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

Proceeding	91229200
Party	Defendant SJM Partners, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Ganz,

Opposer,

Opposition No. 91229200

v.

SJM Partners, Inc.,

Applicant.

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant SJM Partners, Inc. (“Applicant”) responds to the Notice of Opposition filed by Opposer Ganz (“Ganz”) as follows:

1. Applicant admits, on information and belief, that U.S. Trademark Registration No. 2,554,518, claiming the mark GOOGLES for “plush toys,” is owned by Ganz. Applicant lacks knowledge or information sufficient to form a belief about the truth of the remaining allegations contained in Paragraph 1 of the Notice of Opposition.

2. Applicant admits the allegations contained in Paragraph 2 of the Notice of Opposition.

3. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 3 of the Notice of Opposition.

4. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 4 of the Notice of Opposition.

5. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 5 of the Notice of Opposition.

6. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 6 of the Notice of Opposition.

7. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 7 of the Notice of Opposition.

8. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 8 of the Notice of Opposition.

9. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 9 of the Notice of Opposition.

10. Applicant admits, on information and belief, that the trademark application that matured into U.S. Trademark Registration No. 2,554,518 was filed on October 19, 1998. Except as admitted, Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 10 of the Notice of Opposition.

11. Applicant admits, on information and belief, that the trademark application that matured into U.S. Trademark Registration No. 2,554,518 was published for opposition on January 8, 2002. Except as admitted, Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations contained in the first sentence of Paragraph 12 of the Notice of Opposition. Applicant admits, on information and belief, the allegations contained in the first sentence of Paragraph 12 of the Notice of Opposition.

13. Applicant denies the allegations contained in Paragraph 13 of the Notice of Opposition.

14. Applicant admits the allegations contained in Paragraph 14 of the Notice of Opposition.

15. Applicant denies the allegations contained in Paragraph 15 of the Notice of Opposition.

16. Applicant denies the allegations contained in Paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations contained in Paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations contained in the first sentence of Paragraph 18 of the Notice of Opposition. Applicant admits it filed Application Serial No. 86/052,534 after the registration date of U.S. Trademark Reg. No. 2,554,518. Except as specifically admitted, applicant lacks knowledge of information sufficient to form a belief about the truth of the remaining allegations contained in Paragraph 18 of the Notice of Opposition.

CLAIM I - LIKELIHOOD OF CONFUSION

19. Applicant incorporates by reference each of its responses to Paragraphs 1 through 18.

20. Applicant denies the allegations contained in Paragraph 20 of the Notice of Opposition.

21. Applicant admits that if it obtains a registration on the Principal Register of the mark applied for in Application Serial No. 86/052,534, that registration will constitute prima facie evidence of Applicant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, pursuant to 15 U.S.C. § 33(a). Applicant denies the remaining allegations contained in Paragraph 21 of the Notice of Opposition.

CLAIM II - ANTICIPATED BREACH OF CONTRACT

22. Applicant incorporates by reference each of its responses to Paragraphs 1 through 21.

23. Applicant admits that in 2001 Ganz and Applicant's predecessors Steven A. Silvers and The Googles Children's Workshop entered into an agreement, a copy is attached to the Notice of Opposition as Exhibit D (hereinafter the "Agreement"), and refers the Board to the Agreement. Except as admitted, Applicant denies the allegations contained in Paragraph 23 of the Notice of Opposition.

24. Applicant admits that Section 1.7 of the Agreement states, "Ganz believes that as long as Silvers uses the Silvers' Mark at all time with the design configuration as reflected in Application No. 75/547,007, there will be no likelihood of confusion in the market place as it

pertains to Ganz's line of GOOGLES plush toys." Except as admitted, Applicant denies the allegations contained in Paragraph 24 of the Notice of Opposition.

25. Applicant admits that Section 2.1 of the Agreement states:

2.1 Silvers shall have the right to use the Silvers' Mark in connection with the extraterrestrial character depicted in Exhibit A to this Agreement, and subject to the following:

- (a) Silvers shall expressly abandon Serial No. 75/547,007 and not seek to register at either the federal or the state level any mark containing, or confusingly similar to, "GOGGLES" for PLUSH TOYS, but Silvers will not abandon any other "Googles" marks he holds or will hold in the future that relate to goods other than plush toys.
- (b) Silvers shall not use the GOGGLES word on or in connection with any product, image or character without also using the character depicted in Exhibit A to this Agreement. If there is not room for the design portion of the Silvers' Mark along with the term "Googles," Silvers may use the word only, so long as use is not made in connection with a plush toy.
- (c) Silvers shall never manufacture, distribute, market and/or sell any characters that resemble Ganz's current line of plush toys, or such plush toys that Ganz may add to the GOOGLES line in the future.
- (d) Silvers and/or any assigns, persons; corporation(s), entities, heirs or legal representatives that Silvers designates to use the Silvers' Mark may use the Silvers' Mark on any such items that shall be marketed and distributed by Silvers, or by any other such designated entity of his or his assigns, heirs, or legal representatives, as long as the Silvers' Mark is used with the design logo and not just the word mark "Googles," except as set forth herein.
- (e) Except as otherwise specified in this Agreement, Silvers is not prevented from creating other aliens or alien-themed merchandise utilizing the Silvers' Mark. Silvers may continue to use the terms "The Googles Family," "The Googles from Goo," "Googles.com" and any other terms currently being used or created for the alien-themed property and merchandise. Silvers may use the term "Googles" for purposes such as titles to books, movies, features, music, music titles and web sites relating to the alien-themed property.

Except as admitted, Applicant denies the allegations contained in Paragraph 25 of the Notice of Opposition.

26. Applicant admits that Section 2.1(a) of the Agreement has the text set forth above in response to Paragraph 25 of the Notice of Opposition. Except as admitted, Applicant denies the allegations contained in Paragraph 26 of the Notice of Opposition.

27. Applicant admits that Section 2.1(b) of the Agreement has the text set forth above in response to Paragraph 25 of the Notice of Opposition. Except as admitted, Applicant denies the allegations contained in Paragraph 27 of the Notice of Opposition.

28. Applicant admits that Section 2.1(e) of the Agreement has the text set forth above in response to Paragraph 25 of the Notice of Opposition. Except as admitted, Applicant denies the allegations contained in Paragraph 28 of the Notice of Opposition.

29. Applicant admits that Section 2.3(b) of the Agreement has the phrase quoted in Paragraph 29 of the Notice of Opposition, denies that is a complete quotation of Section 2.3(b) of that Agreement, and otherwise denies all allegations contained in Paragraph 29 of the Notice of Opposition.

30. Applicant denies the allegations contained in Paragraph 30 of the Notice of Opposition.

CLAIM III - FRAUD

31. Applicant incorporates by reference each of its responses to Paragraphs 1 through 30.

32. Applicant admits the allegations contained in Paragraph 32 of the Notice of Opposition.

33. Applicant admits that the statement quoted in Paragraph 32 of the Notice of Opposition was submitted by Applicant to overcome a Section 2(d) refusal based in part on U.S. Trademark Registration No. 2,554,518. Applicant lacks knowledge or information sufficient to form a belief about the truth of the remaining allegations contained in Paragraph 33 of the Notice of Opposition.

34. Applicant denies the allegations contained in Paragraph 34 of the Notice of Opposition.

35. In response to the first sentence of Paragraph 35 of the Notice of Opposition, Applicant refers the Board to the Agreement, and denies all allegations of the first sentence of Paragraph 35 of the Notice of Opposition that are inconsistent with the Agreement. Applicant lacks knowledge or information sufficient to form a belief as to any undertakings made by Ganz outside the Agreement. Applicant admits that Section 3.7 of the Agreement states, “This constitutes the full and complete Agreement between the parties, and there are no other Agreements or understandings collateral or ancillary to this Agreement. This Agreement can be modified only by writing executed by each of the parties hereto.” Except as admitted, denies all allegations of Paragraph 35 of the Notice of Opposition.

36. Applicant admits that Section 2.3 of the Agreement states:

2.3 Ganz shall have the right to use the Ganz Mark subject to the following:

- (a) Ganz shall not use the Ganz Mark in connection with extraterrestrial characters and shall never manufacture, distribute, market and/or sell any characters that resemble Silvers’ current line of plush toy aliens that are similar to Silvers’ character known as “Googles” and which can be seen at Silvers’ web site at www.googles.com, or such alien-themed plush toys that Silvers may add to the alien line in the future.
- (b) Ganz shall have the unlimited right to use and register the mark “GOOGLES” on any and all goods and services, provided that such use or registration is otherwise in accordance with this Agreement. Ganz shall have the right to use and register the mark “GOOGLES” as a word mark and in conjunction with a design, so long as the design is not confusingly similar to the design logo used in Silvers’ Mark.

Except as admitted, Applicant denies the allegations contained in Paragraph 36 of the Notice of Opposition.

37. Applicant denies the allegations contained in Paragraph 37 of the Notice of Opposition.

38. Applicant denies the allegations contained in Paragraph 38 of the Notice of Opposition.

39. Applicant was not aware of Ganz or the Agreement when it filed Application Serial No. 86/052,534 nor when it submitted its June 16, 2014 response to an office action, had no reason to “verify that Ganz was no longer using the GOOGLES mark in connection with plush toys,” and did not do so. Except as admitted, Applicant denies the allegations contained in Paragraph 39 of the Notice of Opposition.

40. Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations contained in Paragraph 40 of the Notice of Opposition.

41. Applicant was not aware of Ganz or the Agreement when it filed Application Serial No. 86/052,534 nor when it submitted its June 16, 2014 response to an office action, had no reason to perform an internet search for the words Ganz and Googles, but cannot recall now, more than two years later, what internet searches it performed in June 2014. Except as admitted, Applicant denies the allegations contained in Paragraph 41 of the Notice of Opposition.

42. Applicant was not aware of Ganz or the Agreement when it filed Application Serial No. 86/052,534 nor when it submitted its June 16, 2014 response to an office action, denies that even if it had been aware of the Agreement it would have had reason to “contact Ganz or its counsel to determine if the GOOGLES mark was still being used by Ganz”, and admits that it did not contact Ganz or its counsel on or before June 16, 2014. Except as admitted, Applicant denies the allegations contained in Paragraph 42 of the Notice of Opposition.

43. Applicant denies that it knew of the Agreement before its June 16, 2014 response to an office action and admits that it did not review the Agreement before making that response. Except as admitted, Applicant denies the allegations contained in Paragraph 43 of the Notice of Opposition.

44. Applicant denies the allegations contained in Paragraph 44 of the Notice of Opposition.

45. Applicant denies the allegations contained in Paragraph 45 of the Notice of Opposition.

46. Applicant denies the allegations contained in Paragraph 46 of the Notice of Opposition.

47. Applicant denies the allegations contained in Paragraph 47 of the Notice of Opposition.

WHEREFORE, Applicant submits that Opposer will not be injured or damaged by registration of the mark claimed by Application Serial No. 86/052,534 and therefore respectfully requests that the Notice of Opposition be dismissed and judgment be entered in favor of Applicant.

DATED this 6th day of September, 2016.

Davis Wright Tremaine LLP
Attorneys for SJM Partners, Inc.

By s/Stuart R. Dunwoody
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CERTIFICATE OF SERVICE

I hereby certify a true and complete copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION has been served on the Attorney of Record for Opposer by mailing said copy on September 6, 2016, via First Class Mail, postage prepared to:

Deborah A. Wilcox
Shannon V. McCue
Baker & Hostetler LLP
Key Tower, Suite 2000
127 Public Square
Cleveland, OH 44114-1214

Date: September 6, 2016

s/Stuart R. Dunwoody