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

Proceeding	91227576
Party	Defendant Pure Fishing, Inc.
Correspondence Address	Julie C. VanDerZanden Pure Fishing, Inc. 4201 6th Avenue South Seattle, WA 98108  trademarks@jarden.com
Submission	Answer
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Date	06/06/2016
Attachments	EPIC-Answer.pdf(105135 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Swift Fly Fishing,	]	
Opposer,	]	Opp. No. 91227576
v.	]	
Pure Fishing, Inc.,	]	Ser. No. 86/006,682
Applicant.	]	

**ANSWER AND AFFIRMATIVE DEFENSES**

In response to the Notice of Opposition, Applicant Pure Fishing, Inc., hereby responds as follows:

1. Applicant is without sufficient information to admit or deny this allegation and therefore denies the allegation.
2. Applicant is without sufficient information to admit or deny this allegation and therefore denies the allegation.
3. Admitted.
4. Admitted.
5. Admitted.
6. Admitted.
7. Denied.
8. Denied.
9. Applicant admits that it is the owner of US Reg. No. 2,062,238 for EPIC on “fishing reels” and denies all other allegations.
10. Denied.

**AFFIRMATIVE DEFENSES**

Applicant asserts that the following facts and defenses bar Opposer’s request for relief in the Notice of Opposition.

**STATEMENT OF PERTINENT FACTS**

11. Applicant is the owner of Registration Number 2,062,238 for the mark EPIC on “fishing reels”.

12. Applicant's combined Section 8 Declaration and Section 9 Renewal for the EPIC fishing reel mark was filed and accepted in 2007. Applicant's Reg. No. 2,062,238 remains valid and subsisting on the principal register.
13. Applicant was selling and offering for sale the goods recited in the EPIC fishing reel registration continuously up to at least 2011. In 2012 and 2013, Applicant temporarily scaled back its uses of that mark in connection with a planned a "reboot" of the product line. Applicant engaged in product re-design and development and a revised marketing strategy, and began taking orders in 2013, resulting in substantial sales of EPIC fishing reels in early 2014.
14. On 8 May 2013, Opposer filed a petition for cancellation against Applicant's Reg. No. 2,062,238 for EPIC on "fishing reels" years after Applicant's Section 8 and 9 had been accepted. That petition was given cancellation no. 92057198 (the "2013 Cancellation").
15. Applicant denied the material allegations of the 2013 cancellation petition and raised the defense that it had not discontinued use of the registered mark with an intent not to resume use and that applicant had not abandoned the mark so as to make the EPIC registration subject to cancellation.
16. Opposer failed to prosecute the cancellation action. Prior to the pretrial disclosure deadline of June 4, 2014, Opposer made no pretrial disclosures. Prior to the end of Opposer's 30 day trial period on July 19, 2014, Opposer had not taken any trial testimony, had not submitted any notices of reliance, and otherwise had not offered evidence. At no time did Petitioner request additional time for taking testimony or receive any additional time.
17. Applicant moved for involuntary dismissal under 37 CFR 2.132(a) (failure to prosecute) and, in the alternative, under 37 CFR 2.132(b) (failure to establish right to relief).
18. Opposer did not respond to the motion for involuntary dismissal.
19. The Board granted applicant's motion for involuntary dismissal on 26 August 2014, terminating the 2013 Cancellation with prejudice.

20. Since 2014, Applicant's business associated with the EPIC mark has grown and expanded into goods that are used in fishing with or in combination with fishing reels, e.g., fishing tackle attached to fishing lines wound onto a fishing reel that are used to cast a fishing lure.
21. Fishing reels and fishing rods are commonly used together and represent related goods for purposes of determining likelihood of confusion.
22. Fishing reels and fishing tackle are commonly used together and represent related goods for purposes of determining likelihood of confusion.

#### **First Affirmative Defense**

23. Opposer fails to state a sufficient claim upon which relief can be granted in light of its inability to seek cancellation of Applicant's incontestable EPIC mark on fishing reels, the subsistence of that registration on the principal register, the relation of the goods listed in that registration to the goods listed in Applicant's opposed application, and the failure to identify any form of damage it might sustain due to registration of Applicant's opposed mark.

#### **Second Affirmative Defense**

24. As a result of the dismissal with prejudice of the 2013 Cancellation, Opposer is precluded from challenging Applicant's priority of use, right to use, and validity of use of EPIC for fishing reels and related goods.
25. Opposer is thus precluded from asserting any earlier date of use for an EPIC mark on any goods related to fishing reels, e.g., fishing tackle, so as to prevent registration of the current application.

#### **Third Affirmative Defense**

26. Applicant has been using the Mark and developing consumer recognition and goodwill therein since at least April 1, 1995, such use being open, notorious and known to Opposer and such knowledge, in turn, being known to Applicant.

27. From 1995 to the filing of the 2013 Cancellation, Opposer failed to take meaningful action to assert the claims on which it bases this Opposition and then failed to prosecute its petition for cancellation which resulted in an involuntary dismissal with prejudice.
28. Applicant has relied on Opposer's inaction to its detriment.
29. Opposer's claims are consequently barred by the doctrines of laches, acquiescence and estoppel.

#### **Fourth Affirmative Defense**

30. As a matter of law, Opposer cannot be damaged within the meaning of 15 USC § 1063(a) by the issuance to Applicant of a second registration where Applicant already has an existing registration of the same mark for the same and substantially similar goods.
31. As a result of the adverse decision in the 2013 Cancellation, Opposer cannot procure the cancellation of the existing EPIC registration for fishing reels so it cannot prevent the granting of a second registration for fishing reels. See *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969) (that defendant already owns a substantially similar registered mark for substantially similar goods and/or services such that the second registration (or second registration sought) causes no added injury to the plaintiff).

WHEREFORE, Applicant prays as follows:

- (a) that this opposition be dismissed; and
- (b) that a registration for the mark EPIC on “fishing reels; fishing tackle” be issued to the Applicant.

For Applicant:

/Lance G. Johnson/

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**CERTIFICATE OF SERVICE**

*I hereby certify that a true and complete copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES has been served on counsel listed below by transmitting said copy by email, per agreement of counsel, on the date noted below to:*

*Patrick J. Jennings  
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**CERTIFICATE OF ELECTRONIC FILING**

*The undersigned certifies that this submission (along with any paper referred to as being attached or enclosed) was filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on the dated noted below.*

*Signature: /Lance G. Johnson/*

*Date: June 6, 2016*