

ESTTA Tracking number: **ESTTA952035**

Filing date: **02/05/2019**

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

Proceeding	91245553
Party	Defendant Simsii, Inc.
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Submission	Answer
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Date	02/05/2019
Attachments	Answer to Notice of Opposition.pdf(111991 bytes)

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

ENTEGRIS, INC.,

Opposer,

v.

Opposition No. 91245553

SIMSII, INC.,

Applicant.

APPLICANT’S ANSWER TO NOTICE OF OPPOSITION

In response to the Notice of Opposition (hereafter “Notice”) filed by ENTEGRIS, INC.. (hereafter “Opposer”) on December 31, 2018, the Applicant, SIMSII, INC. (hereafter “Applicant”), answers the Notice identified above as follows:

COUNT I

1. In response to the allegations of paragraph 1 of the Notice, the Applicant is without knowledge.
2. Applicant admits that it is a corporation organized under the laws of California, with a principal place of business located in Irvine, California. Any and all other allegations contained within paragraph 2 are denied.
3. In response to the allegations of paragraph 3 of the Notice, the Applicant is without knowledge.
4. In response to the allegations of paragraph 4 of the Notice, the Applicant is without knowledge.

5. In response to the allegations of paragraph 5 of the Notice, the Applicant is without knowledge.
6. Applicant admits that it claims a date of first use of at least as early as January 20, 2016. Any and all other allegations contained within paragraph 6 are denied.
7. In response to the allegations of paragraph 7 of the Notice, the Applicant is without knowledge.
8. Applicant denies the allegations of paragraph 8 of the Notice.
9. In response to the allegations of paragraph 9 of the Notice, the Applicant is without knowledge.
10. In response to the allegations of paragraph 10 of the Notice, the Applicant is without knowledge.
11. In response to the allegations of paragraph 11 of the Notice, the Applicant is without knowledge.
12. In response to the allegations of paragraph 12 of the Notice, the Applicant is without knowledge.
13. In response to the allegations of paragraph 13 of the Notice, the Applicant is without knowledge.
14. In response to the allegations of paragraph 14 of the Notice, the Applicant is without knowledge.
15. Applicant admits it filed Application No. 87/742,561 on January 3, 2018, seeking registration of the composite mark SIMSII for use with laboratory filters, claiming a date of first use of at least as early as January 20, 2016. Any and all other allegations contained within paragraph 15 are denied.

16. Applicant admits that Application No. 87/742,561 was published for opposition on September 4, 2016, and that Opposer filed two extensions of time to oppose on October 4, 2018, and October 31, 2018. Any and all other allegations contained within paragraph 16 are denied.
17. Applicant denies the allegations of paragraph 17 of the Notice.
18. Applicant denies the allegations of paragraph 18 of the Notice.
19. Applicant denies the allegations of paragraph 19 of the Notice.

FIRST GROUNDS FOR OPPOSITION:
PRIORITY & LIKELIHOOD OF CONFUSION
15 U.S.C. § 1052(d)

20. Applicant realleges and repeats the responses contained within paragraphs 1 – 19 as if fully set forth herein.
21. In response to the allegations of paragraph 21 of the Notice, the Applicant is without knowledge.
22. Applicant denies the allegations of paragraph 22 of the Notice.
23. Applicant denies the allegations of paragraph 23 of the Notice.
24. Applicant denies the allegations of paragraph 24 of the Notice.
25. Applicant denies the allegations of paragraph 25 of the Notice.
26. Applicant denies the allegations of paragraph 26 of the Notice.
27. Applicant denies the allegations of paragraph 27 of the Notice.
28. Applicant admits that it has not received any consent by Opposer to use or register the mark contained within Application No. 87/742,561; however, Applicant denies that any consent or permission is required on the part of Opposer as the respective marks are not

confusingly similar within the meaning of the Trademark Act. Any and all other allegations contained within paragraph 28 are denied.

Affirmative Defenses

In further answer to the Notice, the Applicant asserts that:

First Affirmative Defense

29. Opposer's Notice fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition.

Second Affirmative Defense

30. Upon information and belief, Opposer has no priority of use to the SIMSII mark

Third Affirmative Defense

31. Opposer's claims are barred, in whole or in part, by the doctrines of estoppel, acquiescence and waiver.

Fourth Affirmative Defense

32. Opposer's claims are barred, in whole or in part, by the doctrine of laches.

Fifth Affirmative Defense

33. There is no similarity between Applicant's mark and Opposer's marks. Specifically, the Opposer's marks as cited in the Notice are merely variations on two interlocking or intersecting circles, without any word elements. The literal elements of Applicant's mark (i.e., SIMSII) bear no resemblance to any of Opposer's marks as cited in the Notice. Additionally, it can be said that the dominant portion of the Applicant's mark is the word SIMSII (i.e., the literal elements) rather than the circle design. The word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re*

Viterra Inc., 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)).

Sixth Affirmative Defense

34. Purchasers of goods sold along with the relevant marks are careful and sophisticated, thus making any confusion or mistake amongst potential overlapping consumers highly unlikely.

Seventh Affirmative Defense

35. The respective trademarks, as appears on each party's respective goods and services, do not create the same or overall commercial impression when viewed separately by the ordinary consumer.

Eighth Affirmative Defense

36. Ordinary Consumers would not confuse or conclude that the parties' products share a common source or affiliation or connection.

Ninth Affirmative Defense

37. On information and belief, Opposer's goods are more expensive than that of the Applicant; thus, Consumers are unlikely to purchase Opposer's goods supposing they derive from Applicant or vice versa.

Tenth Affirmative Defense

38. Opposer has no examples of any actual confusion amongst consumers with regards to Applicant's and Opposer's respective marks.

Applicant reserves the right to amend this Answer to assert any additional affirmative defenses arising from any applicable facts or law that may be revealed during discovery.

Relief Requested

WHEREFORE, the Applicant asks that this Opposition proceeding be dismissed forthwith.

By: /Francis John Ciaramella/
Francis John Ciaramella, Esq.
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Dated: February 5, 2019

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer to Notice of Opposition has been served on the following via email:

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By: /Francis John Ciaramella/
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Dated: February 5, 2019