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

Proceeding	91230738
Party	Defendant Indio Products, Inc.
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Date	01/30/2017
Attachments	Answer to NOO.pdf(266265 bytes)

3. Opposer has used the words BREAK UP (“Opposer’s Mark”) in interstate commerce in the United States continuously since before the year 1990 in connection with the manufacture, distribution, provision, sale, marketing, advertising and promotion of mystical candles.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph and, therefore, denies them.

4. Exhibit 1 (attached hereto and made a part hereof for all purposes) is a screen capture of Opposer’s website showing use of the Opposer’s Mark in connection with mystical candles.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph and, therefore, denies them.

5. The goods Opposer offers under the Opposer’s Mark are of high quality mystical candles in glass vessels. The user purchases and lights the candle to activate the mystical “spell” associated with the candle.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph and, therefore, denies them.

FIRST GROUND FOR OPPOSITION - GENERICNESS

6. The Applicant’s Mark is barred from registration because it consists of words which, when used in connection with the alleged goods of Applicant, are incapable of distinguishing the source of the goods pursuant to 15 U.S.C. §1052.

ANSWER: Denied.

7. The relevant category of goods is “separar” or “break up” mystical candles.

ANSWER: Denied.

8. The relevant public, here, the hoodoo or esoterica communities (such as the Santefia community), primarily understands the Mark as referring to that category of goods.

ANSWER: Denied.

9. The words comprising the Mark provide a common name for the goods with which Applicant associates the Mark. In particular, the words “break up” and “separar” in this context commonly refer to a mystical formula said to be embodied in such goods. Lighting a “break up” candle is believed to separate two people.

ANSWER: Denied.

10. Registration of Applicant’s Mark on the Class 004 goods set forth in Appln. No. 86960137, will restrict Opposer Reed’s ability to use Opposer’s Mark to properly identify Opposer Reed’s goods, thereby damaging Opposer Reed.

ANSWER: Denied.

SECOND GROUND FOR OPPOSITION - DESCRIPTIVENESS

11. In the alternative, the Applicant’s Mark is barred from registration because it consists of words that describe and provide the function or purpose of the goods within the meaning of 15 U.S.C. §1052(e).

ANSWER: Denied.

12. Applicant's candle goods use the Applicant's Mark to explain and provide the function or purpose of the candle, namely, the mystical "spell" that use of the candle will activate.

ANSWER: Denied.

13. The term "break up" refers to a "spell" commonly attached to a candle or other item of mysticism (also known as hoodoo or esoterica) such as incense, crystal, and bath salts. The purpose of lighting a "break-up" candle is to separate two people.

ANSWER: Denied.

14. The term BREAK UP often accompanies the term SEPARAR on the same candle. "Separar" means "to separate" in Spanish and refers to the same spell.

ANSWER: Applicant admits that "Separar" translates to "separate." Applicant denies the remaining allegations in this paragraph.

15. Registration of Applicant's Mark on the Class 004 goods set forth in Appln. No. 86960137 will restrict Opposer Reed's ability to use Opposer's Mark descriptively in its business, thereby damaging Opposer Reed.

ANSWER: Denied.

THIRD GROUND FOR OPPOSITION – LIKELIHOOD OF CONFUSION

16. In the alternative, the Applicant's Mark is barred from registration because it consists of or comprises a mark which so resembles Opposer's Mark as to be likely, when used in connection

with the alleged goods of Applicant, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

ANSWER: Denied.

17. Opposer has expended substantial time, money and resources marketing, advertising, and promoting the goods sold under the Opposer's Mark including through trade shows, distributors and retail stores throughout the United States.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph and, therefore, denies them.

18. As a result of its widespread and continuous use of the Opposer's Mark to identify certain of its mystical candles and Opposer as their source, Opposer owns valid and subsisting common law rights to the Opposer's Mark.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph and, therefore, denies them.

19. Applicant allegedly began using the Applicant's Mark on January 1, 1992, several years after Opposer began using Opposer's Mark.

ANSWER: Applicant admits that it began using Applicant's Mark at least as early as January 1, 1992. Applicant lacks knowledge or information sufficient to form a belief about the truth of the remaining allegations in this paragraph and, therefore, denies them.

20. Opposer's Mark has priority over Applicant's Mark throughout the United States because Opposer's use date predates the Applicant's filing date, alleged date of first use, and/or any other date on which the Applicant may rely for purposes of priority.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph and, therefore, denies them.

21. Applicant's Mark is identical or nearly identical to Opposer's Mark. Both consist of the words BREAK UP, though the font or degree of stylization may vary.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph and, therefore, denies them.

22. The Class 004 goods on which Applicant claims it has used in conjunction with Applicant's Marks include and are used for the same purposes, and are or will be advertised and promoted to and directed at the same trade channels, the same purchasers, and or will be used in the same environment as Opposer Reed's goods. Opposer and Applicant both make and sell mystical candles in glass vessels.

ANSWER: Applicant lacks knowledge or information sufficient to form a belief about the truth of the allegations in this paragraph and, therefore, denies them.

23. Simultaneous use of Applicant's Marks in the Class 004 goods set forth in Appln. No. 86960137 and Opposer Reed's Mark on its goods, as set forth above, is likely to cause confusion, mistake or deception among purchasers, users, and the public, thereby damaging Opposer.

ANSWER: Denied.

24. As set forth above, Applicant's Mark is likely to cause confusion with Opposer's prior SEPARAR Mark, in violation of §2(d) of the Trademark Act, 15 U.S.C. §1052(d).

ANSWER: Denied.

AFFIRMATIVE DEFENSES

Indio asserts the following affirmative defenses:

FIRST AFFIRMATIVE DEFENSE

Opposer has failed to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Opposer's claims are barred by the doctrine of laches.

THIRD AFFIRMATIVE DEFENSE

Opposer's claims are barred by the doctrines of waiver, estoppel and acquiescence.

Applicant reserves the right to assert further affirmative defenses as they become known or available.

Respectfully submitted,

BROOKS KUSHMAN P.C.

/s/ Chanille Carswell
Chanille Carswell
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Date: January 30, 2017

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CERTIFICATE OF SERVICE

I certify that I served:

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

on January 30, 2017 by:

_____ delivering

 X email

a copy to counsel of record for Opposer:

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