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

Proceeding	91222582
Party	Plaintiff ETAM
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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ETAM,

Opposer,

Opposition No. 91222582

v.

Undies E-Commerce LLC,

Applicant,

and

Undies E-Commerce LLC,

Counterclaim-Petitioner,

v.

ETAM,

Counterclaim-Registrant.

REPLY TO COUNTERCLAIMS




Counterclaim-Registrant, ETAM, for its answer to the Counterclaims filed by Counterclaim-Petitioner, Undies E-Commerce LLC, states and alleges as follows:


1. With respect to Paragraph 1 of the Counterclaims, Counterclaim-Registrant states that there are no allegations requiring a reply, but to the extent there are, Counterclaim-Registrant denies them.



2. With respect to the allegations contained in Paragraph 2 of the Counterclaims, Counterclaim-Registrant states that it has alleged that use by Counterclaim-Petitioner of undies.com for which registration is sought is likely to cause confusion, mistake or deception as to

the source of origin, sponsorship or approval of Counterclaim-Petitioner's goods in that purchasers or others are likely to believe that Counterclaim-Petitioner's goods are Counterclaim-Registrant's, or are in some way legitimately connected with, licensed by, or approved by Counterclaim-Registrant, and that use by Counterclaim-Petitioner of undies.com for which registration is sought has lessened, and will continue to lessen, the capacity of Counterclaim-Registrant's mark to identify and distinguish goods made by Counterclaim-Registrant, and Counterclaim-Registrant denies the remaining allegations contained in Paragraph 2 of the Counterclaims.

Count One

3. With respect to the allegations contained in Paragraph 3 of the Counterclaims, Counterclaim-Registrant denies that  is a misspelling for the term "undies," that  is generic and merely descriptive of the goods upon which  is used, and denies all remaining allegations contained in Paragraph 3 of the Counterclaims.

4. With respect to the allegations contained in Paragraph 4 of the Counterclaims, Counterclaim-Registrant affirmatively states that  is an inherently distinctive mark and denies all remaining allegations contained in Paragraph 4 of the Counterclaims.

5. With respect to the allegations contained in Paragraph 5 of the Counterclaims, Counterclaim-Registrant denies that  is a misspelling for the term "undies," that  is generic, and denies all remaining allegations contained in Paragraph 5.

Count Two

6. With respect to the allegations contained in Paragraph 6 of the Counterclaims, Counterclaim-Registrant states that under 15 U.S.C. §1126(e) and 37 C.F.R. §2.34(a)(3), the requirements for establishing a basis for registration of a trademark or service mark under §44(e)


do not include use in commerce, and Counterclaim-Registrant denies the remaining allegations contained in Paragraph 6 of the Counterclaims.


7. With respect to the allegations contained in Paragraph 7 of the Counterclaims, Counterclaim-Registrant states that under 15 U.S.C. §1126(e) and 37 C.F.R. §2.34(a)(3), the requirements for establishing a basis for registration of a trademark or service mark under §44(e) do not include use in commerce, and Counterclaim-Registrant denies the remaining allegations contained in Paragraph 7 of the Counterclaims.

8. With respect to the allegations contained in Paragraph 8 of the Counterclaims, Counterclaim-Registrant states that under 15 U.S.C. §1126(e) and 37 C.F.R. §2.34(a)(3), the requirements for establishing a basis for registration of a trademark or service mark under §44(e) do not include use in commerce, and Counterclaim-Registrant denies the remaining allegations contained in Paragraph 8 of the Counterclaims.

9. Counterclaim-Registrant denies the allegations contained in Paragraph 9 of the Counterclaims.

Count Three

10. With respect to the allegations contained in Paragraph 10, Counterclaim-Registrant affirmatively states that  is an inherently distinctive mark, and denies all remaining allegations contained in Paragraph 10 of the Counterclaims.

11. With respect to the allegations contained in Paragraph 11, Counterclaim-Registrant affirmatively states that  is an inherently distinctive mark, and denies all remaining allegations contained in Paragraph 11 of the Counterclaims.

12. Counterclaim-Registrant denies the allegations contained in Paragraph 12 of the Counterclaims.

13. With respect to the allegations contained in Paragraph 13, Counterclaim-Registrant admits only that the USPTO Examining Attorney asked Counterclaim-Registrant to specify whether “UNDIZ” in the mark has any meaning in a foreign language, and Counterclaim-Registrant denies the remaining allegations contained in Paragraph 13 of the Counterclaims.


14. Counterclaim-Registrant denies the allegations contained in Paragraph 14 of the Counterclaims.

15. Counterclaim-Registrant denies the allegations contained in Paragraph 15 of the Counterclaims.

16. Except as expressly admitted or otherwise answered, Counterclaim-Registrant denies each and every allegation contained in the Counterclaims.

Separate Defenses

1. Counterclaim-Petitioner has failed to state a claim for which relief may be granted.

2. Counterclaim-Petitioner’s counterclaim that  is generic or merely descriptive is without factual or legal support.

3. Counterclaim-Petitioner’s fraud-based counterclaims, including the allegation that the registration should be deemed void *ab initio*, are without factual or legal support.

WHEREFORE, Counterclaim-Registrant respectfully requests the Board to dismiss the Counterclaims with prejudice.

