings, socks, belts, scarves; night clothing, namely, pajamas, dressing gowns, night gowns; lingerie articles, namely, underwear, underpants, slippers, brassieres, breeches for wear; beach shoes; shoes except orthopedic shoes, headgear, namely, hats, caps, berets</p>

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

In the Matter of Application Serial No. 86296717
Published in the Official Gazette on May 5, 2015

undies.com

Mark:

ETAM,

Opposer,

v.

UNDIES E-COMMERCE LLC,

Applicant.

Opposition No. 91222582

**APPLICANT’S ANSWER TO AMENDED NOTICE OF OPPOSITION
AND COUNTERCLAIM TO CANCEL REGISTRATION NO. 4270721**

Applicant, Undies E-Commerce LLC (“Applicant”), by and through its attorneys, Oved & Oved LLP, upon information and belief, hereby answers Opposer’s, ETAM (“Opposer”), Amended Notice of Opposition, dated July 9, 2015 (the “Notice of Opposition”), as follows:


1. Denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 1 of the Notice of Opposition.
2. Admits the allegations set forth in paragraph 2 of the Notice of Opposition.
3. Denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 3 of the Notice of Opposition.
4. Denies the allegations set forth in paragraph 4 of the Notice of Opposition.

5. Admits the allegations set forth in paragraph 5 of the Notice of Opposition.
6. Denies the allegations set forth in paragraph 6 of the Notice of Opposition.
7. Denies the allegations set forth in paragraph 7 of the Notice of Opposition.
8. Denies the allegations set forth in paragraph 8 of the Notice of Opposition.
9. Denies knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 9 of the Notice of Opposition.
10. Denies the allegations set forth in paragraph 10 of the Notice of Opposition.
11. Makes no answer to the allegations set forth in paragraph 11 to the extent those allegations state legal conclusions rather than facts as the Mark speaks for itself. Applicant denies any remaining allegations set forth in paragraph 11 of the Notice of Opposition.
12. Makes no answer to the allegations set forth in paragraph 12 to the extent those allegations state legal conclusions rather than facts as the Mark speaks for itself. Applicant denies any remaining allegations set forth in paragraph 12 of the Notice of Opposition.
13. Makes no answer to the allegations set forth in paragraph 13 to the extent those allegations state legal conclusions rather than facts as the Mark speaks for itself. Applicant denies any remaining allegations set forth in paragraph 13 of the Notice of Opposition.
14. Denies the allegations set forth in paragraph 14 of the Notice of Opposition
15. Denies the allegations set forth in paragraph 15 of the Notice of Opposition.
16. Denies the allegations set forth in paragraph 16 of the Notice of Opposition.
17. Denies the allegations set forth in paragraph 17 of the Notice of Opposition.
18. Denies the allegations set forth in paragraph 10 of the Notice of Opposition.

19. Denies the allegations set forth in the “THEREFORE” clause and the preamble to the Notice of Opposition, and specifically denies that Opposer is entitled to any relief whatsoever.

AFFIRMATIVE DEFENSES

1. Opposer fails to state a claim upon which relief can be granted.
2. There is no likelihood of confusion, mistake or deception because Applicant’s

“undies.com” mark (the “Mark”) and the cited  trademark Registration No. 4270721 (the “Cited Trademark”) are not confusingly similar.

3. Confusion is not likely between the Mark and the Cited Trademark because the overall marks are readily distinguishable in appearance and projected connotations, the only similarities being the presence of the generic term, “undies” or its misspelling “UNDIZ,” incapable of creating a likelihood of confusion.

4. Opposer’s Cited Trademark is generic, descriptive and lacks secondary meaning and is in no way distinctive of Opposer’s goods.

5. Opposer’s Cited Trademark is invalid as descriptive and generic, and was procured by fraud by the submission of a trademark application under Section 44(e) when Opposer did not have a bona fide intention to use the Cited Trademark in connection with all of the goods listed in the application.

6. Opposer’s claims ignore the anti-dissection rule, in which a composite mark is tested for its validity and distinctiveness by looking at it as a whole rather than dissecting it into its component parts, and thus fail to state a claim upon which relief can be granted.

7. Applicant denies each and every allegation of the Notice of Opposition not specifically admitted or otherwise specifically responded to herein. Applicant denies that it has violated or infringed any rights of Opposer, has violated any laws or statutes, or has engaged in any acts that have damaged Opposer. Applicant denies that Opposer is entitled to any relief against Applicant.

8. Accordingly, consumers will not be confused by the registration of Applicant's Mark.

COUNTERCLAIMS

As and for its counterclaims against Opposer, Undies E-Commerce LLC, shows as follows:

1. Applicant/Counterclaim Petitioner, Undies E-Commerce LLC, a New York limited liability company, brings the following counterclaims against Opposer ETAM and hereby petitions for cancellation of the Cited Trademark.

2. Opposer has asserted the Cited Trademark against Applicant in the Notice of Opposition.

Count One

3. Opposer's Cited Trademark is a misspelling for the generic term "undies," slang for undergarments, and is therefore generic and merely descriptive of the goods upon which the Cited Trademark is used.

4. Opposer's use of its alleged Cited Trademark is insufficient to establish secondary meaning or acquired distinctiveness in said mark.

5. Inasmuch as the Cited Trademark, a misspelling for the generic term “undies,” slang for undergarments, is generic and is only used in connection with goods in the nature of undergarments, the Cited Trademark must be cancelled.

Count Two

6. Upon information and belief, Opposer has not used the Cited Trademark in connection with all of the goods listed in the Cited Trademark registration and has thus abandoned the Cited Trademark for such goods.

7. Upon information and belief, Opposer has not used the Cited Trademark in connection with any of the goods in International Class 18 listed in the Cited Trademark’s registration.

8. Opposer has not used and has abandoned the Cited Trademark in connection with the following goods:

- a. Class 18: Bags, namely, handbags, rucksacks, school bags, traveling bags, traveling trunks, shoe bags for travel and garment bags for travel; valises, traveling trunks, pocket wallets, purses, card cases, namely, calling card cases, credit card cases and name card cases; umbrellas, parasols and walking sticks.
- b. Class 25: Clothing, namely, frocks, coats, suits, skirts, blouses, waistcoats, vests, gloves, stockings, socks, belts, scarves; beach shoes; shoes except orthopedic shoes, headgear, namely, hats, caps, berets.

9. Opposer has abandoned the Cited Trademark and therefore the Board must cancel the Cited Trademark.

Count Three

10. Opposer, with the knowledge that the Cited Trademark is generic for undergarments, has deceived and misled the United States Patent and Trademark Office (“USPTO”) by filing the application for the Cited Trademark in connection with numerous clothing items and goods in International Class 18, which goods Opposer does not use with the mark, and did not have a bona fide intention to use with the mark, in order to deceive the USPTO that the Cited Trademark is not generic for its proposed use.

11. Additionally, Opposer has misused the Section 44(e) trademark application process, which forgoes the general Lanham Act requirement of submitting to the USPTO an affidavit supporting use of a mark in U.S. commerce, in order to obtain the trademark registration for the Cited Trademark in connection with goods it does not use, and did not have intention to use, and in order to inhibit competition by unfairly impeding other market participants from using the generic term “undies” for underwear, seizing for itself the exclusive right to use the word “undies” in connection with clothing, including undergarments.

12. Upon information and belief, Opposer has committed a fraud on the USPTO because it lacked a bona fide intent to use the Cited Trademark in connection with each and every good listed in the application for the Cited Trademark. Accordingly, the entire registration for the Cited Trademark must be deemed void *ab initio*.

13. In addition, in the February 21, 2012 Office Action for the Cited Trademark, the USPTO Examining Attorney requested that Opposer must “specify whether ‘UNDIZ’ in the mark has any meaning in a foreign language.” Due to Opposer’s fraud, deceit and misuse of Section 44(e), the USPTO Examiner was unaware that the word “UNDIZ” was a misspelling of the generic term, in the English language, for undergarments, the only goods which Opposer intended to use in connection with the mark.

14. By filing and prosecuting the Notice of Opposition, Opposer has shown its intention to unfairly inhibit marketplace competition by preventing, and maliciously prosecuting, market participants, such as Applicant, that use the generic term “undies” in connection with underwear.

15. The USPTO has improperly granted the Cited Trademark and must cancel the Cited Trademark.

WHEREFORE, Applicant respectfully requests that this Opposition No. 91222582 be dismissed with prejudice and Applicant/Cancellation Petitioner also respectfully requests the Cited Trademark, U.S. Registration No. 4270721, be canceled.

Dated: August 31, 2015
New York, New York

Respectfully submitted,

/David Yedid/
David Yedid, Esq.
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CERTIFICATE OF SERVICE

I hereby certify that on August 31, 2015, I served Applicant's Answer to Amended Notice of Opposition And Counterclaim to Cancel Registration No. 4270721 on Opposer's counsel via First Class Mail, with postage paid thereon, to the following address:

Dean R. Karau, Esq.
Fredrikson & Byron PA
200 South Sixth Street , Suite 4000
Minneapolis, MN 55402-1425

/David Yedid/
David Yedid, Esq.