

ESTTA Tracking number: **ESTTA1005308**

Filing date: **09/28/2019**

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

Proceeding	91250321
Party	Defendant Yes Studio, LLC
Correspondence Address	THOMAS F. ZUBER ZUBER LAWLER AND DEL DUCA LLP 350 S GRAND AVE, 32ND FLOOR 350 S GRAND AVE, 32ND FLOOR LOS ANGELES, CA 90071 trademarkprosecution@zuberlaw.com no phone number provided
Submission	Answer
Filer's Name	Nathaniel L. Fintz
Filer's email	trademarkprosecution@zuberlawler.com, tzuber@zuberlawler.com, jzuber@zuberlawler.com, nfintz@zuberlawler.com, khipps@zuberlawler.com, kkawai@zuberlawler.com
Signature	/Nathaniel Fintz/
Date	09/28/2019
Attachments	2019_09_28_ANSWER.pdf(161464 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

POTOMAC TOBACCO COMPANY
LIMITED,

Opposer,

v.

YES STUDIO, LLC,

Applicant.

Opposition No.: 91250321

Ser. No.: 87876821

Mark: YES CANNABIS

**ANSWER TO NOTICE OF
OPPOSITION**

Yes Studio, LLC (“Applicant”) answers the Notice of Opposition (the “Notice”) filed by Potomac Tobacco Company Limited (“Opposer”) against Applicant’s U.S. Trademark Application Ser. No. 87876821 for the mark YES CANNABIS (“Applicant’s Mark”), as follows:

With respect to the preamble to the Notice, Applicant denies that Opposer will be damaged by the registration of Applicant’s Mark.

ANSWER TO PARAGRAPH 1: Admitted that Applicant filed U.S. Trademark Application Ser. No. 87876821 for the mark YES CANNABIS, covering “Creating an on-line community for registered and unregistered users, for the purpose of reviewing and discussing cannabis products, manufacturers, distributors and service providers; Hosting an on-line community web site featuring information on cannabis products, manufacturers, distributors and service providers” in International Class 042 and “Providing a website for connecting sellers with buyers; Providing a website for connecting cannabis consumers with products and producers of products; Providing consumer product information via the Internet; Providing a web site featuring the ratings, reviews and recommendations on products and services for commercial purposes

posted by users; Promoting the goods and services of others by providing a website featuring product reviews, maps to physical stores and links to the retail websites of others; Providing consumer information in the field of cannabis products, manufacturers, distributors and service providers” in International Class 035, on an intent-to-use basis under Section 1(b) of the Trademark Act. Admitted that Ser. No. 87876821 was published in the Trademark Official Gazette on April 23, 2019. Otherwise, denied.

ANSWER TO PARAGRAPH 2: Admitted.

ANSWER TO PARAGRAPH 3: Admitted.

ANSWER TO PARAGRAPH 4: Admitted.

ANSWER TO PARAGRAPH 5: Admitted.

ANSWER TO PARAGRAPH 6: Applicant lacks information or knowledge sufficient to form a belief as to the truth of the allegations contained in this paragraph of the Opposition and therefore denies those allegations.

ANSWER TO PARAGRAPH 7: Applicant lacks information or knowledge sufficient to form a belief as to the truth of the allegations contained in this paragraph of the Opposition and therefore denies those allegations.

ANSWER TO PARAGRAPH 8: Admitted that searching <https://tsdr.uspto.gov> for Ser. No. 87141106 yields a record for the mark YES listing a filing date of August 17, 2016, and listing a 1(b) filing basis, and listing an identification of goods and services containing “Cigarettes” in International Class 034 and nothing more. Admitted that the records for Ser. No. 87141106 at <https://tsdr.uspto.gov> indicate that, on August 23, 2019, a fourth request for Extension of Time to File a Statement of Use was granted. Admitted that Ser. No. 87876821 for the mark YES CANNABIS was filed by Applicant on April 13, 2018. Otherwise, denied.

ANSWER TO PARAGRAPH 9: Admitted that Applicant seeks to register the mark YES CANNABIS. Otherwise, denied.

ANSWER TO PARAGRAPH 10: Applicant lacks information or knowledge sufficient to form a belief as to the truth of the allegations contained in this paragraph of the Opposition and therefore denies those allegations.

ANSWER TO PARAGRAPH 11: Applicant lacks information or knowledge sufficient to form a belief as to the truth of the allegations contained in this paragraph of the Opposition and therefore denies those allegations.

ANSWER TO PARAGRAPH 12: No response is required for this paragraph of the Opposition because it contains legal arguments and/or legal conclusions. To the extent a response is required, Applicant states as follows: Admitted that the Controlled Substances Act (“CSA”) makes federally unlawful, *inter alia*, the manufacturing, distributing, dispensing, or possessing of certain controlled substances, including marijuana. Also admitted that the CSA makes it federally unlawful to sell, offer for sale, or use any facility of interstate commerce to transport drug paraphernalia, which means any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under the CSA. Also admitted that the 2018 Farm Bill removed “hemp” from the CSA’s definition of marijuana, which means that cannabis plants and derivatives such as CBD that contain no more than 0.3% THC on a dry-weight basis are no longer controlled substances under the CSA. Otherwise, denied.

ANSWER TO PARAGRAPH 13: No response is required for this paragraph of the Opposition because it contains legal arguments and/or legal conclusions. To the extent a response

is required, Applicant states as follows: Admitted that the Controlled Substances Act (“CSA”) makes federally unlawful, *inter alia*, the manufacturing, distributing, dispensing, or possessing of certain controlled substances, including marijuana. Also admitted that the CSA makes it federally unlawful to sell, offer for sale, or use any facility of interstate commerce to transport drug paraphernalia, which means any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under the CSA. Also admitted that the 2018 Farm Bill removed “hemp” from the CSA’s definition of marijuana, which means that cannabis plants and derivatives such as CBD that contain no more than 0.3% THC on a dry-weight basis are no longer controlled substances under the CSA. Otherwise, denied.

ANSWER TO PARAGRAPH 14: No response is required for this paragraph of the Opposition because it contains legal arguments and/or legal conclusions. To the extent a response is required, Applicant states as follows: Admitted that the Controlled Substances Act (“CSA”) makes federally unlawful, *inter alia*, the manufacturing, distributing, dispensing, or possessing of certain controlled substances, including marijuana. Also admitted that the CSA makes it federally unlawful to sell, offer for sale, or use any facility of interstate commerce to transport drug paraphernalia, which means any equipment, product, or material of any kind which is primarily intended or designed for use in manufacturing, compounding, converting, concealing, producing, processing, preparing, injecting, ingesting, inhaling, or otherwise introducing into the human body a controlled substance, possession of which is unlawful under the CSA. Also admitted that the 2018 Farm Bill removed “hemp” from the CSA’s definition of marijuana, which means that cannabis plants and derivatives such as CBD that contain no more than 0.3% THC on a dry-weight

basis are no longer controlled substances under the CSA. Otherwise, denied.

ANSWER TO PARAGRAPH 15: Applicant lacks information or knowledge sufficient to form a belief as to the truth of the allegations contained in this paragraph of the Opposition and therefore denies those allegations.

ANSWER TO PARAGRAPH 16: Applicant denies the allegations contained in this paragraph of the Opposition.

ANSWER TO PARAGRAPH 17: Applicant is not able to provide a response to this paragraph of the Opposition as it is not written with sufficient clarity to fully comprehend it. To the extent a response is required, Applicant denies the allegations contained in this paragraph of the Opposition.

ANSWER TO PARAGRAPH 18: No response is required for this paragraph of the Opposition because it contains legal arguments and/or legal conclusions. To the extent a response is required, Applicant states as follows: (a) the opposed mark has not created, does not create, and will not create the impression of an association with Opposer; and (b) otherwise, Applicant lacks information or knowledge sufficient to form a belief as to the truth of the allegations contained in this paragraph of the Opposition and therefore denies those allegations.

ANSWER TO PARAGRAPH 19: No response is required for this paragraph of the Opposition because it contains legal arguments and/or legal conclusions. To the extent a response is required, Applicant denies the allegations contained in this paragraph of the Opposition.

AFFIRMATIVE DEFENSES

1. Opposer's claims are barred by the doctrine of laches.
2. Opposer's claims are barred by the doctrine of acquiescence.

3. Opposer's claims are barred by the doctrine of estoppel.
4. Opposer's claims are barred by the doctrine of waiver.
5. Opposer's claims are barred due to non-infringement.
6. Opposer's claims are barred due to lack of intent to infringe.
7. Opposer is not entitled to any of the requested relief because Applicant's use of the mark YES CANNABIS is not likely, when used in connection with the services set forth in the opposed application, to cause confusion, mistake, or deception with the mark YES cited by Opposer in the Notice (the "Cited Mark"). Opposer does not allege that it uses the Cited Mark in connection with "Creating an on-line community for registered and unregistered users, for the purpose of reviewing and discussing cannabis products, manufacturers, distributors and service providers; Hosting an on-line community web site featuring information on cannabis products, manufacturers, distributors and service providers" in International Class 042 or "Providing a website for connecting sellers with buyers; Providing a website for connecting cannabis consumers with products and producers of products; Providing consumer product information via the Internet; Providing a web site featuring the ratings, reviews and recommendations on products and services for commercial purposes posted by users; Promoting the goods and services of others by providing a website featuring product reviews, maps to physical stores and links to the retail websites of others; Providing consumer information in the field of cannabis products, manufacturers, distributors and service providers" in International Class 035.
8. Opposer is not entitled to any of the requested relief because the overall differences in the Cited Mark and Applicant's Mark are substantial and significant. Applicant's Mark differs significantly in sound, appearance, connotation, and commercial impression from the Cited

Mark.

9. Opposer is not entitled to any of the requested relief because Opposer has neither alleged nor presented any evidence of actual confusion.
10. Opposer's claims are barred because the Cited Mark is invalid.

CONCLUSION

For the foregoing reasons, Applicant prays that the Board promptly dismiss the current opposition proceeding with prejudice.

Respectfully submitted,

Dated: September 28, 2019

/Jeffrey J. Zuber/
Jeffrey J. Zuber, Esq.
ZUBER LAWLER & DEL DUCA LLP
350 S. Grand Avenue, 32nd Floor
Los Angeles, California 90071
213-596-5620 (main)
jzuber@zuberlawler.com

/Nathaniel Fintz/
Nathaniel L. Fintz, Esq.
ZUBER LAWLER & DEL DUCA LLP
One Penn Plaza, Suite 4430
New York, New York 10119
212-899-9830 (main)
nfintz@zuberlawler.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on September 28, 2019, a true copy of this paper is being served upon Opposer's counsel via email sent to the following email addresses:

kjs@jennisonlaw.com

jennisonlaw@jennisonlaw.com

Respectfully submitted,

/Nathaniel Fintz/

Nathaniel L. Fintz, Esq.
ZUBER LAWLER & DEL DUCA LLP
One Penn Plaza, Suite 4430
New York, New York 10119
212-899-9830 (main)
nfintz@zuberlawler.com