

ESTTA Tracking number: **ESTTA1001383**

Filing date: **09/12/2019**

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

Proceeding	91249586
Party	Defendant Peter Velikin and Kiril Alexandrov
Correspondence Address	ROBERT M WARD BMWIP LAW.COM 3455 PEACHTREE ROAD NE, 5TH FLOOR ATLANTA, GA 30326 UNITED STATES rward@bmiplaw.com, bmwlaw@aol.com 404-606-6480
Submission	Other Motions/Papers
Filer's Name	Robert M. Ward
Filer's email	rward@bmiplaw.com, bmwlaw@aol.com
Signature	/Robert M. Ward/
Date	09/12/2019
Attachments	Exhibit A Bonobo Brew.pdf(59897 bytes) Exhibit B Bonobos dietary supplements.pdf(138997 bytes) Exhibit C Bonobo Winery .pdf(110522 bytes) Exhibit D Coexistence Agreement .pdf(1080352 bytes) brief in opposition to Opposer motion to strike.pdf(331372 bytes)

Int. Cls.: 30 and 32

Prior U.S. Cls.: 45, 46 and 48

United States Patent and Trademark Office

Reg. No. 3,520,671

Registered Oct. 21, 2008

**TRADEMARK
PRINCIPAL REGISTER**

Bonobo Brew

SALLY J. COXE (UNITED STATES INDIVIDUAL)
2701 CONNECTICUT AVE, NW #702
WASHINGTON, DC 20008

FOR: COFFEE SOLD IN CONNECTION WITH
RAISING FUNDS FOR, AND AWARENESS OF, THE
BONOBO AND ITS HABITAT, IN CLASS 30 (U.S. CL.
46).

FIRST USE 1-10-2005; IN COMMERCE 2-0-2006.

FOR: BEER SOLD IN CONNECTION WITH RAIS-
ING FUNDS FOR, AND AWARENESS OF, THE
BONOBO AND ITS HABITAT, IN CLASS 32 (U.S.
CLS. 45, 46 AND 48).

FIRST USE 1-10-2005; IN COMMERCE 2-0-2006.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "BREW", APART FROM THE
MARK AS SHOWN.

SER. NO. 78-877,323, FILED 5-5-2006.

CORY BOONE, EXAMINING ATTORNEY

United States of America

United States Patent and Trademark Office

BONOBOS

Reg. No. 5,728,493

Natural Cosmeceuticals of America Inc. (TEXAS CORPORATION)
2909 Hillcroft Street, Suite 250
Houston, TEXAS 770575820

Registered Apr. 16, 2019

Int. Cl.: 5

CLASS 5: Nutritional and dietary supplements; Dietary supplements, namely, antioxidants, minerals, proteins, amino acids, super food supplements and nutraceuticals; all of the foregoing not being for veterinary use

Trademark

FIRST USE 1-1-2018; IN COMMERCE 1-1-2018

Principal Register

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

SER. NO. 87-411,797, FILED 04-14-2017



Andrei Iancu

Director of the United States
Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*

What and When to File:

- **First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.

United States of America

United States Patent and Trademark Office

BONOBO WINERY

Reg. No. 5,161,314

OV The Farm, LLC (MICHIGAN LIMITED LIABILITY COMPANY)
7700 Peninsula Drive

Registered Mar. 14, 2017

Traverse City, MI 49686

Int. Cl.: 40

CLASS 40: Winery services

Service Mark

FIRST USE 12-31-2014; IN COMMERCE 12-31-2014

Principal Register

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

No claim is made to the exclusive right to use the following apart from the mark as shown:
"WINERY"

SER. NO. 85-922,373, FILED 05-03-2013
TEJBIR SINGH, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

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Requirements in the First Ten Years*

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- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

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- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77372978
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION (no change)	
ARGUMENT(S)	
The examining attorney has refused registration citing Reg. No. 2996357 for BONOBO. Applicant submits herewith a Coexistence and Consent Agreement executed by the owner of the cited registration. In light of the understandings set forth in that Agreement, Applicant respectfully submits that its application may proceed to registration.	
EVIDENCE SECTION	
EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	evi_71229209215-094618532_ . Bonobos_signed_consent.pdf
CONVERTED PDF FILE(S) (2 pages)	\\TICRS\EXPORT2\IMAGEOUT2\773\729\77372978\xml1\ROA0002.JPG
	\\TICRS\EXPORT2\IMAGEOUT2\773\729\77372978\xml1\ROA0003.JPG
DESCRIPTION OF EVIDENCE FILE	an agreement between applicant and the owner of Reg. No. 2996357 providing consent to applicant's registration of its BONOBO trademark
CORRESPONDENCE SECTION	
NAME	Jessica Stone Levy
FIRM NAME	Law Office of Jessica Stone Levy, PLLC
STREET	4950 S. Yosemite St., F2-341
CITY	Greenwood Village
STATE	Colorado
ZIP/POSTAL CODE	80111
COUNTRY	United States
PHONE	303-740-5771
EMAIL	jessica@jessicastonelevy.com
AUTHORIZED EMAIL COMMUNICATION	Yes
SIGNATURE SECTION	
RESPONSE SIGNATURE	/Jessica Stone Levy/
SIGNATORY'S NAME	Jessica Stone Levy
SIGNATORY'S POSITION	Attorney of record
DATE SIGNED	08/05/2008
AUTHORIZED SIGNATORY	YES
FILING INFORMATION SECTION	

SUBMIT DATE	Tue Aug 05 09:54:23 EDT 2008
TEAS STAMP	USPTO/ROA-XX.XXX.XXX.XXX- 20080805095423398777-7737 2978-42037785236fa2eb5c0c 576d9ba42fb7-N/A-N/A-2008 0805094618532602

PTO Form 1957 (Rev 9/2005)
OMB No. 0651-0050 (Exp. 04/2009)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **77372978** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

The examining attorney has refused registration citing Reg. No. 2996357 for BONOBO. Applicant submits herewith a Coexistence and Consent Agreement executed by the owner of the cited registration. In light of the understandings set forth in that Agreement, Applicant respectfully submits that its application may proceed to registration.

EVIDENCE

Evidence in the nature of an agreement between applicant and the owner of Reg. No. 2996357 providing consent to applicant's registration of its BONOBOS trademark has been attached.

Original PDF file:

[evi_71229209215-094618532 . Bonobos_signed_consent.pdf](#)

Converted PDF file(s) (2 pages)

[Evidence-1](#)

[Evidence-2](#)

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current:

JESSICA STONE LEVY
LAW OFFICE OF JESSICA STONE LEVY PLLC
7217 W MERCER WAY
MERCER ISLAND, WA 98040-5533

Proposed:

Jessica Stone Levy of Law Office of Jessica Stone Levy, PLLC, having an address of
4950 S. Yosemite St., F2-341 Greenwood Village, Colorado 80111
United States
jessica@jessicastonelevy.com
303-740-5771

SIGNATURE(S)

Response Signature

Signature: /Jessica Stone Levy/ Date: 08/05/2008

Signatory's Name: Jessica Stone Levy

Signatory's Position: Attorney of record

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to

withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: Jessica Stone Levy
Law Office of Jessica Stone Levy, PLLC
4950 S. Yosemite St., F2-341
Greenwood Village, Colorado 80111

Serial Number: 77372978
Internet Transmission Date: Tue Aug 05 09:54:23 EDT 2008
TEAS Stamp: USPTO/ROA-XX.XXX.XXX.XXX-200808050954233
98777-77372978-42037785236fa2eb5c0c576d9
ba42fb7-N/A-N/A-20080805094618532602

Coexistence and Consent Agreement

WHEREAS, Cari Borja, an individual with an address at 669 Cleveland Street, Oakland, CA 94609 ("Borja"), is the owner of United States Trademark Registration No. 2,996,357, for the mark BONOBO, in respect of "clothing, namely, dresses, pants, sweaters, scarves, jackets, coats, skirts, tops," which mark is in use in connection with a line of designer clothing marketed under Borja's CARI BORJA name and brand; and

WHEREAS, Bonobos Inc., a Delaware corporation with an address at 112 E. 17th St., #3W, New York, NY 10003 ("Bonobos") has adopted and is using the trademark BONOBO in respect of men's clothing, namely, trousers, belts and T-shirts, and intends to expand its use to other items of clothing for men and women; and

WHEREAS, the parties agree that there is neither actual confusion nor a likelihood of confusion between their respective marks when used as described above, based on the already existing differences between the respective marks, respective goods, and respective channels of trade.


THE PARTIES THEREBY AGREE AS FOLLOWS:

1. Borja agrees that she will not object to the use or registration by Bonobos of the BONOBO trademark, anywhere in the world, on or in conjunction with men's and women's clothing.
2. Bonobos agrees that it will not object to the use or registration by Borja of the BONOBO trademark, anywhere in the world, on or in conjunction with the goods currently identified in Reg. No. 2,996,357, for designer clothing sold under the CARI BORJA name and brand.
3. The parties believe that there is neither actual confusion nor likelihood of confusion between their respective marks when used as described above, based on the differences between the respective marks, respective goods, and respective channels of trade.
4. The parties agree that should a likelihood of confusion or actual confusion arise in conjunction with the use of the respective marks, the parties will cooperate to take such steps as are reasonable and necessary to protect the consuming public and the trade from such confusion.


5. This agreement may be submitted by either party to the U.S. Patent & Trademark Office, or to any other country's trademark office, in support of its right to use and/or register its respective mark and as evidence of the other party's consent to the same.
6. The parties agree to refrain from taking any adverse action against the other's trademark as applied to its respective goods of interest as detailed in this Agreement, such as, by way of example, initiating opposition or cancellation proceedings or trademark litigation.
7. This Agreement shall be binding upon and inure to the benefit of the respective parties and their successors in interest, assigns, affiliates and licensees.
8. This Agreement shall be without definite term. However, should either party completely abandon its trademark detailed herein as defined under 15 U.S.C. § 1127, this Agreement shall be deemed terminate.

CARI BORJA

BONOBOS INC.



Cari Borja
Dated: June 24, 2008



Andy Dunn, CEO
Dated: July 1, 2008

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

In the matter of Trademark
Application Serial No: 8793373
Filing date: May 23, 2018
Mark: BONOBO
Published for Opposition: May 29, 2019

Bonobos, Inc.,

Opposer,

Opposition No. 91249586

v.

Peter Velikin and Kiril Alexandrov,

Applicants.

**APPLICANTS' RESPONSE TO OPPOSER'S
MOTION TO STRIKE AFFIRMATIVE DEFENSES**

Unfortunately, and having filed the present Opposition Proceeding in bad faith, the Opposer has burdened the Board with a massive (but entirely unnecessary) canned brief. Characteristically, there was no phone call or discussion.

Moreover, Opposer's argument that it, rather than the Applicant, retains the burden of proof is readily conceded by Applicant. Hence, the technical presence or absence of the subject "Affirmative Defenses" in a pleading makes no difference

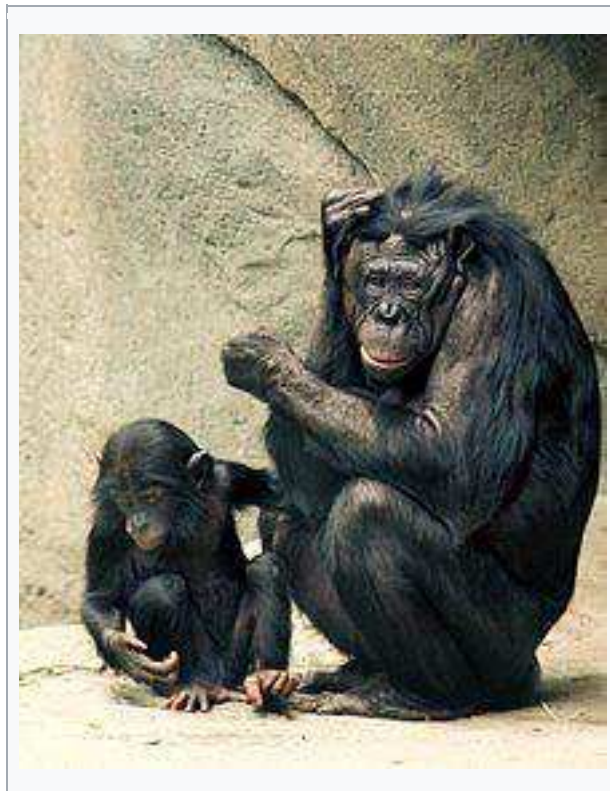
i.e., apparently copied from a pending "Chicago Cubs" Opposition.

whatsoever in this proceeding. Accordingly, Opposer's covert purpose stands exposed as a mechanism to delay resolution of its ill-brought case.

I. On its face, the Notice of Opposition Demonstrates Lack of any Likelihood of Confusion.

But, most importantly, there is nothing in Opposer's massive undertaking that can change the fact that (i) the Opposer (a WalMart company) markets "fashion consulting", custom clothes, towels, etc., under its BONOBO mark, but (ii) the Applicants market a unique, patented pull-up bar and accessories dependent therefrom under their BONOBO mark.

By way of underlying definition, a "Bonobo" is a small, gracile chimpanzee.
<https://en.wikipedia.org/wiki/Bonobo>.



Female bonobo with infant
at the San Diego Zoo

But, the Opposer's marketing materials give no suggestion that its usage has any connection with such a simian being. For example, in its "About Us" section, the Opposer states:

How It All Started

We started Bonobos because we couldn't find pants that fit. They were either way too tight or too boxy. We fixed it. Now we've expanded our playbook to shirts and suits.

How We Fixed It

The secret is our signature curved waistband. It actually conforms to the natural shape of your waist.

A Better Experience

Like most guys, we're not big fans of shopping. That's why we set out to build the best online shopping experience in the world, and we made it the core of what we do. We're now the largest clothing brand ever built on the web in the US.

Easy Returns and Exchanges

Because we stand behind what we make, and because we know that sh*t happens beyond the typical 7-14 day return period.

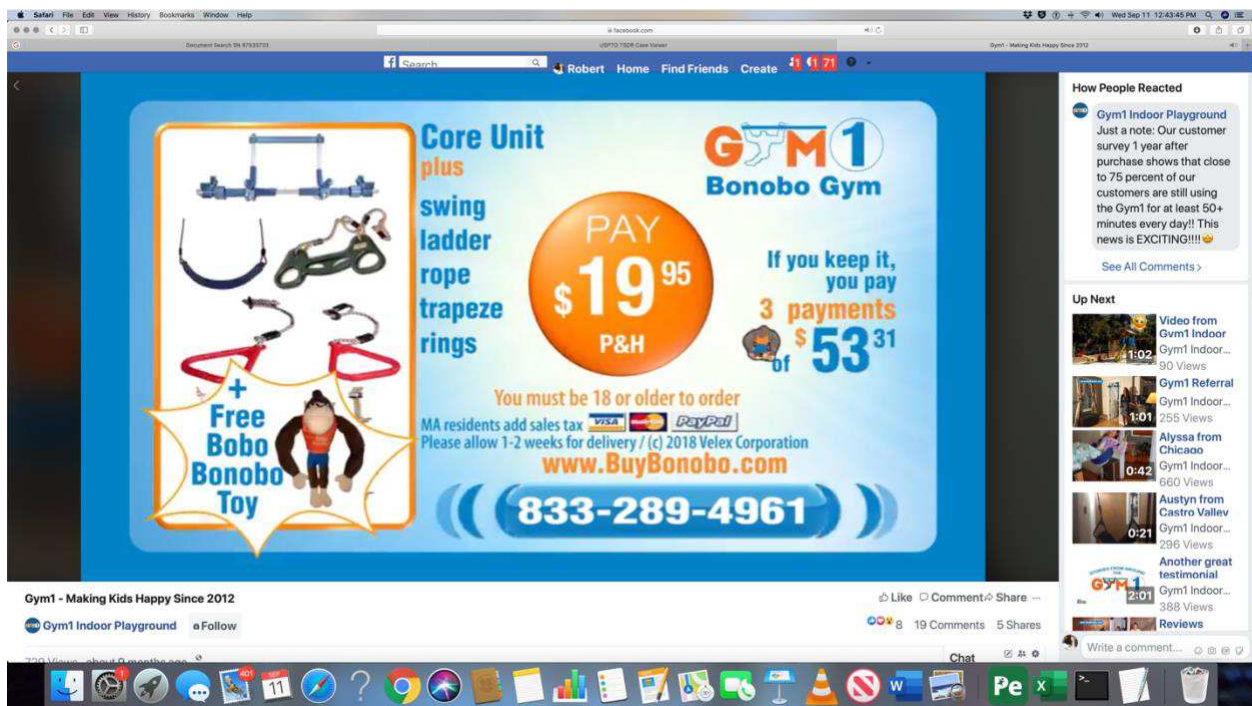
We reinvented the retail store. It's completely personalized, and we call it a guideshop.

Bonobos last guideshop for 197 miles.

Opposer’s vulgarities aside, Opposer does not explain what “sh*t happens” has to do with (a) simians, or (b) a pull-up-based exercise product suitable for use by children.

A typical specimen of Applicants’ simian-related usage of their “BONOBO” mark is shown at

<https://www.facebook.com/BuyGym1/videos/355100318570151/>, as follows:



In contrast, a typical use of the Opposer’s BONOBO clothing line is shown

as2:

2 https://bonobos.com/products/denim-shirt?color=light%20blue&mrkgcl=1200&mrkgadid=3336768734&utm_source=google&utm_medium=ppc&utm_term=680689128402_custom_label_0_full_price_product_type_tops_product_type_casual_shi&utm_campaign=Shopping_US_NB_%7C_Tops&cvosrc=ppc.google.Shopping_US_NB_%7C_Tops_680689128402_custom_label_0_full_price_product_type_tops_product_type_casual_shi&product_id=18646-BLS48-XSXREG&adpos=1o5&creative=343189212600&device=c&matchtype=&network=g&gclid=EAIAIQobChMI9vi4-NXJ5AIVU__jBx20eQN8EAYYBSABEgI33PD_BwE



Nonetheless, Opposer has the temerity to represent to this Board its abusive absurdity that:

10. The goods for which Applicant seeks to register the applied-for mark are **related to and highly similar (!?)** to the goods and services for which Opposer has used and registered Opposer's Mark. (emphasis and explanation added).

Tellingly, Opposer's purely conclusory (and self-evidentially false) remarks provide no facts from which any such alleged "relatedness" or purported "similarity" between clothing and a pull-up bar could be demonstrated.

II. At the Very Least, the Opposer Stands Guilty of Acquiescence and Estoppel.

The Record will show that marks including the prominent "BONOBO" designation have been registered by third-parties for use on coffee, dietary supplements, wine, etc., etc. (See, *e.g.*, Exhibits A, B, and C hereof). Even more non-registered usages are shown on the Internet. Opposer has not seen fit to challenge

any of these third-party usages – but, incompetently targets a pull-up bar and accessories as being somehow “confusing”³.

Yet further, third-party usages of the BONOBO mark on the very same **clothing goods** abound. The Opposer -- together with its thus-weakened mark -- should focus its efforts (if at all) accordingly.



<https://shop.bonobomusic.com/collections/merchandise>

A fortiori, Opposer’s posturing before the Board is even more sanctionable⁴ -
- considering that Opposer has already agreed that prior third-party uses of the

³ Perhaps Opposer’s make-weight argument is that persons usually wear clothing while doing pull-ups.

⁴ Facing Rule 11 FRCP sanctions in federal court, Opposer does not sue for purported trademark infringement – but, instead, would misuse this Board as an asset-draining, intimidation vehicle.

“BOBOBO” mark versus its BONOBO mark are not confusing **even for use on the very same (clothing) goods.** (See Coexistence Agreement attached as Exhibit D hereof).

These facts alone show that the Opposer has acquiesced in usages of the very same mark “BONOBO” for use on a wide variety of goods, and thus should be estopped from taking its present inconsistent position herein. Therefore, the Applicants’ Affirmative Defenses related thereto should not be stricken. But, however, if a more detailed pleading were deemed by the Board to be necessary, the Applicants would be pleased to do so.

Conclusion.

The Applicants will not importune the Board. Specifically, and because Opposer acknowledges that it has the burden of proof regarding:

- (i) whether its Pleading has stated a cause of action for which relief could be granted (and it does not); and
- (ii) whether a likelihood of confusion exists between (a) Opposer’s goods comprising “fashion consulting”, custom clothes, towels, etc., and (b) Applicants’ pull-up bar and dependent accessories (and it does not);

the Applicant has no present reason to make an issue thereon, and thus respectfully withdraws these Affirmative Defenses without prejudice.

But, however, as for the Affirmative Defense(s) that: “The Notice of Opposition is barred by the doctrines of acquiescence, waiver, consent, laches or estoppel...”, the Opposer is manifestly incorrect. These defenses are expressly permitted under Rule 8(c) FRCP. And, moreover, Opposer’s posturing is even more absurd, considering that it has already agreed that use of the “BOBOBO” mark versus its “BONOBOS” marks are not confusing **even for us on the very same (clothing) goods.** (Coexistence Agreement, Exhibit D hereof).

Wherefore, the shameful Opposer has no cognizable case here.

Respectfully submitted this 12th day of September, 2019,

Robert M. Ward

Robert M. Ward

USPTO Reg. No. 26,517

BMWipLAW, LLC

3455 Peachtree Road NE,

Floor 5

Atlanta, GA 30326

Ph: 404-606-6480

Attorney for Applicants

CERTIFICATE OF SERVICE

I do hereby certify that a true and correct copy of the foregoing was filed on the date set forth hereon electronically via the ESTTA electronic filing system in the United States Patent and Trademark Office with notice and copy of same being electronically served by the TTAB upon all counsel of record.

Robert M. Ward