


ESTTA Tracking number: **ESTTA848677**

Filing date: **09/27/2017**

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

Proceeding	91236459
Party	Defendant US Pony Holdings LLC
Correspondence Address	KARL SCHEIDER ICONIX BRAND GROUP, INC. 1450 BROADWAY 3RD FLOOR NEW YORK, NY 10018 Email: trademarks@iconixbrand.com
Submission	Answer
Filer's Name	Theodore R. Remaklus
Filer's email	tremaklus@whe-law.com
Signature	/theodore r remaklus/
Date	09/27/2017
Attachments	Answer of Applicant.pdf(55086 bytes )

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

L&L Wings, Inc.,	)	
	)	
Opposer,	)	Opposition No. 91236459
v.	)	App. No. 87352526
	)	
US Pony Holdings LLC,	)	
	)	
Applicant.	)	Mark: 
	)	

**ANSWER OF APPLICANT**

Applicant US Pony Holdings LLC ("US Pony"), for its response to the numbered paragraphs of the Notice of Opposition filed by Opposer L&L Wings, Inc. ("L&L"), answers as follows

1. In response to Paragraph 1 of the Notice of Opposition, US Pony admits on information and belief that the mark, registration number, date of registration, and goods/services of the listed Trademark and Service Mark registrations are accurate. With respect to the remaining allegations of Paragraph 1 of the Notice of Opposition, US Pony is without knowledge or information sufficient to form a belief as to the truth thereof and, therefore, denies the same.

2. In response to Paragraph 2 of the Notice of Opposition, US Pony admits that a declaration pursuant to Sections 8 and 15 of the Lanham Act was filed and accepted for US Registration No. 3458144. US Pony is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations of Paragraph 2 of the Notice of Opposition and, therefore, denies the same.

3. US Pony denies the allegations of Paragraph 3 of the Notice of Opposition.

4. US Pony is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 of the Notice of Opposition and, therefore, denies the same.

5. US Pony admits the allegations of paragraph 5 of the Notice of Opposition.

6. US Pony is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 6 of the Notice of Opposition and, therefore, denies the same.

7. US Pony is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 7 of the Notice of Opposition and, therefore, denies the same.

8. US Pony is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 8 of the Notice of Opposition and, therefore, denies the same.

9. US Pony is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 9 of the Notice of Opposition and, therefore, denies the same.

10. US Pony admits the allegation of Paragraph 10 of the Notice of Opposition.

11. In response to Paragraph 11 of the Notice of Opposition, US Pony admits that its mark of US Application No. 87352526 (hereinafter "the '526 Application") includes the word "WINGS." US Pony denies the remaining allegations of Paragraph 11 of the Notice of Opposition.

12. US Pony denies the allegations of Paragraph 12 of the Notice of Opposition.

13. US Pony denies the allegations of Paragraph 13 of the Notice of Opposition.

14. US Pony denies the allegations of Paragraph 14 of the Notice of Opposition.
15. US Pony denies the allegations of Paragraph 15 of the Notice of Opposition.
16. US Pony denies the allegations of Paragraph 16 of the Notice of Opposition.
17. US Pony denies the allegations of Paragraph 17 of the Notice of Opposition.
18. US Pony denies the allegations of Paragraph 18 of the Notice of Opposition.

### **AFFIRMATIVE DEFENSES**

#### **First Affirmative Defense**

19. The mark of the '526 Application, when used with the goods of that application, is sufficiently distinctively different from the marks of L&L so as to avoid confusion, deception or mistake as to the source, sponsorship, association or approval of those goods.

#### **Second Affirmative Defense**

20. The goods of the '526 Application travel through different channels of trade than do the products marketed and sold by L&L under the recited registrations such that there is no likelihood of confusion, deception or mistake as to the source, sponsorship, association or approval of the goods of the '526 Application when used with the mark of that application.

#### **Third Affirmative Defense**

21. US Pony is the owner of the following US Trademarks:

**CITY WINGS**

Registration No. 2680800 (incontestable), registered January 20, 2003 for "Athletic and casual footwear" in Class 25



Registration No. 2717274 (incontestable), registered May 20, 2003 for "Athletic and casual footwear" in Class 25

These registrations are valid and subsisting.

22. The '526 Application is a refile by US Pony of its prior Registration No. 3136140, which registered on August 29, 2006 and was canceled on April 7, 2017, for the identical mark and goods as are the subject of the '526 Application.

23. US Registration Nos. 2680800, 2717274 and 3136140 are referred to collectively as "US Pony's Prior CITY WINGS Marks."

24. L&L's "Wings" bearing marks were registered after the registration dates of US Pony's Prior CITY WINGS Marks.

25. The CITY WINGS Marks of US Pony and the "Wings" bearing marks of L&L have coexisted in the market without confusion for more than 20 years.

26. Because there was no likelihood of confusion between the marks of US Pony's Prior CITY WINGS Marks, when used with the goods of those registrations, and the "Wings" bearing marks of L&L when used with the goods/services of those marks, the "Wings" bearing marks of L&L were allowed by the US Trademark Office over the US Pony Holding Prior CITY WINGS Marks.

27. For the same reasons, there is no likelihood of confusion between the mark of the '526 Application, when used with the goods of that application, and the "Wings" bearing registrations of L&L when used with the goods of those registrations.

#### **Fourth Affirmative Defense**

28. During prosecution of Application No. 78962652, which issued as Registration No. 3458144, L&L argued in a Response to Office Action dated July 30, 2007:

During almost 30 years of operating in these highly visible and profiled market places, there has not been one known claim of confusion by any consumer and/or vendor.

A search of the mark "Wings" shows there are many registrations of this mark for different usages with many examples of related usage. Notwithstanding, the lack

of confusion has permitted registration for these similar registrations. Notwithstanding the similar usage that Applicant may have, there has been not one known claim of confusion in almost 30 years of usage.

29. There are at least the following existing "WING" bearing marks in Class 25:

**PRAIRIE WINGS** Registration No. 5170725  
Class 25 - Hats; t-shirts; sweatshirts; footwear; gloves; fishing and hunting waders; jackets; sweaters  
Class 35 - Retail sporting goods stores; Retail on-line ordering services featuring sporting goods also accessible by telephone, facsimile and mail order

**ROYAL WINGS** Registration No. 5168303  
Class 25 - T-shirts; Graphic T-shirts; Short-sleeved or long-sleeved t-shirts

**WICKED WING** Registration No. 5093023  
Class 25 - Clothing, namely, caps, beanies, shirts, pants, gloves, hand warmers

*Fairy Wings*

Registration No. 4900406  
Class 25 - Clothing, namely, babies' pants, layettes, headbands, underwear, underclothing, body linen, dresses, socks, shoes, hats, scarves, scarfs, and hosiery

**ARTWINGS** Registration No. 4391539  
Class 25 - A-shirts; Adult novelty gag clothing item, namely, socks; Apparel for dancers, namely, tee shirts, sweatshirts, pants, leggings, shorts and jackets; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Athletic shirts; Babies' pants; Baby layettes for clothing; Baseball caps; Baseball caps and hats; Belts; Belts for clothing; Belts made out of cloth; Body shirts; Bottoms; Button down shirts; Button-front aloha shirts; Camouflage shirts; Camp shirts; Cap peaks; Cap visors; Caps; Caps with visors; Children's and infants' cloth bibs; Clothing for athletic use, namely, padded elbow compression sleeves being part of an athletic garment; Clothing for athletic use, namely, padded pants; Clothing for athletic use, namely, padded shirts; Clothing for athletic use, namely, padded shorts; Clothing for babies, toddlers and children, treated with fire and heat retardants, namely, pajamas, jackets, shirts, pants, jumpers; Clothing items, namely, adhesive pockets that may be affixed directly to the body as a decorative piece of clothing with utility; Clothing items, namely, adhesive pockets that may be

affixed directly to the inside of clothing for storage and safekeeping of personal items; Clothing items, namely, blindfolds worn over the eyes; Clothing, namely, arm warmers; Clothing, namely, athletic sleeves; Clothing, namely, base layers; Clothing, namely, cowls and smoke ring scarves; Clothing, namely, crops; Clothing, namely, khakis; Clothing, namely, neck tubes; Collared shirts; Combinations; Dress shirts; Dusters; Eyeshades; Fishing shirts; Gloves as clothing; Golf caps; Golf pants, shirts and skirts; Golf shirts; Hat bands; Hats; Hats for infants, babies, toddlers and children; Headbands for clothing; Headgear, namely, hats, caps, berets; Hooded sweat shirts; Hoods; Hunting shirts; Infant and toddler one piece clothing; Jackets; Jerseys; Knit shirts; Knitted caps; Knot caps; Leather belts; Leather hats; Long-sleeved shirts; Maternity clothing, namely, dresses, pants, shirts, blouses; Moisture-wicking sports shirts; Mufflers; Night shirts; Non-disposable cloth training pants; Open-necked shirts; Over shirts; Perspiration absorbent strap to be used in the bill of a hat; Perspiration absorbent underwear clothing; Pique shirts; Polo shirts; Rain hats; Rugby shirts; Scientific and technological apparel, namely, shirts, pants, jackets, footwear, hats and caps, uniforms; Shifts; Shirts; Shirts and short-sleeved shirts; Shirts and slippers; Shirts for infants, babies, toddlers and children; Shirts for suits; Short sets; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sleep shirts; Sports caps and hats; Sports shirts; Sports shirts with short sleeves; Sun protective clothing, namely, shirts, pants, dresses, hats; Sweat shirts; Swim caps; Swimming caps; T-shirts; T-shirts for babies, men and women; Ties; Toboggan hats, pants and caps; Toe caps; Tops; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; Turtle neck shirts; Wearable garments and clothing, namely, shirts; Wind shirts; Women's clothing, namely, shirts, dresses, skirts, blouses; Women's hats and hoods; Woolly hats; Wrist bands; Wristbands; Yoga pant

## **RED WINGS**

Registration No. 4229559

Class 25 - Clothing, namely, bandanas, beach cover-ups, belts, body suits, boxer shorts, caps, cloth bibs, coats, ear muffs, gloves, hats, headbands, hosiery, housecoats, jackets, jerseys, leggings, leotards, mittens, nightshirts, pajamas, pants, rain coats, rain wear, robes, scarves, shirts, shorts, skirts, socks, suits, sun visors, suspenders, sweaters, sweatpants, sweatshirts, swimsuits, swim trunks, t-shirts, ties, toques, underwear, vests, warm-up suits, wristbands, and

athletic footwear, all intended to create an association with the Detroit Red Wings hockey team

**PAPER WINGS**

Registration No. 4402313

Class 25 - Clothing, namely jackets, shirts, blouses, vests, sweaters, smocks, tunics, rompers, trousers, pants, shorts, dresses and skirts

**STEEL WING**

Registration No. 4132442

Class 25 - Men's, women's and children's clothing, namely, t-shirts, long sleeved shirts, sweatshirts, sweatpants, pants, jeans, shorts, skirts, union suits, lined and unlined jackets, lined and unlined vests, short sleeve and long sleeve knit and woven shirts, socks, leggings, long underwear, underwear, scarves, kerchiefs, gloves, belts and suspenders; headwear, namely, hats, knit hats, knit face masks, skull caps, sweatbands and neck gaiters; children's and infant's apparel, namely, tee-shirts, sweatshirts, bottoms, jumpers, sleepwear, rompers, one-piece garments and knit hats

**RIGHT WING**

Registration No. 3817269

Class 25 - Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Dress shirts; Golf pants, shirts and skirts; Hats; Hooded sweat shirts; Knit shirts; Long-sleeved shirts; Polo shirts; Rugby shirts; Shirts for suits; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts; Sports shirts with short sleeves; Sweat shirts; T-shirts; Tee shirts; Waterproof jackets and pants; Wearable garments and clothing, namely, shirts

**ROCKWINGS**

Registration No. 3733909

Class 25 - Golf shirts; Hats; Headgear, namely, hats; Hooded sweat shirts; Knit shirts; Pique shirts; Polo shirts; Shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sports shirts; Sports shirts with short sleeves; Sweat shirts; T-shirts; Tee shirts; Wearable garments and clothing, namely, shirts

30. "WINGS" is a weak formative, as admitted by L&L, and any rights of L&L are strictly limited in scope to the marks as registered. Thus, there is no likelihood of confusion between the mark of the '526 Application, when used with the goods of that application, and the "Wings" bearing registrations of L&L when used with the goods of those registrations.



WHEREFORE, Applicant US Pony Holdings LLC prays that the Notice of Opposition be dismissed with prejudice.

Respectfully submitted,

US PONY HOLDINGS LLC

Date: September 27, 2017

By: /s/ Theodore R. Remaklus  
Theodore R. Remaklus  
Wood, Herron & Evans, L.L.P.  
2700 Carew Tower  
441 Vine Street  
Cincinnati, Ohio 45202  
(513) 241-2324  
tremaklus@whe-law.com

Attorneys for Applicant  
US Pony Holdings LLC

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **Answer of Applicant** was served upon the following counsel for Opposer by electronic mail this 27th day of September, 2017:

Bennett D. Krasner, Esq.  
The Law Offices of Bennett D. Krasner  
1233 Beech Street, No. 49  
Atlantic Beach, NY 11509  
bkrasner@bdklaw.net  
bonnie.krasner@bdklaw.net  
bkrasner@optonline.net

/s/ Theodore R. Remaklus  
Theodore R. Remaklus  
Wood, Herron & Evans, L.L.P.  
2700 Carew Tower  
Cincinnati, Ohio 45202  
(513) 241-2324