

ESTTA Tracking number: **ESTTA807273**

Filing date: **03/15/2017**

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

Proceeding	91232631
Party	Defendant South Shore Slag LLC
Correspondence Address	DAVID G. OBERDICK MEYER, UNKOVIC & SCOTT LLP 535 SMITHFIELD STREET SUITE 1300 PITTSBURGH, PA 15222 dgo@muslaw.com, tma@muslaw.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	David G. Oberdick
Filer's e-mail	dgo@muslaw.com, tma@muslaw.com
Signature	/David G. Oberdick/
Date	03/15/2017
Attachments	Beemsterboer_VitraSparAmendedAnswerOpp.pdf(100451 bytes)

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

ECZACIBASI HOLDING ANONIM SIRKETI,)	Opposition No. 91232631
)	
Opposer,)	Application No. 87/027,240
)	
v.)	Mark: VITRASPAR
)	<i>ELECTRONICALLY FILED</i>
SOUTH SHORE SLAG LLC,)	
)	
Applicant.)	

AMENDED ANSWER TO NOTICE OF OPPOSITION

South Shore Slag LLC (“Applicant”), by and through its attorneys, hereby responds to the individually numbered paragraphs of the Notice of Opposition filed by Eczacibasi Holding Anonim Sirketi (“Opposer”) before the Trademark Trial and Appeal Board as follows:

1. Opposer’s assertion of ownership in Paragraph 1 of the Notice of Opposition states a conclusion of law to which no responsive pleadings is required. The remaining allegations of Paragraph 1 are denied to the extent they seek to interpret or summarize the referenced registration, which is in writing and speaks for itself.

2. Opposer’s assertion of ownership in Paragraph 2 of the Notice of Opposition states a conclusion of law to which no responsive pleadings is required. The remaining allegations of Paragraph 2 are denied to the extent they seek to interpret or summarize the referenced registration, which is in writing and speaks for itself.

3. Paragraph 3 of the Notice of Opposition provides a defined term, to which no responsive pleading is required.

4. The allegations in Paragraph 4 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

5. Admitted.

6. The allegations in Paragraph 6 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

7. The allegations in Paragraph 7 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

8. The allegations in Paragraph 8 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

9. The allegations in Paragraph 9 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

10. The allegations in Paragraph 10 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

11. The allegations in Paragraph 11 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

12. The allegations in Paragraph 12 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

13. The allegations in Paragraph 13 of the Notice of Opposition state conclusions of law to which no responsive pleadings is required. To the extent that a response is required, the allegations are denied.

AFFIRMATIVE DEFENSES

1. The Notice of Opposition is barred by the doctrines of estoppel, waiver and estoppel, acquiescence, and laches.

2. The Notice of Opposition is also barred by Opposer's failure to oppose prior and current third party applications that incorporate the term "Vitra."

3. The Notice of Opposition is additionally barred by Opposer's failure to oppose and/or prosecute claims of infringement by third parties for the use of the term "Vitra."

4. The Notice of Opposition is barred because Opposer's cited registrations were obtained improperly through fraud and/or mistake and are invalid.

5. Opposer is barred from opposing Applicant's VITRASPARE application due to unclean hands.

6. The Notice of Opposition is barred because Opposer has not used and/or has abandoned use the Opposer's cited marks with all or a portion of the goods and services listed and identified with the marks.

7. Applicant reserves all rights to assert additional affirmative defenses based upon information learned during discovery in this matter.

AFFIRMATIVE PLEADINGS PURSUANT TO TTAB RULE 311.02(d)

1. The goods identified with and listed under Opposer's referenced U.S. Registration Nos. 4,541,211 and 4,523,929 for VITRA marks are unrelated to the goods identified with and listed under Applicant's Application Serial No. 87/027,240 for the VITRASPAN mark, and there is no overlap in the trade channels, industries, and/or markets for goods/services associated with the respective marks.

2. The parties' respective marks do not create a similar impression in the minds of consumers.

3. The parties' respective marks are not visually and aurally similar.

4. Applicant's VITRASPAN mark is not likely to cause confusion, mistake, or deception in the trade or among purchasers as to the source, origin or sponsorship of the parties' respective goods and services.

5. Applicant's VITRASPAN mark does not falsely suggest a connection with Opposer's cited marks. The public is not likely to associate the goods/services of Applicant with Opposer's goods/services, and the public is not likely to believe that Applicant's goods/services are sponsored, endorsed, or licensed by Opposer, or that there is some relationship between Opposer and Applicant.

6. There is no actual confusion between Applicant's VITRASPAN mark and the Opposer's cited marks.

7. Opposer has not established goodwill in its cited marks. The public does not associate the Opposer's marks with Opposer's goods and services, and the public does not know the Opposer's cited marks as an indicator of goods and services that originate from Opposer.

8. Opposer's cited marks are not famous marks.
9. Opposer has suffered no damage or injury as a result of Applicant's VITRASPAR mark and/or Applicant's use of this mark.

WHEREFORE, Applicant respectfully requests that Opposer's Notice of Opposition be dismissed with prejudice, and for such other relief as the Board deems just and proper.

Respectfully submitted,

Dated: March 15, 2017

/s/ David G. Oberdick
David G. Oberdick, Esquire
Pa. I.D. No. 47648

Meyer, Unkovic & Scott LLP
535 Smithfield Street, Suite 1300
Pittsburgh, PA 15222
Telephone: (412) 456-2881
Facsimile: (412) 456-2864
E-mail: dgo@muslaw.com.

Attorneys for Applicant,
South Shore Slag LLC

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

ECZACIBASI HOLDING ANONIM SIRKETI,)	Opposition No. 91232631
)	
Opposer,)	Application No. 87/027,240
)	
v.)	Mark: VITRASPAN
)	<i>ELECTRONICALLY FILED</i>
SOUTH SHORE SLAG LLC,)	
)	
Applicant.)	

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **AMENDED ANSWER TO NOTICE OF OPPOSITION**, was filed electronically with the TTAB and mailed, via U.S. first class mail postage-paid, on the 15th day of March, 2017, to the following:

Otto O. Lee, Esquire
Intellectual Property Law Group LLP
12 South First Street, 12th Floor
San Jose, CA 95113
tm_docket@iplg.com

MEYER UNKOVIC & SCOTT, LLP

/s/ David G. Oberdick
David G. Oberdick, Esquire