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

Proceeding	91237763
Party	Defendant Secret of the Islands, Inc.
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Submission	Answer
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Date	12/23/2017
Attachments	DESIGN.pdf(394996 bytes)

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

In the Matter of Application Serial No.: 87/250,354
By Holy City Skin Products, LLC, for the Mark:
MISCELLANEOUS DESIGN
Filed: November 29,2016
Published in the *Official Gazette*: October 31, 2017

Holy City Skin Products, LLC, Opposer,)	
)	
)	
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)	
v.)	Case No.:
		Applicant's Response to Notice of Opposition
Secret of The Islands, Inc.,)	
)	
)	
Applicant.)	

RESPONSE TO NOTICE OF OPPOSITION

Opposer, Holy City Skin Products, LLC, ("Opposer"), filed a Notice of Opposition on November 13, 2017 claiming against Application Serial No. 87/328,354 (the "Application"). Applicant has been granted consent by Opposer's counsel to request of the court extensions of time to answer until February 1, 2018. However, in the interest of avoiding unneeded delay Applicant is filing this response on December 23, 2017 but since the Applicant will be seeking replacement counsel for any future filing, correspondence, events in this matter Applicant requests the court allow for any requested amendments to the Applicant's Response by new counsel at least until the February 1, 2018 agreed upon date.

Applicant believes the Opposition is completely frivolous and further believes the Notice of Opposition contains outright knowingly false statements.

The Opposer/Defendant sites in paragraph 8 of its Notice of Opposition ("NOO") the current litigation between the parties which Opposer/Defendant labels in the NOO as (the

“Litigation”).

In the “Litigation” the Applicant’s use as first user, senior user, and recognized source of goods is documented in great detail from Applicant as are Applicant’s claims (including specifics and details) of Opposer/Defendant’s knowingly, willful, and malicious infringement. Applicant believes that in the Litigation there is no specific dispute by Opposer/Defendant of Applicant’s claim to first use, or senior use at all from Opposer/Defendant nor is there any claim of first use, senior use, or use since 2009 from Opposer/Defendant. If possible Applicant requests that the “Litigation” be part of the Opposition record and incorporated herein by this reference and the reference made in paragraph 8 of the NOO.

Applicant hereby responds as follows:

1. Applicant affirms the information contained in paragraph 1 of the Opposition.
2. Applicant lacks sufficient knowledge or information to form a belief as to all the allegations contained in paragraph 2 of the Opposition.
3. Applicant lacks sufficient knowledge or information to form a belief as to all the allegations contained in sentence one of paragraph 3 of the Opposition. Applicant denies each and every other allegation contained in paragraph 3 of the Opposition except for those in sentence one and those in the last sentence of paragraph 3. Applicant affirms the last sentence in paragraph 3 as further proof of Opposer’s infringement as is further described in the “Litigation” as cited and labeled in paragraph 8 of the notice of opposition. Applicant further believes Opposer is knowingly, willfully, and purposely making false statements. It is an undisputable fact that Opposer has not employed such methods of sale and marketing since 2009. It is further fact that Applicant as senior user did employ such methods of sale and marketing since 2009.
4. Applicant denies each and every allegation contained in paragraph 4 of the Opposition
5. Applicant denies each and every allegation contained in paragraph 5 of the Opposition.

6. Applicant denies each and every allegation contained in paragraph 5 of the Opposition.
7. Applicant denies each allegation contained in paragraph 7 of the Opposition.
8. Applicant is the senior user. Applicant is known as the source for the mark. Applicant instituted litigation against Opposer/Defendant for infringement, so obviously Applicant was aware of Opposer/Defendant's infringing use of Applicant's mark.
9. Answers to Paragraphs 1-8 are restated and reiterated as fully as said forth herein.
10. Registration should be granted to Applicant's mark. The USPTO has examined Applicant's application and believes the asserted mark is not generic in allowing this application to publication. Opposer/Defendant has not proved otherwise. Defendant, as they have attempted to in Federal Court, is once again in this opposition, attempting to change the rules to suit its own apparently willful conduct. Applicant denies each allegation contained in paragraph 10 of the Opposition.
12. Registration should be granted to Applicant's mark. Applicant is the senior user. Defendant, as they have attempted to in Federal Court, is once again in this opposition, attempting to change the rules to suit its own apparently willful conduct and false statements. Applicant denies each and every allegation contained in paragraph 12 of the Opposition. Applicant is known as the source for this miscellaneous Design. The USPTO recognizes that this Jar design functions as a trademark for Applicant and does not agree with Opposer/Defendant as there are many examples of Jar designs as USPTO registered trademarks. Opposer/Defendant is just making up its own incorrect allegations.
11. Registration should be granted to Applicant's mark. This mark is obviously not functional and the USPTO in its examination agrees, Opposer/Defendant has not set forth any evidence to prove otherwise. The USPTO has examined Applicant's application and believes the asserted mark functions as a trademark in allowing this application to publication. Defendant, as they have attempted to in Federal Court, is once again in this opposition, attempting to change the rules to suit its own apparently willful conduct.

Applicant denies each and every allegation contained in paragraph 11 of the Opposition.

AFFIRMATIVE DEFENSES

1. The Opposition fails to state a claim upon which relief can be granted.
2. Applicant believes the Opposition makes false claims in its Notice of Opposition such as for example, claiming that Opposer is the senior user. It is an undisputable fact that the Applicant is the senior user. In fact, Applicant's use began in at least as early as mid-2009 and it is a fact that Opposer was not even formed until late December 2011 and began doing business therefore at the start of 2012, making its earliest possible use over two years after Applicant's. It's undisputable that Applicant has had continuous use since 2009 and was established early on as the recognized source for the mark.
3. Applicant believes this Opposition is frivolous as Opposer's Opposition is based on what appears to be Opposer's false statements, as well as, statements questioning whether Opposer understands what a trademark is.
4. Applicant owns common law rights in the trademark.
5. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, acquiescence, and/or waiver.
6. Opposer does not own valid and enforceable rights for the mark.
7. Opposer does not own valid and enforceable rights for the mark that are superior to Applicant's rights.
8. Opposer does not own any valid and enforceable common law rights in the mark or any other derivative mark which would predate the common law rights owned by Applicant.

COUNTER CLAIMS

1. The Opposer/Defendant has and is continuing to damage Applicant's business by willfully and maliciously combined with false statements and allegations attacking Applicant in various forms including this one while continuing to infringe and interfere with Applicant's business and cause significant damages including but not limited to loss of business to Applicant. Applicant requests that this Court Award Applicant any damages this Court is permitted to award Applicant, including but not limited to, Attorneys' fees and to the damages presented by Applicant in the Court case named and described in Opposer/Defendant's Notice of Opposition #8 the "Litigation".

PRAYER FOR RELIEF

WHEREFORE, Applicant generally denies that Opposer would be damaged by Applicant's registration of the mark, and respectfully requests that the Board dismiss all claims set forth in the Opposition, and grant registration to Applicant's mark.

MOTION TO ADJOURN

Applicant motions this Court to adjourn any proceedings in this matter:

Attorney Richard Blank, in accordance with USPTO Rule 11.116 (a) (2), hereby is withdrawing from representation due to extremely worsening health and disabilities and therefore Applicant requests adjournment of any further proceedings here under for 120 days, so Applicant can reasonably obtain new representation.

DATED: December 23, 2017

RESPECTFULLY SUBMITTED,

APPLICANT: Secret of The Islands, Inc.

By: /Richard Blank/

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CERTIFICATE OF TRANSMITTAL

I hereby certify that on December 23, 2017, this correspondence is being electronically transmitted in PDF format to the Trademark Trial and Appeal Board through the Electronic System for Trademark Trials and Appeals (ESTTA).

/Richard Blank/

Richard Blank

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing ANSWER TO NOTICE OF OPPOSITION has been served on Opposers' counsel by electronic transmission on December 23, 2017, and via First-Class Mail, postage pre-paid.

/Richard Blank/

Richard Blank